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Abstracts of decisions

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1. Article 056 EPC | T 2004/21 | Board 3.3.09

Article 056 EPC

Case Number	T 2004/21
Board	3.3.09
Date of decision	2023.12.05
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (yes) – alternative solution of a known problem (no) – ex post facto analysis (no)
Cited decisions	
Case Law Book	I.D.4.5. , I.D.6. , 10th edition

In [T 2004/21](#) the claimed invention related to a chewing gum which provided a hydration or "mouthwatering" sensation to a consumer. The appeal was against the decision of the opposition division finding that the European patent as amended according to auxiliary request 1 met the requirements of the EPC and in which decision the claimed subject-matter was considered by the opposition division to have involved an inventive step over the teaching of D1 and D2.

The board considered that since D2, like the opposed patent, related to a chewing gum inducing a pleasant sensory experience in the consumer, it was, as argued by the respondent, the closest prior art. D1 focused on maintaining the mechanical properties of a chewing gum after long storage rather than on the sensorial effects induced in a consumer. Thus, the board found that D1 was not the closest prior art.

Although D2 did not mention the mouthwatering effect, the results in the patent made it credible that the chewing gum disclosed in D2, which contained erythritol granules, induced it. There was no evidence that the chewing gum according to the invention induced a stronger mouthwatering effect compared to that of D2.

The board did not agree with the appellant, however, that mouthwatering was an inherent property of the chewing gum of D2 and that this document already provided a solution to the problem of providing a chewing gum inducing mouthwatering. It referred to the established case law as set out in Case Law of the Boards of Appeal, 10th ed. 2022, I.D.4.5., "Alternative solution of a known problem". Although

the chewing gum of D2 had "inherent" mouthwatering properties, D2 disclosed neither these properties nor the problem of providing a mouthwatering effect in a user. "Mouthwatering" was not mentioned in any of the cited prior-art documents. The claimed chewing gum could therefore not be considered an alternative solution to a known problem.

When assessing inventive step, an interpretation of the prior-art documents as influenced by the problem solved by the invention where the problem was neither mentioned nor suggested in those documents had to be avoided, such an approach being merely the result of a posteriori analysis (Case Law of the Boards of Appeal, 10th ed. 2022, I.D.6., "Ex-post facto analysis"). Formulating the problem as the provision of an "alternative chewing gum" which was meant, explicitly or implicitly, to solve the problem of inducing mouthwatering would imply that this problem, as well as its solution, was known at the filing date. This would require reading into the teaching of D2 the technical contribution which the patent made over the prior art, namely the finding that erythritol granules induced a mouthwatering effect. This would inevitably result in an ex-post facto analysis.

For these reasons, starting from D2, which disclosed chewing gums preventing an abrasive sensation, the underlying objective technical problem was to be formulated as the provision of a chewing gum inducing a mouthwatering effect in a consumer.

Considering obviousness, the board held that none of the cited prior-art documents mentioned the problem of providing a chewing gum providing a mouthwatering effect. This problem was apparently not even known at the filing date. Therefore, to arrive at the claimed chewing gum without hindsight knowledge of the patent in suit would have required inventive skills. For these reasons alone, the skilled person confronted with the underlying problem would have had neither any reason nor guidance to prepare the claimed chewing gum by increasing the amount of coarse particles in the chewing gum of D2. Furthermore, D2 did not suggest providing a chewing gum comprising the claimed amount of coarse erythritol granules and taught away from the claimed solution.

The subject-matter of claim 1, as well as that of the following claims, which were narrower in scope, therefore involved an inventive step over the prior art. For these reasons the board dismissed the appeal.

051-05-24

2. Article 087(1) EPC | T 2224/21 | Board 3.2.01

Article 087(1) EPC

Case Number	T 2224/21
Board	3.2.01
Date of decision	2024.03.20
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 087(1), 088(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority (yes) – application of G 1/22 – presumption of entitlement rebutted (no) – same invention (yes) – validity of priority date (yes)
Cited decisions	G 0001/22
Case Law Book	II.D.2.2. , II.D.3.1. , 10th edition

In [T 2224/21](#) the appellant (opponent) argued that it had not been proven that the applicant of the contested patent was the same as the applicant of the first application. It pointed out that it had been impossible for it to access all the relevant information relating to the disputed transfer because this was non-public information in the possession of the respondent (patent proprietor). Therefore, the burden of proof lay with the respondent. The appellant also argued that the contested patent did not relate to the same invention as disclosed in the priority document.

The board disagreed. On the "same applicant" argument, the board referred to the principles set out in G 1/22, which were also applicable to the case in hand. A rebuttable presumption of priority entitlement applied. This was a strong presumption under normal circumstances since the other priority requirements (which established the basis for the presumption of priority entitlement) could usually only be fulfilled with the consent and even cooperation of the priority applicant. The party challenging the entitlement to priority could thus not just raise speculative doubts but must demonstrate that specific facts support serious doubts about the subsequent applicant's entitlement to priority. In the present case, the appellant only raised speculative doubts not supported by evidence. On the contrary, the evidence presented by the respondent reinforced the strong presumption. In this context, it was not apparent to the board why the alleged failure by the respondent to provide written evidence in the form of commercial contracts or agreements between the parties should go to the detriment of the respondent. Moreover, the appellant was not

in a position in which any evidence for rebutting the presumption of entitlement would only be at the hands of the respondent. The board concluded that the respondent was entitled to the priority.

On the "same invention" argument, the appellant put forward that the contested patent related to an "electronic vapour provision device" whereas the priority document disclosed an "electronic inhalation device". A vapour provision device was not meant to be necessarily used for inhalation purposes and also covered other kind of devices such as e.g. fog machines and engines exhausting toxic vapour not envisaged by the first application. The term "electronic vapour provision device" was technically different from the term "electronic inhalation device" with the consequence that the priority document and the contested patent did not cover the same invention as required by Art. 87(1) EPC. Moreover, according to the priority document electronic inhalation devices were typically cigarette-sized devices allowing a user to inhale a nicotine or essence vapour from a liquid store by applying a suction force to a mouthpiece. Electronic vapour provision devices as recited in claim 1 of the contested patent were not intended for inhalation. In fact, the claimed device did not comprise a mouthpiece which was required in the inhalation device of the priority document for directing the flow of vapour into the user's mouth. Thus, the subject-matter of claim 1 was not directly and unambiguously derivable from the disclosure in the priority document.

