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Boards
of Appeal

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Edited by

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Article 016 EPC | J 0011/20 | Board 3.1.01
Article 016 EPC

Case Number	J 0011/20
Board	3.1.01
Date of decision	2024.07.25
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 016, 090(5), 109, 113, 123(2) EPC
EPC Rules	Rules 046, 049, 057, 058 EPC
RPBA	
Other legal provisions	
Keywords	competence of the Receiving Section – formal requirements of the patent application documents – drawings – interlocutory revision
Cited decisions	G 0003/89, G 0011/91, J 0007/83, J 0004/85, J 0033/89, J 0007/97, J 0018/08, J 0004/09, J 0002/12, J 0005/12, J 0008/13, J 0011/15, J 0001/18, J 0010/20, T 0012/03
Case Law Book	IV.A.2 , IV.A.6.3.1 , 10th edition

[See also abstract under Article 113\(1\) EPC.](#)

In [J 11/20](#) the applicant appealed a decision of the Receiving Section refusing their application under Art. 90(5) EPC in conjunction with R. 58 EPC. The sole reason for the refusal was that the four amended drawings filed by the applicant to remedy formal deficiencies in the application documents were not in agreement with the application documents as originally filed and, despite the invitation by the Receiving Section, the applicant had not corrected this deficiency in due time.

In the statement of grounds of appeal, the appellant had objected that the Receiving Section had committed a substantial procedural violation by exceeding its competence when issuing the communication concerning the formal requirements of the application documents by addressing substantive matters that belonged to the competence of the examining division. Thus, the first question addressed by the Legal Board concerned the competence of the Receiving Section and, in particular, whether the Receiving Section had acted ultra vires.

The Legal Board recalled that the Receiving Section was responsible for the examination on filing and the examination as to formal requirements of the

application (Art. 16 EPC). It was established case law that the responsibilities of the Receiving Section did not involve any technical examination of the application (J 5/12, J 7/97, J 33/89 and J 4/85).

Within this framework, the Legal Board explained that the Receiving Section was competent under R. 58 EPC to identify inconsistencies in the application documents which were immediately apparent from the face of the documents, including whether formal discrepancies were present between amended documents and the documents as originally filed, provided no technical knowledge was required.

In the case in hand, the deficiency noted by the Receiving Section was of a purely formal nature and did not involve any assessment in terms of disclosure. Hence, no procedural violation was committed in this respect.

The Legal Board also assessed whether the Receiving Section should have granted interlocutory revision of the appealed decision. The Legal Board referred to J 18/08 and explained that a deficiency on which a decision under Art. 90(5) EPC is based could be corrected at the appeal stage. Such a case was different from the situation where the non-observance of a time limit automatically led to the application being deemed to be withdrawn, i.e. where the legal consequence automatically ensued when an act required within a specific time limit was not performed.

In the case in hand, the Legal Board observed that, when the appeal was filed, the deficiency had already been remedied, albeit late, with the filing of the correct drawings. Considering that the ground for refusal of the application under Art. 90(5) EPC had been remedied, the Legal Board established that the Receiving Section should have granted interlocutory revision in accordance with Art. 109 EPC.

119-11-24

Article 024 EPC | R 0012/22 | Enlarged Board of Appeal

Article 024 EPC

Case Number	R 0012/22
Board	EBA
Date of decision	2023.12.18
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 024 EPC, 112a(2)(c), 113 EPC
EPC Rules	
RPBA	Article 02 RPBA 2020
Other legal provisions	Article 12(1) RPEBA
Keywords	suspicion of partiality – replacement of legal member at short notice – objection raised immediately (no) – violation of the right to be heard (no) – no right to a designated judge – objection reasoned and substantiated (no)
Cited decisions	R 0010/11, R 0005/19,
Case Law Book	III.J.1.4. , III.J.3.2. , 10th edition

[See also abstract under Article 112a\(2\)\(c\) EPC.](#)

In [R 12/22](#) machte die Antragstellerin in ihrem Antrag auf Überprüfung mehrere schwerwiegende Verfahrensmängel geltend, unter anderem, dass die kurzfristige Ersetzung des juristischen Mitglieds im vorliegenden Fall ihr Recht auf rechtliches Gehör unter folgenden Aspekten verletze: (a) mangels Möglichkeit, das Vorliegen der Voraussetzungen von Art. 24 EPÜ im Hinblick auf das neue Mitglied zu untersuchen, (b) wegen fehlender ausreichender Vorbereitungsmöglichkeit des umfangreichen Falles für das neue Mitglied, (c) wegen fehlender Möglichkeit der Stellungnahme der Antragstellerin zur kurzfristigen Ersetzung vor der mündlichen Verhandlung.

Zu (a) stellte die Große Beschwerdekammer (GBK) fest, dass der Anspruch auf rechtliches Gehör auch das Recht umfassen kann, Informationen zu erhalten, um das Recht zu wahren, das neue Kammermitglied gegebenenfalls nach Art. 24 EPÜ abzulehnen. Das Vorbringen der Antragstellerin, sie hätte das Vorliegen der Voraussetzungen von Art. 24 EPÜ wegen der Kürze der Zeit nicht überprüfen können, überzeugte die GBK jedoch nicht, da die Antragstellerin diese Überprüfung in der mündlichen Verhandlung durch Fragen zu der Thematik an das betroffene Kammermitglied hätte nachholen können. Zudem hatte die Antragstellerin in ihrem Überprüfungsantrag auf keinen denkbaren Verstoß gegen Art. 24 EPÜ hingewiesen,

so dass die GBK auch keinen derartigen Sachvortrag auf einen denkbaren Gehörsverstoß überprüfen konnte. Die Antragstellerin hatte zudem argumentiert, dass – auch wenn auf freiwilliger Basis eine Auskunft über ein Kammermitglied erteilt worden wäre – diese in der Kürze der Zeit nicht objektiv nachprüfbar gewesen wäre. Die GBK war von diesem Vortrag nicht überzeugt. Ein Auskunftsrecht bestand nach ihrer Auffassung nur über Umstände, die geeignet sein könnten, eine Ablehnung zu begründen, nicht aber über die Vorbereitung eines Mitglieds auf die mündliche Verhandlung in einem konkreten Fall, da dies mit seiner Unabhängigkeit nicht vereinbar wäre. Ferner müsse es zur Vermeidung der Verzögerung von Verfahren möglich sein, auch kurzfristig eine Kammer im Einklang mit Art. 2 VOBK umzubesetzen. Es reiche aus, dass den Beteiligten die Möglichkeit der Ablehnung eines Mitglieds nach Art. 24 (3) EPÜ wegen eines Ausschließungsgrundes oder wegen Besorgnis der Befangenheit zustehe.

Zu (b), stellte die GBK fest, dass aus dem Recht auf rechtliches Gehör kein Recht eines Beteiligten auf einen Nachweis folgt, dass ein Kammermitglied ausreichend vorbereitet ist, weder im Falle einer kurzfristigen Einwechslung noch generell. Denn die Ausübung eines solchen Rechts würde gegen die Unabhängigkeit des betroffenen Beschwerdekammermitglieds verstoßen. Insbesondere müsse das Mitglied seine Pflichten nach eigenem Gutdünken erledigen können. Die GBK stimmte der folgenden Passage aus R 5/19 zu: "bis zum Beweis des Gegenteils in einem konkreten Fall [kann] davon ausgegangen werden [...], dass Mitglieder von Beschwerdekammern generell ihre Amtspflichten korrekt ausüben [...]."

Auch hinsichtlich (c), d.h. der fehlenden Möglichkeit sich vor der mündlichen Verhandlung zur kurzfristigen Ersetzung zu äußern, sah die GBK keine Bedenken hinsichtlich der Wahrung des rechtlichen Gehörs in einer solchen Situation.

In der mündlichen Verhandlung vor der GBK, machte die Antragstellerin die kurzfristige Ersetzung des juristischen Mitglieds erstmals auch als Gehörsverstoß unter einem weiteren Gesichtspunkt, nämlich demjenigen eines Verstoßes gegen ein "Recht auf den gesetzlichen Richter" geltend. Die GBK stellte fest, dass ein solches Recht im EPÜ und den dieses ergänzenden Vorschriften, insbesondere denjenigen der VOBK, nicht geregelt ist. Art. 2 VOBK regelt Ausnahmen vom Geschäftsverteilungsplan, nämlich die Ersetzung von Mitgliedern bei Verhinderung an der Mitwirkung. Ähnlich wie im Fall des geltend gemachten Informationsrechts betreffend Art. 24 EPÜ hatte die Antragstellerin in der mündlichen Verhandlung vor der Beschwerdekammer ein Recht auf den gesetzlichen Richter nicht geltend gemacht. Sie hatte explizit lediglich die Kurzfristigkeit der Umbesetzung und die damit angeblich verbundene zu knappe Vorbereitungszeit für das neue Mitglied sowie das Fehlen einer Möglichkeit zur Stellungnahme zur Ersetzung vor der mündlichen Verhandlung beanstandet. Das Nichtvorliegen einer Ausnahme nach Art. 2 VOBK hatte die Antragstellerin in der mündlichen Verhandlung nicht geltend gemacht. Daher entschied die GBK, diesen neu geltend gemachten Gehörsverstoß durch Verletzung eines Rechts auf den gesetzlichen Richter als offensichtlich unbegründet zurückzuweisen.

Article 024 EPC | T 2274/22 | Board 3.2.04
Article 024 EPC

Case Number	T 2274/22
Board	3.2.04
Date of decision	2024.05.13
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 019(2), 024 EPC
EPC Rules	
RPBA	Article 11(1) RPBA 2020
Other legal provisions	Article 6(1) ECHR
Keywords	substantial procedural violation (yes) – suspicion of partiality in first instance proceedings – remittal (yes) – new composition of the opposition division
Cited decisions	G 0005/91, G 0001/05
Case Law Book	III.J.1.5. , III.J.4.2. , III.J.4.4. , IV.C.6.1. , 10th edition

In [T 2274/22](#) war ein Mitglied der Öffentlichkeit von Einsprechenden-Seite (Herr T.) vor Eröffnung der mündlichen Verhandlung unbeabsichtigt dem virtuellen Dolmetscher-Besprechungsraum zugeordnet worden, wo er mehr als 10 Minuten mithörte, bevor er die anderen Besprechungsteilnehmer darüber in Kenntnis setzte und ausgeschlossen wurde. Während dieser Zeit kommunizierte Herr T. dem zugelassenen Vertreter der Einsprechenden und seinem Kollegen Details aus dem mitgehörten Inhalt der Vorbesprechung. Kurz nach Eröffnung der mündlichen Verhandlung legte der Vertreter der Einsprechenden den obigen Vorfall offen. Die Patentinhaberin befürchtete eine Benachteiligung und sprach dabei eine Neubesetzung der Einspruchsabteilung an. Die Einsprechende stellte daraufhin mit einem Kurzprotokoll die erhaltenen Informationen schriftlich zur Verfügung. Die Patentinhaberin war der Auffassung, diese gingen entgegen der Aussage des Vorsitzenden über den Inhalt des Ladungszusatzes hinaus, und beantragte schriftlich die Ablehnung der Einspruchsabteilung wegen Besorgnis der Befangenheit.

Zur Frage, ob ein schwerwiegender Verfahrensfehler im Vorfeld der mündlichen Verhandlung begangen wurde, erläuterte die Kammer, die Anwesenheit einer Partei in einer Vorbesprechung zwischen einem oder mehreren Mitgliedern einer Einspruchsabteilung und den Dolmetschern stelle grundsätzlich einen Verfahrensfehler dar, unabhängig davon, ob dieser durch einen technischen oder menschlichen Fehler verursacht geworden sei. Ein solcher Verfahrensfehler müsse aber nicht zwangsläufig in einen schwerwiegenden münden. Vielmehr könne er

dadurch geheilt werden, dass die abwesende Partei vor Eröffnung der sachlichen Debatte auf den gleichen Kenntnisstand wie die anwesende gebracht werde.

Nach Ansicht der Kammer konnte allein die Anwesenheit von Herrn T. beim Dolmetscher-Briefing auch keine Besorgnis der Befangenheit der Einspruchsabteilung begründen. Denn, da die Zuschaltung eines Parteivertreters in den virtuellen Besprechungsraum vorliegend unstreitig versehentlich erfolgt sei, und die Einspruchsabteilung sie umgehend beendet habe, sobald sie ihrer gewahr wurde, bestehe objektiv kein Verdacht, die Einspruchsabteilung habe hier willentlich für eine Bevorzugung der Einsprechenden gesorgt oder diese billigend in Kauf genommen. Jedoch sei die Tatsache, dass die Einspruchsabteilung den Vorfall nicht von sich aus angesprochen und der Patentinhaberin mitgeteilt habe, dazu geeignet, bei der Patentinhaberin den Eindruck einer Parteilichkeit zu erwecken. Dass die Einspruchsabteilung sich zudem auch nach Intervention der Einsprechenden, die ausdrücklich auf einen möglichen Verfahrensfehler hingewiesen hatte, nicht aktiv an der Aufklärung des Vorfalls beteiligte, sondern den Vorschlag der Einsprechenden, eine schriftliche Zusammenfassung einzureichen, abwartete und diesem lediglich zustimmte, könne einen solchen Eindruck noch verstärken. Dass eine inhaltliche Auseinandersetzung der Einspruchsabteilung mit dem Kurzprotokoll ausgeblieben sei, stelle aus Sicht eines objektiven Beobachters einen weiteren Umstand dar, der zum Anschein ihrer Befangenheit beitrage.

Die Kammer rief in Erinnerung, dass Besorgnis der Befangenheit bereits dann gegeben ist, wenn objektive Anhaltspunkte dafür vorliegen, auch wenn andere Tatsachen dagegensprechen mögen. Vorliegend war nach Ansicht der Kammer eine Befangenheit der Einspruchsabteilung objektiv zu besorgen, da diese keine der aufgetretenen Gelegenheiten ergriffen hatte, die Patentinhaberin selbst über den Vorfall zu informieren und selbst zu dessen Aufklärung beizutragen. Daher hätte dem Antrag der Patentinhaberin auf Ablehnung ihrer Mitglieder analog zu Art. 24(3) EPÜ stattgegeben und die Einspruchsabteilung neu besetzt werden müssen.

Die Kammer kam zu dem Schluss, dass die angefochtene Entscheidung nicht von der Einspruchsabteilung in ihrer ursprünglichen Besetzung hätte getroffen werden dürfen. Dass dies dennoch geschah, stelle einen schwerwiegenden Verfahrensmangel dar, der zur Aufhebung der angefochtenen Entscheidung und zur Zurückverweisung des Falls an eine neu zu besetzende Einspruchsabteilung führe. Darauf wie groß der ursprüngliche Fehler war, komme es in der Regel nicht an, wenn er letztlich ursächlich für einen wesentlichen Verfahrensmangel gewesen sei. Entscheidend sei allein, dass der aus ihm resultierende Verfahrensmangel als so schwerwiegend eingestuft wird, dass er zu einer Zurückverweisung führt. Dies sei vorliegend der Fall. Die Kammer wies zuletzt darauf hin, dass wegen der räumlichen Distanz und nur mittelbaren Präsenz in einer Videokonferenz, hier ein "schlechter Eindruck" zudem schneller entstehen könne und somit auch die Schwelle sinke, ab der eine Befangenheit befürchtet werden könne. Daher seien an eine ordnungsgemäße Verhandlungsführung und insbesondere den Umgang mit technischen Pannen hohe Maßstäbe anzulegen.

087-08-24

Article 024 EPC | R 0004/24 | Enlarged Board of Appeal

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

Article 024 EPC | T 2175/15 | Board 3.4.02
Article 024 EPC

Case Number	T 2175/15
Board	3.4.02
Date of decision	2024.06.11
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 024 EPC
EPC Rules	
RPBA	Article 13(1) and (3) RPBA 2007 Article 15(4) RPBA 2020
Other legal provisions	
Keywords	suspicion of partiality – suspected partiality of a board member – objectively justified fear of partiality (no) – arbitrary procedural action (no)
Cited decisions	G 0001/05
Case Law Book	III.J.3.1 , III.J.3.3 , III.J.5.3.4 , 10th edition

[See also abstract under Article 104\(1\) EPC on the parallel decision T 2175/15.](#)

Die Zwischenentscheidung [T 2175/15](#) vom 11. Juni 2024 behandelt den ersten von insgesamt fünf Befangenheitsanträgen. Zur Begründetheit des Befangenheitsantrags, stützte die Einsprechende auf Umstände, die ihrer Ansicht nach eine objektiv berechnete Besorgnis der Befangenheit begründeten, und die daher im Rahmen einer objektiven Prüfung zu beurteilen waren (mit Bezug auf G 1/05).

Die Einsprechende sah als maßgebliches, die objektive Besorgnis der Befangenheit der Mitglieder der Kammer in ihrer ursprünglichen Besetzung begründendes Verhalten die Zulassung des Hilfsantrags I bei gleichzeitiger Vertagung der mündlichen Verhandlung an. Hierdurch habe die Kammer willkürlich den insofern eindeutigen Wortlaut von Art. 13 (3) VOBK 2007 ignoriert, demzufolge "Änderungen des Vorbringens [...] nach Anberaumung der mündlichen Verhandlung nicht zugelassen [werden], wenn sie Fragen aufwerfen, deren Behandlung der Kammer oder dem bzw. den anderen Beteiligten ohne Verlegung der mündlichen Verhandlung nicht zuzumuten ist". Die Kammer war jedoch nicht davon überzeugt, dass die Kammer in der mündlichen Verhandlung im eröffneten Anwendungsbereich des Art. 13 (3) VOBK 2007 gehandelt hatte.

Es sei bei verständiger Würdigung des Protokolls der mündlichen Verhandlung keineswegs ersichtlich, dass auch die zweite Voraussetzung in Art. 13 (3) VOBK 2007 – nämlich dass durch die Änderung des Vorbringens Fragen aufgeworfen wurden, "deren Behandlung der Kammer oder dem bzw. den anderen Beteiligten ohne Verlegung der mündlichen Verhandlung nicht zuzumuten ist" – von der Kammer bejaht wurde, auch wenn laut Protokoll diese Voraussetzung tatsächlich diskutiert wurde. Obwohl an einigen Stellen im Protokoll Art. 13 (3) VOBK 2007 ausdrücklich zitiert worden war, hatte die Kammer am Ende der mündlichen Verhandlung ihre Entscheidung über die Zulassung des Hilfsantrags "in Ausübung ihres Ermessens nach Artikel 13 VOBK 2007" verkündet und damit die Anwendung von Art. 13 (3) VOBK 2007 offengelassen. Die Zulassung des Hilfsantrags konnte aber auch auf Grundlage des während der mündlichen Verhandlung ebenfalls erörterten Art. 13 (1) VOBK 2007 erfolgen.

Die Kammer stellte fest, dass es im freien und grundsätzlich nicht überprüfbareren Ermessen eines Vorsitzenden stehe, die mündliche Verhandlung auch ohne rechtliche Notwendigkeit zu vertagen, um eine "faire, ordnungsgemäße und effiziente Durchführung der mündlichen Verhandlung" sicherzustellen (s. Art. 15 (4) VOBK). Mögliche Gründe für eine solche Vertagung seien beispielsweise ein Entgegenkommen gegenüber einem Beteiligten, der ein entsprechendes Bedürfnis geäußert hat, die Ermöglichung eines wohl vorbereiteten Vortrags von ausstehenden Fragen zur Steigerung der Effizienz des Verfahrens, (drohende) zeitliche Engpässe oder etwa die Vermeidung oder Beendigung von Konfliktsituationen. Aus Sicht eines objektiven Betrachters erscheine es ohne Weiteres möglich, dass die Kammer die mündliche Verhandlung aus einem der genannten Gründe vertagt hatte.

Somit stand für die erkennende Kammer nicht mit hinreichender Wahrscheinlichkeit fest, dass die Kammer in ihrer ursprünglichen Besetzung gerade in Anwendung von Art. 13 (3) VOBK 2007 den Hilfsantrag zugelassen und die mündliche Verhandlung vertagt hatte. Darüber hinaus erkannte die erkennende Kammer keine hinreichenden Anhaltspunkte für ein willkürliches Verhalten der als befangen abgelehnten Kammermitglieder, das die objektive Besorgnis der Befangenheit begründen könnte. Aus Sicht eines objektiven Betrachters könnte ein Indiz für willkürliches Verhalten gegeben sein, wenn eine Kammer eine Rechtsanwendung entgegen dem Wortlaut einer Vorschrift vornimmt, ohne dies in irgendeiner Weise hinreichend nachvollziehbar zu erläutern, sozusagen "aus einer Laune heraus". So verhält es sich aber vorliegend gerade nicht. Vielmehr hat die Kammer in der mündlichen Verhandlung ausweislich des Protokolls mehrere Gründe angegeben, warum sie der Ansicht war, dass sie – auch im Falle der Anwendung von Art. 13 (3) VOBK 2007 – ein Ermessen zur Zulassung von verspätetem Vorbringen habe, selbst wenn es hierdurch zu einer Vertagung der mündlichen Verhandlung komme. Da der Befangenheitsantrag der Einsprechenden jedenfalls unbegründet sei, konnte die Frage der Zulässigkeit des Befangenheitsantrags offen bleiben.

141-13-24

Article 052 EPC | T 1465/22 | Board 3.2.07
Article 052 EPC

Case Number	T 1465/22
Board	3.2.07
Date of decision	2024.05.23
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 052 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	patentable invention – method for performing mental acts
Cited decisions	
Case Law Book	I.A.6.6.2 , 10th edition

In [T 1465/22](#) the appellant (opponent) had contested the opposition division's findings that although the method steps of claim 1 could be carried out manually, this did not render them non-technical, as the performance of a manual activity was not a purely mental act. According to the appellant, the method steps in features 1.2 to 1.8 of claim 1 were merely instructions to a user that could be carried out manually. In particular features 1.5.1 and 1.7 did not require that the steps were actually carried out, so that they remained instructions which were purely mental acts and therefore non-technical (Art. 52(2)(c) EPC). The appellant had argued that only feature 1.1 could be considered to be a technical feature and that this feature was well-known from the skilled person's common general knowledge (as shown in D1), so that the subject-matter of claim 1 of the main request was not inventive.

The board agreed with the opposition division that at least some of the method steps of claim 1 might be carried out manually, but that this did not lead to these method steps being "schemes, rules and methods for performing mental acts" as set out in Art. 52(2)(c) EPC. A method for performing mental acts requires that the method be performed entirely within the human brain. According to the established case law, subject-matter is excluded from patentability if the claim is not restricted to physical, technical implementations, i.e. if it is not excluded that the claimed invention may be carried out mentally. As the respondent (patent proprietor) argued, the features of claim 1 inter alia of "inserting, extracting, transferring, juxtaposing and capping" could not be considered to be purely mental acts. They required concrete handling of containers, nests, a transport tub, a substance, a stopper and a cap. It could not be

seen how any of these steps could possibly be achieved purely through mental activity.

The appellant's further argument that a user might not actually carry out the steps of the method, as the method steps were merely instructions, was not convincing either. The board noted that claims to methods were clearly allowed under the EPC (G 2/88). Any method claim requires that the steps are indeed carried out (whether manually, automatically or in a combination of both) and not just given to a user as instructions, otherwise the user would not be working within the scope of the claim. The board held that this applied also to method steps 1.2 to 1.8 of claim 1. Therefore, the appellant had not convincingly demonstrated that the subject-matter of claim 1 was not inventive in view of the skilled person's common general knowledge alone.

097-09-24

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

Article 054 EPC | T 1356/21 | Board 3.3.07

Article 054 EPC

Case Number	T 1356/21
Board	3.3.07
Date of decision	2023.10.05
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 054 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	novelty – second medical use – dosage regime – purpose-limited product claims
Cited decisions	G 0002/08, T 1074/06
Case Law Book	I.C.7.2.4e , 10th edition

[See also abstract under Article 056 EPC.](#)

In [T 1356/21](#) claim 1 of the main request pertained to an aqueous pharmaceutical formulation characterised in particular in that "the concentration of insulin glargine is 270-330 U/mL being equimolar to 270-330 IU human insulin". This feature of claim 1 defined the concentration of insulin glargine in the composition, expressed as (international) units (U or IU). Claim 11 was identical to claim 1 with the addition of "for use in the treatment of Type I and Type II Diabetes Mellitus in a patient". Claim 23, pertaining to the "aqueous formulation according to any of the foregoing claims for use in the treatment of Type 1 Diabetes Mellitus and Type 2 Diabetes Mellitus", related to the same subject-matter as claim 11. Thus, both claims 11 and 23 were drafted in the format of Art. 54(5) EPC, i.e. as claims directed to the same composition as in claim 1 for a specific use in a method referred to in Art. 53(c) EPC.

According to the appellant, the subject-matter of claims 11-23 of the main request lacked novelty over D12, because the insulin glargine concentration defined in said claims fell within the broad meaning of the term "dosage regimen" as used in G 2/08, and yet was not characterised by any technical effect that would be particular to said sub-range compared to other concentrations within the range disclosed in D12. The appellant did not, however, object to the novelty of claim 1.

The board held that the fact that the compositions of claims 11 and 23 were limited, in comparison with claim 1, by the feature pertaining to their specific use in a method of treatment of Type I or II Diabetes Mellitus, did not entail that the features pertaining to the concentration of insulin glargine should no longer be regarded as defining the composition, but merely its use. Neither decision G 2/08 nor its reference to T 1074/06 (where the claims related to doses, and not concentration) justified reading the word "concentration" of claims 11 and 23 as a dosage regimen. In claims 11 and 23 just as in claim 1, the concentration feature defined the composition itself, i.e. the amount of insulin glargine in the composition, and not the use of the composition, i.e. the dose given to a patient at particular times or time intervals. This concentration feature thus established novelty for the subject-matter of claims 11 and 23 for the same reasons as for claim 1.

Additionally, considering the case law in the general situation of selections from numerical ranges, the board was not convinced by the appellant's argument that in the case of purpose-limited product claims pursuant to Art. 54(5) EPC relying on a dosage regimen defined by a numerical range, a selection from the prior art must be purposive for it to be novel.

In point 6.3 of G 2/08 the Enlarged Board of Appeal had stated that "the claimed definition of the dosage regime must therefore not only be verbally different from what was described in the state of the art but also reflect a different technical teaching". However, under the same point of the Reasons the Enlarged Board of Appeal explained that "for the assessment of novelty and inventive step of a claim in which the only novel feature would be the dosage regimen, the whole body of jurisprudence relating to the assessment of novelty and inventive step generally also applies". In the board's view, this indicated that G 2/08 did not seek to establish different novelty criteria for numerical ranges in the case of dosage regimen. Thus, the case law in the general situation of numerical ranges, as it has evolved over the years, must apply also in the case of dosage regimen. Consequently, the appellant's objection had to fail for the additional reason that, even if the concentration features of claims 11 and 23 were *arguendo* seen as a dosage regimen, the former criterion of a purposive selection should no longer be regarded as a requirement under G 2/08 for a dosage regimen to represent a novel selection from a broader range known in the prior art. Accordingly, the claimed subject-matter was novel.

001-01-24

Article 054 EPC | T 1252/20 | Board 3.3.10
Article 054 EPC

Case Number	T 1252/20
Board	3.3.10
Date of decision	2024.02.06
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Ex parte
EPC Articles	Articles 053, 054 EPC
EPC Rules	
RPBA	
Other legal provisions	Guidelines for Examination G-VI, 7.1
Keywords	novelty – second medical use – substance or composition
Cited decisions	G 0005/83, T 1020/03, T 2003/08, T 1758/15
Case Law Book	I.C.7.2.4 , 10th edition

In [T 1252/20](#) claim 1 of the applicant's main request related to "a composition for use in reducing or eliminating cancerous cells" by blocking the blood supply to the tumour. The claim defined the composition as a peptide solution forming a hydrogel once inside the body. The peptide was defined by its specific amino acid sequence. The examining division had set out in its decision, that the peptide solution did not constitute a "substance or composition" according to Art. 54(4) and (5) EPC. Referencing the Guidelines for Examination (G-VI, 7.1) as well as T 1758/15, according to which, if the therapeutic effect of a product is based exclusively on the "macroscopic 3D-structure formed by a composition once inside the body", the product should be considered a device, the examining division found that the peptide hydrogel had a physical mode of action and was thus a device and not a substance or composition.

The board held that whether a material or an object is a substance or composition in the sense of Art. 53(c) and 54(4) or (5) EPC should be decided, in the first place, on the basis of the claimed material or object as such. The claim at hand does not define the material by any technical features which would be characteristic for a device, e.g. its shape. When the material is administered to the patient, the material does not yet have the crucial shape of the plug fitting to the blood vessel, which will in the end, result in the therapeutic effect aimed at. Thus, the material defined in the claim is evidently a "substance or composition". It is a shapeless liquid mixture of chemical entities and, already for this reason alone, it is not a device.

The board decided to depart from previous case law, which distinguished between substance or composition and device based on the "mode of action" of the claimed product in question, since it saw no legal basis for it. The previous case law (T 2003/08, T 1758/15) had taken G 5/83 as a starting point. However, the board held that Art. 54(4) and (5) EPC are not limited to therapeutic applications, but also cover surgical and diagnostic uses, unlike G 5/83. Moreover, the mode of action as the relevant criterion for judging whether a material is a "substance or composition" was not derivable from G 5/83 according to the board. The case underlying G 5/83 had related to the use of a specific chemical compound, so the definition of "substance or composition" and generally the scope of this expression had not been addressed in the decision in any detail. Furthermore, for the Enlarged Board, the subject-matter deserving protection was the invention that the known substance could be used for new therapies. This was fully comparable to the case in question. Taking the mode of action as the decisive criterion was also deemed problematic by the board for several reasons:

Firstly, the material defined in the claim and the material acting inside the body may differ in composition or in some other relevant property. However, second medical use claims are directed to the substance as administered. Since it is this substance which is used in a method excluded under Art. 53(c) EPC, such claim drafting is entirely in line with Art. 54(4) and (5) EPC.

Secondly, the mechanism of action may not be understood in detail and knowing the mechanism of action is not required under the EPC (point 10.2 of the Reasons).

Thirdly, a material may behave in different ways according to its mode of administration. It then appears odd to classify the material according to extrinsic factors not related to the material itself, but to its way of administration.

Lastly, the result of a restriction based on the mode of action does not achieve the legislative purpose behind Art. 54(4) and (5) EPC (similarly in T 1020/03).

The board noted that distinguishing devices from substances for the purposes of Art. 54(5) EPC was required, and this article should not be used to circumvent the usual assessment of novelty of devices. A pacemaker or a surgical scalpel made of a particular stainless steel alloy do not qualify as a "substance or composition", even if they are claimed for use in an arguably novel therapeutic or surgical method. However, there was no apparent reason to disqualify a solution of a peptide without any device-like features, from the scope of Art. 54(5) EPC. The board held that whether a material or an object is a substance or composition in the sense of Art. 53(c) and 54(4) or (5) EPC should be decided, in the first place, on the basis of the claimed material or object as such. If this analysis leads to the conclusion that indeed a substance or composition is present, this requirement of Art. 54(4) or (5) EPC is fulfilled. No additional restrictions relating to its mode of action are derivable from the EPC.

039-04-25

Article 054 EPC | T 0989/22 | Board 3.3.05
Article 054 EPC

Case Number	T 0989/22
Board	3.3.05
Date of decision	2024.04.25
Language of the proceedings	FR
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 054 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	novelty – selection from a range – multiple selections – gold standard – direct and unambiguous disclosure
Cited decisions	G 0001/03, G 0002/10, T 26/85, T 666/89, T 1634/13, T 0261/15, T 0900/18, T 2623/19, T 1688/20
Case Law Book	I.C.6.3.2 , 10th edition

Dans l'affaire [T 989/22](#), la requérante avait soumis un tableau comparant la revendication 1 du brevet attaqué à la divulgation de D10. Il ressortait de ce tableau et du tableau de la décision attaquée qu'il n'y avait pas de divulgation directe et sans équivoque dans D10 d'un alliage ayant une composition telle que définie dans la revendication 1 du brevet attaqué. Pour arriver à un tel alliage la personne du métier aurait dû faire plusieurs choix parmi les plages et valeurs spécifiques divulguées dans D10, ce qui n'était pas considéré comme une divulgation directe et sans équivoque. La combinaison de différentes valeurs limites de différentes plages de valeurs n'était pas considérée comme divulguée (voir T 900/18, citant T 1634/13). En outre les plages de valeurs ne devaient pas être comparées séparément mais ensemble (voir T 2623/19, citant T 261/15).

La chambre rappelle que le critère à appliquer pour évaluer la nouveauté de plages de valeurs est la divulgation directe et sans équivoque (voir T 1688/20, citant G 1/03 et G 2/10). Le concept "d'envisager sérieusement" cité par la requérante a été initialement décrit dans la décision T 26/85 et repris dans la décision T 666/89 et utilisé dans beaucoup d'autres décisions concernant le recoupement de domaines (Jurisprudence des chambres de recours, 10e édition, 2022, I.C.6.3.2). Dans la décision T 666/89, la chambre a estimé que le concept "d'envisager sérieusement"

était un concept de la nouveauté. La chambre a cependant noté que, comme indiqué ci-dessus, entre-temps il est bien établi que la divulgation directe et sans équivoque est le critère incontestable pour l'évaluation de la nouveauté. La chambre est d'avis que le concept "d'envisager sérieusement" implique que la personne du métier doit évaluer si l'enseignement technique du document antérieur est à appliquer dans la plage de valeurs commune (voir T 26/85 et T 666/89) ce qui est, de l'avis de la présente chambre, directement lié à l'effet recherché. C'est pourquoi le concept "d'envisager sérieusement" est difficilement conciliable avec le critère primordial d'une divulgation directe et sans équivoque dans le cas de multiples plages de valeurs.

Il est aussi à noter que dans l'affaire T 26/85, la chambre avait conclu que la nouveauté était donnée car l'état de la technique dissuadait clairement l'homme du métier de travailler dans la plage de valeurs revendiquée.

Dans le cas d'espèce, même si le critère "d'envisager sérieusement" était accepté contrairement à ce qui a été écrit ci-dessus, il aurait été à noter que tous les alliages selon l'invention de D10 donnés à titre d'exemples avaient des concentrations de Mg > 0,7 et Li > 1 en % en poids. Il semblait peu probable qu'une personne du métier envisage alors sérieusement de travailler à des concentrations plus basses.

L'objet de la revendication 1 et des revendications 2 à 15, incorporant directement ou indirectement l'objet de la revendication 1, étaient donc nouveaux.

075-07-24

Article 056 EPC | T 1356/21 | Board 3.3.07

Article 056 EPC

Case Number	T 1356/21
Board	3.3.07
Date of decision	2023.10.05
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (yes) – bonus effect (no) – limits to the application of the concept of bonus effect
Cited decisions	T 0021/81, T 0192/82, T 0227/89, T 0506/92, T 1317/13, T 1147/16
Case Law Book	I.D.10.8. , 10th edition

[See also abstract under Article 54 EPC.](#)

In [T 1356/21](#) the differentiating feature of the invention, namely the increase in insulin glargine concentration from 100 U/mL to 270-330 U/mL, lead to two types of technical effects: reduced discomfort or pain (due to reduced volume of injection), and flatter PK/PD profile, longer duration of action. The parties differed as to which of the two effects should be taken into account in the assessment of inventive step.

In the board's view, both effects were mentioned in the patent and were credibly achieved by the claimed subject-matter in comparison with the closest prior art embodiment. Accordingly, the technical problem was to be formulated objectively, taking into account both effects, as the provision of an improved aqueous pharmaceutical formulation of insulin glargine, i.e. the improvement being both a flatter exposure and flatter biological profile together with a longer duration of action, and a reduced discomfort.

According to the appellant (opponent), the reduction in the injection volume was the relevant effect, and was, as acknowledged in the patent, the purpose for increasing insulin glargine concentration in the first place. The additional effect of the concentration-dependent change of the PK/PD profile would be inevitably achieved as the result of increasing the insulin glargine concentration for the purpose of reducing the injection volume, and would thus represent a mere bonus effect.

The board disagreed. According to established case law, an effect which might be said to be unexpected could be regarded as an indication of inventive step. However, certain preconditions had to be met (see Case Law of the Boards of Appeal, 10th edition, 2022, I.D.10.8; in particular T 21/81 and T 506/92).

In the board's view, the case law on bonus effects could not be applied to all situations where a given differentiating feature lead to (or inevitably achieved) two separable technical effects, one of which may be expected. For an additional, unexpected effect to be disqualified as a mere bonus effect, it had to be shown either that the situation was characterised by a lack of alternatives as regards the means for achieving the first, expected improvement (i.e. a "one-way-street" situation as explained in T 192/82), or that, considering the relative technical and practical importance of the effects in the circumstances of the case, the additional unexpected effect was merely accidental (following T 227/89 and T 1147/16). In situations which did not qualify as a "one-way street", the board did not consider it appropriate that a crucial and unexpected technical advantage be disregarded in the assessment of inventive step as soon as any additional obvious effect was mentioned in the patent.

The board was aware of the view expressed in T 1317/13 that a "one-way-street" situation was not a mandatory prerequisite for the application of the principle established in T 21/81. However, neither T 1317/13 nor T 21/81 offered a basis for an unqualified application of the bonus effect case law to any situation of plurality of technical effects without regard to their respective technical and practical importance. The board's view in this regard was in agreement with the statement in T 192/82 that the use of means leading to some expected improvements might well be patentable if relying on an additional effect, provided this involved a choice from a multiplicity of possibilities.

The board considered that the present case did not qualify as a "one-way-street" situation; the skilled person could have addressed the issue of discomfort caused by the injection of larger volumes of the formulation by other means than an increased concentration. Furthermore, the effects of flatter PK/PD profiles and longer duration of action could not be regarded as merely accidental, but instead represented crucial advantages in the context of basal insulins. Lastly, in the board's opinion, it would also not be appropriate to disqualify the effect of flatter PK/PD profiles and longer duration of action as accidental, i.e. as being of lesser technical and practical importance, on account that these effects may be the result of a serendipitous discovery. What mattered was not in what circumstances the inventors realised the invention, but what the invention achieved. Thus, in the circumstances of the present case, the technical effects of flatter PK/PD profiles and longer duration of action could not be regarded as accidental and had to be taken into account. Similarly, the board was not convinced that the effect of reduced discomfort and injection volume should be regarded as a bonus effect either.

For the reasons given above, the board found that the fact that two technical effects arose from the same distinguishing feature did not mean that one of the two effects necessarily had to be regarded as a bonus effect.

Article 056 EPC | T 1806/20 | Board 3.5.01
Article 056 EPC

Case Number	T 1806/20
Board	3.5.01
Date of decision	2023.11.17
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 – mixture of technical and non-technical features – logistics
Cited decisions	T 1194/97, T 0424/03
Case Law Book	I.D.9.2.16 , 10th edition

In [T 1806/20](#) the invention claimed in the main request concerned a parcel delivery system that sought to prevent damage to water-sensitive parcels by avoiding delivery to rainy destinations. A delivery vehicle is equipped with a satellite navigation system, for example within a tablet (not claimed), that is connected to a remote server. The system calculates a route for the delivery destinations of the parcels on board and acquires weather forecasts for the areas at these destinations at the estimated arrival times. Although not explicitly claimed, the application disclosed that these steps were performed by the remote server, which provided the calculated route, the weather forecasts and each parcel's water sensitivity feature to the satellite navigation system. Each parcel had an RFID tag that stored its delivery destination and a water-sensitivity feature. Although the appellant had argued that the water-sensitivity features in the RFID tags were uploaded to the server, this was neither claimed nor disclosed. Instead, the board understood, in light of the application, that the remote server stored the parcels' water-sensitivity features independently of the RFID tags and performed all processing using the internally-stored features. The navigation system guided the driver along the received route and if rain was expected at a delivery destination for a water-sensitive parcel, the navigation system provided a warning message to the driver and rescheduled the delivery of the parcel to another time during the same day or to the following day, provided that no rain was expected for that time or day.

The board agreed with the examining division, that the distinguishing features implemented a non-technical logistics scheme, which the appellant did not dispute.

The point of dispute was whether the rescheduling of the delivery based on the parcels' sensitivity to water and the rain forecast also formed part of this non-technical logistics scheme. The board was not convinced by the argument that information about a parcel's water-sensitivity was functional technical data in the sense of decisions T 1194/97 and T 424/03, because its loss would impair the technical operation of the system (T 1194/97).

It was self-evident that if a piece, either technical or non-technical, of any invention is taken out, it would not work as designed. In the board's view, what T 1194/97 was saying was rather that the loss of functional data would make the system inoperable at the technical level. In contrast, if cognitive data was lost, the system would still work but possibly produce results that would be unintended for non-technical reasons. Thus, in T 1194/97, the loss of functional data had prevented the system from generating any television picture, whereas the loss of cognitive data only resulted in a meaningless television picture resembling snow.

In the present case, the loss of water-sensitivity information would not cause the system to stop working; the vehicle would still be guided, and parcels would be delivered. However, it would result in leaving water-sensitive parcels standing in the rain – an unintended operation comparable to producing a television picture that resembles snow. The reasons why these outcomes are unintended are non-technical. In T 1194/97, it was the cognitive meaninglessness of the television picture to a human viewer; in the present case, it was the prevention of rain damage to a parcel. Hence, judged by the consequence of its loss, the water-sensitivity data was equivalent to cognitive rather than functional data.

Applying the Comvik approach, once the business requirement had been given to the skilled person to implement, enhancing the server to calculate routes including multiple parcel destinations and acquiring rain forecast for those destinations would have been obvious. It would also have been obvious to store the parcels' water-sensitivity features at the server and to adapt it to reschedule parcel delivery in case of rain. The use of RFID tags to store features of parcels would also have been obvious in view of the prior art. Hence, claim 1 of the main request lacked an inventive step.

003-01-2024

Article 056 EPC | T 0302/19 | Board 3.5.06
Article 056 EPC

Case Number	T 0302/19
Board	3.5.06
Date of decision	2023.12.21
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 – mixture of technical and non-technical features – automation
Cited decisions	
Case Law Book	I.D.9.2.4 , 10th edition

In [T 302/19](#) the examining division considered claim 1 as being a straightforward automation of a known manual practice of a laboratory assistant.

The board held that for such an argument to succeed, it should be clear what the alleged manual practice is, it should be convincing that it was indeed an existing practice at the relevant date and that it would have been obvious to consider automating it. It held that a clear description of the alleged manual practice – in particular of the concrete steps allegedly performed by a laboratory assistant – had not been sufficiently provided by the examining division.

While it appeared to be uncontested that the trypan blue dye exclusion test was the basis of a common manual practice for assessing the viability of cells in a sample at the relevant date, the board was unconvinced, on the basis of the available evidence, that it was part of that practice, to determine the viability of any given cell by first attempting to determine it based on a first focus plane and, if the cell appeared to be dead on the basis of that first focus plane, to try again based on a second focus plane. The board considered that the quoted prior art D6 did not establish the existence before the relevant date of a manual practice as described by the examining division. It furthermore held, that automating the manual practice described in the prior art D10 would have been an obvious aim, but the skilled person would thereby not have arrived at the invention. According to the board, even consideration of the teaching of D6 in the course of devising an automated version of

the manual practice described in D10 would not have led the skilled person to the invention.

004-01-24

Article 056 EPC | T 1959/20 | Board 3.5.01
Article 056 EPC

Case Number	T 1959/20
Board	3.5.01
Date of decision	2023.11.09
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 – mixture of technical and non-technical features – implementation of non-technical requirements
Cited decisions	
Case Law Book	I.D.9.2.9 , 10th edition

In [T 1959/20](#) the invention concerned the automatic deletion of messages in group chats, for example in the context of social networks. In particular, the goal was to implement an "ephemeral group chat", that is, a chat whose messages are automatically deleted when a certain condition is met, for example, when a message has been viewed for a certain amount of time by all recipients. To achieve this, the invention defined a system in which several client devices exchange messages via a central server system. Chat messages entered at a client device are provided to the server, which forwards them to all the intended recipients. When a triggering event occurs (for example, a recipient has viewed the message for the predetermined amount of time), the recipient's client device sends a message ("chat monitoring information") back to the server. Having received chat monitoring information from all the recipients, the server determines that the deletion triggering condition has been met and sends, to the client devices, a message indicating that the message be deleted.

The board judged that the feature of deleting all copies of a message after it has been read by all recipients was not based on technical considerations. Nor did it solve a technical problem. Rather, it was a non-technical requirement expressing a user's wish or subjective preference. Indeed, the claim was even more general than this, as it did not specify the content of the deletion trigger information, or the corresponding event. Following the established case law of the Boards of Appeal, non-technical features do not contribute to inventive step but may instead appear in

the formulation of the technical problem, in particular as constraints or requirements to be achieved. Accordingly, the board formulated the technical problem as how to implement the requirement of deleting all copies of a chat message based on the occurrence of an event in all client devices, such as the message having been read by all participants.

The board recognised that the implementation of non-technical requirements on a technical prior art system might require modifications which, at first glance, appear non-obvious, as there is no technical reason for them in view of the prior art alone. However, since according to the principles of "Comvik" non-technical features cannot contribute to inventive step, the non-technical requirements must be seen as a given, and the skilled person implementing them must make the necessary modifications to the prior art. For these reasons, the board concluded that claim 1 lacked an inventive step over the prior art.

005-01-24

Article 056 EPC | T 0852/20 | Board 3.3.02
Article 056 EPC

Case Number	T 0852/20
Board	3.3.02
Date of decision	2023.11.27
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 (no) – post-published evidence taken into account (no) – purported technical effect derivable from application as originally filed (no)
Cited decisions	G 0002/21
Case Law Book	I.D.4.3.3 , 10th edition

In [T 852/20](#) the board addressed the issue of whether post-published experimental data could be used to demonstrate a technical effect that was not explicitly derivable from the application as filed.

In the impugned decision, the opposition division had rejected the opposition filed against the patent, concluding that the subject-matter of the claims according to the main request involved an inventive step. In arriving at this conclusion, the opposition division had taken into account an effect evidenced by post-published data.

The post-published experimental data in question comprised two tables filed by the patent proprietor (respondent) during the examination phase. These tables showed that Form 1 of vemurafenib exhibited increased water solubility and bioavailability in comparison with Form 2. The opposition division had relied on these data to formulate the objective technical problem as providing an improved form of vemurafenib with the aim of overcoming known solubility issues.

The appellant (opponent) did not dispute that the experimental data demonstrated increased water solubility and bioavailability achieved by Form 1 of vemurafenib compared with Form 2; however, it contested that the post-published experimental data could be used as the sole basis to demonstrate this effect, since this effect was not derivable from the application as filed.

The board considered order no. 2 of G 2/21, and determined that the question to be answered in the present case was thus whether the effect relied upon by the respondent and demonstrated in the post-published experimental data could be derived by the skilled person, having the common general knowledge in mind and based on the application as filed, as being encompassed by the technical teaching and embodied by the same originally disclosed invention.

The board concluded that the purported technical effect of increased water solubility and bioavailability of Form 1 over Form 2 was not disclosed or taught anywhere in the application as filed. By no means could the skilled person derive from the application as filed that one particular crystalline form, namely the claimed Form 1, had good solubility and bioavailability, let alone solubility and bioavailability that was better than that of another crystalline form (Form 2).

It followed that, based on the application as filed, and having the common general knowledge in mind, the skilled person would not have derived the purported technical effect, i.e. the increased water solubility and bioavailability of Form 1 of vemurafenib over Form 2, as being encompassed by the technical teaching of the application as filed, let alone that the skilled person would have derived it as being embodied by the same originally disclosed invention. Therefore, it could not be taken into account for formulating the objective technical problem in accordance with G 2/21.

In the absence of a technical effect achieved by the distinguishing feature of claim 1, the objective technical problem was defined as providing an alternative crystalline form of vemurafenib, as formulated by the appellant. The board found that the subject-matter of claim 1 of the main request lacked an inventive step in view of the closest prior art (D1) in combination with the common general knowledge represented by D4. As a result, the board set aside the decision of the opposition division and revoked the patent.

013-02-24

Article 056 EPC | T 0183/21 | Board 3.5.07
Article 056 EPC

Case Number	T 0183/21
Board	3.5.07
Date of decision	2023.09.29
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 – mixture of technical and non-technical features – technical character
Cited decisions	T 1869/08, T 0306/10
Case Law Book	I.D.9.2.9 , 10th edition

In [T 183/21](#) the application related to controlling a recommender configured to provide up-to-date predictions of user preferences for products within a large set, for example within a Video on Demand (VOD) catalogue. The claim defined a method of automatically controlling the performance of a recommender system in a communications system, the communications system including a client device associated with a user to which the recommendations were provided. The board noted that recommending products is not generally recognised as having technical character (T 1869/08, T 306/10) and the appellant had thus argued that the purpose of the invention was rather to limit the amount of resources used.

The board found that the technical effect of the distinguishing features was that the use of network bandwidth required to provide the training data to the recommender system was minimised, as was the amount of storage necessary for storing said training data in the communications system including the client device and the recommender system. The amount of training data was indirectly limited via the tendency/convergence of the measured performance metric towards, or oscillation around, the predetermined level of recommendation performance, which was not necessarily the maximum achievable level of recommendation performance. The board came to the conclusion that this technical effect was achieved, on average, over substantially the whole scope of the claim.

014-02-24

Article 056 EPC | T 1246/21 | Board 3.4.02

Article 056 EPC

Case Number	T 1246/21
Board	3.4.02
Date of decision	2023.07.14
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 056, 084, 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (no) – final stage of the problem and solution approach – obvious combination of known features – skilled person’s common general knowledge when combining two prior art documents
Cited decisions	
Case Law Book	I.D.10.4. , 10th edition

In [T 1246/21](#) the appellant (patent proprietor) appealed against the opposition division’s decision to revoke the patent. As an auxiliary measure, the proprietor requested that the patent be maintained on the basis of claims according to one of the auxiliary requests filed with the statement of grounds of appeal. The board agreed with the opposition division's formulation of the objective technical problem starting from D3 (undisputed closest prior art) as finding an alternative for the image icons with increased resolution.

As regards the application of the problem-solution approach, the appellant argued that in its strict application, the skilled person combining the teaching of D3 with that of D2 would arrive in a straightforward manner only at the provision of a protective layer over the focusing elements (as known from D3). However, there was no indication in either D2 or D3 or a combination thereof to use a protective layer which covered the focusing elements and also filled the interstitial spaces between them. Arriving at this feature would clearly involve hindsight.

With respect to a combination of two documents, the proprietor argued that for some of the claimed features the documents provided no "direct and unambiguous disclosure" and that "[a]ccording to the problem-solution approach, if there is any remaining feature not taught by this combination, the subject-matter claimed has to

be acknowledged to involve an inventive step". The board disagreed with this application of the problem-solution approach. In the fourth and final stage of the problem-solution approach it was to be considered "whether or not the claimed solution, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person" (Case Law of the Boards of Appeal, 10th ed. 2022, I.D.2). This was the stage most closely related to the requirement of Art. 56 EPC according to which "[a]n invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art".

The board stated that since Art. 56 EPC and the final stage of the problem-solution approach both considered what was obvious to a person skilled in the art, an inventive step could not be acknowledged solely on the finding that the claimed subject-matter was not directly and unambiguously disclosed from the combination of two documents. In other words, when considering the question of whether an invention was obvious starting from a document representing the closest prior art in combination with another document, it was not the mere sum of the teachings of these two documents that had to be considered. An inventive step could not be acknowledged solely on the finding that the claimed subject-matter was not directly and unambiguously disclosed from the combination of two documents. The skilled person's common general knowledge and skills also had to be taken into account when combining the two documents.

