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Abstracts of decisions

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1. Article 056 EPC | T 2465/19 | Board 3.4.03

Article 056 EPC

Case Number	T 2465/19
Board	3.4.03
Date of decision	2023.07.13
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (yes) – arbitrary modification (no) – non-obvious alternative (yes) – technical effect derivable from the original application (yes)
Cited decisions	G 0002/21, T 1294/16
Case Law Book	I.D.4.1. , I.D.9.21.1 , 10th edition

In [T 2465/19](#) there was agreement that, as set out by the examining division in the decision at issue, D1 represented the closest state of the art and that the subject-matter of claim 1 of the main request differed from D1 by feature i): "wherein the control contact region is spaced apart from the current shifting region so that the current shifting region is electrically isolated from the control contact region". The examining division found that D1 and the application solved the same (subjective) technical problem and that feature i) had no (additional) advantage or surprising/beneficial effect and was therefore not important.

The examining division further set out that the original description was not only totally silent about any such advantage or beneficial/surprising effect, but that a statement in the application indicated that direct contact between the current shifting region and the base contact region would not have much influence, supporting its view that feature i) was not important and rather represented an arbitrary modification. It concluded that an arbitrary modification of a known device having only disadvantages as compared to that known device could not justify an inventive step.

The appellant accepted that D1 and the application had the common goal to reduce surface recombination. It argued that this did not prove, however, that the novel feature of the invention provided no advantage. The appellant further submitted that

the disclosure of advantages in the description was not a requirement for inventive step, as long as such advantages were derivable from the application.

The board accepted that the application did not explicitly mention any particular additional advantage or surprising beneficial effect. However, it found that contrary to the view of the examining division, feature i) could not be said to have only disadvantages with respect to D1 (closest prior art). Nor could this feature be said to be arbitrary. The board noted with reference to Headnote II of G 2/21 that the technical effect of an invention over the closest prior art need not be explicitly stated in the application, as long as it is derivable from the original application, in particular since the closest prior art may not have been known to the applicant when drafting it.

The board found that the passage of paragraph [88] cited by the examining division did not support its view that feature i) was not important. The distinguishing feature i) did not represent an arbitrary modification of the device of D1 having only foreseeable disadvantages in the sense of section I.D.9.21.1 of the Case Law of the Boards of Appeal (10th edition, 2022), on which no acknowledgement of an inventive step could be based, but rather represented an alternative solution to a known problem as referred to in section I.D.4.5 of the Case Law of the Boards of Appeal (10th edition, 2022), having particular properties with respect to the solution known from D1.

The board concluded that the subject-matter of claim 1 of the main request involved an inventive step within the meaning of Art. 56 EPC with respect to D1 as closest state of the art and combined with the common general knowledge of the skilled person.

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2. Article 056 EPC | T 0215/20 | Board 3.3.02

Article 056 EPC

Case Number	T 0215/20
Board	3.3.02
Date of decision	2023.01.19
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (yes) – non-obvious solution – solution in prior art a mere allegation – skilled person – reasonable expectation of success (no)
Cited decisions	T 0777/08
Case Law Book	I.D.9.9.5 , 10th edition

In [T 215/20](#) the board held that the objective technical problem could be considered to be that of providing a pharmaceutical composition comprising a crystalline form of dapagliflozin which is more stable, i.e. less hygroscopic.

As regards obviousness, the appellant (opponent) argued the skilled person would have turned to D4 because it offered solutions to the problem of providing a crystalline form of an API as well as to the problem of providing a form that is less hygroscopic. Consequently, the subject-matter of claim 1 did not involve an inventive step over a combination of D1 and D4.

The board stated that for this argument to be correct, the skilled person, in order to take the teaching of D4 into account, would also have had to have had a reasonable expectation of success, i.e. a reasonable expectation that this teaching would solve the objective technical problem. However, the board reasoned that this was not the case. The skilled person would have considered the effect suggested by D4, namely the universal decrease in hygroscopicity, to be a mere allegation. Given the generally recognised high unpredictability of properties of crystalline forms, the skilled person would not have had a reasonable expectation of obtaining a less hygroscopic form of dapagliflozin.

The board therefore distinguished the current case from T 777/08 on which the appellant relied. In that case the deciding board held that the skilled person would

have had a reasonable expectation that providing a crystalline form of the API would have solved the objective technical problem. The current case was different in that, first, the effect relied on for inventive step was different (filterability and drying characteristics in T 777/08 vs hygroscopicity in the case at hand) and, second, although a solution to the objective technical problem may have been suggested by D4, the skilled person would not have had a reasonable expectation that the solution offered by D4 would have solved this problem.

In summary, the board held the subject-matter of claim 1 involved an inventive step over amorphous dapagliflozin as disclosed in D1 in combination with D4 because the skilled person, considering the teaching of D4, would not have had a reasonable expectation of obtaining a form of dapagliflozin which was less hygroscopic than amorphous dapagliflozin.

The board concluded the subject-matter of claim 1 involved an inventive step within the meaning of Art. 56 EPC. The reasoning applied, *mutatis mutandis*, also to the subject-matter of dependent claims 2 to 5. The board ordered the decision under appeal be set aside and remitted the case to the opposition division with the order to maintain the patent in amended form.