The board was not convinced. In the board's opinion, the electronic vapour provision device of claim 1 as granted was also an inhalation device in the sense that the vapour delivered in the environment in which the device is operated was necessarily inhaled by any individual located nearby. Furthermore, as convincingly pointed out by the respondent, the application as originally filed described the electronic vapour provision device at issue essentially in the same way as the priority document disclosed an inhalation electronic inhalation device, i.e. as devices "allowing an user to inhale a nicotine vapour from a liquid store by applying a suction 10 force to a mouthpiece". The board also observed that the fact that the "mouthpiece" was omitted in claim 1 did not result in any new technical information because this feature was also omitted in claim 1 of the priority application. Therefore, the opposition division was correct in its finding that the patent as granted related to the same invention disclosed in the priority application.

052-05-24

3. Article 104(1) EPC | T 1292/21 | Board 3.2.08

Article 104(1) EPC

Case Number	T 1292/21
Board	3.2.08
Date of decision	2024.03.04
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 104(1) EPC
EPC Rules	
RPBA	Article 16(1)(c) RPBA 2020
Other legal provisions	
Keywords	apportionment of costs (no) – postponement of oral proceedings
Cited decisions	
Case Law Book	III.R.2.2.2 , III.C.6.1.4i , 10th edition

In [T 1292/21](#) stellte die Beschwerdegegnerin (Patentinhaberin) einen Antrag auf Kostenverteilung. Der Antrag bezog sich auf folgende Umstände:

Die Kammer hatte zu einer mündlichen Präsenzverhandlung am 23. Februar 2024 in Haar geladen. Der für den Vorabend dieser Verhandlung vorgesehene Flug des Vertreters des Beschwerdeführers (Einsprechenden) nach München wurde von der Fluggesellschaft kurz vor Abflug wegen eines Warnstreiks des Bodenpersonals am Zielflughafen storniert. Am selben Abend informierte der Vertreter des Beschwerdeführers den Vertreter der Beschwerdegegnerin via E-Mail davon, dass er aufgrund der Flugstornierung die Verhandlung am nächsten Tag nicht wahrnehmen können. Zu diesem Zeitpunkt war der Vertreter der Beschwerdegegnerin allerdings bereits abgereist und in München angekommen. Er erfuhr erst am nächsten Morgen von der Kammer, dass der Beschwerdeführer nicht anwesend sein konnte und dass dieser einen Verlegungsantrag gestellt hatte. Daraufhin schlug die Kammer dem anwesenden Vertreter der Beschwerdegegnerin und per Telefon dem Vertreter des Beschwerdeführers vor, eine Verhandlung per Videokonferenz stattfinden zu lassen, wobei die Kammer und die Beschwerdegegnerin in getrennten Räumen sitzen würden. Der Vertreter der Beschwerdegegnerin stimmte diesem Vorschlag zu. Der Vertreter des Beschwerdeführers stimmte diesem Vorschlag allerdings nicht zu. Die Kammer verlegte die mündliche Verhandlung auf ein späteres Datum.

Die Kammer erinnerte daran, dass nach Art. 104 (1) EPÜ der Grundsatz gilt, dass jeder Beteiligte die ihm erwachsenen Kosten selbst trägt. Von diesem Grundsatz kann aus Gründen der Billigkeit abgewichen werden. Zu den auferlegbaren Kosten gehören gemäß Art. 16 (1) Satz 2, Buchstabe c) VOBK diejenigen Kosten, die durch Handlungen oder Unterlassungen entstanden sind, die die rechtzeitige und effiziente Durchführung der mündlichen Verhandlung beeinträchtigen. Die Billigkeit einer Kostenverteilung ist grundsätzlich nur dann gegeben, wenn einem Beteiligten eine Sorgfaltspflichtverletzung vorzuwerfen ist.

Die Kammer merkte an, dass es einem Vertreter im Rahmen seiner Sorgfaltspflicht obliegt, die Anreise zu einer mündlichen Verhandlung so zu organisieren, dass er rechtzeitig vor Ort sein kann. Dies sei beim Vertreter des Beschwerdeführers der Fall gewesen. Die Sorgfaltspflicht umfasse jedoch nicht, dass der Vertreter sich vorab über sämtliche theoretisch möglichen Schwierigkeiten bei seiner Anreise informiert und diese im Vorfeld ausschließt. Der Kammer zufolge gab es im vorliegenden Fall keine Anhaltspunkte dafür, dass der Vertreter des Beschwerdeführers, der aus Luxemburg kam, bei Beachtung seiner Sorgfaltspflicht von dem Warnstreik in München hätte wissen müssen. Somit habe es sich bei der daraus resultierenden Flugstornierung um ein für den Vertreter des Beschwerdeführers unvorhersehbares Ereignis gehandelt. Im Zusammenhang mit der geplanten Anreise zur mündlichen Verhandlung konnte die Kammer daher keine Sorgfaltspflichtverletzung seitens des Vertreters des Beschwerdeführers erkennen.

Was das Format der mündlichen Verhandlung anbelangt, hatte der Beschwerdeführer argumentiert, dass es sich bei einer mündlichen Verhandlung in Präsenz um ein Grundrecht handle. Allein die Tatsache, dass sein Vertreter mit einem unvorhersehbaren Ereignis konfrontiert worden ist, könne nicht dazu führen, dass er auf dieses Recht verzichten müsse. Die Kammer stellte klar, dass es nicht darum ging, ob es ein Recht auf eine mündliche Verhandlung in Präsenz gibt, worauf der Vertreter des Beschwerdeführers hätte verzichten müssen, wenn er einer Verhandlung per Videokonferenz zugestimmt hätte. Entscheidend im vorliegenden Fall sei gewesen, dass die Kammer die Beteiligten zu einer Verhandlung in Präsenz geladen hatte. Der Vorschlag der Kammer, das Format kurzfristig zu ändern und die Verhandlung per Videokonferenz stattfinden zu lassen, sei lediglich ein Angebot und auch als solches formuliert gewesen. Dieses Angebot hatte der Vertreter des Beschwerdeführers ausgeschlagen. Damit blieb es letztlich bei dem von der Kammer für diese Verhandlung gewählten Format, also einer mündlichen Verhandlung in Präsenz. Zwar hätte der Beschwerdeführer durch die Annahme des Angebots verhindern können, dass der Beschwerdegegnerin weitere Kosten entstehen, jedoch falle die Vermeidung von Kosten auf Seiten der Beschwerdegegnerin nicht per se unter die Sorgfaltspflicht des Beschwerdeführers.