In the case at hand, D3 did not disclose that the protective layer filled interstitial spaces between and covered the focusing elements and formed a distinct interface between the first and the second materials, as discussed above. However, the board found that for the person skilled in the art considering the specific implementation of the protective layer taught by D3, it would be obvious not only to fill the concave parts of the lenses with material but also to cover the spaces between them in order to provide sufficient protection for the focusing elements. Otherwise, the boundaries between the filled portions and the protrusions would act as points of attack for harmful environmental conditions, as would be readily apparent to the skilled person. In addition, in view of the required relationship between the refractive indices, it would be clear to the skilled person that the protective layer would necessarily have to be formed without an additional intermediate layer and would therefore also form a distinct interface with the first material.

In conclusion, the board was of the opinion that the subject-matter of claim 1 did not involve an inventive step starting from D3 in view of D2. The patent proprietor's arguments with regard to the remaining auxiliary requests were also unsuccessful for reasons of lack of inventive step, added subject matter and clarity, and the board dismissed the proprietor's appeal.

015-02-24

Article 056 EPC | T 1989/19 | Board 3.3.02

Article 056 EPC

Case Number	T 1989/19
Board	3.3.02
Date of decision	2023.06.30
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step – technical effect derivable from application as originally filed (yes) – an improvement to a technical effect found to be derivable (Order 2, G 2/21) is also to be regarded as implicitly derivable
Cited decisions	G 0002/21
Case Law Book	I.D.4.3.3 , 10th edition

In [T 1989/19](#) stellte die Kammer fest, dass gemäß Punkt 1 der Entscheidungsformel in G 2/21 die Tatsache, dass D23 und D65 im vorliegenden Fall nachveröffentlicht wurden, für sich genommen nicht ausschließt, dass diese Beweismittel, welche die technische Wirkung einer verbesserten Lagerstabilität des beanspruchten Gegenstandes zeigen, berücksichtigt werden können. Ausweislich des Wortlauts von Punkt 2 der Entscheidungsformel hat die Prüfung, ob eine solche Wirkung aus der Anmeldung in der ursprünglich eingereichten Fassung abzuleiten bzw. dieser zu entnehmen ist, anhand zweier Kriterien zu erfolgen, nämlich "von der technischen Lehre umfasst" und "von derselben ursprünglich offenbarten Erfindung verkörpert". Aus den Entscheidungsgründen, beispielsweise den Punkten 71 und 93, ergebe sich, dass es dabei auf die technische Lehre der Anmeldung wie ursprünglich eingereicht ankomme.

Mit Verweis auf Punkt 71 der Entscheidungsgründe hob die Kammer hervor, dass die Beurteilung, ob die technische Wirkung bei der Prüfung der erfinderischen Tätigkeit berücksichtigt werden kann, aus der Perspektive des Fachmanns erfolgen muss, der unter Heranziehung seines allgemeinen Fachwissens von der Anmeldung in der ursprünglich eingereichten Fassung ausgeht. Aus dieser spezifischen Perspektive des Fachmanns sei zu beurteilen, ob die genannte technische Wirkung als "von der technischen Lehre umfasst und von derselben ursprünglich offenbarten Erfindung

verkörpert" ableitbar ist (Punkt 2 der Entscheidungsformel in G 2/21). Nach Auffassung der Kammer handelt es sich ferner bei der Ableitbarkeit als "von der technischen Lehre umfasst" und "von derselben ursprünglich offenbarten Erfindung verkörpert" um zwei Kriterien, die kumulativ erfüllt sein müssen.

Aus Punkt 93 der Entscheidungsgründe schloss die Kammer, dass eine technische Wirkung auch erst zu einem späteren Zeitpunkt, d. h. nach dem Anmeldetag, im Verfahren geltend gemacht werden kann. Es sei für die Anerkennung einer geltend gemachten technischen Wirkung im Rahmen der Beurteilung der erfinderischen Tätigkeit dabei nicht Voraussetzung, dass diese in der Anmeldung wie ursprünglich eingereicht ausdrücklich genannt oder darin nachgewiesen sein müsse. Vielmehr könne eine durch nachveröffentlichte Beweismittel nachgewiesene technische Wirkung im Sinne des Punktes 2 der Entscheidungsformel in G 2/21 dann anerkannt werden, wenn sie die beiden vorgenannten Kriterien erfülle, d.h. von der technischen Lehre der ursprünglich eingereichten Anmeldung umfasst und als von der ursprünglich offenbarten Erfindung verkörpert ableitbar ist. Dies wiederum bedeute, dass im Hinblick auf diese technische Wirkung die Art der beanspruchten Erfindung gegenüber der ursprünglich offenbarten Erfindung nicht verändert wird.

Im vorliegenden Fall befand die Kammer, dass die aus der ursprünglich eingereichten Anmeldung (nämlich aus der beschriebenen Anwendung als Inhalationsprodukt) im Sinne des Punktes 2 der Entscheidungsformel der G 2/21 ableitbare technische Wirkung in einer Lagerstabilität als solcher besteht, während es sich bei der durch D23 und D65 gezeigten Wirkung um die Verbesserung eben dieser Lagerstabilität gegenüber dem zitierten nächstliegenden Stand der Technik handelt. Nach Ansicht der Kammer gilt aber, sobald das oben genannte Kriterium der Ableitbarkeit einer technischen Wirkung erfüllt ist, dass auch eine Verbesserung dieser Wirkung gleichermaßen in diesem Sinne ableitbar ist. Konkret werde der Fachmann, auch wenn er über keine erfinderischen Fähigkeiten verfügt, in jedem Bereich der Technologie nach Weiterentwicklungen oder technischen Verbesserungen streben. Wenn also eine bestimmte technische Wirkung, wie im vorliegenden Fall die Lagerstabilität, für den Fachmann im Sinne von Punkt 2 der Entscheidungsformel in G 2/21 aus der ursprünglich eingereichten Anmeldung ableitbar ist, ist auch deren Verbesserung als implizit ableitbar zu betrachten.

Folglich ändert die in den nachveröffentlichten Dokumenten D23 und D65 gezeigte technische Wirkung der verbesserten Lagerstabilität auch nicht die Art der beanspruchten Erfindung. Die in D23 und D65 gezeigte verbesserte Lagerstabilität kann daher im Lichte der Entscheidung G 2/21 berücksichtigt werden.

026-03-24

Article 056 EPC | T 2716/19 | Board 3.3.02
Article 056 EPC

Case Number	T 2716/19
Board	3.3.02
Date of decision	2024.01.10
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) – post-published evidence taken into account (yes)
Cited decisions	G 0002/21
Case Law Book	I.D.4.3.3 , 10th edition

In [T 2716/19](#) it was common ground that the subject-matter of claim 1 of the main request differed from disclosures in D1, D5 and D15 only in that magnesium t-butyl oxide or magnesium isopropyl oxide was used in lieu of lithium t-butoxide. However, the views of the parties diverged on the technical effect deriving from this distinguishing feature.

The respondent (patent proprietor) argued that example 1b of the application as filed demonstrated an improvement in the yield in the reaction of HPA to PMPA when magnesium t-butyl oxide or magnesium isopropyl oxide was used as the base instead of lithium butoxide. This improvement was confirmed by each of the post-published documents D18 to D21 and D24.

The appellant (opponent 2) contested the presence of any technical effect associated with the distinguishing feature. Firstly, it argued that the application as filed did not make the above-mentioned technical effect brought forward by the respondent plausible. The application as filed did not include any evidence that the claimed bases would result in an improved PMPA yield. It argued that not only was there no absolute proof, there was no evidence whatsoever in the application as filed of any improved yield. Moreover, the respondent had not relied on common general knowledge for justifying the alleged technical effect. It argued the opposition division was incorrect to allow the respondent to rely on post-published evidence.

The board was not convinced by this line of argument. Decision G 2/21 states (point 1 of the Order) that "[e]vidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date". The skilled person would have immediately recognised an improvement in the yield of the desired product, here PMPA, as a fundamental objective of the disclosed method. It held that the improvement of the PMPA yield in a reaction starting from HPA by using the alkoxides defined in the current main request relied on by the respondent was encompassed by the technical teaching and embodied by the invention originally disclosed in the application as filed. In line with the Order in G 2/21, this technical effect could thus be relied on by the respondent, and post-published evidence confirming this technical effect could not be disregarded.

The board was also not convinced by the appellant's other lines of argument and held that when starting from D1, D5 or D15, the objective technical problem should at least be seen as the provision of a method achieving an improved yield of PMPA. The skilled person facing this objective technical problem would not have been prompted by any available document or common general knowledge to replace the lithium-t-butoxide used in the method of the closest prior art with either magnesium t-butyl oxide or magnesium isopropyl oxide as required by claim 1 of the main request. The subject-matter of claim 1 of the main request thus involved an inventive step within the meaning of Art. 56 EPC.

027-03-24

Article 056 EPC | T 1231/20 | Board 3.5.06
Article 056 EPC

Case Number	T 1231/20
Board	3.5.06
Date of decision	2023.11.06
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 (no) – a finding of obviousness cannot be overcome by mere reference to a different "subjective" technical problem addressed by the invention
Cited decisions	
Case Law Book	I.D.5. , 10th edition

In [T 1231/20](#) the application aimed to provide a microcontroller with a more flexible configurability of a digital clock source that could be used as a system clock or as a clock source for peripheral devices or other uses. In order to achieve this aim, the microcontroller further comprised a multiplexer configurable to select the output clock signal of the numerical controlled oscillator (NCO) as an internal system clock, thereby providing a clock for the central processing core of the microcontroller.

During the oral proceedings, the appellant (applicant) did not specifically question the board's analysis that NCOs were known in the prior art to have numerous advantages compared to analogue oscillators, or that the skilled person would, in order to achieve these advantages, consider the modification of the microcontroller disclosed in D5 (closest prior art) by using an NCO as disclosed in D6.

However, the appellant defended the point of view that the problem of making these advantages available to the microcontroller disclosed in D5 was an inappropriate objective technical problem to be considered, given the fact that the description of the present application set out a different problem addressed by the invention, viz. to fill in the gap between the binary-multiple frequency increases which could be achieved with analogue oscillators.

This argument did not sway the board's opinion. Once a convincing argument had been made why the claimed invention would have been obvious to the skilled person having regard to the state of the art (Art. 56 EPC), the claimed invention would no longer be considered to involve an inventive step. More specifically, if the claimed invention were found to be an obvious solution to an objective technical problem which could be assumed to have arisen – as was the case in the appeal before the board – the identification of an alternative technical problem as a solution to which the claimed invention might not appear to be obvious did not suffice to invalidate the finding of obviousness. Especially the fact that the alternative technical problem was the one addressed in the application, i.e. the "subjective" technical problem, was insufficient to establish an inventive step.

As the board summarised in its catchword: an inventive step objection based on an appropriate objective technical problem which the invention solves over the prior art cannot be overcome by mere reference to the fact that the application discloses a different, more specific ("subjective") technical problem addressed by the invention.

The board consequently held that the subject-matter of claim 1 was not inventive (Art. 56 EPC) and dismissed the appeal.

028-03-24

Article 056 EPC | T 0681/21 | Board 3.3.06
Article 056 EPC

Case Number	T 0681/21
Board	3.3.06
Date of decision	2023.10.30
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 (no) – synergistic effect not encompassed by technical teaching of application as filed (G 2/21) – post-published data considered in view of G 2/21 – diverging experimental data – benefit of the doubt not to be granted to the patent proprietors
Cited decisions	G 0002/21, T 0570/08, T 1182/15
Case Law Book	I.D.4.1. , I.D.4.3.3. , 10th edition

In [T 681/21](#) the board noted that the formulation of the technical effect differed from that identified in the patent, and thus it was important to verify whether such a formulation was in accordance with the conclusion of the Enlarged Board of Appeal in G 2/21 (point 94 of the Reasons) that "A patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would consider said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention".

It was not in dispute that the application as filed did not relate to a synergistic effect arising from the combination of a silicone with CPP or any other component. Also, the fact that the application as filed indicated the CPP to be a preferred cationic polymer without explaining the reason for this preference could not foreshadow that the claimed combination would provide any type of synergism. The respondents (patent proprietors) also did not file any evidence that it was common general knowledge that silicone and cationic polymers might provide a synergism in terms of improved softness. Therefore, the board concluded the alleged synergistic effect would not have been considered by the skilled person as being encompassed by the technical teaching of the application as filed and had to be disregarded.

The board considered the data available from the respondents in relation to the alleged invention and closest prior art. In the board's view, it was obvious for the skilled person faced with the technical problem posed to try as an alternative to the composition of example E4, one comprising any combination of the softening agents suggested by the description such as one comprising the silicone of example E4 with any cationic polymer disclosed in the description, for example a CPP. Subject-matter of claim 1 according to the main request thus lacked an inventive step. Auxiliary requests 2, 3, 5 and 6 also lacked an inventive step.

As to auxiliary request 4, the respondents relied on post-published experimental data D7 and submitted that a combination of anionic silicone with CPP provided unexpectedly better softening than a similar combination comprising a cationic polymer which was not a CPP. In the board's view, a skilled person reading the application as originally filed and having the common general knowledge in mind would derive therefrom as a technical teaching that the addressed improved silicone softness was especially obtained by using a combination with the components indicated as preferred, such as a CPP and an anionic silicone. Therefore, said alleged technical effect could be considered to be encompassed by the technical teaching and embodied by the same originally disclosed invention and could thus be considered in view of G 2/21. The appellant (opponent 2), relying especially on data contained in D16 filed with its statement of the grounds of appeal in reaction to D7, contested the validity of the alleged technical effect at least across the entire scope of claim 1 at issue.

In view of the diverging results in D7 and D16 the respondents also invoked the benefit of the doubt in their favour. However, the board noted that it was established case law (see for example T 570/08 and T 1182/15) that the benefit of the doubt cannot be granted if the other party provides experimental data convincingly casting doubts on the effect allegedly achieved as it was also in the present case. It followed that it could not be established that the claimed combination provided the alleged improved softness at least across the entire scope of claim 1.

The objective technical problem solved thus had to be again formulated as the provision of a further fabric treatment composition comprising silicone as it was with regard to the main request. However, the board found it was obvious for the skilled person faced with the above technical problem to modify the composition of D1/example 4 by using the anionic silicone of D2 as a promising alternative for PDMS in combination with CPPs and to add thereto a small amount of CPP as taught in D1. The board therefore concluded that claim 1 of this request lacked an inventive step.

029-03-24

Article 056 EPC | T 0887/21 | Board 3.3.04
Article 056 EPC

Case Number	T 0887/21
Board	3.3.04
Date of decision	2023.07.13
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 (no) – post-published evidence taken into account (no) – technical effect derivable from application as originally filed (no)
Cited decisions	G 0002/21
Case Law Book	I.D.4.3.3 , 10th edition

In [T 887/21](#) the patent in suit sought to provide a method for the prevention of secondary infections following viral infections such as influenza, which did not rely on the use of antibiotics and which may be conveniently and safely administered. The respondent (patent proprietor) argued that, in view of the mechanistic concept set out in the application as filed and the experimental data presented in the (post-filed) test report D15, the objective technical problem should be defined as the provision of an improved composition for use in the prevention of secondary infections following a viral infection characterised by neuraminidase activity.

The board reached a different conclusion. The application as filed contained no experimental data. The mechanistic concept that the respondent relied on was a mere assertion by way of a hypothesis and was not backed up by any corroborative data. Thus, the board found the information provided in the application as filed did not amount to evidence of an "improvement" in comparison with the starting point in the prior art (i.e. D16).

The respondent had argued that the fact that the application as filed included a mechanistic concept at least provided justification for submitting additional evidence with D15. However, the test described in D15 related to inhibition of *Salmonella typhimurium* (known for causing gastroenteritis) in a culture medium, without the involvement of epithelial host cells. This was not corroborative evidence of the

concept taught in the application as filed, but entirely new information both on the mechanism of action and the pathogenic organism involved.

Firstly, D15 related to a presumed synergistic effect that was independent of epithelial binding. This was not derivable from the application as filed. Contrary to the respondent's view, the fact that a mechanistic concept of the antiadhesive activity of oligosaccharides was set out in the application as filed could not justify introducing new experimental data that was manifestly based on a different mechanism of action.

Secondly, the application as filed mentioned only once, in a general way, that the infections which may be prevented, apart from infections of the respiratory tract, also included infections of the gastrointestinal tract.

An invention cannot be based solely on knowledge made available only after the effective date. In the case in hand, the board found it could not have been derived from the application as filed that the envisaged compositions were supposed to inhibit *Salmonellae*, and this independently of any antiadherence mechanism.

In the terms used in decision G 2/21, in these circumstances, the board found that the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would not have derived the technical effect examined in D15 and relied on by the respondent for inventive step as being encompassed by the technical teaching and embodied by the same originally disclosed invention.

The board elaborated that it was not sufficient that a technical effect could be achieved by a composition which in terms of technical features corresponded to compositions in the application as filed. In order to be taken into account in the formulation of the objective technical problem, the alleged technical effect that was supposedly shown by the post-filed evidence (in the present case, the inhibition of *Salmonellae* outside the context of epithelial adherence) also had to be encompassed by the technical teaching of the application as filed, i.e. the technical effect in question had to in the first place be disclosed or be at least derivable from the technical teaching of the application documents (G 2/21, point 72 of the Reasons). Already this first requirement was not met in the case in hand.

For these reasons, the improvement alleged by the respondent could not be taken into account in the formulation of the objective technical problem.

030-03-24

Article 056 EPC | T 2004/21 | Board 3.3.09

Article 056 EPC

Case Number	T 2004/21
Board	3.3.09
Date of decision	2023.12.05
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) – alternative solution of a known problem (no) – ex post facto analysis (no)
Cited decisions	
Case Law Book	I.D.4.5. , I.D.6. , 10th edition

In [T 2004/21](#) the claimed invention related to a chewing gum which provided a hydration or "mouthwatering" sensation to a consumer. The appeal was against the decision of the opposition division finding that the European patent as amended according to auxiliary request 1 met the requirements of the EPC and in which decision the claimed subject-matter was considered by the opposition division to have involved an inventive step over the teaching of D1 and D2.

The board considered that since D2, like the opposed patent, related to a chewing gum inducing a pleasant sensory experience in the consumer, it was, as argued by the respondent, the closest prior art. D1 focused on maintaining the mechanical properties of a chewing gum after long storage rather than on the sensorial effects induced in a consumer. Thus, the board found that D1 was not the closest prior art.

Although D2 did not mention the mouthwatering effect, the results in the patent made it credible that the chewing gum disclosed in D2, which contained erythritol granules, induced it. There was no evidence that the chewing gum according to the invention induced a stronger mouthwatering effect compared to that of D2.

The board did not agree with the appellant, however, that mouthwatering was an inherent property of the chewing gum of D2 and that this document already provided a solution to the problem of providing a chewing gum inducing mouthwatering. It referred to the established case law as set out in Case Law of the Boards of Appeal, 10th ed. 2022, I.D.4.5., "Alternative solution of a known problem". Although

the chewing gum of D2 had "inherent" mouthwatering properties, D2 disclosed neither these properties nor the problem of providing a mouthwatering effect in a user. "Mouthwatering" was not mentioned in any of the cited prior-art documents. The claimed chewing gum could therefore not be considered an alternative solution to a known problem.

When assessing inventive step, an interpretation of the prior-art documents as influenced by the problem solved by the invention where the problem was neither mentioned nor suggested in those documents had to be avoided, such an approach being merely the result of a posteriori analysis (Case Law of the Boards of Appeal, 10th ed. 2022, I.D.6., "Ex-post facto analysis"). Formulating the problem as the provision of an "alternative chewing gum" which was meant, explicitly or implicitly, to solve the problem of inducing mouthwatering would imply that this problem, as well as its solution, was known at the filing date. This would require reading into the teaching of D2 the technical contribution which the patent made over the prior art, namely the finding that erythritol granules induced a mouthwatering effect. This would inevitably result in an ex-post facto analysis.

For these reasons, starting from D2, which disclosed chewing gums preventing an abrasive sensation, the underlying objective technical problem was to be formulated as the provision of a chewing gum inducing a mouthwatering effect in a consumer.

Considering obviousness, the board held that none of the cited prior-art documents mentioned the problem of providing a chewing gum providing a mouthwatering effect. This problem was apparently not even known at the filing date. Therefore, to arrive at the claimed chewing gum without hindsight knowledge of the patent in suit would have required inventive skills. For these reasons alone, the skilled person confronted with the underlying problem would have had neither any reason nor guidance to prepare the claimed chewing gum by increasing the amount of coarse particles in the chewing gum of D2. Furthermore, D2 did not suggest providing a chewing gum comprising the claimed amount of coarse erythritol granules and taught away from the claimed solution.

The subject-matter of claim 1, as well as that of the following claims, which were narrower in scope, therefore involved an inventive step over the prior art. For these reasons the board dismissed the appeal.

051-05-24

Article 056 EPC | T 1126/19 | Board 3.3.07
Article 056 EPC

Case Number	T 1126/19
Board	3.3.07
Date of decision	2023.07.21
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) – ex post facto analysis – whole list of alternatives in the closest prior art must be considered
Cited decisions	T 0970/00, T 0777/08, T 0041/17
Case Law Book	I.D.6. , 10th edition

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

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

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

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

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

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

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

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

064-06-24

Article 056 EPC | T 1994/20 | Board 3.3.03
Article 056 EPC

Case Number	T 1994/20
Board	3.3.03
Date of decision	2023.11.24
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 (no) – comparative tests – experimental comparison not suitable to demonstrate an alleged effect in the context of the closest prior art
Cited decisions	T 0035/85
Case Law Book	I.D.4.3.2 , 10th edition

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

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

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

used as reference example in the comparative test. It had to additionally be credible that the same effect or advantage took place in the context of the closest prior art, i.e. irrespective of the modification of the closest prior art operated to prepare the reference example of the comparative test. Concerning the present case, in the absence of any technical explanation for the technical effects resulting from the use of a LMW fraction having a lower MFR₂ of not more than 100 g/10 min. in the context of the comparative example of the patent in suit, there was no apparent reason to expect that the same effects were also obtained in the context of the closest prior art, which substantially differed therefrom.

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

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

065-06-24

Article 056 EPC | T 0686/22 | Board 3.2.04
Article 056 EPC

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

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

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

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

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

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

066-06-24

Article 056 EPC | T 1594/20 | Board 3.5.01

Article 056 EPC

Case Number	T 1594/20
Board	3.5.01
Date of decision	2024.04.30
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step – mixture of technical and non-technical features – simulation – technical effect
Cited decisions	G 0001/19, T 0641/00, T 1227/05
Case Law Book	I.D.9.2.16 , I.D.9.2.1 , I.D.9.2.11b), 10th edition

In [T 1594/20](#) bezweifelte die Kammer, dass überhaupt eine Simulation eines technischen Gegenstands vorlag. Eine mathematisch rechnerische Optimierung bewirke nicht zwangsläufig auch eine Simulation des zugrunde liegenden physikalischen Vorgangs (hier Warentransport), sondern es seien vom hier vorliegenden Anspruchsgegenstand auch rein deterministische mathematische Optimierungen umfasst. Die optimierte Aufteilung eines Kommissionierauftrags nach rein kaufmännischen Kostenbetrachtungen (z.B. break-even-point) sei ebenso umfasst wie mathematische Optimierungsalgorithmen analog zum bekannten travelling-salesman-problem. Dabei werden kognitive geschäftsbezogene Daten verarbeitet und es liegen keine technischen Überlegungen zugrunde, die zu einer erfinderischen Tätigkeit nach Art. 56 EPÜ beitragen könnten.

Die Beschwerdeführerin argumentierte, dass mit dem beanspruchten Gegenstand eine Reduktion der Anzahl von Fahrten erreicht werde und damit eine Energieeinsparung verbunden sei. Die Kammer war davon nicht überzeugt. Eine geltend gemachte Energieeinsparung sei rein spekulativ und könne nicht ohne weiteres zur Annahme eines technischen Effekts führen. Dazu wäre erforderlich, dass ein solcher Effekt mit technischen Mitteln erreicht werde. Beim beanspruchten Gegenstand wäre eine Energieeinsparung (sofern tatsächlich erzielt) aber Folge einer rein organisatorischen oder algorithmischen Optimierung, die im Wesentlichen auf einer gedanklichen Tätigkeit basiere. Daraus könne kein technischer Effekt zur Berücksichtigung einer erfinderischen Tätigkeit abgeleitet werden. Die Kammer stimmte daher der angefochtenen Entscheidung zu, dass die objektive technische

Aufgabe darin bestand, das mathematische Verfahren zur Warenkommissionierung, welches vom Geschäftsmann der Logistik als Spezifikation vorgegeben wurde, auf einem Computersystem zu implementieren. Bei der Implementierung sah die Kammer keinen technischen Effekt, welcher über die reine Automatisierung hinausging.

088-08-24

Article 056 EPC | T 1733/21 | Board 3.2.05

Article:

Article 056 EPC

Case Number	T 1733/21
Board	3.2.05
Date of decision	2024.01.15
Language of the proceedings	FR
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) – closest prior art – relevance of the problem solved in a prior art document
Cited decisions	T 1742/12
Case Law Book	I.D.3.1. , I.D.6. , 10th edition

Dans l'affaire [T 1733/21](#), les revendications 1 et 6 de la requête dont la division d'opposition avait jugé qu'elle satisfaisait aux exigences de la CBE peuvent être résumées comme suit : (1) Procédé d'impression de substrat et de personnalisation dudit substrat par dorure, (6) Système d'impression de substrat et de personnalisation du dit substrat par dorure comprenant un groupe d'impression du substrat par jet d'encre adapté à la mise en relief de zones au moyen d'encre et/ou de vernis.

Concernant l'activité inventive, la requérante (opposante) a présenté des objections en partant des documents D3, D2 et D4. La division d'opposition a conclu qu'aucun des documents D2 et D3 ne pouvaient constituer un point de départ valable, car ils ne concernaient pas des procédés ou systèmes d'impression et de personnalisation de substrat par dorure sélective et ne visaient donc pas à obtenir le même effet que l'invention. La chambre ne partage pas ce raisonnement.

La chambre énonce que de manière générale, pour être prometteur, le point de départ doit se situer dans le même domaine technique que l'invention ou dans un domaine voisin. S'il est vrai qu'un état de la technique qui vise le même effet technique que l'invention semble a priori prometteur, il ne s'agit pas d'une condition sine qua non pour sa prise en compte. S'il en était autrement, des éléments de l'état de la technique qui sont silencieux quant à l'effet visé (tels que, par exemple, la plupart des usages antérieurs) ne sauraient jamais constituer un point de départ valable, ce qui est contraire à la pratique établie de l'OEB (cf. T 1742/12).

La chambre énonce que c'est à l'opposante de démontrer que l'invention n'est pas inventive ; si son choix du point de départ pour mener cette démonstration n'est pas aberrant, il convient d'en tenir compte. Or, le seul fait que la technologie utilisée dans les documents D2 et D3 était basée sur le gaufrage ne les disqualifiait pas d'office comme points de départ. La chambre a donc jugé que la division d'opposition n'aurait pas dû écarter d'office D2 et D3 comme points de départ.

Partant du document D3, la chambre a estimé que bien que D3, même en combinaison avec D9, pourrait conduire à l'invention, cela n'était pas démontré de manière évidente par les connaissances générales de l'homme du métier. Le procédé de D3 est assez différent; l'étape d'impression décrite y a une fonction différente de celle revendiquée. Par conséquent, D3, même en combinaison avec D9, ne conduisait pas à l'objet des revendications 1 ou 6.

Partant du document D2, la chambre a estimé que la requérante n'a pas démontré de façon convaincante que l'homme du métier aurait été conduit à l'invention par le document D2 seul ou en combinaison avec le document D4. L'affirmation que l'homme du métier aurait été conduit à l'invention par la combinaison des documents D2 et D4 n'est pas plausible, car il s'agit de technologies différentes (mise en relief par impression vs. gaufrage). Aux yeux de la chambre, l'homme du métier n'avait pas de raison objective d'isoler l'enseignement concernant l'impression à jet d'encre dans le document D4 et de l'incorporer dans la station d'encollage du dispositif décrit dans le document D2. Le raisonnement de la requérante reposait sur une analyse a posteriori. Par conséquent, D2, même en combinaison avec D4, n'aurait pas conduit l'homme du métier à l'objet des revendications 1 ou 6.

La chambre n'a pas non plus été convaincue par les lignes d'attaque partant du document D4.

En conclusion la requérante n'a pas convaincu la chambre que l'objet de la revendication 1 n'impliquait pas d'activité inventive. Les parties étaient d'accord que la conclusion relative à l'activité inventive du procédé selon la revendication 1 s'appliquait également au dispositif correspondant selon la revendication 6. Comme les objections par la requérante contre le maintien du brevet n'étaient pas fondées, la chambre a rejeté le recours.

089-08-24

Article 056 EPC | T 0629/22 | Board 3.3.09
Article 056 EPC

Case Number	T 0629/22
Board	3.3.09
Date of decision	2024.03.19
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) – auxiliary request 1a-p-s – claimed effect obtained and problem solved substantially across the entire scope claimed (yes) – presence of a single non-working embodiment was of no harm
Cited decisions	G 0001/03
Case Law Book	I.D.4.1.3 , 10th edition

In [T 629/22](#), concerning the inventive step of the subject-matter claimed in auxiliary request 1a-p-s, the board identified D12 as the closest prior art. The claimed subject-matter of a cheese analogue differed from the teaching of D12 at least on account of the type and amount of starch: 10 to 24 wt.% of non-modified root or tuber starch or of a waxy root or tuber starch instead of 7 wt.% modified starch.

The board was satisfied that the tests in the patent and in D27 and D29 made it credible that cheese analogues prepared using non-modified tuber and root starch had melt-stretch characteristics. Appellant 1 noted however that example 28 of D38 showed that no stretchable cheese analogue could be obtained using 10 wt.% waxy potato starch, 0.5 wt.% potato protein and 35 wt.% sunflower oil. This demonstrated that the claims were overly broad and that melt-stretch characteristics could not be achieved across the entire scope claimed.

The board did not agree with these conclusions. The amounts of potato protein (0.5 wt.%) and starch (10 wt.%) used in example 28 of D38 were the lowest foreseen in the patent whereas the amount of fat (35 wt.%) was the highest. This meant that the allegedly non-working embodiment in example 28 related to a rather peculiar case.

The patent and the experimental reports D27 and D55 described cheese analogues comprising different amounts of waxy starch, potato protein and fat. The amount of these ingredients was varied substantially across the entire scope claimed: that of the potato proteins from 0.5 to 5 wt.%, that of the starch from 10 to 24 wt.% and that of oil from 10 to 35 wt.%. All these cheese analogues exhibited melt-stretch characteristics. This made it credible that the claimed effect could be obtained substantially across the entire scope claimed.

The board noted the findings of the Enlarged Board in G 1/03 (OJ 2004, 413), point 2.5.2 of the Reasons, that where "...there is a large number of conceivable alternatives and the specification contains sufficient information on the relevant criteria for finding appropriate alternatives over the claimed range with reasonable effort [...] the inclusion of non-working embodiments is of no harm."

The board found that in the case in hand the patent indeed described a large number of conceivable alternatives and sufficient information for finding appropriate alternatives over the claimed range, with reasonable effort. If a skilled person failed to prepare a stretchable cheese analogue using the amounts of ingredients in example 28 of D38, they would: realise that the conditions used are extreme because the amounts of the ingredients are at the edge of each of the ranges foreseen in the patent; find in the patent, and in particular in the examples, the teaching that compositions having the desired properties could be obtained by increasing the amount of potato protein and/or decreasing the amount of the oil. The tests in the patent and in D27 and D55 made it credible that if a skilled person followed the teaching in the patent, they would obtain a cheese analogue having the relevant stretch properties.

The board concluded the claimed effect could be obtained substantially across the entire scope claimed. Therefore, the presence of a single non-working embodiment was of no harm.

090-08-24

Article 056 EPC | T 0672/21 | Board 3.3.02
Article 056 EPC

Case Number	T 0672/21
Board	3.3.02
Date of decision	2024.04.15
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) – unexpected balance of various beneficial properties (yes) – polymorphs
Cited decisions	T 0777/08, T 1684/16, T 0041/17
Case Law Book	I.D.9.9.5 , 10th edition

In [T 672/21](#) the appellant (opponent 2) had provided submissions on obviousness based on the assumption that any improved property was absent, so that the objective technical problem was the mere provision of a further polymorph. It relied in this respect on decision T 777/08.

The board, however, defined the objective technical problem in a more ambitious way. For this reason alone, the board held the appellant's submission on obviousness had to fail. The objective technical problem as defined by the board was the provision of a crystalline form of selexipag with a balance of beneficial properties, namely an intermediate stability and at the same time improved industrial processability and improved purity in terms of reduced amounts of residual solvents and residual impurities.

The board noted that according to T 777/08 "in the absence of any technical prejudice and in the absence of any unexpected property, the mere provision of a crystalline form of a known pharmaceutically active compound cannot be regarded as involving an inventive step" (headnote 1) and "the arbitrary selection of a specific polymorph from a group of equally suitable candidates cannot be viewed as involving an inventive step" (headnote 2). However, in the present case there was no absence of unexpected properties and the selection was not arbitrary, since the selected Form I had a balance of beneficial properties in terms of stability, industrial processability and purity in comparison with Form II and Form III. There was nothing in the prior art which pointed to the fact that the claimed Form I would have this

balance of beneficial properties and they were thus not expected. The present case thus differed from the situation at issue in decision T 777/08.

The board also distinguished T 41/17, relied upon by the appellant for its further argument that the alleged stability of Form I was not a surprising technical effect because the skilled person always looked for the most thermodynamically stable polymorph in order to avoid the problem of interconversion within the dosage form. In T 41/17 it was concluded that the skilled person would have performed screening of the different polymorphs disclosed in the closest prior art, which could exist in order to isolate and identify the most thermodynamically stable form thereof. By doing so, the skilled person would have arrived at the claimed polymorph, which was the most thermodynamically stable form and which, for this reason, was expected not to convert to other forms under mechanical stress. However, unlike in T 41/17, in the present case the stability was not the only property, but rather part of a balance of beneficial properties. Hence, even if the stability of Form I (which is at an intermediate level) had been expected, the same would not apply to the balance of various beneficial properties.

The board also noted that the mere fact that the skilled person would have carried out routine screening for polymorphs as such did not render the claimed Form I obvious. As set out in T 1684/16, the fact that the skilled person was taught in the prior art to investigate polymorphs in order to isolate the crystalline form having the most desirable properties was in itself not necessarily sufficient to consider a specific polymorphic form having a certain desired property or, as in the present case, balance of properties obvious.

Thus the subject-matter of claim 1 of the main request, and by the same token of claims 2 to 13, which included the subject-matter of claim 1, involved an inventive step in view of D10 as the closest prior art.

098-09-24

Article 056 EPC | T 1994/22 | Board 3.3.02
Article 056 EPC

Case Number	T 1994/22
Board	3.3.02
Date of decision	2024.04.15
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 (no) – unexpected balance of beneficial properties (no) – arbitrary selection (yes) – polymorphs
Cited decisions	T 0777/08, T 1684/16, T 0041/17, T 0672/21
Case Law Book	I.D.9.9.5 , 10th edition

[See also abstract under Article 56 EPC regarding the purported technical effect of improved photostability.](#)

In [T 1994/22](#) the appeal lay from the opposition division's decision to reject the oppositions filed against the European patent. Claim 1 of the main request related to Form II of selexipag, an agonist of the prostaglandin receptor PGI₂. The appellant (opponent) objected to the inventive step of the subject-matter of claim 1 of the main request in view of D10 as the closest prior art. The distinguishing feature of claim 1 of the main request in view of example 84 of D10 was the crystalline form, namely Form II of selexipag.

In view of the available experimental results, the board concluded that Form II exhibited the best stability but only intermediate industrial processability, intermediate residual solvent content and an intermediate amount of residual impurities. Contrary to the situation in T 672/21 there was no balance of beneficial properties for Form II according to the main request. The objective technical problem could therefore only be considered that of providing a crystalline form of selexipag which is the best for one property, but only intermediate for all other tested properties.

The respondent submitted that, in line with T 1684/16, there was no reasonable expectation based on the prior art that a suggested investigation in terms of polymorph screening would be successful in finding a form of selexipag having a

balance of beneficial properties in terms of stability, industrial processability, solvent content and purity.

The board disagreed. Based on T 1684/16 and in line with T 777/08, an inventive step can be acknowledged if the claimed polymorph has an unexpected property meaning that its selection is non-arbitrary. In the present case, the board saw nothing unexpected in finding a polymorph that was optimum for one property but only intermediate for several other properties. If this were unexpected and thus gave rise to an inventive step being acknowledged, an applicant or proprietor having identified a new polymorph would simply need to carry out tests for long enough to find one single property for which the identified polymorph performed best. This might result in a situation in which almost any polymorph in the world becomes inventive, which would render Art. 56 EPC meaningless.

Therefore, the selection of Form II is an arbitrary selection from the host of alternatives covered by the closest prior art. Such an arbitrary selection without any unexpected balance of properties being produced cannot contribute to inventive step. The subject-matter of claim 1 of the main request therefore does not involve an inventive step in view of D10 as the closest prior art.

099-09-24

Article 056 EPC | T 1994/22 | Board 3.3.02

Article 056 EPC

Case Number	T 1994/22
Board	3.3.02
Date of decision	2024.04.15
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 (no) – post-published evidence taken into account (no) – purported technical effect not encompassed by the teaching of the application as filed (G 0002/21)
Cited decisions	G 0002/21, T 0116/18, T 1989/19
Case Law Book	I.D.4.1.2b , I.D.4.3.3c , 10th edition

[See also abstract under Article 56 EPC regarding unexpected balance of beneficial properties.](#)

In [T 1994/22](#) the respondent (patent proprietor) inter alia had relied on post-published data D32 and submitted that Form II (according to claim 1 of the main request) as claimed had an improved photostability over Form III (comparative).

The respondent relied on the statements made in T 116/18 as regards G 2/21 and submitted that referring to the provision of a novel crystal of compound A (selexipag) and to a pharmaceutical product of "high quality for which constant effect can always be shown and a form which is handled easily industrially", the skilled person would have understood that the effect of improved photostability was implied by or at least related to the technical problem initially suggested in the originally filed application. Therefore, requirement (i) [in T 116/18], as encompassed by the technical teaching, was met. Furthermore, the respondent claimed the skilled person would not have had any legitimate reason to doubt that the improved photostability could be achieved with the claimed polymorphic form of selexipag. Therefore, requirement (ii) [in T 116/18], as embodied by the same originally disclosed invention, was also met in the present case.

In line with T 116/18, the board in the present case acknowledged that the mere fact that photostability or improved photostability was not contained in terms of a positive verbal statement in the application as filed and that the application as filed did not contain any data as regards photostability, as such, did not imply that the effect of improved photostability could not be relied on in terms of G 2/21 or T 116/18.

However, the board did not consider such a sweeping statement regarding "high quality" and "easy industrial handleability", which covers a plethora of potential advantageous properties, to encompass photostability, let alone improved photostability. If such a sweeping statement were sufficient, a reference to high quality would be sufficient to invoke whatever technical effect as being encompassed by an application as filed in the sense of G 2/21. This would essentially render the first criterion of order no. 2 of G 2/21 meaningless. In the present case, the application as filed was in fact directed to particle size, residual solvent content and amount of impurities, properties which are entirely unrelated to photostability. Therefore, based on these properties, having the common general knowledge in mind, the skilled person would by no means have recognised that (improved) photostability was relevant to the claimed subject-matter. Going from these specific properties to the effect of photostability would also clearly change the nature of the invention, contrary to what is required by T 116/18. Hence, the board found the effect of photostability was not encompassed by the teaching of the application as filed.

Furthermore, even if it were wrongly concluded in the respondent's favour that the technical teaching of the application as filed were to encompass photostability in the sense of T 116/18, it would not do so "together with the claimed subject-matter", as required by this decision.

The respondent submitted during the oral proceedings that the present case was also in line with T 1989/19 and that it was not a requirement that the application as filed disclosed improved photostability. In that case, the board held that once the criterion of the derivability of a technical effect in the sense of G 2/21 was fulfilled, this applied equally to the improvement in this effect. The board agreed with the view expressed in T 1989/19; however in the present case, photostability was not encompassed and thus not derivable from the teaching of the application as filed in the sense of G 2/21. Furthermore, unlike in T 1989/19, the application as filed in the present case referred to three polymorphic forms in equal terms, and the present case was not one in which the purported improvement was asserted to be present for the subject-matter of the application as filed over the subject-matter disclosed in the prior art.

It followed that improved photostability of Form II as demonstrated in D32 could not be taken into account in the assessment of the technical effects achieved by the distinguishing feature.

100-09-24

Article 056 EPC | T 0182/20 | Board 3.5.01
Article 056 EPC

Case Number	T 0182/20
Board	3.5.01
Date of decision	2023.10.24
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 – mixture of technical and non-technical features – modelling – predicting a specific malfunction of a specific mechanical or electrical component based on specific parameters
Cited decisions	G 0001/19
Case Law Book	I.D.9.2.15 , 10th edition

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

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

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

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

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

109-10-24

Article 056 EPC | T 2086/21 | Board 3.3.02
Article 056 EPC

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

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

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

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

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

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

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

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

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

110-10-24

Article 056 EPC | T 1741/22 | Board 3.5.05
Article 056 EPC

Case Number	T 1741/22
Board	3.5.05
Date of decision	2024.07.26
Language of the proceedings	EN
Internal distribution code	B
Inter partes/ex parte	Ex parte
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	Guidelines G-II, 3.3 – March 2022 and 2024 versions
Keywords	inventive step – technical effect (no) –new data derived from data collected from the human body
Cited decisions	G 0001/04, G 0001/19, T 2681/16, T 1091/17, T 1910/20, T 335/21
Case Law Book	I.D.9.2.11 , 10th edition

In [T 1741/22](#) the board referred to G 1/19 to show that it is generally acknowledged that measurements have technical character, since they are based on an interaction with physical reality, such as the human or animal body (see also G 1/04). However, the board went on to find that in the case at hand, features (c) and (d) did not involve the actual measurement of the respective glucose level in a bodily fluid. Instead, they processed already measured and received continuous glucose monitoring data to generate and display further "new data", namely a plurality of minimum/maximum glucose values, in order to support a physician in their purely intellectual deductive decision phases of diagnosis and therapy. Such subsequent processing of certain measurement data collected from the human or animal body is predominantly of a non-technical nature. Thus, it could not contribute to the technical character of the invention. The board also referred to its earlier decisions T 1091/17, T 1910/20, T 335/21.

At the oral proceedings before the board, the appellants referred to T 2681/16 and to the Guidelines for Examination in the EPO in support of their view. In particular, the appellants considered the case in T 2681/16 to be analogous to the case at hand. The competent board in that case had dealt with distinguishing features related to an algorithm to process already acquired, i.e. measured, blood glucose data points. The board had acknowledged that these features, when taken in isolation, were non-technical, and could support the presence of an inventive step only if they credibly

contributed to producing a technical effect serving a technical purpose. However, the board had then accepted the technical effect alleged by the appellant, namely "providing an overall measure of the glucose variability (i.e. equally sensitive to both hypo- and hyperglycemic events) and a prediction of glycemic events that were better than, or at least alternative to, those used in [the closest prior art]".

This board was not in agreement with and therefore deviated from the interpretation of the Convention given in T 2681/16. In particular, the board disagreed with the finding in T 2681/16 that providing an overall "measure" of the glucose variability and a prediction of glycemic events amounted to a technical effect. The board was well aware of the tendency of applicants to use the word "measure(ment)" liberally in order to give inventions the veneer of technicality. This was mainly because it is generally acknowledged in the jurisprudence of the Boards of Appeal that "measurements" have technical character. Admittedly, the applicants' use might well correspond to the meaning of the word in common parlance. However, a prerequisite for a "measurement" with technical character, within the meaning of the jurisprudence of the Boards of Appeal, is an interaction with "physical reality" for the calculation of the physical state of an object, even if the measurement could be carried out indirectly, e.g. by means of measurements of another physical entity (G 1/19). In the present case and in the case underlying T 2681/16, where the "physical reality" was typically the "patient's blood", the interaction with the physical reality ended once blood glucose measurements were carried out, either directly on the relevant physical entity "blood", or indirectly e.g. on another bodily fluid. The provision of overall glucose variability and a prediction of glycemic events were mathematical steps or intellectual activities which took place in the absence of this interaction with the physical reality and were therefore not "measurements" in this sense. In other words, the taking of a sample from the patient is an interaction with "physical reality". Generating new data as a consequence of this interaction may result in "measurements" of a technical nature. But generating (and displaying) further data by an evaluation or interpretation of these measurements (as done according to features (c) and (d) here) amounts to "measurements" generated merely by a cognitive or mathematical exercise that is inherently non-technical.

As to the Guidelines for Examination in the EPO (in its applicable version of March 2022 and also in its current version of March 2024), section G-II, 3.3, which relates to the technical contribution of mathematical methods, lists "providing a medical diagnosis by an automated system processing physiological measurements" among "examples of technical contributions of a mathematical method". As providing a "medical diagnosis" – whether done by a physician or by an automated system – is devoid of any technical character (G 1/04), the board found this example to be erroneous. As there was no further explanation, let alone a reference to any case law, the board saw no reason to speculate on how the Guidelines had come up with this example. In view of the above, the board held that the subject-matter of claim 1 of auxiliary request 10 did not involve an inventive step (Art. 56 EPC).

120-11-24

Article 056 EPC | T 1525/19 | Board 3.3.07
Article 056 EPC

Case Number	T 1525/19
Board	3.3.07
Date of decision	2024.04.12
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 056, 112 EPC
EPC Rules	
RPBA	Article 012(4) RPBA 2007
Other legal provisions	
Keywords	inventive step (yes) – post-published evidence taken into account (yes) – common general knowledge – referral to the Enlarged Board of Appeal (no) – stay of proceedings (no)
Cited decisions	G 0002/21
Case Law Book	I.D.4.3.3c), III.C.7.9 , 10th edition

The decision under appeal in [T 1525/19](#) concerned the opposition division's decision to reject the five oppositions filed against the patent at issue for a solid pharmaceutical dosage form comprising linagliptin as a first active pharmaceutical ingredient in an amount of 5 mg and empagliflozin as a second pharmaceutical ingredient in an amount of 10 mg or 25 mg and one or more excipients.

AR 1 (admitted under Art. 12(4) RPBA 2007) was directed to a solid pharmaceutical dosage form comprising 5 mg linagliptin and 10 or 25 mg empagliflozin. The appellants (opponents) had argued that, in accordance with decision G 2/21, the overadditive effect on GLP-1 levels assigned to the combination of linagliptin and empagliflozin could not be taken into account for the assessment of inventive step. The effect was not derivable from the application as filed or from common general knowledge, since empagliflozin could not be expected to have an effect on GLP-1 levels.

The board disagreed. The application as filed was generally directed to the combination of linagliptin with a SGLT2 inhibitor for improving glycaemic control compared with monotherapy. The mode of action of linagliptin and SGLT2 inhibitors was common general knowledge and it was also disclosed in the application as filed. The fact that the combination of linagliptin and empagliflozin increases GLP-1 levels

in an overadditive manner did not change the nature of the effect assigned to the combination of the invention, it merely related to a difference in intensity, which becomes relevant for comparison with the closest prior art. Therefore, the effect shown in D62 and D64 (post-published evidence) was encompassed by the teaching of the application as filed. The board also found that there was a synergistic interaction between linagliptin and empagliflozin. Therefore, in the light of common general knowledge and Example I of the application as filed, the skilled person would consider it likely that the overadditive glucose excursion observed in Example I of the patent was at least partially due to an increase in the effect on GLP-1 levels compared with linagliptin monotherapy. The effect shown in D62 and D64 was embodied by Example I in the application as filed. G 2/21 did not preclude taking into account the effect merely confirmed by D62 and D64.

Appellant 5 argued that the board's conclusion that D62 and D64 could be taken into account was based on an argument raised for the first time by the board at the oral proceedings on 1 September 2023. The board was not convinced; if appellant 5 had needed time to reconsider its case after the board's conclusion on the consideration of D62 and D64, it could have requested this before the debate was closed. However, no requests or comments were made when the board gave the parties the opportunity to do so before closing the debate. The request to be heard on additional arguments was made more than three months after the oral proceedings.

Appellants 1 and 5 also argued that a reopening of the debate was justified to avoid divergent case law, since Board 3.3.04 had decided in related appeal case T 314/20 that decision G 2/21 did not allow taking D64 into account, and that at least the present appeal proceedings should be stayed until the written reasoned decision in T 314/20 is issued. Furthermore, if the proceedings were not stayed and the debate not reopened, in view of the diverging views on the interpretation of G 2/21, the present board should refer questions to the Enlarged Board. The board again was not convinced. A decision by a different board in a different case did not constitute exceptional circumstances justifying the reopening of the debate. Even if the appeal cases concerned closely related subject-matter, the decision in one appeal case was not binding on the other. This was particularly true considering that the case in T 314/20 was not the same as that presented in the case at hand, at least with respect to technical arguments. Furthermore, in the absence of exceptional circumstances to reopen the debate, the board saw no reason to stay the appeal proceedings until the written reasoned decision in appeal case T 314/20 was issued. The board rejected the requests to reopen the debate, stay the appeal proceedings and refer questions to the Enlarged Board.

The board remitted the case to the opposition division with the order to maintain the patent in amended form with claims 1 to 14 of AR1 as filed with the reply to the statements of grounds of appeal.

Article 056 EPC | T 1050/22 | Board 3.3.07

Article 056 EPC

Case Number	T 1050/22
Board	3.3.07
Date of decision	2024.07.09
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 (no) – combination invention (no) – obvious combination of known features
Cited decisions	
Case Law Book	I.D.9.3.1 , 10th edition

[See also abstract under Article 76\(1\) EPC.](#)

In [T 1050/22](#), with regard to obviousness, the relevant question was whether the skilled person would have contemplated a reduction of the amount of mannitol to less than 0.5 w/v%, by partially replacing mannitol with propylene glycol and/or glycerine, while at the same time further reducing the concentration of BAC to less than 0.0035 w/v%, in the presence of an anionic polymer and any of the defined suspended active agents, with a reasonable expectation of still meeting appropriate antimicrobial preservation.

The main argument of the respondent was that any technical effect associated with individual distinguishing features over D1 could not be split up and that the nature and concentration of all the components had a combined effect. The respondent claimed that neither D1, nor any other cited prior art document provided any hints towards the claimed combination of ingredients, let alone their concentrations.

The board disagreed and considered that the subject-matter of claim 1 was a simple aggregation of known features and that the implementation of each feature was obvious in view of the cited prior art. There was in the board's view no evidence of a general relationship between the effects from the distinguishing features. It thus considered that, in the present case, the individual differentiating features were mostly the result of specific individual technical effects, and not of a combined

technical effect different from the sum of the technical effects of the individual features. These features and their related effects were per se known from either the closest prior art (D1) or from the additionally cited documents.

