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# Abstracts of decisions

Selected case law of the Boards of Appeal  
edited by the Legal Research Service  
of the Boards of Appeal

Issue 10 | 2024



Boards  
of Appeal

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**Case Law of the Boards of Appeal, 10<sup>th</sup> edition (update 2024) – references in issue 7/2024 and following**

In the table summarising the decision data for an abstract, the links to the CLB, 10th edition, lead to the [HTML version](#), which was updated in June 2024. In the body of any given abstract, references to the CLB mirror those provided by the board in the underlying decision.

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## Abstracts of decisions

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## 1. Article 056 EPC | T 0182/20 | Board 3.5.01

### Article 056 EPC

<b>Case Number</b>	T 0182/20
<b>Board</b>	3.5.01
<b>Date of decision</b>	2023.10.24
<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 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step – mixture of technical and non-technical features – modelling – predicting a specific malfunction of a specific mechanical or electrical component based on specific parameters
<b>Cited decisions</b>	G 0001/19
<b>Case Law Book</b>	<a href="#">I.D.9.2.15</a> , 10th edition

In [T 182/20](#) the invention concerned predicting future malfunctions of mechanical or electrical components based on the current values of one or more parameters.

Beyond the server-based processing, the method in claim 1 comprised a number of technical features. Firstly, the method involved measuring specific parameters (e.g. temperature and lubricant condition in the bearings of a gas turbine), which the board considered to be inherently technical (G 1/19, points 85 and 99 of the Reasons). Furthermore, these measurements were used to predict specific malfunctions in particular components (e.g. a bearing defect in a gas turbine or an insulation defect in a transformer). The board considered that the choice of parameters for predicting the specified malfunctions reflected technical considerations about the functioning of the claimed mechanical or electrical components.

On the other hand, the mathematical calculations in steps 3) and 4), when considered in isolation, were non-technical. These computations generated numerical data, i.e. the conditional probability of a future malfunction in an electrical or mechanical component and the question remained, whether these calculations contributed to the technical character of the invention. With reference to G 1/19 the board saw the conditional probability obtained by the method of claim 1 as an indirect

measurement of the physical state (i.e. a particular failure) of a specific physical entity (i.e. a specific mechanical or electrical component). The mathematical framework in the claim is rooted in stochastic modelling and simulation, specifically Markov chains, which are recognised for credibly capturing and predicting the transition dynamics of systems based on empirical data. The fact that the result is a probability does not detract from its ability to provide a technically meaningful estimate of the component's state. Making accurate predictions in the real world, given all its uncertainties, is rarely possible. The board also saw a credible causal link between the measured parameters and the predicted malfunctions. For instance, a bearing defect in a gas turbine is likely to generate more heat, degrade lubricant, and cause vibrations in the shaft and/or casing. Therefore, temperature, lubricant condition, and shaft or casing vibrations are suitable parameters for predicting a bearing defect. In summary, the board was satisfied that the calculated probability provided a credible estimate of the future physical state of a specific physical entity and, therefore, could be seen as an indirect measurement.

For these reasons, the board judged that the mathematical steps in claim 1 were part of a technical measurement method. The board remitted the case for further examination.

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## 2. Article 056 EPC | T 2086/21 | Board 3.3.02

### Article 056 EPC

<b>Case Number</b>	T 2086/21
<b>Board</b>	3.3.02
<b>Date of decision</b>	2024.05.14
<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) – unexpected balance of beneficial properties (yes) – arbitrary selection (no) – try and see situation (no) – mere bonus effect (no)
<b>Cited decisions</b>	T 0777/08, T 1317/13, T 0325/16, T 0041/17, T 1065/18
<b>Case Law Book</b>	<a href="#">I.D.9.9.5</a> , 10th edition

In [T 2086/21](#) the board found that, as stated by the respondents (patent proprietors), the effects of improved hygroscopicity, high thermodynamic stability and high polymorphic stability represented a beneficial combination of properties possessed by Form B of apalutamide compared to the physical forms disclosed in D1 and D2. The objective technical problem underlying claim 1 starting from either of D1 or D2 was therefore the provision of a form of apalutamide with a beneficial combination of these mentioned properties.

On obviousness, the appellants (opponents) submitted that in view of the fact that apalutamide was the subject of an Investigational New Drug (IND) filing before the filing date of the patent, the skilled person would have been motivated to perform routine polymorphic analyses or screening, especially given apalutamide's development stage. They cited various documents to support the argument that polymorphic screening and stability testing were part of common general knowledge and that following such routine guidance the skilled person would have arrived at the claimed Form B in an obvious manner.

The board disagreed, emphasising that the appellants' submissions failed to take into account the formulation of the objective technical problem in accordance with the problem-solution approach. Specifically, that Form B displayed a beneficial

combination of properties which could not have been expected by the mere provision of a crystalline form per se. The implication from the landmark decision T 777/08 was that when the advantages or effects of the claimed crystalline form were unexpected, i.e. they were not arbitrary and did not follow merely by virtue of being crystalline, then an inventive step was present. In the present case the board held there was no absence of unexpected properties, and that the selection of Form B was not arbitrary, since it possessed a beneficial combination of properties. Although the skilled person could have carried out a polymorphic screening, there was nothing in the prior art motivating the skilled person to have taken a particular path in the expectation of solving the aforementioned objective technical problem. The respondents further relied on T 325/16: "Only if the prior art either contains a clear pointer ...or at least creates a reasonable expectation that a suggested investigation would be successful, can an inventive step be denied", which supported the board's conclusion.

