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Abstracts of decisions

In this issue:

1.	Article 024 EPC T 1656/17 Board 3.X.XX	1
2.	Article 024 EPC T 1493/20 Board 3.2.04	3
3.	Article 053 EPC T 0318/21 Board 3.3.02	5
4.	Article 054 EPC T 0558/20 Board 3.3.10	7
5.	Article 069 EPC T 0450/20 Board 3.2.02	9
6.	Article 084 EPC T 1382/20 Board 3.2.03	11
7.	Article 084 EPC T 1426/21 Board 3.2.01	13
8.	Article 084 EPC T 0042/22 Board 3.3.04	15
9.	Article 084 EPC T 0111/22 Board 3.3.09	17
10.	Article 109 EPC T 2381/19 Board 3.4.03	19
11.	Article 113(1) EPC T 2054/19 Board 3.2.02	21
12.	Article 117 EPC T 1076/21 Board 3.3.05	23
13.	Article 12(4) RPBA 2020 T 0019/20 Board 3.3.03	25
14.	Article 13(2) RPBA 2020 T 0463/19 Board 3.4.02	27

1. Article 024 EPC | T 1656/17 | Board 3.X.XX

Article 024 EPC

Case Number	T 1656/17
Board	3.X.XX
Date of decision	2023.01.12
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 024 EPC
EPC Rules	Rule 106 EPC
RPBA	
Other legal provisions	
Keywords	suspected partiality – formation of the board in its alternate composition – notice of self-recusation – objection of suspected partiality of original board – admissibility (yes) – allowability (no)
Cited decisions	G 0001/05, J 0015/04
Case Law Book	III.J.2.3. , III.J.3.1. , III.J.3.2. , III.J.5.2. , 10th edition

In [T 1656/17](#) the appellant raised an objection of suspected partiality against all members of the board under Art. 24(3), first sentence, EPC. The objection was deemed admissible and an alternate board was formed. A technically qualified member of the alternate board then informed it in a notice of exclusion that they considered that they should not take part in the appeal proceedings as there existed a close family relationship between them and a person who had been involved in the first-instance proceedings. As per G 1/05, if a member of a board of appeal in a notice of withdrawal under Art. 24(2) EPC gives a ground which could by its nature constitute a possible ground for an objection of partiality, that ground should normally be respected. It can be expected that the member submitting the notice knows best whether a possible suspicion of partiality might arise (see J 15/04). The alternate board decided that in the case in hand the technically qualified member concerned should be replaced. It was at least arguable that a board member who had family ties to a person involved in the first-instance proceedings might have an interest in confirming the findings of those proceedings and could therefore appear to be biased. Following the replacement of said member, the alternate board in its final composition was competent to decide on the appellant's objection of suspected partiality.

In its main request, the appellant had raised an objection against all three members of the original board, and in its auxiliary request, against only the chair. A large part

of the appellant's allegations of suspected partiality concerned the behaviour and statements of the chair and not of the two other members of the original board. However, the board stated it was clear that a chair, when presiding over the oral proceedings, was normally acting after consultation with or with the tacit consent of the other board members. The appellant could therefore legitimately assume that the actions of the chair, in this case, were supported by the other two members.

An objection on the ground of suspected partiality is not admissible if, while being aware of a reason for objection, the party has taken a procedural step (Art. 24(3), second sentence, EPC). Although the appellant claimed that it had not taken any procedural steps while being aware of a reason for objection, it had filed an objection under R. 106 EPC at the end of the oral proceedings on 21 October 2022. In the board's view, such an objection was without doubt to be classed as a procedural step within the meaning of Art. 24(3), second sentence, EPC. The appellant's objection of suspected partiality was, however, not limited to facts occurring before the objection under R. 106 EPC was filed. It was based on a chain of events that also encompassed facts that occurred after this objection had been filed. Moreover, the board understood the appellant's submission to mean that it was not until all the events had occurred that it had become aware of the original board's biased attitude against it. Consequently, the board considered that the filing of the objection under R. 106 EPC did not render the subsequent objection of suspected partiality inadmissible.

In examining the appellant's request, the board observed that the appellant had not presented any proof of actual partiality of the three members of the original board. Rather, its case was based on circumstances which in its view gave rise to an objectively justified fear of partiality. This was to be examined in an objective test. The board was not convinced that the described chain of events as a whole could give rise to a suspicion of partiality. For this to be the case, a certain preconceived attitude would have to be at least partially discernible or inherent in each or some of the events. However, none of the single chain links referred to by the appellant contained elements which could suggest that the original board was influenced in its decision making by extraneous considerations or prejudices.

As a result, the appellant's suspicion of partiality was not objectively justified regarding either the chair or the other two members of the original board.

123-11-23

2. Article 024 EPC | T 1493/20 | Board 3.2.04

Article 024 EPC

Case Number	T 1493/20
Board	3.2.04
Date of decision	2023.06.02
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 024(1), 024(3), 117(1)(e) EPC
EPC Rules	Rule 121 EPC
RPBA	Article 1(2) RPBA 2020
Other legal provisions	
Keywords	suspected partiality – admitted (no) – objection not substantiated – lack of technical knowledge not a valid ground under Art. 24(3) EPC – business distribution scheme
Cited decisions	G 0001/05
Case Law Book	III.J.5.3.2 , 10th edition

In [T 1493/20](#) beantragte der Beschwerdeführer in der mündlichen Verhandlung die Ablehnung der Kammer wegen Befangenheit gestützt auf angebliche mangelnde technische Kenntnisse auf dem Gebiet von Windenergieanlagen. Die Kammer entschied in ihrer ursprünglichen Besetzung über die Zulässigkeit des Antrages.

Die Kammer ging davon aus, dass der Antrag auf eine Ablehnung nach Art. 24 (3) EPÜ gerichtet war. Andere Möglichkeiten der Ablehnung von Kammermitgliedern seien weder im EPÜ noch in der VOBK normiert. Die Kammer erläuterte, dass Art. 24 (3) EPÜ eine Ablehnung aus einem der in Art. 24 (1) EPÜ genannten Gründe oder wegen Besorgnis der Befangenheit vorsieht. Im vorliegenden Fall hatte sich der Beschwerdeführer auf Letzteres berufen ohne allerdings weiter zu erklären, inwiefern sich eine Befangenheit der Kammermitglieder aus deren angeblich mangelnden technischen Kenntnissen ergeben sollte. Ein solcher Kausalzusammenhang war auch für die Kammer nicht ersichtlich.

