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# Abstracts of decisions

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## Abstracts of decisions

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## 1. Article 056 EPC | T 1126/19 | Board 3.3.07

### Article 056 EPC

<b>Case Number</b>	T 1126/19
<b>Board</b>	3.3.07
<b>Date of decision</b>	2023.07.21
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Article 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step (yes) – ex post facto analysis – whole list of alternatives in the closest prior art must be considered
<b>Cited decisions</b>	T 0970/00, T 0777/08, T 0041/17
<b>Case Law Book</b>	<a href="#">I.D.6.</a> , 10th edition

In [T 1126/19](#) the patent was directed to new polymorphic forms of rucaparib salts. Rucaparib is used in cancer therapy to potentiate the effect of radiotherapy or cytotoxic drugs which cause DNA damage. The invention was based on the finding that crystalline rucaparib camsylate was particularly suitable for the preparation of solid dosage forms due to its physical stability and low hygroscopicity.

The closest prior art was D1, which disclosed a list of about 60 pharmaceutically acceptable salts of rucaparib that could be used in therapy, including camsylate, although the preferred salts were phosphate and gluconate. Starting from the list of pharmaceutically acceptable salts in paragraph of D1, the subject-matter of claim 1 differed in the selection of camsylate as the rucaparib salt and the additional requirements that the salt be crystalline and show three specific PXRD peaks.

The board stated that the starting point should be the whole list rather than the specific option of the camsylate salt. As explained in decision T 970/00, the disclosure of the closest prior art had to be considered on the basis of its technical information, without distorting or misrepresenting it by the knowledge of the invention. D1 neither illustrated the camsylate salt of rucaparib nor presented it as a standalone embodiment; camsylate was one among a long list of possible options, but not among the preferred ones. The board held that the isolation of one of the non-

preferred options would distort the teaching of D1, putting an inappropriate weight on that option.

The board found the objective technical problem to be the provision of a solid form of rucaparib having a suitable combination of properties for development into a solid dosage form. The board was satisfied that the subject-matter of claim 1 solved this problem.

On the issue of obviousness, D1 did not deal with the formulation of solid forms of rucaparib. It contained no teaching on whether any of the salts in the long list therein might possibly be suitable for preparing an oral solid formulation. The skilled person would have needed to study each of the salts for assessing: first, whether they were solid; second, how many solid forms they could adopt; and third, whether there were forms with properties suitable for a solid formulation. The board noted it was common general knowledge that finding a salt of an active compound which has a balance of properties making it suitable for an oral solid formulation was generally a difficult semi-empirical task which required non-routine experimentation and had an uncertain outcome. The board did not find a pointer to the salt of claim 1 in any of the combination documents cited by the appellant-opponent either.

The board accepted the argument that D3 and D35 showed it was common general knowledge that crystalline forms were less hygroscopic and more stable than amorphous forms, and that searching for stable solid forms was part of the development of solid oral dosage forms. However, starting from the list of salts in D1, it went beyond routine work to find whether any of the listed salts, if at all, exhibit the set of properties required for solid oral dosage forms.

The board distinguished T 777/08, in which the skilled person started from the amorphous form of a drug, and T 41/17, in which the skilled person started from a known crystalline form of sorafenib tosylate. These situations were not comparable with the one at hand, in which the skilled person had to start from a long list of possible salts.

Thus the board found the salt of claim 1 involved an inventive step and claim 1 met the requirements of Art. 56 EPC.

064-06-24

## 2. Article 056 EPC | T 1994/20 | Board 3.3.03

### Article 056 EPC

<b>Case Number</b>	T 1994/20
<b>Board</b>	3.3.03
<b>Date of decision</b>	2023.11.24
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Article 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step (no) – comparative tests – experimental comparison not suitable to demonstrate an alleged effect in the context of the closest prior art
<b>Cited decisions</b>	T 0035/85
<b>Case Law Book</b>	<a href="#">I.D.4.3.2</a> , 10th edition

In [T 1994/20](#) the appeal lay against the decision of the opposition division to reject the opposition. It was an object of the invention to provide an improved polyolefin composition suitable for the production of a pressure pipe with improved pressure resistance as well as impact properties. D3 related to pressure pipe multimodal polyethylene compositions and material D – which the board took as the closest prior art – was therein described as having good non-sagging properties, as well as excellent physical properties. The parties took differing positions as to which problem could be considered to be successfully solved by the subject-matter of operative claim 1 and comparative tests were offered by the respondent in support of its position.