The claimed solution involved a combination of several components, including brinzolamide, an anionic polymer, a surfactant, sodium chloride, a first polyol (mannitol or sorbitol), a second polyol (propylene glycol or glycerine), borate, benzalkonium chloride (BAC) as an antimicrobial preservative, and water. However, the board noted that D2 already suggested the use of brinzolamide in ophthalmic compositions in the treatment of glaucoma, which exhibiting poor water solubility had to be formulated in a suspension. This common knowledge was reflected in the teaching of document D18, from which it was known to use anionic polymers such as carbomers as suspending agents for these active agents. Ophthalmic compositions comprising a borate-polyol complex for increasing the antimicrobial efficacy of other antimicrobial agents were known from D1. A borate-polyol system such as claimed was furthermore known from D4. Moreover, D4 disclosed specifically a composition which corresponded qualitatively and quantitatively to the borate/polyol system of claim 1 of auxiliary request 13. D7 disclosed that the tear osmolality corresponded to the claimed osmolality of the composition. In light of the above, the board concluded it would have been straightforward for the skilled person faced with the objective technical problem to modify formulations 9 or 10 of document D1.

Consequently, the subject-matter of claim 1 of auxiliary request 13 did not involve an inventive step (Art. 56 EPC). The remaining auxiliary requests were found to either be contrary to the requirements of Art. 76(1) EPC (auxiliary requests 1-12, 14-18, 20-23) or Art. 56 EPC (auxiliary request 19).

143-13-24

Article 056 EPC | T 0279/21 | Board 3.5.01
Article 056 EPC

Case Number	T 0279/21
Board	3.5.01
Date of decision	2024.01.30
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Ex parte
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step – technicality – computer-implemented invention – workflow rules controlling tasks and tags labelling the states of the tasks
Cited decisions	G 0001/19, T 0894/10
Case Law Book	I.D.9.2.15 , 10th edition

In [T 279/21](#) the invention related to a central control system for providing automated real-time interaction and state-transition-controlled processing of (data) objects. The invention was said, rather generally, to provide a system which was capable of flexibly capturing the external and/or internal factors that may affect the processing of an object within a workflow and that was more capable of being operated by externally or internally occurring boundary conditions or constraints. Furthermore, it was able to react dynamically to changing environmental or internal conditions or measuring parameters that were possibly not known or predictable at the beginning of the workflow process, in particular without human interaction.

The examining division had argued that the claimed subject-matter related to abstract information modelling concepts at meta-language level in the context of workflows. They had pointed out that the design and modelling of workflows for business processes represented activities in the sphere of methods for doing business.

The appellant had argued that when G 1/19 (e.g. at point 51 of the Reasons) stated that any technical effect going beyond the implementation of the process on a computer may be considered for inventive step, it meant anything beyond a 1:1 mapping between the implementation and a step of the business method being implemented. In other words, any subject-matter that does not "map" to a step in the business method is technical.

The board agreed that the "implementation" of a business method implies some sort of mapping between non-technical steps of the business method and their technical realisation. Decision G 1/19 had something to say about this mapping, at least in the forward direction, at point 51 of the Reasons, when it rephrased the requirement for technical effect as "technical effect going beyond the simulation's straightforward or unspecified implementation on a standard computer system". Thus, even a 1:1 mapping might be inventive if it is not "straight-forward" (e.g. not standard programming or routine modification of the technical means used), or "unspecified" (e.g. not simply as "means for [carrying out the step]").

But, according to the board, looking for a mapping from "implementation" to the step of a business method in the reverse direction did not make sense as the steps of the non-technical activity do not have to be specified explicitly. They would include any steps that the business person would come up with in a non-technical workflow. The way this was handled was by considering the mapping of the implementation to the effect of the step and to examine whether the effect had any technical character, or whether it would be covered by what the business person would consider as part of the non-technical process. This was, in other words, the standard COMVIK approach where one looks at the effect of a feature in order to pose a technical problem, which might simply be the implementation of the feature, for which the above-mentioned mapping in the forward direction meant in G 1/19 applied.

Thus, looking at the feature of the "operating tags" in the present case, the effect was to define business conditions determining whether a certain task shall be executed or not. This, of course, corresponded to a non-technical step of the workflow system, namely keeping track of the state of a process. Going forward again with the mapping in order to judge inventive step, the implementation was seen to be the use of "operating tags", which even if escaping the "unspecified" classification must surely be "straight-forward".

Furthermore, the board could not see how avoiding the folder data structure of the prior art, as argued by the appellant, represented a technical effect.

The board found the present case comparable to T 894/10, in which the board, in a different composition, held that "all aspects of the idea of modelling and manipulating representations of a workflow are fundamentally non-technical, being essentially aspects of either a business method or an algorithm or both. [...] Technical considerations only come into play when implementing the representation and rules".

The board therefore concluded that the subject-matter of the claim in question lacked an inventive step over the prior art within the meaning of Art. 56 EPC, because the skilled person would adapt the modules seen in the prior art, with additional functions to implement new workflow rules or constraints based on common general knowledge.

Article 056 EPC | T 0318/22 | Board 3.3.02
Article 056 EPC

Case Number	T 0318/22
Board	3.3.02
Date of decision	2024.09.09
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) – credibly solved (yes) – technical effect derivable from application as originally filed (yes) – post-published evidence taken into account (yes) – test-data in application as filed rendered the improvement credible
Cited decisions	G 0002/21, T 0939/92, T 0116/18 of 11 October 2021
Case Law Book	I.D.4.1.2b), 10th edition

In [T 318/22](#) the patent comprised data demonstrating that compounds falling within the scope of claim 1 possessed herbicidal activity. That the herbicidal activity was improved compared to structurally close compounds of D7 was demonstrated in the post-filed tests of D9 and D10.

The appellant (opponent) argued that the data in the patent was not sufficient to render the alleged herbicidal effect credible across the scope of the claim and that the data in D9 and D10 should not be taken into account in view of G 2/21. Even if taken into account, the appellant argued, the data in D9 and D10 for two compounds was not sufficient to extrapolate the effect across the scope of the claim.

The board found that the application as filed comprised data demonstrating that a range of compounds falling within the claimed scope possessed herbicidal activity against various plant species, and that the examples of the application as filed adequately demonstrated that herbicidal activity was maintained with variation in the substitution pattern around the periphery. Hence, it was credible on the basis of the application as filed that the claimed compounds possessed the alleged herbicidal

activity. The board found that the situation in T 939/92 – which the appellant sought to rely on – was not relevant to the present case.

As to the question whether D9 and D10 could be taken into account in view of G 2/21, the board noted as set out above that the technical effect upon which the respondent relied was explicitly mentioned in and rendered credible by the application as filed. Hence, the requirement in G 2/21 that the skilled person would derive the technical effect as being "encompassed by the technical teaching" and "embodied by the same originally disclosed invention" was met. The board further found that referral T 116/18 and decision G 2/21 appeared to be irrelevant to the present case, since the question to be answered in those cases was whether post-published data in relation to a particular technical effect could be relied on for inventive step when evidence for said effect relied exclusively on said post-published data (see question 1 posed by the referring board in T 116/18). This did not correspond to the present situation.

The board concluded that the data in D9 and D10 and in the application as filed demonstrated that the technical effect of improved herbicidal activity could be attributed to the distinguishing features over the structurally closest compounds disclosed in D7. While this did not constitute absolute proof that all claimed compounds differing from the equivalent compound of D7 only in the distinguishing features would demonstrate the same improvement, this conclusion was rendered credible by the test data. In the absence of any evidence to the contrary, the board therefore accepted that the effect of improved herbicidal activity was achieved over substantially the whole of the claimed scope. Hence, on the basis of referral T 116/18 and G 2/21, D9 and D10 could be relied on in the assessment of inventive step for the claimed subject-matter.

Consequently, the board held the objective technical problem underlying claim 1 was as formulated by the respondent, namely the provision of compounds having improved herbicidal activity against a variety of weeds. Noting that the appellant had not submitted any arguments according to which inventive step would be lacking if the objective technical problem were to be formulated as set out above, the board concluded that the subject-matter of claim 1 involves an inventive step pursuant to Art. 56 EPC.

145-13-24

Article 056 EPC | T 2363/22 | Board 3.3.09
Article 056 EPC

Case Number	T 2363/22
Board	3.3.09
Date of decision	2024.06.10
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 056, 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (yes) – closest prior art – comparative tests not expected with respect to each and every starting point
Cited decisions	G 0002/21
Case Law Book	I.D.4.3.2 , 10th edition

In [T 2363/22](#) the patent at issue related to a dry pet food which comprised a core and a palatability-enhancing coating that contained edible phosphate salt and yeast extract. In both the application as filed and the patent, the reduction in palatability resulting from the decrease in the phosphate salt content was stated to be compensated for by the impact of the yeast extract; that is, the yeast extract enhanced the palatability contribution of the phosphate salt.

The patent proprietor had with its reply to the notice of opposition, filed the declaration D15, which included comparative tests intended to provide a basis for comparing the closest prior art with claim 1. The tests in D15 did not compare every composition that the opponent considered a starting point with the subject-matter of claim 1. However, in a situation where an opponent lodges several inventive-step attacks from various starting points, the board held it was understandable that the patent proprietor might choose to formulate comparative compositions that addressed distinguishing features that all starting points had in common. The patent proprietor was not expected to provide comparative tests with respect to each and every starting point. Rather, the question to be answered was whether the set-up chosen supported the conclusion that a technical effect was credibly achieved, and in particular whether the comparative test was representative of the disclosure used as a starting point. In the case in hand, it was not convincing that the difference identified by the appellant had a decisive effect on the conclusions drawn from D15, let alone that it led to results that lacked technical meaning.

The board was satisfied that the effects highlighted in D15 were, in the words of G 2/21 (OJ 2023, 85), "encompassed by the technical teaching and embodied by the same originally disclosed invention". The data in D15 illustrated with respect to the specific closest prior art cited how yeast extract compensated for the decrease in phosphate concentration.

Considering the technical effect demonstrated, the board determined the problem was to maintain or improve the palatability of a pet food composition. It concluded that contrary to the appellant's view, there was no teaching in D1 or D2 leading to the solution of claim 1. While in these two documents low concentrations of phosphate were suggested and were possible, in principle, there was no indication that this could be done while maintaining palatability. The prior art contained no teaching to this effect, let alone when combined with the use of yeast extract. Therefore, the subject-matter of claim 1 involved an inventive step (Art. 56 EPC).

146-13-24

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

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

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

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

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

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

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

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

067-06-24

Article 069 EPC | T 1628/21 | Board 3.2.06

Article 069 EPC

Case Number	T 1628/21
Board	3.2.06
Date of decision	2024.02.06
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 069 EPC
EPC Rules	
RPBA	
Other legal provisions	Protocol on the Interpretation of Article 69 EPC
Keywords	claims – claim interpretation – using description and drawings to interpret the claims – limits
Cited decisions	G 0002/88, T 0881/01, T 0223/05, T 1404/05, T 0299/09, T 1646/12, T 0058/13, T 1127/16, T 1473/19
Case Law Book	II.A.6.3.1 , 10th edition

In [T 1628/21](#) claim 1 was directed to an article of apparel comprising among other things "a lower back position feedback system (202) engaged with the garment structure at the lower back portion". The interpretation of the expression "engaged with" was relevant in the context of assessing novelty and inventive step of the opposed patent. The respondent (patent proprietor) submitted that the meaning of "engage" was for one distinct part to interact with another part, rather than for one part to be inherently and inseparably comprised within the other. The respondent also argued that Art. 69 EPC should be used to interpret the claim and referred to several paragraphs of the description where "engaged with" was used only in relation to separate material pieces being attached to one another rather than being otherwise incorporated.

The board disagreed with the respondent's interpretation of the term "engaged with" and held that its meaning was broader (i.e. also encompassed arrangements in which the lower back position feedback system was integrally incorporated into the garment structure). In the board's view the expression was not unclear in its context and consequently there was no need to refer to the description in order to interpret the scope of the claim (see T 881/01, T 58/13 and T 299/09 in which limitations to a claim's interpretation could not be derived from the description). The board referred to T 223/05, T 1404/05 and T 1127/16 in which it was held that a technically skilled

reader does not normally need any further description-based guidance on claim interpretation, the claims essentially being read and interpreted on their own merits. The board also stated that consideration of the description would not lead to the respondent's restrictive interpretation. It emphasised that in the context of Art. 69 EPC the claims and the description, including the drawings, did not have the same status. As mentioned in Art. 1 of the Protocol on the Interpretation of Article 69 EPC (the Protocol), under the principle of primacy of the patent claims, two "polar" models of interpretation are in principle possible, i.e. an isolated interpretation of the wording of the claims alone on the one hand and an interpretation which understands the wording of the claims merely as a starting point in the context of the overall disclosure on the other. The established case law of the boards of appeal did not favour either of these "polar" models of interpretation, but something lying in-between. In G 2/88, point 4 of the Reasons, the Enlarged Board of Appeal had already stated that the "object of the Protocol is clearly to avoid too much emphasis on the literal wording of the claims when considered in isolation from the remainder of the text of the patent in which they appear; and also to avoid too much emphasis upon the general inventive concept disclosed in the text of the patent as compared to the relevant prior art, without sufficient regard also to the wording of the claims as a means of definition."

In line with this case law, the board established that the interpretation of "engaged with" was not a matter of an isolated interpretation of only the wording of the claim in the sense of a purely linguistic consideration of the same. Rather, the feature must be interpreted in the light of general knowledge of the person skilled in the technical field concerned. This first required an identification of the technical field resulting from the overall disclosure of the patent in order to determine the person skilled in that specific field. Furthermore, the general knowledge of the skilled person ensured that the technical context in which the claims were situated was taken into account when interpreting the claims (see also T 1646/12).

The board noted that neither Art. 69 nor its Protocol explicitly addressed the extent to which the description and drawings can be used to interpret the claims. Nevertheless, according to the board, the principle of primacy of the claims seemed to exclude the use of the description and drawings for limiting the claims if an interpretation of the claim in the light of common general knowledge already leads to a technically meaningful result. Similarly, the principle, established by case law, according to which "limiting features which are only present in the description and not in the claim cannot be read into a patent claim" was also fully compatible with Art. 69 EPC and Art. 1 of the Protocol (cf. T 1473/19).

The board also stated that it may be that the reader is presented with specific definitions in the description in cases where terminology in the claims is e.g. unusual or where special meanings are attributed. Such definitions, if relevant for validity, should normally be included in the claims. In the case at hand, however, there was no such definition of "engaged with" in the description.

Article 069 EPC | T 0177/22 | Board 3.2.03
Article 069 EPC

Case Number	T 0177/22
Board	3.2.03
Date of decision	2024.03.19
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054, 056, 069, 083, 084, 100 EPC
EPC Rules	
RPBA	
Other legal provisions	Protocol on the Interpretation of Article 69 EPC
Keywords	claim interpretation – in the context of the description (yes) – interpretation in a uniform and objective manner (yes)
Cited decisions:	G 0002/88, G 0006/88, G 0003/14, T 0518/00, T 1473/19, T 0367/20, T 0450/20, T 0092/21, T 1537/21, T 0438/22, T 0447/22
Case Law Book:	II.A.6.3.1 , II.A.6.3.2 , II.A.6.3.4 , 10th edition

In [T 177/22](#) the board stated that in order to assess whether the claimed invention is sufficiently disclosed or is novel or inventive, the claimed invention must – to the extent to which this is decisive for the outcome of the case – first be determined by interpreting the claim from the perspective of the person skilled in the art (see T 367/20). When doing this, a board of appeal is not limited to the claim interpretations advanced by the parties but may also adopt a claim interpretation of its own (T 450/20, T 1537/21).

According to the board, the relevant feature of claim 1 as granted was to be interpreted not only in the context of the other features in that claim but also in the context of the description as granted (for recent case law on this matter see T 367/20, referring to the principles of claim interpretation as set out in Art. 69 EPC and Art. 1 of the Protocol on the Interpretation of Article 69 EPC; T 447/22, referring to the general principle under the EPC that claims can be interpreted only in context, which includes the description and the drawings; T 1473/19, referring to G 2/88, applying Art. 69 EPC and the Protocol for interpreting "the technical features of the claim" when assessing extension of the scope of protection under Art. 123(3) EPC; G 6/88 (taken on the same day as G 2/88), where the Enlarged Board (directly) applied Art. 69 EPC and the Protocol "to construe the claim in order to determine its technical features" when assessing novelty; compare also Court of Appeal of the

Unified Patent Court, UPC_CoA_335/2023, Grounds 4.d)aa), referring to Art. 69 EPC and the Protocol as well as to G 2/88, and stating that the principles for the interpretation of a patent claim apply equally to the assessment of the infringement and the validity of a European patent; as to the harmonised approach on claim interpretation introduced by the EPC see further G 6/88, referring to Art. 69 EPC and the Protocol on its interpretation as "a mechanism for harmonisation" which provides a "method of interpretation of claims of European patents throughout their life"; T 1473/19, referring to the legitimate interests of the users of the European patent system in a common approach to claim interpretation; T 367/20 and T 438/22, referring to the overarching objective under the EPC that authorities, courts and the public interpreting the claims should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on its patentability; as to the primacy of the claims under Art. 69 EPC and the Protocol see T 1473/19; in regard to the latter compare also Court of Appeal of the Unified Patent Court, UPC_CoA_335/2023, Grounds 4.d)aa), referring to the patent claim as not only the starting point, but the decisive basis for determining its subject-matter and scope of protection).

The board noted that the fact that the patent specification disclosed embodiments which were not encompassed by claim 1 did not result in an insufficient disclosure but in a lack of support by the description under Art. 84 EPC. However, the requirements of Art. 84 EPC play no role in opposition proceedings where the proprietor seeks to have the patent as granted upheld (G 3/14, point 55 of the Reasons).

The respondent (opponent) submitted that a different, broader, claim interpretation had to be adopted for the assessment of novelty and inventive step than for the assessment of sufficiency of disclosure. The board disagreed and stated that the "invention" within the meaning of Art. 54(1) EPC, the "invention" within the meaning of Art. 56 EPC and the "invention" within the meaning of Art. 100(b) EPC (and Art. 83 EPC) all refer to the claimed subject-matter (see T 1473/19 and T 92/21), and a given patent claim's subject-matter must be interpreted and determined in a uniform and consistent manner (see T 1473/19). This excluded interpreting the same claim differently when assessing sufficiency of disclosure on the one hand, and when assessing novelty and inventive step on the other hand. It also presupposed that the same principles of claim interpretation must be applied when assessing compliance with any of these requirements under the EPC.

The board further held that a patent claim must be construed in an objective manner (see T 518/00, referring to the description and the drawings as an aid to interpretation). This prohibited adopting a certain claim interpretation – be it narrow or broad – only because it was, under a certain ground of opposition (or, for that matter, under a certain ground for revocation or in infringement proceedings), (more) detrimental or beneficial to one of the parties.

076-07-24

Article 069 EPC | T 1208/21 | Board 3.2.06
Article 069 EPC

Case Number	T 1208/21
Board	3.2.06
Date of decision	2024.04.09
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 069 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claim interpretation – limitation of the claim's features in the light of the description (no)
Cited decisions	T 0454/89, T 0860/93, T 1127/03, T 1473/19, T 1628/21, T 0447/22
Case Law Book	II.A.6.3.4 , 10th edition

In [T 1208/21](#) the board rejected the respondent's (patent proprietor's) approach of a limited interpretation of the expression "gas turbine blade" in claim 1 in the light of the description.

The board held that according to the commonly accepted approach on claim interpretation by the boards of appeal, when assessing inter alia the patentability requirements of Art. 54 and 56 EPC a claim which is clear by itself should be interpreted as broadly as technically reasonable in the relevant technical field (see T 1628/21, T 447/22). As to the extent to which the description and the figures of the patent have to be taken into account for interpreting the wording of a claim, the board agreed with the principles set out in decisions T 1628/21 and T 1473/19.

Moreover, the board noted that the description of the patent in suit did not lead to a different conclusion either. The description of the patent as granted stated: "Generally, the gas turbine blade according to the present invention is not restricted to a gas turbine: rotor blades or guide vanes of a turbo-machinery fall legally under the present invention". Correspondingly, granted claim 13 was directed to a blade suitable for use as a rotor blade or guide vane for turbo-machinery. This confirmed that the patent itself considered the term "blade" in claim 1 to cover rotating and stationary blades (vanes) as well as their use in turbo-machinery in general, thus not limited to the turbine section of a gas turbine.

Although the description and the claims had been amended in auxiliary request 3 by deleting these statements of the granted patent, such an amendment of the description did not constitute a limitation of the claimed subject-matter. The board stated that, in analogy to the situation underlying decision T 454/89, in which it was held that a lack of clarity in a claim could not be cured by relying on Art. 69 EPC as a replacement for the Art. 84 requirements, i.e. as a substitute for an amendment which would be necessary to remedy a lack of clarity, also in the context of the requirements of Art. 54 and 56 EPC, a technically reasonable and not illogical understanding of the claim wording could not be restricted by reference or an amendment to the description. In such a situation, it would, rather, be the claim wording that would require amendment (see T 1628/21).

091-08-24

Article 069 EPC | T 2030/20 | Board 3.2.03

Article 069 EPC

Case Number	T 2030/20
Board	3.2.03
Date of decision	2024.01.16
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 069 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claim interpretation – use of the description – special (broader) meaning in the description – interpretation to assess novelty
Cited decisions	T 1473/19, T 0367/20
Case Law Book	II.A.6.3.3 , 10th edition

In [T 2030/20](#) befasste sich die Kammer mit der Auslegung der Begriffe "Tauchrohr" und "eines Durchmessers" in Anspruch 1 im Rahmen der Neuheitsprüfung.

Die Patentinhaberin wollte den Begriff „Tauchrohr" in Anspruch 1 des erteilten Patents im Sinne des unmittelbaren Wortsinns verstanden wissen, wonach das Rohr dazu geeignet sein sollte, in ein Kulturmedium einzutauchen. Ein Tauchrohr müsse demnach insbesondere lang genug ausgebildet sein, um das Kulturmedium, beispielsweise eine Flüssigkeit wie die Kulturbrühe oder ein Gel, eines angeschlossenen Einweg-Bioreaktors erreichen zu können.

Die Kammer merkte an, dass nach ständiger Rechtsprechung den in einem Patent verwendeten Begriffen die im einschlägigen Stand der Technik übliche Bedeutung zu geben sei, sofern ihnen nicht in der Beschreibung des Patents ein besonderer Sinn zugewiesen wurde (siehe Rechtsprechung der Beschwerdekammern, 10. Auflage 2022, Kapitel II.A.6.3.3; vgl. auch T 1473/19). Sei Letzteres der Fall, könne dies auch dazu führen, dass einem Anspruchsmerkmal gegenüber der im einschlägigen Stand der Technik üblichen Bedeutung im Lichte der Beschreibung eine breitere Bedeutung zukomme. Dies sei im vorliegenden Fall so.

Zwar sei es gemäß den in den Figuren dargestellten Ausführungsformen des Patents, wie von der Patentinhaberin dargelegt, bevorzugt, dass ein Tauchrohr des Patents dazu vorgesehen sei, in eine im Bioreaktor bestimmungsgemäß vorhandene

Kulturbrühe einzutauchen. Allerdings weise das Patent dem Begriff "Tauchrohr" in der Beschreibung eine über den eigentlichen Wortsinn hinausgehende, breitere Bedeutung zu, wonach ein Tauchrohr lediglich in den Reaktionsraum ragen könne, also irgendwo innerhalb des Reaktionsraums oberhalb des Flüssigkeitsspiegels enden könne.

Die vorgenommenen Änderungen im Hilfsantrag 1 betrafen die Beschreibung der Tauchrohre in Absätze 46 und 60. Die Kammer war jedoch der Ansicht, dass die unverändert belassenen Absätze der Patentschrift weiterhin definierten, dass die Tauchrohre im Sinne des Patents lediglich lang genug ausgebildet sein müssten, um in den Reaktionsraum zu ragen.

Im Hilfsantrag 4 wurde folgendes Merkmal ergänzt: "und wobei die Tauchrohre eine Länge von über 50 Prozent eines Durchmessers der Kopfplatte aufweisen". Von den Beteiligten wurde diskutiert, was unter "eines Durchmessers" zu verstehen sei.

Nach Ansicht der Kammer müsse die Wortfolge "eines Durchmessers" im Gesamtzusammenhang des Anspruchs und der Patentschrift (T 367/20) als Maß für die Ausdehnung der Kopfplatte, also als Maß für ihren Gesamtdurchmesser, verstanden werden. Bei nur isolierter Betrachtung des Wortlautes von Anspruch 1 bestehe eine technisch sinnvolle Auslegung der Wortfolge "eines Durchmessers" darin, dass der Fachmann sich bei der Definition der Länge der Tauchrohre im Bezug auf die Kopfplatte an der für die Kopfplatte charakterisierenden Größe des Gesamtdurchmessers orientiere – und nicht an dem Durchmesser lediglich eines Teiles der Kopfplatte, welcher für die Größe der gesamten Kopfplatte nicht repräsentativ sei. Sollte ein Fachmann nichtsdestotrotz Zweifel daran haben, welche Bedeutung dem Begriff "eines Durchmessers" in Anspruch 1 zukomme, würde er die Beschreibung des Patents konsultieren. Die Patentschrift stütze das o.g. Verständnis der Wortfolge "eines Durchmessers".

101-09-24

Article 076(1) EPC | T 2171/21 | Board 3.3.04
Article 076(1) EPC

Case Number	T 2171/21
Board	3.3.04
Date of decision	2023.11.07
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 076, 100(c) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	divisional application – added subject-matter – extension beyond the content of the earlier application as filed (yes) – selections from two or more lists
Cited decisions	G 0002/10, T 2273/09, T 3035/19
Case Law Book	II.E.1.6.2c , 10th edition

In [T 2171/21](#) the board explained that there existed a difference between the conceptual disclosure of a number of possible combinations and the individualised disclosure of specific combinations. While the former might be a more economical way of drafting a patent application, it did not necessarily allow the skilled person to derive each and every individual combination directly and unambiguously.

In the case in hand, claim 1 was directed to a specific dosage regimen (steps (a) and (b) of the claim) including a specific induction dose (150 mg) for a specific disease (AS). The disease AS was disclosed in the earlier application as filed in a list comprising RA and a generic reference to other forms of inflammatory arthritis, which were exemplified by three concrete diseases. The dosage regimen was disclosed in the last of nine rows in Table 5, and the induction dose was disclosed as one of two options in the last row of Table 5. To arrive at the claimed subject-matter, the skilled person had to select one element from each of the three lists and combine the three, or they had to "compute" all possible combinations (48 in this case) and discard 47 of them. Neither approach could be considered to lead to subject-matter disclosed directly and unambiguously in the earlier application as filed. Due to the repeated necessity for making selections, the selection from three lists could not be seen as resulting in subject-matter derivable from what was directly at the disposal of the skilled person. The calculation of all possible combinations, due to the step of computing, was not direct.

The respondent argued that the situation was fundamentally different from the selection of groups for substitution in a Markush formula. The board disagreed. In the same way that Markush formulae could represent conceptual combinations of lists of different chemical groups (e.g. R1 and R2) with different core structures, the disclosure in the earlier application as filed represented conceptual combinations of different dosage regimens and induction dosages with different diseases. Just as different chemical groups could not coexist at the same position on a given chemical core structure, the same patient with a disease could not be treated at the same time with different dosage regimens or different induction dosages.

The board agreed with the respondent that considerations on a selection from several lists were not meant to replace the gold standard (G 2/10, point 4.3 of the Reasons).

An aspect also addressed by the Enlarged Board in G 2/10 was the issue of "singling out" by holding that "there would be added matter" where the amendment "would result in singling out any hitherto not specifically mentioned or at least implicitly disclosed individual compound or group of compounds ..." (point 4.5.4 of the Reasons). The board held that the "singling out" of a combination of features was precisely what happened in claim 1 of the present case (T 2273/09). Furthermore, the board agreed with T 3035/19 that considerations on selections from two or more lists of some length provided valuable guidance. However, the board also acknowledged that the combination of features resulting from selections from two or more lists only added subject-matter in the absence of a pointer to that particular combination. The concept of selection from lists had to be applied with due regard to the whole content of the earlier application as filed.

In the case in hand, the earlier application as filed did not contain a preference for or pointer to any of the combined features or to the chosen combination. The ground for opposition in Art. 100(c) EPC thus prejudiced the maintenance of the patent.

006-01-24

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

Case Number	T 1054/22
Board	3.3.09
Date of decision	2024.06.14
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 076(1), 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	divisional application – amendments – added subject-matter (yes) – subject-matter extends beyond content of earlier application (yes) – ranges of parameters
Cited decisions	G 0003/89, G 0011/91, G 0001/93, G 0002/10, G 0001/16
Case Law Book	II.E.1.1 , II.E.1.3.1 , II.F.2.1.1 , 10th edition

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

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

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

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

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

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

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

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

111-10-24

Article 076(1) EPC | T 1050/22 | Board 3.3.07
Article 076(1) EPC

Case Number	T 1050/22
Board	3.3.07
Date of decision	2024.07.09
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 076(1), 100(c), 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (yes) – selections from two lists – (sub)ranges – disclosure of combination in an individualised manner – pointer
Cited decisions	G 0002/10, T 1511/07, T 1731/18, T 1408/21
Case Law Book	II.E.1.6.2a), II.E.1.6.2c), 10th edition

[See also abstract under Article 56 EPC.](#)

In [T 1050/22](#) the board explained that the selection of originally explicitly disclosed limit values defining several (sub)ranges to define an individual range did not necessarily generate subject-matter extending beyond the original disclosure. However, the further combination of such an individual range with another individual range emerging from a second list of ranges and relating to a different feature was not considered to be derivable from the original disclosure, unless there was a clear pointer to such a combination (see for instance T 1511/07, T 1731/18). In the case in hand, the basis for the definition of the indicated combination of ranges was even less evident due to the presentation in the claims and the description of the grandparent application (D5) of lists of upper and lower limits rather than defined ranges (compare with T 1408/21).

According to the board, a relevant pointer was usually a specific indication or teaching in the original application directing the skilled person to a specific combination. Such a specific indication could originate from the original claims and/or from disclosed specific embodiments, in particular when the examples of the application as filed presented a uniform disclosure with regard to the concerned combination of features and all fell under the scope of the claims. However, the

presence of discordant examples could well indicate that the examples did not provide any clear pointer to the combination of features.

In the case in hand, starting from the disclosure in D5, feature (e) represented a first selection from the list of ranges which emerged from the endpoints shown in claim 3 and page 7, while feature (g) represented a further selection from a second list of ranges that was created on the basis of the endpoints shown in claim 1 and page 8 of D5. In the absence of any pointer to the particular combination of claim 1 of the main request, the combination of the range amounts for features (e) and (g) as claimed represented added subject-matter. The board did not identify any passage of the description nor any example as a possible pointer for the combination of such selections. Examples A, M and N, cited by the respondent, corresponded to the only examples where the compounds and their amounts matched with the claimed compounds and amounts. Most of the remaining examples, in particular examples B-K, showed however discordant compositions, so that the examples could not be seen as a clear pointer to the defined combination of features.

The combination of features (e) and (g) with the further selected feature of viscosity of dependent claim 11 was also considered not to be derivable from D5, since there was also no further pointer for such combination. Examples M and N cited by the respondent did not even indicate the viscosity of the compositions disclosed therein.

Consequently, the main request did not meet the requirements of Art. 76(1) EPC. Since the content of D5 was similar to the content of the application as filed, the same conclusion applied with regard to the requirements of Art. 123(2) EPC.

147-13-24

Article 083 EPC | T 0552/22 | Board 3.3.08
Article 083 EPC

Case Number	T 0552/22
Board	3.3.08
Date of decision	2023.09.19
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b), 113(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – invention to be performed over whole range claimed and indication of "at least one way" – technical concept fit for generalisation – post-published documents and right to be heard
Cited decisions	G 0001/03, G 0002/21, T 0435/91, T 0743/97
Case Law Book	II.C.5.2. , II.C.5.4. , 10th edition

In [T 552/22](#) the invention lay in the field of fermentative production of human milk oligosaccharides, in particular the production of fucosyllactose. While the SET family of proteins comprised proteins SetA, SetB and SetC, claim 1 was not limited to these three proteins but related generally to any protein of the SET family of proteins. Implementation of the claimed functional requirement of the bacterial cells required that overexpression of the protein of the SET family leading to an export of fucosyllactose be achievable at the filing date without undue burden over the whole range claimed.

The board recalled that the requirements of sufficiency of disclosure were met if a person skilled in the art could carry out the invention as defined in the independent claims over the whole ambit of the claims without undue burden based on the disclosure in the patent application. The disclosure of one way of performing an invention was only sufficient if it allowed the invention to be performed over the whole range claimed. This principle applied to any invention, irrespective of how it was defined, be it by way of a functional feature or not. A functional definition was acceptable if all alternatives were available and achieved the desired result. For functional definitions of a technical feature, it had to be established whether or not the patent application disclosed a technical concept fit for generalisation which made the host of variants encompassed by the functional definition available to the skilled

person. Sufficiency of disclosure had to be shown to exist at the effective date of the patent (priority date or date of filing), i.e. on the basis of the information in the patent application as a whole and taking into account the common general knowledge then available to the skilled person. A lack in this respect could not be remedied by post-published evidence (cf. G 1/03, point 2.5.3 of the Reasons).

The board stated that overexpression of SetA in *E. coli* was one way of performing the claimed invention that was disclosed in the patent. However, claim 1 was not limited to the overexpression of SetA. While the patent mentioned SetB and SetC, it reported no data on these two proteins or any explanation, reasoning or technical basis.

With respect to G 2/21, the board observed that G 2/21 held that "the term 'plausibility' [...] does not amount to a distinctive legal concept or a specific patent law requirement under the EPC", and that G 2/21 explicitly ruled on plausibility only in the context of Art. 56 EPC, distinguishing it from the context of Art. 83 EPC. Therefore, in the board's view nothing could be gained by the respondent (patent proprietor) by referring to plausibility in the given context. Moreover, contrary to the respondent's assertion, the opposition division did not find that "the patent specification already contains experimental evidence showing the plausibility of the claimed technical effect" but that the possibility that "... for all three setA, B, and C" was not "inherently implausible". The board held, however, that something not inherently implausible was not necessarily sufficiently disclosed. And the opposition division had not explained why it was not "inherently implausible".

The skilled person wanting to perform the claimed invention had to test the Set family members including SetB and SetC with no guarantee that any of the tested proteins would work. In view of the case law summarised by the board, this amounted to an undue burden, even if it involved routine experimentation.

In conclusion, there was no relevant guidance in the patent application and the common general knowledge on SET family proteins, except SetA. The patent application and the prior art did not demonstrate that any teaching shown in the patent on SetA could be extended to other SET family proteins, including SetB and SetC. The appellant was therefore under no obligation to provide further experimental evidence to support the insufficiency objection. The main request did not meet the requirements of sufficiency of disclosure. The lack of disclosure could not be remedied by post-published evidence. And the right to be heard did not entail the right to have post-published evidence considered.

018-02-24

Article 083 EPC | T 0748/19 | Board 3.5.06

Article 083 EPC

Case Number	T 0748/19
Board	3.5.06
Date of decision	2023.12.15
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 083, 100(b) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – invention to be performed over whole range claimed – technical field and discussion in recent case law (T 149/21 followed) – claims must be construed to exclude instances which the skilled person would "not expect to work" (no) – "technically unreasonable" instance not detrimental to sufficiency (sometimes)
Cited decisions	T 2773/18, T 1983/19, T 0814/20, T 0149/21
Case Law Book	II.C.5.2. , II.C.5.4. , 10th edition

In ex parte case [T 748/19](#) the application related to identifying events in scenes under surveillance. The board remarked in its preliminary opinion that claim 1 defined a method for identifying events without any definition of the events which were classified. Hence it covered in principle any event in video surveillance. It did not appear credible to the board that the types of data claimed, separately or in combination, contained the information needed to distinguish between all types of events. The application also remained very generic as to the implementation of the proposed concept, providing no detailed examples, and no results. Thus the application was limited to presenting a concept, the validity of which was already questionable for theoretical reasons, and which was also not established by any evidence. The application did not contain even a single detailed embodiment.

The appellant argued that it was true that the claim was based on a limited number of experiments, and that the claim scope included cases which were not covered by these experiments. But the examples were sufficient, because they illustrated how

the invention was to be implemented in general and determined the expectations of the skilled person. Implementation using a neural network, i.e. choosing a suitable architecture and training the network, was straightforward for the skilled person. If a parameter (a camera processing data type) was not useful for the scene and events considered, it would not be used in real life, because the training would not converge. The temporary identification process claimed provided scene-specific ground truth, so it reduced the claimed scope and training requirements. Moreover, the skilled person would have an understanding of which parameters were affected by which of the considered events. In its view, the board in its preliminary opinion had an incorrect understanding of what the skilled person in the art would expect.

The board agreed that the skilled person would be able to choose an architecture for a neural network and carry out its training if a set of camera parameters and events to be identified were defined. However, this was insufficient to establish compliance with Art. 83 EPC in the present case. That was because the claimed invention was not characterised only by it being a neural network, but also, perhaps primarily, by its purpose, that of being able to (reliably) identify events. This purpose must be achieved in different scenarios, also corresponding to different sets of events.

The board explained that it was for the applicant who drafts the claims to define the protection it was seeking. If it was clear that the claim intentionally covered certain matter, then this matter was part of the claimed invention and the fact that it could not be carried out could not be ignored (sufficiency of disclosure). Therefore, the board disagreed with the idea that the claims had to, a priori, be construed to exclude instances which the skilled person would "not expect to work", or which only after trial and error turned out not to work.

The board agreed that it may sometimes be the case that "technically unreasonable" instances of the claimed subject-matter should not be detrimental to sufficiency under Art. 83 EPC. When the "technically unreasonable" instance was a contrived one, i.e. one which the skilled person would, in view of the provided teaching and of the claimed generalisation, not consider the claim to cover, this instance should not be covered. However, non-contrived instances where it was clear that the claim intended to cover them, should be taken into account for assessing sufficiency of disclosure (even if "technically unreasonable" – a claim to a teleporting machine).

The board concluded that on the facts the requirements of Art. 83 EPC were not met.

As to related case law, T 814/20 (video surveillance) was different. The board was also aware of discussions in recent decisions and agreed with T 149/21 that there was no basis in the EPC for applying different standards for compliance with Art. 83 EPC depending on the technical field. The board considered also T 1983/19.

Article 083 EPC | T 1779/21 | Board 3.3.04
Article 083 EPC

Case Number	T 1779/21
Board	3.3.04
Date of decision	2023.12.19
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – evidence of therapeutic effect – absence of experimental data – credibility – level of proof required – serious nature of the disease
Cited decisions	G 0001/03, G 0002/21, T 0609/02, T 0754/11, T 0887/14
Case Law Book	II.C.7.2.2 , 10th edition

In [T 1779/21](#), the board, stressing that G 2/21 confirmed most of the case law on sufficiency of disclosure, summarised in this respect the contribution of G 2/21 (points 74, 77 of the Reasons) as to whether a therapeutic effect had been shown to be achieved, notably that "it is necessary that the patent at the date of its filing renders it credible that the known therapeutic agent, i.e. the product, is suitable for the claimed therapeutic application" and that "the proof of a claimed therapeutic effect has to be provided in the application as filed, in particular if, in the absence of experimental data in the application as filed, it would not be credible to the skilled person that the therapeutic effect is achieved. A lack in this respect cannot be remedied by post-published evidence."

The present board noted that the Enlarged Board endorsed the conclusions in T 609/02 (G 2/21, point 75 of the Reasons), and decisions T 754/11 and T 887/14. The expression "proof of a claimed therapeutic effect" in point 77 of the Reasons could therefore not be interpreted as a deviation from the established case law in the context of second medical uses: it did not apply a stricter requirement than the established case law prior to decision G 2/21. Rather, the Enlarged Board confirmed

that means other than experimental data in the application as filed could establish proof of a claimed therapeutic effect.

What is required, however, in the absence of experimental evidence, is for the patent or the application as filed to provide some information demonstrating that the claimed compound had a direct effect on a metabolic mechanism specifically involved in the disease, this mechanism being either known from the prior art or demonstrated in the patent itself (see T 609/02, points 5 to 9 of the Reasons). The board also quoted G 1/03 (point 2.5.3 of the Reasons – contribution to the state of the art). The board concluded that a contribution to the state of the art which enabled the skilled person to carry out the invention had to be present in the application as filed.

The patent related to the treatment of Dravet syndrome with fenfluramine. Dravet syndrome is a rare and catastrophic form of intractable epilepsy that begins in infancy. It had in the present case to be decided whether fenfluramine as a monotherapy, i.e. as the sole therapeutic agent, could be considered suitable for the treatment of Dravet syndrome at the relevant date. In the absence of experimental data for fenfluramine monotherapy in the application as filed, the board considered whether achieving the claimed therapeutic effect was made credible in the application as filed in another way. "Monotherapy" was explicitly mentioned in the application as filed as an alternative to combination therapy. However, this mere statement was not in itself sufficient to provide any "proof" in the sense of decision G 2/21. Until the present invention was made, it was not known that fenfluramine's mechanism of action had made it suitable for the treatment of Dravet Syndrome. The board noted that treatment by therapy did not per se necessitate a complete cure of the disease or even the addressing of its cause, but did include the alleviation of symptoms.

Although the skilled person could conclude, from the data in the application as filed, that fenfluramine in combination with valproate alleviated some symptoms of Dravet syndrome, it was not clear whether this also applied in a monotherapy. In this particular case, namely a very serious disease for which an established, albeit sub-optimal, therapy exists and where a wrong therapy decision could lead to irreversible damage, the level of proof required had to be at least such that the skilled person had reason to assume that the standard valproate treatment could be discontinued and replaced by fenfluramine without worsening the condition of the patient.

From the technical teaching of the application as filed, even taking into account the prior art, therapeutic effect was not credibly achieved. In line with decision G 2/21, the board did not take the post-published data into account. Sufficiency of disclosure was not satisfied. The opposition division's decision was set aside and the patent revoked.

Article 083 EPC | T 1942/21 | Board 3.3.05

Article 083 EPC

Case Number	T 1942/21
Board	3.3.05
Date of decision	2024.01.19
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b) EPC
EPC Rules	Rule 043(3) EPC
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – invention to be performed over whole range claimed – open ended range
Cited decisions	T 0412/93, T 0136/04, T 1018/05, T 1697/12, T 0398/19, T 0615/19, T 1945/19, T 1586/20
Case Law Book	II.C.5.4. , II.C.5.5.2 , 10th edition

In [T 1942/21](#) stellte sich die Frage, ob die Fachperson genügend Anleitungen im Patent erhält, wie hohe Anteile an Methan im Synthesegas erhalten werden können.

Der Argumentation der Beschwerdeführerin (Patentinhaberin), dass diese Frage sich gar nicht stelle, da ohne Angabe einer Untergrenze für Methan kein Ausführbarkeitsproblem vorgelegen hätte, stimmte die Kammer nicht zu. Würde diese Argumentation gutgeheißen, so könnte eine Einschränkung eines Anspruchs durch einen nicht-ausführbaren Parameter nicht bemängelt werden, da der breitere Anspruch ohne den Parameter ja wahrscheinlich kein Ausführbarkeitsproblem aufwies. Es ist jedoch etablierte Rechtsprechung, dass, wenn ein wesentliches Merkmal einer Erfindung durch einen Parameter ausgedrückt wird, sich die Frage stellt, ob der Parameter so definiert ist, dass es der Fachperson möglich ist, anhand der Offenbarung in ihrer Gesamtheit und mithilfe des allgemeinen Fachwissens ohne unzumutbaren Aufwand die technischen Maßnahmen zu identifizieren, die zum beanspruchten Gegenstand führen. Diese Sichtweise ist auch im Einklang mit Entscheidungen, die abhängige, also eingeschränkte Ansprüche als nicht ausführbar ansahen, ohne den breiteren unabhängigen Anspruch wegen fehlender Ausführbarkeit zu bemängeln.

Dies bedeutet für den vorliegenden Fall, dass das Patent ausreichend Anweisungen enthalten muss, wie das jetzt wesentliche Merkmal, das sozusagen das zu erreichende Ergebnis definiert, nämlich einen Methananteil von mehr als 12 Vol-% im Synthesegas zu erhalten, über die gesamte Breite verwirklicht werden kann. Dieses Merkmal ist das Wesen der Erfindung, da Synthesegas mit weniger Methan bereits bekannt war. Deshalb sollte die Lehre des Patents es erlauben, dieses neue Merkmal über den gesamten beanspruchten Bereich zu erhalten. Obwohl der vorliegende Fall ein zu erreichendes Ergebnis einer chemischen Reaktion betrifft und nicht einen physikalischen Parameter, ist er trotzdem ähnlich gelagert wie der in der Rechtsprechung zitierte Fall T 1697/12 (dort waren bestimmte realistische Werte durch das offenbarte Verfahren nicht erreichbar weshalb auch die Ausführbarkeit verneint worden war).

Im vorliegenden Fall führt die Einführung der Methanmenge im Synthesegas dazu, dass dieses Merkmal wesentlich ist (R. 43 (3) EPÜ) und sich somit die Frage stellt, wie das beanspruchte Ziel über den gesamten Bereich erreicht werden kann. Das Patent enthält Informationen wie die Untergrenze von 12 Vol-% Methan überschritten werden kann. Jedoch gab es keinerlei Informationen im Patent, wie Methanmengen von 20 bis 25% erreicht werden können, die sicherlich nicht als unrealistisch angesehen werden. Es stimmt, dass der nach oben offene Bereich durch das Verfahren an sich (Reaktion mit Wasserdampf) beschränkt ist, jedoch sind Werte im Bereich von 20 bis 25 Vol.% Methan unbestritten nicht durch diese Beschränkung ausgeschlossen. Die Kammer ist sich bewusst, dass es Entscheidungen gibt, die jedoch einen physikalischen Parameter betreffen, in denen der nach oben offene Bereich als nicht problematisch angesehen wurde. Im vorliegenden Fall ist jedoch die Situation anders.

Da es unstrittig zwischen den Parteien war, dass Methangehalte von 20 bis 25 Vol-% von dem Anspruch umfasst sind und die Lehre des Patents dahingehend nicht ausreichend ist, wird der Gegenstand des Anspruchs 1 als nicht ausführbar angesehen.

042-04-24

Article 083 EPC | T 1311/22 | Board 3.2.04

Article 083 EPC

Case Number	T 1311/22
Board	3.2.04
Date of decision	2024.01.24
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – invention to be performed over whole range claimed – functional features
Cited decisions	T 0409/91, T 0435/91, T 1697/12, T 0398/19
Case Law Book	II.C.5.4. , II.C.5.5.2. , II.C.8.1. , 10th edition

In der Sache [T 1311/22](#) definierte Anspruch 1 des Hauptantrags die beanspruchte Vorrichtung zum Staubsaugen durch funktionelle Merkmale, und zwar in Bezug auf ein zu erreichendes Ergebnis, das wiederum durch Werte des neu definierten Parameters "Qualitätsfaktor" ausgedrückt wurde.

Die Kammer rief in Erinnerung, dass nach der ständigen Rechtsprechung das Erfordernis der ausreichenden Offenbarung erfüllt ist, wenn der Fachmann die in den unabhängigen Ansprüchen definierte Erfindung über den gesamten Schutzbereich der Ansprüche anhand seines allgemeinen Fachwissens ohne unzumutbaren Aufwand ausführen kann. Dieser Grundsatz gelte auch für Erfindungen, die durch ihre Funktion definiert werden. Die Besonderheit der funktionellen Definition eines technischen Merkmals bestehe darin, dass es durch seine Wirkung definiert werde. Eine solche Definition beziehe sich ganz abstrakt auf eine unbestimmte Vielzahl möglicher Alternativen und sei solange zulässig, wie alle Alternativen dem Fachmann zur Verfügung stehen und das gewünschte Ergebnis liefern. Deshalb müsse geprüft werden, ob das Patent eine verallgemeinerungsfähige technische Lehre offenbart, die dem Fachmann das ganze Variantenspektrum, das unter die funktionelle Definition fällt, zugänglich macht.

Die Kammer verwies auch auf den Grundsatz, dass der Schutzbereich eines Patents dem technischen Beitrag entsprechen muss, den die Offenbarung der darin beschriebenen Erfindung zum Stand der Technik leistet. Daher darf sich das mit dem Patent verliehene Monopol nicht auf Gegenstände erstrecken, die dem Fachmann auch nach der Lektüre der Patentschrift noch nicht zur Verfügung stehen. Die vorhandenen Informationen müssen den Fachmann in die Lage versetzen, das angestrebte Ergebnis im gesamten Bereich des Anspruchs, der die betreffende funktionelle Definition enthält, ohne unzumutbaren Aufwand zu erreichen.

Bei ihrer detailliert erläuterten Anwendung dieser Grundsätze auf den konkreten Fall führte die Kammer u. a. Folgendes aus: Die Angabe zu Parametern, die den Qualitätsfaktor beeinflussen, sei sehr allgemein und derart unspezifisch, dass sie sich aufgrund der unzähligen Varianten von Staubsaugergeräten und Filterbeuteln unterschiedlichsten Aufbaus und Materialbeschaffenheit nicht ohne unzumutbaren Aufwand umsetzen lasse. Auch die sehr spezifischen Ausführungsbeispiele gäben dem Fachmann keine Anhaltspunkte dafür, welche der zahlreichen Merkmale und Maßnahmen – ob alle oder nur bestimmte davon – für die Erzielung der beanspruchten Qualitätsfaktoren ausschlaggebend seien, so dass er den Anspruchsgegenstand auch durch zielgerichtete Auswahl anderer geeigneter Paarungen von Filterbeuteln und Staubsaugergeräten sowie gegebenenfalls weitere geeignete Maßnahmen ohne unzumutbaren Aufwand realisieren könnte. Die Kammer erläuterte zudem, dass der Schutzbereich von Anspruch 1 breite Bereiche für die Qualitätsfaktoren beinhalte, die nicht implizit durch Verknüpfung mit anderen Merkmalen oder Angaben auf gewisse einschätzbare Obergrenzen begrenzt seien, wodurch auch Vorrichtungen mit noch unbekanntem, zukünftigen Komponenten erfasst würden. Demgegenüber seien nur ganz konkrete Ausführungsbeispiele offenbart, die eine sehr begrenzte Verbesserung der Qualitätsfaktoren ermöglichten.

Die Kammer wies auch darauf hin, dass die Beschwerdegegnerin nicht bestritten hatte, dass Anspruch 1 Ausführungsformen umfasst, die durch andere als die spezifisch in den Ausführungsbeispielen vorgeschlagenen Merkmale und Maßnahmen realisiert werden könnten. Die Beschwerdegegnerin argumentierte, zukünftige Erfindungen, die Qualitätsfaktoren im beanspruchten Bereich auf andere Weise bereitstellten, seien wie üblich abhängige Erfindungen und könnten selbst Patentschutz erlangen. Dies sei bei Grundlagenerfindungen immer der Fall. Die Kammer konnte aber eine solche im vorliegenden Fall nicht erkennen.

Voraussetzung für die Inanspruchnahme eines Schutzbereichs ist zumindest, so die Kammer, dass der Fachmann aus dem Patent einen Weg zur Ausführung oder wenigstens Weiterentwicklung der beanspruchten Erfindung über den gesamten Schutzbereich ableiten kann. Diese Voraussetzung sah die Kammer vorliegend als nicht erfüllt an.