Die Kammer entschied, dass alle Beteiligten ihre Kosten selbst zu tragen hatten.

053-05-24

4. Article 111(1) EPC | T 0884/22 | Board 3.2.04

Article 111(1) EPC

Case Number	T 0884/22
Board	3.2.04
Date of decision	2024.02.23
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 111(1) EPC
EPC Rules	
RPBA	Article 11 RPBA 2020
Other legal provisions	
Keywords	remittal to the department of first instance (no) – request for remittal for examination of auxiliary requests not examined at first instance
Cited decisions	G 0001/95, G 0007/95
Case Law Book	V.A.9.2.1 , V.A.9.5 , V.A.9.6 , 10th edition

In [T 884/22](#) wies die Kammer den Antrag auf Zurückverweisung an die Einspruchsabteilung zurück.

Die Kammer erinnerte daran, dass sie gemäß Art. 111 (1) EPÜ entweder im Rahmen der Zuständigkeit des Organs tätig wird, das die Entscheidung erlassen hat, oder sie die Angelegenheit zur weiteren Entscheidung an dieses Organ zurückverweist. Nach Art. 11 VOBK verweist eine Kammer die Angelegenheit dann zur weiteren Entscheidung an das Organ zurück, das die angefochtene Entscheidung erlassen hat, wenn besondere Gründe dafür sprechen. Die Kammer erläuterte, dass solche in der Regel vorliegen, wenn das Verfahren vor diesem Organ wesentliche Mängel aufweist oder sich ungeprüfte Fragen der Patentierbarkeit ergeben (Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.9.3.2b)). Dies gelte insbesondere dann, wenn die Einspruchsabteilung nicht alle Einspruchsgründe geprüft hat. Denn in diesem Fall würde die Kammer zwangsläufig den rechtlichen Rahmen der erstinstanzlichen Entscheidung überschreiten, da die verschiedenen Einspruchsgründe gegen das Patent nach Art. 100 a) bis 100 c) EPÜ als eigenständige Rechtsgrundlagen zu betrachten sind (s. die konsolidierten Entscheidungen G 1/95 und G 7/95, Entscheidungsgrund 4 mit Unterpunkten 4.1-4.6). Hingegen stellten nicht geprüfte Hilfsanträge oder weitere Angriffslinien gegen das Vorliegen einer an sich geprüften Patentierungsvoraussetzung regelmäßig keine besonderen Gründe dar (Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.9.6.1, V.A.9.6.2). Die Kammer rief in Erinnerung, dass ein Rechtsanspruch auf

Entscheidung aller Fragen in zwei Instanzen nicht besteht (siehe Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.9.2.1) und begründete dies insbesondere damit, dass die Anerkennung eines solchen Anspruchs absehbar zu einer Vielzahl von Zurückverweisungen und anschließenden Beschwerden führen könnte, was ein offensichtlich widersinniges Ergebnis sei. Ziel des Beschwerdeverfahrens sei es, zu einer für alle Parteien verbindlichen Entscheidung zu gelangen. In den Fällen, in denen hierfür die erstmalige Behandlung neuen Sachverhaltes oder neuen Sachvortrages erforderlich wird, so die Kammer, ist eine Abwägung zwischen der wünschenswerten Behandlung des Stoffes in zwei Instanzen und der ebenfalls wünschenswerten Verfahrenseffizienz erforderlich. Die Kammer wies darauf hin, dass die Praxis der Kammern dazu tendiere, neu eingereichte Hilfsanträge, die bereits in der Einspruchsabteilung behandelte Einspruchsgründe betreffen, ohne eine Zurückverweisung zu behandeln, eine Zurückverweisung aber dann vorzunehmen, wenn es erforderlich würde, in der ersten Instanz nicht behandelte Einspruchsgründe zu diskutieren.

Die Kammer kam zu dem Schluss, dass die Beschwerdegegnerin (Patentinhaberin) keine besonderen Gründe, geschweige denn wesentliche Mängel des Verfahrens vor der Einspruchsabteilung aufgezeigt hatte. Aus der Tatsache, dass das Patent in geändertem Umfang aufrechterhalten wurde, folge vielmehr, dass die Einspruchsabteilung alle Einspruchsgründe geprüft hatte, was auch aus der angefochtenen Entscheidung hervorgehe. Die Tatsache, dass die erst während der mündlichen Verhandlung vor der Einspruchsabteilung gestellten Hilfsanträge 2-4 dort nicht diskutiert wurden, stellte aus Sicht der Kammer keinen besonderen Grund dar, da keine derartig neuen Tatsachen zu Tage getreten waren, die die Beteiligten hätten überraschen können oder deren Behandlung den Beteiligten unter den gegebenen Umständen nicht zugemutet werden konnte. Da die angefochtene Entscheidung auf Basis des vorliegenden Hilfsantrags 1 ergangen war, mussten die weiteren Hilfsanträge 2-4 nicht von der Einspruchsabteilung behandelt werden. Auch die Tatsache, dass die Mitteilung der Kammer nur darauf verwiesen hatte, dass gegebenenfalls die Hilfsanträge zu prüfen seien, stellte nach Ansicht der Kammer keinen solchen Grund dar. Denn alle Parteien hatten bereits im schriftlichen Beschwerdeverfahren zu den Hilfsanträgen 2-4 vorgetragen.

Daher entschied die Kammer, im Rahmen der Zuständigkeit der Einspruchsabteilung tätig zu werden und sich mit den Hilfsanträgen 2-4 zu befassen (Art. 111 (1) EPÜ).

054-05-24

5. Article 113 EPC | T 0737/20 | Board 3.3.04

Article 113 EPC

Case Number	T 0737/20
Board	3.3.04
Date of decision	2023.10.18
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 111(1), 112a, 113 EPC
EPC Rules	Rules 104, 106 EPC
RPBA	Articles 11, 12(2), 23 RPBA 2020
Other legal provisions	
Keywords	right to be heard – violation (no) – fundamental procedural defect (no) – obligation to raise objections – objection dismissed – remittal to the department of first instance (no)
Cited decisions	
Case Law Book	III.B.1. , V.B.3.4.2. , 10th edition

During the oral proceedings in [T 737/20](#) the board informed the parties that it had decided not to remit the case to the opposition division and intended to deal with the issue of inventive step itself. Subsequently, the appellant raised an objection under R. 106 EPC to the effect that its right to be heard under Art. 113 EPC had not been respected. The appellant argued that the board's refusal to remit the case to the opposition division in accordance with Art. 11 RPBA infringed both Art. 112a(2)(c) and (d) EPC. According to the appellant, Art. 112a(2)(c) EPC was infringed because the patentees' request to have the question of inventive step examined at two different levels of jurisdiction had been refused and Art. 112a(2)(d) EPC was infringed because the refusal of the request to remit the matter to the opposition division was a fundamental procedural defect in view of Art. 11, 12(2) and 23 RPBA. The board dismissed the objection.