The board found the material used in the comparative example of the specification differed in many aspects from the material of the closest prior art. This in itself did not invalidate the respondent's arguments based on the comparison made in the specification, since the possibility of using a comparison made with a variant of the closest prior art has been recognised by the Boards of Appeal as early as in T 35/85.

However, since the question to be answered concerned the problem successfully solved over the closest prior art by the claimed subject-matter, the board held it was per se not sufficient to demonstrate that an effect or advantage resulting from the distinguishing feature was observed in the context of a variant of the closest prior art

used as reference example in the comparative test. It had to additionally be credible that the same effect or advantage took place in the context of the closest prior art, i.e. irrespective of the modification of the closest prior art operated to prepare the reference example of the comparative test. Concerning the present case, in the absence of any technical explanation for the technical effects resulting from the use of a LMW fraction having a lower MFR<sub>2</sub> of not more than 100 g/10 min. in the context of the comparative example of the patent in suit, there was no apparent reason to expect that the same effects were also obtained in the context of the closest prior art, which substantially differed therefrom.

Consequently, the respondent had not presented any corroborating evidence or explanations rendering it credible that the purported technical effect was actually achieved. Accordingly, any such advantage of the claimed polyethylene composition over the closest prior art could not be taken into account for the purpose of assessing inventive step.

Thus, the board held the problem underlying the claimed invention had to be reformulated as the mere provision of a further polyethylene composition for use in pressure pipes.

065-06-24

### 3. Article 056 EPC | T 0686/22 | Board 3.2.04

#### Article 056 EPC

<b>Case Number</b>	T 0686/22
<b>Board</b>	3.2.04
<b>Date of decision</b>	2023.11.27
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Articles 052, 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step – technical and non-technical features – games
<b>Cited decisions</b>	T 0641/00, T 1543/06, T 0336/07
<b>Case Law Book</b>	<a href="#">I.D.9.2.14</a> , 10th edition

In [T 686/22](#) the application related to an information processing apparatus comprising game processing means. An object of the invention was to enable the apparatus to perform game play by splitting a screen at a place, that is on a display means, desired by a user. The apparatus was provided with a restriction process means which restricted the number of players permitted to play a multi-player game when the apparatus display means was used rather than an external TV.

Before discussing inventive step in detail, the board reviewed the context of examining inventive step of inventions concerned with games. Art. 52(2)(c) with Art. 52(3) EPC explicitly mentions schemes, rules and methods for playing games as being excluded from patentability as such. As explained in T 336/07, "a game in the usual sense of the word is characterized by ... its rules of play which govern the conduct and actions of the players during game play...[A] set of game rules thus determines how game play evolves from beginning to end in response to player actions and decisions...". That decision went on to emphasise that such a set of rules is "normally so perceived by the players involved, and as serving the explicit purpose of playing a game".

The board adopted the approach as set out in T 1543/06 (Gameaccount) which was based foremost on T 641/00 (Comvik, OJ EPO 2003, 352). Thus, only those features that contribute to technical character are to be taken into account when assessing inventive step. That requirement cannot rely on excluded (non-technical) subject-matter alone, however original it may be. The mere technical implementation of



something excluded cannot therefore form the basis for inventive step. Rather, it is necessary to consider in detail how that matter has been technically implemented.

In the case at hand, the board found that the application differed from the prior art (the Nintendo Wii U system with its Wii U game console and Wii U GamePad operator device) insofar as it offered the availability of a limited multiplayer mode. The board considered this not to be inventive since the idea of restricting the number of players permitted to play a certain game according to the screen used (display or TV) determines how gameplay is permitted to develop and thus lies firmly in the domain of the game designer who conceives the game. The game designer will make this choice based, amongst other things on the screen area and screen resolution needed for a player to comfortably view the content of a particular game. Moreover, the players will be well aware of the game designer's choice in this respect: They would know that using a certain screen determines how many players can play the game. Thus, the board considered that a game rule underpinned this feature making it not inventive.