The board also addressed the appellants' argument that any unexpected effects associated with Form B, such as improved hygroscopicity, amounted to mere bonus effects. The board clarified that the objective technical problem solved by the claimed subject-matter was the provision of a beneficial combination of properties, not just a single property, and there was no reason for the skilled person to assume that the thermodynamically most stable form would at the same time be also polymorphically stable and in addition display improved hygroscopicity, and no such reason was provided by the appellants.

Distinguishing the case in hand from T 41/17, in which the solution was considered obvious because the skilled person would have performed a screening to identify the most thermodynamically stable form, the board highlighted that in the present case, in contrast, thermodynamic stability was only one property from a beneficial combination of properties displayed by the claimed Form B of apalutamide. Even if the effect of thermodynamic stability were to have been considered obvious, the same did not apply to the beneficial combination, since, for example, there was no teaching in the prior art that the effect of lower hygroscopicity could be obtained with the thermodynamically most stable form of apalutamide.

The board also disagreed that the skilled person starting from the amorphous apalutamide of D1 would have been in a "try and see" situation, which is predicated on the existence of a pointer to the solution, the existence of such the board had ruled out.

In view of the above the board concluded that the subject-matter of claim 1 of the main request (and by extension dependent claims 2-6) involved an inventive step starting from each of the cited documents (D1 and D2). It thus ruled that the appellants' appeals were to be dismissed.

110-10-24

### 3. Article 076(1) EPC | T 1054/22 | Board 3.3.09

#### Article 076(1) EPC

<b>Case Number</b>	T 1054/22
<b>Board</b>	3.3.09
<b>Date of decision</b>	2024.06.14
<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 076(1), 123(2) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	divisional application – amendments – added subject-matter (yes) – subject-matter extends beyond content of earlier application (yes) – ranges of parameters
<b>Cited decisions</b>	G 0003/89, G 0011/91, G 0001/93, G 0002/10, G 0001/16
<b>Case Law Book</b>	<a href="#">II.E.1.1</a> , <a href="#">II.E.1.3.1</a> , <a href="#">II.F.2.1.1</a> , 10th edition

In [T 1054/22](#) the examining division had concluded that claim 1 of the main request did not fulfil requirements of Art. 123(2) or 76(1) EPC, among other things, and it refused the patent application.

In its submissions on appeal, the applicant had argued that applying the criteria of G 1/93 (point 16 of the Reasons), the amendments did not result in an unwarranted advantage. Amended claim 1 of the main request was based on the earlier application as filed. This applied in particular to the amendments concerning the omega-6 to omega-3 ratio of 4:1 or greater and the concentration of omega-6 fatty acids (4-75% by weight of total lipids) and omega-3 fatty acids (0.1-30% by weight of total lipids).

The board dismissed the appeal. It explained that determining whether an amendment complied with the requirements of Art. 123(2) and 76(1) EPC was assessed using the "gold standard". This term was coined in G 2/10, in which the jurisprudence developed by the Enlarged Board in opinion G 3/89 and decision G 11/91 was confirmed.

The board explained that G 1/93 primarily concerned a case in which a granted claim could not be maintained unamended in opposition proceedings because the claim



was found to contravene Art. 123(2) EPC. The examining division had allowed an amendment that should not have been allowed. As explained in G 2/10 (point 4.3 of the Reasons, last paragraph), G 1/93 was not intended to modify the "gold standard".

According to G 1/93, the purpose of Art. 123(2) EPC (and Art. 76(1) EPC) was to prevent an applicant from gaining an unwarranted advantage by obtaining patent protection for something it had not properly disclosed on the date of filing of the application. An added feature limiting the scope of the claim may still contravene Art. 123(2) EPC. An example of this, explicitly mentioned in G 1/93, is a limiting feature that creates an inventive selection not disclosed in the application as filed or otherwise derivable therefrom.

In the case in hand, value ranges had been added to claim 1 of the main request, in features a), (i) and (ii). The question was whether the skilled person would have derived these amendments directly and unambiguously, using common general knowledge, from the entirety of the earlier application as filed. What had to be examined was not only whether there was a basis for each of the features added by the amendments but also whether the skilled person would have derived the combination of features a), (i) and (ii), and that combination of features alone, from the earlier application as filed.

The board concluded that no basis could be found in the earlier application as filed for the combination of the concentration of omega-6 fatty acids of 4-75% by weight of total lipids and omega-3 fatty acids of 0.1-30% by weight of total lipids (feature (i) of claim 1 of the main request). As to the ratio (feature a) of claim 1 of the main request), there was no basis in the earlier application as filed for an open-ended ratio of omega-6 to omega-3 fatty acids of 4:1 or greater. Thus, claim 1 of the main request contravened Art. 76(1) EPC.