The board found that there were two reasons why no violation of the right to be heard had occurred in the oral proceedings.

Firstly, the appellant had been heard on the issue of remittal. Indeed, it had been given and had taken advantage of multiple opportunities both in writing and during the oral proceedings to comment on whether the case should be remitted to the opposition division for further prosecution. Furthermore, it had been given and had

taken advantage of multiple opportunities both in writing and at the oral proceedings to comment on the respondents' objections on inventive step.

Secondly, where a board opts not to remit a case and to decide the case on the merits, there was no legal obligation under Art. 113 EPC to hear the parties on this matter. The right to be heard was not an end in itself. A party had to be heard on matters, whether substantive or procedural, only if these lead to decisions which could adversely affect the legitimate interest of that party. While deciding to remit a case to allow issues to be decided by two instances is one of the two options under Art. 111(1) EPC, it had to be remembered that the boards of appeal had the final say on the allowability of claim requests. Deferring a decision by the board on the allowability of a claim request through a remittal could not be regarded as a legitimate interest of a party. No party was adversely affected by a board's decision to decide the case itself. Any potential adverse effect would be due to other, later decisions taken by the board, e.g. on the merits of the case or on the admittance of new requests or objections. As a consequence, even though the board had considered the extensive submissions of the parties on the issue of remittal, this had not been legally necessary.

The board furthermore held that not remitting the case to the opposition division for further prosecution for consideration of inventive step of claim 1 of the patent was not a fundamental procedural violation in view of Art. 12(2) RPBA. As emphasised in Art. 11 RPBA and contrary to the appellant's view, Art. 12(2) RPBA did not preclude boards of appeal from dealing with matters not dealt with in the decision under appeal. Instead, the boards had discretion on this under Art. 111(1) EPC.

For the sake of completeness, the board noted that the list of grounds for a petition for review in Art. 112a EPC and R. 104 EPC was exhaustive. The "other" fundamental procedural defects referred to in Art. 112a(2)(d) EPC could only arise from either a failure to arrange for the holding of oral proceedings requested by a party (R. 104(a) EPC) or a failure to decide on a request relevant to the board's decision (R. 104(b) EPC). Therefore, even if the appellant's understanding of Art. 12(2) RPBA were correct, the alleged violation of the procedural principle that the appellant had inferred from that provision would not qualify as a ground for filing a petition for review.

055-05-24

6. Article 123(2) EPC | T 2047/21 | Board 3.4.03

Article 123(2) EPC

Case Number	T 2047/21
Board	3.4.03
Date of decision	2024.04.11
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (yes) – disclaimers – undisclosed disclaimers
Cited decisions	G 0001/03, G 0002/10, G 0001/16
Case Law Book	II.E.1.7.3 , 10th edition

In [T 2047/21](#) claim 1 of auxiliary request 1b defined a container by means of a disclaimer. It was disputed among the parties whether this was a "disclosed disclaimer" or an "undisclosed disclaimer".

The board explained that G 1/16 provided definitions for the terms "undisclosed disclaimer" and "disclosed disclaimer". The term "undisclosed disclaimer" related to the situation in which neither the disclaimer itself nor the subject-matter excluded by it had been disclosed in the application as filed. The term "disclosed disclaimer" related to the situation in which the disclaimer itself might not have been disclosed in the application as filed but the subject-matter excluded by it had a basis in the application as filed. Thus, undisclosed disclaimers and disclosed disclaimers could be distinguished according to whether the subject-matter on which the respective disclaimer was based was explicitly or implicitly, directly and unambiguously, disclosed to the skilled person using common general knowledge, in the application as filed.

In the case in hand, the disclaimed subject-matter was a container for containing tissue comprising features (a) to (c1). The board established that this was an "undisclosed disclaimer" because the skilled person using their general knowledge would not directly and unambiguously derive this type of container from the original application.

To be allowable, an undisclosed disclaimer had to fulfil one of the criteria set out in point 2.1 of the order of decision G 1/03 (see the Headnote of G 1/16).

An undisclosed disclaimer may be allowable in order to: restore novelty by delimiting a claim against state of the art under Art. 54(3) and (4) EPC [1973]; restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC (an anticipation was accidental if it was so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention); and disclaim subject-matter which, under Art. 52 to 57 EPC, was excluded from patentability for non-technical reasons.

During the opposition proceedings, the appellant justified the disclaimer by the objections raised against granted claim 1 in view of D2. However, D2 was neither state of the art under Art. 54(3) EPC nor an accidental anticipation under Art. 54(2) EPC. During the appeal proceedings, the appellant did not put forward any argument to show that any of the criteria set out in G 1/03 were fulfilled.

The board thus concluded that claim 1 of auxiliary request 1b did not meet the requirements of Art. 123(2) EPC.

056-05-24

7. Rule 071(5) EPC | T 1823/23 | Board 3.3.06

Rule 071(5) EPC

Case Number	T 1823/23
Board	3.3.06
Date of decision	2024.01.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 097(1), 113(2) EPC
EPC Rules	Rules 071(3), 071(5), 103(1)(b) EPC
RPBA	
Other legal provisions	
Keywords	examination procedure – approval of the text intended for grant by the applicant (no) – "true will" of the examining division – substantial procedural violation (yes) – reimbursement of appeal fee (no)
Cited decisions	G 0001/10, J 0004/09, T 2081/16, T 1003/19, T 0265/20, T 0408/21
Case Law Book	IV.B.3.2.3b , V.A.11.7.2a , 10th edition

In [T 1823/23](#) the appellant (applicant) filed an appeal against the decision of the examining division to grant the patent in the version indicated in the communication under R. 71(3) EPC of 21 February 2023. The appellant requested that the patent be granted on the basis of the documents identified in its letter of 31 January 2023 and the reimbursement of the appeal fee.