138-12-23

3. Article 056 EPC | T 1623/21 | Board 3.4.02

Article 056 EPC

Case Number	T 1623/21
Board	3.4.02
Date of decision	2023.05.25
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step – identification of technical and non-technical features – problem-solution approach
Cited decisions	
Case Law Book	I.D.9.2. , 10th edition

In [T 1623/21](#) the board found the reasons of the appealed decision for showing that the subject-matter of claim 1 lacked an inventive step not convincing.

Contrary to the examining division's view expressed in the appealed decision, overlaying information onto a received sensory work at a specific instance relative to the epoch time amounted to a technical task. Indeed, as explained by the applicant, the technical task underlying the playback method of claim 1 included identifying a source of the overlay information, controlling the communication of the network media player with the identified source of the overlay information, controlling the subsequent playback carried out by the network media player and defining a point in time at which the overlay was overlaid onto the sensory work.

In view of the method steps referred to above, the board was not convinced that claim 1 only defined "non-technical display of information". To convincingly argue lack of inventive step, it was not sufficient to assert that the skilled person was aware of the underlying technology. It must also be shown that the skilled person had a clear incentive to apply the presumably known technology in a particular way, namely to arrive at the claimed subject-matter.

At least some of the method steps of claim 1 were technical features having a technical content going beyond the mere display of information. Therefore, the technical content of these features should not have been ignored when assessing the

inventive step of the subject-matter of claim 1. Rather, the assessment of inventive step should, in principle, have been carried out on the basis of the problem-solution approach, including the definition of an objective technical problem solved by the distinguishing technical features of claim 1. If the problem-solution approach was not used, the examining division should have explained the reasons for not using it, which they had not.

139-12-23

4. Article 099 EPC | T 1522/21 | Board 3.2.07

Article 099 EPC

Case Number	T 1522/21
Board	3.2.07
Date of decision	2023.03.16
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 099(1) EPC
EPC Rules	Rule 116(1) EPC
RPBA	Articles 11, 12(6) RPBA 2020
Other legal provisions	
Keywords	late-filed evidence – admitted (no) – late-filed evidence – error in use of discretion at first instance (no) – remittal (no)
Cited decisions	
Case Law Book	IV.C.4.5.2 , 10th edition

In [T 1522/21](#) the opposition division had admitted document D11 into the proceedings finding it prima facie relevant. The opponent had filed document D11 after the nine-month period under Art. 99(1) EPC but before the final date for making written submissions according to R. 116(1) EPC. The patent proprietor argued that the opposition division had not exercised its discretion in a reasonable way because D11 had not been filed in reaction to any amendment to the claims and could not have been considered as being prima facie relevant as its contents were not detrimental to the maintenance of the patent.

The board noted that according to established case law, evidence submitted after the nine-month period was generally to be regarded as late-filed, unless special circumstances applied. It was however also established case law that if a discretionary decision of an opposition division was challenged in appeal, it was not for the board to review all the facts and circumstances as if it were the opposition division. A board should only overrule the way in which an opposition division has exercised its discretion if it comes to the conclusion that the opposition division used the wrong principles, failed to take into account the right principles, or exercised its discretion in an unreasonable or arbitrary manner.

In the board's view the opposition division in the case in hand had exercised its discretion reasonably and according to the right criteria. During the oral proceedings before the opposition division, both parties had presented their arguments on the

content and admissibility of D11. The minutes of the proceedings contained these discussions. The opposition division had based its ruling on the principle of prima facie relevance, which was a decisive principle in such decisions. Consequently, there was no justification to overturn the opposition division's discretionary decision and to exclude D11 from the proceedings.

The patent proprietor had also requested that the case be remitted to the opposition division in the event that D11 was admitted into appeal proceedings. However pursuant to Art. 11 RPBA 2020, the board stated it should only remit the case if there were special reasons for doing so. The board observed that the appealed decision was already based on D11 and, thus, subject to review by the board in accordance with Art. 12(2) RPBA 2020. The board therefore did not remit the case to the opposition division.

140-12-23

5. Article 111 EPC | T 2916/19 | Board 3.3.03

Article 111 EPC

Case Number	T 2916/19
Board	3.3.03
Date of decision	2023.04.19
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 111 EPC
EPC Rules	
RPBA	Art. 11 RPBA 2020
Other legal provisions	
Keywords	remittal to the department of first instance (yes) – board not empowered to instruct first-instance department to accelerate proceedings
Cited decisions	
Case Law Book	IV.C.7. , V.A.9. , 10th edition

In [T 2916/19](#) the appellant raised objections of lack of novelty and of lack of inventive step against claim 1 of the main request. The board noted that an objection had already been put forward during the opposition proceedings but that the opposition division had not deemed it necessary to deal with it. It was unclear to the board why and on which basis the appellant's objection of lack of inventive step of claim 1 of the main request had not been dealt with in the decision under appeal. It found said decision suffered from a substantial procedural violation in that the opponents' objections and arguments were not properly taken into account. According to established case law, such a substantial procedural violation was to be equated with a fundamental deficiency in the sense of Art. 11 RPBA 2020, and the board accordingly remitted the case to the opposition division for further prosecution (Art. 111(1) EPC).

The respondent requested that the board instruct the opposition division i) to deal with the present case in an accelerated manner and ii) to limit the further discussion to the documents on file in the event that the case was remitted to the opposition division. The request was made in view of the filing date of the application on which the patent in suit was based (2007) and the fact that this would be the second remittal to the opposition division.