111-10-24

## 4. Article 083 EPC | T 0553/23 | Board 3.5.01

### Article 083 EPC

<b>Case Number</b>	T 0553/23
<b>Board</b>	3.5.01
<b>Date of decision</b>	2024.07.19
<b>Language of the proceedings</b>	DE
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Articles 056, 083 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	sufficiency of disclosure – invention to be performed over whole range claimed – skilled person able to infer what will and what will not work – closest prior art
<b>Cited decisions</b>	T 1473/13, T 0383/14, T 1845/14, T 2773/18
<b>Case Law Book</b>	<a href="#">II.C.5.4</a> , <a href="#">II.C.6.1</a> , <a href="#">I.D.3.2</a> , 10th edition

Ex parte Fall [T 553/23](#) betraf die Lokalisierung von Objekten in einem Laderaum eines Transportfahrzeugs mittels einer optischen Positionserkennung. Die Anmeldung wurde von der Prüfungsabteilung im Wesentlichen zurückgewiesen, weil keiner der Anträge die Erfordernisse der Ausführbarkeit erfüllte.

Bezüglich der Prüfung des Hauptantrags (nicht gewährbar), erinnerte die Kammer zunächst daran, dass Art. 83 EPÜ nicht erfüllt sei, wenn eine im Anspruch ausgedrückte Wirkung nicht reproduziert werden könne. Die Prüfungsabteilung habe die Ausführbarkeit der beanspruchten Lehre auf Grund der Problematik eines verdeckten Sichtfelds für die optische Positionsbestimmung zurecht in Frage gestellt. Denn um ein stetes Nachverfolgen der Position eines Objekts im Laderaum zu gewährleisten, musste dieses jederzeit optisch erkennbar sein. Dies trifft vor allem dann bei einer mehrlagigen Beladung nicht zu. Die Beschwerdeführerin argumentierte, dass Anspruch 1 auch den speziellen Fall umfasse, dass genau ein Objekt transportiert wird. Dabei könne die Problematik eines verdeckten Sichtfelds gar nicht auftreten und damit sei die Lehre auf jeden Fall ausführbar. Die Kammer stimmte dem zwar zu, jedoch muss die beanspruchte Lehre in ihrer ganzen Breite ausführbar sein, also auch für den eigentlichen Anwendungsfall der Erfindung, bei dem eine Mehrzahl von Objekten nebeneinander und in mehreren Lagen transportiert werden.

Was den Fall einer mehrlagigen Anordnung von Objekten betrifft, stimmte die Kammer der angefochtenen Entscheidung zu, dass nicht alle Objekte sicher optisch lokalisiert werden können. Dies gilt unabhängig von der räumlichen Anordnung einer Kamera (oder eines Laserscanners) im Laderaum. Damit wird der angestrebte Zweck mit den beanspruchten Mitteln nicht sicher erreicht. Daran können auch Versuche des Fachmanns nichts ändern. Das Argument der angeblich üblichen Messunsicherheit wurde zurückgewiesen. Auch eine Zeugeneinvernahme des Erfinders könne daran nichts ändern, da diese die Offenbarung nicht ersetze.

Im Hilfsantrag (gewährbar) ging es um nebeneinander angeordnete Objekte, nicht mehr um nur ein transportiertes Objekt oder um den problematischen mehrlagigen Fall. Es wurde spezifiziert, dass die Positionsbestimmungsvorrichtung an der Decke des Laderaums angebracht war. Keine eindeutige Aussage konnte darüber getroffen werden, ob ein großes Objekt das Sichtfeld auf ein kleines Objekt verdeckt. In Anspruch 1 fehlten nähere Informationen zur räumlichen Anordnung der Kamera, die eine Ausführbarkeit der Erfindung für alle möglichen unterschiedliche Größen von Objekten gewährleistete. Es könne (anders als beim mehrlagigen Fall mit übereinandergestapelten Objekten) nicht pauschal angenommen werden, dass die beanspruchte Lehre nicht ausführbar sei. Jedoch muss der Fachmann zumindest Versuche durchführen, wozu ihm die Anmeldungsunterlagen abgesehen von dem Ausführungsbeispiel nach Figur 1 keine Hilfestellung boten.

Nach der Rechtsprechung der Beschwerdekammern ist nicht erforderlich, dass eine Reproduktion in jeder denkbaren theoretischen Konstellation gelingt. "In einem Anspruch wird allgemein versucht, eine Vorrichtung unter Idealbedingungen zu definieren. Kann sich der Fachmann unter Berücksichtigung der Offenbarung und des allgemeinen Fachwissens erschließen, was funktioniert und was nicht, ist eine beanspruchte Erfindung hinreichend offenbart, auch wenn eine breite Auslegung einen Gegenstand einschließen könnte, der nicht funktioniert. Im vorliegenden Fall ist der Fachmann in der Lage, Situationen direkt zu erkennen und auszuschließen, die offenkundig die angestrebte Wirkung nicht erzielen (etwa aufgrund einer verdeckten Sicht) und darauf durch eine angepasste Positionsbestimmungsvorrichtung zu reagieren. Die Kammer hat keine Zweifel daran, dass der Fachmann im Rahmen seines allgemeinen Fachwissens das funktionale Merkmal einer optischen Positionsbestimmungsvorrichtung den Größenverhältnissen der zu transportierenden Objekte anpassen würde", so die Kammer in ihrem Orientierungssatz (s. auch Punkt 3.5 der Gründe). Der zweite Absatz des Orientierungssatzes betrifft die Ermittlung des nächstliegenden Stands der Technik für die Bewertung der erfinderischen Tätigkeit.

