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

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

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Abstracts of decisions

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1. Article 024 EPC | R 0004/24 | EBA

Article 024 EPC

Case Number	R 0004/24
Board	EBA
Date of decision	2024.08.19
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 024 EPC
EPC Rules	
RPBA	
Other legal provisions	Article 02(6) RPEBA
Keywords	suspicion of partiality – suspected partiality of members of the Enlarged Board of Appeal – disqualifying partiality of chair (no) – involvement of chair in G-decision leads to partiality in R case reviewing the decision applying the G-decision (no)
Cited decisions	G 0001/21 of 17 May 2021, G 0002/21, T 0116/18 of 11 October 2021, T 0116/18 of 28 July 2023
Case Law Book	III.J.6.1.1 , 10th edition

Interlocutory decision [R 4/24](#) of 19 August 2024 concerned a petition for review against decision T 116/18 of Board 3.3.02 of 28 July 2023. In T 116/18 of 11 October 2021, a referral had been made under Art. 112 EPC to the Enlarged Board, resulting in decision G 2/21, which was then applied in T 116/18 of 28 July 2023.

The petitioner raised an objection of suspected partiality under Art. 24 EPC against the Chair in the petition for review case R 4/24, on the basis that he had also been the Chair of the Enlarged Board in G 2/21. The petitioner acknowledged that the Chair in both G 2/21 and R 4/24 did not participate in decision T 116/18 and was not Chair of Board 3.3.02.

Nevertheless, the petitioner argued that G 2/21 and T 116/18 were: "[...] inextricably related by virtue of Art. 112(3) EPC and well-known by the European patent community to be so...". It further submitted that "it would be unfortunate, if not undesirable, for a member of the Enlarged Board who participated in the Enlarged

Board decision now to participate in deciding whether or not that decision was implemented with fundamental procedural fairness in the decision under review."

The petitioner further argued that the present case might fall under the "or for any other reason" clause of Art. 24(2) EPC.

The objection was found to be admissible by the original composition of the Enlarged Board, an alternate Chair was appointed, and the Enlarged Board decided upon the objection of suspected partiality in this altered composition.

The Enlarged Board summarised the principles developed by the Enlarged Board and the Boards of Appeal for the application of Art. 24 EPC (see point 1 of the Reasons and as referred to by the Enlarged Board, G 1/21 of 17 May 2021 and also Case Law of the Boards of Appeal, 10th ed. 2022, III.J.1. "General principles").

The Enlarged Board in its alternate composition found that the Chair of the Enlarged Board in R 4/24 in its original composition had not participated in the decision that was the subject of the petition for review (T 116/18 of 23 July 2023) and was therefore not excluded under Art. 2(6), second sentence, RPEBA, from acting as Chair in case R 4/24. It acknowledged that G 2/21 was binding for the decision under review, but pointed out that a decision by the Enlarged Board under Art. 112 EPC and the following final decision by the referring board were separate decisions. Further, under Art. 112 EPC, the Enlarged Board in "G"-cases answers questions of law, and the application of the law in question to the facts of the appeal case rests exclusively with the competent board of appeal. Against this background, the Enlarged Board was of the view that participating in decision G 2/21 did not exclude the objected to Chair from taking part in R 4/24. Moreover, it saw no other reasons, whether or not mentioned in Art. 24(1) EPC, for excluding the Chair from R 4/24.

As to the petitioner's argument that the present case might fall under the "or for any other reason" clause of Art. 24(2) EPC, the Enlarged Board was also not convinced. Art. 24(2) EPC provides for a member themselves to put forward a reason for their exclusion, which had not happened in the case in hand. Rather the Chair was of the view that there was no such reason, as submitted in comments under Art. 24(4) EPC.

In conclusion, the Enlarged Board found that the objection against the Chair in R 4/24 in its original composition to be unfounded and that he could continue to participate in case R 4/24 as Chair.

131-12-24

2. Article 053 EPC | T 2510/18 | Board 3.3.02

Article 053 EPC

Case Number	T 2510/18
Board	3.3.02
Date of decision	2024.05.31
Language of the proceedings	FR
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 053(a) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	patentability – contrary to morality – traditional knowledge
Cited decisions	G 0002/06
Case Law Book	I.B.2.2.2b , 10th edition

Dans l'affaire [T 2510/18](#), il s'agissait de déterminer si une invention dérivée de recherches sur des remèdes traditionnels dans des conditions alléguées de tromperie et d'abus de confiance à l'égard de populations autochtones allait contre les bonnes mœurs et l'ordre public. Le brevet en cause avait pour objet une molécule, la Simalikalactone E (SkE), qui peut être extraite de la plante *Quassia amara*, ainsi que son utilisation comme médicament dans la prévention et le traitement du paludisme. Il a été reconnu dans le brevet que la plante *Quassia amara* avait été utilisée en médecine traditionnelle contre les fièvres et le paludisme dans tout le nord-ouest de l'Amazonie et jusqu'en Amérique centrale. L'intimé (titulaire du brevet) a identifié et isolé la SkE en utilisant un procédé spécifique à partir de feuilles (matures séchées) de *Quassia amara*. Cette molécule s'est avérée active contre le paludisme.