The application as filed included three drawing sheets including figures 1 to 6. The drawing sheets were always properly listed in the request for entry into the European phase and in the communications from the examining division. They were also included in the documents submitted by the applicant on 31 January 2023 as the basis for a communication under R. 71(3) EPC.

The communication under R. 71(3) EPC of 21 February 2023, however, did not contain any drawings, nor was there, according to the board, any hint that any deletion or amendment had been made by the examining division to the drawing sheets. There was thus a clear discrepancy between the description referring to the figures and the absence of any drawing sheets in the text intended for grant, which should have been remarked upon by the examining division when allegedly deleting the drawing sheets. It appeared to the board that neither the members of the

examining division nor the appellant had realised that the drawing sheets were missing and that the documents referred to in the communication pursuant to R. 71(3) EPC did not correspond to those according to the appellant's request. The appellant had filed a translation of the claims in the two other official languages and paid the fee for grant and publication.

In view of the file history and taking into account the EPO practice regarding amendments proposed by the examining division, the board concluded that the examining division had not indicated in the communication according to R. 71(3) EPC the text it had intended to grant. Following T 2081/16, T 408/21 and T 1003/19, the board held that R. 71(5) EPC did not apply, as in the step preceding the deemed approval the applicant had to be informed of the text in which the examining division intended to grant the patent according to R. 71(3) EPC. Although the applicant had received a R. 71(3) EPC communication, the documents indicated were not those which the examining division intended to grant.

The board was aware of decision T 265/20, in which the competent board did not follow the approach in decisions T 2081/16, T 408/21 and T 1003/19. The present case was however distinguished from T 265/20 not least in that the board could identify convincing reasons why the examining division's true intention was not reflected by the text of the R. 71(3) EPC communication.

As all other requirements pursuant to R. 101(1) EPC had been met, the board concluded that the appeal was admissible. It held that a decision to grant pursuant to Art. 97(1) EPC based on an application in a text which was neither submitted nor agreed to by the appellant, as was the case here, did not comply with Art. 113(2) EPC. The decision under appeal was therefore set aside.

According to the board, the reimbursement of the appeal fee was not equitable because the applicant had made no use of opportunities to participate in the initial proceedings. The error made by the examining division had already been inserted into the communication under R. 71(3) EPC, and the applicant could and should have noticed it when checking the text of this communication. The fact that no published drawing sheets existed should have alerted it and prompted a double check. The request for reimbursement of the appeal fee was therefore rejected.

057-05-24

8. Rule 136(1) EPC | T 0231/23 | Board 3.2.03

Rule 136(1) EPC

Case Number	T 0231/23
Board	3.2.03
Date of decision	2023.12.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 122(1) EPC
EPC Rules	Rules 112(1), 136(1) EPC
RPBA	
Other legal provisions	
Keywords	re-establishment of rights (no) – request admissible (no) – removal of the cause of non-compliance upon knowledge by professional representative – time limit for filing request for re-establishment
Cited decisions	J 0027/90, J 0001/20, T 0812/04, T 2251/12, T 1588/15, T 1995/19, T 1547/20, T 1570/20, T 1678/21
Case Law Book	III.E.4.1.1a), III.E.4.1.1b), 10th edition

In [T 231/23](#) the appeal was against the examining division decision rejecting the appellant's request for re-establishment of rights with regard to the time limit for paying the renewal fee for the 6th year with surcharge. According to the board, the admissibility of the appellant's request for re-establishment filed on 16 September 2020 depended on whether it was submitted in due time in accordance with Art. 122(1) EPC, R. 136(1) EPC. It was thus decisive when the cause of non-compliance with the time limit to pay the renewal fee together with a surcharge was removed.

The board recalled that the removal of the cause of non-compliance with a time limit under R. 136(1) EPC was to be established on a purely factual basis and occurred, as a rule, on the date on which the person responsible for the application vis-à-vis the EPO became aware of the fact that a time limit had not been observed (T 1547/20, T 1995/19, J 27/90, T 1570/20) for example by receipt of a loss of rights communication under R. 112(1) EPC. As a rule, the cause of non-compliance did not persist longer than up to the time at which the previous unawareness of the missed time limit was removed (T 1995/19). If a professional representative was appointed, the representative was the person responsible for the application vis-à-vis the EPO

(J 1/20). Accordingly, if a loss of rights communication under R. 112(1) EPC was issued to a duly appointed professional representative, the removal of the cause of non-compliance in principle occurred with the actual receipt of such a communication (T 1995/19, T 2251/12, T 812/04, T 1678/21). Regarding time limits for the payment of fees, an appointed professional representative remained the person responsible for the application vis-à-vis the EPO, and thus the person whose knowledge matters in assessing when the cause of non-compliance was removed, irrespective of whether a third party other than the representative was responsible for the payment of fees (see J 27/90, T 1570/20).

In the present case, the loss of rights communication was received by the professional representative's firm on 7 February 2020. The professional representative denied that his colleagues at the firm presented this communication to him before 18 July 2020. The board noted that, even if this had happened, the representative's own affidavit confirmed that he already had at the very least actual knowledge of the relevant contents of this on 2 July 2020. Hence, at the latest on 2 July 2020, the representative gained actual knowledge of the missed time limit and the associated loss of rights. In line with the case law referred to above, the removal of the cause of non-compliance had occurred on this date at the latest. This triggered the two-month time limit under R. 136(1) EPC.

The board reiterated that the removal of the cause of non-compliance – initiating the start of the two-month time limit under R. 136(1) EPC – did not require any additional knowledge on the part of the professional representative about possible reasons for missing the time limit, such as whether the non-payment of renewal fees had been intentional or not. It was sufficient that the representative became aware of the fact that the time limit for paying the renewal fee for the 6th year with surcharge had not been complied with. This knowledge objectively enabled the professional representative to take appropriate action, for example by filing a request for re-establishment of rights within two months of having gained that knowledge.

The appellant contested the board's findings and argued that awareness of an error within the meaning of J 1/20 required actual knowledge by the professional representative that it had been unintentional on the part of the applicant not to pay the renewal fee. In the board's view, the gist of J 1/20 was that removal of the cause of non-compliance within the meaning of R. 136(1) EPC was a question of fact. Accordingly, the cause of non-compliance was only removed on the date on which the person responsible for the application became aware of the fact that a time limit had not been observed, and not on an earlier date on which it ought to have become aware of that fact.