112-10-24

## 5. Article 112a EPC | R 0005/23 | EBA

### Article 112a EPC

<b>Case Number</b>	R 0005/23
<b>Board</b>	EBA
<b>Date of decision</b>	2024.07.01
<b>Language of the proceedings</b>	DE
<b>Internal distribution code</b>	C
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 024(4), 112a, 113(1) EPC
<b>EPC Rules</b>	Rules 012b(4), 108(3) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	petition for review – clearly inadmissible
<b>Cited decisions</b>	R 0001/08, R 0019/12, R 0003/22, T 2078/17
<b>Case Law Book</b>	<a href="#">V.B.3</a> , 10th edition

Der Überprüfungsantrag in [R 5/23](#) war gegen die Zwischenentscheidung T 2078/17 vom 7. Februar 2023 gerichtet, mit der die Beschwerdekammer (in der Besetzung nach Art. 24 (4) EPÜ) einen gegen ihre drei Mitglieder gerichteten Ablehnungsantrag wegen Besorgnis der Befangenheit als unzulässig zurückgewiesen hatte.

Die Große Beschwerdekammer (GBK) befand, dass diese Entscheidung jedoch, auch wenn sie als schriftlich begründete Zwischenentscheidung in formeller Form ergangen war, nicht Gegenstand eines Überprüfungsverfahrens nach Art. 112a EPÜ sein könne.

Sie verwies unter anderem darauf, dass die Rechtsfolge eines erfolgreichen Antrags auf Überprüfung gemäß Art. 112a (5) EPÜ die Aufhebung der Entscheidung und die "Wiederaufnahme des Verfahrens vor den Beschwerdekammern" ist. Ferner präzisiere R. 108 (3) EPÜ weiter, dass im Falle eines begründeten Überprüfungsantrags die GBK die "Wiedereröffnung des Verfahrens vor der nach R. 12b (4) EPÜ zuständigen Beschwerdekammer" anordnet. Eine "Wiederaufnahme des Verfahrens" oder "Wiedereröffnung des Verfahrens" setze voraus, dass es sich bei der zu überprüfenden Entscheidung um eine Entscheidung handele, die ein Verfahren abgeschlossen hat. Die GBK kam folglich zu dem Schluss, dass das Überprüfungsverfahren nach Art. 112a EPÜ gemäß der Ausgestaltung der maßgeblichen Vorschriften jedenfalls keine Entscheidungen betreffe, mit denen ein Verfahren vor einer Beschwerdekammer dem Betroffenen gegenüber nicht abgeschlossen wird.

Ferner stellte die GBK fest, dass den *Travaux préparatoires* zur EPÜ-Revision 2000, deren Ziel es war diesen neuen Rechtsbehelf einzuführen, auch nur zu entnehmen sei, dass die Überprüfung von verfahrensabschließenden Entscheidungen beabsichtigt gewesen sei.

In Bezug auf den von der Antragstellerin geltend gemachten Verstoß gegen Art. 113 (1) EPÜ erinnerte die GBK daran, dass ein solcher Verstoß nach der ständigen Rechtsprechung nur dann als schwerwiegend i.S.v. Art. 112a (2) c) EPÜ anzusehen ist, wenn ein Kausalzusammenhang zwischen dem behaupteten Verstoß und der das Beschwerdeverfahren abschließenden Entscheidung besteht (s. z. B. R 1/08). In vorliegendem Fall, wo noch keine verfahrensabschließende Entscheidung getroffen sei, könne kein solcher, notwendiger Kausalzusammenhang bestehen.

Ferner äußerte sich die GBK zu ihrer im vorliegenden Fall vorgebrachten Schlussfolgerung, dass das Überprüfungsverfahren gemäß der Ausgestaltung der maßgeblichen Vorschriften jedenfalls keine Entscheidung betrifft, mit der ein Verfahren vor einer Beschwerdekammer dem Betroffenen gegenüber nicht abgeschlossen wird. Dieser Schlussfolgerung stünde nicht entgegen, dass in der Rechtsprechung die Möglichkeit eingeräumt wurde, einen Überprüfungsantrag auf einen selbständigen Teil der Entscheidung zu beschränken und eine zu überprüfende Entscheidung gegebenenfalls nur teilweise aufzuheben (s. z. B. R 19/12). Auch die Rechtsprechung, die Überprüfungsanträge gegen Entscheidungen zulässt, auch wenn sie nicht in formeller Form getroffen wurden, die aber über die Beendigung des Beschwerdeverfahrens befinden (R 3/22), stünde dieser Schlussfolgerung nicht entgegen.