Les requérants soutenaient que l'exploitation commerciale de l'invention revendiquée était contraire aux bonnes mœurs et à l'ordre public selon l'art. 53a) CBE, dans la mesure où elle n'était pas conforme à la morale ni à l'ensemble des normes acceptées et profondément ancrées dans la culture européenne. Ces normes concernent celles qui encadrent la recherche avec les communautés autochtones et locales ainsi que l'utilisation de leurs savoirs traditionnels. Il n'était pas contesté qu'au début des années 2000, l'intimé a mené des recherches sur les remèdes traditionnels antipaludiques auprès des populations de la Guyane française. Les chercheurs ont étudié ces remèdes traditionnels et ont par la suite concentré leurs

efforts sur l'étude de la plante *Quassia amara*. Les chercheurs sont ainsi parvenus à l'identification d'une molécule antipaludique, la SkE.

Selon les requérants, les comportements contraires aux normes acceptées, notamment celles qui encadrent la recherche avec les communautés autochtones ainsi que l'utilisation de leurs savoirs traditionnels, constituaient une tromperie à l'égard des communautés autochtones et locales et un abus de leur confiance pour le développement de l'invention en cause. En effet, c'était grâce à l'apport des savoirs traditionnels que les chercheurs de l'intimé sont parvenus à identifier la molécule SkE. Néanmoins, les membres des communautés autochtones contactés par l'intimé n'ont pas été informés de manière complète et transparente de la nature du projet de recherche, de ses objectifs, du dépôt du brevet, et d'autres risques et avantages du projet pour les membres des communautés et leurs savoirs. Pour les requérants, "l'invention" comprenait les étapes préalables au développement de l'invention et requises pour son exploitation, à savoir la manière dont la SkE avait été découverte par l'intimé. Donc, le comportement de l'intimé pendant le développement de l'invention (tromperie et abus de confiance, etc) était lié à l'exploitation commerciale de l'invention. Il fallait alors examiner ce comportement pour le respect des bonnes mœurs et de l'ordre public dans le cas d'espèce de l'invention revendiquée.

La chambre n'a pas partagé cette approche. Comme indiqué par l'intimé, aucune des allégations des requérants ne concernaient l'exploitation commerciale de l'invention, condition préalable pour conclure que l'invention serait exclue en vertu de l'art 53 CBE. Au contraire, l'invention revendiquée dans la requête principale concernait: la molécule SkE (revendication 1), un médicament comprenant la molécule SkE (revendications 2 à 6), et le procédé d'isolement de la SkE selon la revendication 1 à partir des feuilles de *Quassia amara* (revendications 7 et 8).

Comme l'a fait valoir l'intimé, l'exploitation commerciale de cette molécule, du médicament la comprenant et de son procédé d'isolement n'était pas contraire à la morale, aux bonnes mœurs ou à l'ordre public. Bien au contraire, il y avait un grand besoin de médicaments contre le paludisme, et trouver de nouveaux médicaments antipaludiques était une mission dont le but était de soigner les populations à risques et de sauver des vies. G 2/06 est invoquée sans succès par les requérants; la chambre estime que le développement d'une invention est distinct de son exploitation commerciale une fois qu'elle a été réalisée. Aucune preuve n'a été apportée par les requérants que l'isolement de la molécule SkE et son administration seraient contraires à l'ordre public ou aux bonnes mœurs. La chambre a finalement conclu que le motif tiré de l'art. 53a) CBE ne s'opposait pas au maintien du brevet.

132-12-24

3. Article 084 EPC | T 0056/21 | Board 3.3.04

Article 084 EPC

Case Number	T 0056/21
Board	3.3.04
Date of decision	2024.10.04
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Ex parte
EPC Articles	Articles 069 and 084 EPC
EPC Rules	Rules 042, 043, 048 and 049 EPC
RPBA	Article 21 RPBA 2020
Other legal provisions	Protocol on the Interpretation of Article 69 EPC
Keywords	claims – adaptation of the description (no) – no legal basis – clarity – support in the description – claim-like clauses
Cited decisions	G 0002/88, G 0006/88, G 0001/93, G 0001/97, G 0001/98, G 0001/04, G 0002/10, G 0002/12, G 0003/14, T 0020/80, T 0175/84, T 0454/89, T 0442/91, T 0740/96, T 1129/97, T 1208/97, T 0488/99, T 0412/03, T 0056/04, T 1279/04, T 0223/05, T 1404/05, T 1825/09, T 0712/10, T 0786/16, T 0030/17
Case Law Book	II.A.5.3 , II.A.3.1 , II.A.6.3.5 , 10th edition

In [T 56/21](#) the board addressed the question whether Art. 84 EPC provides a legal basis for (i) objecting to an inconsistency between what is disclosed as the invention in the description (and/or drawings, if any) and the subject-matter of the claims, the inconsistency being that the description (or any drawing) contains subject-matter which is not claimed, and (ii) requiring removal of this inconsistency by way of amendment of the description (hereinafter: "adaptation of the description").