The board considered that the question of when or at which pace the case was to be dealt with by the opposition division was a managerial decision to be taken by the

department of first instance; the board was not empowered to impose any timeline/time constraints to the department of first instance which would be in charge of the case. The board noted that the respondent could at any time request accelerated proceedings under the PACE programme, which may be done both at the opposition and appeal stages.

The board further considered it could not, in advance, decide to exclude from consideration any unknown and unforeseeable facts, pieces of evidence and/or submissions. Therefore, the respondent's request for the board to instruct the opposition division to limit the further discussion to the documents on file was rejected.

141-12-23

6. Article 112a(2)(c) EPC | R 0006/20 | EBA

Article 112a(2)(c) EPC

Case Number	R 0006/20
Board	EBA
Date of decision	2023.07.10
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 112a(2)(c), 113(1), 114(1) EPC
EPC Rules	
RPBA	Article 12(4) RPBA 2007
Other legal provisions	
Keywords	petition for review – clearly unallowable – fundamental violation of the right to be heard (no) – compliance of Art. 12(4) RPBA 2007 with Art. 114(1) and 113(1) EPC (yes)
Cited decisions	R 0017/10, R 0009/11, R 0010/11, R 0017/11, R 0001/13, R 0008/15, R 0010/18
Case Law Book	V.B.3.4.3 , V.B.4.3.10a , 10th edition

In [R 6/20](#) the petition for review was based on Art. 112a(2)(c) EPC, i.e. on the grounds that a fundamental violation of the right to be heard (Art. 113(1) EPC) had occurred, whereas the petitioner relied on two asserted procedural defects.

The Enlarged Board (EBA) thus assessed whether the decision under review had been tainted by a fundamental violation of the right to be heard for

- not addressing all the facts and arguments (first defect) and/or
- the way in which the facts and arguments relating to non-admittance of the submissions on public prior use were addressed (second defect).

As to the first asserted procedural defect, the petitioner indicated that the board had only addressed admittance of the submissions on public prior use, without even discussing whether these submissions had been prima facie relevant for assessing the question of novelty of the subject-matter of claim 1 of the patent as granted. Referring to R 8/15, the petitioner held that, in order to comply with the right to be heard, the decision would have had to have made it possible to conclude that the board had "substantively considered" the submissions on public prior use.

The EBA expressed the view that the requirement that "the Board substantively considered those submissions" (catchword of R 10/18, point 1, second paragraph) should be given the meaning that "the Board considered the contents of those submissions", with this consideration comprising matters pertaining to admittance of facts, evidence and requests, and/or relating to substantive law, i.e. the merits of a case. According to the EBA, the board had complied with the "substantively considered" requirement interpreted this way, especially since the board applying Art. 12(4) RPBA 2007 had concluded that the submissions on public prior use should have been filed in the proceedings before the opposition division. Given that the submissions on public prior use had not been admitted, there had been no point in discussing their merits, i.e. whether the respective evidence had been novelty-destroying. The board had thus complied with the "substantive consideration" requirement of R 8/15 as affirmed in R 10/18, both in respect of admittance and merits.

With regard to the second asserted procedural defect, the EBA analysed its case law on the review of substantive law under Art. 112a EPC and recalled the principle set out therein according to which the petition for review may, under no circumstances, be a means to review the application of substantive law. The EBA had no competence under Art. 112a EPC to examine the merits of the decision and to go into the substance of a case. In the context of (non-) admittance, the EBA recalled that it could not be considered in review proceedings whether to admit a new request (R 10/11) or a new document (R 1/13). Referring to R 17/10, the EBA emphasised that admitting late-filed documents and/or other evidence was a matter for the board's discretion and, therefore, as such not subject to review under Art. 112a EPC, unless the exercise of discretion was arbitrary or manifestly illegal (R 10/11), thereby involving a fundamental violation of the right to be heard (R 9/11, R 17/11). Under the essence of this case law, the decision to not admit must be neither arbitrary nor manifestly illegal. The EBA held that these criteria were met in the case in hand: first, the applicable legal provision of Art. 12(4) RPBA 2007 complied with both the principle of ex officio examination and the right to be heard, and, second, so did its application in the case in hand.

The EBA emphasised that Art. 12(4) RPBA 2007 was in line with Art. 114(1) and 113(1) EPC. Non-compliance with the admittance criterion of Art. 12(4) RPBA 2007, correctly interpreted in a specific case, in itself justified not admitting submissions filed outside of a time limit, without the requirement to assess in addition prima facie relevance of the submissions or the state of the proceedings (procedural efficiency). Furthermore, in the case in hand, this provision had not been applied in a way that was arbitrary or manifestly incorrect.

The EBA concluded that none of the asserted defects had been established and the asserted fundamental violation of the right to be heard based thereupon was clearly unfounded. The EBA thus rejected the petition and refused the remaining requests.