Die GBK fasste zusammen, dass die Zwischenentscheidung vom 7. Februar 2023 weder das Verfahren abschließe, mit welchem die Ersatzkammer befasst ist, d.h. das Verfahren zur Entscheidung über den Ablehnungsantrag nach Art. 24 EPÜ, noch das Beschwerdeverfahren insgesamt oder gegenüber einem Beteiligten. Eine "Wiederaufnahme" bzw. "Wiedereröffnung des Verfahrens" i.S.v. Art. 112a (5) bzw. R. 108 (3) EPÜ sei daher nicht möglich. Es sei im vorliegenden Fall lediglich ein Einwand der Antragstellerin mittels einer Zwischenentscheidung in formeller Form ohne Auswirkung auf ihre Verfahrensbeteiligung im laufenden Verfahren vor der Beschwerdekammer zurückgewiesen worden. Die Zwischenentscheidung vom 7. Februar 2023 könne daher nicht Gegenstand eines Überprüfungsverfahrens gemäß Art. 112a (1) EPÜ sein. Der gegen sie gerichtete Überprüfungsantrag wurde folglich als offensichtlich unzulässig verworfen.

113-10-24

## 6. Article 117 EPC | T 2517/22 | Board 3.2.04

### Article 117 EPC

<b>Case Number</b>	T 2517/22
<b>Board</b>	3.2.04
<b>Date of decision</b>	2024.07.18
<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 113(1), 117(1) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	Article 11 RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	law of evidence – taking of evidence – right to be heard – improper reasons for rejection of evidence offered – relevance of the evidence to the outcome of the decision – failure to hear witness – recollection of various events 15 years later not to be denied beforehand without a hearing in person
<b>Cited decisions</b>	T 0906/98, T 0474/04, T 0314/18
<b>Case Law Book</b>	<a href="#">III.G.3.3.4</a> , <a href="#">III.G.4.1</a> , 10th edition

In [T 2517/22](#), in support of their argument of lack of inventive step, appellant 2 (opponent) had submitted documents D2 (operating manual) and D2a, which was the affidavit of an employee of appellant 2, Mr R.

Already in the notice of opposition and again in their reply, after the patentee had put into question the probative value of the affidavit D2a, appellant 2 had offered Mr R as a witness. In the annex to the first summons, the opposition division considered D2a to be sufficient evidence for public availability of D2 and did not summon Mr R as witness. In the annex to the second summons, discussion of novelty over D2 was envisaged for the oral proceedings. The opposition division changed its mind however and announced, after discussion of public availability of D2 during the second oral proceedings, that D2 was not part of the prior art albeit without taking into account the previous offer to hear a witness on the topic.

In the board's view, the statements in the affidavit D2a represented facts which were a priori of high relevance for the establishment of whether or not D2 was part of the prior art in the sense of Art. 54(2) EPC, and therefore of high relevance for the outcome of the opposition proceedings. An offer to hear the undersigned of the affidavit D2a as a witness represented a further relevant and appropriate offer of

evidence for the facts. The board stated it was a party's choice to present whatever means of evidence it considered to be suitable and it was an opposition division's duty to take its decision on the basis of all the relevant evidence actually available rather than to expect the presentation of more preferred pieces of documentary evidence, and to speculate on the reasons for and draw conclusions from their absence. The opposition division was of course free to evaluate any evidence provided by a party, but this freedom could not be used to disregard evidence that had been offered, and which might turn out to be decisive for a case, in particular not with the argument that some better evidence would have been expected.

Instead of accepting the evidence offered by appellant 2, the opposition division appeared to have based its decision on general assumptions made on the capability of persons to recollect events after a certain time period (15 years) and specific assumptions made on the witness's personal capability, knowledge and experience, thus implicitly on assumptions made on the veracity of his statements and on his credibility. By making these assumptions without hearing the offered witness person, the opposition division had in fact assessed evidence without examining it.

According to the respondent (patent proprietor), the offer of Mr R as a witness was not substantiated. For the board, affidavit D2a appeared to contain the factual information relevant for the outcome of the case. Before the oral proceedings, the opposition division had not shared the respondent's concerns about the veracity of D2a. The board stated that appellant 2 did not have to address these concerns and had no obligation to announce in their offer how exactly the witness would be able to corroborate his own statements, e.g. by answering in advance hypothetical questions that might possibly arise. Such questions would normally be asked during witness hearings in order to assess the credibility of the witness and the exactness of their memory, which is one of the main purposes of the hearing. A sufficiently exact recollection of various events 15 years later should not have been denied beforehand.

Appellant 2 requested that the decision be set aside due to a violation of their right to be heard and to remit the case. The board concluded that the failure to consider appellant's 2 offer to hear a witness on the public availability of D2 constituted a substantial procedural violation of the right to be heard. The decision of the opposition division to reject both oppositions was set aside in order to allow re-examination of the public availability of D2 taking into account all the evidence admissibly submitted by appellant 2.

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## 7. Article 123(2) EPC | T 1809/20 | Board 3.3.02

### Article 123(2) EPC

<b>Case Number</b>	T 1809/20
<b>Board</b>	3.3.02
<b>Date of decision</b>	2024.06.06
<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 123(2) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	amendments – added subject-matter (yes) – multiple selection at different levels of preference – no pointer
<b>Cited decisions</b>	T 1241/03, T 0181/08, T 1621/16
<b>Case Law Book</b>	<a href="#">II.E.1.6.1a</a> , 10th edition

In [T 1809/20](#) appellants 1 and 2 (opponents) objected that claim 1 of the main request contained subject-matter extending beyond the content of the application as filed.