As the appeal concerned ex parte proceedings, the board dealt with the interpretation of Art. 84 EPC for the purpose of its application in examination proceedings. The board analysed the function and relationship of the claims and the description, the relationship between the assessment of patentability and the determination of the extent of protection as well as the requirements of support by the description and clarity in Art. 84 EPC.

On adaptation of the description, the board came to the following conclusions:

- (a) Art. 84 and R. 43 EPC set forth requirements for the claims, not for the description.
- (b) It is the purpose of the assessment of Art. 84 EPC as part of the examination of patentability to arrive at a definition of the patentable subject-matter in terms of distinctive technical features distinguishing it from the prior art.
- (c) Art. 69(1) EPC and the Protocol on the Interpretation of Art. 69 EPC are not concerned with the definition of the subject-matter according to Art. 84, first sentence, EPC, or the assessment of patentability in examination before the EPO but with the extent of protection in the context of infringement proceedings in the contracting states. Art. 69 EPC and its Protocol are hence not applicable in grant proceedings before the EPO.
- (d) The requirements of Art. 84 EPC and R. 43 EPC are to be assessed separately and independently of considerations of extent of protection when examining a patent application.
- (e) In examination, future legal certainty is best served by a strict definitional approach which ensures that allowable claims per se provide an unambiguous definition of the subject-matter meeting the requirements for patentability.
- (f) Adapting the description to match the more limited subject-matter claimed does not improve legal certainty but reduces the reservoir of technical information in the granted patent. This may have unwarranted consequences in post-grant proceedings and may encroach on the competence of national courts and legislators.
- (g) R. 48 EPC is not concerned with the adaptation of the description, but with the avoidance of expressions which are contrary to public morality or public order, or certain disparaging or irrelevant statements in the publication of an application.

The board held that in examination of a patent application, neither Art. 84 nor R. 42, 43 and 48 EPC provide a legal basis for requiring that the description be adapted to match allowable claims of more limited subject-matter. Within the limits of Art. 123 EPC, an applicant may, however, amend the description of its own volition.

In the case at hand the description included a passage entitled "SPECIFIC EMBODIMENTS", which contained claim-like clauses. Those clauses included subject-matter which was not claimed. The board set aside the (refusal) decision under appeal and the case was remitted to the examining division with the order to grant a patent based on the main request on file.

133-12-24

4. Article 084 EPC | T 1152/21 | Board 3.3.02

Article 084 EPC

Case Number	T 1152/21
Board	3.3.02
Date of decision	2024.06.24
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 084 EPC
EPC Rules	
RPBA	
Other legal provisions	Guidelines F-IV, 4.7.1 – March 2021 version
Keywords	claims – clarity (no) – clarity in opposition proceedings – using description to interpret the claims – conciseness (no)
Cited decisions	G 0003/14
Case Law Book	II.A.3.1 , II.A.2.3 , II.A.6.3.5 , 10th edition

In [T 1152/21](#) the board concluded that claim 1 of auxiliary requests 9b and 10a did not meet the requirements of Art. 84 EPC.

Claim 1 of auxiliary request 9b included the term "cooling to an appropriate temperature". The board found that the skilled person could not assess whether a particular temperature was an "appropriate temperature", since the wording of the claim did not allow them to determine the conditions under which a temperature was an "appropriate temperature". Therefore, the claim was not clear.

The patent proprietor (appellant) had submitted that the skilled person was very familiar with heating and cooling steps, which were inherent to any (re)crystallisation process. It was a routine task for the skilled person to determine said appropriate temperature by reasonable trial-and-error experiments. Hence, the feature "appropriate temperature" was a functional feature related to a process step which could easily be performed in order to obtain the desired result. The board did not agree. It held that the patent proprietor's submission was relevant for sufficiency of disclosure rather than for the clarity of the claim. The relevant issue was what was covered by claim 1 of auxiliary request 9b, not whether the skilled person could reproduce the claimed method.

Auxiliary request 10a included in claim 1 the following terms: "heating to about 70°C", "heating at about 70°C", "heating the organic layer to about 120°C", "cooling to about

80°C", "maintaining the mixture at about 80°C for about 3 hours" and "gradually cooling to about 10°C".

The board noted that the term "about" in the context of said claim was associated with a specific temperature or a specific time. It could be that the term "about" was intended to cover measurement errors. However, measurement errors were covered for any value of any technical parameter to be measured and given in any claim (without the need for the term "about") since patents were in the field of technology, not mathematics, and a value could only be as precise as it could be measured according to the general technological convention. Thus, following this interpretation, the term "about" was superfluous and claim 1 was not concise, contrary to what was required by Art. 84 EPC. Alternatively, the term "about" could be intended to denote a range broader than the measurement error range. Following this second interpretation, it could not be determined how broad the range could be in claim 1 and what the exact limits of this range were. In this case, the term "about" in said claim was not clear, again contrary to what was required by Art. 84 EPC.