Article 083 EPC | T 0025/20 | Board 3.3.02
Article 083 EPC

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

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

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

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

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

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

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

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

068-06-24

Article 083 EPC | T 0553/23 | Board 3.5.01

Article 083 EPC

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

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

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

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

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

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

112-10-24

Article 083 EPC | T 1669/21 | Board 3.2.03

Article 083 EPC

Case Number	T 1669/21
Board	3.2.03
Date of decision	2024.07.23
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – reproducibility (no) – alleged learning machine – precise knowledge of parameters allegedly not necessary due to ability of learning machine to predict by self-learning – alleged irrelevant alternatives filtered out automatically – no concrete examples – lack of detail of disclosure – breadth of the claim
Cited decisions	G 0001/03, T 0923/92, T 0161/18, T 1983/19
Case Law Book	II.C.6.1 , II.C.5.4 , 10th edition

In [T 1669/21](#), machte die Beschwerdeführerin (Patentinhaberin) geltend, die Erfindung sei auch ohne ein konkretes Ausführungsbeispiel im Patent deutlich und vollständig offenbart. Bei dem anspruchsgemäßen Rechenmodell handele es sich um ein Modell des maschinellen Lernens. Angesichts des rasanten Fortschritts sei auch das Erstellen eines geeigneten Rechenmodells des maschinellen Lernens, (anders als in T 161/18) mittlerweile Gegenstand des allgemeinen Fachwissens und bedürfe keiner ausdrücklichen Offenbarung. Die Erfindung strebe eine "umfassende Lösung" zur Vorhersage des Verschleißes der feuerfesten Auskleidung eines metallurgischen Gefäßes an.

Der Begriff "Rechenmodell" war für die Kammer auch im Zusammenhang mit einer Anpassung ("adaptiert") nicht auf ein Modell aus dem Bereich des maschinellen Lernens eingeschränkt. So ist die Tatsache, dass das Modell "adaptiert wird" nicht gleichbedeutend damit, dass das Modell "adaptiv" ist, sich also selbst anpasst bzw. selbstlernend ist. Anspruch 1 war daher nicht auf ein Verfahren zum maschinellen Lernen beschränkt. Für ein solches Rechenmodell gab das Patent weder ein Beispiel

noch Anhaltspunkte für die zu modellierenden Zusammenhänge. Schon aus diesem Grund erfüllte der Hauptantrag nicht die Erfordernisse von Art. 83 EPÜ.

Die Ausführbarkeit der Erfindung wurde auch hinsichtlich des von Anspruch 1 mitumfassten Modells maschinellen Lernens geprüft. Das Streitpatent machte hierzu keinerlei Angaben im Unterschied zu T 161/18, wo das verwendete neuronale Netz spezifiziert wurde.

Eine Vielzahl an Möglichkeiten für die Ausgestaltung eines Rechenmodells bestand. Das vorgetragene Fachwissen enthielt jedoch keine Informationen zu den spezifischen Anforderungen, und das Patent enthielt hierzu auch keine. Daher lag bereits in der Wahl eines konkreten geeigneten Rechenmodells des maschinellen Lernens für den Fachmann eine erhebliche Hürde für die Ausführbarkeit der Erfindung. Selbst wenn, wäre der Fachmann dabei auf sich allein gestellt, aus der Vielzahl an möglichen Eingangsgrößen diejenigen Kombinationen auszuwählen. Schon jeder einzelne derartige Versuch für sich genommen stellte einen erheblichen Aufwand dar. Mangels eines konkret nacharbeitbaren Ausführungsbeispiels als Ausgangspunkt im Patent oder einer sonstigen spezifischen Anleitung, welche Parameter relevant sind, fehlte zudem ein Beleg für die grundsätzliche erfolgreiche Ausführbarkeit der Erfindung mit einem anspruchsgemäß trainierten Rechenmodell. Die Beschwerdeführerin trug hierzu vor, es sei nicht erforderlich, weil es gerade das Wesen des maschinellen Lernens sei, dass die Fähigkeit zur Vorhersage der Ausgangsgröße ohne Kenntnis der kausalen Zusammenhänge durch Training selbstlernend erworben werde. Dabei werde der Einfluss irrelevanter Eingangsgrößen von selbst herausgefiltert. Laut der Kammer enthielt die Patentschrift kein einziges konkret nacharbeitbares Ausführungsbeispiel und keine Anhaltspunkte oder Kriterien zur Auswahl geeigneter konkreter Parameter innerhalb der beanspruchten Kategorien.

Bezüglich Menge und Qualität der Trainingsdaten (s. auch T 161/18), wurde das Rechenmodell nur mit einem reduzierten Datensatz trainiert. Die vorgetragene Art der Ausführung der Erfindung und der Trainingsdatenerfassung war nicht im Streitpatent offenbart. Die Beschwerdeführerin konnte nicht plausibel darlegen, dass das Rechenmodell mit einem solchen eingeschränkten Trainingsdatensatz erfolgreich trainiert werden kann. Somit war die Offenbarung des Patents auch bezüglich des für den Erfolg der Erfindung entscheidenden Aspekts der Trainingsdaten allgemein und unvollständig. Der fehlende Detailgrad dieser Offenbarung im Patent stand in keinem Verhältnis zur Breite der beanspruchten Erfindung und dem entsprechenden Aufwand für einen Fachmann, die Lücken zu füllen, um die Erfindung (über ihre Breite hinweg) ausführen zu können.

Article 084 EPC | T 0438/22 | Board 3.4.03

Article 084 EPC

Case Number	T 0438/22
Board	3.4.03
Date of decision	2023.11.23
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Ex parte
EPC Articles	Articles 010(2)(a), 069, 084, 094(3), 112(1)(a), 112(3) EPC
EPC Rules	Rules 042, 048, 071(1) EPC
RPBA	
Other legal provisions	Guidelines F-IV, 4.4 – March 2021 and March 2023 versions
Keywords	claims – support in the description – claim interpretation – adaptation of the description – claim-like clauses – referral to the Enlarged Board (no)
Cited decisions	T 0454/89, T 0749/00, T 1808/06, T 1399/17, T 2766/17, T 1024/18, T 1968/18, T 1989/18, T 2293/18, T 1473/19, T 2194/19, T 2685/19, T 2968/19, T 3097/19, T 0169/20, T 1444/20, T 0121/20, T 1516/20, T 1426/21
Case Law Book	II.A.5.3. , II.A.6.3.2. , II.E.1.14.2. , V.B.2.1. , V.B.2.3.1. , V.B.2.3.6. , 10th edition

In [T 438/22](#) the board pointed out that there was no provision stipulating that examples within the meaning of R. 42(1)(e) EPC should not be in the form of claim-like clauses (i.e. in the form of one or more independent clauses followed by a number of clauses referring to previous clauses) at the end of or in another part of the description. There was no justification for deleting such examples just because they were drafted as claim-like clauses. They were to be treated like any other part of the description and thus, inter alia, must support the claims (Art. 84 EPC). It was not justified to unconditionally require their deletion from the description, contrary to what was stated in the Guidelines (F-IV, 4.4).

Concerning the interpretation of the requirement of Art. 84 EPC that the claims must be supported by the description, the board disagreed with the findings of T 1989/18. The board also disagreed that R. 48(1)(c) EPC could not provide a legal basis for an obligatory adaptation of the description. On the contrary, the board agreed with the

long-established case law of the boards that "supported by the description" meant requiring the entirety of the description to be consistent with any claims found to meet the requirements of the EPC (see T 1024/18, T 1808/06, T 2293/18, T 1399/17, T 2766/17, T 1516/20, T 121/20, T 1968/18, T 2685/19).

According to the board, it was a general and overarching objective, and as such also a "requirement" of the Convention, that authorities, courts and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter. The only tool for achieving this objective was the patent specification as the expression of a unitary legal title. The description, as an integral part of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims. If the description contained subject-matter which manifestly impeded a common understanding, it was legitimate to insist on its removal under Art. 84 and 94(3) EPC and R. 42, 48 and 71(1) EPC. Regarding the provisions of R. 48(1) EPC, including those of R. 48(1)(c) EPC, the board found that they were not to be regarded as merely optional guidelines but as mandatory and to be complied with for a patent to be granted on a European patent application.

The board approved of the practice where instead of a direct removal, i.e. the deletion of the subject-matter not covered by the claims, a "removal" by way of an appropriate statement is made, leaving the technical disclosure unaffected. In the view of the board, this practice resulted in a correct and equitable compromise between the interests of the applicant to retain the disclosed subject-matter and the overall purpose of the description to facilitate claim interpretation and the common understanding of the claimed subject-matter.

Moreover, the board refused the request for referral to the Enlarged Board of questions relating to the rejection of an application due to the usage of claim-like clauses. The appellant submitted, among others, that a decision of the Enlarged Board was necessary as the Guidelines would have to take into account a decision by the Enlarged Board, which "might put an end to the current discrepancy between the Guidelines and the case law". The board admitted that the wording of Art. 112(1)(a) EPC may appear to suggest that the removal of a discrepancy between the Guidelines and the case law could also be understood as "ensuring uniform application of the law" and as such be a good reason for an admissible referral. However, the Enlarged Board had no formal powers in this respect. According to the board, this could be inferred from Art. 112(3) EPC which made it clear that the formal binding power of the decision of the Enlarged Board was limited to the case before the referring board. The board concluded that a referral whose sole purpose was to correct the Guidelines and which was not necessary either for ensuring a uniform case law within the boards or for the board's decision was inadmissible. Such a referral could be perceived as an attempt to encroach on the President's powers under Art. 10(2)(a) EPC.

008-01-24

Article 084 EPC | T 0223/23 | Board 3.3.07
Article 084 EPC

Case Number	T 0223/23
Board	3.3.07
Date of decision	2024.01.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – essential features – support in the description (yes)
Cited decisions	T 0242/92, T 0809/12
Case Law Book	II.A.3.2. , II.A.5.1. , 10th edition

In [T 223/23](#) claim 1 of the main request was directed at a product as such, namely a trace element solution. It clearly defined the solution by its technical features, i.e. the types and amounts of the trace elements (zinc, manganese, selenium and copper) dissolved therein.

The examining division had found that the criteria of Art. 84 EPC were not met because it was the process of manufacturing that provided the increased concentrations of trace elements in solution. In its view, claim 1 was not supported because it lacked the essential features defining the identity of the product. Moreover, the examining division held that claim 1 defined the trace element solution by a result to be achieved, namely trace elements at high concentrations being able to remain in solution, but claim 1 did not state the essential features necessary to achieve this result.

The board disagreed with the views of the examining division. The board noted that defining the claimed product in terms of the process used for its preparation, i.e. by a product-by-process feature, could only further characterise the composition insofar as this process gave rise to a distinct and identifiable characteristic of the product. In this sense, the steps of the process could not themselves be regarded as essential features of the product: at most the technical features imparted by this process to the resulting product could represent such essential features.

The board understood the examining division's conclusions to be motivated by the finding that the preparation of a trace element solution with the claimed high concentration could not be achieved in the prior art and was part of the problem to be solved mentioned in the application, and that the process disclosed in the application was the first process to allow such a preparation. In contrast, the board held that this situation did not justify that each and every feature imparted by the process shown in the example to the resulting composition be seen as an essential feature. As explained in T 242/92, the mere fact that only one way of carrying out the invention was indicated did not in itself offer grounds for considering that the application was not entitled to broader claims. A lack of support would only arise if there were well-founded reasons for believing that the skilled person would be unable to extend the particular teaching of the description to the whole of the field claimed by using routine methods. In the underlying case the absence of reference in claim 1 to the EDTA used in the example did not lead to a lack of support, considering that the description mentioned EDDS as an alternative, and considering the absence of an indication that the skilled person could not use other chelants. Moreover, the board noted that the examining division had not determined which feature of the trace element solution would be missing from claim 1 and would be essential for obtaining the high concentration recited in the claim.

The board concluded that even if, according to the description, the invention aimed at providing a highly concentrated trace element solution, and provided for the first time a process allowing the preparation of such a highly concentrated solution, this did not mean that the claims should be limited to that particular process or to a solution defined in terms of that particular process for them to comply with Art. 84 EPC.

019-02-24

Article 084 EPC | T 0712/21 | Board 3.3.06
Article 084 EPC

Case Number	T 0712/21
Board	3.3.06
Date of decision	2023.10.16
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – essential features – clarity (yes) – broad claim
Cited decisions	
Case Law Book	II.A.3.3. , II.A.3.4. , 10th edition

In [T 712/21](#) the applicant filed an appeal against the decision of the examining division to refuse the patent application for non-compliance among others with the requirements of Art. 84 EPC. The examining division had argued that the invention was defined in terms of a result to be achieved, namely hydrodeoxygenation (hereinafter "HDO") and hydrodewaxing (hereinafter "HDW") steps, for which no indication was given as to the extension of the desired reactions. According to the examining division, in order to meet the requirements of Art. 84 EPC, the claim should have defined all the essential features for carrying out the HDO and the HDW steps.

The board, however, noted that HDO and HDW were well-known chemical processes in the field of petrochemistry. Thus, the features relating to these processes should be treated as allowable functional definitions rather than as results to be achieved. In this respect, the board stated that an objection of essential feature(s) missing should in principle be raised where a claim defines an effect or result which is technically challenging in the sense that a skilled person reading the claim and applying common knowledge would not know how to achieve it without the information provided by the omitted (essential) feature(s). In the current case, however, the claimed subject-matter defined the active metals in the catalysts and the operating ranges necessary to carry out the HDO and HDW reactions, and so the claim included all the essential features of the invention.

In the board's view the features HDO and HDW also met the requirement of clarity under Art. 84 EPC. In this respect, the board emphasised the differences between lack of clarity and breadth of the claims. A feature may be considered to be unclear if its boundaries are diffuse, leaving the reader in doubt as to whether certain embodiments fall within or outside the scope of protection. This generally occurs when the feature is defined in confusing or incomplete terms (e.g. an ill-defined parameter) and/or when it is inherently unsuited for providing a well-defined scope (e.g. relative terms). On the contrary, features with generally accepted meanings should not be considered unclear just because they are broadly defined.

The board stated that it was undisputed that the terms "HDO" and "HDW" had a generally accepted meaning in the underlying technical field. Therefore, although it could be argued that the scope of these features could overlap with that of similar processes (e.g. does a hydrotreating process fall within or outside the scope of HDO?, or does a hydroisomerisation step fall within or outside the scope of HDW?), such challenges did not arise due to a faulty or incomplete definition, but because language cannot comprehensively capture every detail of real-life objects or processes, an issue which becomes more pronounced when features are broadly defined. The board therefore considered that the basic question to be asked was whether the vagueness of the scope of protection was the result of an incorrect, incomplete or relative feature, or whether it was simply the result of the inherent ambiguity of technical terms. In the present case, the board concluded that the features HDO and HDW would be clear to a person skilled in the art and that any ambiguity in distinguishing them from other similar processes should be attributed to the inherent limitations of technical language.

The board also noted that the above conclusions were consistent with, and to some extent explained, the well-established practice of giving technical terms their broadest reasonable technical meaning when assessing patentability.

Therefore, the board decided that the requirements of Art. 84 EPC were met.

032-03-24

Article 084 EPC | T 0447/22 | Board 3.2.05
Article 084 EPC

Case Number	T 0447/22
Board	3.2.05
Date of decision	2023.09.28
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 084, 100, 101(3) EPC
EPC Rules	Rule 080 EPC
RPBA	
Other legal provisions	
Keywords	claims – claim interpretation – using description and drawings to interpret the claims – limits – adaptation of the description
Cited decisions	G 0010/91, G 0003/14, T 0977/94, T 0367/96, T 0433/97, T 0881/01, T 0556/02, T 1018/02, T 0431/03, T 0323/05, T 1808/06, T 0197/10, T 1597/12, T 1646/12, T 1249/14, T 1817/14, T 1391/15, T 2766/17, T 1024/18, T 2293/18, T 2391/18, T 3097/19, T 0169/20
Case Law Book	II.A.5.3. , II.A.6.3.1 , 10th edition

In [T 447/22](#) the board construed the "steering device" in claim 1 as an actual physical component of the machining device which was adapted for actively controlling the direction of the machining device.

The board recalled that it was a general principle applied throughout the EPC that a term of a claim could be interpreted only in context. The claims did not stand on their own, but together with the description and the drawings they were part of a unitary document, which must be read as a whole (see e.g. T 556/02, T 1646/12, T 1817/14 and T 169/20). The board stressed that the extent to which description and drawings could provide an aid to interpret the claims was however subject to certain limitations. In particular, a claim could be interpreted in the light of the description and the drawings to the extent that they contained logical and technically sensible information. Furthermore, interpreting the claim in the light of the description and the drawings did not make it legitimate to read into the claim features appearing only in the description or the drawings and then relying on such features to provide a distinction over the prior art. This would not be to interpret claims but to rewrite them (see T 881/01). Many decisions of the boards of appeal had concluded that a

discrepancy between the claims and the description was not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently (see, for example, T 431/03, T 1597/12, T 1249/14). The description could not be used to give a different meaning to a claim feature which in itself imparted a clear, credible technical teaching to the skilled reader (T 1018/02, T 1391/15). On a similar note, the board in T 197/10 had held that, in the event of a discrepancy between the claims and the description, those elements of the description not reflected in the claims were not, as a rule, to be taken into account for the examination of novelty and inventive step.

In the present case, the board concluded that, despite the inclusion of several examples without a steering device in the paragraphs referring to embodiments of the invention, the description was consistent with the board's interpretation of "steering device" in claim 1. Only one sentence in paragraph [0030] stood out, since it stated that the "springy protruding parts act as the steering device". In the board's view, taking account of this deviant note would mean ignoring the natural reading of the claim and disregarding the extensive contextual information provided by the rest of the description. It could only lead to a technically discrepant claim interpretation which the skilled person would be unwilling to adopt and would actually deprive the claims of their intended function. The board noted that the Regional Court of Düsseldorf reached a different conclusion in its judgement concerning infringement proceedings on the patent in suit.

Regarding adaptation of the description, the board concurred with the large body of case law of the boards of appeal according to which Art. 84 EPC is the basis for bringing the description in line with the amended claims in order to avoid inconsistencies (see, for example, T 977/94, T 1808/06, T 2293/18). Hence, any disclosure in the description and/or drawings inconsistent with the amended subject-matter should normally be deleted or a statement should be added that an embodiment was not covered by the claims (see e.g. T 1808/06).

In the underlying case the board agreed with the submissions of the opponents (appellants II and III) that the amended description still contained passages that were inconsistent with a claim of auxiliary request 2. The board noted, however, that these inconsistencies had already existed in the patent as granted. In this context, it pointed out that the Enlarged Board of Appeal had concluded in G 3/14 that a granted claim may turn out not to comply with Art. 84 EPC but that "such non-compliance must be lived with" (see point 55 of the Reasons). By analogy, the same must apply in respect of a claim amended in opposition proceedings where a non-compliance with Art. 84 EPC – whether concerning a lack of clarity or a lack of support by the description – already existed in the patent as granted. Since neither clarity nor lack of support as expressed in Art. 84 EPC constituted a ground for opposition under Art. 100 EPC, it must thus be accepted that the removal of an inconsistency between description and claims was not possible in such a case (see, for example, T 433/97, T 367/96 of 3 December 1997, T 1808/06, T 2391/18). Hence, the board concluded that the inconsistencies raised were not open to examination in opposition appeal proceedings, in accordance with decision G 3/14.

Article 084 EPC | T 0147/22 | Board 3.3.07
Article 084 EPC

Case Number	T 0147/22
Board	3.3.07
Date of decision	2024.01.18
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	
Keywords	claims – clarity (yes) – expression "consisting essentially of" – functional definition of ingredients
Cited decisions	T 0472/88
Case Law Book	II.A.3.4. , II.A.6.2. , II.A.3.3. , 10th edition

In [T 147/22](#) the respondent (opponent) raised several clarity objections, which were mainly directed to the expression "consisting essentially of" and to the fact that the ingredients cited in claim 1 were associated with a function.

On the first aspect, the board noted that the expression "consisting essentially of" limited the ingredients in the composition of claim 1 to those defined in components (a) to (d), although further non-active ingredients could be present provided they did not materially affect the chemical stability of TAS-102. The respondent had argued that the expression "consisting essentially of" rendered claim 1 unclear because the skilled person would not know which were the compounds that did not impair the stability of TAS-102 in the composition, and the patent did not contain any information in that respect. According to the board, however, the nature and amount of those additional ingredients was strongly limited by the condition that they must not impair TAS-102 stability. Furthermore, the skilled person confronted with a composition containing components (a) to (d) and additional ingredients could easily determine whether or not the additional ingredients impair TAS-102 stability. Testing the chemical stability of active compounds in a composition was standard practice in the field of pharmaceutical formulations. Such tests were illustrated in Test Examples 1 to 5 of the patent for the particular case of TAS-102. Therefore, the skilled person could easily determine by standard comparative tests whether or not a given composition consisted essentially of components (a) to (d).

With regard to the functional definition of the ingredients in claim 1, the board held that the criterion for assessing whether a compound had the function assigned to it was the function (or functions) that the skilled person would assign to that compound in the context of a given formulation. Contrary to the respondent's view, the formulator's intention was irrelevant in that respect. It was undisputed that the functional features "excipient", "disintegrating agent", "binder", "lubricant", "flavouring agent", "colourant" and "taste-masking agent" were standard in the technical field of pharmaceutical formulations. The skilled person would have no difficulty in determining whether a given formulation ingredient fulfils one or more of these functions on the basis of common general knowledge. These were functional features which were generally allowed if the invention could not be defined more precisely without unduly restricting the scope of the invention. Furthermore, in the present case, the main ingredients were not solely defined by functional features. They were further limited by structural features: for instance, the excipient according to component (b) was selected from lactose, sucrose, mannitol and erythritol. In view of common general knowledge and the structural limitations of the functional features, the board considered that the definition of the ingredients in claim 1 was not unclear.

The respondent's objection was based on the possibility that an ingredient fulfilled more than one function and, depending on its function, the amount of the compound in the composition could vary. For instance, polyvinyl alcohol was generally known to be a binder and a lubricant. If it was considered a binder, it could be present in an amount of 0.001 to 5% by mass while it could not be present if it was considered a lubricant.

The board disagreed. The fact that polyvinyl alcohol was known to be a binder and a lubricant did not render the claim unclear. If polyvinyl alcohol was present in the composition, it necessarily played the role of a binder, even if it also fulfilled the function of a lubricant. Therefore, it should be counted as a binder that may be present in an amount of 0.001 to 5% by mass in the composition. Considering arbitrarily that polyvinyl alcohol could function exclusively as a lubricant and that therefore its presence would render the composition different from the one in claim 1 would be unrealistic. Certainly this was not how the skilled person would read the claim.

Moreover, the board stated that the fact that "excipient" was a very broad term did not mean that it was unclear. "Excipient" was a standard term in pharmaceutical formulations.

077-07-24

Article 084 EPC | T 1526/22 | Board 3.5.06
Article 084 EPC

Case Number	T 1526/22
Board	3.5.06
Date of decision	2024.05.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 084 EPC
EPC Rules	
RPBA	
Other legal provisions	Guidelines F-IV, 4.5.1 – March 2021 version
Keywords	claims – clarity (no) – broad but clear claim – missing essential features (no)
Cited decisions	T 0032/82, T 1055/92
Case Law Book	II.A.3.1 , II.A.3.2 , II.A.3.3 , 10th edition

In [T 1526/22](#) the application related to a method (and a corresponding apparatus) for estimating a "state" of an ego vehicle, for use in a motor vehicle driver assistance system for the ego vehicle. The examining division had objected that claims 1 and 12 failed to meet the requirements of Art. 84 EPC for two reasons:

(1) the wording "the first state and the second state each include at least one local object attribute describing a local object located in the vicinity of the ego vehicle, wherein the local object is a local vehicle" did not allow to unambiguously derive the meaning of an attribute describing a local object, for example whether it was limited or not to a colour of said local vehicle; and

(2) the wording "for a motor vehicle driver assistance for an ego vehicle" suggested that an effect supporting motor vehicle assistance was to be produced, which was however not apparent from the wording of the claim.

In both cases, it was said that claims 1 and 12 had to be limited in order for the claimed subject-matter to be in agreement with the effect and problem argued by the appellant. Reference was made in that respect to the Guidelines F-IV, 4.5.1.

As regards (1) the board considered the recited feature to be broad but not unclear: "at least one local object attribute" could be any attribute of the local vehicle that was suitable for use by a driver assistance system. It could be, for instance, the local

vehicle's position or velocity or even its colour (e.g. as it could be relevant for a classification of that vehicle).

As regards (2) the board interpreted the wording of claim 1 "an apparatus for a motor vehicle driver assistance system for an ego vehicle" as meaning an apparatus suitable for a motor vehicle driver assistance system for an ego vehicle, as is usual for a purpose feature in an apparatus claim in the form "apparatus for ...". Claim 1 did not require the claimed apparatus to be configured to provide the output of the state estimator as input to a driver assistance system.

Claim 12 was directed to "a method for estimating a state of an ego vehicle, the method being implemented on a compute module, the state being for use in a motor vehicle driver assistance system for the ego vehicle". The board noted that last statement appeared to define an intended use of the calculated state obtained by the claimed method. This was not a purpose feature of the kind "method for...", which could in certain circumstances be considered to imply a corresponding method step, but rather of the kind "data for...". The claim did not specify any method step in which the calculated state would be actually used for that purpose, nor did the claim comprise any other feature that would establish that said use was part of the claimed method, be it explicitly or implicitly. The board understood this feature as merely requiring the calculated state to be suitable for use in a motor vehicle driver assistance system for the ego vehicle, in which case there would be no clarity problem. However, in view of the other objections, this issue was left open.

Moreover, the board observed that the examining division had not referred to any specific passage of the description in support of its objections. Hence, the passage of the Guidelines F-IV, 4.5.1 "Objections arising from missing essential features", cited by the examining division, did not support the raised objections.

However, the board raised further objections and concluded that claims 1 and 12 lacked clarity under Art. 84 EPC. In particular, the board noted that according to the third and fourth embodiments, reflected in dependent claim 5, the prediction model and the update model were "combined into a combined ANN". In these embodiments, the combined ANN carried out an estimation of the second state taking as input the first state and the measurements of the second state but without necessarily performing separate prediction and update calculations, as suggested by claim 1. This cast doubt as to how the features of claim 1 related to the prediction and update elements were to be interpreted, rendering claim 1 unclear. Similar considerations applied to claim 12.

078-07-24

Article 084 EPC | T 0566/20 | Board 3.5.04

Article 084 EPC

Case Number	T 0566/20
Board	3.5.04
Date of decision	2024.02.29
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 084, 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – claim interpretation – in the context of assessing added matter
Cited decisions	T 1127/16, T 0169/20
Case Law Book	II.A.6.1 , II.E.1.3.9 , 10th edition

In [T 566/20](#) the parties disagreed on the interpretation of the feature "the position information in association with the serial number information output from the position control device".

The appellant (opponent) submitted that the position control device could output the serial number information, possibly with the position information. In their opinion, this interpretation was grammatically correct, made technical sense and was not disclosed in the application as originally filed.

In the respondent's view, it was apparent from the claim that the output from the position control device concerned the position information in association with the serial number information. The respondent also noted that this interpretation was in accordance with the disclosure of the application as filed.

The board concurred with the appellant that outputting both the position information and the associated serial number information from the position control device was technically sensible. It further agreed with the appellant that the fact that the claim did not include a step of receiving serial number information did not necessarily mean that the position control device did not receive this information. Outputting both the position information and the serial number information allowed the vision measuring system to match position information with image information by unambiguously correlating serial number information associated with, or included in, each of them.

This interpretation did not appear to give rise to incompatibilities with the remaining features of the claim.

Moreover, the board endorsed the view that a patent proprietor would be awarded an unwarranted advantage if it were allowed to restrict the claimed subject-matter by discarding at will technically reasonable interpretations in view of the description (see T 1127/16 and T 169/20). Therefore, the fact that the description and drawings support one interpretation of an ambiguous feature was not sufficient for other interpretations of the ambiguous feature that are technically reasonable in the context of the claim to be discarded.

102-09-24

Article 084 EPC | T 1726/22 | Board 3.3.05
Article 084 EPC

Case Number	T 1726/22
Board	3.3.05
Date of decision	2024.04.10
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – clarity (no) – unclear characterisation by parameters
Cited decisions	T 0849/11
Case Law Book	II.A.3.5 , 10th edition

In [T 1726/22](#) the claimed subject-matter was defined by parameters; however, even though the claims related to an acetylated wood as such, the parameters, i.e. the shrinkage ratios, were defined in relation to the wood before acetylation. The application did not mention anything regarding how the shrinkage ratios, relative to the shrinkage before acetylation, could be determined on the basis of the acetylated wood.

According to the appellant, the shrinkage ratios could be easily determined during the manufacture of the acetylated wood, during which the wood before acetylation was necessarily available and its shrinkage could thus be measured easily. The board found that this argument was not convincing. It noted that it was not enough for the requirement of clarity to be fulfilled that the parameter could be measured when manufacturing the wood, as the manufacturing method was not specified in the claim. The skilled person needs to be able to determine whether a given acetylated wood falls within the scope of the claim, the claim being directed to an acetylated wood as such. As outlined in T 849/11, an applicant who chooses to define the scope of the claim by parameters should ensure, inter alia, that a skilled person can easily and unambiguously verify whether they are working inside or outside the scope of the claim; however, in the present case, it was impossible for the skilled person faced with the acetylated wood to revert to the manufacturing process during which the shrinkage before acetylation could have been measured, or to the unacetylated wood.

The appellant also argued that the skilled person could alternatively measure the shrinkage ratio by using "a reference non-acetylated wood sample of the same wood species having similar properties". In the appellant's view this meant the same wood species of the same geographic origin, and the same part of the tree, i.e. heartwood or sapwood. The appellant submitted that the skilled person could identify the wood species by isotope analysis.

The board pointed out that using a reference wood was not suggested anywhere, let alone specified in the claim. Even if it was nevertheless assumed that the skilled person had the idea to turn to using a reference wood, they would not find any instructions on how to select a suitable reference wood. It thus could not be concluded that the skilled person would necessarily select a wood using the same criteria as identified by the appellant. Considering that the choice of the reference wood, and indeed the choice of the measuring method in general, was in no way limited, it could not be concluded that repeatable and reliable results for the shrinkage ratios would be obtained on this basis, irrespective of the question of whether such a reference wood could be reliably identified, and whether such a reference wood was at all representative of the (acetylated) wood under consideration.

The board recalled that there are cases in which it is not necessary to specify the measuring method for a parameter in the claim, namely when it is ("convincingly") shown that the method to be employed belongs to the skilled person's common general knowledge, or all the methodologies known in the relevant technical field for determining this parameter yield the same result within the appropriate limit of measurement accuracy (T 849/11); however, it was a mere assertion by the appellant that the skilled person could and would use a reference wood, and that this would lead to reliable results. This assertion was not even supported by the application, nor was any other supporting information available. By contrast with the appellant's view, it thus could not be concluded that the present case would be such an exceptional case in which it would be unnecessary to specify the measuring method. The requirements of Art. 84 EPC were therefore not met.

103-09-24

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

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

Article 087(1) EPC | T 2224/21 | Board 3.2.01
Article 087(1) EPC

Case Number	T 2224/21
Board	3.2.01
Date of decision	2024.03.20
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 087(1), 088(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority (yes) – application of G 1/22 – presumption of entitlement rebutted (no) – same invention (yes) – validity of priority date (yes)
Cited decisions	G 0001/22
Case Law Book	II.D.2.2. , II.D.3.1. , 10th edition

In [T 2224/21](#) the appellant (opponent) argued that it had not been proven that the applicant of the contested patent was the same as the applicant of the first application. It pointed out that it had been impossible for it to access all the relevant information relating to the disputed transfer because this was non-public information in the possession of the respondent (patent proprietor). Therefore, the burden of proof lay with the respondent. The appellant also argued that the contested patent did not relate to the same invention as disclosed in the priority document.

The board disagreed. On the "same applicant" argument, the board referred to the principles set out in G 1/22, which were also applicable to the case in hand. A rebuttable presumption of priority entitlement applied. This was a strong presumption under normal circumstances since the other priority requirements (which established the basis for the presumption of priority entitlement) could usually only be fulfilled with the consent and even cooperation of the priority applicant. The party challenging the entitlement to priority could thus not just raise speculative doubts but must demonstrate that specific facts support serious doubts about the subsequent applicant's entitlement to priority. In the present case, the appellant only raised speculative doubts not supported by evidence. On the contrary, the evidence presented by the respondent reinforced the strong presumption. In this context, it was not apparent to the board why the alleged failure by the respondent to provide written evidence in the form of commercial contracts or agreements between the parties should go to the detriment of the respondent. Moreover, the appellant was not

in a position in which any evidence for rebutting the presumption of entitlement would only be at the hands of the respondent. The board concluded that the respondent was entitled to the priority.

On the "same invention" argument, the appellant put forward that the contested patent related to an "electronic vapour provision device" whereas the priority document disclosed an "electronic inhalation device". A vapour provision device was not meant to be necessarily used for inhalation purposes and also covered other kind of devices such as e.g. fog machines and engines exhausting toxic vapour not envisaged by the first application. The term "electronic vapour provision device" was technically different from the term "electronic inhalation device" with the consequence that the priority document and the contested patent did not cover the same invention as required by Art. 87(1) EPC. Moreover, according to the priority document electronic inhalation devices were typically cigarette-sized devices allowing a user to inhale a nicotine or essence vapour from a liquid store by applying a suction force to a mouthpiece. Electronic vapour provision devices as recited in claim 1 of the contested patent were not intended for inhalation. In fact, the claimed device did not comprise a mouthpiece which was required in the inhalation device of the priority document for directing the flow of vapour into the user's mouth. Thus, the subject-matter of claim 1 was not directly and unambiguously derivable from the disclosure in the priority document.

The board was not convinced. In the board's opinion, the electronic vapour provision device of claim 1 as granted was also an inhalation device in the sense that the vapour delivered in the environment in which the device is operated was necessarily inhaled by any individual located nearby. Furthermore, as convincingly pointed out by the respondent, the application as originally filed described the electronic vapour provision device at issue essentially in the same way as the priority document disclosed an inhalation electronic inhalation device, i.e. as devices "allowing an user to inhale a nicotine vapour from a liquid store by applying a suction 10 force to a mouthpiece". The board also observed that the fact that the "mouthpiece" was omitted in claim 1 did not result in any new technical information because this feature was also omitted in claim 1 of the priority application. Therefore, the opposition division was correct in its finding that the patent as granted related to the same invention disclosed in the priority application.

052-05-24

Article 087(1) EPC | T 2643/16 | Board 3.3.07
Article 087(1) EPC

Case Number	T 2643/16
Board	3.3.07
Date of decision	2024.06.03
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054(2), 087(1), 088(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority (yes) – application of G 1/22 and G 2/22 – presumption of entitlement rebutted (no) – validity of priority date (yes)
Cited decisions	G 0001/22, G 0002/22
Case Law Book	II.D.2.2. , 10th edition

In [T 2643/16](#) of 3 June 2024, the board had to decide whether the applicant was entitled to claim priority from previous applications D1 and D2 when filing the application on which the patent in suit was granted. This was a final decision following interlocutory decision T 2643/16 of 16 February 2023.

The board recalled that, in accordance with the order of G 1/22 and G 2/22, it was competent to assess whether a party was entitled to claim priority under Art. 87(1) EPC. In this context, there was a rebuttable presumption that the applicant claiming priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations was entitled to claim priority. This rebuttable presumption also applied in situations such as the one in hand, in which the European patent application derived from a PCT application and the priority applicants differed from the subsequent applicant.

According to the board, the opponents did not rebut the presumption that the applicant was entitled to claim the priority from applications D1 and D2. The applicant was therefore entitled to claim priority from such applications. Consequently, documents D6, D8 and D9 did not belong to the prior art under Art. 54(2) EPC and could not be considered for assessing inventive step of the claimed subject-matter of auxiliary request 1.

092-08-24

Article 087(1) EPC | T 0419/16 | Board 3.3.04
Article 087(1) EPC

Case Number	T 0419/16
Board	3.3.04
Date of decision	2024.06.24
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 087(1), 088(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority (yes) – application of G 1/22 – presumption of entitlement rebutted (no) – validity of priority date (yes)
Cited decisions	G 0001/22, G 0002/22, T 0419/16 of 3 February 2022
Case Law Book	II.D.2.2 , II.D.3.1 , 10th edition

In [T 419/16](#) of 24 June 2024 the application on which the European patent was granted (the "application") was filed as a PCT application on 15 February 2005 (the "PCT application"). It named (i) parties A1, A2 and A3 as inventors and applicants for the United States of America (US) and (ii) corporation B1 as applicant for all other designated States. Party A4 was added under R. 92bis.1 PCT as applicant and inventor for the US. The PCT application claimed priority from a US provisional patent application filed on 17 February 2004 in the name of A1, A2 and A3, the inventors (the "priority application").

The board summarised the matters decided by it in its interlocutory decision T 419/16 of 3 February 2022. On novelty, it had noted that the disclosure in document D1, published after the priority date but before the filing date of the patent, would, in the absence of a valid priority, anticipate the subject-matter of claim 1 of auxiliary request 1. The board had decided that the subject-matter of claims 1 and 2 of auxiliary request 1 related to the same invention as disclosed in the previous application in the sense of Art. 87(1) EPC. The appellants had objected to the validity of the claimed priority querying whether a valid transfer of the right to claim priority from the priority application had taken place prior to the filing of the PCT application. Because the board's decision on this issue hinged on an answer to questions referred to the Enlarged Board of Appeal (the Enlarged Board) in consolidated cases

G 1/22 and G 2/22, the board had decided to stay the proceedings until a decision was issued by the Enlarged Board.

The board recalled that in G 1/22 and G 2/22 the Enlarged Board had decided that entitlement to claim priority (and any related assignments of priority rights) should be assessed under the autonomous law of the EPC. Furthermore, the Enlarged Board had decided that there was a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations was entitled to claim priority.

According to the board, this presumption applied in the factual situation of the case at hand. Moreover, in the situation where the PCT application was jointly filed by parties A and B, (i) designating party A (here A1, A2 and A3) as inventors and applicants for the US only and party B (here B1) for all designated States except the US, and (ii) claiming priority from an earlier patent application (here the priority application) designating party A as the applicant, the joint filing implied an agreement between parties A and B, allowing party B to rely on the priority, unless there were substantial factual indications to the contrary.

Appellant-opponent 5 argued that contrary to the opposition division's finding in the decision under appeal, there had been no valid transfer of the priority right prior to the filing of the PCT application. Appellant-opponent 5 based this objection on the reason that the transfer had not been proven by the respondent in a formal way.

In the board's opinion, in view of the Enlarged Board's decision that the joint filing of the PCT application implies an agreement between parties A and B, allowing party B to rely on the priority, the aforementioned objection could not succeed because there was no requirement under the EPC that a transfer of the priority right be proven in a formal way. Furthermore, there were no substantial factual indications brought forward by the appellants that could lead to the conclusion that the joint filing of the PCT application did not imply an agreement between the applicants of the priority application and corporation B1 as the co-applicant of the subsequent PCT application (for all States other than the US). Thus, the presumption of entitlement to priority was not rebutted, and the priority claimed from the priority application as regards the subject-matter of claims 1 and 2 was valid.

104-09-24

Article 087(1) EPC | T 2360/19 | Board 3.3.08
Article 087(1) EPC

Case Number	T 2360/19
Board	3.3.08
Date of decision	2024.03.05
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 087(1), 088(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority (yes) – application of G 1/22 – presumption of entitlement rebutted (no)
Cited decisions	G 0001/22, G 0002/22, T 0521/18, T 2719/19
Case Law Book	II.D.2.2 , 10th edition

In [T 2360/19](#) the patent was based on a European patent application which was a divisional application of an earlier European patent resulting from an international PCT application. This PCT application claimed priority from 12 US provisional applications (P1 to P12). The opposition division, applying the so-called "all applicants approach", had found that priority was not validly claimed from P1, P2, P5 and P11 because these had been filed by joint applicants (Party A1 or Party A2 being among them) and neither Party A1 nor Party A2 were named as applicants in the PCT application (and consequently in the patent in suit). This had led to a finding that the patent was not novel and to the revocation of the patent. The patent proprietors (appellants) had appealed the decision of the opposition division.

The board pointed out that there had been a dispute in the US (the inventorship dispute) regarding whether Party A1, an employee of Party A2, should also be named as one of the inventors in the PCT application (PCT/US2013/074819), and about the ownership of the patent. The inventorship dispute had been resolved in January 2018: an independent arbitrator had decided, inter alia, that neither Party A1 should be named as an inventor, nor Party A2 as a proprietor in the PCT application.

The board recalled that in G 1/22 and G 2/22 the Enlarged Board had found that "entitlement to priority should in principle be presumed to exist to the benefit of the subsequent applicant of the European patent application if the applicant claims priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations...". This presumption was based on the concept of an implicit (implied,

tacit or informal) agreement on the transfer of the priority right from the priority applicant to the subsequent applicant "under almost any circumstances". It, notably, allowed ex-post (retroactive, nunc pro tunc, ex tunc) transfers concluded after the filing of the subsequent application. The Enlarged Board had noted, however, that "the allowability of a retroactive transfer of priority rights may have limited practical relevance if priority entitlement is presumed to exist on the date on which the priority is claimed for the subsequent European application." Moreover, the Enlarged Board had found that a priority right and its transfer was a matter exclusively governed by the autonomous law of the EPC. Consequently, there was no room for the application of national laws on legal presumptions and their rebuttal.

The board further recalled that the presumption that the subsequent applicant was entitled to the priority right was a strong presumption, under "normal circumstances". It applied to any case in which the subsequent applicant was not identical with the priority applicant, and thus also to a plurality of co-applicants for the priority application regardless of the extent to which that group overlaps with the co-applicants for the subsequent application. This was the situation in the present case. Thus, the presumption of a validly claimed priority applied.

G 1/22 and G 2/22 further provided that the presumption can be rebutted to take into account "rare exceptional circumstances" where the subsequent applicant cannot justifiably rely on the priority. The rebuttable presumption thus involved the reversal of the burden of proof, i.e. the party challenging the subsequent applicant's entitlement to priority had to prove that this entitlement was missing. Just raising speculative doubts – even if these were "serious" – was not sufficient.

The board noted that the opponent's arguments were mainly based on documents concerning the resolution of the inventorship dispute, which said nothing about priority entitlement. From this, the opponents argued that these documents did not provide any basis for inferring the existence of an implicit transfer of the priority rights from Party A1/A2 to the appellants and, therefore, that the appellants had not provided evidence that they were entitled to the priority rights they claimed. According to the board, however, the presumption in G 1/22 and G 2/22 stated that the appellants do not have to provide such evidence, but the opponents have to rebut the presumption. There was no evidence that rebutted the presumption in the present case. If at all, there was evidence supporting the presumption of an implied transfer agreement. The entire purpose of the inventorship dispute was to have Party A1 named as inventor, and Party A2 as proprietor, in the PCT application. In the absence of evidence to the contrary, it was not credible that Party A1 or Party A2 would have acted in any way to invalidate the priority claim of the patent.

The board found the priority claims to be valid and remitted the case to the opposition division for further prosecution.

105-09-24

Article 087(1) EPC | T 2689/19 | Board 3.3.08
Article 087(1) EPC

Case Number	T 2689/19
Board	3.3.08
Date of decision	2024.03.05
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 087(1), 088(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority (yes) – application of G 1/22 and G 2/22 – presumption of entitlement rebutted (no)
Cited decisions	G 0001/22, G 0002/22, T 0521/18, T 2719/19
Case Law Book	II.D.2.2 , 10th edition

In [T 2689/19](#) the European patent application on which the patent was based was a divisional application of an earlier European patent resulting from an international PCT application. This PCT application claimed priority from six US provisional applications (P1, P2, P5, P11, P13 and P14). The opposition division, applying the so-called "all applicants approach", had found that priority was not validly claimed from P1, P2, P5 and P11 because these had been filed by joint applicants (Party A1 or Party A2 being among them) and neither Party A1 nor Party A2 were named as applicants in the PCT application (and consequently in the patent in suit). This had led to a finding that the patent as granted lacked novelty and to its revocation. The patent proprietors appealed the opposition division's decision.

The board pointed out that there had been a dispute in the US (the inventorship dispute) regarding whether Party A1, an employee of Party A2, should also be named as one of the inventors in the PCT application (PCT/US2013/074743), and about the ownership of the patent. The inventorship dispute had been resolved in January 2018: an independent arbitrator had decided, inter alia, that neither Party A1 should be named as an inventor, nor Party A2 as a proprietor in the PCT application.

The board recalled that in G 1/22 and G 2/22 the Enlarged Board had found that "entitlement to priority should in principle be presumed to exist to the benefit of the subsequent applicant of the European patent application if the applicant claims priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations...". This presumption was based on the concept of an implicit (implied,

tacit or informal) agreement on the transfer of the priority right from the priority applicant to the subsequent applicant "under almost any circumstances". It, notably, allowed ex-post (retroactive, nunc pro tunc, ex tunc) transfers concluded after the filing of the subsequent application. The Enlarged Board had noted, however, that "the allowability of a retroactive transfer of priority rights may have limited practical relevance if priority entitlement is presumed to exist on the date on which the priority is claimed for the subsequent European application." Moreover, the Enlarged Board had found that a priority right and its transfer was a matter exclusively governed by the autonomous law of the EPC. Consequently, there was no room for the application of national laws on legal presumptions and their rebuttal.

The board further recalled that the presumption that the subsequent applicant was entitled to the priority right was a strong presumption, under "normal circumstances". It applied to any case in which the subsequent applicant was not identical with the priority applicant, and thus also to a plurality of co-applicants for the priority application regardless of the extent to which that group overlaps with the co-applicants for the subsequent application. This was the situation in the present case. Thus, the presumption of a validly claimed priority applied.

G 1/22 and G 2/22 further provided that the presumption can be rebutted to take into account "rare exceptional circumstances" where the subsequent applicant cannot justifiably rely on the priority. The rebuttable presumption thus involved the reversal of the burden of proof, i.e. the party challenging the subsequent applicant's entitlement to priority had to prove that this entitlement was missing. Just raising speculative doubts – even if these were "serious" – was not sufficient.

The board noted that the opponent's arguments were mainly based on documents concerning the resolution of the inventorship dispute, which said nothing about priority entitlement. From this, the opponents argued that these documents did not provide any basis for inferring the existence of an implicit transfer of the priority rights from Party A1/A2 to the appellants and, therefore, that the appellants had not provided evidence that they were entitled to the priority rights they claimed. According to the board, however, the presumption in G 1/22 and G 2/22 stated that the appellants do not have to provide such evidence, but the opponents have to rebut the presumption. There was no evidence that rebutted the presumption in the present case. If at all, there was evidence supporting the presumption of an implied transfer agreement. The entire purpose of the inventorship dispute was to have Party A1 named as inventor, and Party A2 as proprietor, in the PCT application. In the absence of evidence to the contrary, it was not credible that Party A1 or Party A2 would have acted in any way to invalidate the priority claim of the patent.

The board found the priority claims to be valid and remitted the case to the opposition division for further prosecution.

122-11-24

Article 087(1) EPC | T 2132/21 | Board 3.3.02

Article 087(1) EPC

Case Number	T 2132/21
Board	3.3.02
Date of decision	2024.06.13
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 087(1), 088(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority (yes) – application of G 1/22 and G 2/22 – implied agreement (yes)
Cited decisions	G 0001/22, G 0002/22
Case Law Book	II.D.2.2 , 10th edition

In [T 2132/21](#) the patent claimed priority from a US application filed in the name of four inventors. In the filing of the PCT application leading to the patent, the four inventors were named as applicants for the US only and a corporation was named as applicant for all other states. The appellant (opponent) argued that the priority was not valid because there was no evidence that the priority rights had been transferred to the respondent (patent proprietor) before the PCT application was filed.

The board recalled that in G 1/22 and G 2/22 the Enlarged Board had stated that in a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary. This was the situation in the case in hand. Thus, the joint filing of the PCT application, in the absence of evidence to the contrary, was sufficient proof of an implied agreement on the joint use of the priority right.

The board concluded that, on formal grounds, the priority claim was valid.

123-11-24

Article 088(1) EPC | T 0521/18

| Board 3.3.08

Article 088(1) EPC

Case Number	T 0521/18
Board	3.3.08
Date of decision	2024.03.07
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054, 088(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority (yes) – prior art document – application of G 1/22 and G 2/22 – presumption of entitlement rebutted (no) – novelty (no)
Cited decisions	G 0001/22, G 0002/22
Case Law Book	II.D.2.2. , 10th edition

[T 521/18](#) was an appeal by the patent proprietor against the decision of the opposition division to revoke the patent for lack of novelty of the subject-matter of claims 1 and 5 of auxiliary request 3 (main request on appeal) over the disclosure of document D4. The prior art document D4 was a Euro-PCT application, filed in the name of a corporation (designated for the States outside US) and ten inventors/applicants (designated for the US only). The opposition division had held that D4 was entitled to priority from application P4 (D4a), which had been filed in the name of seven out of the ten inventors/applicants of D4.

The board agreed with the findings of the opposition division both regarding the priority entitlement of D4 and the lack of novelty of claims 1 and 5 of the main request. On the question of priority entitlement of D4, the board recalled that G 1/22 and G 2/22 had set out that under the EPC normally a strong presumption exists that the priority applicants accept the subsequent applicant's reliance on the priority right for the purposes of Art. 88(1) EPC. This strong presumption also applies in a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant. The joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary (Order II of G 1/22 and G 2/22).

Applying G 1/22 and G 2/22, the board held that the strong presumption of entitlement applied in the case in hand (which corresponded to the situation referred to in Order II of G 1/22 and G 2/22). Such presumption could only be rebutted in the presence of "serious" doubts based on facts or clear indications to the contrary (see G 1/22 and G 2/22, points 110 and 125 of the Reasons). The appellant had filed documents D12 to D14 to cast doubts that a valid priority transfer had taken place from the inventors to the corporation. According to the board, however, the evidence submitted by the appellant was not suitable to rebut the presumption of entitlement as also confirmed by the declarations of two inventors of D4. Consequently, D4 was entitled to priority from application P4 (D4a) and thus formed prior art for the patent at least according to Art. 54(3) EPC.

On the question of novelty, the board noted that the appellant had not provided any substantiation that the opposition division's finding, i.e. that claims 1 and 5 of the main request lacked novelty if D4 was entitled to priority from application P4 (D4a), was erroneous. The board concluded that the main request contravened Art. 54 EPC.

044-04-24

Article 088(4) EPC

Case Number	T 1762/21
Board	3.2.02
Date of decision	2024.02.14
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 087(1), 088(4) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority – validity of priority date (yes) – basis in priority document (yes)
Cited decisions	G 0002/98
Case Law Book	II.D.3.1.2 , II.D.3.1.3 , 10th edition

[See also abstract under Art. 123\(2\) EPC.](#)

In [T 1762/21](#) the appellant (opponent) disputed the validity of the priority claim for the subject-matter of claims 1 and 7 of the main request. It argued that the validity of the priority claim could not be assessed by applying the same criteria as for the assessment of added subject-matter. It should be assessed according to the principles set out in G 2/98. According to the appellant, G 2/98 did not consider intermediate generalisations, which were of importance only for the assessment of added subject-matter. The subject-matter of the claim for which priority was claimed had to be clear ("deutlich" in the German version of G 2/98). Moreover, it had to be disclosed in the form of a claim or in the form of an embodiment or example specified in the description of the application whose priority was claimed.