Claim 1 of the main request related to a method for producing a certain purified protein. The board agreed that, as submitted by the appellants, claim 1 of the main request comprised multiple selections regarding the type protein to be purified (antibody, antibody fragment, or Fc fusion protein), the concentration of arginine or arginine derivative in the wash solution (in a range of 0.05-0.85 M), the concentration of the non-buffering salt in the wash solution (in a range of 0.1-2.0 M), and the pH of the wash solution (being greater than 8.0).

The board explained that it is established case law that the content of the application as filed must not be considered a reservoir from which features pertaining to separate embodiments are taken and combined to artificially create a particular embodiment without the presence of a pointer to combine the features of the separate embodiments.

In the case in hand, nothing in the application as filed pointed to the specific combination of selections made in claim 1 of the main request. Firstly, two selections were needed to arrive at the protein to be purified and nothing in the application as filed pointed to any preference for combining these selections. Secondly, the chosen



range of the concentration of arginine or arginine derivative in the wash solution was only at an intermediate level of preference in the application as filed, while the most preferred range was narrower. Thirdly, the selected range of the concentration of the non-buffering salt in the wash solution represented the selection of the broadest range out of the list of ranges in the application as filed. Finally, the chosen pH of the wash solution was the broadest range of the pH disclosed in a passage of the description and it did not constitute a preferred embodiment.

Regarding the examples, the board explained that each of the concentration values of arginine and arginine-HCl in the wash solution in the examples of the application as filed fell within the range selected in claim 1 of the main request. However, the board observed that each of these concentration values also fell within the most preferred range disclosed in the application as filed. Moreover, each of the concentration values of the non-buffering salt (sodium chloride) in the wash solution of the examples in the application as filed fell within the range selected in claim 1 of the main request. However, each of these concentration values also fell within one of the other two ranges disclosed in the description of the application as filed. Therefore, the examples in the application as filed did not point to the combination of features resulting from the selections of at least the concentration of arginine or arginine derivative and the concentration of the non-buffering salt in the wash solution.

In view of the above, the board concluded that the combination of the features relating to the specification of the protein to be purified, the concentration of arginine or arginine derivative in the wash solution, the concentration of the non-buffering salt in the wash solution and the pH of the wash solution was based on multiple selections at different levels of preference without any pointer being present in the application as filed for these selections. The skilled person reading the application as filed would thus find no guidance as to which of the preferred features they had to start with and which of the other features were then to be combined.

It followed that claim 1 of the main request did not meet the requirements of Art. 123(2) EPC.

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## 8. Article 125 EPC | J 0003/24 | Board 3.1.01

### Article 125 EPC

<b>Case Number</b>	J 0003/24
<b>Board</b>	3.1.01
<b>Date of decision</b>	2024.07.17
<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 121, 125 EPC
<b>EPC Rules</b>	Rule 103(1)(a) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	Articles 07(3), 07(4) RFees
<b>Keywords</b>	protection of legitimate expectations – expectation relied upon by the appellant not legitimate – reimbursement of appeal fee (no) – equitable by reason of a substantial procedural violation (no)
<b>Cited decisions</b>	G 0002/97, R 0004/09, J 0002/87, J 0003/87, J 0027/92, J 0004/23, T 2092/13
<b>Case Law Book</b>	<a href="#">III.A.3.1</a> , <a href="#">III.A.2.3</a> , <a href="#">V.A.11.7.2a</a> ), 10th edition

In [J 3/24](#) the examination and designation fees (due on Friday, 10 February 2023) had been paid too late (on Monday, 13 February 2023). By letter of 12 February 2023, the appellant's representative had requested that the payment be considered as made on time, as he had wrongly assumed that he had given an automatic debit order. On 21 February 2023, a notification of loss of rights had been sent undated, and had been sent again on 7 March 2023 (together, the "Notification") informing the appellant that the application had been deemed to be withdrawn due to the late payment. The Notification indicated as available means of redress a request for further processing under Art. 121 EPC and a request to consider the fee to have been paid on time under Art. 7(3), 7(4) RFees, each within a two-month time limit for filing. No valid request for further processing had been filed during that time.

The appellant argued that the fact that the Receiving Section had not replied to his letter of 12 February 2023 and had wrongly stated that a reply had been given with the Notification constituted a substantial procedural violation. He requested reimbursement of the appeal fee.

The Legal Board did not consider that the requirements in R. 103(1)(a) EPC were met in the present case. It recalled that according to the established case law of the

Boards of Appeal, the principle of the protection of legitimate expectations (also referred to as the principle of good faith) requires communications addressed to applicants to be clear and unambiguous, i.e. drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee. An applicant must not suffer a disadvantage as a result of having relied on a misleading communication (see G 2/97, J 2/87, J 3/87, J 4/23, T 2092/13). If a communication is not as clear and unambiguous as it should be and misleads a reasonable recipient, this may constitute a substantial procedural violation and entitle the appellant to reimbursement of the appeal fee (see J 3/87). On the other hand, both the EPO and users of the European patent system who are parties to proceedings before it are obliged to act in good faith. The principle of the protection of legitimate expectations does not give carte blanche to the person relying on it (J 4/23). It is the responsibility of users of the European patent system to take all necessary procedural actions to avoid a loss of rights (see G 2/97, R 4/09). It is also inherent in the principle of the protection of legitimate expectations that a person can only successfully invoke an expectation on which they could, on an objective basis, legitimately rely. The erroneous information from the EPO must objectively justify their conduct (see J 4/23; G 2/97). Thus it must be established that, on an objective basis and in the circumstances of the case, it was reasonable for the appellant to have been misled by the information on which they relied (see J 4/23, J 27/92, G 2/97).