In conclusion, in the present case, the cause of non-compliance under R. 136(1) EPC was removed when the professional representative became aware of the missed time limit and the lapse of the application, which is established to have been the case at the latest on 2 July 2020. The appellant's request for re-establishment dated 16 September 2020 was not filed within two months of that date and was therefore inadmissible. The appeal was dismissed.

058-05-24

9. Article 12(3) RPBA | T 1220/21 | Board 3.3.06

Article 12(3) RPBA 2020

Case Number	T 1220/21
Board	3.3.06
Date of decision	2023.11.14
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(3), 12(5), 13(2) RPBA 2020
Other legal provisions	
Keywords	party's complete appeal case (no) – reply to statement of grounds of appeal – validly filed request (yes) – discretion not to admit submission
Cited decisions	T 2598/12, T 0420/14, T 0568/14, T 2115/17, T 1659/20
Case Law Book	V.A.4.3.5b), V.A.4.3.5c), 10th edition

In [T 1220/21](#) auxiliary requests 2 and 3, filed by the respondent with its reply to the appeal, corresponded to two auxiliary requests, which, in the board's view, had been admissibly raised and maintained in the opposition proceedings. They were thus not regarded as an amendment under Art. 12(4) RPBA. However, these requests had not been substantiated in the reply to the appeal.

For assessing the requests' admittance under Art. 12(3) and (5) RPBA, the board proceeded in two steps: in a first step, it ascertained whether they had been validly filed and whether the respondent's reply, with respect to these requests, fulfilled the requirements of Art. 12(3) RPBA; in a second step it assessed whether the subsequent submissions of the respondent, aiming at substantiating the auxiliary requests, should be admitted pursuant to Art. 13(2) RPBA, and exercised its discretion under Art. 12(5) RPBA.

On whether an unsubstantiated request is validly filed, the board held, in view of the provisions of Art. 12(3) and (5) RPBA, that a lack of or an insufficient substantiation of an amended request may lead to its non-admittance, but that this did not imply that the request had not been validly filed.

Concerning the required substantiation, the board noted that the provisions of Art. 12(3) RPBA reflect that it is not for the board to speculate as to the intentions

underlying the party's submissions or to further investigate the submissions made before the first instance. The board then pointed out that an amended request, that is self-explanatory, nevertheless did not meet the standard as set out in Art. 12(3) RPBA, because an implicit argument did not meet the requirement that the party should specify expressly the arguments relied on (see also T 2598/12).

With regard to the required degree of substantiation, the board explained that this depended on the specific circumstances of the case. The proprietor was at least required to (i) indicate the basis in the application as filed for each amendment, (ii) indicate which objections are intended to be overcome by which amendment, and (iii) provide reasons why an amendment overcomes the objections raised (similar to Art. 12(4), fourth sentence, RPBA). Moreover, if a claim request was intended to overcome novelty or inventive step objections, the proprietor should identify the relevant documents and the features which distinguish the claimed subject-matter therefrom (see T 1659/20). The board finally held that the specific extent and detail of the explanations required depended on the level of detail and accuracy of the objections to be overcome.

The board made it clear that the requirement set out in Art. 12(3) RPBA also applied when the opposition had been rejected and the proprietor acted as respondent in the appeal proceedings. If the proprietor requests that the patent be maintained based on a claim request which does not correspond to that found allowable in the impugned decision, this implies that the decision under appeal is to be amended and should therefore be reasoned according to Art. 12(3) RPBA. The board pointed out that the duty to provide a basis for the amendments did not depend on whether the allowability of the request has been previously contested under Art. 123(2) EPC. It also held that information that can only be found in attached documents, without an explicit reference and explanation by the party, cannot be regarded as sufficient substantiation pursuant to Art. 12(3) RPBA.

The board then assessed whether the late substantiation of the request could be admitted under Art. 13(2) RPBA, which was rejected by the board, and exercised its discretion under Art. 12(5) RPBA not to admit the requests. As noted by the board, this discretion had to be exercised in view of the specific circumstances of the case. The purpose of Art. 12(3) RPBA was to ensure that the relevant submissions were present in the proceedings as early as possible to enable the board and the other party(ies) to start working on the case on the basis of the parties' complete submissions without being forced to speculate on the intentions of the other parties. The extent to which a lack of or an incomplete substantiation runs counter to this objective was a factor that could be taken into account when exercising the discretion under Art. 12(5) RPBA (T 1659/20). This included addressing the question of whether the amendments and the chain of logic underlying the claim requests were self-explanatory (which was not the case here).

059-05-24

10. Article 13(2) RPBA | T 2019/20 | Board 3.3.10

Article 13(2) RPBA 2020

Case Number	T 2019/20
Board	3.3.10
Date of decision	2023.11.21
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(4), 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons – taken into account (yes) – deletion of claims – no amendment "in substance" – claimed subject-matter and attacks fully encompassed by initial appeal cases – partial abandonment of the initial appeal case
Cited decisions	T 2295/19
Case Law Book	V.A.4.2.2d), V.A.4.5.5g), 10th edition

In [T 2019/20](#) the board had to decide on the admittance of auxiliary request 1 filed by the respondent during oral proceedings before the board. This request consisted of independent claim 1 which was identical to independent claim 17 of the patent as granted (main request) and 10 dependent claims, which were likewise identical to claims in the patent as granted. All product claims had been deleted.

The board noted that all the issues to be discussed for auxiliary request 1 would also have had to be discussed for the main request (patent as granted) if claim 1 of this request had been found to involve an inventive step, which was a plausible outcome in view of the findings of the opposition division's decision to reject the opposition. Therefore, the filing of auxiliary request 1 during the oral proceedings before the board did not bring in unexpected new issues to be dealt with.

The board concluded that the substance of this request – i.e. the claimed subject-matter and the attacks against it – was fully encompassed by both the appellant's and the respondent's initial appeal case within the meaning of Art. 12(1) to (3) RPBA. The request certainly limited the potential issues for discussion. In the board's opinion, this meant that, in view of the totality of the facts of the present case, the filing of this request, although formally an amendment and as such potentially subject to the strict provisions of Art. 13(2) RPBA, in substance did not constitute an

amendment of the party's case within the meaning of Art. 12(4) RPBA. It rather constituted a partial abandonment of the initial appeal case.

The board held that there was no apparent reason not to admit the request under any of Art. 12(5), 13(1) or 13(2) RPBA, and decided to admit the request under its discretionary powers pursuant to Art. 13(1) RPBA.