The patent proprietor had submitted that the term "about" was clear in light of the description of the patent since paragraph [0020] gave a clear definition of the term. According to the board, the claims have to be clear as such, i.e. without taking the description into account to interpret any unclear term. Even if it were accepted that the description could be consulted in the context of Art. 84 EPC, paragraph [0020] of the patent read as follows: "[...], the term "about" means within a statistically meaningful range of a value, such as a stated concentration range, time frame, molecular weight, particle size, temperature or pH. Such a range can be within an order of magnitude, typically within 20%, more typically within 10%, and even more typically within 5% of the indicated value or range". In the board's view, the term "statistically meaningful range" did not clearly define a range and for that reason was unclear. Even if it were accepted that, as submitted by the patent proprietor, the term "statistically meaningful range" was specified by relative variations in percent, said term would still be unclear since the following sentence contained various different percentages ("typically within 20%, more typically within 10%, and even more typically within 5% of the indicated value or range"). Contrary to the patent proprietor's submission that the skilled person would choose the broadest range, there was no teaching in this following sentence to choose the percentage within 20% of the indicated value, in view of the lower preference of the term "typically" compared with the two other terms "more typically" and "even more typically".

The patent proprietor further submitted that the term "about" was to be considered clear in light of the Guidelines F-IV, 4.7.1 – March 2021 version. The board pointed out that this chapter related to the interpretation of terms such as "about", not to the assessment of the clarity of such terms. Thus, the board found that the patent proprietor's submission was not convincing.

134-12-24

5. Article 099 EPC | T 0846/22 | Board 3.2.02

Article 099 EPC

Case Number	T 0846/22
Board	3.2.02
Date of decision	2024.07.30
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 058, 099, 104 EPC
EPC Rules	
RPBA	
Other legal provisions	Section 1169 of the UK Companies Act 2006
Keywords	admissibility of opposition (yes) – acting on behalf of a third party – UK dormant company a legal person (yes) – abuse of procedure (no)
Cited decisions	G 0003/97, G 0003/99, G 0001/13, T 0184/11
Case Law Book	IV.C.2.1.1 , IV.C.2.1.4 , 10th edition

[See also abstract under Article 104\(1\) EPC.](#)

In [T 846/22](#) the respondent (patent proprietor) questioned the status of the appellant as a legal person in the context of Art. 99(1) EPC, according to which "any person may give notice to the European Patent Office of opposition [...] in accordance with the Implementing Regulations". "Any person" is to be interpreted in line with Art. 58 EPC as "any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it" (G 3/99, OJ 2002, 347; G 1/13, OJ 2015, 42).

The respondent had submitted that the appellant, a UK company, had been a "dormant company" under UK law at the time of filing the opposition and had never changed this status. The respondent argued that this meant that the appellant was not entitled to conduct any business and could not be equated to a legal person.

The board noted that the status of a legal person as such, i.e. the question as to whether they had the capacity to sue or be sued, was a matter of national law. The right to bring opposition proceedings, to take part in such proceedings, to file an appeal and to take part in appeal proceedings was, by contrast, a matter of procedural law governed by the EPC (G 1/13, point 5.3 of the Reasons with reference to G 3/97, OJ 1999, 245, point 2.1 of the Reasons). Hence, it had to be established whether the appellant, in particular at the time of filing the notice of opposition and the notice of appeal, had the status of a legal person.

The board referred to Section 1169 of the (UK) Companies Act 2006, according to which a company is dormant during any period in which it has no significant accounting transactions. Although inactive, a dormant company was not struck off, but remained on the Companies House register. This meant that a dormant company maintained the status of a legal person. The board thus agreed with the conclusion drawn to this effect in T 184/11.

It followed therefore that the appellant had the status of a legal person at the time of filing the notice of opposition and throughout the opposition and appeal proceedings. The respondent's argument in this respect was therefore not convincing.

Whether the appellant had engaged in transactions which could have led to the loss of its dormant status went beyond the assessment of its status as a legal person. The assessment of potential financial relationships between a dormant company and an appointed representative was of no relevance to establishing the legal status of the company as a legal person either. Moreover, the opponent's representative was appointed in accordance with the requirements of the EPC. Hence, there was no reason for the board to doubt that the representative was duly authorised. The remaining provisions under the EPC for the admissibility of the opposition and appeal, including the payment of the relevant fees, were also complied with.

As regards the contention that the appellant had been acting on behalf of a third party with the intention of avoiding any liability for possible costs apportioned to the appellant under Art. 104 EPC, the board noted that acting on behalf of a third party could not be seen as a circumvention of the law unless further circumstances were involved and there was no requirement under the EPC that a party be equipped with sufficient financial means to comply with a merely hypothetical costs order. Moreover, the EPC did not offer the patent proprietor any kind of guarantee that an opponent would be able in fact to reimburse costs awarded against them (G 3/97, point 3.2.6 of the Reasons).