142-12-23

7. Article 114 EPC | T 0375/21 | Board 3.3.04

Article 114 EPC

Case Number	T 0375/21
Board	3.3.04
Date of decision	2023.05.09
Language of the proceedings	FR
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 114 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	correct exercise of discretion (no) – fresh ground for opposition admitted at first-instance – review of first-instance discretionary decision – first-instance admittance of fresh ground for opposition annulled – late-submitted material
Cited decisions	G 0010/91
Case Law Book	V.A.3.4.5 , IV.C.3.4.1 , 10th edition

Dans l'affaire [T 375/21](#) la chambre a annulé la décision de la division d'opposition selon laquelle était admis un nouveau motif d'opposition soumis pour la première fois deux mois avant la procédure orale devant la division d'opposition. La chambre était d'avis que la division d'opposition avait exercé son pouvoir d'appréciation en la matière de manière déraisonnable.

La division d'opposition n'avait pas reconnu le caractère tardif du motif d'opposition, quand bien même celui-ci n'avait pas été évoqué dans l'acte d'opposition. Elle avait considéré qu'il n'était pas tardif au motif qu'il représentait une réaction à certains documents soumis par la titulaire en réponse au mémoire d'opposition.

La division d'opposition n'avait pas non plus indiqué en quoi le nouveau motif était de prime abord pertinent. Elle avait par ailleurs demandé aux titulaires de donner des raisons pour lesquelles le "motif ne serait pas pertinent". Or selon l'avis G 10/91, c'est plutôt à la division d'opposition qu'il revient d'expliquer pourquoi, de prime abord, le nouveau motif semble en tout ou en partie s'opposer au maintien du brevet contesté.

143-12-23

8. Article 116(1) EPC | J 0006/22 | Board 3.1.01

Article 116(1) EPC

Case Number	J 0006/22
Board	3.1.01
Date of decision	2023.07.26
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 116(1), 125 EPC
EPC Rules	Rule 136(1) EPC
RPBA	
Other legal provisions	Article 6(1) ECHR, Article 31(1) Vienna Convention on the Law of Treaties (1969)
Keywords	oral proceedings – no "absolute" right to oral proceedings – "Eventualmaxime" principle – "principe de concentration des moyens" – interpretation of the EPC – dynamic interpretation of Article 116(1) EPC – legal certainty in due time
Cited decisions	G 0001/97, G 0003/97, G 0003/98, G 0002/12, G 0002/13, G 0002/19, G 0003/19, J 0019/05, J 0011/09, T 1573/20
Case Law Book	III.C.2.1. , III.C.4.3.3. , III.H.1.2.5. , III.H.3. , 10th edition

[See also abstract under Article 122 EPC.](#)

In [J 6/22](#) the Legal Board handed down its decision that the request for re-establishment and the appeal be rejected as inadmissible without the oral proceedings requested by the appellant. In its decision, the Legal Board recalled R. 136(1) EPC corresponding to the principle of "Eventualmaxime", under which the request must state all grounds for re-establishment and means of evidence without the possibility of submitting these at a later stage. Only if this requirement is complied with may it be permissible to complement the facts and evidence in later submissions, provided that they do not extend beyond the framework of the previous submissions (see e.g. J 19/05). According to the Legal Board, this was not the case for either of the requests for re-establishment in the proceedings at hand. Thus, no further procedural steps were permissible, notably no further communication and no appointment of oral proceedings. Neither would serve any legitimate purpose.

The Legal Board noted that it was not the purpose of oral proceedings in the context of proceedings for re-establishment to give the appellant a (further) chance to substantiate their factual assertions or to provide evidence despite the absence of factual assertions (see e.g. J 11/09). It was undisputed that the right to oral proceedings as guaranteed by Art. 116(1) EPC was a cornerstone of proceedings before the EPO. The jurisprudence of the boards generally followed the assumption of an "absolute" right to oral proceedings upon request. However, even this "absolute" right to oral proceedings upon a party's request was subject to inherent restrictions by the EPC and procedural principles generally recognised in the contracting states of the EPO (Art. 125 EPC). Such limits had also been recognised in the jurisprudence of the boards (see e.g. G 2/19, T 1573/20). The jurisprudence of the boards had repeatedly underlined that the requirement of legal certainty in due time was recognised as a fundamental principle enshrined in the EPC (e.g. G 1/97, G 3/97). This principle had also been reflected in the RPBA 2020. If oral proceedings did not serve any legitimate purpose, as in the case at hand, the requirement of legal certainty in due time would trump and even prevent a board from appointing oral proceedings.

As to the interpretation of Art. 116(1) EPC, the Legal Board cited Art. 31(1) Vienna Convention, which provides that the starting point for the interpretation of the terms used in a treaty provision is their ordinary meaning in their context in light of the provision's object and purpose. However, the jurisprudence of the boards had also reiterated the importance of a "dynamic" interpretation of the EPC in light of its object and purpose (G 2/12, G 2/13, G 3/19, G 3/98). In this context, the Legal Board referred, among others, to the development of the case law of the European Court of Human Rights (ECtHR) on Art. 6(1) ECHR. The ECtHR had also identified occasions where oral proceedings could or even should be dispensed with in pursuit of a party's right to a fair trial.

In the Legal Board's view, a literal interpretation of Art. 116(1) EPC conflicted with the legislature's aims when oral proceedings would serve no purpose and thus only prolong proceedings to no one's avail. A narrow interpretation of Art. 116(1) EPC therefore had to make way for a dynamic and evolutive understanding instead, in light of the provision's object and purpose. The very purpose of Art. 116(1) EPC could be seen as providing for the essential right to be heard in oral proceedings only insofar as these served a legitimate purpose and thus did not run counter to the requirement of legal certainty in due time as a further essential element of a fair trial for all parties. In a case like the current one, legal certainty in due time, just as procedural economy, as a further essential cornerstone of a fair trial, had to prevail.