The board disagreed. It held that the same considerations applied to the assessment of the priority claim as to the assessment of added subject-matter. The disclosure of the description and the drawings of the priority document were identical to those of the application as filed. The priority document differed from the application as filed only in that it did not contain any claims. However, the claims of the application as filed were not required in order to provide a basis for claims 1 and 7 of the main request.

The board recalled that the criteria for assessing the validity of a priority claim were set out in G 2/98. These criteria corresponded to the "gold" standard for assessing

any amendment, no matter whether or not it included intermediate generalisations, for its compliance with Art. 123(2) EPC. Point 4 of the Reasons of G 2/98, referred to by the appellant, did not imply any different criterion in the assessment of added subject-matter and the validity of a priority claim either. The relevant passage read: "It follows that priority for a claim, i.e. an 'element of the invention' within the meaning of Article 4H of the Paris Convention, is to be acknowledged, if the subject-matter of the claim is specifically disclosed be it explicitly or implicitly in the application documents relating to the disclosure, in particular, in the form of a claim or in the form of an embodiment or example specified in the description of the application whose priority is claimed, and that priority for the claim can be refused, if there is no such disclosure."

In the board's opinion, this passage was in line with and did not go beyond the order of G 2/98, as it stated that, for a priority claim to be valid, a specific disclosure, be it explicit or implicit, had to be present in the application from which the priority was claimed. The term "deutlich" in the German version of the decision, which is a translation of the term "specifically" in the English version, did not imply that only a clear claim may enjoy a priority claim. The term qualified the disclosure in the application from which priority was claimed. This disclosure should be specific ("deutlich") in the sense that the subject-matter for which priority was claimed was to be derived from the disclosure in a direct and unambiguous way. Whether this subject-matter as such was unclear was not decisive as long as the same (unclear) subject-matter was directly and unambiguously disclosed in the application from which priority was claimed. In view of Art. 88(4) EPC, it was not required that this subject-matter be disclosed in the form of a claim or in the form of an embodiment or example specified in the description of the application from which priority was claimed. In the passage in point 4 of the Reasons of G 2/98, these items, as derived from the expression "in particular", were simply listed as exemplary parts of the application documents.

The board concluded that the priority for the subject-matter of claims 1 and 7 of the main request was valid for the same reasons as the ones set out with respect to added subject-matter.

045-04-24

Article 099(1) EPC

Case Number	T 0480/21
Board	3.4.01
Date of decision	2024.01.19
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 099(1) EPC
EPC Rules	
RPBA	
Other legal provisions	Article 5 RFees, point 5 Arrangements for deposit accounts valid as from 1 December 2017, Notice from the EPO dated 18 January 2018 concerning the safeguards available under the EPC and the PCT in case of unavailability of means of electronic communication (OJ 2018, A25)
Keywords	opposition – deemed to have been filed (yes) – opposition fee (paid) – inability to file debit order – malfunction of EPO’s Online Filing software – attributable to EPO – period for payment extended – point 5.5 ADA 2017
Cited decisions	
Case Law Book	III.U.2.2. , IV.C.2.2.2. , 10th edition

In [T 480/21](#) the opponent had attempted to file a notice of opposition using EPO Online Filing software on the last day of the opposition period. This transmission had failed. The opponent had then, on the same day, filed the notice by fax, including a copy of the online opposition form 2300E. The fax comprised a request for debiting of a deposit account for the payment of the opposition fee. The EPO had not carried out this request. A further, successful request had been made on the day after the expiry of the opposition period, using the EPO online payment system via web payment. The opposition division had deemed the opposition not to have been filed. On appeal, the opponent requested that the decision be set aside.

The board recalled that payment of the opposition fee was governed by Art. 5 RFees. It could be made by bank transfer, by credit card or by debiting of a deposit account held with the EPO, as governed by the Arrangements for deposit accounts valid as from 1 December 2017 (hereinafter ADA). The board agreed with the opposition division’s finding that the debit order had not been received at the EPO in an

electronically processable format (XML) within the regular opposition period, but only in the form of a fax. Payment on the following day came too late (points 5.1.2, 5.1.3 and 5.1.4 ADA). Without a remedy, the legal consequence would be that the notice of opposition would be deemed not to have been filed.

The board referred to the first sentence of point 5.5 ADA, which read: "If a payment period expires on a day on which one of the accepted means of filing debit orders under point 5.1.2 is not available at the EPO, the payment period is extended to the first day thereafter on which all such means as are available for the type of application concerned can be accessed again." The board also referred to the "Notice from the EPO dated 18 January 2018 concerning the safeguards available under the EPC and the PCT in case of unavailability of means of electronic communication". Point 7 of this notice read: "A means of electronic communication may exceptionally be unavailable for reasons other than those indicated above (e.g. a malfunction). Although the burden of proving receipt lies with the party alleging submission in time, the EPO will look into any alleged unavailability of a means of electronic communication. A user in doubt as to whether a document was properly transmitted is recommended to contact EPO Customer Services. The user will suffer no adverse consequences if it is confirmed that the unavailability was attributable to the EPO. However, to be sure of avoiding any adverse consequences, it is also advisable, as a precautionary measure, to request the legal remedy available."

The board concluded that an extension of the period for paying the opposition fee was provided under point 5.5 ADA. The evidence strongly suggested that the inability to file the debit order was due to a malfunction of the EPO's Online Filing software, which, in this case, was attributable to the EPO. Hence, the payment period was extended under the first sentence of point 5.5 ADA to at least the next day. On that day, the payment was successfully made. The opposition was thus validly filed.

The board noted that this result did not constitute a disproportionate protection of the opponent's legitimate expectation to be able to rely on safeguards in the event of malfunction of the EPO's software, as opposed to the proprietor's legitimate expectation of legal certainty. The proprietor was aware that a notice of opposition had been sent by fax in due time and should have been aware of the possibility of an extension of the payment period under point 5.5 ADA.

046-04-24

Article 099(1) EPC | T 0846/22 | Board 3.2.02
Article 099(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	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

Article 104(1) EPC

Case Number	T 1292/21
Board	3.2.08
Date of decision	2024.03.04
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 104(1) EPC
EPC Rules	
RPBA	Article 16(1)(c) RPBA 2020
Other legal provisions	
Keywords	apportionment of costs (no) – postponement of oral proceedings
Cited decisions	
Case Law Book	III.R.2.2.2 , III.C.6.1.4i , 10th edition

In [T 1292/21](#) stellte die Beschwerdegegnerin (Patentinhaberin) einen Antrag auf Kostenverteilung. Der Antrag bezog sich auf folgende Umstände:

Die Kammer hatte zu einer mündlichen Präsenzverhandlung am 23. Februar 2024 in Haar geladen. Der für den Vorabend dieser Verhandlung vorgesehene Flug des Vertreters des Beschwerdeführers (Einsprechenden) nach München wurde von der Fluggesellschaft kurz vor Abflug wegen eines Warnstreiks des Bodenpersonals am Zielflughafen storniert. Am selben Abend informierte der Vertreter des Beschwerdeführers den Vertreter der Beschwerdegegnerin via E-Mail davon, dass er aufgrund der Flugstornierung die Verhandlung am nächsten Tag nicht wahrnehmen können. Zu diesem Zeitpunkt war der Vertreter der Beschwerdegegnerin allerdings bereits abgereist und in München angekommen. Er erfuhr erst am nächsten Morgen von der Kammer, dass der Beschwerdeführer nicht anwesend sein konnte und dass dieser einen Verlegungsantrag gestellt hatte. Daraufhin schlug die Kammer dem anwesenden Vertreter der Beschwerdegegnerin und per Telefon dem Vertreter des Beschwerdeführers vor, eine Verhandlung per Videokonferenz stattfinden zu lassen, wobei die Kammer und die Beschwerdegegnerin in getrennten Räumen sitzen würden. Der Vertreter der Beschwerdegegnerin stimmte diesem Vorschlag zu. Der Vertreter des Beschwerdeführers stimmte diesem Vorschlag allerdings nicht zu. Die Kammer verlegte die mündliche Verhandlung auf ein späteres Datum.

Die Kammer erinnerte daran, dass nach Art. 104 (1) EPÜ der Grundsatz gilt, dass jeder Beteiligte die ihm erwachsenen Kosten selbst trägt. Von diesem Grundsatz kann aus Gründen der Billigkeit abgewichen werden. Zu den auferlegbaren Kosten gehören gemäß Art. 16 (1) Satz 2, Buchstabe c) VOBK diejenigen Kosten, die durch Handlungen oder Unterlassungen entstanden sind, die die rechtzeitige und effiziente Durchführung der mündlichen Verhandlung beeinträchtigen. Die Billigkeit einer Kostenverteilung ist grundsätzlich nur dann gegeben, wenn einem Beteiligten eine Sorgfaltspflichtverletzung vorzuwerfen ist.

Die Kammer merkte an, dass es einem Vertreter im Rahmen seiner Sorgfaltspflicht obliegt, die Anreise zu einer mündlichen Verhandlung so zu organisieren, dass er rechtzeitig vor Ort sein kann. Dies sei beim Vertreter des Beschwerdeführers der Fall gewesen. Die Sorgfaltspflicht umfasse jedoch nicht, dass der Vertreter sich vorab über sämtliche theoretisch möglichen Schwierigkeiten bei seiner Anreise informiert und diese im Vorfeld ausschließt. Der Kammer zufolge gab es im vorliegenden Fall keine Anhaltspunkte dafür, dass der Vertreter des Beschwerdeführers, der aus Luxemburg kam, bei Beachtung seiner Sorgfaltspflicht von dem Warnstreik in München hätte wissen müssen. Somit habe es sich bei der daraus resultierenden Flugstornierung um ein für den Vertreter des Beschwerdeführers unvorhersehbares Ereignis gehandelt. Im Zusammenhang mit der geplanten Anreise zur mündlichen Verhandlung konnte die Kammer daher keine Sorgfaltspflichtverletzung seitens des Vertreters des Beschwerdeführers erkennen.

Was das Format der mündlichen Verhandlung anbelangt, hatte der Beschwerdeführer argumentiert, dass es sich bei einer mündlichen Verhandlung in Präsenz um ein Grundrecht handle. Allein die Tatsache, dass sein Vertreter mit einem unvorhersehbaren Ereignis konfrontiert worden ist, könne nicht dazu führen, dass er auf dieses Recht verzichten müsse. Die Kammer stellte klar, dass es nicht darum ging, ob es ein Recht auf eine mündliche Verhandlung in Präsenz gibt, worauf der Vertreter des Beschwerdeführers hätte verzichten müssen, wenn er einer Verhandlung per Videokonferenz zugestimmt hätte. Entscheidend im vorliegenden Fall sei gewesen, dass die Kammer die Beteiligten zu einer Verhandlung in Präsenz geladen hatte. Der Vorschlag der Kammer, das Format kurzfristig zu ändern und die Verhandlung per Videokonferenz stattfinden zu lassen, sei lediglich ein Angebot und auch als solches formuliert gewesen. Dieses Angebot hatte der Vertreter des Beschwerdeführers ausgeschlagen. Damit blieb es letztlich bei dem von der Kammer für diese Verhandlung gewählten Format, also einer mündlichen Verhandlung in Präsenz. Zwar hätte der Beschwerdeführer durch die Annahme des Angebots verhindern können, dass der Beschwerdegegnerin weitere Kosten entstehen, jedoch falle die Vermeidung von Kosten auf Seiten der Beschwerdegegnerin nicht per se unter die Sorgfaltspflicht des Beschwerdeführers.

Die Kammer entschied, dass alle Beteiligten ihre Kosten selbst zu tragen hatten.

053-05-24

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 – appear 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

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

Article 104(1) EPC | T 2175/15 | Board 3.4.02
Article 104(1) EPC

Case Number	T 2175/15
Board	3.4.02
Date of decision	2024.06.11
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 104(1) EPC
EPC Rules	
RPBA	Article 16(1) RPBA 2020
Other legal provisions	
Keywords	apportionment of costs (no) – not equitable – late filed request – objections of suspicion of partiality
Cited decisions	T 0765/89, T 0026/92, T 0432/92, T 0674/03, T 0490/05, T 0671/08, T 1781/13, T 0482/19
Case Law Book	III.R.2.1.1b), III.R.2.4 , III.R.2.5 , 10th edition

[See also abstract under Article 24 EPC on the parallel decision T 2175/15.](#)

Nachdem beide Beschwerden zurückgenommen wurden, entschied die Kammer in [T 2175/15](#) vom 11. Juni 2024 über die jeweiligen Anträge der Einsprechenden und der Patentinhaber auf anderweitige Kostenverteilung. Die Kammer rief in Erinnerung, dass nach der Rechtsprechung der Beschwerdekammern eine anderweitige Kostenverteilung der Billigkeit entspricht, wenn das Verhalten einer Partei nicht mit der zu fordernden Sorgfalt im Einklang steht, d.h. wenn Kosten durch leichtfertiges oder gar böswilliges Handeln verursacht werden (z. B. T 765/89, T 26/92 und T 432/92). Um festzustellen, ob eine anderweitige Kostenverteilung aus Billigkeitsgründen gerechtfertigt ist, müssen sowohl das Verhalten der Beteiligten als auch die sich daraus ergebenden Kostenfolgen berücksichtigt und gegeneinander abgewogen werden. Eine anderweitige Kostenverteilung aus Billigkeitsgründen kommt daher in Betracht, wenn das Verhalten von Beteiligten unter Verletzung der Sorgfaltspflicht Kosten verursacht hat, die nicht unerheblich sind.

Die Einsprechende hatte vorgetragen, dass aufgrund der erstmaligen und damit verspäteten Einreichung des Hilfsantrags I in der ersten mündlichen Verhandlung eine Vertagung der mündlichen Verhandlung notwendig gewesen sei und es deshalb aus Billigkeitsgründen geboten gewesen sei, den Patentinhabern die dadurch entstandenen Kosten aufzuerlegen.

Die Kammer erinnerte daran, dass Hilfsantrag I ausschließlich die erteilten Verfahrensansprüche umfasste. In ihrer Beschwerdebegründung hatten die Patentinhaber zu dem obiter dictum (zu den Verfahrensansprüchen) in der angefochtenen Entscheidung Stellung genommen. Die Kammer war daher der Ansicht, dass eine Behandlung des Hilfsantrags I in der ersten mündlichen Verhandlung zumutbar gewesen wäre. Deren Vertagung war somit nicht wegen des verspäteten Einreichens des Hilfsantrags I notwendig. Vielmehr erfolgte sie aus Fairness- und Effizienzgründen.

Die Einsprechende hatte ferner vorgetragen, dass eine anderweitige Kostenverteilung auch deshalb gerechtfertigt sei, weil die Patentinhaber wenige Tage vor der anberaumten zweiten mündlichen Verhandlung durch Rücknahme ihrer Beschwerde auf eine Weiterverfolgung des Hilfsantrags wieder verzichtet hatten, so dass der gesamte durch die Einreichung des Hilfsantrags und die Vertagung erzeugte Aufwand überflüssig geworden sei.

Die Kammer konnte aber auch in der Rücknahme der Beschwerde keinen Verstoß gegen grundlegende prozessuale Sorgfaltspflichten seitens der Patentinhaber erkennen. Dieses auf dem Verfügungsgrundsatz basierende Recht könne nicht – auch nicht implizit durch Androhung einer anderweitigen Kostenverteilung – eingeschränkt werden, selbst wenn eine mündliche Verhandlung anberaumt ist und die betroffene Gegenpartei nur kurzfristig davon unterrichtet werden kann. In der Regel sei sogar davon auszugehen, dass die Vorteile einer Beschwerderücknahme für die Gegenpartei die ihr erwachsenen – wenn auch vermeidbaren – Kosten aufwiegen (siehe T 490/05). Zwar wurde mit der Rücknahme der Beschwerde der Patentinhaber die Einsprechende zur alleinigen Beschwerdeführerin und wäre deshalb das im Beschwerdeverfahren geltende Verbot der reformatio in peius hinsichtlich des Hilfsantrags I zu beachten gewesen. Dies bedeutete jedoch nicht, so die Kammer, dass der Hilfsantrag I nach der Rücknahme der Beschwerde der Patentinhaber unmittelbar nicht mehr Gegenstand des Beschwerdeverfahrens war, sondern es hätte zunächst über die Frage entschieden werden müssen, ob das Verbot der reformatio in peius hinsichtlich des Hilfsantrags I greift. Die Kammer konnte daher kein missbräuchliches oder leichtfertiges Verhalten der Patentinhaber erkennen, so dass es nicht der Billigkeit entsprach, eine andere Verteilung der Kosten zugunsten der Einsprechenden gemäß Art. 104 (1) EPÜ und Art. 16 (1) VOBK anzuordnen.

Der Antrag der Patentinhaber auf eine anderweitige Kostenverteilung wurde ebenfalls zurückgewiesen. Die Kammer hielt es nicht für gerechtfertigt, in Ausübung ihres Ermessens nach Art. 104 (1) EPÜ i.V.m. Art. 16 (1) VOBK der Einsprechenden aus Gründen der Billigkeit die Kosten der Patentinhaber wegen der Einreichung von insgesamt fünf Befangenheitsanträgen aufzuerlegen. Sie teilte nicht die Ansicht der Patentinhaber, dass die im EPÜ vorgesehene Möglichkeit eines Befangenheitsantrags nur im Ausnahmefall heranzuziehen sei. Darüber hinaus konnte die Kammer keinen Grund erkennen, warum das Verhalten der Einsprechenden schuldhaft oder verfahrensmisbräuchlich gewesen wäre.

Article 107 EPC | T 1286/23 | Board 3.2.04
Article 107 EPC

Case Number	T 1286/23
Board	3.2.04
Date of decision	2024.11.11
Language of the proceedings	EN
Internal distribution code	A
Inter partes/ex parte	Inter partes
EPC Articles	Articles 099, 105, 107, 108, 112 EPC
EPC Rules	Rule 089 EPC
RPBA	
Other legal provisions	
Keywords	intervention of the assumed infringer – intervention during appeal proceedings – admissibility of appeal by the intervener – party status of the intervener – continuation of proceedings with intervener after withdrawal of all appeals – referral to the Enlarged Board
Cited decisions	G 0002/91, G 0004/91, G 0008/91, G 0009/92, G 0003/04, T 0202/89, T 1026/98, T 1007/01, T 0439/17
Case Law Book	III.P.1.4.2 , III.P.1.6 , III.P.2.2 , V.A.2.4.2 , V.A.2.4.3a), V.A.2.4.3b), 10th edition

In [T 1286/23](#) one of the opponents (the "appellant") filed an appeal against the decision of the opposition division. Thereafter, a third party (the "intervener") declared an intervention and filed an appeal against the opposition division's decision, paying the fees for both opposition and appeal. The board then issued summons for oral proceedings, whereupon the appellant withdrew its appeal.

The board summarised the situation in the light of G 3/04 as such that Art. 105 EPC allows an intervener to join as an opponent and as an opponent only. Neither Art. 105 EPC nor Art. 107 EPC mention any position, and thus also of any possibly different position, of interveners joining at the appeal stage only. An intervener intervening at the appeal stage could not be treated as an appellant because it does not fulfil the requirements of Art. 107, first sentence, EPC, in particular it has not been party to the earlier proceedings. The provisions governing the payment of the appeal fee were also silent about the possibility of payment of an appeal fee by a person who is not an appellant. Given that it is settled case law of the Enlarged Board that appeal proceedings cannot be continued where the (only) appellant has

withdrawn the appeal, the intervener as opponent thus could not by their own motion continue the appeal proceedings.

The board went on to highlight that on a purely literal and systematic interpretation, i.e. without taking into account the legislative intent as derivable from the travaux, Art. 107 EPC simply does not leave any room for interveners to be parties to appeal proceedings at all, be it as appellants, respondents or just other parties. This conclusion however directly contradicted settled case law of the Enlarged Board and the undisputed legislative intent behind Art. 105 EPC, as clearly set out in G 1/94. The board also noted that the conclusion of the Enlarged Board that "the valid intervener only acquires the status of an opponent" in G 3/04 plainly contradicts the provisions of Art. 107, second sentence, EPC, at least as long as "status of an opponent" is read as "status of an opponent who had been party to the proceedings leading to the appealed decision (but is not itself an appellant within the meaning of Art. 107, first sentence, EPC)". Still, it seemed clear that the Enlarged Board in G 3/04 understood an "opponent" in this sense. From this, it followed directly that procedural conditions that intend to put limitations on the party status in Art. 107 EPC could not apply to interveners, at least as long as the so far undisputed legislative intent is respected. At the very least, the requirement of a party status in the earlier proceedings could not hold for an intervener. This then begged the question why the other requirement for acquiring the party status of an appellant, namely the adverse effect, should apply to an intervener, or at the very least why it should be applied in strict combination with the party status in the earlier proceedings.

Considering G 3/04, the board explained that it did not agree that Art. 105 EPC in combination with Art. 107 EPC must be read in the sense that also a third party intervening only at the appeal stage can never become more than a non-appealing opponent. Put differently, the board had serious doubts that an intervener, regardless of the state of proceedings would always have to be treated as no more than a non-appealing opponent. The board proposed that Art. 105(2) EPC should be interpreted as providing that an admissible intervention is to be treated as an opposition, and the intervener enters the proceedings with full rights as if it had been a party to the proceedings from the very beginning. Depending on the outcome of the appealed decision, the intervener should be given the choice of entering the proceedings in any party position open to them. In particular, they must be given the opportunity to file their own appeal in a given case, of course upon payment of the appeal fee.

In the board's view, it followed that the intervener by advancing their grounds of opposition and by properly paying the opposition and appeal fee within the three-month time period of Art. 105 EPC should be entitled to continue the appeal proceedings even upon a withdrawal of the appellant's appeal. This result was however at odds with G 3/04. The board therefore referred the following points of law to the Enlarged Board: "[a]fter withdrawal of all appeals, may the proceedings be continued with a third party who intervened during the appeal proceedings? In particular, may the third party acquire an appellant status corresponding to the status of a person entitled to appeal within the meaning of Article 107, first sentence, EPC?"

Article 111(1) EPC

Case Number	T 0884/22
Board	3.2.04
Date of decision	2024.02.23
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 111(1) EPC
EPC Rules	
RPBA	Article 11 RPBA 2020
Other legal provisions	
Keywords	remittal to the department of first instance (no) – request for remittal for examination of auxiliary requests not examined at first instance
Cited decisions	G 0001/95, G 0007/95
Case Law Book	V.A.9.2.1 , V.A.9.5 , V.A.9.6 , 10th edition

In [T 884/22](#) wies die Kammer den Antrag auf Zurückverweisung an die Einspruchsabteilung zurück.

Die Kammer erinnerte daran, dass sie gemäß Art. 111 (1) EPÜ entweder im Rahmen der Zuständigkeit des Organs tätig wird, das die Entscheidung erlassen hat, oder sie die Angelegenheit zur weiteren Entscheidung an dieses Organ zurückverweist. Nach Art. 11 VOBK verweist eine Kammer die Angelegenheit dann zur weiteren Entscheidung an das Organ zurück, das die angefochtene Entscheidung erlassen hat, wenn besondere Gründe dafür sprechen. Die Kammer erläuterte, dass solche in der Regel vorliegen, wenn das Verfahren vor diesem Organ wesentliche Mängel aufweist oder sich ungeprüfte Fragen der Patentierbarkeit ergeben (Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.9.3.2b)). Dies gelte insbesondere dann, wenn die Einspruchsabteilung nicht alle Einspruchsgründe geprüft hat. Denn in diesem Fall würde die Kammer zwangsläufig den rechtlichen Rahmen der erstinstanzlichen Entscheidung überschreiten, da die verschiedenen Einspruchsgründe gegen das Patent nach Art. 100 a) bis 100 c) EPÜ als eigenständige Rechtsgrundlagen zu betrachten sind (s. die konsolidierten Entscheidungen G 1/95 und G 7/95, Entscheidungsgrund 4 mit Unterpunkten 4.1-4.6). Hingegen stellten nicht geprüfte Hilfsanträge oder weitere Angriffslinien gegen das Vorliegen einer an sich geprüften Patentierungsvoraussetzung regelmäßig keine besonderen Gründe dar (Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.9.6.1, V.A.9.6.2). Die Kammer rief in Erinnerung, dass ein Rechtsanspruch auf

Entscheidung aller Fragen in zwei Instanzen nicht besteht (siehe Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.9.2.1) und begründete dies insbesondere damit, dass die Anerkennung eines solchen Anspruchs absehbar zu einer Vielzahl von Zurückverweisungen und anschließenden Beschwerden führen könnte, was ein offensichtlich widersinniges Ergebnis sei. Ziel des Beschwerdeverfahrens sei es, zu einer für alle Parteien verbindlichen Entscheidung zu gelangen. In den Fällen, in denen hierfür die erstmalige Behandlung neuen Sachverhaltes oder neuen Sachvortrages erforderlich wird, so die Kammer, ist eine Abwägung zwischen der wünschenswerten Behandlung des Stoffes in zwei Instanzen und der ebenfalls wünschenswerten Verfahrenseffizienz erforderlich. Die Kammer wies darauf hin, dass die Praxis der Kammern dazu tendiere, neu eingereichte Hilfsanträge, die bereits in der Einspruchsabteilung behandelte Einspruchsgründe betreffen, ohne eine Zurückverweisung zu behandeln, eine Zurückverweisung aber dann vorzunehmen, wenn es erforderlich würde, in der ersten Instanz nicht behandelte Einspruchsgründe zu diskutieren.

Die Kammer kam zu dem Schluss, dass die Beschwerdegegnerin (Patentinhaberin) keine besonderen Gründe, geschweige denn wesentliche Mängel des Verfahrens vor der Einspruchsabteilung aufgezeigt hatte. Aus der Tatsache, dass das Patent in geändertem Umfang aufrechterhalten wurde, folge vielmehr, dass die Einspruchsabteilung alle Einspruchsgründe geprüft hatte, was auch aus der angefochtenen Entscheidung hervorgehe. Die Tatsache, dass die erst während der mündlichen Verhandlung vor der Einspruchsabteilung gestellten Hilfsanträge 2-4 dort nicht diskutiert wurden, stellte aus Sicht der Kammer keinen besonderen Grund dar, da keine derartig neuen Tatsachen zu Tage getreten waren, die die Beteiligten hätten überraschen können oder deren Behandlung den Beteiligten unter den gegebenen Umständen nicht zugemutet werden konnte. Da die angefochtene Entscheidung auf Basis des vorliegenden Hilfsantrags 1 ergangen war, mussten die weiteren Hilfsanträge 2-4 nicht von der Einspruchsabteilung behandelt werden. Auch die Tatsache, dass die Mitteilung der Kammer nur darauf verwiesen hatte, dass gegebenenfalls die Hilfsanträge zu prüfen seien, stellte nach Ansicht der Kammer keinen solchen Grund dar. Denn alle Parteien hatten bereits im schriftlichen Beschwerdeverfahren zu den Hilfsanträgen 2-4 vorgetragen.

Daher entschied die Kammer, im Rahmen der Zuständigkeit der Einspruchsabteilung tätig zu werden und sich mit den Hilfsanträgen 2-4 zu befassen (Art. 111 (1) EPÜ).

054-05-24

Article 112(1)(a) EPC | T 0439/22 | Board 3.2.01
Article 112(1)(a) EPC

Case Number	T 0439/22
Board	3.2.01
Date of decision	2024.06.24
Language of the proceedings	EN
Internal distribution code	A
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054, 056, 069(1), 084, 112(1)(a) EPC
EPC Rules	
RPBA	
Other legal provisions	Protocol on the Interpretation of Article 69 EPC
Keywords	referral to the Enlarged Board of Appeal – uniform application of law – point of law of fundamental importance – claim interpretation – using the description to interpret the claims – legal basis – primacy of the claims – unambiguous wording – patent as its own dictionary
Cited decisions	G 0002/88, G 0006/88, T 1648/18, T 1266/19, T 1473/19, T 1844/19, T 2764/19, T 0169/20, T 0367/20, T 0450/20, T 0821/20, T 1171/20, T 1924/20, T 0470/21, T 1494/21, T 0177/22, T 0675/22
Case Law Book	II.A.6.3 , V.B.2.3.3 , V.B.2.3.6 , V.B.2.3.7 , 10th edition

In [T 439/22](#) the interpretation of the term "gathered sheet" in claim 1 was decisive to assess novelty. In particular, the prior-art document D1 disclosed – in addition to all other features of the claim – a tobacco sheet spirally wound. The board stated that a skilled person in the current technical field would understand the term "gathered sheet", when read in isolation, as defining a sheet folded along lines to occupy a tridimensional space. Accordingly, when assigning this usual meaning to the term, the subject-matter of claim 1 would have to be regarded as novel. However, if the same term was read in a broader but still technically meaningful manner in view of the definition in paragraph [0035] of the description, the subject-matter of claim 1 would lack novelty. Said paragraph [0035] establishes that "the term "gathered" denotes that the sheet of tobacco material is convoluted, folded, or otherwise compressed or constricted substantially transversely to the cylindrical axis of the rod."

The board examined the case law of the boards and concluded that it was divergent on the following questions, which were all decisive for the case in hand:

- legal basis for construing patent claims
- whether it is a prerequisite for taking the figures and description into account when construing a patent claim, that the claim wording, when read in isolation, be found to be unclear or ambiguous
- extent to which a patent can serve as its own dictionary

According to the board, a decision of the Enlarged Board of Appeal was also required because a point of law of fundamental importance had arisen, since claim construction by the EPO had to be seen within the greater context of the patent protection system as a whole. To provide an overview on claim interpretation in validity and enforcement proceedings, the board took into account decisions of national courts in France, Germany and United Kingdom as well as two recent decisions of the Court of Appeal of the Unified Patent Court (Nanostring v 10x Genomics, UPC CoA 335/2023, App 576355/2023 of 26 February 2024; VusionGroup v Hanshow (APL 8/2024, ORD 17447/2024) of 13 May 2024).

The board concluded that, in order to come to a decision in the case at hand, three questions first had to be answered, both to ensure the uniform application of the law and because a point of law of fundamental importance had arisen. The board thus referred the following questions to the Enlarged Board (referral pending under G 1/24 – Heated aerosol):

1. Is Art. 69(1), second sentence EPC and Art. 1 of the Protocol on the Interpretation of Article 69 EPC to be applied to the interpretation of patent claims when assessing the patentability of an invention under Art. 52 to 57 EPC? [see points 3.2, 4.2 and 6.1 of the Reasons]
2. May the description and figures be consulted when interpreting the claims to assess patentability and, if so, may this be done generally or only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation? [see points 3.3, 4.3 and 6.2 of the Reasons]
3. May a definition or similar information on a term used in the claims which is explicitly given in the description be disregarded when interpreting the claims to assess patentability and, if so, under what conditions? [see points 3.4, 4.4 and 6.3 of the Reasons]

093-08-24

Article 112a EPC | R 0005/23 | Enlarged Board of Appeal

Article 112a EPC

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

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

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

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

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

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

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

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

113-10-24

Article 112a(2)(c) EPC | R 0010/20 | Enlarged Board of Appeal

Article 112a(2)(c) EPC

Case Number	R 0010/20
Board	EBA
Date of decision	2023.09.25
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 112a(2)(c) and (d), 113(1) EPC
EPC Rules	Rule 104 EPC
RPBA	
Other legal provisions	
Keywords	petition for review – list of grounds exhaustive – fundamental violation of Article 113 EPC (no)
Cited decisions	R 0010/18
Case Law Book	V.B.4.3.10a), V.B.4.3.8a), V.B.3.4.2 , V.B.4.4. , 10th edition

Der Antrag auf Überprüfung in [R 10/20](#) wurde darauf gestützt, dass die angefochtene Entscheidung in mehrfacher Hinsicht mit einem schwerwiegenden Verfahrensmangel behaftet sei, und – ebenfalls in mehrfacher Hinsicht – ein schwerwiegender Verstoß gegen Art. 113 EPÜ vorliege.

Im Rahmen der Prüfung der Begründetheit des Antrags stellte die Große Beschwerdekammer (GBK) zunächst fest, dass sich die Antragstellerin weder auf das Übergehen eines Antrags auf mündliche Verhandlung (R. 104 a) EPÜ) noch eines sonstigen relevanten Antrags im Verfahren (R. 104 b) EPÜ) berufen hatte. Nach Ansicht der GBK konnten aber die von der Antragstellerin im Rahmen des Verfahrensmangels gemäß Art. 112a (2) d) EPÜ gemachten Darlegungen dem Verfahrensmangel gemäß Art. 112a (2) c) EPÜ wegen Verletzung des Rechts auf rechtliches Gehör (Art. 113 (1) EPÜ) zugeordnet werden.

Für die rechtliche Beurteilung der geltend gemachten Begründungsmängel stellte die GBK den Orientierungssatz von R 10/18 wie folgt klar: Art. 113 (1) EPÜ verlangt, dass die Kammer Vorbringen eines Beteiligten in der Sache berücksichtigt hat, d.h.

- erstens, dass sie das Vorbringen eines Beteiligten zur Kenntnis genommen und
- zweitens dieses Vorbringen erwogen hat, d.h. geprüft hat, ob es relevant und ggf. richtig ist.

Es wird vermutet, dass eine Kammer das Vorbringen eines Beteiligten in der Sache berücksichtigt hat, welches sie in den Entscheidungsgründen nicht behandelt hat. Denn dann ist anzunehmen, dass es aus ihrer Sicht nicht relevant war. Diese Vermutung kann widerlegt sein, wenn Anzeichen für eine Nicht-Berücksichtigung vorliegen, z.B. wenn eine Kammer in den Entscheidungsgründen das Vorbringen eines Beteiligten nicht behandelt, welches objektiv betrachtet entscheidend für den Ausgang des Falles ist, oder derartiges Vorbringen von der Hand weist, ohne es zuvor auf seine Richtigkeit zu überprüfen.

Bei der Beurteilung der geltend gemachten "mangelnden Berücksichtigung hochrelevanter Argumente" (Defizite a) und b)) schloss die GBK aus der Behandlung der betroffenen Fragen in der Entscheidung, dass in Bezug auf diese Defizite keine Abweichung von der Vermutung der Kenntnisnahme anzunehmen war. Betreffend die Vermutung einer Berücksichtigung und damit (nicht nur einer Kenntnisnahme, sondern auch) Erwägung, hatte die Antragstellerin geltend gemacht, es liege die Ausnahme vor, wonach das fragliche Vorbringen objektiv entscheidend für den Ausgang des Falles sei. Die GBK teilte diese Auffassung nicht: Da das Verfahren nach Art. 112a EPÜ grundsätzlich nicht der Überprüfung des materiellen Rechts diene, seien Ausnahmen von diesem Grundsatz nur unter strengen Voraussetzungen zuzulassen, was vorliegend bedeute, dass sich der Charakter des Vorbringens als objektiv betrachtet entscheidend für den Ausgang des Falles aufdrängen müsse. Die GBK schlussfolgerte aus dem Umstand, dass die Bewertung als entscheidend für den Ausgang des Falles der als hochrelevant geltend gemachten Argumente eine technische Analyse voraussetzte, dass in Bezug auf diese Begründungsmängel a) und b) die Vermutung der Erwägung, und damit ihrer Berücksichtigung, gelte. Aus der Nichtbehandlung in der Entscheidung sei abzuleiten, dass die Kammer die von der Antragstellerin als hochrelevant angesehenen Argumente als gar nicht relevant betrachtet und daher auf eine Diskussion in der Entscheidung verzichtet habe. Aus Sicht der GBK war ein Gehörverstoß zu verneinen.

In Bezug auf die geltend gemachten Defizite c) und d) stellte die GBK klar, dass die Antragstellerin mit der Beanstandung einer "unlogischen und widersprüchlichen Begründung" nicht eine mangelnde, sondern eine fehlerhafte Erwägung ihres Vorbringens geltend machte. Diese könne insbesondere materielle Fehlbeurteilungen widerspiegeln, welche im Verfahren nach Art. 112a EPÜ nicht überprüfbar seien.

Schließlich stellte die GBK fest, dass die Antragstellerin (auch ohne eine Beanstandung der Kammer betreffend die Nichtdurchführung eigener Versuche) Gelegenheit hatte, sich zu den Vergleichsversuchen im Patent mittels Vorlage des Ergebnisses eigener Versuche zu äußern. Der unter diesem Gesichtspunkt geltend gemachte Gehörverstoß liege daher nicht vor.

Der Antrag auf Überprüfung wurde folglich als teils offensichtlich unzulässig und im Übrigen als offensichtlich unbegründet verworfen.

Article 112a(2)(c) EPC | R 0012/22 | Enlarged Board of Appeal

Article 112a(2)(c) EPC

Case Number	R 0012/22
Board	EBA
Date of decision	2023.12.18
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 112a(2)(c) and (d), 113(1) EPC
EPC Rules	Rules 102(g), 104 EPC
RPBA	Article 15a RPBA 2020
Other legal provisions	
Keywords	petition for review – clearly unallowable – list of grounds exhaustive – fundamental violation of Article 113 EPC (no)
Cited decisions	G 0004/95, G 0001/21, R 0010/18, R 0010/20
Case Law Book	V.B.4.3. , V.B.4.3.10a), V.B.4.3.18 , V.B.4.4. , V.B.3.4.3 , III.C.7.3.4a), III.B.2.6. , 10th edition

[See also abstract under Article 24 EPC.](#)

Der Antrag auf Überprüfung in [R 12/22](#) wurde darauf gestützt, dass die angefochtene Entscheidung in mehrfacher Hinsicht mit einem schwerwiegenden Verfahrensmangel behaftet sei, und – ebenfalls in mehrfacher Hinsicht – ein schwerwiegender Verstoß gegen Art. 113 EPÜ vorliege.

Die Große Beschwerdekammer (GBK) erörterte zunächst, dass ein Verstoß gegen die Begründungspflicht nach R. 102 g) EPÜ nicht von Art. 112a (2) d) EPÜ erfasst sei. Sie verwies auf die in R 10/18 und R 10/20 dargelegten Grundsätze zum Umfang der Begründungspflicht. Die von der Antragstellerin zitierte Aussage aus der Kommentarliteratur, das Korrelat zum Äußerungsrecht nach Art. 113 (1) EPÜ bilde die Pflicht, die Entscheidungen zu begründen, müsse im Einklang mit diesen Grundsätzen stehen. Eine Behandlung des Geäußerten in den Entscheidungsgründen sei nur unter den in R 10/18 und R 10/20 dargelegten Voraussetzungen vom Recht auf rechtliches Gehör gefordert. Hingegen beinhalte das Recht auf rechtliches Gehör neben dem Äußerungsrecht das Recht auf Berücksichtigung des Geäußerten. Wenn ein Schlagwort zur Charakterisierung dieser Beziehung als nützlich empfunden werden sollte, dann würde sich der Kammer zufolge der Begriff "Korrelat" hier eignen.

Zu den geltend gemachten Verfahrensmängeln gemäß Art. 112a (2) d) EPÜ, stellte die GBK fest, dass die Antragstellerin sich weder auf das Übergehen eines Antrags auf mündliche Verhandlung (R. 104 a) EPÜ) noch eines sonstigen relevanten Antrags im Verfahren (R. 104 b) EPÜ) berufen hatte, weshalb der Überprüfungsantrag diesbezüglich für unbegründet befunden wurde.

Zu den geltend gemachten Verfahrensmängeln gemäß Art. 112a (2) c) EPÜ, befand die GBK unter anderem Folgendes:

G 1/21 habe klargestellt, dass die Durchführung einer mündlichen Verhandlung in Form einer Videokonferenz grundsätzlich keinen Verstoß gegen das Recht auf rechtliches Gehör bedeute. Die Auffassung der Antragstellerin, eine nur theoretische Möglichkeit verschlechterter Kommunikation und Austauschmöglichkeit stelle bereits einen Verstoß gegen Art. 113 (1) EPÜ dar, stehe in diametralem Gegensatz zu G 1/21. In Bezug auf Art. 15a VOBK betonte die GBK, dass eine unzutreffende Ermessensausübung zugunsten der Durchführung einer mündlichen Verhandlung als Videokonferenz mangels Einfluss auf das Recht auf rechtliches Gehör keinen Verstoß gegen dieses Recht begründen könne, wenn ein konkreter praktischer Mangel weder behauptet noch ersichtlich sei.

In Bezug auf die beanstandete Zulassung des Vortrags einer Begleitperson stellte die GBK klar, dass es auf einen abstrakten Verstoß gegen die in G 4/95 aufgestellten Zulassungsvoraussetzungen bei der Prüfung eines Verstoßes gegen das Recht auf rechtliches Gehör nicht ankommen könne. Denn letzteres Recht beziehe sich auf die Möglichkeit, auf den Inhalt konkreter Äußerungen angemessen reagieren zu können, nicht auf das Recht, diesen Inhalt durch eine zum umfassenden Vortrag berechnete und von einem zugelassenen Vertreter hierbei beaufsichtigte Begleitperson präsentiert zu bekommen.

In Bezug auf den geltend gemachten Verstoß gegen Art. 113 EPÜ infolge der kurzfristigen Umbesetzung der zuständigen Beschwerdekammer stellte die GBK unter anderem fest, dass aus dem Recht auf rechtliches Gehör kein Recht eines Beteiligten auf einen Nachweis folge, dass ein Kammermitglied ausreichend vorbereitet ist, weder im Falle einer kurzfristigen Einwechslung noch generell. Denn die Ausübung eines solchen Rechts würde gegen die Unabhängigkeit des betroffenen Beschwerdekammermitglieds verstoßen.

Zu dem geltend gemachten Verstoß gegen Art. 113 EPÜ infolge einer „fehlerhaften und widersprüchlichen Beurteilung“ des streitpatentgemäßen Gegenstands, stellte die GBK klar, dass dies nur dann beanstandet werden könnte, wenn die Widersprüche gleichbedeutend damit wären, dass die Kammer das Vorbringen in den Entscheidungsgründen nicht behandelt hätte und dieses objektiv betrachtet entscheidend für den Ausgang des Falles gewesen wäre. Dass die widersprüchliche Begründung gleichbedeutend mit einer Nicht-Begründung ist, müsse sich aufdrängen.

Der Antrag auf Überprüfung wurde folglich als offensichtlich unbegründet verworfen.

Article 112a(2)(c) EPC | R 0008/19 | Enlarged Board of Appeal

Article 112a(2)(c) EPC

Case Number	R 0008/19
Board	EBA
Date of decision	2024.04.12
Language of the proceedings	EN
Internal distribution code	B
Inter partes/ex parte	Inter partes
EPC Articles	Articles 112a(2)(c), 113(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	petition for review – unallowable – fundamental violation of Article 113 EPC (no) – opportunity to comment (yes)
Cited decisions	R 0001/08, R 0015/12, R 0008/13, R 0016/13, T 1537/16
Case Law Book	V.B.4.3.5 , V.B.4.3.8a , 10th edition

In [R 8/19](#) the petitioner (opponent 1) claimed that its right to be heard had been fundamentally violated. It had allegedly only learnt from the written reasons of the decision that, when acknowledging inventive step with respect to auxiliary request 1, the board had redefined the objective technical problem; and the board had allegedly done this in a completely unexpected manner. The petitioner argued that unless an opponent knew how the problem was being defined, it was impossible to present arguments on inventive step.

First of all, the Enlarged Board of Appeal (EBA) recalled that decisions of a board of appeal may only be based on grounds or evidence on which the parties have had an opportunity to present their comments (Art. 113(1) EPC) and a party must not be taken by surprise by the reasons for the decision referring to unknown grounds or evidence. The right to be heard is observed if a party has had the opportunity to comment on the decisive considerations and the relevant passages of the prior art on which a decision is based (see e.g. R 16/13). On the other hand, the board must be able to draw its own conclusion from the discussion of the grounds put forward (R 8/13, R 16/13). Thus, the right to be heard does not go so far as to impose an obligation on a board to disclose to the parties, in advance, how and why, on the basis of the decisive issues under discussion – or at least those foreseeable as the core of the discussion – it will come to its conclusion. This is part of the reasoning given in the written decision (R 1/08, R 15/12, R 16/13).

In the present case, a cornerstone of the board's inventive step reasoning with respect to claim 1 of auxiliary request 1 was the construction of the objective problem to be solved by the claimed subject-matter. While not following the proprietor's and petitioner's views, the board had considered that the objective problem solved was the provision of a pharmaceutical formulation with a zero order release profile.

According to the EBA, whether the board's reliance on an objective problem that had never been mentioned to the petitioner amounted to a fundamental violation of the right to be heard could not generally be answered in the affirmative. The EBA argued that the right to be heard in the context of the problem-solution approach meant that there should normally have been a discussion on the relevant prior art, the differences between the prior art and the claimed invention, and the technical relevance of these differences. Within the framework of what had been addressed in the course of these discussions, the deciding organ should be free to apply the problem-solution approach as it sees fit, and even identify an objective problem that had not been explicitly spelled out as such during the proceedings. In any case, the objective problem eventually used in the reasoning had to be based on technical effects (or the lack of any) and the features of the invention causally linked to such effects, upon which the parties had had an opportunity to comment.

With respect to auxiliary request 1 and, the board's decision on inventive step, which had given rise to the petition, the EBA concluded that the board had based its decision only on grounds that had been objectively foreseeable by the parties, in view of their submissions and the board's statements during the appeal proceedings.

The EBA reasoned that during the entire proceedings leading to the decision under review, the zero order release profile – the provision of which had been eventually adopted by the board as the objective technical problem – had been discussed, either as a quality of the erosion matrix or as a feature that was desirable per se. According to the file, the discussion on the main request had covered the zero order release profile in connection with the disputed distinguishing feature, the erosion matrix. Not only the problem eventually used in the context of auxiliary request 1 (to achieve a zero order release profile) but also the solution (the use of a water-soluble polymer) had been explicitly discussed in the context of the main request. The EBA held that the facts and evidence underlying the board's decision on auxiliary request 1 had been discussed in a way that had given the petitioner sufficient opportunities to be heard.

The EBA concluded that no fundamental violation of Art. 113 EPC had occurred, since the parties had had the opportunity to comment upon the grounds and evidence on which the decision under review was based, in particular, on the additional limiting feature of auxiliary request 1 and the technical effect eventually used by the board in its application of the problem-solution approach.

Article 113 EPC | T 0737/20 | Board 3.3.04

Article 113 EPC

Case Number	T 0737/20
Board	3.3.04
Date of decision	2023.10.18
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 111(1), 112a, 113 EPC
EPC Rules	Rules 104, 106 EPC
RPBA	Articles 11, 12(2), 23 RPBA 2020
Other legal provisions	
Keywords	right to be heard – violation (no) – fundamental procedural defect (no) – obligation to raise objections – objection dismissed – remittal to the department of first instance (no)
Cited decisions	
Case Law Book	III.B.1. , V.B.3.4.2. , 10th edition

During the oral proceedings in [T 737/20](#) the board informed the parties that it had decided not to remit the case to the opposition division and intended to deal with the issue of inventive step itself. Subsequently, the appellant raised an objection under R. 106 EPC to the effect that its right to be heard under Art. 113 EPC had not been respected. The appellant argued that the board's refusal to remit the case to the opposition division in accordance with Art. 11 RPBA infringed both Art. 112a(2)(c) and (d) EPC. According to the appellant, Art. 112a(2)(c) EPC was infringed because the patentees' request to have the question of inventive step examined at two different levels of jurisdiction had been refused and Art. 112a(2)(d) EPC was infringed because the refusal of the request to remit the matter to the opposition division was a fundamental procedural defect in view of Art. 11, 12(2) and 23 RPBA. The board dismissed the objection.

The board found that there were two reasons why no violation of the right to be heard had occurred in the oral proceedings.

Firstly, the appellant had been heard on the issue of remittal. Indeed, it had been given and had taken advantage of multiple opportunities both in writing and during the oral proceedings to comment on whether the case should be remitted to the opposition division for further prosecution. Furthermore, it had been given and had

taken advantage of multiple opportunities both in writing and at the oral proceedings to comment on the respondents' objections on inventive step.

Secondly, where a board opts not to remit a case and to decide the case on the merits, there was no legal obligation under Art. 113 EPC to hear the parties on this matter. The right to be heard was not an end in itself. A party had to be heard on matters, whether substantive or procedural, only if these lead to decisions which could adversely affect the legitimate interest of that party. While deciding to remit a case to allow issues to be decided by two instances is one of the two options under Art. 111(1) EPC, it had to be remembered that the boards of appeal had the final say on the allowability of claim requests. Deferring a decision by the board on the allowability of a claim request through a remittal could not be regarded as a legitimate interest of a party. No party was adversely affected by a board's decision to decide the case itself. Any potential adverse effect would be due to other, later decisions taken by the board, e.g. on the merits of the case or on the admittance of new requests or objections. As a consequence, even though the board had considered the extensive submissions of the parties on the issue of remittal, this had not been legally necessary.

The board furthermore held that not remitting the case to the opposition division for further prosecution for consideration of inventive step of claim 1 of the patent was not a fundamental procedural violation in view of Art. 12(2) RPBA. As emphasised in Art. 11 RPBA and contrary to the appellant's view, Art. 12(2) RPBA did not preclude boards of appeal from dealing with matters not dealt with in the decision under appeal. Instead, the boards had discretion on this under Art. 111(1) EPC.

For the sake of completeness, the board noted that the list of grounds for a petition for review in Art. 112a EPC and R. 104 EPC was exhaustive. The "other" fundamental procedural defects referred to in Art. 112a(2)(d) EPC could only arise from either a failure to arrange for the holding of oral proceedings requested by a party (R. 104(a) EPC) or a failure to decide on a request relevant to the board's decision (R. 104(b) EPC). Therefore, even if the appellant's understanding of Art. 12(2) RPBA were correct, the alleged violation of the procedural principle that the appellant had inferred from that provision would not qualify as a ground for filing a petition for review.

055-05-24

Article 113 EPC | T 0419/21 | Board 3.5.02

Article 113(2) EPC

Case Number	T 0419/21
Board	3.5.02
Date of decision	2024.02.26
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 113(2) EPC
EPC Rules	Rule 51(2) EPC
RPBA	
Other legal provisions	
Keywords	withdrawal of the appeal (no) – withdrawal to be unambiguous – conditional withdrawal
Cited decisions	J 0016/94, J 0027/94, T 0006/92, T 0304/99, T 0502/02, T 0854/02, T 1402/13
Case Law Book	V.A.7.3.5 , V.A.7.3.6 , 10th edition

In [T 419/21](#) erklärte die Beschwerdeführerin (Anmelderin) die Rücknahme der Beschwerde mit folgender Bedingung: "...namens und in Vertretung der Beschwerdeführenden (sic) Anmelderin wird die vorliegende Beschwerde T 0419/21-3.5.02 zurückgenommen, sofern nicht

- die Jahresgebühr für das sechste (6.) Jahr (= EPAGebühren-Code 036) sowie
- die Zuschlagsgebühr zur Jahresgebühr für das sechste (6.) Jahr (= EPA-Gebühren-Code 096) wirksam entrichtet sind."