060-05-24

11. Article 13(2) RPBA | T 1686/21 | Board 3.2.01

Article 13(2) RPBA 2020

Case Number	T 1686/21
Board	3.2.01
Date of decision	2024.01.23
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Art. 15(1) RPBA communication – taken into account (yes) – exceptional circumstances (yes) – amendment solving all issues, not surprising for the opponent and not detrimental to procedural economy – high number of objections – procedural efficiency
Cited decisions	
Case Law Book	V.A.4.5.1 , V.A.4.5.5j , 10th edition

In [T 1686/21](#) the main request was filed by the respondent as auxiliary request 1f" during the oral proceedings before the board in reaction to the board's finding that the omission, in claim 1 of the patent as maintained, of a certain feature resulted – contrary to the assessment of the opposition division – in an unallowable intermediate generalisation of a specific embodiment disclosed in the originally filed parent application and therefore infringed Art. 76(1) EPC.

The board noted that the specific combination of features now recited in claim 1 had never been claimed as such in any request filed by the respondent and that the addition of the feature at issue ("paddle shape" feature) – even though it had already been added to claim 1 of several other auxiliary requests – was an amendment to the respondent's appeal case.

Regarding the admissibility of this amendment, the appellant (opponent) had argued that the omission of the "paddle shape" feature had been the subject of an objection both during the opposition proceedings and in its statement of grounds of appeal and that the respondent could and should have filed this request at the latest with its reply to the statement of grounds of appeal.

However, the board considered the following circumstances of the case and concluded that they represented exceptional circumstances justifying the admittance of the main request in hand.

The amendment under discussion was already present in several auxiliary requests filed during the first-instance proceedings and re-submitted by the respondent on appeal in order to address the objection raised by the appellant concerning omission of the "paddle shape" feature. In view of this, the appellant's objection of lack of substantiation was not justified. This amendment explicitly defined a feature that the opposition division had read – albeit erroneously, in the board's view – into the wording of independent claim 1. It clearly addressed and solved the issue under Art. 76(1) EPC raised against the patent as maintained. In view of the above, the amendment could not be considered surprising for the appellant in such a way as to negatively affect its position in the appeal proceedings, thereby giving an advantage to the other party. The amendment at issue did not give rise to new objections and was not detrimental to procedural economy. And, last but not least, in view of the large number of different objections raised under Art. 76(1) EPC, the number of requests to be filed at the very beginning of the appeal proceedings in order to provide appropriate fall-back positions for every possible outcome of the assessment of compliance with Art. 76(1) EPC would have been extremely high and therefore not compliant with procedural efficiency.

061-05-24

12. Article 13(2) RPBA | T 1800/21 | Board 3.3.05

Article 13(2) RPBA 2020

Case Number	T 1800/21
Board	3.3.05
Date of decision	2023.12.18
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(4), 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons – taken into account (yes) – deletion of claims – exceptional circumstances (yes) – amendment serving procedural economy – fair proceedings
Cited decisions	R 0007/14, T 1480/16, T 1569/17, T 0494/18, T 0995/18, T 2091/18, T 2920/18, T 1857/19, T 2201/19, T 2295/19, T 0532/20, T 0598/20, T 0424/21
Case Law Book	V.A.4.2.2d), V.A.4.5.5g), 10th edition

In der Sache [T 1800/21](#) waren im Hilfsantrag V, der nach Zustellung der Ladung zur mündlichen Verhandlung eingereicht wurde, sämtliche Verfahrensansprüche gestrichen und lediglich die Vorrichtungsansprüche beibehalten worden.

Zunächst prüfte die Kammer, ob es sich um eine Änderung des Vorbringens gegenüber dem Vorbringen in der Beschwerdeerwiderung handelte. Sie bejahte dies im Einklang mit einer Reihe vorheriger Entscheidungen und begründete dies damit, dass eine Kammer, sofern ein Anspruch aus einem Anspruchssatz nicht gewährbar ist, keine Verpflichtung hat, die anderen Ansprüche zu prüfen. Erst das Streichen der Verfahrensansprüche führte im vorliegenden Fall zur Notwendigkeit, die Vorrichtungsansprüche ebenfalls zu prüfen. Daher, so die Kammer, kann die Streichung nicht lediglich als Verzicht auf einen Teil des Streitgegenstands angesehen werden. Die Frage, inwieweit die verbleibenden Ansprüche bereits erörtert wurden bzw. welchen Umfang die notwendige weitere Prüfung hat, betreffe dagegen Aspekte der Verfahrensökonomie und der Fairness des Verfahrens und sei daher erst für die in einem zweiten Schritt vorzunehmende Ermessensausübung, ob diese Änderung noch ins Verfahren zugelassen werden kann, relevant.

Hinsichtlich der Auslegung des Begriffs "außergewöhnliche Umstände" befand die Kammer, dass dieser nicht auf den in den erläuternden Bemerkungen anlässlich der Einführung der VOBK genannten typischen Anwendungsfall der Reaktion auf eine späte Verfahrensentwicklung beschränkt werden könne. Sie bestätigte die Auffassung in T 2295/19, wonach der Wortlaut von Art. 13 (2) VOBK keine Kausalität zwischen den außergewöhnlichen Umständen und der Einreichung der späten Änderung verlangt und bei einer teleologischen Auslegung der Vorschrift vor dem Hintergrund der Art. 114 (2) und 123 (1) EPÜ die Befugnis zur Nichtberücksichtigung späten Vortrags keinen Selbstzweck darstellt; vielmehr dient sie den Grundsätzen der Verfahrensökonomie und des fairen Verfahrens. Demnach kann nach Ansicht der Kammer ein Hilfsantrag berücksichtigt werden, wenn die Änderung den faktischen oder rechtlichen Rahmen des Verfahrens nicht verschiebt, keine Neugewichtung des Verfahrensgegenstandes bedingt und weder dem Grundsatz der Verfahrensökonomie, noch den berechtigten Interessen einer Verfahrenspartei zuwiderläuft.