Aus der abschließenden Aufzählung der Ablehnungsgründe in Art. 24 (3) EPÜ ergebe sich jedoch, dass ein Ablehnungsantrag nicht auf jeden beliebigen Grund gestützt werden könne, selbst wenn die vorgebrachten Tatsachen, die die Kammermitglieder betreffen, zumindest subjektiv als nachteilig für die Sache eines Beteiligten angesehen werden könnten. Eine Ablehnung wegen mangelnder technischer Kenntnisse sei daher kein zulässiger Ablehnungsgrund nach Art. 24 (3)

EPÜ. Es bleibe dabei, dass weder im EPÜ noch in der VOBK die technische Inkompetenz einer Kammer auf einem ihr gemäß Geschäftsverteilungsplan zugeordneten technischen Gebiet als ein Grund für deren Ablehnung vorgesehen sei. Den Versuch, dies dennoch durch die Hintertür einer dadurch angeblich begründeten Besorgnis der Befangenheit zu erreichen, hielt die Kammer für nicht statthaft, und den darauf gerichteten Antrag für unzulässig.

Lediglich ergänzend wies die Kammer darauf hin, dass eine technische Beschwerdekammer grundsätzlich dazu verpflichtet sei, die ihr gemäß ihrer sachlichen Zuständigkeit vom Präsidium über den Geschäftsverteilungsplan gemäß Art. 1 (2) VOBK 2020 zugewiesenen Fälle zu verhandeln (G 1/05). Die Zuordnung einer sachlichen Zuständigkeit für ein technisches Gebiet beruhe auf der Annahme der technischen Kompetenz einer Kammer auf diesem Gebiet. Schließlich habe eine Kammer auch die Möglichkeit, ggf. eine Begutachtung durch Sachverständige (Art. 117 (1) e) und R. 121 EPÜ) von Amts wegen einzuholen, wenn sie der Ansicht ist, dass ihre eigenen Fachkenntnisse für die Beurteilung des Falls nicht ausreichen.

Daher verwarf die Kammer den Antrag des Beschwerdeführers auf ihre Ablehnung wegen mangelnder technischer Kenntnisse auf dem Gebiet der Windkraftanlagen und der damit begründeten Besorgnis der Befangenheit als unzulässig.

124-11-23

3. Article 053 EPC | T 0318/21 | Board 3.3.02

Article 053 EPC

Case Number	T 0318/21
Board	3.3.02
Date of decision	2023.05.25
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 053(c) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	exceptions to patentability (yes) – method for treatment by surgery
Cited decisions	G 0001/07, T 0992/03, T 0836/08
Case Law Book	I.B.4.4.5c , 10th edition

In [T 318/21](#) beantragte der Beschwerdeführer der Großen Beschwerdekammer folgenden Fragen vorzulegen:

„Ist ein beanspruchtes Verfahren, das auf die Ermittlung einer Position und einer Orientierung eines Endoskops in einem Hohlraum gerichtet ist, schon deshalb als "Verfahren zur chirurgischen oder therapeutischen Behandlung des menschlichen oder tierischen Körpers" nach Art. 53 c) EPÜ vom Patentschutz auszuschließen, wenn der Hohlraum ein körperinnerer Hohlraum eines menschlichen oder tierischen Körpers sein kann und es für die Bestimmung der Position und Orientierung unerlässlich ist, dass eine Datenerfassung an mehreren Zeitpunkten und an mehreren Positionen und/oder Orientierungen des Endoskops erfolgt, auch wenn kein Verfahrensschritt der Bewegung des Endoskops in dem Hohlraum beansprucht wird und das Verfahren keinen funktionellen Zusammenhang mit den Wirkungen des Endoskops auf den Körper vorsieht (s. G 1/07)?“

Falls die Frage mit 'ja' beantwortet wird, worin ist ein Unterschied zu dem Sachverhalt zu sehen, der der Entscheidung T 836/08 zugrunde lag?“

Die Kammer stellte fest, dass die Bewegung eines Endoskops in einem Hohlraum eines menschlichen oder tierischen Körpers eine chirurgische Behandlung im Sinne des Art. 53 c) EPÜ darstelle. Der Beschwerdegegner machte allerdings geltend, dass die Bewegung des Endoskops nicht beansprucht sei. Er machte geltend, das Verfahren bestimme lediglich eine Betriebseigenschaft des Endoskops und

entspreche einem "Verfahren zum Betreiben eines Geräts" im Sinne von G 1/07. Außerdem bestehe kein funktioneller Zusammenhang zwischen dem beanspruchten Verfahren und den Wirkungen des Endoskops auf den Körper, so dass das Verfahren nicht als Behandlungsverfahren im Sinne von Art. 53 c) EPÜ anzusehen sei. Die Kammer stellte diesbezüglich fest, dass weder die Entscheidung G 1/07 noch die darin unter Punkt 4.3.2 der Gründe zitierten Entscheidungen definieren, was unter funktionellem Zusammenhang ("functional link") im Falle eines chirurgischen Eingriffs zu verstehen ist. Darüber hinaus ist das Fehlen oder Vorhandensein eines funktionellen Zusammenhangs nur insoweit relevant, als das beanspruchte Verfahren nur den Betrieb einer Vorrichtung betrifft (G 1/07). Die Entscheidung G 1/07 stellt nämlich fest, dass ein Verfahren - auch wenn das Verfahren als Verfahren zum Betreiben eines Geräts angesehen werden sollte - als ein Verfahren zur chirurgischen Behandlung vom Patentschutz auszuschließen ist, wenn es einen chirurgischen Schritt aufweist oder umfasst (G 1/07). Im vorliegenden Fall war der chirurgische Schritt - die Bewegung des Endoskops im Körperinneren - nicht lediglich ein vorbereitender Schritt, der vorgelagert und nicht Bestandteil des Verfahrens war. Vielmehr war die Bewegung des Endoskops Teil der beanspruchten Datenerfassung.

Anders als in T 992/03, in der die zuständige Kammer feststellte, dass die Verabreichung von polarisiertem ¹²⁹Xe-Gas ein vorbereitender Schritt sei, der nicht Teil des beanspruchten Verfahrens war, war im vorliegenden Fall der strittige Schritt der Endoskopbewegung kein vorbereitender Schritt, der vorgelagert war, sondern Teil des beanspruchten Verfahrens.

Der Beschwerdeführer zitierte auch T 836/08, in der die zuständige Kammer befand, dass ein Verfahren zum Ermitteln der Position des distalen Endes eines Knochenführungsdrahts mit einem optischen Tracking- und Navigationssystem nicht invasiv sondern ein passives Mess- und Auswerteverfahren war, das nicht unter die Ausschlussbestimmung von Art. 53 c) EPÜ fiel. Nach Ansicht der Kammer scheint die T 836/08 keine allgemein etablierte Rechtsprechung darzustellen (siehe Rechtsprechung der Beschwerdekammern, 10. Auflage, Juli 2022, I.B.4.4.4d), erster und zweiter Absatz). Auf jeden Fall umfasste - nach der Ansicht der zuständigen Kammer - das Verfahren zum Ermitteln der Position keine Bewegung des Knochenführungsdrahts. Folglich war der Vergleich mit der Bewegung des Endoskops im vorliegenden Fall nicht überzeugend und eine Vorlage an die Große Beschwerdekammer nicht angebracht. Da in einer Ausführungsform die Bewegung des Endoskops in einem Hohlraum eines menschlichen oder tierischen Körpers stattfand, umfasste das vorliegende Verfahren eine derartige Bewegung.