066-06-24

## 4. Article 061(1) EPC | J 0001/23 | Board 3.1.01

### Article 061(1) EPC

<b>Case Number</b>	J 0001/23
<b>Board</b>	3.1.01
<b>Date of decision</b>	2024.03.27
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Articles 060(1), 061(1), 081 EPC
<b>EPC Rules</b>	Rules 014, 019 EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent
<b>Keywords</b>	entitlement to the grant of the patent by a person other than the applicant – final entitlement decision – resumption of proceedings
<b>Cited decisions</b>	G 0003/92, J 0008/20
<b>Case Law Book</b>	<a href="#">III.M.3.1.2</a> , <a href="#">III.T.</a> , <a href="#">IV.A.4.</a> , 10th edition

In [J 1/23](#) a third party had provided evidence to the EPO that it had instituted proceedings in Sweden against the registered applicant (appellant) seeking a decision within the meaning of Art. 61(1) EPC. The Legal Division had stayed the grant proceedings under R. 14(1) EPC. After the Swedish (appeal court) decision was handed down, the third party had requested to be included as co-applicant of the European patent application. In the decision under appeal, the Legal Division had held that the Swedish decision was a final decision within the meaning of Art. 61(1) EPC granting half of the right to the grant of the European patent to the third party, and the proceedings were resumed with the registered applicant and the third party as co-applicants.

The board explained that under R. 14(2) EPC, where evidence was provided that a final decision within the meaning of Art. 61(1) EPC had been taken, the EPO had to inform the applicant and any other party that the proceedings for grant were to be resumed as from the date stated in the communication. The EPO, in deciding on the stay or resumption of the grant proceedings under R. 14(1) and (2) EPC, only had to ascertain that the national proceedings invoked by the third party were indeed entitlement proceedings within the meaning of Art. 61 EPC.

It was undisputed that the Swedish decision was a final decision. The appellant, however, contended that it did not qualify as a decision adjudging that the third party was entitled to half of the European patent application within the meaning of Art. 61(1) EPC. In its view, the Swedish court could not decide on entitlement to the application because a passage referring to the "patent applications" had been removed from the third party's request in the Swedish appeal proceedings.

The board disagreed with the appellant's assertion. Entitlement decisions by national courts under Art. 61(1) EPC were expected to look different from one case to another. The wording of decisions in similar cases may vary accordingly. The key question was whether, in the particular case, the EPO interpreted the decision as a final entitlement decision within the meaning of Art. 61(1) EPC. In the case in hand, even in the absence of an explicit reference to "all patent applications and patents that may be issued thereof", the entitlement to the invention as specified in the application inherently implied entitlement to the grant of a European patent based on the application.

The appellant also pointed out that there was no reference in the Swedish decision to any legal or contractual basis for the transfer of rights from the inventors to the third party. Citing J 8/20, it argued that the EPO had to examine, even if only formally, whether the statement filed under Art. 81 EPC identified an origin for the right to the patent within the scope of Art. 60(1) EPC.

The board disagreed. The statement under Art. 81, second sentence, EPC indicating the origin of the right to the patent had to be submitted by the applicant together with the request for grant (R. 19 EPC). The conclusion reached in J 8/20, stipulating that the EPO had to examine whether a statement filed under Art. 81, second sentence, EPC fell within the scope of the EPC, did not apply to the circumstances of the present case. In cases where a final sovereign decision of a national court had determined that a person other than the applicant was entitled to the grant of the European patent under Art. 61(1) EPC, the matter of how and by whom the right to the patent had been acquired was considered and settled by the competent national court, and the EPO was bound by the court's conclusion (Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent). The EPO was not competent to examine the substance and merits of the court's decision (G 3/92).