For these reasons, the board did not see any abuse of procedure by the appellant which might render the opposition and/or the appeal inadmissible.

The board thus refused the respondent's requests that the decision under appeal be set aside and the opposition be held inadmissible or that the appeal be held inadmissible.

135-12-24

6. Article 104(1) EPC | T 0964/21 | Board 3.2.06

Article 104(1) EPC

Case Number	T 0964/21
Board	3.2.06
Date of decision	2024.07.09
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 104(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	apportionment of costs (no) – order not clear – not equitable
Cited decisions	
Case Law Book	III.R.3 , III.R.2.1.2a), 10th edition

In [T 964/21](#) the patent proprietor (appellant) requested, among other things, that the opposition division's decision as to the apportionment of costs be set aside. The formulation of that decision was set out in the Reasons of the impugned decision as follows: "... the Opposition Division apportions to the Proprietor the costs of the remuneration of the representatives of the parties in respect to oral proceedings and for the undue delaying of the procedure in respect of late filing".

The board emphasised that an order for the apportionment of costs under Art. 104 EPC must clearly state (at least) the kind of costs to be borne by the burdened party. According to the board, the order referred to above did not comply with this requirement. The order was so vague that it was not possible to clearly determine (a) whether the representatives' costs of preparing for the oral proceedings were included, and (b) whether the representatives' costs for both oral proceedings (i.e. for the one of 8 October 2019 and also for the later one of 26 April 2021) were included.

In this regard the board noted that according to the minutes of the oral proceedings of 8 October 2019 before the opposition division, the costs for both oral proceedings should be borne by the patent proprietor. This however was not properly reflected in the order and could not be assumed to be covered by it. Furthermore, in view of the fact that parties to opposition proceedings have a right to oral proceedings, such a ruling – without any limitations of the specific costs to be borne in relation to the oral proceedings and without providing sound reasons for such a decision – would not comply with the right to be heard in oral proceedings as enshrined in the EPC.

The board found that, even on the basis of the foregoing alone, the decision on the apportionment of costs was to be set aside.

Furthermore, the board held that the opposition division's decision also failed in terms of substance. According to established case law, a board should overrule a discretionary decision only if they conclude that it was taken in accordance with the wrong principles, without taking the right principles into account or in an arbitrary or **unreasonable way**, thereby exceeding the proper limits of its discretion (see Case Law of the Boards of Appeal, 10th ed. 2022, V.A.3.4.1b); emphasis by the board). A substantive review of a discretionary decision was therefore not excluded in the present case.

According to the board, the fact that the patent proprietor did not contest the earliest priority claimed for D22 in view of the embodiment of Figures B34A and B34B until the first oral proceedings before the opposition division could not justify a different apportionment of costs. In this regard it had to be taken into account that a novelty objection based on the embodiment of Figures B34A and B34B of D22 was raised for the first time in said oral proceedings. Even if a novelty objection based on the embodiment of Figure 1B of D22 was already in the proceedings, this did not mean that the patent proprietor would have been obliged to consider the validity of the priorities of D22 in relation to that objection.

With regard to the late filing of amended requests, the board did not see any procedurally abusive behaviour on the part of the patent proprietor, nor did the effort of the opponents caused by the late filing of the requests – which was partly due to the late submission of the objections based on D22 – appeared to be unduly high. The efforts for the preparation of the issue of admittance of the newly filed requests did not appear to the board to have caused unreasonable expense to the opponents. Moreover, such preparatory work could in no way justify the award of the entire costs of the oral proceedings.

Thus, the board found it appropriate for each party to bear its own costs. The decision of the opposition division as to the apportionment of costs was set aside.

136-12-24

7. Article 104(1) EPC | T 0846/22 | Board 3.2.02

Article 104(1) EPC

Case Number	T 0846/22
Board	3.2.02
Date of decision	2024.07.30
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 104(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	apportionment of costs (no) – abuse of procedure (no) – non-attendance at oral proceeding
Cited decisions	G 0003/97, T 0475/07
Case Law Book	III.R.2.2.1b), III.R.2.3 , 10th edition

[See also abstract under Article 99 EPC.](#)

In [T 846/22](#) the respondent (patent proprietor) had requested that its costs from the first and second instance proceedings should be charged to the appellant (opponent). The respondent argued that these costs were incurred through an abuse of procedure by the appellant, namely acting throughout the opposition and appeal proceedings whilst being a dormant company with the aim of circumventing possible remedies given to the parties by Art. 104 EPC. The board noted that acting on behalf of a third party could not be seen as a circumvention of the law unless further circumstances were involved (G 3/97, OJ 1999, 245, point 3.2 of the Reasons) and there was no requirement under the EPC that a party be equipped with sufficient financial means to comply with a merely hypothetical costs order. Moreover, the EPC did not offer the patent proprietor any kind of guarantee that an opponent would be able in fact to reimburse costs awarded against him (G 3/97, point 3.2.6 of the Reasons). Hence, the board concluded that there was no abuse of procedure in this respect and refused this request for apportionment of costs.