144-12-23

9. Article 122 EPC | J 0006/22 | Board 3.1.01

Article 122 EPC

Case Number	J 0006/22
Board	3.1.01
Date of decision	2023.07.26
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 108, 122 EPC
EPC Rules	Rules 101(1), 127(2), 136(2) EPC
RPBA	
Other legal provisions	
Keywords	re-establishment of rights (no) – time limit for paying renewal fee – time limit for filing statement of grounds – request not duly substantiated – all due care (no)
Cited decisions	J 0015/10, T 0287/84, T 0742/11
Case Law Book	III.E.4.4. , III.E.5.5.1. , III.E.5.5.2. , 10th edition

[See also abstract under Article 116 EPC.](#)

In [J 6/22](#) the appellant had requested re-establishment of rights with respect to the time limit for the statement of the grounds of appeal, citing merely the medical condition of its European professional representative. This was complemented by the representative's declaration, essentially outlining that in the period from 27 April 2022 to end of June 2022 the representative began to suffer from a medical condition which continued developing and that said representative was the sole attorney in the office who was empowered to act before the EPO. Sick leave certificates for the representative were also submitted, merely stating the representative's inability to work from 24 August to 28 September 2022, without giving any further details.

The Legal Board recalled that a request for re-establishment must set out, in a sufficiently substantiated fashion, the grounds on which it is based, the facts on which it relies and the precise cause of non-compliance with the time limit concerned, and it must specify when and under which circumstances the cause occurred and when it was removed (see J 15/10). The Legal Board then referred to the jurisprudence of the boards to observe that the reference to a declaration like the representative's might suffice for the request for re-establishment to be properly substantiated if the necessary facts and reasons are given in that declaration (see T 287/84). In the case at hand, no reasons could be found as to why the

representative would not have been in a position throughout the whole two-month time limit for the subsequent filing of the grounds of appeal to take any action. No reasons were given on how far-reaching the representative's medical condition was or what actions might have become impossible because of it. The medical certificates also laid out no conclusive details. Moreover, they covered a period that was completely different (August to September 2022) from the one in question (April to June 2022).

Lastly, nothing was said about a system of staff substitution that should have kicked in in case of the representative's inability to act. If said representative was the only one capable to act before the EPO, provisions would have had to be made to provide for substitution from outside the office. Notably, the office in question was part of a large IP consulting group operating worldwide, and they should have provided a backup. The request for re-establishment being pursued by their colleagues in the sister office at least showed that such a substitution would have been feasible, and no reasons to the contrary were given.

Thus, the Legal Board found on the basis of the appellant's own submissions and factual assertions that it could not be said that all due care had been taken as required by the circumstances. Absent any kind of provisions for the representative's substitution, the request for re-establishment into the time limit for the grounds of appeal had to fail for this reason alone. Since the request for re-establishment of rights was refused, the grounds of appeal were late-filed and the appeal was rejected as inadmissible (R. 101(1) EPC in conjunction with Art. 108 EPC).

The Legal Board went on to observe for the sake of completeness that the appeal against the examining division's decision rejecting the request for re-establishment into the time limit for the payment of the seventh renewal fee plus the additional fee would also not have been successful on the merits. In claiming that all parties had exercised all due care for the payment of the fees in question, the appellant had overlooked that all acts of its "US agent", an intermediary between it and the European professional representatives, tasked "to supervise the procedure and communicate with the agent empowered to act before the EPO", were also fully attributed to it (see T 742/11). No reasons had been given to conclude that the US agent had exercised all due care. To the contrary, from the appellant's own arguments, it was apparent that the US agent, by not monitoring the time limits properly, not proactively reaching out to the appellant, not responding to a large number of emails and not making provisions for staff losses, had not exercised all due care. For these reasons alone, there would also have been no need to look further into the appellant's own or its European professional representatives' behaviour.

145-12-23

10. Rule 116 EPC | T 1219/19 | Board 3.3.08

Rule 116 EPC

Case Number	T 1219/19
Board	3.3.08
Date of decision	2023.01.18
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 076(1), 084, 123(2) EPC
EPC Rules	Rules 081(3), 116 EPC
RPBA	Article 12(4) RPBA 2007
Other legal provisions	Guidelines E-VI, 2.2(2) and 2.2(3), November 2018 version
Keywords	opposition proceedings – discretion of the opposition division not to admit amended claims filed at the oral proceedings (yes) – change of subject of proceedings (no) – discretion exercised correctly by opposition division (yes)
Cited decisions	G 0007/93, R 0006/19, T 1213/19, T 0966/17
Case Law Book	IV.C.5.1.4d , 10th edition

In the decision at issue in [T 1219/19](#), the opposition division had decided not to admit auxiliary request 6, which was filed by the appellant during the oral proceedings. According to the opposition division, it had been filed late, was an attempt to address an issue already raised in the notices of opposition, was prima facie unsuitable to solve the issue of added subject-matter (Art. 123(2) EPC), and appeared to lack clarity (Art. 84 EPC). The appellant disputed whether the opposition division had indeed had discretion not to admit this request and, in the event that it did, whether it had exercised its discretion in accordance with the proper criteria.