067-06-24

## 5. Article 083 EPC | T 0025/20 | Board 3.3.02

### Article 083 EPC

<b>Case Number</b>	T 0025/20
<b>Board</b>	3.3.02
<b>Date of decision</b>	2024.01.11
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 083, 100(b) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	sufficiency of disclosure – evidence of therapeutic effect – absence of experimental evidence – absence of a credible technical concept – therapeutic effect being a mere statement – no remedy with post-published evidence
<b>Cited decisions</b>	G 0002/21, T 0950/13
<b>Case Law Book</b>	<a href="#">II.C.7.2.2</a> , 10th edition

In [T 25/20](#) the invention concerned methods and compositions for treating symptoms associated with Post-Traumatic Stress Disorder (PTSD) using Cyclobenzaprine. Claims 1 and 6 related to second medical uses of a composition comprising cyclobenzaprine. They differed essentially in terms of the therapeutic effect to be achieved. The application as filed stated that cyclobenzaprine was suitable for the treatment of a variety of sleep disturbances, of which those mentioned in the patent were associated with conditions other than PTSD. The patent also stated that disturbed sleep was a central feature of PTSD. The parties agreed that these points were common general knowledge. The parties disagreed, inter alia, as to whether sleep disturbances associated with PTSD – a condition covered by claims 1 and 6 – could credibly be treated with a composition comprising cyclobenzaprine.

The board made reference to G 2/21 (point 77 of the Reasons) issued in the course of the present appeal proceedings.

The parties agreed that the application as filed did not contain any experimental evidence relating to the therapeutic effect in question. Turning then to the assessment of credibility, the board stated that there was no reference to the mode of action of cyclobenzaprine in the passage of the application relied on by the respondent (patent proprietor). The board concluded that the purported mode of action of cyclobenzaprine relied on by the respondent as a technical concept

supporting the achievement of the claimed therapeutic effect had not been disclosed in the application as filed. The board added that even if the respondent's purported mode of action of cyclobenzaprine had been disclosed verbatim in the application as filed, such a disclosure would still not have been tantamount to a credible technical concept, since the application as filed did in fact not demonstrate any mode of action of cyclobenzaprine; there were no investigations or explanations setting cyclobenzaprine apart from other drugs. There was no teaching as to what exactly made a compound, let alone cyclobenzaprine, suitable for the treatment of sleep disturbances associated with PTSD. The application as filed lacked any specificity in relation to cyclobenzaprine: the word "cyclobenzaprine" could simply be replaced by the name of any other drug.

The purported mode of action of cyclobenzaprine merely amounted to a guess as to how cyclobenzaprine might work and that it would be suitable for the treatment of sleep disturbances associated with PTSD. Such a guess did not make the purported mode of action of cyclobenzaprine or the technical concept built on it credible. Instead, there were substantiated doubts in the present case about the credibility of the purported mode of action of cyclobenzaprine and the technical concept based on it.

According to the respondent, the situation was analogous to that underlying T 950/13. In both cases, the application as filed did not contain experimental evidence. Nevertheless, in each case the mode of action of the drug was disclosed. Hence credibility of the technical concept should also be acknowledged in the present case. However, in the board's view the purported mode of action of cyclobenzaprine in the present case was not a mechanism at the molecular level which was of generally recognised importance for the disease or the symptom to be treated. Instead, the application as filed offered as support for the purported mode of action merely the known suitability of cyclobenzaprine for treating sleep disturbances associated with various conditions other than PTSD. This suitability alone was not sufficient to establish credibility in the present case because there were substantiated doubts about the purported mode of action and the technical concept based on it. This was different from T 950/13, in which the board did not identify such doubts.

In the absence of a credible technical concept, the mere allegation in the application as filed that cyclobenzaprine was suitable for treating sleep disturbances associated with PTSD, as covered by both claims 1 and 6, was a mere statement which was not enough to ensure sufficiency of disclosure. This lack of sufficiency could not be remedied by post-published evidence.