Somit stellte das beanspruchte Verfahren ein Verfahren zur chirurgischen Behandlung des menschlichen oder tierischen Körpers im Sinne des Art. 53 c) EPÜ dar.

125-11-23

4. Article 054 EPC | T 0558/20 | Board 3.3.10

Article 054 EPC

Case Number	T 0558/20
Board	3.3.10
Date of decision	2023.04.20
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 053(c), 054(5) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	novelty – novelty of use – second (or further) medical use
Cited decisions	G 0002/08
Case Law Book	I.C.7.2.4c , 10th edition

In [T 558/20](#) the board had to decide on the proper assessment of novelty under Art. 54(5) EPC, in particular when a claim defines a combined surgical and therapeutic method. The invention concerned a bone regenerative material for use in a method of treating a patient suffering from a degenerative bone condition that can be characterized by a loss of bone mineral density. The method comprised surgical steps of forming a void in a localized area of intact bone and filling it with the bone regenerative material.

In its decision, the opposition division came to the conclusion that claim 1 of the granted patent could not benefit from the novelty exception in Art. 54(5) EPC; the claim had to be interpreted as being directed to a material suitable to be used in the method defined in the claim. The claim thus lacked novelty over the prior art.

The board stated that Art. 54(5) EPC did not, as such, define any criteria to be applied for assessing whether a claim drafted according to the wording of the article was novel or not. It held that novelty of the claim over the prior art must be assessed in the usual way, i. e. by comparing the features of the claim, the nature of the substance or composition as well as the use and method steps, with the disclosure of the prior art. In the present case, the opposition division had first examined whether the specific use of the substance or composition defined in the claim was already known or not. If the use was already known, the claim could not benefit from the novelty exception.

The board's approach by contrast meant reading the claim as it was drafted, assuring that the method fell under Art. 53(c) EPC, then considering the use and method features as limiting and assessing whether the specific use defined by them was already known from the prior art. This, in the board's view is aligned with Art. 54(5) EPC and follows its logic.

The respondent argued that the therapeutic use defined in the claim, i. e. the use of the bone grafting materials defined therein for the treatment of degenerative bone conditions, was already known as such. The board however held that the claim defined a method for treating a patient suffering from a degenerative bone disease comprising two steps, firstly creating a void in an intact bone, and secondly filling the void with bone regenerative material. This was the "specific use in a method" referred to in Art. 54(5) EPC, and this use needed to be compared with the prior art. The surgical step was clearly a part of the therapeutic method. Without it, the bone grafting material could not deploy its therapeutic activity. The method defined in the present claim had to be assessed as a whole. The respondent's approach to mentally split the method into different parts, associate to some of them an effect of the substance or composition defined in the claim as opposed to others, and ignore the ones, which were not considered associated in this way was not valid in the present case because the surgical step was an integral part of the therapeutic method in which the substance was used. In view of Art. 53(c) EPC, referring to both therapeutic and surgical methods individually the board had some doubts whether, in general, such an approach was at all justified, but this was not decisive here. Thus, the surgical method steps could not be ignored when assessing novelty of the claim.

The opposition division had also held auxiliary request 2 to lack novelty, since the method steps therein did not provide a "new technical teaching", a terminology taken from the Enlarged Board's decision G 2/08, which implied that for establishing novelty a new technical teaching was required.

The board held that, as set out above, in a claim drafted according to Art. 54(5) EPC the method steps had to be taken into account when deciding on novelty. In the present case, requiring additional surgical steps clearly provided a new technical teaching compared to the prior art, because additional physical actions had to be undertaken. It disclosed forming a channel and using this channel as an access to form a void greater than the channel in the bone, whereas in the prior art, a hole was drilled, but nothing more. The method defined in the claim was thus not just verbally different from the prior art, but differed in tangible, physical method steps and thus novel.

126-11-23

5. Article 069 EPC | T 0450/20 | Board 3.2.02

Article 069 EPC

Case Number	T 0450/20
Board	3.2.02
Date of decision	2023.03.09
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 069, 054 EPC
EPC Rules	
RPBA	
Other legal provisions	Protocol on the Interpretation of Article 69 EPC
Keywords	claim interpretation – claim interpretation in the light of the description (yes) – limitations – novelty
Cited decisions	R 0019/11, T 1646/12, T 1354/18, T 1473/19
Case Law Book	II.A.6.3.4 , II.A.6.3.2 , II.A.6.1. , 10th edition

In [T 450/20](#) the board followed the approach taken in T 1473/19, according to which the principles of claim interpretation as set out in Art. 69 EPC and Art. 1 of the Protocol on the Interpretation of this provision are to be applied in proceedings before the EPO. In the present case the understanding of the term "permanently attached" in claim 1 was relevant for assessing novelty in opposition appeal proceedings.

The board stated that according to Art. 69(1), first sentence, EPC, only the claims determined the extent of protection. The description and the drawings had no such function, and must only be used to interpret the claims. This meant that the description and the drawings could only be used for interpreting features which were already present in the claims, but not for adding further - positive or negative - claim features or for replacing existing claim features by others.

Claim 1 itself neither defined nor specified the term "permanently attached" further. The description of the patent did not provide a definition of this term either. The board confirmed that patent claims must be interpreted through the eyes of the person skilled in the art and this included taking account of the skilled person's common general knowledge. The prior-art documents invoked by the respondent (patent proprietor) were, however, not suitable evidence for proving the skilled person's understanding of the term "permanently attached" according to common general knowledge.

In the board's opinion, the intended use of the claimed apparatus according to the patent was the appropriate criterion for determining the required duration or durability of the attachment. Hence, it understood that a "permanently attached" tapering portion did not exclude that the same tapering portion could be released from the push or guide wire. The respondent disagreed with this understanding, arguing that the description defined "permanent" as the opposite of "releasable". The respondent referred, among other things, to a passage of the description stating that figures 19a and 19b - which depicted a releasable device - showed "two variations of a separating arrangement by which the distal segment 1 according to an example not in accordance with the invention is detachably connected to a guide wire". The board pointed out that the exclusion of the releasable device depicted in those figures was only present in the description, but not in the claims. Assigning to the term "permanently attached" in claim 1 the meaning - on account of the description - that it excluded any releasable device as depicted in such figures would go beyond the mere interpretation of this claim feature in light of the description. It would amount to adding a further limitation to the claim which was only present in the description - and this would not be in line with the principle of primacy of the claims (see T 1473/19).