The appellant invoked R. 116(2) EPC to argue that the opposition division did not have discretion to disregard this auxiliary request or to apply the criterion of prima facie allowability. It argued that since the opposition division had changed its view in oral proceedings, expressed in the preliminary opinion sent with the summons, that omitting the feature "template-directed" did not result in added subject-matter, auxiliary request 6, although filed after the time limit under R. 116 EPC, could not be regarded as late-filed and should have been admitted. Under R. 116(2) EPC, requests filed after the final date set for making written submissions in preparation for oral proceedings could only then not be admitted if the patent proprietor had been notified of the grounds prejudicing the maintenance of the patent.

The board found that under the circumstances in hand the opposition division was entitled to exercise its discretion accorded by Art. 123(1) in conjunction with R. 81(3) EPC (see R 6/19, T 966/17, T 1213/19), and that it had exercised it in accordance with the right principles. The opposition division could not be deprived of that discretion merely because it had expressed a different opinion at the oral proceedings from that provisionally set out in the communication accompanying the summons. Moreover, the opposition division's preliminary opinion had discussed the added-matter objections raised by the opponents and had clearly indicated that those objections were to be the subject of further discussion at the oral proceedings. In the board's view, the preliminary conclusion that claim 1 did not add subject-matter was expressed in a careful manner and could not be understood to mean that the opposition division thereby gave up its discretionary power to disregard submissions filed later. A different conclusion would penalise the useful practice of providing a detailed discussion of the relevant issues in preparation for oral proceedings.

The appellant also referred to the Guidelines for Examination to argue that the opposition division's change of opinion at the oral proceedings constituted a change of subject of the proceedings, justifying the later filing of auxiliary request. The board agreed that, in principle, it did change the subject of the proceedings, especially where the opposition division had introduced a new objection at a relatively late stage. However, the Guidelines did not exclude the possibility that, under particular circumstances, a change from the preliminary opinion would not necessarily involve a change of subject of the proceedings. In this regard, the board found that the content of the preliminary opinion, taken as a whole, was articulate and could not be read in a manner limited to the conclusion that claim 1 did not add subject-matter. The objection that the single-molecule sequencing process had no basis in the parent application had been raised by both opponents at the outset of the opposition proceedings and was not introduced into the proceedings by the opposition division. The issue had been discussed at length in preparation for the oral proceedings, it had been considered an issue by the opposition division in the preliminary opinion, and it was also sufficiently clear that it was a crucial one. Thus the appellant had indeed been notified of the grounds prejudicing the maintenance of the patent.

The board therefore found that the different conclusion reached at the oral proceedings by the opposition division could not be regarded as a change of subject of the proceedings. Auxiliary request 6 had thus not been submitted in due time and the opposition division had had discretion to disregard it, pursuant to the correct criterion of prima facie allowability (or non-allowability). That auxiliary request 6 raised clarity issues was an additional criterion for non-admittance. The board therefore saw no reason to revise the opposition division's decision or to exercise its own discretion in favour of admitting auxiliary request 6 into the appeal proceedings (Art. 12(4) RPBA 2007).

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11. Rule 140 EPC | T 1846/20 | Board 3.3.02

Rule 140 EPC

Case Number	T 1846/20
Board	3.3.02
Date of decision	2023.03.09
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 002(2), 097 EPC
EPC Rules	Rules 071(3), 140 EPC
RPBA	
Other legal provisions	
Keywords	correction of errors in decisions – request refused
Cited decisions	G 0001/10, T 1003/19
Case Law Book	H.VI.3.1. , 10th edition

In [T 1846/20](#) the appeal was lodged by the patent proprietor (appellant) against the decision of the examining division refusing the request for the re-issue of the B-specification of the patent and the request for re-establishment of rights.

The application for the patent was filed on 16 June 2016 in Chinese as an international application under the PCT. The application was published on 23 December 2015 and included sheets 1/3 to 3/3 of drawings. These drawings contained text in Chinese.

When the application entered the European phase, the applicant checked the boxes in Form 1200P specifying that: the proceedings before the EPO were to be based on the application documents published by the International Bureau with all claims, description and drawings; and the translations of the international application documents, i.e. abstract, description, claims and any text in the drawings, in one of the official languages of the EPO were attached. However, no translation of text matter of the drawings was filed. On 5 April 2019, the examining division issued a communication under R. 71(3) EPC notifying the applicant about its intention to grant a European patent on the basis of the documents, with no mention of the drawings. The text intended for grant, i.e. the Druckexemplar, not containing any sheet of drawings, was attached to the communication. On 25 July 2019, the examining division issued the decision to grant a European patent with the documents indicated in its communication. No appeal against this decision to grant was filed.

By letter dated 4 November 2019, the applicant stated that the applicant's name in the B-specification of the patent was incorrect. Moreover, it noted that the B-specification of the patent did not include the drawings present in the PCT application. It requested re-issue of the B-specification of the patent, including the correct applicant's name and the drawings filed with this letter. Drawings sheets 1/3 to 3/3 corresponding to sheets 1/3 to 3/3 as published under the PCT with Chinese text matter translated into English were enclosed. The examining division informed the appellant that the applicant's name had been corrected as requested, but that the request to correct the patent was not admissible. This decision was appealed.