Die Kammer erläuterte, dass die Beschwerdeführerin das Beschwerdeverfahren nicht rechtswirksam durch die Erklärung der Beschwerderücknahme beendet hatte, da diese unter einer unzulässigen Bedingung erfolgte und nicht eindeutig war. Generell sei nämlich anerkannt, dass Verfahrenserklärungen, von denen abhängt, ob ein Verfahren einzuleiten oder fortzusetzen ist, im Interesse der Rechtssicherheit nicht an Bedingungen geknüpft sein dürfen, wenn dadurch offen bliebe, ob das Europäische Patentamt das Verfahren fortsetzen kann. Dies gelte insbesondere, wenn Dritte über die aufschiebende Wirkung einer Beschwerde nach Art. 106 (1) Satz 2 EPÜ im Unklaren bleiben würden. Sinn und Zweck einer Beschwerderücknahme sei es zudem, das Beschwerdeverfahren unmittelbar und ohne weiteren Prüfungsaufwand der Kammer zu beenden. Im Gegenzug werde der Beschwerdeführerin die entrichtete Beschwerdegebühr nach R. 103 EPÜ ganz oder teilweise erstattet. Dem würde es nach Ansicht der Kammer zuwiderlaufen, wenn sie

aufgrund der bedingten Erklärung erst prüfen müsste, ob für die für eine bedingte Rücknahmeerklärung maßgeblichen tatsächlichen oder rechtlichen Umstände eingetreten sind. Es wäre auch nicht gerechtfertigt, eine etwaige unzureichende Abstimmung zwischen Anmelder und Mandanten und die daraus resultierende Unklarheit über erfolgte Gebühreuzahlungen auf das Beschwerdeverfahren zu übertragen und die nicht erfüllten Abstimmungs- und Prüfungspflichten auf die Beschwerdekammer zu verlagern, um die Erstattung der Beschwerdegebühr zu ermöglichen. Dadurch würde die Kammer mit Prüfungspflichten belastet, die in den originären Verantwortungsbereich des Anmelders fallen, und es würde ohne rechtfertigenden Grund eine unklare Rechtssituation zu Lasten Dritter geschaffen. Auch im Falle der von der Beschwerdeführerin angeführten Gebühreuzahlung durch Dritte bestehe insoweit kein schutzwürdiges Interesse des Anmelders, da die Zahlung von Gebühren originär in seinen Verantwortungsbereich falle. Unterlasse es der Anmelder, selbst oder durch seine Vertreter entsprechende Zahlungen (rechtzeitig) zu veranlassen, so könne er entweder auf Zahlungen durch Dritte vertrauen oder seine Beschwerde (unbedingt und eindeutig) zurücknehmen, um die Beschwerdegebühr erstattet zu bekommen.

Eine bedingte Beschwerderücknahme sei demnach rechtlich nicht wirksam, wenn dadurch zunächst offenbleibt, ob das Beschwerdeverfahren fortgesetzt werden kann.

Ungeachtet der grundsätzlichen Problematik einer bedingten Beschwerderücknahme war die Rücknahmeerklärung der Beschwerdeführerin vorliegend nach Auffassung der Kammer auch deshalb nicht wirksam, weil sie unklar war. Die Abgabe einer verfahrensbeendenden Erklärung unter einer Bedingung, die nicht eindeutig ist, könne keine Rechtswirkungen entfalten. Die Beschwerdeführerin hatte ihre Rücknahmeerklärung an die wirksame Entrichtung der 6. Jahresgebühr und der Zuschlagsgebühr geknüpft. Die Formulierung "wirksam entrichtet sind" war jedoch unklar, denn, so die Kammer, es war nicht eindeutig erkennbar, ob die Rücknahmeerklärung unter der Bedingung stehen sollte, dass die Gebühren nicht bereits vor Eingang des Schriftsatzes vom 31. Januar 2023 gezahlt worden waren, oder ob auch eine Zahlung nach Eingang dieses Schriftsatzes, aber vor Ablauf der in R. 51 (2) EPÜ geregelten Frist, der Rücknahme entgegenstehen sollte. Zudem war auch nicht eindeutig erkennbar, ob allein auf die tatsächliche fristgerechte Einzahlung abgestellt werden sollte oder auf eine verfahrensabschließende Feststellung der (Un-)Wirksamkeit in einem Verfahren nach R. 112 (2) EPÜ, Art. 122 EPÜ oder Art. 7 (3) und (4) GebO.

Und schließlich war die Erklärung der Beschwerderücknahme nach Ansicht der Kammer auch deshalb nicht wirksam, weil sie unter einer Bedingung erfolgt war, die nicht rein innerprozessualer Art war. Die Kammer bestätigte die Rechtsprechung, wonach die Erklärung der Beschwerderücknahme unter einer Bedingung, die es erforderlich macht, Fragen zu prüfen, die nicht Bestandteil des eigentlichen Beschwerdeverfahrens sind, nicht wirksam ist.

094-08-24

Article 113 EPC | J 0011/20 | Board 3.1.01
Article 113(1) EPC

Case Number	J 0011/20
Board	3.1.01
Date of decision	2024.07.25
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 113(1) EPC
EPC Rules	Rules 058, 103(1)(a) EPC
RPBA	
Other legal provisions	
Keywords	right to be heard – violation of the right to be heard (yes) – substantial procedural violation (yes) – reimbursement of appeal fee (yes)
Cited decisions	
Case Law Book	III.B.2.4.4 , III.B.2.2.2 , 10th edition

[See also abstract under Article 16 EPC.](#)

In [J 11/20](#) the applicant appealed a decision of the Receiving Section refusing their application for the reason that the amended drawings filed by the applicant to remedy formal deficiencies in the application documents were not in agreement with the application documents as originally filed and, despite the invitation by the Receiving Section dated 14 March 2019, the applicant had not corrected this deficiency in due time.

In the statement of grounds of appeal, the appellant submitted that the Receiving Section's communication dated 14 March 2019 had appeared not to have been received by them. They also objected that the EPO had committed a substantial procedural violation by providing information on a procedural non-compliance leading to a severe loss of rights to an assistant by means of an informal telephone call, rather than to the duly appointed representative with an official communication. Informing, in an informal manner, the assistant instead of the duly appointed professional representative, prevented the latter from the possibility to correctly react. The appellant furthermore indicated that these arguments had already been brought to the attention of the Receiving Section with the letter dated 24 October 2019, in reply to the communication under Art. 113(1) EPC. However, they had remained disregarded and the Receiving Section had issued the appealed decision.

In the context of the reimbursement of the appeal fee under R. 103(1)(a) EPC, the Legal Board saw at least a substantial procedural violation in the fact that the Receiving Section had disregarded the objection of lack of receipt of the communication dated 14 March 2019, and had given no consideration to the request for re-establishment of rights. The lack of receipt of this communication had been disputed by the appellant – in addition to the statement of grounds of appeal – before the appealed decision was issued, both in the request for re-establishment of rights and in reply to the communication under Art. 113(1) EPC.

The Legal Board remarked that in the Receiving Section's communication under Art. 113(1) EPC, by reference to the telephone conversation with the assistant of the appellant's representative, the assumption that the communication dated 14 March 2019 had actually been received by the professional representative was taken as a fact. However, there was no trace in the file that the respective telephone note had also been formally notified to the professional representative, giving him the chance to take position on this fact before it being taken into account in the communication under Art. 113(1) EPC.

The Legal Board held that, by simply disregarding the appellant's submissions, the Receiving Section had violated the right to be heard under Art. 113(1) EPC. It is a well-established principle that this right requires not only that an opportunity to present comments is given, but also that these comments are actually taken into due consideration in the decision. The Legal Board concluded that this violation was of a substantial nature since it had affected the reasons on which the appealed decision had been taken, namely the assumption that the communication dated 14 March 2019 had been received by the appellant and thus the deficiencies under R. 58 EPC had not been corrected in due time. The appellant had been given no other choice than filing the appeal. In view of these circumstances, the Legal Board considered that reimbursement of the appeal fee was equitable.

125-11-24

Article 114 EPC | T 0307/22 | Board 3.2.04
Article 114 EPC

Case Number	T 0307/22
Board	3.2.04
Date of decision	2023.10.27
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 087(1), 089, 114 EPC
EPC Rules	Rule 116(1) EPC
RPBA	Articles 12(6), 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	late submissions – review of first instance discretionary decision – late-filed document – review of substantive issues underlying the discretionary decision – same invention (no) – partial priority (yes) – amendment after summons – exceptional circumstances (yes) – exercise of discretion – admitted (no)
Cited decisions	G 0001/15
Case Law Book	V.A.3.4.1 , V.A.3.4.3.a , V.A.4.3.6 , V.A.4.5.11 , 10th edition

In [T 307/22](#) richtete sich die Beschwerde der Einsprechenden gegen die Entscheidung der Einspruchsabteilung, in der unter anderem D7 wegen mangelnder Relevanz nicht zum Verfahren zugelassen wurde.

Im Einspruchsverfahren hatte die Einsprechende die gültige Inanspruchnahme der Priorität aus D8 bestritten und einen Neuheitseinwand auf die inhaltsgleiche Gebrauchsmusteranmeldung D7 (mit gleichem Anmeldetag wie D8) gestützt. Die Einspruchsabteilung hatte jedoch die Gültigkeit der Priorität bestätigt und die verspätet vorgelegte D7 als nicht relevant (da nicht zum Stand der Technik gehörig) nicht zum Einspruchsverfahren zugelassen.

Die Kammer wies darauf hin, dass eine Beschwerdekammer grundsätzlich darauf beschränkt ist zu überprüfen, ob die Einspruchsabteilung ihr Ermessen gemäß Art. 114, R. 116 (1) EPÜ bei der Nichtzulassung eines verspätet vorgebrachten Dokuments korrekt ausgeübt hat, d.h. nicht willkürlich und unter Berücksichtigung von angemessenen Kriterien (siehe Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.3.4.1.b). Somit entscheide die Kammer in der Regel nicht

nochmals an Stelle der Einspruchsabteilung über die Zulassung in Ausübung eigenen Ermessens. Vorliegend beruhe die Ermessensentscheidung der Einspruchsabteilung jedoch auf einer vorhergehenden materiellrechtlichen Feststellung der gültigen Inanspruchnahme der Priorität und damit der Zuerkennung eines entsprechenden Zeitrangs für das Patent. Eine solche Entscheidung über Priorität und Zeitrang sei durchaus einer Überprüfung durch die Kammer zugänglich (Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.3.4.1.c)).

Bei dieser Überprüfung kam die Kammer zu dem Schluss, dass Anspruch 1 gemäß Hauptantrag (erteilte Fassung) entgegen der Feststellung der Einspruchsabteilung nicht über seinen gesamten Umfang der über die Priorität beanspruchte Zeitrang zukomme. Damit entfalle die Grundlage für die Ermessensentscheidung der Einspruchsabteilung, D7 nicht zum Verfahren zuzulassen. Die Kammer befand erneut über die Zulassung der D7 mit dem Ergebnis, dass diese Entgeghaltung – aufgrund der wirksamen Inanspruchnahme einer Teilpriorität nach den Grundsätzen aus G 1/15 – wiederum wegen mangelnder Relevanz für die Neuheit nicht zugelassen wurde.

Den erstmals in der mündlichen Verhandlung vorgetragenen Einwand, dass D7 für die Alternativen des Anspruchs 1, denen nicht der Zeitrang der D8 zukomme, geeignet sei, die erfinderische Tätigkeit in Frage zu stellen, ließ die Kammer in Ausübung ihres Ermessens nach Art. 13 (1), (2) VOBK nicht zum Verfahren zu. Zwar sah die Kammer einen außergewöhnlichen Umstand darin, dass sie in ihrer Mitteilung nach Art. 15 (1) VOBK die Auffassung vertreten hatte, dass der Gegenstand von Anspruch 1 des Hauptantrags statt vollumfänglicher Priorität aus D8 nur Teilpriorität genieße, da sich daraus erstmalig ergab, dass D7 geeignet sein könnte, die erfinderische Tätigkeit der Alternativen mit späterem Zeitrang in Frage zu stellen. Die Kammer stellte aber in einem zweiten Schritt im Rahmen ihrer Ermessensausübung nach den Kriterien des Art. 13 (1) VOBK auf die prima facie Relevanz von D7 für die erfinderische Tätigkeit ab und ließ D7 letztlich mangels einer solchen Relevanz nicht zum Verfahren zu.

020-02-24

Article 114 EPC | T 2716/19 | Board 3.3.02
Article 114 EPC

Case Number	T 2716/19
Board	3.3.02
Date of decision	2024.01.10
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 114 EPC
EPC Rules	
RPBA	Article 12(1), (2), (4) RPBA 2007 Article 25(2) RPBA 2020
Other legal provisions	
Keywords	document admitted by first instance (no) – correct exercise of discretion (no) – limited assessment of prima facie relevance unreasonable – non-admittance decision of opposition division overturned
Cited decisions	G 0007/93
Case Law Book	IV.C.4.5.2 , IV.C.4.5.3a , V.A.3.4.3 , 10th edition

In [T 2716/19](#) the board held that D24 should have been admitted into the opposition proceedings by the opposition division for the following reasons.

Assuming the opposition division had correctly concluded that D24 was late-filed, the board found it had correctly assessed whether D24 was prima facie relevant for maintaining the then main request when deciding on its admittance. However, the assessment of the prima facie relevance of D24 should not have been limited to the subject-matter of claim 1 of the then main request. It should have extended to the subject-matter of the auxiliary requests on file, especially the subject-matter of claim 1 of then auxiliary request 6 (main request in the appeal proceedings). Extending the assessment avoided finding the potentially patentable subject-matter of an auxiliary request unallowable for the sole reason that a document, prima facie relevant to the subject-matter of the request, was not considered. Therefore, the opposition division, when deciding on the admittance of D24, while using the correct criterion of prima facie relevance, had used it in an unreasonable way because it limited its assessment to the subject-matter of the then main request.

In accordance with G 7/93, the board exercised its power to overrule this admittance decision by the opposition division and decided that the decision by the opposition

division to not admit D24 had to be set aside. Since the respondent referred to D24 in its reply to the grounds of appeal, i.e. at the earliest possible stage of the appeal proceedings, and based its inventive-step case on it, the board concluded that D24 should be part of the appeal proceedings pursuant to Art. 12(1), (2) and (4) RPBA 2007 (applicable according to Art. 25(2) RPBA 2020).

034-03-24

Article 114 EPC | T 0021/22 | Board 3.3.03
Article 114(2) EPC

Case Number	T 0021/22
Board	3.3.03
Date of decision	2024.07.09
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 099, 114(2) EPC
EPC Rules	
RPBA	Article 12(4) RPBA 2020
Other legal provisions	
Keywords	Late-filed facts – correct exercise of discretion (no)
Cited decisions	T 2324/14, T 2026/15, T 1525/17, T 0847/20
Case Law Book	IV.C.4.5.3a , 10th edition

In [T 21/22](#) document D20 was filed by the appellant (opponent) on the day of the oral proceedings before the opposition division but was not admitted into the proceedings because of its late filing and the fact that it was not prima facie relevant for novelty and inventive step.

Although the respondent had initially endorsed the arguments of the opposition division, they stated during the oral proceedings before the board that they withdrew their objection to the admittance of D20 into the proceedings.

The board observed that the opposition division had in fact conducted a comprehensive examination of late-filed D20 in respect of novelty and inventive step prior to concluding that it should not be admitted on the basis of its late filing and the fact that it was not prima facie relevant. The opposition division had therefore not only carried out a mere prima facie assessment but had fully considered D20 and the objections based upon it. Thus, the board held that there was no discretion left for the opposition division not to admit D20 into the proceedings (cf. T 1525/17, T 847/20, T 2026/15, T 2324/14), since it was de facto fully considered (and therefore implicitly admitted) by the opposition division.

126-11-24

Article 114 EPC | T 1445/22 | Board 3.2.07
Article 114(2) EPC

Case Number	T 1445/22
Board	3.2.07
Date of decision	2024.03.28
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 099(1), 114(2) EPC
EPC Rules	Rule 116(1) EPC
RPBA	Articles 12(4), 12(6) RPBA 2020
Other legal provisions	
Keywords	late filed evidence – opportunity to present comments (yes) – correct exercise of discretion (yes) – evidence admitted (no)
Cited decisions	G 0010/91, T 1002/92
Case Law Book	IV.C.2.2.2 , IV.C.4.3 , IV.C.4.5.1 , V.A.4.3.6 , 10th edition

In [T 1445/22](#) the appellant requested the admittance into the appeal proceedings of late-filed documents D10 to D12, D14, D15 and D20, which had not been admitted into the opposition proceedings for being prima facie not relevant with respect to the sufficiency of disclosure objection, as well as D26 and D27 filed with the statement of grounds of appeal.

The board first examined Art. 12(6), first sentence, RPBA and noted that evidence submitted by an opponent after the expiry of the nine-month period according to Art. 99(1) EPC was generally to be regarded as late-filed. Exceptions to this rule were where such evidence could not have been filed earlier, for example where the subject of the proceedings had changed. This was typically the case where new claim requests were filed such that there was no reason to file the evidence in response thereto any earlier or where the opposition division had raised a new issue.

In the case in hand the opposition division had not raised any new aspects in its preliminary opinion, but rather reiterated the position, given by the respondent (patent proprietor) in its reply to the notice of opposition. The board found therefore that there had been no change in the subject of the proceedings before the opposition division which would have led to new evidence being considered to be timely filed.

The board also did not consider the circumstances leading to the obtainment of the evidence by the party filing it as relevant for the issue of whether a document was filed in due time. These circumstances were external to the proceedings and it would run counter to the concept of discretionary power if that discretion were denied to a deciding body by circumstances external to the proceedings. Were such discretion to be denied, then all documents created or coming to light at any stage of the proceedings that were filed by a party would automatically be part of the proceedings. However, this would undermine the nine-month period under Art. 99(1) EPC which aims to establish the factual and legal framework within which the substantive examination of the opposition is, in principle, conducted, allowing the patent proprietor a fair chance to consider its position at an early stage of the proceedings (see G 10/91, point 6 of the Reasons, and T 1002/92). Therefore, documents D10 to D12, D14, D15 and D20 had not been filed in due time and the opposition division had the discretion, under Art. 114(2) EPC, not to admit them.

The appellant (opponent) argued that it had not been given the opportunity to present detailed arguments based on documents D10 to D12, D14, D15 and D20, as only prima facie relevance had been discussed before the opposition division. The board found, however, that the appellant had in fact had the opportunity to present its arguments relating to the admittance and prima facie relevance of those documents during the opposition proceedings. It also noted it was established case law that a board of appeal should only overrule the way an opposition division exercised its discretion if it did so according to the wrong principles, not taking into account the right principles or in an unreasonable way. It was, therefore, not the function of a board of appeal to review all the facts and circumstances of the case to decide whether it would have exercised its discretion in the same way or not. In the case in hand the opposition division had regarded D10 to D12 as representing common general knowledge which did not need to be supported, and it could not see the relevance of D14, D15 or D20 for supporting the objection to insufficiency of disclosure. Thus, the opposition division had considered these documents as prima facie not relevant and had exercised its discretion reasonably, according to the right principles, after hearing both parties.

In its statement of grounds of appeal, the appellant had further requested that documents D10 to D12, D14, D15 and D20 be admitted into the appeal proceedings with respect to the appellant's lack of inventive step objections. The board decided to exercise its discretion under Art. 114(2) EPC and Art. 12(4) RPBA and not admit these documents into the appeal proceedings as none of the documents were suitable to address the issues which led to the decision under appeal.

In addition, the board found that there was no change in the opposition proceedings or particular circumstances in the present case which necessitated the filing of documents D26 and D27 for the first time in the appeal proceedings. D26 and D27 could and should have been filed during the opposition period. Therefore, the board did not admit them into the appeal proceedings (Art. 12(6), second sentence, RPBA and Art. 12(4) RPBA).

127-11-24

Article 116(1) EPC

Case Number	T 0124/22
Board	3.5.03
Date of decision	2024.07.19
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 116(1) EPC
EPC Rules	
RPBA	Articles 12(8), 15(1) RPBA 2020
Other legal provisions	Articles 5(a), 6 of the epi Code of Conduct
Keywords	oral proceedings – non-attendance of party
Cited decisions	T 0930/92
Case Law Book	III.C.5.3 , III.C.4.3.2 , 10th edition

In [T 124/22](#) the parties had been summoned to oral proceedings before the board and a communication had been issued under Art. 15(1) RPBA. By letter of reply, received one day before the scheduled oral proceedings, the respondent had stated that it would not be attending the arranged oral proceedings. No substantive submissions had been made. Subsequently, the oral proceedings had been cancelled.

The board noted that the respondent's representative had provided his videoconferencing details eight days before the scheduled oral proceedings, indicating an intention to participate. However, he had notified the board of his non-participation only one day before the scheduled proceedings. Typically, such notifications were given well in advance (see also T 930/92). According to the board, given that the board's preliminary opinion had been issued ten months ahead of the scheduled hearing, the respondent had had ample time to inform the board of its non-attendance well ahead of the hearing.

In the board's opinion, while it was not uncommon for representatives to receive late instructions, they should seek timely directions from their clients, particularly when arranged oral proceedings approach. In this instance, the representative had failed to communicate promptly with the board's registry. The board pointed out that it (and presumably the opposing party's representative) had already invested some time in preparing for the oral proceedings. It recalled that according to Art. 6 of the epi Code of Conduct, members are required to act courteously in their dealings with the EPO.

The same principle applied to behaviour towards other representatives (Art. 5(a) of the epi Code of Conduct).

The board also took the view that the respondent had effectively withdrawn its request for oral proceedings by declaring its intent not to attend them. In turn, the board did not consider the conduct of oral proceedings to be expedient (Art. 116(1) EPC). As a consequence, the decision was handed down in written proceedings (Art. 12(8) RPBA).

106-09-24

Article 117 EPC | T 2517/22 | Board 3.2.04
Article 117 EPC

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

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

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

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

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

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

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

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

114-10-24

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

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

Article 123(2) EPC | T 0110/20

| Board 3.2.02

Article 123(2) EPC

Case Number	T 0110/20
Board	3.2.02
Date of decision	2023.09.26
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (yes) – undisclosed feature – disclaimers – undisclosed disclaimers
Cited decisions	G 0001/93, G 0001/03, G 0002/10, G 0001/16, T 0535/08, T 0824/08, T 1779/09, T 1595/11, T 0312/16, T 0768/20, T 0412/22
Case Law Book	II.E.1.3.1 , 10th edition

In [T 110/20](#) the board recalled that in G 1/93 the Enlarged Board acknowledged the inescapable trap that may result from Art. 123(2) and (3) EPC (see point 1 of the Order). The Enlarged Board then went on to specify certain circumstances under which an undisclosed feature was not to be considered to infringe Art. 123(2) EPC (see point 2 of the Order): "A feature which has not been disclosed in the application as filed but which has been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed in the sense of Art. 123(2) EPC."

The board explained that several decisions had assessed whether an undisclosed feature was to be considered added subject-matter under Art. 123(2) EPC in view of point 2 of the Order of G 1/93. Occasionally, an undisclosed feature was found allowable under Art. 123(2) EPC on the basis of point 2 of the Order of G 1/93 (see for example T 1779/09, T 1595/11, T 824/08 and T 535/08). However, in most cases, the competent board had found that the undisclosed feature provided a technical contribution, concluding that the conditions set out in point 2 of the Order of G 1/93 were not fulfilled (see for example T 412/22 and T 312/16). Also in the case in hand,

the board established that the undisclosed feature added to claims 1 and 4 provided a technical contribution to the subject-matter of the claimed invention within the meaning of point 2 of the Order of G 1/93.

The board noted that T 768/20 stated that point 2 of the Order of G 1/93 seemed to address undisclosed disclaimers, which were later examined in greater detail in G 1/03. The present board further noted that the allowability criteria according to point 2 of the Order of G 1/93 were different from those laid down for undisclosed disclaimers in G 1/03. Accordingly, an undisclosed disclaimer could fulfil the criteria according to point 2 of G 1/93 without fulfilling the (stricter) criteria set out in G 1/03. In the board's view this could only mean that, to the extent that point 2 of the Order of G 1/93 concerned undisclosed disclaimers, it had to be considered to have been superseded by G 1/03 and G 1/16.

Moreover, regardless of whether or not point 2 of the Order of G 1/93 addressed undisclosed disclaimers, the present board referred to T 768/20 in which it was stated that the case law of the Enlarged Board did not seem to provide for any further exception to the gold standard other than the exception concerning undisclosed disclaimers under G 1/03.

The board concluded that the only claim request comprised added subject-matter thus infringing Art. 123(2) EPC.

035-03-24

Article 123(2) EPC | T 1261/21 | Board 3.3.09
Article 123(2) EPC

Case Number	T 1261/21
Board	3.3.09
Date of decision	2024.01.10
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (no) – selections from two or more lists – convergent lists
Cited decisions	T 2237/10, T 1621/16, T 1937/17, T 1210/20, T 1133/21
Case Law Book	II.E.1.6.1a , II.E.1.6.2c , II.E.1.6.2d , 10th edition

In [T 1261/21](#) the board established that in claim 1 of auxiliary request 26, the deodorisation time and the deodorisation temperature were limited based on a disclosure of converging numerical ranges or converging elements of the same feature (also named "converging alternatives" in some board decisions) in claims 3 and 4 of the application as filed. The triglyceride composition was limited based on a list of non-converging alternatives in claim 10 of the application as filed.

The board explained that the "gold standard" must be applied universally to assess whether amendments comply with Art. 123(2) EPC (G 2/10). In the case in hand, the criteria set out in T 1621/16 were helpful.

The board concurred with T 1937/17 that the first criterion in point 2 of the Catchword of T 1621/16 ("the subject-matter resulting from the multiple selections is not associated with an undisclosed technical contribution") should not be taken into account when establishing whether there was a direct and unambiguous disclosure for the combination of features resulting from a multiple selection. However, the board agreed with the conclusion in point 1 of the Catchword of T 1621/16 that the choice of a more or less preferred element from a list of converging alternatives should not be treated as an arbitrary selection because this choice did not lead to a "singling out". The board further agreed that in general a pointer to the combination of features resulting from multiple selections was necessary to comply with

Art. 123(2) EPC (see second criterion in point 2 of the Catchword of T 1621/16). In this context, the present board preferred the term "converging elements" to "converging alternatives", as "alternatives" seemed to imply that there were real alternatives that did not overlap.

Furthermore, the board agreed with T 1133/21 that, first, the mere fact that features were described in terms of lists of more or less converging elements (alternatives) did not give the proprietor carte blanche to freely combine features selected from a first list with features selected from a second list disclosed in the application as filed. This was particularly relevant where an application as filed provided a large reservoir of options and alternatives. Second, factors which may play a role in the assessment of Art. 123(2) EPC were, inter alia, the number of elements (alternatives) disclosed in the application; the length, convergence and any preference in the lists of enumerated features; and the presence of examples pointing to a combination of features.

In addition, the board considered that the question of whether the claimed combination of features merely resulted from the combination of claims having an appropriate back-reference to each other (see T 2237/10) played a role in the assessment of compliance with Art. 123(2) EPC. Particularly relevant was whether there was a pointer to the claimed combination of features. This was especially so in cases like the present one where only very few "selections" were necessary to arrive at the claimed combination of features. A pointer was an (implicit or explicit) indication or hint towards the combination of features in question. The pointer needed to be suitable for demonstrating that the claimed combination of features was envisaged in the application as filed. Typically, it consisted of an example or embodiment. In the board's view, there was not normally only one pointer towards the most preferred example or embodiment.

Finally, the board observed that an overly formalistic application of the concept of multiple selections from lists of alternatives should be avoided (see T 1210/20).

Thus, the question was whether there was a pointer in the application as filed to the combination of the two numerical ranges relating to different levels or enumerations of converging elements, and a selection from a list of non-converging alternatives. Example 1 of the application as filed exemplified the deodorisation of cocoa butter. In the board's view, this emphasised that cocoa butter was a preferred triglyceride composition. Thus, the selection of cocoa butter was not arbitrary. Also, the experiments of example 1 all fell within the time and temperature requirements of claim 1, thus supporting that the claimed combination of features was not the result of an arbitrary selection. The board concluded that the subject-matter of claim 1 of auxiliary request 26 met Art. 123(2) EPC.

048-04-24

Article 123(2) EPC | T 1762/21 | Board 3.2.02
Article 123(2) EPC

Case Number	T 1762/21
Board	3.2.02
Date of decision	2024.02.14
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (no) – intermediate generalisations
Cited decisions	G 0001/93, G 0002/10
Case Law Book	II.E.1.9.1 , II.E.1.9.2 , 10th edition

[See also abstract under Article 88\(4\) EPC.](#)

In [T 1762/21](#) the appellant (opponent) argued that claims 1 and 7 of the main request had inadmissibly omitted a number of features which had been presented together with the claimed features in the application as filed and which were important for the functioning of the claimed breast tomosynthesis system. This amounted to an intermediate generalisation.

The board explained that when assessing the allowability of an intermediate generalisation, it had to be established whether, because of this generalisation, the claim presented technical information which extended beyond what was directly and unambiguously disclosed in the application as filed, be it explicitly or implicitly, to the skilled person using common general knowledge. This was the "gold" standard for assessing whether any amendment fulfilled Art. 123(2) EPC (G 2/10). G 1/93, referred to by the appellant, dealt with the conflicting requirements of Art. 123, paragraphs (2) and (3), EPC. It did not prescribe any special criteria for the assessment of intermediate generalisations.

The skilled person was presented with subject-matter extending beyond the application as filed when an amended claim included only some features of an originally disclosed combination and the features left out of the claim were understood by the skilled person to be inextricably linked to the claimed ones. This was the case if the skilled person would have considered the omitted features as

necessary to achieve the effect associated with the added features. In such a situation, the amended claim conveyed the technical teaching that the effect could be obtained with the claimed features alone. This was in contradiction with the original disclosure, according to which the whole combination of features was needed. The passage concerning intermediate generalisations in chapter H-V, 3.2.1 of the Guidelines had to be understood in this context.

In the case in hand, the invention as claimed in independent claims 1 and 7 of the main request was directed to a breast tomosynthesis system and a method of acquiring breast tomosynthesis x-ray images with such a system. In the original disclosure, the features of these claims related specifically to optimising the acquired images by acting on the focal spot. Features in the description relating to other aspects of the system, such as the way in which the x-rays were generated or the way in which the breast was fixed in place on the detector, could be left out of the claims as long as they were not relevant to the optimisation, even if they contributed to the general functioning of the tomosynthesis system.

Hence, the board concluded that the subject-matter of claims 1 and 7 of the main request did not extend beyond the content of the application as filed.

049-04-24

Article 123(2) EPC | T 2047/21 | Board 3.4.03
Article 123(2) EPC

Case Number	T 2047/21
Board	3.4.03
Date of decision	2024.04.11
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (yes) – disclaimers – undisclosed disclaimers
Cited decisions	G 0001/03, G 0002/10, G 0001/16
Case Law Book	II.E.1.7.3 , 10th edition

In [T 2047/21](#) claim 1 of auxiliary request 1b defined a container by means of a disclaimer. It was disputed among the parties whether this was a "disclosed disclaimer" or an "undisclosed disclaimer".

The board explained that G 1/16 provided definitions for the terms "undisclosed disclaimer" and "disclosed disclaimer". The term "undisclosed disclaimer" related to the situation in which neither the disclaimer itself nor the subject-matter excluded by it had been disclosed in the application as filed. The term "disclosed disclaimer" related to the situation in which the disclaimer itself might not have been disclosed in the application as filed but the subject-matter excluded by it had a basis in the application as filed. Thus, undisclosed disclaimers and disclosed disclaimers could be distinguished according to whether the subject-matter on which the respective disclaimer was based was explicitly or implicitly, directly and unambiguously, disclosed to the skilled person using common general knowledge, in the application as filed.

In the case in hand, the disclaimed subject-matter was a container for containing tissue comprising features (a) to (c1). The board established that this was an "undisclosed disclaimer" because the skilled person using their general knowledge would not directly and unambiguously derive this type of container from the original application.

To be allowable, an undisclosed disclaimer had to fulfil one of the criteria set out in point 2.1 of the order of decision G 1/03 (see the Headnote of G 1/16).

An undisclosed disclaimer may be allowable in order to: restore novelty by delimiting a claim against state of the art under Art. 54(3) and (4) EPC [1973]; restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC (an anticipation was accidental if it was so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention); and disclaim subject-matter which, under Art. 52 to 57 EPC, was excluded from patentability for non-technical reasons.

During the opposition proceedings, the appellant justified the disclaimer by the objections raised against granted claim 1 in view of D2. However, D2 was neither state of the art under Art. 54(3) EPC nor an accidental anticipation under Art. 54(2) EPC. During the appeal proceedings, the appellant did not put forward any argument to show that any of the criteria set out in G 1/03 were fulfilled.

The board thus concluded that claim 1 of auxiliary request 1b did not meet the requirements of Art. 123(2) EPC.

056-05-24

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

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

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

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

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

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

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

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

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

069-06-24

Article 123(2) EPC | T 1084/22 | Board 3.2.04
Article 123(2) EPC

Case Number	T 1084/22
Board	3.2.04
Date of decision	2024.05.24
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (yes) – cross-references to other documents – intermediate generalisation
Cited decisions	T 0689/90
Case Law Book	II.E.1.2.4 , II.E.1.3.1 , II.E.1.9.1 , 10th edition

In [T 1084/22](#) the patent concerned insulating glazing units, which typically consist of two glass sheets separated by a perimeter spacer. Specifically, it related to a method for creating such units. This involved providing a spacer body with adhesive on both sides in a storage container. Claim 1 was amended during examination to specify that the adhesive was a pressure sensitive adhesive.

The board was not convinced by the argument put forward by the appellant (patent proprietor) which aimed to show that the feature was implicitly derivable from the description.

The board found that the second line of argument submitted by the appellant was not convincing either. The appellant had submitted that the reference in the description of the application as filed to HBP8 (a US patent), which mentioned pressure sensitive adhesives, also provided an original basis for the added feature.

The board explained that the appealed decision referred to conditions developed in the case law for being able to incorporate features from a cross-referenced document (see in particular T 689/90). Thus, only under particular conditions would adding features from a cross-referenced document to a claim not be contrary to Art. 123(2) EPC, namely if (a) the description of the invention as filed left the skilled reader in no doubt that protection was sought or may be sought for those features; (b) that they implicitly clearly belonged to the description of the invention contained in

the application as filed and thus to the content of the application as filed; and (c) that they were precisely defined and identifiable within the total technical information contained in the reference document.

The board viewed these conditions, along with alternative or reformulated criteria found in the cases cited in Case Law of the Boards of Appeal, 10th ed. 2022, II.E.1.2.4, as different applications of the "gold standard". While different tests had been developed, they could only assist in determining whether an amendment complied with Art. 123(2) EPC, but did not replace the "gold standard" and should not lead to a different result. Thus, the board considered it sufficient and appropriate to apply the "gold standard" principle to this case.

In a case of incorporating features from a cross-d document, the "gold standard" essentially required that the skilled reader had to be able to directly and unambiguously derive which subject-matter of the incorporated document was part of the original application. In other words, which features of the application were to be taken from the referenced document.

Therefore, the question that the board needed to answer was whether, in the absence of any hindsight or knowledge of the amended claim, the skilled person reading the original documents would directly and unambiguously derive from the cross-reference to HBP8 that the adhesive's pressure sensitive nature was a feature to be incorporated from HBP8 into the original application. This required that when the skilled reader of the application as filed consulted HPB8 as instructed it was immediately clear to them that it was that feature and that feature alone that was to be included. If that feature was disclosed in a certain technical context in the cross-referenced document, then, applying the same standard as for intermediate generalisations, isolation of the feature was justified only in the absence of any clearly recognisable functional or structural relationship.

In the board's view it was neither immediately clear to the skilled person from the cross-reference to HBP8 that it was the feature of the adhesive being pressure sensitive that was to be included, nor that that feature could be taken out of its context in HPB8.

Hence, the board concluded that the amendment to claim 1 specifying the adhesive as "pressure sensitive" extended the patent's subject matter beyond the content of the original application.

080-07-24

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

Case Number	T 1809/20
Board	3.3.02
Date of decision	2024.06.06
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (yes) – multiple selection at different levels of preference – no pointer
Cited decisions	T 1241/03, T 0181/08, T 1621/16
Case Law Book	II.E.1.6.1a , 10th edition

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

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

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

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

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

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

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

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

115-10-24

Article 123(3) EPC

Case Number	T 0953/22
Board	3.2.05
Date of decision	2023.09.19
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 069, 100(c), 123(3) EPC; Article 123(3) EPC 1973
EPC Rules	
RPBA	
Other legal provisions	Protocol on the Interpretation of Article 69 EPC
Keywords	amendments – extension of the protection conferred (yes) – disclosure in drawings
Cited decisions	G 0002/88, G 0001/93, T 1149/97, T 0142/05, T 2475/18, T 1473/19
Case Law Book	II.A.6.3.3 , II.E.2.4.5 , 10th edition

In [T 953/22](#) the board noted that the wording of Art. 123(3) EPC was not identical to the wording of Art. 123(3) EPC 1973, which read: "**The claims of** the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred." (emphasis added by the board). However, the case law on Art. 123(3) EPC 1973 made it clear that the extent of protection under Art. 69 EPC 1973 and the Protocol on its Interpretation was determined by the wording of the claims, taking into account the description and drawings, and that amendments to the description and drawings may therefore also extend the protection under Art. 69(1) EPC 1973 (see e.g. G 2/88, point 4 of the Reasons; G 1/93, point 11 of the Reasons; T 1149/97 and T 142/05). For this reason, the basic principles analysed in the case law on Art. 123(3) EPC 1973 were applicable to Art. 123(3) EPC as well. In T 142/05, the board held that amendments to the description and drawings could modify the content of the claims and possibly extend the scope of protection under Art. 69(1) EPC 1973, even where the wording of the claims was clear and remained unamended.

In auxiliary request 1 ("AR 1") of the case in hand, claim 1 and the description remained unamended. The description disclosed that the length of the overlay welds was shown as L2 in Figure 4 ("Fig. 4"). However, Fig. 4 of AR 1 differed from Fig. 4 of the patent as granted. In Fig. 4 of the patent as granted, length L2 of the overlay welds was depicted as extending on only one side of the girth weld. In contrast, in

Fig. 4 of AR 1, length L2 of the overlay welds was depicted as the total length of the overlay welds on both sides of the girth weld. Using Fig. 4 of the patent as granted, an arrangement with a total length of the overlay welds of 160 mm, i.e. 80 mm on either side of the girth weld, was not within the extent of the protection conferred. However, in view of amended Fig. 4, the same arrangement lay within the extent of the protection conferred according to AR 1. Considering amended Fig. 4, the board established that the protection conferred by the patent as amended according to AR 1 was extended (Art. 123(3) EPC; G 2/88, point 4.1 of the Reasons).

The board was not convinced by the counter-arguments of the appellant. Firstly, the appellant submitted that the skilled person knew that Fig. 4 of AR 1 was wrong, so they would not use this figure to interpret the claims. However, the board explained that the skilled person would not immediately recognise amended Fig. 4 as incorrect. Secondly, by referring inter alia to T 1473/19, the appellant argued that a discrepancy between the claims and the description was not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently or to give a different meaning to a claim feature which in itself imparted a clear credible technical teaching to the skilled reader. The board explained that the description and drawings were also taken into account for the purposes of Art. 123(3) EPC if the claims were clear and unambiguous. They were not only consulted to fill gaps. The statement that "limiting features which are only present in the description but not in the claim cannot be read into a patent claim" (T 1473/19) was not fully applicable to the case in hand.

Citing Art. 1 of the Protocol on the Interpretation of Article 69 EPC and G 2/88 (point 4 of the Reasons), the board, while also recognising the primacy of the claims under Art. 69(1) EPC, explained that it would not in the case in hand go so far as to say that the disclosure of the description and the figures could not be read into the patent claim. The board also relied on G 1/93 (point 11 of the Reasons), according to which: "In principle, it does not matter whether the addition concerns the claims, the description or the drawings, since the protection conferred by the patent has to be determined by all these elements in accordance with Art. 69 EPC and the Protocol on the interpretation of this provision. However, the claims are no doubt the most important element in this respect."

Further, the facts in T 1473/19 were different. In T 1473/19 the objection under Art. 123(3) EPC was raised against a request with amended claims, whereas in the present case the amendment was only to one of the figures of the patent as granted. The features of claim 1 as granted did not define how the length of the overlay welds was to be understood. It was only by using the description and the drawings, in particular Fig. 4 as granted (or as amended in AR 1), that the extent of protection could be determined. Fig. 4 as granted (or as amended in AR 1) was thus not used to read limiting features into claim 1 that were not present in this claim but to determine the extent of the protection conferred.

009-01-24

Article 123(3) EPC | T 0664/20 | Board 3.3.10
Article 123(3) EPC

Case Number	T 0664/20
Board	3.3.10
Date of decision	2023.10.18
Language of the proceedings	FR
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(3) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – extension of the protection conferred (yes) – cascade formulation
Cited decisions	T 2017/07, T 0999/10, T 0287/11, T 0881/11, T 1360/11, T 0052/13, T 0262/13, T 0865/13, T 0306/14, T 0514/14, T 1063/15, T 2215/18
Case Law Book	II.E.2.3.3 , II.E.2.4.13 , 10th edition

[See also abstract under Article 12\(3\) RPBA.](#)

Dans la décision [T 664/20](#) la chambre a notamment indiqué dans son exergue qu'une formulation dite "en cascade" de caractéristiques est susceptible d'entraîner une ambiguïté de la revendication. Lorsqu'une revendication est définie comme incluant une classe générique de composés présents dans une gamme pondérale et que la revendication est modifiée "en cascade" en indiquant que la classe générique est un composé spécifique, alors la gamme pondérale s'applique à ce composé spécifique, et non plus à la classe générique.

Dans la présente affaire, la revendication 1 de la requête subsidiaire 3 a été modifiée en indiquant que le copolymère fonctionnel est l'anhydride maléique. La limitation à 1% en poids des copolymères fonctionnels requis par les revendications du brevet tel que délivré ne s'applique plus qu'à l'anhydride maléique. La composition de la revendication 1 de la requête subsidiaire 3, du fait qu'elle est définie comme étant ouverte à la présence de composés optionnels, peut ainsi comprendre l'acide acrylique dans une proportion supérieure à 1% en poids, ce qui n'était pas couvert par les revendications du brevet tel que délivré, car l'acide acrylique étant un comonomère fonctionnel, sa quantité y est limitée à 1% (voir T 2017/07). La chambre

arrive donc à la conclusion que la revendication 1 de la requête subsidiaire 3 ne satisfait pas aux exigences de l'art. 123(3) CBE.

L'exergue de T 999/10, invoqué par le requérant I (titulaire), indique que la formulation "en cascade" dans une revendication ouverte ("comprenant"), c'est-à-dire, en gardant dans une revendication modifiée la définition large de la revendication 1 et en ajoutant, par le biais de la tournure "et dans lequel/laquelle...", une restriction supplémentaire, évite la situation envisagée par T 2017/07 où une modification initialement apportée dans l'intention de restreindre une revendication étendait en fait la protection conférée par celle-ci.

Cependant, la chambre dans la présente affaire estime que la revendication 1 de la requête subsidiaire 3 ne maintient pas la limitation relative à la quantité des comonomères fonctionnels présents dans la composition de la revendication 1 du brevet tel que délivré. La chambre s'écarte de l'interprétation restrictive suivie dans l'affaire T 999/10 dans laquelle il avait été jugé que compte tenu de la formulation en cascade de la revendication modifiée, il n'y avait aucun doute quant à l'intention du titulaire du brevet qu'aucun copolymère séquencé autre que le type SIS spécifique ne puisse être présent dans l'adhésif. Cette interprétation restrictive de la portée de la revendication a été adoptée dans les affaires T 262/13, T 1063/15 et T 2215/18. Cependant, elle n'a pas été suivie dans les affaires T 514/14, T 881/11, T 52/13, T 865/13 et T 287/11.

La chambre ici rejette l'argumentation basée sur les intentions du rédacteur d'une revendication et fait siennes les considérations du point 2.8.2 des motifs de T 287/11 selon lesquelles l'étendue de la protection est un critère objectif qui doit s'apprécier sur la base de la signification des caractéristiques techniques présentes dans la revendication et non pas à la lumière de l'intention du rédacteur de la revendication. La chambre souscrit également au point 2 des motifs de T 514/14 énonçant qu'une modification apportée à une revendication ne doit pas conduire à une ambiguïté, et ce d'autant plus, si la modification ouvre la voie à une interprétation techniquement sensée qui, si elle est adoptée, rend la revendication contestable au motif qu'elle étend la portée de la protection conférée par le brevet tel que délivré.

La décision T 999/10 poursuit en indiquant que même si la revendication devait être interprétée comme n'excluant pas la présence d'autres copolymères à blocs, la formulation en cascade choisie par le titulaire du brevet signifie que la condition limitant la quantité de copolymères à blocs, définie de manière plus large dans la revendication 1, doit également être remplie dans la revendication modifiée. Cependant, la chambre a rejeté cette interprétation. La chambre considère que le comonomère fonctionnel étant l'anhydride maléique dans le cas de l'espèce, pour interpréter la revendication 1 de manière à ce que le taux maximum de 1% en poids s'applique à l'ensemble des comonomères fonctionnels présents dans la composition, il faut donner deux significations différentes au même terme de la revendication 1, à savoir que le terme "comonomère fonctionnel" désigne l'anhydride maléique sauf lorsqu'il s'agit de l'aspect quantitatif, auquel cas ce terme ne désignerait plus l'anhydride maléique, mais tout comonomère fonctionnel.

Article 125 EPC | J 0004/23 | Board 3.1.01
Article 125 EPC

Case Number	J 0004/23
Board	3.1.01
Date of decision	2023.10.25
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 125, 134(2)(a), 134(2)(c), 134(7) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	general principles – protection of legitimate expectations – erroneous information from EPO – request to be entered on the list of professional representatives (rejected)
Cited decisions	G 0005/88, G 0003/91, G 0005/93, G 0002/97, J 0027/92, J 0010/17, J 0010/20, T 0460/95, T 0152/95, T 1063/18
Case Law Book	III.A.2.2.1 , III.A.2.3. , 10th edition

In [J 4/23](#) the appeal was against the decision of the Legal Division rejecting the appellant's request to be entered on the list of professional representatives before the EPO (the "List"). The appellant had relied on erroneous information published on the EPO's website and based his appeal on the principle of the protection of legitimate expectations. It was not disputed that the appellant had not passed the European qualifying examination (EQE) and that there was no legal basis in the EPC under which the EPO could grant an exemption from the requirement under Art. 134(2)(c) EPC to pass the EQE for being entered on the List.

The EPO's website at the time of the request provided the following information: "... in accordance with Article 134(7) EPC, the Vice-President in charge of DG5 is entitled to grant exemption from requirements (a) and (c) of Article 134(2) EPC", referring to the Decision of the President of the EPO dated 1 December 2011 delegating his powers to decide on requests for exemption from requirements for entry on the List (OJ 2012, 13). The Legal Board noted that this information merely stated that a power had been delegated by the President of the Office to VP5 and that it could not be deduced from such information that the appellant would be entered on the List. The Legal Board recalled that the principle of the protection of legitimate expectations was subject to several limitations. Not every expectation held by a

person was automatically a legitimate one within the meaning of this principle. Whether an expectation was legitimate must be assessed by applying the principle to the facts of the case and, depending on the circumstances of the case, the relief sought may or may not be granted. It was therefore inherent in the principle of the protection of legitimate expectations that a person could only successfully invoke an expectation on which they could, on an objective basis, legitimately rely. Therefore, it must be established that, on an objective basis, it was reasonable for a requestor to have been misled by the information on which they relied.

The Legal Board pointed out that the appellant had been immediately informed by the EPO that the statement on the website was erroneous. Moreover, the terms and conditions of use of the EPO's website included a disclaimer and, whilst this did not mean that the EPO's website was excluded per se as a source of information which may lead to the application of the principle of the protection of legitimate expectations (J 10/20), such information must not be taken at face value. The Legal Board referred to the general legal principle that a person cannot successfully invoke ignorance of the law. The information on the EPO's website contained an explicit reference to the relevant legal norms of the EPC. A person reading these provisions, acting in a reasonable manner, would have immediately realised that the information on the website was erroneous since the wording of paragraphs 2 and 7 of Art. 134 EPC was unambiguous and left no room for any doubt: exemption from the requirements of Art. 134(2) EPC was expressly provided (see Art. 134(7)(a) EPC) only for the requirement set out in Art. 134(2)(a), but not for the one in Art. 134(2)(c) EPC. The Legal Board concluded that the appellant had failed to establish that, on an objective basis, it was reasonable for him or any other person acting in a reasonable manner to have been misled by the information on the EPO's website. Thus, he had not demonstrated that the expectation on which he relied was legitimate. Moreover, the appellant had failed to demonstrate that he suffered any disadvantage. Rather, he had sought to create, by way of the principle of protection of legitimate expectations, non-existing rights under the EPC to be exempted from the requirement to pass the EQE and to have VP5 evaluate whether he was entitled to the exemption. Since there were no such rights in the first place, they could not be lost.

The appellant had cited J 10/20 and G 5/93 in support of his case, arguing that the EPO was bound by "its announcements" and by "its own published interpretation" respectively. The Legal Board distinguished the situation in the case in hand from that in those cases. Unlike in J 10/20, in the case in hand the appellant could not rely on the expectation invoked. Therefore, there was "good reason" – in the words of J 10/20 – not to honour the incorrect statement on the EPO's website. The situation in G 5/93 concerned a change in the case law of the Boards of Appeal and a subsequent change of practice of the EPO. Moreover, in contrast to the information referred to in G 5/93, in the case in hand the information on the EPO's website could not be said to constitute an "interpretation" of Art. 134(2) or (7) EPC.

The appeal was dismissed.

Article 125 EPC | J 0003/24 | Board 3.1.01
Article 125 EPC

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

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

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

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

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

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

The request for reimbursement of the appeal fee was refused.

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.

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

Case Number	J 0001/24
Board	3.1.01
Date of decision	2024.04.16
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 067, 076, 106(1), 107(1) EPC
EPC Rules	Rule 036(1) EPC
RPBA	
Other legal provisions	
Keywords	divisional application – application to be treated as divisional application (yes) – pending earlier European patent application (yes) – suspensive effect of an appeal
Cited decisions	G 0001/09, J 0028/03
Case Law Book	II.F.3.5.4 , 10th edition

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

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

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

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

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

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

117-10-24

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

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

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

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

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

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

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

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

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

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

070-06-24

Rule 071(5) EPC | T 1823/23 | Board 3.3.06
Rule 071(5) EPC

Case Number	T 1823/23
Board	3.3.06
Date of decision	2024.01.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 097(1), 113(2) EPC
EPC Rules	Rules 071(3), 071(5), 103(1)(b) EPC
RPBA	
Other legal provisions	
Keywords	examination procedure – approval of the text intended for grant by the applicant (no) – "true will" of the examining division – substantial procedural violation (yes) – reimbursement of appeal fee (no)
Cited decisions	G 0001/10, J 0004/09, T 2081/16, T 1003/19, T 0265/20, T 0408/21
Case Law Book	IV.B.3.2.3b , V.A.11.7.2a , 10th edition

In [T 1823/23](#) the appellant (applicant) filed an appeal against the decision of the examining division to grant the patent in the version indicated in the communication under R. 71(3) EPC of 21 February 2023. The appellant requested that the patent be granted on the basis of the documents identified in its letter of 31 January 2023 and the reimbursement of the appeal fee.

The application as filed included three drawing sheets including figures 1 to 6. The drawing sheets were always properly listed in the request for entry into the European phase and in the communications from the examining division. They were also included in the documents submitted by the applicant on 31 January 2023 as the basis for a communication under R. 71(3) EPC.