The respondent had further requested that its costs incurred for the preparation of the oral proceedings be charged to the appellant, who had only informed the board the day before the oral proceedings that it would not attend them. In particular, the respondent argued that, had it been informed, the costs for the preparation of at least part of the oral proceedings would not have been incurred, in view of the board's preliminary opinion, which was favourable to the respondent in respect of a number

of issues. The board stated that the oral proceedings would have had to have taken place anyway. This was because of the respondent's auxiliary request for oral proceedings. Hence, in contrast to the case underlying T 475/07, the appellant's conduct had had no impact on the necessity of holding oral proceedings. The board noted that even when all parties attended oral proceedings, it was possible that not all the issues addressed in the preliminary opinion would be discussed, since for some of them the parties could refer to their written submissions. The board also pointed out that the respondent could not be sure that the preliminary opinion would be maintained in the oral proceedings. Deciding not to be prepared for an issue which could potentially be discussed at the oral proceedings, irrespective of the board's preliminary view on the issue, always involves some risk and it is the parties' responsibility to decide what to prepare for. In any case, it could not be asserted beforehand that the board's preliminary opinion would have rendered the oral proceedings unnecessary. For these reasons, the board did not consider it equitable to order the apportionment of costs in favour of the respondent. Hence, this request was refused too.

137-12-24

8. Article 117 EPC | T 0778/21 | Board 3.2.06

Article 117 EPC

Case Number	T 0778/21
Board	3.2.06
Date of decision	2024.04.11
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 111(1), 113(1), 117(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	law of evidence – taking of evidence – offering evidence – effect on the outcome of the dispute – hearing of witnesses and inspection of prior used machine – remittal
Cited decisions	G 0002/21, T 0097/94, T 0474/04, T 0545/08, T 1363/14, T 1138/20
Case Law Book	III.G.3.1.2 , 10th edition

In [T 778/21](#) (laundry appliance), the opposition division concluded inter alia that the subject-matter of claim 1 of the patent as granted was not new in view of both document E2 and the prior use (PU) relating to a washing machine. Both parties appealed. The opponent alleged that the sale of the prior use PU washing machine as detailed on the invoice PU1 and the related affidavits of Mr N. (PU3) and Mr E. (PU2) sufficed for proving that the machine was publicly available. Serial numbers were unique, so the indication of the serial number of the prior use machine allowed a definitive identification of the machine. Thus, in the opponent's view, the inspection of the machine or the hearing of witnesses as requested by the proprietor was not necessary. The errors in the opponent's grounds of appeal associated with the model number for the prior use PU were to be seen as clerical errors. The proprietor inter alia submitted that in view of the doubts presented already in the opposition proceedings, an inspection of the machine with serial number C21850524 and the hearing of witnesses would have been necessary for verification.

The board first dealt in detail with several issues in relation to RPBA and late filed submissions at different stages, eventually most not admitted. On a particular late submission, the board did not accept the opponent's argument that documents filed during the written stage of the opposition proceedings should generally be included in the appeal by default. Regarding the opponent's reaction to the preliminary opinion of

the board, in which the opponent explained that the incorrect association of model number WFW97HEXW2 with serial number C21850524 was a clerical mistake, the board found that exceptional circumstances existed that in its view justified admitting the opponent's explanation.

Concerning the general principles for assessing an alleged prior use, the board set out four steps that should generally be made (detailed in the Reasons). Steps 1 to 3 consisted in the examination of the substantiation of the prior use, establishing the evidence offered by the opponent as bearing the burden of proof and the evaluation of the entire evidence offered by the opponent. Depending on the outcome of this evaluation, step 4 could vary (three variants) depending on whether or not the opponent's evidence on file confirmed the alleged facts, or if doubts remained, and whether the opponent did (first variant) or did not (second variant) request an inspection or hearing of witnesses (see the detailed Reasons as to the consequences). If, in the third variant, the opponent's evidence confirmed the prior use, the (counter) evidence offered by the patent proprietor would become relevant and would need to be considered. If assertions made in an affidavit or in any other witness declaration remained contested, a request from a party to hear the (available) witness would have to be granted. The board made reference to G 2/21 (points 41, 42, 44 of the Reasons) and to T 474/04.

In case T 778/21, the board applied these general principles for assessing the alleged prior use. Steps 1 to 3 of the assessment were fulfilled. Step 4 concerned the third variant, therefore the proprietor's request for an inspection of the washing machine and for hearing the authors of the affidavits as witnesses needed to be granted. Since the alleged instance of prior use concerned a specific machine to which the proprietor had no access, the applicable standard of proof was either "beyond all reasonable doubt" (T 97/94) or that the deciding body had to be convinced with a sufficient degree of certainty (T 1138/20, T 545/08). Thus, based on the submissions and evidence on file, the board found that the opponent had substantiated that the machine of the prior use was made available to the public and had provided evidence confirming the related facts. Based on the evidence on file, all features of claim 1 were seen to be known from the prior use. Therefore, the patent proprietor's request for taking (counter) evidence (step 4, third variant) needed to be considered. A final conclusion on whether all relevant aspects of the prior use, including public availability, were proven beyond reasonable doubt, could only be drawn after considering the evidence requested to be considered by the proprietor, i.e. after inspecting the machine and hearing the witnesses. The case was remitted to first instance for further prosecution.