The board held that since no errors had occurred in the process of converting the version as intended for grant into the B-specification, the discussion of affecting third parties was irrelevant. When receiving the communication under R. 71(3) EPC clarifying the examining division's position on the text intended for grant, the appellant should have realised that to safeguard its interests it should request the inclusion of the drawings. However, the appellant had failed to do this and instead approved the proposed text and did not file any appeal. As a consequence, the decision to grant became final (Art. 97(1) and (3) EPC)."

Decision T 1003/19 invoked by the appellant concerned a case in which an appeal against the decision to grant a European patent had been filed. In contrast, in the current case, the appellant did not file any appeal against the decision to grant. Therefore, the grant decision became final, and the granted patent ceased to be within the jurisdiction of the EPO (G 1/10).

As stated in G 1/10, from its grant, a European patent becomes, subject only to the possibility of later EPO proceedings by way of opposition or limitation, a bundle of national patents each of which falls within the exclusive jurisdiction of a designated Contracting State (see Art. 2(2) EPC). Therefore, since in the current case the decision to grant has become final, the EPO, except in opposition or limitation proceedings, has no jurisdiction to change the text of the granted patent or deal with the request for correction. The board concluded that the request for re-issue of the B-specification of the patent by including sheets 1/3 to 3/3 of the drawings as filed on 4 November 2019 was not allowable in view of decision G 1/10.

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12. Rule 140 EPC | T 0255/22 | Board 3.2.03

Rule 140 EPC

Case Number	T 0255/22
Board	3.2.03
Date of decision	2023.05.10
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rules 139, 140 EPC
RPBA	
Other legal provisions	
Keywords	correction of error in decisions –first-instance decisions – correction of minutes of department of first instance
Cited decisions	G 0008/95, R 0004/18, T 0613/14
Case Law Book	III.L.1.2 , 10th edition

In [T 255/22](#) the board held that it had no competence to correct or amend under R. 140 EPC the reasons given by a first-instance department in the written decision, or to order such a correction or amendment. The reasons for this were essentially twofold and rely on the Enlarged Board's findings in G 8/95. First, for a correction pursuant to R. 140 EPC, the manifest intention of the deciding body is decisive (see G 8/95, point 3.2 of the Reasons) and the board cannot interfere with this intention.

This was in accordance with the Enlarged Board's finding that the competence to correct errors in a decision under R. 140 EPC lies with the body which had given the decision (G 8/95).

As pointed out in G 8/95, the principle underlying R. 140 EPC was that an obvious clerical mistake can be corrected by the deciding body responsible for the decision in a situation where the decision does not express its manifest intention. It would go against this principle if the board could correct or amend the wording of the reasons in a way which deviated from the opposition division's manifest intention. Doing so should not be within the power of a board.

Second, the reasons given by the deciding body represent the very substance of the decision, which can be challenged by a party only in an appeal against this decision. If there is concern as to the substance of a decision, the correct way of addressing a

deficiency therein is to appeal this decision. An appeal against the refusal to correct the decision under R. 140 EPC is not the correct avenue to pursue.

In its second and third requests, the appellant no longer requested that an amendment to the reasons be ordered. Rather, the board was requested to "confirm" that a specific wording in the main decision was an obvious mistake under R. 140 EPC (and, as an auxiliary measure, it was asked to confirm what the wording should be, namely the one suggested by the appellant), and the board should also "confirm" that the absence of a specific wording in the main decision was an obvious mistake under R. 140 EPC. These requests also failed. The board held that it had no competence to confirm that an "obvious mistake" within the meaning of R. 140 EPC had been made in the reasons given by a first-instance department in the written decision.

The reason for this was again that the board could not interfere with the manifest intention of what the opposition division had – in its view and as confirmed in its communication – correctly written in the reasons of the decision. Yet it was this that the board would have done if it had "confirmed" the existence of obvious mistakes in the reasoning given by the opposition division. This also applied to the request for the board to "confirm" what the party believed the wording of the reasons should be.

In addition, as also set out above, as long as it concerns the substance of the decision, an appeal against the refusal to correct the decision under R. 140 EPC is not the correct avenue to pursue.

Lastly, the board held that the Boards of Appeal have no competence to correct or amend the content of the minutes of oral proceedings before a first-instance department, or to order such a correction or amendment. The correction of the minutes falls neither under R. 139 EPC nor under R. 140 EPC:

The minutes are not a "document filed with the European Patent Office" within the meaning of R. 139 EPC. The board noted that, in R 10/08, the Enlarged Board referred to R. 139 EPC in the context of the correction of the minutes. However, the text of R. 139 EPC was clear in that it only referred to documents filed with the EPO, which is not the case for the minutes. The minutes are also not a "decision" within the meaning of R. 140 EPC. The case law of the Boards of Appeal is consistent in that the minutes do not constitute a decision, nor are they part of the decision announced at the oral proceedings (see T 613/14). That the minutes are not a "decision" was also confirmed by the Enlarged Board in R 4/18. The present board agreed with this case law.