The board further pointed out that, unlike the description of the patent, the application as filed was not referred to in Art. 69(1), second sentence, EPC as part of what must be taken into account when interpreting a patent (T 1473/19). The application as filed often differed from the patent as granted, both regarding the claimed invention and the contents of the description, and it usually could not, for this reason alone, provide guidance for interpreting the claims of the patent as granted. In view of this, the board did not consider the incidental statement in the application as filed, according to which the attachment "may be permanent or a releasable mechanism", to be a sufficient reason to interpret claim 1 as granted such that it excluded an attachment involving a releasable mechanism.

The board concurred with the statement in T 1473/19 that claim interpretation was, overall, a question of law which must, as such, ultimately be answered by the deciding body, and not by linguistic or technical experts. This being so, a board of appeal was not limited to the claim interpretations advanced by the parties but may also adopt a claim interpretation of its own. Relying on documentary evidence was not a precondition for the adoption of a certain claim interpretation by a board of appeal. In this context evidence could only be relied upon to prove facts, such as how the person skilled in the art understood a certain technical term in a certain prior-art document at a certain point in time, but not to ultimately ascertain whether a certain claim interpretation was correct or not.

See also [T 1494/21](#) issued by the same board on the same date as [T 450/20](#) (joint hearing).

127-11-23

6. Article 084 EPC | T 1382/20 | Board 3.2.03

Article 084 EPC

Case Number	T 1382/20
Board	3.2.03
Date of decision	2023.07.11
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054, 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – claim interpretation for assessing novelty
Cited decisions	T 1354/18, T 1473/19
Case Law Book	II.A.6.1. , II.A.6.3.1. , 10th edition

In [T 1382/20](#) befasste sich die Kammer mit der Auslegung des Anspruchs 1 des Hauptantrags im Rahmen der Neuheitsprüfung. Dieser Anspruch spezifizierte unter anderem, dass die Fixiereinrichtung die Lagesicherung der Stützprofile "dergestalt frei [gibt], dass die beiden Stützprofile, unter Verdrängung des Füllprofils nach oben aus dem Spalt heraus, aufeinander zu bewegbar sind".

Die Kammer befand, dass der Ausdruck "unter Verdrängung" eine Gleichzeitigkeit zwischen der Bewegbarkeit der Stützprofile und der Verdrängung des Füllprofils zum Ausdruck bringe. Zum Beleg dieses Verständnisses hatte der Beschwerdegegner (Patentinhaber) einen Auszug aus Duden, "Das große Wörterbuch der deutschen Sprache", Band 6, 1981, Seite 2703, zur Präposition "unter" (Eintrag I.4.) vorgelegt. Der Kammer zufolge bestätigte der vorgelegte Auszug aus Duden das Verständnis der Kammer, wonach die beanspruchte Vorrichtung so ausgestaltet sein müsse, dass die Freigabe der Lagesicherung eine Bewegbarkeit bedinge, bei der gleichzeitig das Füllprofil nach oben aus dem Spalt verdrängt werde.

Der Beschwerdeführer (Einsprechende) hatte eingewandt, dass sich der Anspruch an einen technischen Fachmann, nicht an einen Linguisten richte, und nach dem Verständnis des Fachmanns zu beurteilen sei. Darüber hinaus hatte der Beschwerdeführer argumentiert, dass die in Figur 2 des Streitpatents aufeinander aufliegenden Gleitflächen 36 und 37 zwischen den Stützprofilen und dem Füllprofil nur eine optionale Ausgestaltung seien, welche erst im abhängigen Anspruch 7 spezifiziert sei. Zudem offenbare Absatz [0012] im Sinne einer "Öffnungsklausel", dass sich das Heraustreten des Füllprofils konstruktiv in verschiedener Weise

vollziehen lasse, z.B. auch durch eine Änderung der Geometrie des Füllprofils. Die Verdrängungsbewegung des Füllprofils müsse daher nicht sofort und insbesondere nicht gleichzeitig mit der Bewegung der Stützprofile stattfinden. Die Kammer sah in den vom Beschwerdeführer zitierten Passagen jedoch weder einen Widerspruch noch eine "Öffnungsklausel" zu dem klar formulierten Anspruchsmerkmal.

Die Kammer stimmte dem Beschwerdeführer zu, dass sich ein Patentanspruch nicht an einen Linguisten, sondern an die Fachperson richte. Demnach sei ein Patentanspruch nicht aus Sicht eines Linguisten und auf Grundlage einer rein linguistischen Analyse, sondern vielmehr aus Sicht der Fachperson auszulegen (vgl. T 1354/18). Der Kammer zufolge müssen allerdings bei der Bestimmung des – stets sprachlich angegebenen – technischen Anspruchsgegenstands aus fachmännischer Perspektive die geltenden Regeln der Sprachlehre ebenfalls berücksichtigt werden (vgl. T 1473/19). Der vom Beschwerdegegner herangezogene Duden belege im vorliegenden Fall auch keine nur Linguisten geläufige Sonderbedeutung des mit der Präposition "unter" eingeleiteten Ausdrucks. Vielmehr entspreche das im Duden wiedergegebene Verständnis dieses Ausdrucks im Zusammenhang mit Anspruch 1 dem geltenden allgemeinen Sprachgebrauch, an dem sich auch der fachkundige Leser eines in deutscher Sprache formulierten Anspruchs bei der Bestimmung des davon umfassten technischen Gegenstands orientiere.

128-11-23

7. Article 084 EPC | T 1426/21 | Board 3.2.01

Article 084 EPC

Case Number	T 1426/21
Board	3.2.01
Date of decision	2023.03.27
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 084 EPC
EPC Rules	Rule 042 EPC
RPBA	
Other legal provisions	Guidelines F-IV, 4.4 – March 2023 version
Keywords	claims – clarity (yes) – support in the description (yes) – claim-like clauses – adaptation of the description
Cited decisions	T 1444/20
Case Law Book	II.A.5.3. , 10th edition

In [T 1426/21](#) the board followed decision T 1444/20 finding that the "specific embodiments of the invention" drafted as claim-like clauses in the description (of the new main request), which were consistent with the claims did not render the claims unclear pursuant to Art. 84 EPC and met the requirements of R. 42 EPC.