068-06-24

## 6. Article 123(2) EPC | T 0324/21 | Board 3.4.03

### Article 123(2) EPC

<b>Case Number</b>	T 0324/21
<b>Board</b>	3.4.03
<b>Date of decision</b>	2024.02.06
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Article 123(2) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	amendments – added subject-matter (yes) – intermediate generalisation – drawing – schematic drawing
<b>Cited decisions</b>	G 0003/89, G 0011/91, G 0002/10, T 0169/83, T 0398/00
<b>Case Law Book</b>	<a href="#">II.E.1.2.1</a> , <a href="#">II.E.1.13.1</a> , <a href="#">II.E.1.13.2</a> , 10th edition

In [T 324/21](#) the board found that the subject-matter of claim 1 of the main request extended beyond the content of the application as filed due to an unallowable intermediate generalisation, contrary to the requirements of Art. 123(2) EPC.

Amended claim 1 of the main request comprised some of the features illustrated in schematic Figures 7 and 8 as well as the additional features (M) and (N) originally disclosed only in the description of the detailed embodiments of Figures 2 to 6 in paragraphs [0035] and [0036] of the application as filed. Features (M) and (N) had equivalent meanings.

The board explained that the feature (M)/(N) was mentioned in the context of the mode of action of the structure of the very special arrangement of Figures 2 to 5. This effect and function was only achieved for the special relative dimensions shown in Figures 2 to 5 and not for any arbitrary structure. The feature (M)/(N) was thus very strongly embedded in the specific embodiments of Figures 2 to 6 and could not be transferred in its general and broad meaning to the schematic and generalised representation of Figures 7 and 8 without resulting in a generalisation, which was not disclosed in the application as filed.

On the other hand, despite the more generalised and simplified representation, the schematic drawings of Figures 7 and 8 still contained certain specific features in

relation to the relative sizes and (rectangular) shapes of several components and their relative arrangements which were not reflected in feature (M)/(N).

The description of a drawing may be inextricably linked to the specific disclosure of this drawing. If a feature in the description of the drawing was extracted from the very specific context of the drawing in order to be included in a claim, the specific disclosure of the drawing had to be taken into account. If there was no literal support for this specific disclosure in the application as filed which could be used to supplement the feature used to amend the claim, it may not be possible to avoid an unallowable intermediate generalisation. This could in particular occur if a feature from a specific and detailed embodiment was included in the context of a schematic drawing.

Therefore, the board considered that an unallowable intermediate generalisation occurred by including certain text passages from paragraphs [0035] and [0036] of the detailed embodiments of Figures 2 to 6 in the context of the description of schematic Figures 7 and 8, which in turn was inseparably linked to the specific disclosure of Figures 7 and 8.

069-06-24

## 7. Rule 064(2) EPC | T 2703/18 | Board 3.5.06

### Rule 064(2) EPC

<b>Case Number</b>	T 2703/18
<b>Board</b>	3.5.06
<b>Date of decision</b>	2023.12.06
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	C
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Articles 023(3), 082 EPC
<b>EPC Rules</b>	Rules 064, 111(2) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	Rules 40, 68 PCT
<b>Keywords</b>	unity of invention – scope of review under Rule 64(2) EPC – invitation to pay further fees justified (no) – refund of further search fee (yes)
<b>Cited decisions</b>	G 0001/89, G 0001/91, G 0002/92, J 0024/96, T 0631/97, T 0188/00, T 0708/00, T 0389/03, T 1476/09, T 0755/14, T 0756/14, T 2285/17, T 2526/17, T 0806/18, T 1414/18, T 2873/19, W 0004/85, W 0004/93, W 0011/93, W 0021/03, W 0009/07
<b>Case Law Book</b>	<a href="#">II.B.3.3.</a> , 10th edition

In [T 2703/18](#) the board considered the scope of the review under R. 64 EPC and the restraint to be exercised in the context of this rule. It noted that according to a number of board of appeal decisions the scope of the examining division's review under R 64(2) EPC (previously R. 46(1) EPC 1973) is limited to the consideration of certain facts and/or arguments.

The board agreed with T 188/00 to the extent that the examining division may only find that the communication pursuant to R. 64(1) EPC was justified within the meaning of R. 64(2) EPC on the basis of the facts regarding the prior art presented by the search division with that communication, in particular the documents cited in the partial search report including sheet B.