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13. Article 13(2) RPBA 2020 | T 1906/19 | Board 3.4.01

Article 13(2) RPBA 2020

Case Number	T 1906/19
Board	3.4.01
Date of decision	2023.05.31
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons – interpretation of “in principle” (“en principe”; “grundsätzlich”) – some limited leeway left for exceptions – amendment can be considered despite the absence of exceptional circumstances justified by cogent reasons – procedural economy primary reason for the convergent approach
Cited decisions	T 1294/16
Case Law Book	V.A.4.5.1 , V.A.4.5.4 , 10th edition

In [T 1906/19](#) the board raised different objections in its preliminary opinion and at the oral proceedings to which the appellant (applicant) immediately reacted each time with the filing of a single new request that addressed the objections.

The board explained that it understood the wording of Art. 13(2) RPBA 2020 as laying down a basic rule but leaving some limited leeway for exceptions. The basic rule was that amendments were not considered unless there were exceptional circumstances justified by cogent reasons (by the submitting party). The leeway for deviating from this rule lay in the expression “in principle” (“en principe”; “grundsätzlich”), which the board read roughly as “as a rule”, meaning that the provision’s basic rule was not entirely without exception. This leeway, when applied, meant that an amendment could be considered despite the absence of exceptional circumstances justified by cogent reasons.

In the board’s view, this textual understanding of Art. 13(2) RPBA 2020 was supported by systematic and teleological considerations. Art. 13(1) and (2) RPBA 2020 define the second and third levels of the convergent approach. Together with the first level specified in Art. 12(4) RPBA 2020, these provisions set increasingly

stringent hurdles for the admission of new requests and other amendments. The board held that this approach for deciding on the admittance of amendments would lose some of its coherence and convergence if the boards could exercise discretion on the first two levels but not the third. The board thus interpreted the passage "shall, in principle, not" as indicative of a remaining (though restricted) discretion. It was not convinced that the lawmaker had put words without meaning into a provision as important as Art. 13(2) RPBA 2020. Rather, the lawmaker had had the foresight to see that the otherwise harshly-worded Art. 13(2) RPBA 2020 needed a caveat allowing for consideration of the particular circumstances of a case.

With regard to the case in hand, the board observed that the appellant had not followed the common practice, when submitting amended requests, of maintaining at least some previous requests. This practice sometimes meant that the board and the parties had to spend considerable time on requests that even the applicant or proprietor no longer thought viable. Instead, the appellant had given the board a single set of claims to consider. While it was true that the request was twice further amended during oral proceedings, these amendments were straightforward, within the limits of the debate, and finally led to a set of claims that was, *prima facie*, clearly allowable. The succession of requests in the present case was not detrimental to procedural economy. There was no inconvenience for the board, and no other party to the proceedings was affected.

The board emphasised that the primary reason for the convergent approach was procedural economy. It would be unfortunate if it were so strictly applied that appellants, in *ex parte* proceedings, were seriously discouraged from filing a promising and facilitating new request and dropping non-viable requests.

149-12-23

14. Article 13(2) RPBA 2020 | T 2465/19 | Board 3.4.03

Article 13(2) RPBA 2020

Case Number	T 2465/19
Board	3.4.03
Date of decision	2023.07.13
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons – amendment filed on express invitation from the board – late-filed request – exceptional circumstances (no) – not detrimental to procedural economy – taken into account (yes)
Cited decisions	T 1294/16
Case Law Book	V.A.4.5.1 , V.A.4.5.4 , 10th edition

In [T 2465/19](#) the claims and the adapted description (main request) had been filed as a response to the express invitation of the board in its communication under Art. 15(1) RPBA 2020 to file such amended application documents. The board was satisfied that the amendments addressed its objections and prima facie appeared suitable to overcome the outstanding objections and admitted the request under Art. 13(2) RPBA 2020.

The board held that such a situation could not be considered to constitute truly "exceptional circumstances" as required by Art. 13(2) RPBA 2020, at least according to its plain wording. After all, such conduct of the proceedings could even be considered as perfectly normal in ex-parte appeal proceedings. Nevertheless, the board was convinced that the procedural situation in the case in hand was covered by the legislative intent underlying the structure of Art. 12 and 13 RPBA 2020, and that the request was admissible.

The board pointed out that since some of the objections addressed by the request at issue were not new, it could have come to the conclusion that the amendments were not admissible under Art. 13(2) RPBA 2020. On the other hand, there was a further procedural aspect that strongly supported the admittance of the request. The board noted that Art. 12 and 13 RPBA 2020 made no formal distinction between inter-

partes and ex-parte cases. However, in the board's view, these provisions mainly served to prevent the raising of issues that could not be expected to be treated by other parties or the board within the foreseeable extent of the appeal proceedings, and in particular in view of the expected decision at the end of the oral proceedings (Art. 15(6) RPBA 2020). In the case in hand, the board was satisfied that the amendments in fact did not raise new issues for the board. They were therefore not detrimental to procedural economy, and there was also no other party whose interest could be jeopardised by such late amendments (see also T 1294/16). The board also saw no reason to depart from the settled practice of adapting the description only after the establishment of an allowable claim set.

With regard to the appellant's duty to provide an explanation for the late filing of any amendments, the board observed that, in view of the totality of the circumstances of the present case, in particular in view of the fact that the amendments were filed following the express invitation from the board, requiring such an explanation from the appellant would be clearly counter-intuitive. The board was well aware for which purpose the amendments were filed and why they were filed at that stage. Thus no detailed arguments and reasons were required from the appellant in the present case.

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