The board noted that the Guidelines 2023, Part F, Chapter IV, 4.4 indicate that "claim-like clauses must also be deleted or amended to avoid claim-like language prior to grant since they otherwise may lead to unclarity on the subject-matter for which protection is sought". The board held that in the present case the "claim-like clauses" did not render the subject-matter for which protection was sought unclear, because the text in the description was consistent, and not in contradiction, with the set of claims. Moreover, the claim-like clauses disclosed as "aspects" on pages 11 and 12 could not be mistaken for claims. It was obvious that they were part of the description and were not part of the claims defining the protection to be sought.

According to the board, R. 42 EPC did not rule out claim-like clauses in the description. In the present case, the claim-like clauses could be considered as embodiments of the invention defined in terms of technical features. These claim-like clauses did not change or impair the understanding of the technical problem and the solution defined in the description. Therefore, there was no reason to require their deletion.

The board concluded that the amendments to the description according to the (new) main request had removed the previous inconsistencies between the claim-like clause embodiments and the claims. The claims were thereby supported by the description pursuant to Art. 84 EPC.

129-11-23

8. Article 084 EPC | T 0042/22 | Board 3.3.04

Article 084 EPC

Case Number	T 0042/22
Board	3.3.04
Date of decision	2023.03.17
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 069, 076(1), 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – claim interpretation – interpretation in the light of the description and the claims as a whole – subject-matter of divisional application extends beyond content of earlier application (yes)
Cited decisions	T 0454/89, T 1018/02, T 1023/02, T 0056/04, T 1404/05, T 1172/08, T 0197/10, T 2221/10, T 1896/11, T 1646/12, T 1603/13, T 0935/14, T 1817/14, T 1127/16
Case Law Book	II.A.6.1. , II.A.6.3.1. , II.A.6.3.4. , 10th edition

In [T 42/22](#) claim 1 of the main request was a product claim directed to a modified nucleotide, i.e. to a chemical compound as such, which comprised the following components: (i) a purine or pyrimidine base, (ii) a deoxyribose sugar moiety having a 3'-azidomethyl group and (iii) triphosphate.

The appeal turned on the interpretation of the term "3'-azidomethyl" in claim 1. In particular, the question was whether claim 1 was directed to nucleotides having an azidomethyl group directly bound to the 3' carbon of the deoxyribose (interpretation 1) or whether it was directed to nucleotides having an azidomethyl group bound via an oxygen to the 3' carbon of the deoxyribose (interpretation 2).

After examining what the skilled person understood by the term "3'-azidomethyl" in claim 1, the board concluded that the symbol "3' " without any letter following the number denoted for the skilled person "3'-C", i.e. being directly bound to the carbon atom at position 3' (interpretation 1).

A second point addressed in this decision was whether the term "3'-azidomethyl" in claim 1 was to be interpreted in light of the description. In the case at hand, the board

held that claim 1 was clear and no technical inconsistencies between the terms in the claim had been identified. Moreover, it considered that interpretation 1 was technically sensible. In the board's judgement, the meaning of a term in a claim which was clear could not vary depending on how well the claim was aligned with the description. Also, in decisions T 1127/16 and T 1896/11, the competent board in each case had considered claim wording which imparted a clear and credible technical teaching when interpreted on its own, although this teaching did not correspond to the invention in the description. The board in each of those cases had held that the description could not be used to give a different meaning to the claim.

The board in the current case disagreed with T 1023/02, which had held that a given term in the claim should be interpreted according to the teaching in the description. It followed instead the line of decisions establishing that there was no need to use the description to interpret a claim which was clear and allowed a technically sensible interpretation (see e.g. T 1018/02, T 1172/08, T 197/10, T 1896/11, T 1127/16).

Hence, the board concluded that there was no reason to use the description to interpret claim 1. In a case such as this one, where the claim and the description related to different compounds, a technically reasonable interpretation based on the literal wording of the claim should not be discarded and replaced by a different interpretation finding a basis solely in the description.

An additional point addressed by the board was whether independent claim 1 was to be interpreted in the context of claim 6 and whether doing so would change the claim interpretation. In the board's view, the interpretation of product claim 1 could not be dependent on whether or not method claim 6 was present in the claim set. Instead, each claim should be interpreted independently. Contrary to the view of the respondent (patent proprietor), the board did not find in Art. 84 EPC support for the contention that all claims needed to be interpreted together. In addition, the board noted that the appellants (opponents) had provided a technically sensible interpretation of claim 6 which was also compatible with interpretation 1 of claim 1. The board pointed out that in line with the case law, a technically sensible interpretation could not be disregarded even if additional interpretations were possible. As such, it was not relevant for the current case which additional interpretations could follow from interpreting claim 6.

Hence, the board came to the conclusion that claim 1 should be given interpretation 1. Regarding the basis for the claimed subject-matter in the grandparent and parent applications as filed, the board decided that the claim related to subject-matter extending beyond the content of the earlier applications as filed (Art. 76(1) EPC).

130-11-23

9. Article 084 EPC | T 0111/22 | Board 3.3.09

Article 084 EPC

Case Number	T 0111/22
Board	3.3.09
Date of decision	2023.06.28
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 069, 084, 100(c), 123(2), 123(3) EPC
EPC Rules	
RPBA	
Other legal provisions	Protocol on the Interpretation of Article 69 EPC
Keywords	claims – claim interpretation – interpretation in the light of the description – added subject-matter (yes) – extension of the scope of protection (yes)
Cited decisions	T 1172/08, T 1646/12, T 0073/19, T 1473/19, T 0169/20, T 0450/20
Case Law Book	II.A.6.3.4 , II.A.6.1. , II.E.1.3.9d), II.E.2.3.1c), II.E.2.3.3 , 10th edition

In [T 111/22](#) the board interpreted the feature "wherein component (ii) comprises 10-45 wt.% of palatinose" in claim 1 of the patent as granted (main request) in order to compare the claimed subject-matter with the original disclosure.

The appellant (patent proprietor) had argued that claim 1 was unclear on how to calculate the range 10-45 wt.% of palatinose and thus the description had to be used for interpretation. In the description, this amount was calculated referring to the total amount of available carbohydrates. This was evident from page 5, lines 15 to 20 of the description as filed. Therefore, according to the appellant, the skilled person would have interpreted claim 1 as granted calculating the 10-45 wt.% of palatinose on the basis of the "available carbohydrates composition" and not on the basis of the amount of component (ii).

The board recalled that patent claims must be interpreted through the eyes of the person skilled in the art, who should try with synthetic propensity to arrive at an interpretation which is technically sensible and takes into account the whole disclosure of the patent. However, the extent to which the meaning of a claimed feature may be affected by the description and/or the drawings was limited. There was a consensus within the boards about the primacy of the claims in claim interpretation (see T 1473/19, T 73/19 and T 169/20). This meant that in case of a

clear conflict between the claims and the description, the claims took precedence. In other words, if a person skilled in the art understood a claim in a certain manner without doubt, taking into account the rules of grammar, the ordinary meaning of the terms used and common general knowledge, this understanding usually took precedence over an incidental and conflicting statement in the description, in particular if that statement was only made in the context of an alleged embodiment.