The communication under R. 71(3) EPC of 21 February 2023, however, did not contain any drawings, nor was there, according to the board, any hint that any deletion or amendment had been made by the examining division to the drawing sheets. There was thus a clear discrepancy between the description referring to the figures and the absence of any drawing sheets in the text intended for grant, which should have been remarked upon by the examining division when allegedly deleting the drawing sheets. It appeared to the board that neither the members of the

examining division nor the appellant had realised that the drawing sheets were missing and that the documents referred to in the communication pursuant to R. 71(3) EPC did not correspond to those according to the appellant's request. The appellant had filed a translation of the claims in the two other official languages and paid the fee for grant and publication.

In view of the file history and taking into account the EPO practice regarding amendments proposed by the examining division, the board concluded that the examining division had not indicated in the communication according to R. 71(3) EPC the text it had intended to grant. Following T 2081/16, T 408/21 and T 1003/19, the board held that R. 71(5) EPC did not apply, as in the step preceding the deemed approval the applicant had to be informed of the text in which the examining division intended to grant the patent according to R. 71(3) EPC. Although the applicant had received a R. 71(3) EPC communication, the documents indicated were not those which the examining division intended to grant.

The board was aware of decision T 265/20, in which the competent board did not follow the approach in decisions T 2081/16, T 408/21 and T 1003/19. The present case was however distinguished from T 265/20 not least in that the board could identify convincing reasons why the examining division's true intention was not reflected by the text of the R. 71(3) EPC communication.

As all other requirements pursuant to R. 101(1) EPC had been met, the board concluded that the appeal was admissible. It held that a decision to grant pursuant to Art. 97(1) EPC based on an application in a text which was neither submitted nor agreed to by the appellant, as was the case here, did not comply with Art. 113(2) EPC. The decision under appeal was therefore set aside.

According to the board, the reimbursement of the appeal fee was not equitable because the applicant had made no use of opportunities to participate in the initial proceedings. The error made by the examining division had already been inserted into the communication under R. 71(3) EPC, and the applicant could and should have noticed it when checking the text of this communication. The fact that no published drawing sheets existed should have alerted it and prompted a double check. The request for reimbursement of the appeal fee was therefore rejected.

057-05-24

Rule 080 EPC | T 0431/22 | Board 3.2.05
Rule 080 EPC

Case Number	T 0431/22
Board	3.2.05
Date of decision	2024.03.04
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054, 056, 100 EPC
EPC Rules	Rule 080 EPC
RPBA	
Other legal provisions	
Keywords	amendment occasioned by a ground for opposition (yes) – amendments allowable (yes) – not derivable from R. 80 EPC how a ground for opposition is to be overcome – R. 80 EPC does not preclude replacement of opposed independent claim by two or more independent claims
Cited decisions	T 0263/05
Case Law Book	IV.C.5.1.2c(ii) , 10th edition

In [T 431/22](#) war die Beschwerdeführerin (Einsprechende) der Ansicht, der Hauptantrag erfülle nicht die Erfordernisse der R. 80 EPÜ, da der erteilte unabhängige Anspruch 1 im Einspruchsverfahren durch mehrere unabhängige Ansprüche ersetzt worden sei.

Nach R. 80 EPÜ können die Beschreibung, die Ansprüche und die Zeichnungen geändert werden, soweit die Änderungen durch einen Einspruchsgrund nach Art. 100 EPÜ veranlasst sind.

Die Kammer folgte im Wesentlichen den Erwägungen der Entscheidung T 263/05, insbesondere dem Ansatz, dass die Vereinbarkeit mit R. 80 EPÜ einer Beurteilung im konkreten Einzelfall bedarf und nicht pauschal zu beantworten ist.

Die Kammer vermochte aus R. 80 EPÜ keine Vorgaben dafür ableiten, auf welche Art und Weise bzw. mittels welcher Änderungen ein Patentinhaber einen Einspruchsgrund zu überwinden habe. Als "veranlasst" im Sinne von R. 80 EPÜ könnten Änderungen angesehen werden, die notwendig und zweckmäßig seien, einen Einspruchsgrund auszuräumen. Betreffe der Einspruchsgrund einen

unabhängigen Anspruch, so stehe R. 80 EPÜ Änderungen nicht entgegen, wodurch dieser Anspruch durch zwei oder mehrere unabhängige Ansprüche ersetzt werde, sofern deren Gegenstand im Vergleich zum erteilten Anspruch eingeschränkt oder geändert sei. Es erschien der Kammer legitim, dass ein Patentinhaber zum Überwinden eines Einspruchsgrunds versucht, Teilbereiche des erteilten unabhängigen Anspruchs gegebenenfalls mittels zweier oder mehrerer unabhängiger Ansprüche abzudecken. Nach Auffassung der Kammer dürfte eine Grenze allerdings dann zu ziehen sein, wenn ein solches Vorgehen des Ersetzens eines unabhängigen Anspruchs als Versuch der Fortführung des Erteilungsverfahrens oder sonst verfahrensmisbräuchlich erscheine.

Vorliegend war der gegen das Streitpatent eingelegte Einspruch mit mangelnder Neuheit und mangelnder erfinderischer Tätigkeit insbesondere der jeweiligen Gegenstände der unabhängigen Ansprüche 1 und 14 begründet worden. Die Beschwerdegegnerin hatte auf diese Einspruchsgründe, sowie auf weitere zwischenzeitlich erhobene Einwände, mit dem Anspruchssatz des Hauptantrags reagiert, in dem der erteilte unabhängige Anspruch 1 durch die unabhängigen Ansprüche 1, 2, 3 und 4 ersetzt und der erteilte unabhängige Anspruch 14 gestrichen wurde. Die Kammer hielt fest, dass jeder dieser vier unabhängigen Ansprüche im Vergleich zum erteilten Anspruch 1 weitere beschränkende Merkmale enthielt. Diese vier Ansprüche stellten im Wesentlichen Kombinationen aus dem erteilten unabhängigen Anspruch 1 mit von diesem abhängigen Ansprüchen dar, wobei der aus der Beschreibung stammende Zusatz in Anspruch 3 das aus dem erteilten Anspruch 8 stammende Merkmal näher definierte. Einen Verfahrensmisbrauch hatte die Beschwerdeführerin nicht geltend gemacht und vermochte die Kammer nicht zu erkennen.

Damit waren die Änderungen gemäß R. 80 EPÜ aus Sicht der Kammer nicht zu beanstanden.

081-07-24

Rule 103(1)(a) EPC | T 0641/20 | Board 3.2.08
Rule 103(1)(a) EPC

Case Number	T 0641/20
Board	3.2.08
Date of decision	2023.08.24
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 114(1) EPC
EPC Rules	Rule 103(1)(a) EPC.
RPBA	
Other legal provisions	
Keywords	reimbursement of appeal fee (no) – substantial procedural violation (no) – a substantively incorrect but procedurally correct discretionary decision not a substantial procedural violation
Cited decisions	G 0009/91, T 1002/92
Case Law Book	V.A.11.6. , IV.C.4.1. , IV.C.4.5.2. , IV.C.4.5.3. , 10th edition

In [T 641/20](#) stützte die Beschwerdeführerin ihren Antrag auf Rückerstattung der Beschwerdegebühr auf einen behaupteten wesentlichen Verfahrensmangel in Bezug auf u. a. die Zulassung der verspätet eingereichten E6 in das Verfahren, und die Einführung der E4 durch die Einspruchsabteilung in das Verfahren.

Die E6 wurde von der Einspruchsabteilung in Ausübung ihres Ermessens in der mündlichen Verhandlung in das Verfahren zugelassen. Diesbezüglich argumentierte die Beschwerdeführerin, die E6 erfülle nicht das Kriterium der prima facie Relevanz, da sie nicht offensichtlich sämtliche Merkmale des Anspruchs 1 des Hilfsantrags 3 neuheitsschädlich vorwegnehme. In der Zulassung habe daher ein Ermessensfehler der Einspruchsabteilung und folglich ein wesentlicher Verfahrensmangel gelegen.

Die Kammer stellte jedoch fest, dass die Frage, ob ein Ermessen fehlerfrei, zum Beispiel unter Berücksichtigung der richtigen Kriterien ausgeübt wurde, eine inhaltliche Frage materiell-rechtlicher Natur ist und keine verfahrensrechtliche. Daher liegt in einer inhaltlich unrichtigen Ermessensentscheidung, die unter korrekter Anwendung der Verfahrensvorschriften des EPÜ ergangen ist, kein Verfahrensmangel im Sinne der R. 103 (1) a) EPÜ.

Der Kammer zufolge wurde eine Verletzung der Verfahrensvorschriften des EPÜ im Zusammenhang mit dieser Ermessensentscheidung von der Beschwerdeführerin nicht geltend gemacht und sei auch für die Kammer nicht ersichtlich. Aus der Zulassung der E6 in das Einspruchsverfahren ergab sich nach Ansicht der Kammer folglich kein wesentlicher Verfahrensmangel.

Die E4 wurde von der Einspruchsabteilung mit Verweis auf den Amtsermittlungsgrundsatz gemäß Art. 114 (1) EPÜ von Amts wegen in das Einspruchsverfahren eingeführt. Diesbezüglich argumentierte die Beschwerdeführerin, die Einspruchsabteilung habe "ihr Ermessen gemäß Art. 114 EPÜ unter Nichtbeachtung der richtigen Kriterien ausgeübt und damit ihr eingeräumtes Ermessen überschritten". Ein gravierender Verfahrensfehler liege insbesondere darin, dass die Einspruchsabteilung die Bewertung der prima facie Relevanz der E4 auf eine fehlerhafte Beurteilung ihres Offenbarungsgehalts gestützt und daher ihr Ermessen überschritten habe.

Die Kammer rief in Erinnerung, dass die Einspruchsabteilung unter den in G 9/91 dargelegten Voraussetzungen die Befugnis hat einen neuen, von der Einsprechenden nicht geltend gemachten Einspruchsgrund vorzubringen. Dies gelte erst recht für neue Tatsachen, Beweismittel und Einwände bzw. Angriffslinien, die innerhalb eines bereits geltend gemachten Einspruchsgrunds vorgebracht werden. Derartiges neues Vorbringen sei jedenfalls dann möglich, wenn prima facie triftige Gründe dafür sprechen, dass es relevant sei und der Aufrechterhaltung des Patents ganz oder teilweise entgegenstehen würde (siehe T 1002/92).

Die Kammer hob hervor, dass die Einführung eines neuen Dokuments durch die Einspruchsabteilung daher grundsätzlich keinen Verfahrensmangel darstellen könne. Dies gelte zumindest dann, wenn das Kriterium der "prima facie Relevanz" dieser Einführung zugrunde liegt, wie dies auch für E4 der Fall war. Ob die Bewertung der prima facie Relevanz der E4 im Ergebnis auf eine fehlerhafte Beurteilung ihres Offenbarungsgehalts gestützt wurde, sei aus verfahrensrechtlicher Sicht unerheblich. Aus der Einführung der E4 durch die Einspruchsabteilung in das Verfahren ergebe sich also ebenfalls kein wesentlicher Verfahrensmangel, da die zu beachtenden verfahrensrechtlichen Grundsätze (insb. die Gewährung rechtlichen Gehörs) eingehalten wurden.

Auch ein Hinweis der Einspruchsabteilung auf das Zulassungskriterium der Konvergenz stellte nach Ansicht der Kammer keinen Verstoß gegen die Grundsätze der Gleichbehandlung und des fairen Verfahrens dar.

Demnach stellte die Kammer im Hinblick auf die von der Beschwerdeführerin vorgebrachten Punkte keinen wesentlichen Verfahrensmangel im Sinne der R. 103 (1) a) EPÜ fest. Daher wurde der Antrag auf Rückzahlung der Beschwerdegebühr zurückgewiesen.

036-03-24

Rule 106 EPC | R 0006/22 | Enlarged Board of Appeal

Rule 106 EPC

Case Number	R 0006/22
Board	EBA
Date of decision	2023.11.06
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 112a(2)(c) and (d), 113(1) EPC
EPC Rules	Rules 104(b), 106 EPC
RPBA	
Other legal provisions	
Keywords	obligation to raise objections – objection raised (no) – fundamental procedural defect (no) – fundamental violation of Article 113 EPC (no)
Cited decisions	R 0014/11, R 0018/12
Case Law Book	V.B.3.6.2a , V.B.3.6.2b , V.B.3.6.3 , V.B.4.4.2 , 10th edition

In [R 6/22](#) the petition for review was essentially based on the two grounds that (1) the non-admittance of the auxiliary request had constituted a violation of the right to be heard since the auxiliary request had been submitted in response to a new argument raised by the board, and (2) the board's failure to carry out a full and proper examination of the inventive step of the auxiliary request (when deciding on its clear allowability for the purposes of its admittance) had been tantamount to not taking a decision within the meaning of R. 104(b) EPC. Moreover, this had been, according to the petitioner, another case where the proprietor's right to be heard had not been respected because its inventive step arguments had been ignored.

The Enlarged Board of Appeal (EBA) recalled that pursuant to R. 106 EPC, a petition for review based on a ground for petition under any of Art. 112a(2)(a) to (d) EPC is admissible only where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the board of appeal, except where such objection could not be raised during the appeal proceedings. Referring to R 18/12 the EBA recalled that in determining whether the petitioner has complied with R. 106 EPC, what matters is not the formal wording of the objection but its substance as it could be objectively understood by the board.

According to the EBA, in the present case, the petitioner could and should have made an explicit objection under R. 106 EPC. With regard to the first ground on

which the petition for review was based no such objection was apparent from the file. According to the petitioner, during the discussion on the admittance of the auxiliary request, it had made an unequivocal statement that failure to admit the request would be a violation of its right to be heard. This alone had to have been sufficient for the board to recognise the objection as one under R. 106 EPC.

The EBA disagreed with the petitioner. Even if the board might have subjectively perceived that the proprietor's argument during the discussion on admittance was intended as an objection under R. 106 EPC, the board apparently had not considered the objection to have been effectively raised. Under the circumstances as apparent from the file, the board had had no reason to assume that the petitioner's argument on the right to be heard had already been a formal objection pursuant to R. 106 EPC. Such objection normally needed to be formulated after the alleged procedural irregularity and could not be formulated prematurely (R 14/11). For this reason alone, the board had not had to assume in the course of the oral proceedings that the proprietor had intended to make an objection under R. 106 EPC, even if it had taken note of the remark on the right to be heard during the discussion on admittance.

The EBA furthermore pointed out that there was no trace of any explicit dismissal of the alleged objection on file and it was not convinced about the petitioner's explanation, according to which the non-admittance of the auxiliary request had to be regarded as the dismissal. In the EBA's view, from the totality of the circumstances as presented by the petitioner, it seemed much more likely that the board had not taken note of the objection and therefore had not reacted. In this way, the absence of any discernible reaction from the board was a further indication that the board could not perceive the right to be heard argument as a recognisable objection under R. 106 EPC. The EBA held that in a situation such as the present case, a diligent party should normally insist on a discernible response from the board. Failure to do so may leave the party with an indication that weighs against its case.

The EBA concluded that the petitioner had not made a recognisable objection under R. 106 EPC. The first ground had thus to be rejected as clearly inadmissible.

As regards the second ground for petition, the EBA found that though it was admissible, it was clearly unallowable. The EBA reasoned, inter alia, that it had been unable to discern an undecided request within the meaning of R. 104(b) EPC. It reaffirmed the view that ignored facts and arguments did not constitute a "request" within the meaning of this rule and that the fact that an argument is decisive for the particular case did not make it a "relevant request" under R. 104(b) EPC. The EBA held that the relevant procedural request in the present case, which had been directed to the admittance of the auxiliary request, had been duly decided on by the board. The EBA also came to the conclusion that the proprietor had had the opportunity to comment on the issue of inventive step and the prima facie allowability of the auxiliary request.

Rule 106 EPC | T 1690/22 | Board 3.2.07
Rule 106 EPC

Case Number	T 1690/22
Board	3.2.07
Date of decision	2024.04.11
Language of the proceedings	DE
Internal distribution code	B
Inter partes/ex parte	Inter partes
EPC Articles	Articles 112a(2), 113(1) EPC
EPC Rules	Rules 104, 106, 124(1) EPC
RPBA	Articles 12(3), 12(5) RPBA 2020
Other legal provisions	
Keywords	obligation to raise objections – objection dismissed
Cited decisions	R 0004/08
Case Law Book	V.B.3.6. , V.B.3.6.4 , III.C.7.10.1 , 10th edition

In [T 1690/22](#) wendete sich die Beschwerdegegnerin (Patentinhaberin) mit ihrer ersten Rüge gemäß R. 106 EPÜ gegen die Nichtzulassung der Hilfsanträge 1 bis 3 als schweren Verfahrensfehler in Gestalt einer Verletzung des rechtlichen Gehörs. Sie sei in ihren grundlegenden Rechten beschnitten worden, sich gegen die Einspruchsgründe zur Wehr zu setzen. Sie gab auch an, dass die Nichtzulassung der Hilfsanträge nicht durch das Übereinkommen oder die Verfahrensordnung gestützt sei.

Die Beschwerdekammer stellte zunächst klar, dass die Nichtzulassung als solche keinen wesentlichen Verfahrensfehler darstelle. Sie erklärte sodann, dass ein Verfahrensfehler im Sinne von Art. 112a (2) c) EPÜ in Gestalt einer Verletzung des rechtlichen Gehörs nach Art. 113 (1) EPÜ, wie von der Beschwerdegegnerin gerügt, nicht ersichtlich sei. Die Entscheidung über die Nichtzulassung sei auf das Übereinkommen und die geltende Verfahrensordnung gestützt und folge einer langjährigen als gefestigt zu erachtenden Rechtsprechung. Allein der Umstand, dass die Beschwerdegegnerin zu dieser Rechtsanwendung "ausdrücklich" eine gegenteilige Auffassung vertritt, könne jedenfalls keinen schwerwiegenden Verfahrensfehler, respektive keine Gehörsverletzung, begründen.

Zu dem strittigen Punkt der Substantiierung und der Zulassung der Hilfsanträge 1 bis 3 habe die Beschwerdegegnerin von den ihr jeweils gebotenen Möglichkeiten, sich zu äußern, ausgiebig Gebrauch gemacht. Die Kammer sei unter Berücksichtigung der von der Beschwerdegegnerin vorgebrachten Argumente zu der

Beurteilung der Sach- und Rechtslage zu Art. 12 (3) VOBK und zu der nachfolgenden Ermessensbeurteilung im Rahmen des Art. 12 (5) VOBK gelangt. Das rechtliche Gehör der Beschwerdegegnerin sei insoweit gewahrt worden. Ein schwerwiegender Verstoß gegen Art. 113 (1) EPÜ im Sinne von Art. 112a (2) c) EPÜ war daher für die Kammer nicht ersichtlich.

Mit einer zweiten Rüge hatte die Beschwerdegegnerin vorgebracht, dass sie ihre erste Rüge zur Nichtzulassung der Hilfsanträge 1 bis 3 nicht schriftlich vorzulegen brauche und die Aufforderung der Kammer zur Vorlage einer schriftlichen Rüge daher einen wesentlichen Verfahrensmangel darstelle. Die Kammer stellte fest, dass die Beschwerdegegnerin nicht erklärt hatte, welcher der in Art. 112a (2) a) bis d) und R. 104 EPÜ abschließend normierten Gründe für einen Überprüfungsantrag geltend gemacht werden sollte. Der Kammer zufolge war es ebenso wenig ersichtlich, dass einer dieser Gründe hier einschlägig sein könnte.

Die Kammer erinnerte daran, dass es der Sinn und Zweck der Rügeobliegenheit nach R. 106 EPÜ ist, der Kammer die Möglichkeit zu geben, unmittelbar und angemessen zu reagieren. Daher muss eine Rüge nach R. 106 EPÜ eindeutig erkennen lassen, welche der in Art. 112a (2) a) bis d) und R. 104 EPÜ aufgeführten Mängel geltend gemacht werden sollen (ständige Rechtsprechung der Beschwerdekammern, siehe z.B. R 4/08).

Gerade vor dem Hintergrund dieses Zwecks der Rügeobliegenheit war die Kammer der Auffassung, dass die schriftliche Einreichung einer Rüge einer Praxis entspreche, die es ermögliche, den Umfang dieser Rüge klar zu bestimmen. Es schriftlich oder nur mündlich zu tun, ändere nichts an der Substanz der erhobenen Rüge. Die schriftliche Vorlage des Gegenstands einer Rüge ermögliche es jedoch, für die Kammer und die Beteiligten nachvollziehbar festzuhalten, worüber die Kammer zu entscheiden hatte, und sicherzustellen, dass in einem möglichen Überprüfungsverfahren keine Unsicherheiten über die von der rügenden Beteiligten beabsichtigte Formulierung der Rüge bestehen.

Die Kammer ergänzte hierzu, dass zum wesentlichen Gang der mündlichen Verhandlung, der nach R. 124 (1) EPÜ in die Sitzungsniederschrift aufzunehmen ist, der Umstand als solcher gehören könne, dass eine Rüge nach R. 106 EPÜ erhoben wurde, nicht aber die dazu von der jeweiligen Beteiligten vorgebrachten und für die Zulässigkeit der Rüge erforderlichen Gründe und Argumente. Vielmehr sei es Sache der Beteiligten, Erklärungen und Begründungen zu ihren Anträgen schriftlich einzureichen.

Es war für die Kammer vorliegend nicht erkennbar, worin in der Aufforderung zur schriftlichen Formulierung der Rüge ein möglicher Verstoß gegen Art. 113 (1) EPÜ liegen sollte. Die erste und zweite Rüge der Beschwerdegegnerin wurden folglich zurückgewiesen.

Rule 109(2)(a) EPC | R 0025/22 | Enlarged Board of Appeal
Rule 109(2)(a) EPC

Case Number	R 0025/22
Board	EBA
Date of decision	2024.03.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 022(2), 112a(2)(a) to (d), 113 EPC
EPC Rules	Rule 109(2)
RPBA	
Other legal provisions	
Keywords	petition for review – procedure for petition for review – composition of the Enlarged Board of Appeal – clearly unallowable – causal link missing
Cited decisions	
Case Law Book	V.B.3.10.1 , V.B.3.4.3 , V.B.4.3.2 , V.B.4.3.5 , 10th edition

In the decision under review in [R 25/22](#) the board had confirmed the revocation of the patent because it had found that the skilled person had had insufficient information to establish the meaning of the "shrinkage ratio" feature. The petition for review was based on the issue that the Reasons given by the board in point 6.2.3 had not been put to the parties at an earlier point in time, and that the petitioner (patent proprietor) had thus not been able to comment on them. Specifically, the board had given a definition of the shrinkage ratio that had been wholly unexpected by the proprietor and in fact by all parties, namely that the shrinkage ratio was a parameter of a plurality of yarns. The petitioner argued that this definition must have been decisive for the issue of sufficiency.

The Enlarged Board of Appeal (EBA) accepted that the issue of the plurality of yarns vs. a single yarn had not appeared anywhere in the written submissions or in the communications from the board, at least not in the form as discussed in the disputed point of the board's reasons. However, the EBA held that even if the board might have made findings in the written decision that had not been previously raised, the role such findings played in the final decision, if any, must be examined. In this regard, the EBA pointed to the settled case law on petitions, according to which a board of appeal is not required to provide the parties in advance with all foreseeable arguments in favour of or against a request. Furthermore, a violation of Art. 113 EPC

can only be considered fundamental within the meaning of Art. 112a(2)(c) EPC if there is a causal link between the alleged violation and the final decision.

The EBA found that in order to establish whether the disputed finding by the board had been decisive for its final finding on sufficiency, their decision as a whole must be examined. The EBA held that, in the rather specific circumstances of the present case, the new "plurality of yarns" interpretation was not considered to be decisive for the reasons set out in detail, and was thus not causal to the board's final decision either.

The petitioner argued that as a matter of principle, the EBA was not competent to assess the merits of a party's arguments, in particular whether they would be successful or not. The EBA understood this argument to mean that, a fortiori, the EBA also could not judge whether or not an argument could have been decisive. The EBA did not dispute that it was not competent to judge the correctness of a decision, however this did not mean that the EBA was in principle prevented from analysing and understanding the board's reasons. In order to determine whether an ignored argument by a party or a surprising new argument by a board had indeed been causal, the EBA would inevitably have to go into the substance of the case and at least understand the parties' arguments and the board's reasons.

The EBA noted that its composition under Art. 22(2), second sentence, and R. 109(2) EPC ensured that the necessary technical expertise was present. Accordingly, the EBA held that it had the power to examine decisions of the technical boards of appeal in petition proceedings for the purpose of determining the decisive character of any reasons given by the board, irrespective of whether they were of a legal or technical nature.

Furthermore, the EBA interpreted the condition "clearly unallowable" of R. 109(2)(a) EPC. It held that the correct criterion for determining whether the petition was "clearly" unallowable within the meaning of R. 109(2)(a) EPC was not just the depth of the analysis required to understand the case from a legal or technical point of view. Instead, what also mattered was the degree of conviction of the individual members of the EBA as to whether the alleged procedural defect was indeed a fundamental procedural defect within the meaning of Art. 112a(2)(a) to (d) EPC, once the relevant facts of the case had been identified, possibly only after an exhaustive and detailed examination of all the legally and technically relevant facts.

Having reviewed the technical facts of the case and the applicable legal framework, and having considered the exclusively legal arguments by the petitioner, the EBA remained fully convinced that the board's "plurality of yarns" interpretation mentioned in point 6.2.3 of the Reasons had not been decisive for the board's finding of insufficiency. Accordingly, the petition was considered clearly unallowable.

151-13-24

Rule 113(1) EPC | T 0572/19 | Board 3.4.01
Rule 113(1) EPC

Case Number	T 0572/19
Board	3.4.01
Date of decision	2024.04.05
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rules 100(2), 103(1)(a), 113(1), 140 EPC
RPBA	
Other legal provisions	
Keywords	appealed decision – substantial procedural violation (yes) – reimbursement of appeal fee (yes)
Cited decisions	J 0016/17, T 0390/86, T 2076/11, T 3071/19
Case Law Book	III.K.3.3 , III.K.3.3.1 , III.K.3.3.2 , III.L.3 , 10th edition

In [T 572/19](#) the proprietor appealed the opposition division's decision, issued in writing on 17 December 2018, to revoke the patent ("the appealed decision"). By communication under R. 100(2) EPC, the parties were informed of the board's observation that EPO Form 2339, dated 10 December 2018, bore the name, but not the signature, of the legally qualified member who had participated in the decision-making process. The board's preliminary view was that this amounted to a substantial procedural violation.

By the opposition division's communication dated 26 June 2023, to which an altered EPO Form 2339 ("the post-signed Form 2339") and an explanatory note on EPO Form 2906 ("the division's explanation") were annexed, the parties and the board were informed that the missing signature had been corrected under R. 140 EPC, with the chair belatedly signing the form on behalf of the legally qualified member. The missing signature was deemed to concern "a formal error being an obvious mistake", made when the paper file circulated between EPO sites. It was assured that the grounds attached to the appealed decision, when issued, had previously been circulated by email to all members of the opposition division; also the grounds had thus reflected the opinion of all the members of the opposition division, including the legally qualified member, who had confirmed her agreement in an email at the time.

The first question addressed by the board was the scope of signature requirement under R. 113(1) EPC since the parties disagreed thereon. The disagreement lay in

whether the term "decisions" means simply the outcome of the proceedings (e.g. "The patent is revoked"), which is what opponent 1 argued, or extends to the substantiation in the written decision, which was the proprietor's view. Referring to T 2076/11, J 16/17 and T 390/86, the board held that the jurisprudence of the boards of appeal indicated that the written decision, including the substantiation, was the object of the signature requirement. There was, then, no doubt that the signature requirement under R. 113(1) EPC applied to the written decision, including the substantiation, and not only to the outcome that might be announced during oral proceedings.

Secondly, the board examined the purpose of the signature requirement under R. 113(1) EPC. Referring *inter alia* to J 16/17, it emphasised that the purpose of the signature requirement under R. 113(1) EPC was only achieved if there was an unbroken chain of manifest personal responsibility, taken by each member of the decision-making body who was assigned to the case, throughout the decision-making process, including for the written decision.

Finally, due to the cases presented by the opponents, the board addressed three potential remedies: a) "the pragmatic approach" according to which another member signs on behalf of one who is not in a position to sign, and provides a written explanation; b) recognition of a possibility for the opposition division, after remittal, to heal the deficiency without entering into the merits and extent of the appealed decision; and c) correction of the appealed decision under R. 140 EPC. The board held that none of these remedies was applicable in the current case. In particular, it was of the view that while issuing a decision without the legally qualified member's signature had been a mistake, it had not been an obvious one within the meaning of R. 140 EPC. It followed that the appealed decision had not been corrected under R. 140 EPC by the post-signed Form 2339 and the division's explanation.

The board concluded that since none of the potential remedies was applicable, the chain of manifest personal responsibility was broken, the missing signature was a substantial procedural violation, and the appealed decision was invalid. The appealed decision was set aside, and the case remitted to the opposition division for further prosecution. The board found reimbursement of the appeal fee under R. 103(1)(a) EPC equitable, for the reason that no substantial progress had been made in the appeal since it had been filed (T 3071/19).

128-11-24

Rule 126 EPC | T 1529/20 | Board 3.5.02
Rule 126 EPC

Case Number	T 1529/20
Board	3.5.02
Date of decision	2024.02.19
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 113 EPC
EPC Rules	Rules 079, 126 EPC
RPBA	
Other legal provisions	
Keywords	notification – notification by postal services – no proof of receipt of communication under Rule 79(1) EPC – right to be heard – substantial procedural violation
Cited decisions	R 0015/11, R 0004/17, R 0006/19, J 0009/05, T 0247/98, T 1535/10, T 0966/17, T 2037/18, T 1219/19
Case Law Book	III.S.1.1 , III.S.4 , III.B.2.3 , IV.C.2.2.8f , IV.C.6.4 , 10th edition

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

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

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

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

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

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

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

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

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

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

118-10-24

Rule 136(1) EPC | T 0231/23 | Board 3.2.03
Rule 136(1) EPC

Case Number	T 0231/23
Board	3.2.03
Date of decision	2023.12.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 122(1) EPC
EPC Rules	Rules 112(1), 136(1) EPC
RPBA	
Other legal provisions	
Keywords	re-establishment of rights (no) – request admissible (no) – removal of the cause of non-compliance upon knowledge by professional representative – time limit for filing request for re-establishment
Cited decisions	J 0027/90, J 0001/20, T 0812/04, T 2251/12, T 1588/15, T 1995/19, T 1547/20, T 1570/20, T 1678/21
Case Law Book	III.E.4.1.1a), III.E.4.1.1b), 10th edition

In [T 231/23](#) the appeal was against the examining division decision rejecting the appellant's request for re-establishment of rights with regard to the time limit for paying the renewal fee for the 6th year with surcharge. According to the board, the admissibility of the appellant's request for re-establishment filed on 16 September 2020 depended on whether it was submitted in due time in accordance with Art. 122(1) EPC, R. 136(1) EPC. It was thus decisive when the cause of non-compliance with the time limit to pay the renewal fee together with a surcharge was removed.

The board recalled that the removal of the cause of non-compliance with a time limit under R. 136(1) EPC was to be established on a purely factual basis and occurred, as a rule, on the date on which the person responsible for the application vis-à-vis the EPO became aware of the fact that a time limit had not been observed (T 1547/20, T 1995/19, J 27/90, T 1570/20) for example by receipt of a loss of rights communication under R. 112(1) EPC. As a rule, the cause of non-compliance did not persist longer than up to the time at which the previous unawareness of the missed time limit was removed (T 1995/19). If a professional representative was appointed, the representative was the person responsible for the application vis-à-vis the EPO

(J 1/20). Accordingly, if a loss of rights communication under R. 112(1) EPC was issued to a duly appointed professional representative, the removal of the cause of non-compliance in principle occurred with the actual receipt of such a communication (T 1995/19, T 2251/12, T 812/04, T 1678/21). Regarding time limits for the payment of fees, an appointed professional representative remained the person responsible for the application vis-à-vis the EPO, and thus the person whose knowledge matters in assessing when the cause of non-compliance was removed, irrespective of whether a third party other than the representative was responsible for the payment of fees (see J 27/90, T 1570/20).

In the present case, the loss of rights communication was received by the professional representative's firm on 7 February 2020. The professional representative denied that his colleagues at the firm presented this communication to him before 18 July 2020. The board noted that, even if this had happened, the representative's own affidavit confirmed that he already had at the very least actual knowledge of the relevant contents of this on 2 July 2020. Hence, at the latest on 2 July 2020, the representative gained actual knowledge of the missed time limit and the associated loss of rights. In line with the case law referred to above, the removal of the cause of non-compliance had occurred on this date at the latest. This triggered the two-month time limit under R. 136(1) EPC.

The board reiterated that the removal of the cause of non-compliance – initiating the start of the two-month time limit under R. 136(1) EPC – did not require any additional knowledge on the part of the professional representative about possible reasons for missing the time limit, such as whether the non-payment of renewal fees had been intentional or not. It was sufficient that the representative became aware of the fact that the time limit for paying the renewal fee for the 6th year with surcharge had not been complied with. This knowledge objectively enabled the professional representative to take appropriate action, for example by filing a request for re-establishment of rights within two months of having gained that knowledge.

The appellant contested the board's findings and argued that awareness of an error within the meaning of J 1/20 required actual knowledge by the professional representative that it had been unintentional on the part of the applicant not to pay the renewal fee. In the board's view, the gist of J 1/20 was that removal of the cause of non-compliance within the meaning of R. 136(1) EPC was a question of fact. Accordingly, the cause of non-compliance was only removed on the date on which the person responsible for the application became aware of the fact that a time limit had not been observed, and not on an earlier date on which it ought to have become aware of that fact.

In conclusion, in the present case, the cause of non-compliance under R. 136(1) EPC was removed when the professional representative became aware of the missed time limit and the lapse of the application, which is established to have been the case at the latest on 2 July 2020. The appellant's request for re-establishment dated 16 September 2020 was not filed within two months of that date and was therefore inadmissible. The appeal was dismissed.

Rule 136(1) EPC | T 1882/23 | Board 3.5.05
Rule 136(1) EPC

Case Number	T 1882/23
Board	3.5.05
Date of decision	2024.09.23
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 122(1) EPC
EPC Rules	Rules 112(1), 136(1) EPC
RPBA	
Other legal provisions	
Keywords	re-establishment of rights (no) – date of removal of the cause of non-compliance – request not filed in due time
Cited decisions	J 0027/90, J 0001/20, T 0942/12, T 0231/23
Case Law Book	III.E.4.1.1a), III.E.4.1.1b), 10th edition

In the decision under appeal in [T 1882/23](#), the examining division had rejected the applicant's request for re-establishment of rights in respect of the time limit for paying the renewal fee for the fourth year and the additional fee, and deemed the patent application to be withdrawn. The examining division considered the request to be inadmissible because it was not filed within two months of the removal of the cause of non-compliance within the meaning of R. 136(1), first sentence, EPC.

The board recalled that the removal of the cause of non-compliance is to be established on a purely factual basis. It occurred, as a rule, on the date on which the person responsible for the application vis-à-vis the EPO became aware of the fact that a time limit had not been observed. This awareness was typically the result of the actual receipt of a communication of loss of rights under R. 112(1) EPC (see T 231/23, J 1/20). This had not been disputed by the appellant.

The appellant argued that, in the present case, the person responsible for the application vis-à-vis the EPO should be the person employed by the appellant to manage its patent portfolio (the "IP person"). It argued that this person's awareness had to be decisive, and not that of the professional representative. According to the appellant, the present circumstances illustrated the problems associated with a "hybrid" system, where the representative was not fully responsible for all actions relating to the application, but where other persons, in this case the in-house IP person, were responsible for the patent portfolio and for managing the payment of

renewal fees. The appellant stressed that the authorised firm of representatives had been specifically told that they were not responsible for paying the renewal fees.

The board did not find these arguments convincing. The question of who was responsible for which task within the appellant's sphere of responsibility could not be decisive for the issue of determining the point in time when the cause of non-compliance with the period was removed. Legal certainty required that the starting point be clearly and objectively determined. This could not depend on the circumstances of how the appellant had organised its tasks and representation, whether internally or with the help of external providers.

The board referred to the current case law on this matter and observed that, where a professional representative was appointed, it was that representative who was the "person responsible for the application vis-à-vis the EPO" (cf. J 1/20). The professional representative remained the person whose awareness was relevant for assessing when the cause of non-compliance with the period was removed, irrespective of whether a third party other than the representative was responsible for the payment of fees (J 27/90). As such, regardless of the contractual arrangements made by the appellant for the payment of fees, the appointed professional representative remained the EPO's single point of contact (T 231/23). If the appointed professional representative received a communication of loss of rights due to the non-payment of fees, the cause of non-compliance with the period was removed pursuant to R. 136(1), first sentence, EPC on the date of that actual receipt. This was also true where, as in the present case, that representative had been instructed by their client that all renewal matters would be handled by others. According to the board, such an instruction alone was not a reason for the cause of non-compliance to persist despite the appointed professional representative's actual awareness of the non-compliance (T 231/23). Thus, in the case in hand, it was irrelevant whether, and on which date, the appellant's "IP person" received the notice of loss of rights.

The appellant also sought to rely on T 942/12. However, the board did not find this decision relevant to the question at hand. According to the board, the findings in T 942/12 concerned solely the question of whether the representative had exercised "all due care", i.e. the merits of the request for re-establishment of rights. In contrast, the question in the case at hand related to the person whose awareness was relevant for the removal of the cause of non-compliance. This question was independent of the question of whether all due care was taken.

The professional representative had received the notice of loss of rights on 4 June 2019. The removal of the cause of non-compliance with the period thus occurred on that date. The request for re-establishment of rights was filed on 10 September 2019, i.e. it was not filed within the two-month time limit laid down in R. 136(1), first sentence, EPC. Therefore, the appeal was dismissed.

129-11-24

Rule 137(3) EPC | T 1591/23 | Board 3.2.07
Rule 137(3) EPC

Case Number	T 1591/23
Board	3.2.07
Date of decision	2024.01.08
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 113(1) EPC
EPC Rules	Rules 103(1)(a), 116(2), 137(3) EPC
RPBA	
Other legal provisions	
Keywords	amendments of application – consent of examining division (no) – exercise of discretion – substantial procedural violation (yes) – reimbursement of appeal fee (no)
Cited decisions	T 0756/18
Case Law Book	IV.B.2.4.5 , V.A.11.7.1 , 10th edition

In [T 1591/23](#) the board considered the exercise of the examining division's discretion pursuant to R. 137(3) EPC. The examining division had decided not to admit auxiliary requests XV to XXVI before the text thereof was submitted by the applicant. According to the appealed decision auxiliary requests XV to XXVI were not admitted because none of the auxiliary requests filed and discussed beforehand "seriously addressed" the objections of lack of clarity and added subject-matter raised since the beginning of the proceedings, giving the impression that the applicant tried to shift to the examining division the burden of identifying EPC-compliant subject-matter. Based on this impression the examining division had concluded that refusing to admit these amendments in advance was within the limits of its discretion under R. 116(2) and 137(3) EPC, and had decided not to give consent to these further requests.

The board stated that according to the established case law of the boards of appeal the power of the examining division to consent to amendments under R. 137(3) EPC was a discretionary power that had to be exercised after considering all the relevant factors of the specific case and balance in particular the applicant's interest in obtaining an adequate protection for its invention and the EPO's interest in bringing the examination to a close in an effective and speedy way. It was however clearly not possible to do any such assessment as long as the amended set of claims whose admissibility had to be decided upon had not yet been filed (T 756/18).

Therefore, the examining division had not based its exercise of discretion on an assessment of the extent to which auxiliary requests XV to XXVI were suitable to overcome the existing objections, but had decided on the basis of its negative findings in relation to the main request and auxiliary requests I to XIV. The board held that the examining division's refusal of consent to amendments made in advance of the amendment being submitted, not being a reasonable exercise of discretion pursuant to R. 137(3) EPC, amounted to a substantial procedural violation. The board concurred with the appellant that their right to be heard had been violated (Art. 113(1) EPC).

In relation to the request for reimbursement of the appeal fee (R. 103(1)(a) EPC), the board followed the established case law that a reimbursement is not automatically equitable once a procedural violation has been established and the appeal is allowable, but there should also be a link between the procedural violation identified above and the part of the decision under appeal which has to be set aside. As the appeal had to be filed on the basis of the main request, no such link could be identified, and there was no reason to reimburse the appeal fee on the basis of the aforementioned procedural violation. As a consequence, the request for reimbursement of the appeal fee was refused.

022-02-24

Rule 139 EPC | T 1515/20 | Board 3.3.04
Rule 139 EPC

Case Number	T 1515/20
Board	3.3.04
Date of decision	2023.09.21
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 123(2) EPC
EPC Rules	Rule 139 EPC
RPBA	
Other legal provisions	
Keywords	correction of error in document (no) – error in description, claims or drawings – immediately evident that nothing else could have been intended (no) – added subject-matter (yes)
Cited decisions	G 0003/89, G 0011/91
Case Law Book	II.E.4.1. , II.E.4.2. , II.E.5. , 10th edition

In [T 1515/20](#) the board noted that in opinion G 3/89 and decision G 11/91, the Enlarged Board had held that corrections under R. 88, second sentence, EPC 1973 (now R. 139, second sentence, EPC) were special cases of an amendment within the meaning of Art. 123 EPC and fell under the prohibition of extension laid down in this provision. The board referred to the established case law according to which, in the case of a proposed amendment under Art. 123(2) EPC or a correction under R. 139 EPC, the factual disclosure of the patent application as filed had to be established to the standard of certainty "beyond reasonable doubt".

The board explained that, based on the above opinion and decision of the Enlarged Board, the boards applied a two-step approach when a correction in the description, the claims or the drawings was requested under R. 139, second sentence, EPC. For a correction to be allowable, both of the following had to be established:

(i) it had to be obvious that the application as filed contained such an obvious error that a skilled person was in no doubt that this information was not correct and could not be meant to read as such. Accordingly, it had to be obvious that an error was present and had to be objectively recognisable by the skilled person using common general knowledge; and

(ii) the skilled person using common general knowledge would directly and unequivocally have ascertained the precise proposed correction. The correction of the error should be obvious in the sense that it was immediately evident that nothing else would have been intended than what was offered as the correction.

In the case in hand, according to the appellant, the skilled person would have immediately recognised that defining the antibody as comprising a light chain variable region consisting of SEQ ID NO: 4 constituted an error.

The board was not convinced by the appellant's arguments that criterion i) of the two-step approach was met. First, the board saw no arguments as to why the skilled person, when confronted with the statement "a light chain variable region consisting of SEQ ID NO: 4" as such in the disclosure of the application, would *prima facie* be alerted and consequently prompted to consider and analyse the corresponding sequence depicted on page 44 with a view to determining the presence of particular functional parts/compounds in the unannotated amino acid sequence, in this case an ER signal sequence.

Second, even when inspecting the sequence of SEQ ID NO: 4 and noting a starting methionine residue followed by a stretch of mainly hydrophobic amino acids (which was in fact 25 amino acids long and also included the amino acids at positions 23, 24 and 25) and the slightly above average light chain length for a mature antibody, the skilled person would not, as the appellant alleged, immediately have recognised that the depicted sequence of SEQ ID NO: 4 constituted an error because it included a signal peptide, but instead could, at best, be led to doubt that the depicted sequence was the sequence it purported to represent. This state of doubt however, did not equate with the requirement that the skilled person have no doubt that the depicted sequence was an error and could not be intended to read as such. The request for correction was thus rejected.

037-03-24

Rule 142 EPC | J 0002/22 | Board 3.1.01
Rule 142 EPC

Case Number	J 0002/22
Board	3.1.01
Date of decision	2024.07.19
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Ex parte
EPC Articles	Articles 020, 021 EPC
EPC Rules	Rules 011, 142, 143 EPC
RPBA	
Other legal provisions	Article 6(1) European Convention on Human Rights (ECHR)
Keywords	interruption of proceedings – concept of legal incapacity – ex-officio assessment of legal incapacity – competence to declare interruption
Cited decisions	G 0001/22, G 0002/22, J 0900/85, J 0902/87, J 0903/87, J 0049/92, J 0005/99, J 0007/99, J 0007/16, J 0010/19, J 0009/21, T 0854/12, T 1680/13, T 0054/17
Case Law Book	III.D.4.1 , III.D.4.3 , III.D.4.4 , 10th edition

In [J 2/22](#) the Legal Board dealt with the legal (in-)capacity of the appellant, since the notification of the Receiving's Section communication of 21 November 2019 was null and void if the appellant – who was not properly represented – was legally incapable.

The Legal Board recalled that legal incapacity of a person meant that such a person is suffering from a disturbance of their mind which makes them unable to form the necessary voluntary intention to carry out legal transactions binding upon them. In the context of the procedural system of the EPC, this also means that they cannot act on their own in proceedings before the EPO. Moreover, the Legal Board held that the standards for assessing legal capacity regarding natural persons should be the same as those regarding professional representatives, as only unified standards according to the autonomous law of the EPC could guarantee equal treatment of the parties, as an essential element of fair trial.

According to the Legal Board, legal (in-)capacity was to be assessed ex officio, at any time during the proceedings, and it required a reliable medical opinion. There was a general presumption in favour of legal capacity of a natural person appearing as party or representative before the EPO. However, this presumption no longer held

if there were indications to the contrary, in particular from this person's conduct in the proceedings. In such a case, a person could not simply be further treated as legally capable, despite indications to the contrary, by putting the burden (only) on them to provide evidence to prove their own legal incapacity.

The Legal Board further stated that in the event of legal incapacity of an applicant or proprietor, proceedings before the EPO were to be interrupted, and were to be resumed with the person authorised to continue. The interruption occurred *ex lege*, when the conditions for it were met. The decision on and the registration of such interruption were only declaratory.

The Legal Board then turned to the issue of competence to declare an interruption. It held that the competence of the boards under Art. 21(1) EPC for appeal proceedings, including decisions on the merits and ancillary procedural matters, was not affected by the competence of the Legal Division for decisions as to entries in the European Patent Register under Art. 20 EPC. The Decision of the President of the EPO concerning the responsibilities of the Legal Division of 21 November 2013, OJ 2013, 600, did not transfer any powers and competences from the Boards of Appeal to the Legal Division on the basis of R. 11 EPC, but only concerned the allocation of functions between the first-instance departments. From the mere fact that the Legal Division was responsible for entries in the European Patent Register regarding the dates of interruption or resumption of proceedings pursuant to R. 142 EPC, it could not be derived that the Legal Division would also be responsible for the decision to interrupt.

Regarding the continued/renewed proceedings, the Legal Board stated that when proceedings were declared null and void (and interrupted) by a board, because of legal incapacity of an appellant, the case was to be remitted to the department of first instance, for the first-instance proceedings to be resumed and continued/renewed with a representative to (be appointed and) act on the appellant's behalf, and with further notifications also to be made to that representative. The concept of the appointment of a representative for legal proceedings was inherent in the system of the EPC, and could, as a matter of principle, be applied to any case such as the present one, where a representative was essential to guarantee the participation of a legally incapable person as party and thus a fair trial. Such an appointment by the administrative or judicial authority in the proceedings is also in accordance with the principles of procedural law generally recognised in the contracting states to the EPC.

107-09-24

Rule 164 EPC | T 0044/19 | Board 3.2.08
Rule 164 EPC

Case Number	T 0044/19
Board	3.2.08
Date of decision	2023.11.27
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 082 EPC
EPC Rules	Rule 164(2)(a), 164(4), 164(5) EPC
RPBA	
Other legal provisions	Articles 15(3), 17(3)(a) PCT
Keywords	unity of invention – invitation to pay further search fees justified (no) – refund of further search fee (yes)
Cited decisions	
Case Law Book	II.B.6.2. , II.B.6.4. , 10th edition

In [T 44/19](#) the appeal was filed by the applicant against the interlocutory decision of the examining division to refuse the request for refund of the second search fee.

The application had been filed as an international application. The search examiner, acting as International Search Authority, had found that the originally filed claims did not fulfil the requirements of unity of invention but contained two inventions: a first invention in claims 1 to 4 and 6 to 9 and a second invention in claims 5 and 10 to 11. Thus, the applicant had been invited to pay an additional search fee according to Art. 17(3)(a) PCT. No additional search fee was paid in the international phase of the application.

After the entry of the application into the regional phase before the EPO, the examining division sent a communication under R. 164(2)(a) EPC. In this communication the examining division agreed with the finding of lack of unity in the International Preliminary Report on Patentability and invited the applicant to pay an additional search fee for the second invention. The applicant paid this additional search fee and a search was carried out for the second invention. The applicant requested the refund of the additional search fee under R. 164(5) EPC.

The board agreed with the appellant that the search for the first invention had covered the second invention. The board noted that the hub of claims 2 and 3 had

the same function and addressed the same technical problem as the hub of the second invention identified by the objection to lack of unity raised by the search examiner. Consequently, during the search for the first invention and having due regard to the description and drawings, the search examiner had already searched for a hub according to the second invention.

In the particular circumstances of the case, the board found that it was irrelevant whether the examining division correctly considered that there was a lack of unity in the claims. According to R. 164(2) EPC, the examining division may only ask for the payment of an additional search fee if it "considers that in the application documents which are to serve as the basis for examination an invention, or a group of inventions within the meaning of Article 82, is claimed which was not searched by the European Patent Office in its capacity as International Searching Authority". However, the search examiner had covered the second invention with the prior art search for claims 2 and 3, so that in fact this invention had been searched. The communication under R. 164(2)(a) EPC, and thus the request for an additional search fee, was therefore not justified and the additional search fee should have been refunded by the examining division under R. 164(5) EPC.

023-02-24

Article 12(3) RPBA | T 0664/20

| Board 3.3.10

Article 12(3) RPBA 2020

Case Number	T 0664/20
Board	3.3.10
Date of decision	2023.10.18
Language of the proceedings	FR
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(3), 13(1) RPBA 2020
Other legal provisions	
Keywords	party's complete appeal case (no) – all requests pending in first instance to be addressed
Cited decisions	
Case Law Book	V.A.4.3.5b , 10th edition

[See also abstract under Article 123\(3\) EPC.](#)

Dans l'affaire [T 664/20](#) le requérant I (titulaire) a déposé certaines requêtes subsidiaires, dont la requête subsidiaire 3, avec sa réponse au mémoire de recours du requérant II (opposant). En réaction, le requérant II a déposé le document (24), issu d'une recherche supplémentaire et qui, à son avis, antériorisait l'objet des revendications de plusieurs requêtes, en particulier la requête subsidiaire 3.

Cette requête avait déjà été déposée dans la procédure d'opposition. Cependant, selon le requérant II, la première possibilité de déposer des documents issus d'une recherche additionnelle ne s'était présentée qu'au stade de la procédure de recours. Devant la division d'opposition, la requête subsidiaire 3 n'avait été déposée que deux mois avant la procédure orale, lors de laquelle la division d'opposition avait maintenu un brevet sur la base de la requête subsidiaire 2. Selon le requérant II, comme le requérant I avait déjà modifié à de nombreuses reprises ses jeux de revendications, y compris lors d'un premier recours, ce n'était pas prévisible que le requérant I allait redéposer les requêtes subsidiaires 3 à 15 dans la procédure de recours. La recherche additionnelle avait été initiée aussitôt après le dépôt des requêtes subsidiaires 3 à 15 dans la procédure de recours et le document (24) déposé dès que le requérant II en a eu connaissance.