The Legal Board acknowledged that the Notification made reference to the late payment but did not expressly address the request of 12 February 2023 for the late payment to be considered as having been made on time. It was therefore not clearly apparent whether the Receiving Section had taken this request into account in the Notification. However, it was not reasonable for the appellant to completely disregard the Notification. Even if the appellant's representative had considered the Notification as having been generated automatically without taking into account the request of 12 February 2023, it was expected that communications from the EPO would be observed. The Notification pointed out the legal remedies available to overcome the loss of rights caused by the late payment and indicated the time limit for filing a request for further processing. Such an official communication could not simply be ignored and set aside. Rather, it was the appellant's own responsibility to enquire about the situation regarding his request before expiry of the triggered time limits to ensure that he did not suffer any loss of rights. The fact that he only contacted the Receiving Section on 1 June 2023 had to be attributed solely to him. The Legal Board reiterated that it was the responsibility of users of the European patent system to take all necessary procedural actions to avoid a loss of rights. This applied all the more in the case at hand as the matter was initially set in motion by an error on the part of the appellant's representative. Moreover, even if a substantial procedural error were to be assumed – which could not be recognised here – reimbursement of the appeal fee would not be equitable within the meaning of R. 103(1)(a) EPC, since the behaviour of the appellant had contributed to the situation.

The request for reimbursement of the appeal fee was refused.

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## 9. Rule 036(1) EPC | J 0001/24 | Board 3.1.01

### Rule 036(1) EPC

<b>Case Number</b>	J 0001/24
<b>Board</b>	3.1.01
<b>Date of decision</b>	2024.04.16
<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 067, 076, 106(1), 107(1) EPC
<b>EPC Rules</b>	Rule 036(1) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	divisional application – application to be treated as divisional application (yes) – pending earlier European patent application (yes) – suspensive effect of an appeal
<b>Cited decisions</b>	G 0001/09, J 0028/03
<b>Case Law Book</b>	<a href="#">II.F.3.5.4</a> , 10th edition

In [J 1/24](#) the Legal Board examined an appeal against the decision of the Receiving Section dated 14 September 2023 that the appellant's European patent application, filed on 24 May 2021, would not be treated as a divisional application. A decision to grant had been issued for the earlier application (hereinafter parent application) on 18 February 2021, setting an original date of publication of the mention of grant as 17 March 2021. On 16 April 2021, the applicant had filed an appeal against this decision to grant. As a consequence, the date of publication of the mention of grant had been deleted. After filing its grounds of appeal, the appellant had withdrawn its appeal in April 2022.

The Legal Board observed that the question to be decided in the present case was whether the parent application was still pending according to R. 36 EPC when the divisional application was filed. It recalled that in G 1/09 (point 3.2.4 of the Reasons), the Enlarged Board had concluded that a "pending application" was a patent application in a status in which substantive rights deriving therefrom under the EPC were (still) in existence. Substantive rights, which included provisional protection under Art. 67 EPC, might continue to exist after the refusal of the application until the decision to refuse becomes final (G 1/09, point 4.2.1. of the Reasons). The retroactive effect of a final decision refusing the rights conferred did not influence the pending status of the application before such decision was final. The Legal Board also recalled that, according to an obiter dictum in G 1/09, in the case of grant the

pending status of a European patent application normally ceases on the day before the mention of its grant is published.

The Legal Board referred to J 28/03, which differentiated between the decision to refuse the parent application and the decision to grant the parent application, wherein an appeal against the decision to grant the patent as requested could not benefit from the suspensive effect of an appeal against the refusal of a patent application. It noted that in J 28/03, the date of publication of the mention of grant was not deleted, so that the grant of the patent became effective. The earlier application was therefore no longer "pending". On the contrary in the present case, the date of publication of the mention of the grant had been deleted as a result of the appeal filed and therefore the parent application was still pending.

The Legal Board was not convinced by the principle stated in J 28/03 that the answer to the question, whether the parent application was still "pending", depended on the outcome of the appeal against its grant. It referred to Art. 106(1), second sentence, EPC, according to which an appeal has suspensive effect, and observed that the provision did not distinguish between an appeal against the refusal or against the grant of a patent. The later decision G 1/09 stated that a patent application refused by the examining division was still pending within the meaning of R. 25 EPC 1973 until the expiry of the period for filing an appeal. The Legal Board found that the same conclusion had to apply to R. 36(1) EPC in its former and its current version. It further concluded that "pending grant proceedings" were not required, as pending proceedings could not be equated with a pending application (G 1/09). The issue was whether substantive rights still derived from the application. In the present case, the deletion of the date of the mention of grant prevented the grant of the patent becoming effective. Thus, substantive rights still derived from the application which was therefore still pending.