Thus, the board concluded that the requirement in claim 1 that the composition contain a component (ii) "wherein component (ii) comprises 10-45 wt.% of palatinose" could only be understood so that it was component (ii) - and not the entire amount of carbohydrate in the composition - which comprised 10-45 wt.% of palatinose. This interpretation corresponded to the unambiguous wording of claim 1 and was "technically sensible". The board noted that there were no reasons to adopt a different claim interpretation based on the preferred embodiment described in paragraph [0021] of the description.

Since no basis for the feature "wherein component (ii) comprises 10-45 wt.% of palatinose" could be found in the application as originally filed, claim 1 of the main request contained added subject-matter, contrary to the requirements of Art. 123(2) EPC. The same conclusion applied mutatis mutandis to auxiliary requests 1 to 7.

Claim 1 of auxiliary requests 8 to 11 required that "15-45 wt.% of component (ii), based on the available carbohydrate composition, consists of palatinose". The appellant had argued that by virtue of Art. 69 EPC, paragraph [0021] of the granted patent, which defined the amount of palatinose on the basis of the available carbohydrate composition, had to be taken into account to determine the scope of protection of the granted patent. Hence, the scope of protection was not extended.

The board pointed out that Art. 69(1), second sentence, EPC could not be relied upon for replacing a claim feature with a different one which could only be found in the description (see T 450/20). Reading the statement in paragraph [0021] into the clear wording of claim 1 as granted to establish compliance with Art. 123(3) EPC would have the consequence that the wording of this claim merely served as an empty shell (see Case Law of the Boards of Appeal, 10th ed. 2022, II.E.2.3.1c), in particular T 1172/08). This would undermine the principle stipulated in the first sentence of Art. 69(1) EPC and reiterated in decision T 1473/19 that the claims have primacy for determining the extent of protection conferred by the European patent. In the board's view, it would also be at odds with providing a reasonable degree of legal certainty for third parties as required by Art. 1 of the Protocol on the Interpretation of Art. 69 EPC. The board concluded that claim 1 of auxiliary requests 8 to 11 extended the scope of protection beyond that conferred by the patent as granted (Art. 123(3) EPC).

131-11-23

10. Article 109 EPC | T 2381/19 | Board 3.4.03

Article 109 EPC

Case Number	T 2381/19
Board	3.4.03
Date of decision	2023.06.20
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 109 EPC
EPC Rules	Rule 103(1)(a) EPC
RPBA	
Other legal provisions	
Keywords	interlocutory revision – reimbursement of appeal fee (no) – substantial procedural violation (no) – objection maintained and new objections raised after interlocutory revision – second appeal
Cited decisions	J 0005/08, T 0919/95
Case Law Book	V.A.11.4.4 , V.A.11.4.5 , 10th edition

In [T 2381/19](#) the board dealt with the second appeal filed by the applicant against the refusal of the application by the examining division.

In the first decision, the examining division had refused the application based on Art. 123(2) EPC, against which the applicant had appealed. The examining division had granted interlocutory revision by issuing a separate decision, which did not revise the initial refusal decision in the sense of immediately replacing it with a decision dealing with the substantive issues, but only set the initial refusal decision aside and continued the examination proceedings.

In its second decision refusing the application, the examining division had maintained the objections under Art. 123(2) EPC and added additional objections (under Art. 84, 52(1) and 56 EPC), although the requests had remained unchanged.

The applicant had then appealed the second refusal decision, requesting among other things the reimbursement of the second appeal fee. The appellant had argued that the "misuse of the rectification procedure by the examining division to add further objections to their first decision while maintaining the added-matter objection had to be considered a substantial procedural violation which justified the reimbursement of the appeal fee".

In [T 2381/19](#) the board confirmed the examining division's second refusal, based on Art. 123(2) EPC objections. The question that remained was then whether there were good reasons to reimburse the second appeal fee under R. 103(1)(a) EPC.

The board did not see a substantial procedural violation committed by the first instance in the procedure leading to the second refusal decision. In the present case the division did not only maintain the objections under Art. 123(2) EPC, but also raised in particular inventive step objections. In view of these objections, the applicant could not have reasonably expected the grant of the patent without a further refusal following the decision to grant the interlocutory revision. Put differently, already these additional inventive step objections made the payment of the further appeal fee necessary. Moreover, the board noted that, even assuming for the sake of argument that the division would not have allowed the interlocutory revision, the payment of a second appeal fee might still have become unavoidable. Since the first refusal decision only dealt with added subject-matter, it would still have been quite likely that the case would have been remitted to the examining division for examination of the outstanding substantive issues even after a successful (first) appeal.

The board further stated that, after granting interlocutory revision, once the examining division reopens the examination, it is formally not prevented from re-examining all the issues which were already the subject of the previous decision. The principle of prohibition of reformatio in peius does not apply in this situation.

The board concluded that there was no basis for the reimbursement of the second appeal fee, as no procedural violation was apparent and a reimbursement also did not appear equitable for any other reasons.

132-11-23

11. Article 113(1) EPC | T 2054/19 | Board 3.2.02

Article 113(1) EPC

Case Number	T 2054/19
Board	3.2.02
Date of decision	2023.05.02
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 094(3), 113(1) EPC
EPC Rules	Rule 103(1)(a) EPC
RPBA	
Other legal provisions	
Keywords	right to be heard – violation of the right to be heard (yes) – substantial procedural violation (yes) – opportunity to comment (no) – arguments considered (no) – appellant taken by surprise by the timing of the decision (yes) – reimbursement of appeal fee (yes)
Cited decisions	
Case Law Book	III.B.2.3.1 , III.B.2.4.2 , III.B.2.5.3 , 10th edition

In [T 2054/19](#) the board recalled that the right to be heard under Art. 113(1) EPC also included the right not to be surprised by a decision which had been taken against the expectation that the proceedings would be continued.

In the case in hand, the applicant had filed a first amended set of claims as a reaction to the European search report and the search opinion. Based on these claims the examining division issued its only substantive communication under Art. 94(3) EPC. In response the applicant filed a new set of claims. The examining division decided to refuse the application based on these claims. It relied on the views expressed in the European search opinion, as it considered claim 1 of the new set of claims to be identical in scope to claim 1 as originally filed and objected to in the European search report.

The board held that the immediate refusal of the application following the communication under Art. 94(3) EPC amounted to a violation of the right to be heard for the reasons set out below.