138-12-24

9. Article 117 EPC | T 1311/21 | Board 3.4.02

Article 117 EPC

Case Number	T 1311/21
Board	3.4.02
Date of decision	2024.09.12
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054(1), 117(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	law of evidence – standard of proof – yardstick in straightforward cases – none of the standards of proof here applicable – binary approach to proof standards overly formalistic and simplistic – deciding body's conviction matters
Cited decisions	T 1634/17, T 1138/20
Case Law Book	III.G.4.3 , 10th edition

[See also abstract under Article 12\(6\) RPBA.](#)

In [T 1311/21](#), concerning the public availability of the user manual E7, written by the company Sensors, Inc., the board addressed in detail the question of standard of proof.

The board noted that neither of the two standards of proof "balance of probabilities" and "beyond reasonable doubt" was to be applied exclusively and without further reflection. The board also referred to the applicable standards when both parties have access to the evidence relating to the alleged prior use (balance of probabilities) compared to cases where evidence lies within the sphere of the opponent in the sense that the proprietor has barely any or no access to the evidence (up to the hilt).

However, in certain cases, such as the present one, the board stated this binary approach to proof standards could turn out to be overly formalistic and simplistic. On the one hand, since E7 originated not from the opponent but from a third party, it could not simply be said that the evidence "lies within the sphere of the opponent". On the other hand, the arguments put forward by the patentee showed that there was an imbalance between the parties in the access to E7 and thus the possibility to

establish whether E7 was part of the prior art, so that it could also not simply be said that both parties had access to this evidence.

Actually, while the board concurred with the patentee that the evidence on the question of whether E7 was part of the prior art was not in a neutral sphere of control, inter alia due to the undisputed business relationship between the opponent and Sensors, Inc., the board was of the opinion that the patentee had had opportunities to search for counter-evidence.

Since the user manual E7, whose public availability prior to the priority date of the patent was at issue, was neither within the sphere of control of the opponent nor within a neutral sphere of control to which both parties had access, the board was of the opinion that neither standard of proof was applicable. In fact, the present board agreed with the conclusions reached in the decisions T 1138/20 and T 1634/17. It therefore considered that, while the two standards of proof appearing in the jurisprudence of the boards of appeal may well be used as a yardstick in straightforward cases, what mattered, in plain language and as concluded in T 1138/20, was the deciding body's conviction on the occurrence of an alleged fact, taking into account the particular circumstances of the case and the relevant evidence before it (see Catchword 2.).

The dispute between the parties about which exact standard of proof was to be applied to the present situation could be left undecided, and the board came to the conclusion after assessment of the evidence that it was sufficiently proven that E7 had actually been made available to the public prior to the priority date of the patent. The subject-matter of claim 1 was not novel in view of document E7 (Art. 54(1) EPC).

139-12-24

10. Article 134 EPC | T 1893/22 | Board 3.5.05

Article 134 EPC

Case Number	T 1893/22
Board	3.5.05
Date of decision	2024.07.16
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 125, 133, 134 EPC
EPC Rules	Rules 076(2), 152 EPC
RPBA	Articles 09, 15(8) RPBA 2020
Other legal provisions	Articles 1161 French Civil Code, L.227-6 French Commercial Code
Keywords	representation – complete and self-contained set of rules on representation – president of opponent company and qualified professional representative – admissibility of opposition
Cited decisions	G 0003/97, J 0015/86
Case Law Book	III.V.1 , IV.C.2.1.1 , IV.C.2.2.4b), 10th edition

In [T 1893/22](#), the proprietor-appellant had requested an enlargement of the board due to the case potentially setting a precedent regarding proper representation in proceedings established by the EPC. The board held that the case did not go beyond what might be handled by a board with an ordinary composition. Mr N, the representative of the opponent, a French company in the form initially of a SASU (société simplifiée unipersonnelle), was the President of the SASU and also a professional representative.

The proprietor had contested the admissibility of the opposition relying on the following points: (i) the opponent's professional representative could not represent the company since he was simultaneously managing the legal entity he represented; (ii) the identity of the opponent was not unequivocally determined; (iii) the opponent carrying out activities reserved to professional representatives without the necessary qualifications circumvented the principles of representation; (iv) the opponent's change of name; (v) the reference in the notice of opposition to the German translation of the claims.