The Legal Board disagreed with the position in J 28/03 that "an appeal against a decision granting a patent and resulting in the publication of the grant of the patent would be expected to be inadmissible with respect to Art. 107(1) EPC and should therefore not benefit of the possibility to file a divisional application even during the appeal procedure". The current practice of the EPO treats appeals against the grant of a patent as appeals validly filed, with the consequence that the date of the mention of the grant is deleted in such a case. The board considered it inconsistent to view an appeal in two different ways: on the one hand, for the mention of the grant to be deleted, the appeal would only need to be admissible; on the other hand, the application of the suspensive effect would depend on the outcome of the appeal proceedings. There was no basis in Art. 106(1) EPC for this approach. In the established case law of the Boards of Appeal, an example of a clearly inadmissible appeal that should have no suspensive effect was an appeal without basis in the EPC, e.g. filed by a third party. The EPC however had no provision restricting appeals of the applicant against the grant of a patent. Such an appeal could not therefore be seen as clearly inadmissible. Thus, the parent patent application at hand was still pending when the divisional application was filed.

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## 10. Rule 126 EPC | T 1529/20 | Board 3.5.02

### Rule 126 EPC

<b>Case Number</b>	T 1529/20
<b>Board</b>	3.5.02
<b>Date of decision</b>	2024.02.19
<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 113 EPC
<b>EPC Rules</b>	Rules 079, 126 EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	notification – notification by postal services – no proof of receipt of communication under Rule 79(1) EPC – right to be heard – substantial procedural violation
<b>Cited decisions</b>	R 0015/11, R 0004/17, R 0006/19, J 0009/05, T 0247/98, T 1535/10, T 0966/17, T 2037/18, T 1219/19
<b>Case Law Book</b>	<a href="#">III.S.1.1</a> , <a href="#">III.S.4</a> , <a href="#">III.B.2.3</a> , <a href="#">IV.C.2.2.8f</a> , <a href="#">IV.C.6.4</a> , 10th edition

In [T 1529/20](#) the appellant (proprietor) submitted that they had never received the decision of the opposition division revoking their patent and that they had only become aware of it and, more generally, of the opposition proceedings, through an email from a formalities officer of the EPO.

The board explained that with the abolition of advices of delivery for notification of decisions by registered letter (see OJ 2019, A31), it was the practice of the EPO at the time to enclose an acknowledgement of receipt (Form 2936) with notifications by registered letter of decisions incurring a period for appeal and summonses. Addressees were requested to date and sign the form and return it immediately, as evidence of receipt (see OJ 2019, A57).

The board established that the present file did not contain a confirmation of receipt of the decision of the opposition division from the appellant. Since the EPO could not prove whether the registered letter had reached the appellant, as required by the provisions of R. 126(2) EPC in force at the relevant time, it had to be accepted that the legal fiction of deemed notification did not apply and the appellant became aware of the appealed decision for the first time with the email from the formalities officer.



This date was therefore the date of notification of the decision. Thus, the appeal was timely filed.

With regard to the right to be heard, the board held that, as argued by the appellant, the missing opportunity to present their arguments during the opposition proceedings amounted to a substantial procedural violation (Art. 113(1) EPC).

The board observed that, even in view of the notice of the EPO concerning implementation of amended R. 126(1) EPC (OJ 2019, A57) – which did not require to enclose an acknowledgement of receipt (Form 2936) with the communication of the notice of opposition – the requirements of Art. 113 EPC had to be complied with. Before a negative decision revoking a patent was issued, it had to be established that the patent proprietor had been duly informed about the initiation of opposition proceedings. The board explained that the notice of the EPO merely determined the format of notifications. However, the provisions of R. 126(2) EPC remained unaffected. R. 126(2) EPC defined a rebuttable fiction of notification, which, in case of dispute, had to be verified. The burden of proof lied with the EPO.

The board agreed with the appellant that a party submitting that something had not happened, i.e. that a communication had not been received, was in difficulties in trying to prove a negative (*negativa non sunt probanda*, see also T 2037/18, R 15/11, R 4/17). The filing of cogent evidence showing that a letter was not received was hardly ever possible (see also J 9/05). Therefore, the respondent's arguments that the appellant allegedly had the duty to register mail incoming at their premises but failed to provide an excerpt of such register was not pertinent, since there was no trace in the file that the EPO discharged its burden of proving delivery. Under such circumstances, the appellant did not have to bear the risks normally falling in their sphere of responsibility (T 1535/10), so that they have to be given the benefit of the doubt (J 9/05).

According to the board, in the present case legal certainty and the protection of the right to be heard would have required that the opposition division had established, by any available means, the fact and date of delivery of the communication of the notice of opposition.

The patent proprietor could decide not to react to the notice of opposition. Nevertheless, the communication under R. 79(1) EPC was not a mere formality. Rather, it had the function of allowing the patent proprietor to both contribute to the opposition division's appreciation of the facts and to defend their interests. Since the initial act of (non-)notification of the notice of opposition was flawed, the entire opposition proceedings including the decision of the opposition division was flawed.

Thus, the board set aside the appealed decision and remitted the case to the opposition division for further prosecution. The appeal fee was reimbursed.

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