The communication under Art. 94(3) EPC had concerned an entirely different set of claims compared to the one underlying the decision, and in it the examining division

indicated that it was "at present not practicable to carry out a full examination of the application". The board held that when the applicant had sought to remedy these deficiencies by filing a new set of claims, they could expect that the examination proceedings would be continued.

The applicant had neither been made aware that the examining division had considered the scope of claim 1 before it to be identical to the scope of claim 1 as originally filed, nor of the fact that it had relied on the search opinion. The sentence "Should the applicant however insist on obtaining a patent on one of the claims which were found not to be patentable, a refusal under Art. 97(2) EPC is to be expected." stood at the end of a communication concerning a different set of claims and could thus not be read as an unambiguous reference to the search opinion which had been issued two years earlier. The board stated that where an examining division relies on arguments made in a search opinion, it has to do so in a manner which is clear and unambiguous. There should be no doubt to an ordinary reader about what is meant.

Moreover, the appellant had argued in its submission in response to the search opinion that D1 had only disclosed the appearance of gas bubbles in blood during decompression, but had failed to disclose a quantitative estimation ability. This argument, whilst made in the context of a different set of claims, had also been relevant to the claims as originally filed and to the claims underlying the decision. The decision failed, however, to address this argument. Hence, the argument was neither explicitly nor implicitly addressed.

The board concluded that for all these reasons the appellant had been taken by surprise by the timing and the content of the decision. The board considered these shortcomings to amount to a substantial procedural violation justifying remittal to the examining division for further prosecution and reimbursement of the appeal fee pursuant to R. 103(1)(a) EPC.

133-11-23

12. Article 117 EPC | T 1076/21 | Board 3.3.05

Article 117 EPC

Case Number	T 1076/21
Board	3.3.05
Date of decision	2023.05.26
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b), 117 EPC
EPC Rules	Rules 076(2)(c), 099(2) EPC
RPBA	Articles 12(2), 12(3), 13(2) RPBA 2020
Other legal provisions	
Keywords	law of evidence – apportioning the burden of proof – appeal after revocation of the patent by opposition division – no automatic shift of the burden to the patent proprietor – necessity for the opponent to discharge its burden – benefit of the doubt
Cited decisions	G 0009/91, G 0010/91, T 0182/89, T 0019/90, T 0585/92, T 0499/00, T 0072/04, T 1210/05, T 0063/06, T 0066/07, T 2006/08, T 0338/10, T 0518/10, T 1558/11, T 0325/13, T 1608/13, T 0030/15, T 0430/15, T 1596/16, T 2218/16, T 0720/17, T 1911/17, T 0055/18, T 0188/18, T 1487/18, T 0428/21
Case Law Book	III.G.5.1.1 , III.G.5.2.1 , II.C.9. , 10th edition

In [T 1076/21](#), with reference to T 585/92, the respondent (opponent) argued that the appellant (patent proprietor) bore the burden to prove that the patent was sufficiently disclosed because the opposition division had revoked the patent. The appellant contested that the respondent had successfully discharged its initial burden of proof.

The board concluded that the burden of proof regarding the facts, arguments and evidence on the substance (which initially lay with the opponent) did not shift to the proprietor just because the patent had been revoked due to an alleged insufficient disclosure.

The board recalled that only if there are serious doubts, substantiated by verifiable facts, may an application (or a patent) be objected to for insufficient disclosure (T 19/90). After the grant of the patent a legal presumption exists that the patent meets the requirements of the EPC. This presumption can be rebutted. The weight of

the submissions required to rebut the presumption depends on its strength (T 63/06, T 55/18). The initial burden on the opponent to provide facts, arguments and evidence for an assertion of an insufficient disclosure may shift to the patent proprietor once the opponent has successfully discharged its burden of proof by submitting sufficient facts, arguments and evidence to rebut the presumption (T 338/10, T 2218/16). However, this shift can only be caused by sufficient submissions on the substance; formal reasons alone, like the mere existence of the opposition division's decision to revoke the patent, do not lead to a shift of the burden of proof on the substance. If the reasoning in the impugned decision as such is found to be wrong, there cannot be any shift of the "burden of proof on the substance" (T 499/00, T 1608/13).

Linked to the burden of proof is the "burden to substantiate a case". Thus, the opponent first has to provide facts and argue why these facts support its assertion (T 182/89). This burden to substantiate facts and arguments is then followed by the burden to prove these facts, normally done by submitting evidence. Only in the exceptional case of a weak presumption of validity due to a lack of information in the patent may the submission of plausible arguments alone be sufficient (T 63/06, T 1558/11). Often both aspects are together referred to as the burden of proof.

This might have led to the misconception that any decision finding insufficiency would lead to the burden of proof being shifted to the patent proprietor. However, when distinguishing the "burden to substantiate a case" from the "burden of proof on the substance" the board found that it could be clearly deduced from the case law that after a decision by the opposition division allowing an objection of insufficiency, it was down to the patent proprietor to substantiate on appeal why that decision was wrong. The burden of proof on the substance (and in consequence the benefit of the doubt), however, was only shifted when the opposition division's assessment that the presented facts, arguments and evidence were sufficient to discharge the opponent's burden of proof turned out to be correct. The appellant bore the burden to substantiate the appeal. Yet the board noted that an appeal case need not necessarily be substantiated by submitting facts and evidence that counter the arguments and evidence presented by the opponent. It may also be substantiated by submitting why the opposition division's reasoning on insufficiency was flawed and why the burden of proof on the substance still lies with the opponent.

The patent proprietor here substantiated its appeal. The respondent did not submit evidence that the guidance in the patent was insufficient, and also did not show that the alleged unusual parameter was indeed unusual; it did not discharge its burden of proof on the substance. The opposition division could not base its decision on verifiable facts as required. There was no shift of the burden to the patent proprietor. Concerning another aspect, the board concluded that since the parties had made contradictory but unsubstantiated assertions concerning facts, the patent proprietor ought to be given the benefit of the doubt (T 72/04).