Die Kammer wies darauf hin, dass diese Erwägungen den Kriterien entsprechen, die die Rechtsprechung auch bereits zur Begründung herangezogen hatte, wann Streichungen als bloße Beschränkung und nicht als Änderung angesehen werden sollten. Es scheint sich, so die Kammer, eine einheitliche Rechtsprechungslinie dahingehend zu entwickeln, dass in Fällen, in denen durch eine unkomplizierte Änderung wie das Streichen einer gesamten Anspruchskategorie eine Antragsfassung vorliegt, auf deren Basis das Patent erkennbar aufrechterhalten werden kann, außergewöhnliche Umstände im Sinne von Art. 13 (2) VOBK vorliegen können. Diese erlauben nach Ansicht der Kammer dann eine positive Ermessensausübung, wenn die obigen Kriterien erfüllt sind (was im vorliegenden Fall zutrifft).

Diese Rechtsprechung fügt sich, so die Kammer, auch hinsichtlich des Grades der geforderten Relevanz in die Stufen des mit der VOBK etablierten Konvergenzansatzes ein: Während auf der ersten Stufe gemäß Art. 12 (4) VOBK bei der Ermessensausübung lediglich die Eignung zur Behandlung der Fragestellungen, die zur angefochtenen Entscheidung führten, verlangt wird, ist gemäß Art. 13 (1) VOBK auf der zweiten Stufe bereits die Eignung zur Lösung der von einem anderen Beteiligten im Beschwerdeverfahren oder von der Kammer aufgeworfenen Fragen gefordert und darf die Änderung keinen Anlass zu neuen Einwänden geben. Im Vergleich zu den beiden ersten Stufen des Konvergenzansatzes nochmals verschärft sind die Kriterien, die im Rahmen der oben genannten Rechtsprechung erfüllt sein müssen, um einen außergewöhnlichen Umstand gemäß Art. 13 (2) VOBK anzunehmen.

Vor diesem Hintergrund sah die Kammer keine Notwendigkeit (mehr), zur Sicherung einer einheitlichen Rechtsanwendung die Große Beschwerdekammer zu befragen.

062-05-24

13. Article 13(2) RPBA | T 1558/22 | Board 3.2.04

Article 13(2) RPBA 2020

Case Number	T 1558/22
Board	3.2.04
Date of decision	2024.02.07
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rule 139 EPC
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Art. 15(1) RPBA communication – taken into account (no) – correction of errors in document – obvious error (no) – immediately evident that nothing else could have been intended (no) – exceptional circumstances (no)
Cited decisions	
Case Law Book	V.A.4.5.6g), 10th edition

In [T 1558/22](#) hatte die Kammer über die Zulassung des in der mündlichen Verhandlung eingereichten Hilfsantrags 4a zu entscheiden. Dieser war eine korrigierte Fassung des Hilfsantrags 4, der bereits im Einspruchsverfahren eingereicht worden war und erneut mit der Beschwerdeerwiderung. Die Korrektur bestand in der Streichung der Verfahrensansprüche 12 und 13, die – so die Beschwerdegegnerin (Patentinhaberin) – einen offensichtlichen Fehler enthielten, da bestimmte einschränkende Merkmale versehentlich nicht enthalten waren, obwohl dies erkennbar beabsichtigt gewesen sei. Als außergewöhnliche Umstände machte die Beschwerdegegnerin geltend, dass der Fehler offensichtlich sei und die Kammer erst in der mündlichen Verhandlung auf den korrigierten Fehler hingewiesen habe.

Die Kammer vermochte jedoch keinen offensichtlichen Fehler zu erkennen. Dass in den abhängigen Ansprüchen verschiedene einschränkende Merkmale nur selektiv übernommen wurden, erweckte nicht den Eindruck eines Versehens, sondern vielmehr einer bewussten Entscheidung und Auswahl von Merkmalen. Jedenfalls war aus Sicht der Kammer nicht offensichtlich, dass beabsichtigt war, den Wortlaut der abhängigen Ansprüche vollständig an die jeweils in Anspruch 1 vorgenommenen Änderungen anzupassen. Zudem hätte in diesem Fall die Berichtigung in der Anpassung an Anspruch 1 bestanden, nicht in einer Streichung der Ansprüche. Die


Voraussetzungen für die Zulassung einer Berichtigung waren daher nach Ansicht der Kammer nicht erfüllt.

Im Hinblick auf die Ausführungen in ihrer Mitteilung befand die Kammer ferner, dass ihre Auffassung zur erfinderischen Tätigkeit der Ansprüche 12 und 13 gemäß Hilfsantrag 4 die Beschwerdegegnerin in der mündlichen Verhandlung nicht überrascht haben konnte. Im Rahmen ihrer prozessualen Sorgfaltspflicht oblag es ihr, ihre eigenen Anträge vor der mündlichen Verhandlung nochmals zu überprüfen und gegebenenfalls zu korrigieren. Die Beschwerdeführerin durfte nach Ansicht der Kammer auch nicht davon ausgehen, dass alle in der vorläufigen Auffassung nicht nochmals für nachrangige Hilfsanträge erwähnten Einwände in Bezug auf diese Hilfsanträge nicht unverändert weitergälten trotz gleichen Sachverhalts.

Im Übrigen konnte aus Sicht der Kammer dahingestellt bleiben, ob ihr und/oder der Beschwerdegegnerin anfangs tatsächlich bewusst war, dass die Ansprüche 12 und 13 des Hilfsantrags 4 die betreffenden einschränkenden Merkmale nicht enthielten. Denn die Beschwerdeführerin hatte in ihrer Antwort auf die vorläufige Auffassung der Kammer darauf hingewiesen. Spätestens zu diesem Zeitpunkt hätte die Beschwerdegegnerin ihren möglichen Irrtum bezüglich des Inhalts der Ansprüche 12 und 13 gemäß Hilfsantrag 4 erkennen können. Eine entsprechende Änderung des Hilfsantrags 4 versuchte sie erst während der mündlichen Verhandlung mit dem Hilfsantrag 4a nachzuholen. Einer solchen abwartenden, verzögernden Verfahrensführung sollte aber, so die Kammer, mit dem Konvergenzansatz der reformierten Verfahrensordnung gerade Einhalt geboten werden.

Die Kammer stellte somit fest, dass ein außergewöhnlicher Umstand außerhalb des Verantwortungsbereichs der Beschwerdegegnerin, der die verspätete Einreichung des Hilfsantrags 4a hätte rechtfertigen können, nicht vorlag. Daher sei auch nicht maßgeblich, ob weitere in den Art. 12(4), 13(1) VOBK definierte Kriterien der Ermessenausübung (z. B. fehlende Komplexität der Änderung), die zusätzlich zu den strikten Erfordernissen des Art. 13(2) VOBK Berücksichtigung finden können, erfüllt waren.

063-05-24



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