The board, however, was not fully convinced by the reasons provided in T 188/00, which referred inter alia to the so-called "protest procedure" according to R. 40.2(c) PCT. The present board pointed out that there were some notable differences between R. 64 EPC and R. 40 PCT (and, a fortiori, R. 68 PCT). In particular, R. 40.1(i) and 40.2(c) PCT expressly required both the invitation to pay additional



fees and the refund request to be reasoned, which R. 64 EPC did not. Moreover, while the relevant PCT Guidelines were binding guidance for the EPO when acting as an ISA and for the boards of appeal back when they were deciding on protests under the PCT (see G 1/89, headnote and point 6 of the Reasons), neither the PCT International Search and Preliminary Examination Guidelines nor the Guidelines for Examination in the EPO were binding on the boards of appeal when reviewing decisions of examining divisions (Art. 23(3) EPC). Hence, the conclusions drawn in the case law for the review of invitations to pay additional search fees under R. 40.2(c) PCT (or additional preliminary examination fees under R. 68.3(c) PCT) did not immediately carry over to R. 64(2) EPC.

The board concluded that the examining division may well rely on further facts in a finding that the communication under R. 64(1) EPC was not justified, for instance in the circumstances of the case in T 755/14 or, say, if further evidence shows that the only document cited in the partial search report and relied on in an a posteriori non-unity finding does actually not belong to the prior art. Such further facts need also not have been submitted by the applicant.

The board disagreed with the view expressed in T 2526/17 and T 1414/18 that the scope of the review should also be limited to the arguments presented by the search division, at least if understood as a limitation to only those arguments. According to the board, in the context of R. 64(2) EPC, the examining division may, in order to find the communication under R. 64(1) EPC to have been justified, complete a reasoning outlined by the search division with the communication but may not replace it by an entirely different reasoning, even if based on the same prior art.

Concerning the restraint to be exercised in the context of R. 64 EPC, the board stated that findings of lack of unity a posteriori must be raised with caution especially when they rest on an objection of inventive step. Moreover, the search division should refrain from raising formalistic objections based on a literal interpretation of the claims, because the assessment of unity of invention by the search division in the context of R. 64 EPC only serves the purpose of determining whether a partial search report is to be issued and the search according to Art. 92 EPC is to be based on the basis of the claims "with due regard to the description and any drawings". Findings on novelty or inventive step of the search division in its communication under R. 64(1) EPC should thus be robust, especially against foreseeable amendments and against clarity issues that the claims may have.

In the case at issue the board held that the reasoning of the examining division, like that of the search division, ignored the dependencies of claims 10 and 11 (apart from their dependency on claim 1) and it appeared that the examining division had only considered the additional features defined in each of the claims. The board therefore concluded that the communication pursuant to R. 64(1) EPC was not justified and the further search fee paid for claims 10 and 11 was to be refunded.

070-06-24

## 8. Article 12(4) RPBA | T 0246/22 | Board 3.5.03

### Article 12(4) RPBA 2020

<b>Case Number</b>	T 0246/22
<b>Board</b>	3.5.03
<b>Date of decision</b>	2024.01.09
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	C
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	
<b>EPC Rules</b>	
<b>RPBA</b>	Article 12(4) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	amendment to case – admissibly raised and maintained – meaning of "demonstrates" – onus on the party – minimum requirements
<b>Cited decisions</b>	R 0006/19, T 0042/20, T 0221/20, T 0364/20, T 1800/20, T 0476/21
<b>Case Law Book</b>	<a href="#">V.A.4.2.1c</a> , 10th edition

In [T 246/22](#) auxiliary requests 3 to 8 had already been filed during the opposition proceedings. However, the opposition division did not decide on them because a higher-ranking claim request had already been found allowable. The board noted that the decision under appeal was not based on these requests and that, pursuant to Art. 12(4), first sentence, RPBA, they were amendments "unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal".

The board explained that the ordinary meaning of "demonstrates" was that, as a general rule, the party making a submission bears the burden of showing that it was "admissibly raised and maintained". The lawmakers' idea was obviously not to put ex officio responsibilities on the boards and expect them to assume an investigative role, learn every detail of the first-instance proceedings, identify and track claim requests to their source, and understand why they were filed. The onus was no doubt on the amending party.