Concerning the representation, the board stated that – contrary to the proprietor's allegations – Art. 133 and 134 EPC together with R. 152 EPC and the Decision of the President of the EPO of 12 July 2007 on the filing of authorisations (OJ SE 3/2007,

128) indeed constituted a complete and self-contained set of rules on representation in proceedings established by the EPC (a request in this respect to refer the question to the Enlarged Board was also submitted by the proprietor). A legal person having its seat in an EPC contracting state is not obliged to be represented by a professional representative (Art. 133(1) EPC). Furthermore, persons whose names appear on the list of professional representatives are entitled to act in all proceedings established by the EPC (Art. 134 EPC). A legal person having its seat in an EPC contracting state can act in proceedings before the EPO through its legal representatives. At the time the opposition was filed, Mr N in his capacity as President of the SASU was entitled to represent the SASU since under French law (Art. L. 227 Commercial Code) he was entitled to act on behalf of the legal person in all circumstances. Mr N as a professional representative would have been entitled to act not only as the president of the SASU, but also as a professional representative appointed by that legal person.

For the sake of completeness, the board detailed why neither the references to French law (Civil Code) nor German law, nor the reference to general principles under Art. 125 EPC could, in its view, prevent the company from appointing Mr N as its professional representative before the EPO.

Regarding the identity of the opponent, the board held that the opposition was clearly filed on behalf of SARL Cabinet NÜ (see the notice of opposition which mentioned the initial legal form of the company "SASU Cabinet NÜ"). The only uncertainty, based on the submissions of the proprietor itself, concerned whether Mr N was representing the opponent as a European patent attorney or in his capacity as the president of that company. Nonetheless, this alleged ambiguity could not raise any doubt about the identity of the opponent.

The alleged circumvention of the law was also rejected by the board, which observed first that this would occur if a person not entitled to act as a professional representative performed all the activities typically carried out by professional representatives while assuming the role of a party, in order to circumvent the prohibition on unqualified representation, but Mr N was a qualified professional representative.

As regards the change of the opponent's name, the board endorsed the analysis set out in the contested decision (Art. 15(8) RPBA). A change of legal form of the company (SASU to SARL) had taken place, which indicated a change of name and not a transfer of assets to a different entity. The use of the old legal form on the company stationery in a submission filed close to the date of change of the legal form did not undermine this. The reference to the German version of the claims did not make the respective attacks incomprehensible. In conclusion, the opposition was admissible and the request for a referral was rejected. The appeal was also dismissed.

140-12-24

11. Article 12(6) RPBA | T 1311/21 | Board 3.4.02

Article 12(6) RPBA 2020

Case Number	T 1311/21
Board	3.4.02
Date of decision	2024.09.12
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(4), 12(6), 13(2) RPBA 2020
Other legal provisions	
Keywords	late-filed request – amendment to case (yes) – should have been submitted in first-instance proceedings (no) – admitted (yes)
Cited decisions	
Case Law Book	V.A.4.3.7f , 10th edition

[See also abstract under Article 117 EPC.](#)


In [T 1311/21](#) the first auxiliary request, which had been first filed as auxiliary request IV with the patentee's statement of grounds of appeal, differed from claim 1 as granted by the addition of two features and the replacement of one feature. These amendments were also present in claim 1 of auxiliary requests 1 to 3 underlying the appealed decision, which however additionally contained further amendments as compared to claim 1 as granted in order to overcome all the objections raised during the opposition proceedings. These additional features had been omitted in claim 1 of the first auxiliary request.

The board observed that the discussion on whether the amendments in the first auxiliary request (compared to claim 1 as granted) extended its subject-matter beyond the content of the application as filed had already taken place in the first-instance proceedings. Moreover, it was not under dispute that the omitted features were not relevant for the question of novelty and inventive step. Therefore, the amendments of claim 1 of the first auxiliary request did not introduce new issues and did not increase the complexity of the examination of the patent. The board further noted that they were not only suitable to address, but actually overcame the objections of added matter. The board concluded that there was no reason not to admit the amendments of claim 1 into the appeal proceedings under Art. 12(4) RPBA.

Regarding Art. 12(6), second sentence, RPBA, the board explained that claim 1 at issue comprised all the amendments required by the opposition division to overcome its objection of added subject-matter against a certain feature of the main request then on file, but omitted all the amendments required by the opposition division to overcome its objection of added subject-matter against two other features. The patentee had argued that the opposition division had decided on all objections of added subject-matter at once and that this would have made the filing of requests that were already decided not to comply with Art. 123(2) EPC a violation of the rules of procedural efficiency. The board pointed out that it followed from this that the patentee could have filed claim 1 during the first-instance proceedings, but not that it should have done so. Indeed, such a filing would have been pointless in view of the fact that the opposition division had already decided that such claim 1 infringed the requirements of Art. 123(2) EPC. The board held that, in the absence of a compelling reason for the patentee to file present claim 1 during the first-instance proceedings, there was no reason for it not to admit the amendments of present claim 1 into the proceedings under Art. 12(6), second sentence, RPBA.

In the end, however, the board did not allow the first auxiliary request as it contained subject-matter which extended beyond the content of the application as filed.

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