134-11-23

13. Article 12(4) RPBA 2020 | T 0019/20 | Board 3.3.03

Article 12(4) RPBA 2020

Case Number	T 0019/20
Board	3.3.03
Date of decision	2023.03.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 069(1), 123(3) EPC
EPC Rules	
RPBA	Articles 12(2), 12(4), 12(6), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment to case – basis of the proceedings – appeal case directed to objections on which decision was based (yes) – requirements of Art. 12(2) RPBA 2020 met (yes) – admissibly raised and maintained (yes) – amendment to appeal case – amendment after summons – exceptional circumstances (no)
Cited decisions	T 2920/18, T 2988/18, T 0247/20
Case Law Book	V.A.4.2.1 , V.A.4.2.2 , V.A.4.3.7 , 10th edition

In [T 19/20](#) claim 1 of the main request (patent as maintained by the opposition division) corresponded to claim 1 as granted, in which a part had been deleted. The board had to decide on admittance of the appellant's (opponent's) objection under Art. 123(3) EPC against this claim. According to the respondent, the opponent had not raised any objections under Art. 123(3) EPC against this claim during the oral proceedings before the opposition division. Indeed, it was clear from the minutes of the oral proceedings before the opposition division and from the contested decision that no specific objection under Art. 123(3) EPC had been raised against what was then auxiliary request 2 (later main request). However, as underlined by the board, it was also undisputed between the parties that the present objection under Art. 123(3) EPC was exactly the same as the objection raised against the main request of the opposition proceedings. The amendments in auxiliary request 2 were unrelated to the objection. This objection was discussed at the oral proceedings and fully dealt with by the opposition division. Moreover, the board considered that the objection had been maintained also against lower ranking requests such as auxiliary request 2, which differed from the main request by amendments unrelated to the objection, even if not explicitly repeated. In this respect, the board considered that the statement of the appellant that there were no objections under Art. 123(3) EPC

against auxiliary request 2 had to be understood as expressing that there were no further objections. Hence, the condition of the second sentence of Art. 12(6) RPBA 2020 did not apply to the objection at issue. For these reasons, the board took the view that the appellant's submission under Art. 123(3) EPC was directed to an objection on which the decision was based and was therefore not an amendment of the appellant's case. The board had therefore no discretion not to take it into account.

The board also had to deal with the admittance of a new line of defence against this objection under Art. 123(3) EPC, raised for the first time at the oral proceedings before the board. The respondent argued that the deletion did not change the scope of claim 1 because claim 1 was implicitly limited by said feature in view of the description of the patent, whereas previously in the rejoinder to the statement of grounds of appeal the respondent had argued that the deleted part was an added undisclosed feature without any technical meaning that could be deleted without violating Art. 123(3) EPC. The board held that the new line of defence raised new legal and technical issues and thus constituted a change of the legal and factual framework of the appeal, this was therefore an amendment of the respondent's case within the meaning of Art. 13(2) RPBA 2020. The respondent offered no explanation for the submission of this line of defence only at this stage, nor could the board discern any. In the absence of any exceptional circumstances, the new line of defence was not taken into account.

135-11-23

14. Article 13(2) RPBA 2020 | T 0463/19 | Board 3.4.02

Article 13(2) RPBA 2020

Case Number	T 0463/19
Board	3.4.02
Date of decision	2023.06.15
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 12(4) RPBA 2007, Article 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons – late-filed documents – exceptional circumstances (yes) – highly relevant prior use which was difficult to find and could not have been filed earlier – documents not deliberately withheld
Cited decisions	
Case Law Book	V.A.4.5.7 , 10th edition

In [T 463/19](#) machte der Beschwerdeführer (Einsprechende) erstmalig nach der Ladung zur mündlichen Verhandlung vor der Beschwerdekammer die auf die Dokumente E65a bis E65e gestützte offenkundige Vorbenutzung einer Waage geltend, sowie das Benutzerhandbuch E65a zugleich als Stand der Technik. In der mündlichen Verhandlung trug er weitere Umstände und Argumente für die Zulassung vor.

Aufgrund der folgenden Aspekte war die Kammer der Ansicht, dass im vorliegenden Fall außergewöhnliche Umstände vorlagen, die die Berücksichtigung der verspätet eingereichten Dokumente rechtfertigten (Art. 13 (1) und (2) VOBK 2020):

Nach Ansicht der Kammer war das Auffinden der Dokumente schwierig bis unmöglich und konnte eigentlich nur zufällig erfolgen. Dies ergab sich für die Kammer aus den folgenden Umständen: Es handelte sich um die Dokumentation einer Vorbenutzung eines Massenprodukts eines außereuropäischen, vom Hauptstandort des Einsprechenden in Deutschland weit entfernten Herstellers. Weltweit gab es eine Vielzahl von Waagenherstellern, deren Produkte dem Einsprechenden nicht alle bekannt sein konnten. Darüber hinaus waren die

Dokumente E65a bis E65e dem Einsprechenden erst während eines Einspruchsverfahrens durch einen Dritten zur Kenntnis gebracht worden.

Aus diesen Umständen schloss die Kammer auch, dass die Dokumente zweifellos nicht absichtlich zurückgehalten wurden.


Die Kammer berücksichtigte zudem, dass die geltend gemachte Vorbenutzung bzw. das Benutzerhandbuch prima facie zum Stand der Technik gehörten. Darüber hinaus waren die geltend gemachte Vorbenutzung bzw. das Benutzerhandbuch aus Sicht der Kammer prima facie sehr relevant, da eine im Benutzerhandbuch gezeigte Waage alle beanspruchten Bauteile zu enthalten schien.

Im Hinblick auf Argumente des Beschwerdegegners (Patentinhabers) hob die Kammer hervor, dass in der Tat nicht jedes schwierig auffindbare Dokument zu jedem verspäteten Zeitpunkt in das Verfahren eingeführt werden dürfe. Im vorliegenden Fall lägen jedoch zwei weitere besondere Umstände vor, nämlich die sehr hohe Relevanz und die Überzeugung der Kammer, dass die Dokumente vom Einsprechenden nicht absichtlich zurückgehalten wurden. Sie war zudem der Auffassung, dass im vorliegenden Fall eine Verzögerung des Verfahrens zur Erreichung einer erhöhten Rechtssicherheit (nach Überprüfung der Rechtsbeständigkeit in Bezug auf E65a bis E65e) hinnehmbar sei.

Hingegen ließ die Kammer die auf die Dokumente E66a bis E66d gestützte Vorbenutzung bzw. die Entgegenhaltung E66a als Stand der Technik nicht zu, da die sie nicht von deren hoher Relevanz überzeugt war.

Auch die auf die Dokumente E54 bis E58 gestützte Vorbenutzung, die bereits im erstinstanzlichen Verfahren hätten vorgelegt werden können und müssen, ließ die Kammer nicht zu (Art. 12 (4) VOBK 2007). Ebenso wenig berücksichtigte sie die verspätet eingereichte deutsche Patentanmeldung E59 bzw. Gebrauchsmusterschrift E61. Auch das erst nach der Zustellung der Ladung zur mündlichen Verhandlung eingereichte Dokument E64 wurde nicht zugelassen, da die vorgebrachten Tatsachen, dass E64 dem Einsprechenden zufällig bekannt geworden sei bzw. angeblich falsch klassifiziert gewesen sei, nach ihrer Auffassung keine außergewöhnlichen Umstände darstellten, die eine Berücksichtigung des verspätet eingereichten Dokuments E64 rechtfertigten.

136-11-23



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