The board acknowledged that Art. 12(4) RPBA itself did not stipulate a time in the proceedings by which it had to be demonstrated that the respective submission was "admissibly raised and maintained". However, since the statement of grounds of appeal, together with which the auxiliary requests were submitted, lacked any indication that they were "admissibly raised and maintained", it had not contained the

proprietor's complete appeal case (cf. Art. 12(3) RPBA). In addition, there were increasingly demanding criteria for admitting new submissions made after the filing of the statement of grounds of appeal and the written reply (cf. Art. 13(1) and (2) RPBA). In this sense, according to the board, there were temporal restraints on the "demonstration" required under Art. 12(4), first sentence, RPBA. However, as an exemption from the general rule that the onus lies with the party, the board accepted that the minutes of the oral proceedings before the opposition division formed part of the basis of the appeal proceedings and that no further submissions on maintenance of the requests were required in the case in hand.

Regarding the requirements for a party's demonstration that submissions were indeed "admissibly raised" in the opposition proceedings, the board discussed several approaches. One approach was that a board decides whether the opposition division should have admitted the respective claim request into the opposition proceedings, had a decision on admittance been required (see e.g. T 364/20). This would mean that a board – at least in part – should slip into the shoes of the opposition division. It would then have to infer, from the board's perspective, how the opposition division should have exercised its discretion on the basis of the applicable procedural basis, e.g. in view of the current Guidelines for Examination, but also leniently applying the RPBA. This approach did not convince the board *inter alia* because its subject could correspond to a "moving target" and the Guidelines were not binding on the boards. Neither did the board subscribe to the elaborate criteria proposed by the competent board in T 1800/20, which, in the present board's view, could lead to rather harsh situations for the parties. Nor did the board endorse the conclusions drawn in decisions T 42/20 and T 476/21, where merely the timing aspect was considered. Rather it proposed a new approach defining minimum requirements for the demonstration of "admissibly raised". According to this approach the party had to show:

- 1) that the requests had been filed in due time, typically before expiry of the time limit set by the opposition division under R. 116(1) and (2) EPC; and
- 2) that it had been made clear, explicitly or by way of unambiguous implication, for which purpose they were filed, i.e. which objections raised by the other party or the opposition division they tried to overcome and how this was actually achieved.

In the present case, according to the board, regardless of whether the proprietor's submissions made only in its reply to the board's communication under Art. 15(1) RPBA could be considered to be substantiated on time, the proprietor had failed to clearly indicate for what purpose the requests were filed, i.e. how the objections were concretely addressed and why they would be overcome. Consequently, they constituted amendments within the meaning of Art. 12(4) RPBA. Since the amendments gave rise to divergent claims requests and certain features were taken from the description, possibly leading to a fresh case, none of the auxiliary requests 3 to 8 were admitted into the appeal proceedings (Art. 12(4) RPBA).

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## 9. Article 13(2) RPBA | T 0018/21 | Board 3.3.02

### Article 13(2) RPBA 2020

<b>Case Number</b>	T 0018/21
<b>Board</b>	3.3.02
<b>Date of decision</b>	2023.10.24
<b>Language of the proceedings</b>	DE
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	
<b>EPC Rules</b>	
<b>RPBA</b>	Article 13(2) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	amendment after summons (yes) – procedural request – request not to admit the new main request of the proprietor – exceptional circumstances (no)
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">V.A.4.2.2</a> , 10th edition

In [T 18/21](#) beantragte die Einsprechende während der mündlichen Verhandlung erstmals die Nichtzulassung des Hauptantrages, der als Hilfsantrag 1 mit der Beschwerdebeurteilung eingereicht worden war.

Die Kammer prüfte die Zulassung des Antrags der Einsprechenden auf Nichtzulassung des Hauptantrages nach Art. 13(2) VOBK. Dazu stellte sie zunächst fest, dass die Einsprechende im schriftlichen Beschwerdeverfahren in der Sache, nämlich im Hinblick auf die erfinderische Tätigkeit, zum Hauptantrag Stellung genommen hatte. Aus Sicht der Kammer stellte der in der mündlichen Verhandlung gestellte prozedurale Antrag auf Nichtzulassung des Hauptantrags eine Änderung gegenüber diesem bisherigen Vorbringen im Beschwerdeverfahren dar.

Außergewöhnliche Umstände waren weder von der Einsprechenden genannt, noch konnte die Kammer solche erkennen. Daher entschied die Kammer unter Berücksichtigung der Erfordernisse des Art. 13(2) VOBK, den Nichtzulassungsantrag der Einsprechenden nicht zuzulassen.

Die Kammer merkte auch an, dass ihr keine Gründe ersichtlich seien, weshalb der Hauptantrag nicht in das Verfahren zugelassen werden sollte. Entsprechend entschied sie, den Hauptantrag in das Verfahren zuzulassen.

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## 10. Article 13(2) RPBA | T 1006/21 | Board 3.3.08

### Article 13(2) RPBA 2020

<b>Case Number</b>	T 1006/21
<b>Board</b>	3.3.08
<b>Date of decision</b>	2024.01.30
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	C
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Article 111(1) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	Articles 11, 12(2), 12(4), 13(1), 13(2) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	amendment after notification of Art. 15(1) RPBA communication (no) – procedural requests – not subject to Art. 12, 13 RPBA
<b>Cited decisions</b>	T 1805/14, T 0078/17, T 1919/17, T 1913/19
<b>Case Law Book</b>	<a href="#">V.A.4.2.1</a> , <a href="#">V.A.4.2.2</a> , 10th edition

In [T 1006/21](#) both parties requested remittal of the case to the opposition division, albeit under different conditions. The respondents (opponents) also requested that the appellant's (patent proprietor's) request for remittal not be considered for being late-filed.

The board recalled that the discretionary decision to remit or not was to be taken ex officio, at any time during the appeal proceedings (see, inter alia, T 1805/14, T 78/17; Case Law of the Boards of Appeal, 10th ed, V.A.9.5) and that a decision on remittal was not dependent on any request by the parties.

In the board's opinion, any request for remittal made by a party was therefore not subject to the provisions of Art. 12 and 13 RPBA. Rather, these articles served to take account, within narrow limits (see T 1919/17, T 1913/19), of changes in the facts or the subject-matter of the appeal proceedings ("amendments" within the meaning of Art. 12(4) and 13(1) and (2) RPBA). The board concluded that these provisions were directed at (claim) requests or (allegations of) facts and evidence, i.e. at substantive issues, objections and related arguments (see Art. 12(2) and (4) and Art. 13(1) and (2) RPBA). In contrast, procedural requests were not amendments within the meaning of Art. 12(4) and 13(1) and (2) RPBA.

The board specified that procedural requests on questions that have to be taken up ex officio could relate to remittal, as in the case in hand, or to referral to the Enlarged

Board of Appeal (Art. 112(1)(a) EPC), the admissibility of the appeal (Art. 110 EPC), (non-)admission and consideration of claim requests, allegations of facts or evidence (Art. 114, R. 116(1) EPC), interruption of proceedings (R. 142 EPC), exclusion of board members (Art. 24(1) and (2) EPC), or the appointment of oral proceedings if expedient (Art. 116(1) EPC).

The board further explained that its conclusion also applied to other procedural requests on questions that did not have to be taken up ex officio but only upon request, such as for a change of date of oral proceedings (Art. 15(2) RPBA), acceleration of proceedings (Art. 10(3) RPBA), objections against board members (Art. 24(3) EPC) or according to R. 106 EPC, or requests for stay of proceedings (R. 14 EPC).

None of these procedural requests were subject to the provisions of Art. 12 and 13 RPBA. They could therefore be made at any time during the appeal proceedings and had to be considered by the board, regardless of when they were made.

Consequently, in the board's view, the question of the late filing of the appellant's request for remittal could not arise in the case in hand or in any other circumstances. Rather, the board had to decide ex officio whether the case should be remitted, irrespective of any request of the parties. In the case in hand, the board did not see any reasons in favour of a remittal.

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