La chambre n'a pas partagé cette approche. Selon la chambre, le mémoire exposant les motifs du recours d'un requérant (opposant) doit comprendre l'ensemble des

moyens couvrant toutes les requêtes pendantes devant la division d'opposition, y compris celles qui n'ont pas été considérées dans la décision contestée (voir Exergue 1). Le requérant II devait en l'espèce s'attendre à ce que le titulaire du brevet (requérant I) redépose les requêtes subsidiaires 3 à 15 dans la procédure de recours. Par conséquent, la chambre n'a pas admis le document (24), par application des art. 12(3), 13(1) RPCR.

024-02-24

Article 12(3) RPBA | T 1220/21 | Board 3.3.06
Article 12(3) RPBA 2020

Case Number	T 1220/21
Board	3.3.06
Date of decision	2023.11.14
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(3), 12(5), 13(2) RPBA 2020
Other legal provisions	
Keywords	party's complete appeal case (no) – reply to statement of grounds of appeal – validly filed request (yes) – discretion not to admit submission
Cited decisions	T 2598/12, T 0420/14, T 0568/14, T 2115/17, T 1659/20
Case Law Book	V.A.4.3.5b), V.A.4.3.5c), 10th edition

In [T 1220/21](#) auxiliary requests 2 and 3, filed by the respondent with its reply to the appeal, corresponded to two auxiliary requests, which, in the board's view, had been admissibly raised and maintained in the opposition proceedings. They were thus not regarded as an amendment under Art. 12(4) RPBA. However, these requests had not been substantiated in the reply to the appeal.

For assessing the requests' admittance under Art. 12(3) and (5) RPBA, the board proceeded in two steps: in a first step, it ascertained whether they had been validly filed and whether the respondent's reply, with respect to these requests, fulfilled the requirements of Art. 12(3) RPBA; in a second step it assessed whether the subsequent submissions of the respondent, aiming at substantiating the auxiliary requests, should be admitted pursuant to Art. 13(2) RPBA, and exercised its discretion under Art. 12(5) RPBA.

On whether an unsubstantiated request is validly filed, the board held, in view of the provisions of Art. 12(3) and (5) RPBA, that a lack of or an insufficient substantiation of an amended request may lead to its non-admittance, but that this did not imply that the request had not been validly filed.

Concerning the required substantiation, the board noted that the provisions of Art. 12(3) RPBA reflect that it is not for the board to speculate as to the intentions

underlying the party's submissions or to further investigate the submissions made before the first instance. The board then pointed out that an amended request, that is self-explanatory, nevertheless did not meet the standard as set out in Art. 12(3) RPBA, because an implicit argument did not meet the requirement that the party should specify expressly the arguments relied on (see also T 2598/12).

With regard to the required degree of substantiation, the board explained that this depended on the specific circumstances of the case. The proprietor was at least required to (i) indicate the basis in the application as filed for each amendment, (ii) indicate which objections are intended to be overcome by which amendment, and (iii) provide reasons why an amendment overcomes the objections raised (similar to Art. 12(4), fourth sentence, RPBA). Moreover, if a claim request was intended to overcome novelty or inventive step objections, the proprietor should identify the relevant documents and the features which distinguish the claimed subject-matter therefrom (see T 1659/20). The board finally held that the specific extent and detail of the explanations required depended on the level of detail and accuracy of the objections to be overcome.

The board made it clear that the requirement set out in Art. 12(3) RPBA also applied when the opposition had been rejected and the proprietor acted as respondent in the appeal proceedings. If the proprietor requests that the patent be maintained based on a claim request which does not correspond to that found allowable in the impugned decision, this implies that the decision under appeal is to be amended and should therefore be reasoned according to Art. 12(3) RPBA. The board pointed out that the duty to provide a basis for the amendments did not depend on whether the allowability of the request has been previously contested under Art. 123(2) EPC. It also held that information that can only be found in attached documents, without an explicit reference and explanation by the party, cannot be regarded as sufficient substantiation pursuant to Art. 12(3) RPBA.

The board then assessed whether the late substantiation of the request could be admitted under Art. 13(2) RPBA, which was rejected by the board, and exercised its discretion under Art. 12(5) RPBA not to admit the requests. As noted by the board, this discretion had to be exercised in view of the specific circumstances of the case. The purpose of Art. 12(3) RPBA was to ensure that the relevant submissions were present in the proceedings as early as possible to enable the board and the other party(ies) to start working on the case on the basis of the parties' complete submissions without being forced to speculate on the intentions of the other parties. The extent to which a lack of or an incomplete substantiation runs counter to this objective was a factor that could be taken into account when exercising the discretion under Art. 12(5) RPBA (T 1659/20). This included addressing the question of whether the amendments and the chain of logic underlying the claim requests were self-explanatory (which was not the case here).

059-05-24

Article 12(3) RPBA | T 1695/21 | Board 3.2.05
Article 12(3) RPBA 2020

Case Number	T 1695/21
Board	3.2.05
Date of decision	2023.11.07
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 12(3), 12(5) RPBA 2020
Other legal provisions	
Keywords	statement of grounds of appeal – party’s complete case (yes) – insufficient substantiation of objection (no) – reference to minutes of the oral proceedings before the opposition division
Cited decisions	
Case Law Book	V.A.4.3.5b , 10th edition

In [T 1695/21](#) beantragte die Beschwerdegegnerin (Patentinhaberin), einen Einwand nach Art. 84 EPÜ gegen ihren Hauptantrag nicht in das Verfahren zuzulassen, da in der Beschwerdebegründung keine konkreten Passagen der Beschreibung angegeben worden seien, durch die dieser Einwand begründet sein könnte, und dieser daher nicht substantiiert sei (Art. 12 (3) und (5) VOBK).

Die Kammer rief in Erinnerung, dass gemäß Art. 12 (3) VOBK die Beschwerdebegründung und die Erwiderung das vollständige Beschwerdevorbringen der Beteiligten enthalten müssen. Dementsprechend müssen sie laut dieser Vorschrift deutlich und knapp angeben, aus welchen Gründen beantragt wird, die angefochtene Entscheidung aufzuheben, abzuändern oder zu bestätigen; sie sollen ausdrücklich alle geltend gemachten Anträge, Tatsachen, Einwände, Argumente und Beweismittel im Einzelnen anführen.

Die Kammer wies darauf hin, dass die Beschwerdeführerin im vorliegenden Fall in ihrer Beschwerdebegründung auf spezifische Punkte der Niederschrift über die mündliche Verhandlung vor der Einspruchsabteilung verweise. Dort seien die Absätze der Beschreibung konkret angegeben, auf welche sich die Beschwerdeführerin im Einspruchsverfahren hinsichtlich des Einwands nach Art. 84 EPÜ bezogen habe. Die Kammer merkte auch an, dass diese in identischer Weise auch in der angefochtenen Entscheidung wiedergegeben seien. Nach Ansicht der

Kammer ist aufgrund dieses Verweises und der Erläuterung, worin die vermeintliche Inkonsistenz der Beschreibung bestehe, der Beschwerdebeurteilung zu entnehmen, welche Passagen der Beschreibung die Beschwerdeführerin als problematisch im Hinblick auf Art. 84 EPÜ ansah. Damit sei der Gegenstand des Einwands zumindest im Wesentlichen erkennbar. Die Kammer teilte daher die Schlussfolgerung der Beschwerdegegnerin, dass ein Verstoß gegen Art. 12 (3) VOBK vorliege, nicht, sondern sah den von der Beschwerdeführerin erhobenen Einwand nach Art. 84 EPÜ als ausreichend substantiiert an.

Die Kammer berücksichtigte den Einwand daher im Beschwerdeverfahren und gelangte zu dem Ergebnis, dass dieser Einwand dem Hauptantrag entgegenstehe, der somit zurückgewiesen wurde.

083-07-24

Article 12(3) RPBA | T 0559/20 | Board 3.4.03
Article 12(3) RPBA 2020

Case Number	T 0559/20
Board	3.4.03
Date of decision	2024.04.25
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(3), 12(5) RPBA 2020
Other legal provisions	
Keywords	statement of grounds of appeal – insufficient substantiation of request – reasons set out clearly and concisely (no)
Cited decisions	T 0220/83, T 0213/85, T 2457/16, T 0706/17, T 0412/18
Case Law Book	V.A.3.2.2 , V.A.4.3.5b , 10th edition

In [T 559/20](#) ließ die Kammer die Hilfsanträge 1 bis 3 gemäß Art. 12 (5) i. V. m. Art. 12 (3) VOBK nicht zu, da sie nach ihrer Auffassung ohne erkennbare inhaltliche Begründung gestellt worden waren.

Die Beschwerdeführerin (Patentinhaberin) hatte lediglich argumentiert, die Hilfsanträge schränkten den Schutzzumfang des Gegenstands des Hauptantrags weiter ein, so dass sie ebenso wie der Hauptantrag neu und erfinderisch seien.

Da diese Hilfsanträge aber bereits Gegenstand der angefochtenen Entscheidung waren, wäre nach Ansicht der Kammer zu erwarten gewesen, dass sich die Beschwerdeführerin mit den Entscheidungsgründen zu den Hilfsanträgen auseinandersetzt.

Zudem sei die von der Beschwerdeführerin vorgebrachte pauschale Begründung, die Hilfsanträge seien eingeschränkter und daher aus demselben Grund wie der Hauptantrag neu und erfinderisch, ersichtlich nicht geeignet, ihre Gewährbarkeit für den Fall zu begründen, dass die Kammer den Hauptantrag für nicht gewährbar hält. Daher komme diese Begründung dem völligen Fehlen einer Begründung gleich.

095-08-24

Article 12(4) RPBA | T 0248/22 | Board 3.5.05

Article 12(4) RPBA 2020

Case Number	T 0248/22
Board	3.5.05
Date of decision	2023.11.15
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 12(4) RPBA 2020
Other legal provisions	
Keywords	amendment to case – requests – admitted (no) – overcomes an objection that is part of the decision under appeal or the appeal proceedings (no)
Cited decisions	
Case Law Book	V.A.4.3.4a , 10th edition

In [T 248/22](#) the board found that the main request and auxiliary request 1 could not be allowed – after the proprietor had withdrawn its appeal – as they were broader than auxiliary request 2 (*reformatio in peius*), and that auxiliary requests 2 to 5 were not allowable in their substance. Since auxiliary requests 6 to 10 were amended requests filed for the first time with the grounds of appeal and had not been previously presented in the proceedings, their admission was at the discretion of the board as per Art. 12(4) RPBA.

The proprietor argued that these requests could not have been filed earlier as they were filed in response to an objection by the opponent pursuant to Art. 123(2) EPC which was presented for the first time during the oral proceedings before the opposition division.

The board recalled that, in exercising its discretion whether to admit an amendment to a party's case, it had to consider whether the amendment was suitable for addressing the objections *raised* (Art. 12(4) RPBA). However, the board noted that, in the case in hand, the proprietor had argued that the amendments remedied an objection which was not part of the decision under appeal or the appeal proceedings. The objection had neither been admitted by the opposition division nor maintained on appeal by the opponent. The board held that any reason as to why an amendment

overcame an *unraised* objection did not constitute valid reasons for admitting an amended request in view of Art. 12(4), third and fourth sentences, RPBA.

In the absence of a valid reason for admitting auxiliary requests 6 to 10, the board decided not to admit them into these proceedings. The decision under appeal was set aside and the patent was revoked.

025-02-24

Article 12(4) RPBA | T 0246/22 | Board 3.5.03
Article 12(4) RPBA 2020

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

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

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

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

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

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

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

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

Article 12(4) RPBA | T 1135/22 | Board 3.5.05
Article 12(4) RPBA 2020

Case Number	T 1135/22
Board	3.5.05
Date of decision	2024.03.08
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rule 116 EPC
RPBA	Article 12(2), 12(3), 12(4) RPBA 2020
Other legal provisions	
Keywords	amendment to case – appeal case directed to requests on which decision was based (no) – admissibly raised and maintained (no) – meaning of "demonstrates" – onus on the party – "carry-over requests"
Cited decisions	T 0042/20, T 0221/20, T 0364/20, T 1800/20, T 0246/22
Case Law Book	V.A.4.2.1b , V.A.4.2.1c , 10th edition

In [T 1135/22](#) reichte die Beschwerdegegnerin (Patentinhaberin) Hilfsanträge 1 bis 12 mit der Beschwerdeerwiderung ein. Zuvor hatte sie diese Hilfsanträge bereits im Einspruchsverfahren innerhalb der Schriftsatzfrist nach R. 116 (1) und (2) EPÜ eingereicht. Die Hilfsanträge mussten jedoch von der Einspruchsabteilung nicht behandelt werden, da das Streitpatent wie erteilt aufrechterhalten wurde (sog. "carry-over requests").

Die Patentinhaberin brachte hierzu vor, dass Hilfsanträge 1 bis 12 automatisch Bestandteil des Beschwerdeverfahrens seien, da sie im Sinne von Art. 12 (2) VOBK bereits der angefochtenen Entscheidung "zugrunde gelegen" hätten. Dies sei auch der angefochtenen Entscheidung explizit zu entnehmen, weil deren Einreichung und Erörterung durch die Patentinhaberin im Teil "Sachverhalt und Anträge" der angefochtenen Entscheidung erwähnt werde. Somit seien diese Hilfsanträge keine "Änderung" im Sinne von Art. 12 (4) Satz 1 VOBK.

Die Kammer teilte diese Ansicht nicht. Die bloße Erwähnung von Hilfsanträgen im Teil "Sachverhalt und Anträge" könne nicht damit gleichgesetzt werden, dass sie im Sinne von Art. 12 (2) VOBK der angefochtenen Entscheidung "zugrunde lagen". Anderenfalls wäre der Passus von Art. 12 (4) Satz 1 VOBK "sofern der Beteiligte

nicht zeigt, dass dieser Teil in dem Verfahren, das zu der angefochtenen Entscheidung geführt hat, in zulässiger Weise vorgebracht und aufrechterhalten wurde" belanglos. Es entspreche vielmehr sowohl Sinn und Zweck von Art. 12 (2) VOBK als auch der mittlerweile gefestigten Rechtsprechung der Beschwerdekammern (siehe z. B. T 42/20, T 221/20, T 1800/20, T 364/20), dass Änderungsanträge nur dann der angefochtenen Entscheidung "zugrunde liegen", wenn das Entscheidungsorgan diese Anträge auch behandelt und darüber entschieden hat.

Ferner erläuterte die Kammer, es ergebe sich aus dem Wortlaut von Art. 12 (4) VOBK, dass die Kammer, bei der Prüfung der Frage, ob sie über einen Ermessensspielraum bei der Berücksichtigung von sog. "carry-over requests" verfügt, zwei Aspekte zu untersuchen habe: Zunächst ob der Beteiligte "gezeigt" hat, wie und warum die betreffenden Anträge im erstinstanzlichen Verfahren "in zulässiger Weise vorgebracht und aufrechterhalten" wurden; dann, wenn ein solcher Vortrag vorliegt, ob das betreffende Vorbringen sachlich zutreffend ist.

Zum ersten Aspekt verwies die Kammer auf T 246/22, wo sie in anderer Besetzung ausgeführt hatte, dass – wie aus dem Wortlaut von Art. 12 (4) VOBK klar hervorgehe – der Gesetzgeber den Kammern keine Verpflichtungen auferlegen wollte, von Amts wegen das erstinstanzliche Verfahren zu studieren, Anträge zu identifizieren und bis zu ihrem Ursprung zurückzuverfolgen und zu verstehen, warum sie eingereicht wurden. Vielmehr obliege es dem betreffenden Verfahrensbeteiligten, darzulegen, dass diese Anträge "in zulässiger Weise vorgebracht" wurden. Dass diese Darlegung bereits in der Beschwerdebegründung oder -erwiderung erfolgen müsse, ergebe sich aus dem Erfordernis des Art. 12 (3) Satz 1 VOBK.

Nach Auffassung der Kammer war die Patentinhaberin im vorliegenden Fall dieser Darlegungslast nicht nachgekommen. Den Verweis auf den Umstand, dass die Anträge innerhalb der erstinstanzlichen Schriftsatzfrist gemäß R. 116 (1) und (2) EPÜ eingereicht worden waren, hielt die Kammer nicht für ausreichend, da auch solche Anträge nach der Rechtsprechung „verspätet“ sein könnten (s. z. B. T 364/20). Auch hatte die Patentinhaberin in ihrer Beschwerdeerwiderung nur die jeweilige Basis für die vorgenommenen Änderungen angegeben und cursorisch erwähnt, dass die hinzugefügten Merkmale im Stand der Technik nicht offenbart seien, nicht aber ausgeführt, ob die Anträge in zulässiger Weise erstinstanzlich vorgebracht wurden.

Die Kammer kam daher zu dem Schluss, dass die Zulassung dieser Änderung des Beteiligtenvorbringens in ihrem Ermessen stand. Bei der Ausübung dieses Ermessens berücksichtigte die Kammer zum einen, dass die Erfordernisse der Art. 56, 83, 84 und 123 (2) EPÜ der prima facie Gewährbarkeit nicht zwingend entgegenstanden, zum anderen die in Art. 12 (4) Satz 5 VOBK genannten Kriterien, und ließ den Hilfsantrag 6 ins Beschwerdeverfahren zu.

Article 12(4) RPBA | T 0446/22 | Board 3.2.05
Article 12(4) RPBA 2020

Case Number	T 0446/22
Board	3.2.05
Date of decision	2024.03.20
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rule 116 EPC
RPBA	Article 12(2), 12(4) RPBA 2020
Other legal provisions	
Keywords	amendment to case – requests – requirements of Art. 12(2) RPBA met (no) – admissibly raised and maintained (yes) – reference to Guidelines for Examination applicable at the time of the contested decision
Cited decisions	T 1706/19
Case Law Book	V.A.4.2.1c , 10th edition

In [T 446/22](#) beantragte die Beschwerdeführerin (Einsprechende), die mit der Beschwerdeerwiderung eingereichten Hilfsanträge 3.1 und 3.2 nicht in das Beschwerdeverfahren zuzulassen. Diese Hilfsanträge entsprachen den vor der Einspruchsabteilung vorgelegten Hilfsanträgen 3.1 und 3.2, über die die Einspruchsabteilung nicht entschieden hatte, da sie den höherrangigen Hilfsantrag 1 für gewährbar erachtet hatte. Wie von der Kammer festgestellt, bildeten diese Anträge daher einen Teil des Beschwerdevorbringens der Beschwerdegegnerin (Patentinhaberin), welcher der angefochtenen Entscheidung nicht zugrunde lag und somit die Erfordernisse des Art. 12 (2) VOBK nicht erfüllte.

Bei der Prüfung der Frage, ob die Hilfsanträge 3.1 und 3.2 im Verfahren vor der Einspruchsabteilung in zulässiger Weise vorgebracht und aufrechterhalten wurden, zog die Kammer die zum Zeitpunkt der mündlichen Verhandlung vor der Einspruchsabteilung gültige Fassung der Richtlinien für die Prüfung im Europäischen Patentamt (März 2021) heran. Danach waren geänderte Anträge, die in Reaktion auf die in der Anlage zur Ladung erläuterte vorläufige Auffassung der Einspruchsabteilung, dass das Patent wahrscheinlich widerrufen wird, eingereicht wurden, in der Regel zuzulassen, sofern dies vor dem nach R. 116 EPÜ bestimmten Zeitpunkt erfolgte. Die Kammer sah diese Voraussetzung als erfüllt an, auch wenn die betreffenden Hilfsanträge erst nach dem in einer ersten Ladung festgelegten

Zeitpunkt nach R. 116 EPÜ eingereicht worden waren. Sie sah es als entscheidend an, dass die Hilfsanträge vor dem Zeitpunkt nach R. 116 EPÜ eingereicht worden waren, der in der Ladung zur durchgeführten mündlichen Verhandlung festgesetzt worden war. Durch die Aufhebung der Ladung sei auch der mit dieser Ladung bestimmte Zeitpunkt nach R. 116 EPÜ rechtlich unwirksam geworden (s. a. T 1706/19).

Bei dieser Sachlage kam die Kammer zum Schluss, dass die Einspruchsabteilung in Anwendung der damals gültigen Richtlinien die fristgerecht vorgelegten Hilfsanträge 3.1 und 3.2 wohl ins Einspruchsverfahren zugelassen hätte, falls sie die höherrangigen Hilfsanträge 1 und 2 als nicht gewährbar erachtet hätte. Die Hilfsanträge 3.1 und 3.2 wurden daher nach ihrer Ansicht im Einspruchsverfahren in zulässiger Weise vorgebracht. Darüber hinaus wurden diese Hilfsanträge am Ende der mündlichen Verhandlung nicht zurückgenommen. Infolgedessen galten die mit der Beschwerdeerwiderung eingereichten Hilfsanträge nicht als Änderung im Sinne von Art. 12 (4) VOBK. Hilfsantrag 3.2 konnte zudem die Einwände nach Art. 123 (2), 54 und 56 EPÜ überwinden und die Angelegenheit wurde an die Einspruchsabteilung zurückverwiesen mit der Anordnung, das Patent in geändertem Umfang aufrechtzuerhalten.

130-11-24

Article 12(6) RPBA | T 1820/22 | Board 3.2.04
Article 12(6) RPBA 2020

Case Number	T 1820/22
Board	3.2.04
Date of decision	2024.02.28
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(4), 12(6), 13(1) RPBA 2020
Other legal provisions	
Keywords	late-filed requests – should have been submitted in first-instance proceedings (yes) – circumstances of appeal case justify admittance (no)
Cited decisions	
Case Law Book	V.A.4.3.7f , V.A.4.3.7r , 10th edition

In [T 1820/22](#) the board decided not to admit auxiliary requests 1 to 8 filed with the statement of grounds of appeal, nor auxiliary requests auxiliary requests 1a, 1b, 1c, 2a, 2b, 3a, or 4a filed with further submissions after the summons to oral proceedings. All these requests were filed for the first time on appeal and were therefore subject to the discretion of the board under Art. 12(6) RPBA (together with Art. 13(1) RPBA for the later requests).

The appellant (patent proprietor) had argued that all auxiliary requests contained amendments which addressed the added subject-matter objection on which the decision was based. However, the board observed that the proprietor had not made any attempt to address the objection by amendment during the opposition proceedings, even though the objection was known to them from the outset (as it was set out in the notice of opposition), and from the annex to the summons, where the issue was again raised. The appellant proprietor had been given ample opportunity to address the issue by amendment and had indeed submitted various requests in the course of the opposition proceedings, none of which however dealt with the issue of added subject-matter. The board concluded that although they could have addressed the issue of added subject-matter, they chose not to do so.

The board was not convinced by the appellant's explanation that they had chosen not to address the issue by amendment in opposition proceedings because they had

been persuaded that this was futile due to an Art. 123(3) EPC trap. According to the appellant this seemed to have also been the understanding of both parties and the opposition division. Only the mention of claim 18 as originally filed as possible basis in the decision offered an opening.

However, the board pointed out that nothing had changed in the underlying facts. The issue of added subject-matter arising from a feature added before grant was still the very same as at the outset of the opposition proceedings. In the board's view the appellant proprietor should have known ab initio what the basis was in the original disclosure of their patent for the reading of a claim feature they were arguing. If they were unable to identify a basis or failed to do so earlier, they had to bear the consequences. Thus, the board was unable to see a justification for the late submission of amendments only in appeal as a result of a belated realisation on their part, however that realisation may have come about.

Moreover, the board held that the amendments of these requests did not appear suitable to overcome the added subject-matter objection on which the decision was based and some amendments were not occasioned by a ground of opposition in the sense of R. 80 EPC. Thus, additionally, the requirements of Art. 12(4) RPBA were not met.

Finally, the board pointed out that the nature of the requests was complex and considered the number of requests, 16 in all, most of which offered different attempts to resolve the issue of added subject-matter, to be disproportionate to that issue. This was all the more so in view of the argument that a single passage, original claim 18, would provide a basis for the amendment.

Therefore, the board concluded that the circumstances of the appeal case did not justify the admission of these auxiliary requests, which should have been filed during opposition proceedings, Art. 12(6) and Art. 13(1) RPBA.

085-07-24

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.

141-12-24

Article 13(2) RPBA | T 2352/19 | Board 3.2.06
Article 13(2) RPBA 2020

Case Number	T 2352/19
Board	3.2.06
Date of decision	2023.07.11
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 113 EPC
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons – exceptional circumstances (no) – taken into account (no) – reaction to new interpretation of claim feature by the board – no causal link between newly raised aspect and final conclusion of the board
Cited decisions	
Case Law Book	V.A.4.5.6 , 10th edition

In [T 2352/19](#) the respondent (patent proprietor) had filed auxiliary request 2 only after the board's summons to oral proceedings, in reaction to the board's communication under Art. 15(1) RPBA. In this communication the board had indicated its preliminary opinion that the subject-matter of the requests then on file was not novel over O2 and had pointed in this context to two aspects concerning feature 8 of claim 1. The respondent argued that the board's preliminary opinion contained a new interpretation of the feature "operating member" in feature 8 that led to a new objection regarding lack of novelty. Auxiliary request 2, based on previous claim 1 but with an amended feature 8, was thus an attempt to overcome this new objection at the earliest possible stage and should therefore be taken into account.

The board did not find this argument convincing. While it acknowledged that raising an objection for the first time in a board's communication may result in acknowledging exceptional circumstances, it also clarified that the mere fact that the board had raised a new aspect in the preliminary opinion was not sufficient by itself to acknowledge exceptional circumstances if this aspect was ultimately not relevant for the board's conclusion.

The board had stated in its preliminary opinion that it might require discussion whether a certain feature mentioned in O2 (levers 43 and 44) corresponded to an

"operating member" as defined in feature 8 of claim 1 and that this did not seem to be excluded from the wording of claim 1. It was correct that this specific feature's interpretation had not been discussed before. However, in its communication, the board had also considered the appellant's objection made in its statement of grounds of appeal, namely that an alternative embodiment of O2 also appeared to disclose feature 8 such that all the features of claim 1 appeared to be disclosed in O2. Indeed, the board's final conclusion in the oral proceedings as regards the objection of novelty in the light of O2 was solely based on the appellant's objection which had already been assessed in the impugned decision and which was part of the appellant's appeal case from the beginning. Thus, the other aspect, the new possible interpretation of "operating member" in claim 1 as presented by the board in its preliminary opinion never became decisive for the board's final conclusion and decision.

According to the board, the term "exceptional circumstances" needed to be interpreted in the light of and in application of the principles underlying the EPC and the rules of procedure. It stated that Art. 13(2) RPBA provided a fair balance between the need for procedural economy on the one hand, and the right to be heard, guaranteed by Art. 113 EPC, on the other, in order to ensure fair proceedings. Exceptional circumstances could justify the admittance of a new request if a causal link existed between the new aspect raised by the board and the board's final conclusion. The right to be heard required the possibility of providing a defence against it. If the board's conclusion was not based on the newly raised aspect, the parties' right to be heard was thus not affected and there would be no reason for exceptions to be applied. The mere fact that the filing of the respondent's request was triggered by the board's preliminary opinion did not necessarily result in this request being taken into account.

The respondent contested the necessity for this causal link and argued that, if this were the case, the question as to whether the request would be admitted would depend on the order chosen by the board for the assessment of the objections and aspects during the oral proceedings. The board disagreed. It noted that the order of assessment lay within the discretion of the board. If the board chose an assessment that was based on those aspects that had been on file since the beginning of the proceedings and thus served to preserve the parties' interests and procedural economy, the parties did not suffer any disadvantage. Moreover, the decision as to whether a request was to be admitted was advantageously only taken at the stage when the request became relevant and not in advance. Assessing admittance at this stage ensured that the entire preceding circumstances were considered when balancing e.g. the conflicting interests of procedural economy and the right to be heard.

The board therefore exercised its discretion and did not take auxiliary request 2 into account (Art. 13(2) RPBA). In the absence of any set of claims complying with the requirements of the EPC, the patent had to be revoked.

011-01-24

Article 13(2) RPBA | T 0916/21 | Board 3.5.05
Article 13(2) RPBA 2020

Case Number	T 0916/21
Board	3.5.05
Date of decision	2023.08.11
Language of the proceedings	DE
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 – request – taken into account (yes) – exceptional circumstances (yes) – reaction to Art. 15(1) RPBA 2020 communication – amendment serving procedural economy
Cited decisions	T 1055/17
Case Law Book	V.A.4.5.5a), V.A.4.5.5f), 10th edition

In [T 916/21](#) stellten die Änderungen in Hilfsantrag 3 eine Reaktion auf eine Kurzmitteilung der Kammer sowie eine in der vorläufigen Auffassung der Kammer enthaltene Erläuterung zur Interpretation des Anspruchswortlautes dar.

Diese Erläuterung war bereits in der angefochtenen Entscheidung als Teil der Argumentationslinie zu Hilfsantrag 3 enthalten. Jedoch hielt die Kammer diese Argumentationslinie in zentralen Punkten nicht für überzeugend. Nach ihrer Ansicht konnte es von der Beschwerdeführerin im vorliegenden Fall, in dem die Änderungen alle Einwände der Beschwerdekammer ausräumten, nicht erwartet werden, auf einen einzelnen Aspekt einer insgesamt nicht überzeugenden Argumentationslinie in der angefochtenen Entscheidung mit auf diesen Aspekt gerichteten Änderungen bereits bei Einlegen der Beschwerde zu reagieren. Mithin seien die im Hilfsantrag 3 enthaltenen Änderungen als eine Reaktion auf die in ihrer vorläufigen Meinung erstmals geäußerte Argumentationslinie zu betrachten.

Die Kammer hob ferner hervor, dass die Änderungen im Ergebnis zu einem Antrag führten, der klar den Erfordernissen des EPÜ genüge, so dass sie ohne mündliche Verhandlung entscheiden könne. Die Zulassung des Hilfsantrags 3 diene daher der Verfahrensökonomie. Die Kammer sah dies insgesamt als außergewöhnliche Umstände im Sinne von Art. 13 (2) VOBK an, die eine Zulassung dieses Antrags in

das Verfahren rechtfertigen (zur Zulassung eines alle Einwände beseitigenden Antrags siehe T 1055/17).

012-01-24

Article 13(2) RPBA | T 2019/20 | Board 3.3.10
Article 13(2) RPBA 2020

Case Number	T 2019/20
Board	3.3.10
Date of decision	2023.11.21
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(4), 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons – taken into account (yes) – deletion of claims – no amendment "in substance" – claimed subject-matter and attacks fully encompassed by initial appeal cases – partial abandonment of the initial appeal case
Cited decisions	T 2295/19
Case Law Book	V.A.4.2.2d), V.A.4.5.5g), 10th edition

In [T 2019/20](#) the board had to decide on the admittance of auxiliary request 1 filed by the respondent during oral proceedings before the board. This request consisted of independent claim 1 which was identical to independent claim 17 of the patent as granted (main request) and 10 dependent claims, which were likewise identical to claims in the patent as granted. All product claims had been deleted.

The board noted that all the issues to be discussed for auxiliary request 1 would also have had to be discussed for the main request (patent as granted) if claim 1 of this request had been found to involve an inventive step, which was a plausible outcome in view of the findings of the opposition division's decision to reject the opposition. Therefore, the filing of auxiliary request 1 during the oral proceedings before the board did not bring in unexpected new issues to be dealt with.

The board concluded that the substance of this request – i.e. the claimed subject-matter and the attacks against it – was fully encompassed by both the appellant's and the respondent's initial appeal case within the meaning of Art. 12(1) to (3) RPBA. The request certainly limited the potential issues for discussion. In the board's opinion, this meant that, in view of the totality of the facts of the present case, the filing of this request, although formally an amendment and as such potentially subject to the strict provisions of Art. 13(2) RPBA, in substance did not constitute an

amendment of the party's case within the meaning of Art. 12(4) RPBA. It rather constituted a partial abandonment of the initial appeal case.

The board held that there was no apparent reason not to admit the request under any of Art. 12(5), 13(1) or 13(2) RPBA, and decided to admit the request under its discretionary powers pursuant to Art. 13(1) RPBA.

060-05-24

Article 13(2) RPBA | T 1686/21 | Board 3.2.01
Article 13(2) RPBA 2020

Case Number	T 1686/21
Board	3.2.01
Date of decision	2024.01.23
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Art. 15(1) RPBA communication – taken into account (yes) – exceptional circumstances (yes) – amendment solving all issues, not surprising for the opponent and not detrimental to procedural economy – high number of objections – procedural efficiency
Cited decisions	
Case Law Book	V.A.4.5.1 , V.A.4.5.5j , 10th edition

In [T 1686/21](#) the main request was filed by the respondent as auxiliary request 1f" during the oral proceedings before the board in reaction to the board's finding that the omission, in claim 1 of the patent as maintained, of a certain feature resulted – contrary to the assessment of the opposition division – in an unallowable intermediate generalisation of a specific embodiment disclosed in the originally filed parent application and therefore infringed Art. 76(1) EPC.

The board noted that the specific combination of features now recited in claim 1 had never been claimed as such in any request filed by the respondent and that the addition of the feature at issue ("paddle shape" feature) – even though it had already been added to claim 1 of several other auxiliary requests – was an amendment to the respondent's appeal case.

Regarding the admissibility of this amendment, the appellant (opponent) had argued that the omission of the "paddle shape" feature had been the subject of an objection both during the opposition proceedings and in its statement of grounds of appeal and that the respondent could and should have filed this request at the latest with its reply to the statement of grounds of appeal.

However, the board considered the following circumstances of the case and concluded that they represented exceptional circumstances justifying the admittance of the main request in hand.

The amendment under discussion was already present in several auxiliary requests filed during the first-instance proceedings and re-submitted by the respondent on appeal in order to address the objection raised by the appellant concerning omission of the "paddle shape" feature. In view of this, the appellant's objection of lack of substantiation was not justified. This amendment explicitly defined a feature that the opposition division had read – albeit erroneously, in the board's view – into the wording of independent claim 1. It clearly addressed and solved the issue under Art. 76(1) EPC raised against the patent as maintained. In view of the above, the amendment could not be considered surprising for the appellant in such a way as to negatively affect its position in the appeal proceedings, thereby giving an advantage to the other party. The amendment at issue did not give rise to new objections and was not detrimental to procedural economy. And, last but not least, in view of the large number of different objections raised under Art. 76(1) EPC, the number of requests to be filed at the very beginning of the appeal proceedings in order to provide appropriate fall-back positions for every possible outcome of the assessment of compliance with Art. 76(1) EPC would have been extremely high and therefore not compliant with procedural efficiency.

061-05-24

Article 13(2) RPBA | T 1800/21 | Board 3.3.05
Article 13(2) RPBA 2020

Case Number	T 1800/21
Board	3.3.05
Date of decision	2023.12.18
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 12(4), 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons – taken into account (yes) – deletion of claims – exceptional circumstances (yes) – amendment serving procedural economy – fair proceedings
Cited decisions	R 0007/14, T 1480/16, T 1569/17, T 0494/18, T 0995/18, T 2091/18, T 2920/18, T 1857/19, T 2201/19, T 2295/19, T 0532/20, T 0598/20, T 0424/21
Case Law Book	V.A.4.2.2d), V.A.4.5.5g), 10th edition

In der Sache [T 1800/21](#) waren im Hilfsantrag V, der nach Zustellung der Ladung zur mündlichen Verhandlung eingereicht wurde, sämtliche Verfahrensansprüche gestrichen und lediglich die Vorrichtungsansprüche beibehalten worden.

Zunächst prüfte die Kammer, ob es sich um eine Änderung des Vorbringens gegenüber dem Vorbringen in der Beschwerdeerwiderung handelte. Sie bejahte dies im Einklang mit einer Reihe vorheriger Entscheidungen und begründete dies damit, dass eine Kammer, sofern ein Anspruch aus einem Anspruchssatz nicht gewährbar ist, keine Verpflichtung hat, die anderen Ansprüche zu prüfen. Erst das Streichen der Verfahrensansprüche führte im vorliegenden Fall zur Notwendigkeit, die Vorrichtungsansprüche ebenfalls zu prüfen. Daher, so die Kammer, kann die Streichung nicht lediglich als Verzicht auf einen Teil des Streitgegenstands angesehen werden. Die Frage, inwieweit die verbleibenden Ansprüche bereits erörtert wurden bzw. welchen Umfang die notwendige weitere Prüfung hat, betreffe dagegen Aspekte der Verfahrensökonomie und der Fairness des Verfahrens und sei daher erst für die in einem zweiten Schritt vorzunehmende Ermessensausübung, ob diese Änderung noch ins Verfahren zugelassen werden kann, relevant.

Hinsichtlich der Auslegung des Begriffs "außergewöhnliche Umstände" befand die Kammer, dass dieser nicht auf den in den erläuternden Bemerkungen anlässlich der Einführung der VOBK genannten typischen Anwendungsfall der Reaktion auf eine späte Verfahrensentwicklung beschränkt werden könne. Sie bestätigte die Auffassung in T 2295/19, wonach der Wortlaut von Art. 13 (2) VOBK keine Kausalität zwischen den außergewöhnlichen Umständen und der Einreichung der späten Änderung verlangt und bei einer teleologischen Auslegung der Vorschrift vor dem Hintergrund der Art. 114 (2) und 123 (1) EPÜ die Befugnis zur Nichtberücksichtigung späten Vortrags keinen Selbstzweck darstellt; vielmehr dient sie den Grundsätzen der Verfahrensökonomie und des fairen Verfahrens. Demnach kann nach Ansicht der Kammer ein Hilfsantrag berücksichtigt werden, wenn die Änderung den faktischen oder rechtlichen Rahmen des Verfahrens nicht verschiebt, keine Neugewichtung des Verfahrensgegenstandes bedingt und weder dem Grundsatz der Verfahrensökonomie, noch den berechtigten Interessen einer Verfahrenspartei zuwiderläuft.

Die Kammer wies darauf hin, dass diese Erwägungen den Kriterien entsprechen, die die Rechtsprechung auch bereits zur Begründung herangezogen hatte, wann Streichungen als bloße Beschränkung und nicht als Änderung angesehen werden sollten. Es scheint sich, so die Kammer, eine einheitliche Rechtsprechungslinie dahingehend zu entwickeln, dass in Fällen, in denen durch eine unkomplizierte Änderung wie das Streichen einer gesamten Anspruchskategorie eine Antragsfassung vorliegt, auf deren Basis das Patent erkennbar aufrechterhalten werden kann, außergewöhnliche Umstände im Sinne von Art. 13 (2) VOBK vorliegen können. Diese erlauben nach Ansicht der Kammer dann eine positive Ermessensausübung, wenn die obigen Kriterien erfüllt sind (was im vorliegenden Fall zutrifft).

Diese Rechtsprechung fügt sich, so die Kammer, auch hinsichtlich des Grades der geforderten Relevanz in die Stufen des mit der VOBK etablierten Konvergenzansatzes ein: Während auf der ersten Stufe gemäß Art. 12 (4) VOBK bei der Ermessensausübung lediglich die Eignung zur Behandlung der Fragestellungen, die zur angefochtenen Entscheidung führten, verlangt wird, ist gemäß Art. 13 (1) VOBK auf der zweiten Stufe bereits die Eignung zur Lösung der von einem anderen Beteiligten im Beschwerdeverfahren oder von der Kammer aufgeworfenen Fragen gefordert und darf die Änderung keinen Anlass zu neuen Einwänden geben. Im Vergleich zu den beiden ersten Stufen des Konvergenzansatzes nochmals verschärft sind die Kriterien, die im Rahmen der oben genannten Rechtsprechung erfüllt sein müssen, um einen außergewöhnlichen Umstand gemäß Art. 13 (2) VOBK anzunehmen.

Vor diesem Hintergrund sah die Kammer keine Notwendigkeit (mehr), zur Sicherung einer einheitlichen Rechtsanwendung die Große Beschwerdekammer zu befassen.

062-05-24

Article 13(2) RPBA | T 1558/22 | Board 3.2.04
Article 13(2) RPBA 2020

Case Number	T 1558/22
Board	3.2.04
Date of decision	2024.02.07
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rule 139 EPC
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Art. 15(1) RPBA communication – taken into account (no) – correction of errors in document – obvious error (no) – immediately evident that nothing else could have been intended (no) – exceptional circumstances (no)
Cited decisions	
Case Law Book	V.A.4.5.6g , 10th edition

In [T 1558/22](#) hatte die Kammer über die Zulassung des in der mündlichen Verhandlung eingereichten Hilfsantrags 4a zu entscheiden. Dieser war eine korrigierte Fassung des Hilfsantrags 4, der bereits im Einspruchsverfahren eingereicht worden war und erneut mit der Beschwerdeerwiderung. Die Korrektur bestand in der Streichung der Verfahrensansprüche 12 und 13, die – so die Beschwerdegegnerin (Patentinhaberin) – einen offensichtlichen Fehler enthielten, da bestimmte einschränkende Merkmale versehentlich nicht enthalten waren, obwohl dies erkennbar beabsichtigt gewesen sei. Als außergewöhnliche Umstände machte die Beschwerdegegnerin geltend, dass der Fehler offensichtlich sei und die Kammer erst in der mündlichen Verhandlung auf den korrigierten Fehler hingewiesen habe.

Die Kammer vermochte jedoch keinen offensichtlichen Fehler zu erkennen. Dass in den abhängigen Ansprüchen verschiedene einschränkende Merkmale nur selektiv übernommen wurden, erweckte nicht den Eindruck eines Versehens, sondern vielmehr einer bewussten Entscheidung und Auswahl von Merkmalen. Jedenfalls war aus Sicht der Kammer nicht offensichtlich, dass beabsichtigt war, den Wortlaut der abhängigen Ansprüche vollständig an die jeweils in Anspruch 1 vorgenommenen Änderungen anzupassen. Zudem hätte in diesem Fall die Berichtigung in der Anpassung an Anspruch 1 bestanden, nicht in einer Streichung der Ansprüche. Die

Voraussetzungen für die Zulassung einer Berichtigung waren daher nach Ansicht der Kammer nicht erfüllt.

Im Hinblick auf die Ausführungen in ihrer Mitteilung befand die Kammer ferner, dass ihre Auffassung zur erfinderischen Tätigkeit der Ansprüche 12 und 13 gemäß Hilfsantrag 4 die Beschwerdegegnerin in der mündlichen Verhandlung nicht überrascht haben konnte. Im Rahmen ihrer prozessualen Sorgfaltspflicht oblag es ihr, ihre eigenen Anträge vor der mündlichen Verhandlung nochmals zu überprüfen und gegebenenfalls zu korrigieren. Die Beschwerdeführerin durfte nach Ansicht der Kammer auch nicht davon ausgehen, dass alle in der vorläufigen Auffassung nicht nochmals für nachrangige Hilfsanträge erwähnten Einwände in Bezug auf diese Hilfsanträge nicht unverändert weitergälten trotz gleichen Sachverhalts.

Im Übrigen konnte aus Sicht der Kammer dahingestellt bleiben, ob ihr und/oder der Beschwerdegegnerin anfangs tatsächlich bewusst war, dass die Ansprüche 12 und 13 des Hilfsantrags 4 die betreffenden einschränkenden Merkmale nicht enthielten. Denn die Beschwerdeführerin hatte in ihrer Antwort auf die vorläufige Auffassung der Kammer darauf hingewiesen. Spätestens zu diesem Zeitpunkt hätte die Beschwerdegegnerin ihren möglichen Irrtum bezüglich des Inhalts der Ansprüche 12 und 13 gemäß Hilfsantrag 4 erkennen können. Eine entsprechende Änderung des Hilfsantrags 4 versuchte sie erst während der mündlichen Verhandlung mit dem Hilfsantrag 4a nachzuholen. Einer solchen abwartenden, verzögernden Verfahrensführung sollte aber, so die Kammer, mit dem Konvergenzansatz der reformierten Verfahrensordnung gerade Einhalt geboten werden.

Die Kammer stellte somit fest, dass ein außergewöhnlicher Umstand außerhalb des Verantwortungsbereichs der Beschwerdegegnerin, der die verspätete Einreichung des Hilfsantrags 4a hätte rechtfertigen können, nicht vorlag. Daher sei auch nicht maßgeblich, ob weitere in den Art. 12(4), 13(1) VOBK definierte Kriterien der Ermessenausübung (z. B. fehlende Komplexität der Änderung), die zusätzlich zu den strikten Erfordernissen des Art. 13(2) VOBK Berücksichtigung finden können, erfüllt waren.

063-05-24

Article 13(2) RPBA | T 0018/21 | Board 3.3.02
Article 13(2) RPBA 2020

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

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

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

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

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

072-06-24

Article 13(2) RPBA | T 1006/21 | Board 3.3.08
Article 13(2) RPBA 2020

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

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

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

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

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

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

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

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

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

073-06-24

Article 13(2) RPBA | T 2124/21 | Board 3.4.02
Article 13(2) RPBA 2020

Case Number	T 2124/21
Board	3.4.02
Date of decision	2024.01.25
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	
EPC Rules	
RPBA	Articles 12(1), 12(2), 12(3), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Art. 15(1) RPBA communication (yes) – taken into account (no) – sole request subject of the appealed decision abandoned and resubmitted – exceptional circumstances (no) – primary purpose of the appeal proceedings
Cited decisions	
Case Law Book	V.A.4.2.2h), V.A.4.5.6g), 10th edition

In [T 2124/21](#) the appellant (applicant) had filed with the statement of grounds of appeal a main request and a first auxiliary request that superseded the sole request subject of the appealed decision. In its communication under Art. 15(1) RPBA, the board informed the appellant of its preliminary intention not to admit these requests, inter alia because no reason had been given why these amendments were filed only on appeal, and because prima facie they contained added subject-matter. In its written reply the appellant withdrew the main request and the first auxiliary request and requested, by reference, the grant of a patent based on the claims of the request subject of the appealed decision.

The board first explained that it was with the main request and first auxiliary request that the resubmitted sole request subject of the appealed decision had to be compared when establishing whether it was an "amendment" to the appeal case. Since the sole request had been abandoned by the statement of grounds of appeal it was not pending anymore when resubmitted. Therefore, it could not be the object of comparison for the purposes of Art. 13(2) RPBA. The board then pointed out that, since claim 1 of each of the main request and the first auxiliary request had an additional feature compared with claim 1 of the sole request subject of the appealed

decision, the resubmitted request constituted an amendment to the appeal case within the meaning of Art. 13(2) RPBA.

Regarding the question whether there were exceptional circumstances justified by cogent reasons, the board, citing Art. 12(2) and (3) RPBA, explained that the appellant had made a choice, at the outset of appeal proceedings, not to seek a review of the appealed decision and thereby prevented the board from pursuing the primary object of the appeal proceedings (cf. Art. 12(1)(a) and (b) and (2) RPBA). In the board's view, it could not be expected to begin the judicial review of the appealed decision only at the last stage of the appeal proceedings.

Moreover, the board held that the fact that the amendment in question did not imply a substantial technical change of the claimed subject-matter, was not a circumstance that justified admittance of the sole request. Rather, the only exceptional aspect of the case was the appellant's own choice to avoid the board's review of the appealed decision until the last stage of the appeal proceedings. The objection raised in the preliminary opinion against the then freshly filed main request and first auxiliary request was not an exceptional circumstance.

Since there was no admitted request on file the appeal was dismissed.

086-07-24

Article 13(2) RPBA | T 2482/22 | Board 3.2.04
Article 13(2) RPBA 2020

Case Number	T 2482/22
Board	3.2.04
Date of decision	2024.05.22
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Art. 15(1) RPBA communication (yes) – exceptional circumstances (no) – validity prevails over other considerations (no) – legislator’s intent – convergent approach
Cited decisions	G 0007/95
Case Law Book	V.A.4.5.4a), 10th edition

In [T 2482/22](#) the appellant (opponent) raised for the first time during the oral proceedings before the board an objection of lack of novelty over D1. The appellant’s representative justified the late submission by arguing that he took over the case from a colleague, who had overlooked the novelty objection when he drafted the grounds of appeal. The appellant also argued that, because this concerned a European patent, it was of utmost importance that there be no doubts concerning validity. None of these arguments convinced the board of the existence of exceptional circumstances under Art. 13(2) RPBA.

As regards the meaning of the term "exceptional circumstances", according to the board it was established jurisprudence of the boards that such circumstances concerned new or unforeseen developments in the appeal proceedings, such as new objections raised by the board or another party.

In the present case, the appellant had already overlooked that objection when they drafted the notice of opposition, which was signed by the appellant's present representative. Thus, the fact that another representative of the appellant overlooked the novelty objection when drafting the grounds of appeal was not a development of the appeal proceedings, let alone a new or unforeseen one. The appellant alone had to bear the responsibility for any such errors and mistakes.

The board understood the appellant's further argument as implying that the legitimacy of the European patent system depended on the strength of validity of patents issued by it, and that therefore any concerns of validity had to trump any other considerations, e.g. those of procedural economy and transparency or the nature of appeal proceedings as a judicial review. The board pointed out that the legislator had seen this differently, as was evident from Art. 12(2) RPBA as adopted by Decision of the Administrative Council of 26 June 2019, according to which the primary object of the appeal proceedings is to review the decision under appeal and a party should direct their appeal case at the requests, facts, objections, arguments and evidence on which the decision under appeal is based. As a consequence, the possibility of a party to change its case or add to it was very limited, increasingly so as the appeal procedure progressed (see document CA/3/19, points 47 and 48, explaining the convergent approach underlying Art. 12 and 13 RPBA, as well as the explanatory remarks to these articles, reproduced in OJ 2020, Supplementary publication 2).

The board further explained that Art. 12 and 13 RPBA lay out the criteria by which the boards have to exercise their discretion when considering amendments to a party's appeal case. Art. 12(4) and 13(1) RPBA do still include criteria that could be seen as reflecting on the merits or relevance of new submissions (e.g. suitability to address issues), albeit subject to justifying reasons. Indeed, and following established case law (G 7/95, OJ 1996, 626), at an early appeal stage it might still be possible to consider novelty, even if not raised before, *vis-a-vis* a closest prior art already cited against inventive step, but only in the context of assessing inventive step. The board pointed out, however, that such criteria are entirely absent from the wording Art. 13(2) RPBA which was purposely chosen to express the much more stringent criterion applicable at this last stage of the appeal proceedings. The board rejected the approach according to which merit or relevance were somehow subsumed in the sole criterion of "exceptional circumstances". As was clear from the examples, these only concerned circumstances that arose from the way the proceedings had developed, i.e. from the procedure itself and not its subject.

096-08-24

Article 13(2) RPBA | T 1774/21 | Board 3.2.08
Article 13(2) RPBA 2020

Case Number	T 1774/21
Board	3.2.08
Date of decision	2024.04.18
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 114 EPC
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after notification of Art. 15(1) RPBA communication (yes) – procedural request – request for non-admittance of objection – exceptional circumstances (no) – no obligation to assess and decide on admittance of objection ex officio
Cited decisions	G 0009/91, T 0755/16, T 0018/21, T 1006/21
Case Law Book	V.A.4.2.2 , V.A.4.5.6 , 10th edition

In [T 1774/21](#) the appellant had raised a new objection under Art. 123(2) EPC against a feature of the main request (patent as maintained by the opposition division) in its statement of grounds of appeal. The respondent, after first having replied to this allegedly new line of attack with counter-arguments, had requested only in its response to the board's communication under Art. 15(1) RPBA that this line of attack not be admitted into the proceedings pursuant to Art. 12(2), (4), (6) RPBA. The board rejected this request for non-admittance of the objection.

The board first explained that, in the context of the RPBA, the term "requests" included requests for non-admittance of, for example, an objection (contrary to what was suggested in T 1006/21). The general term "requests" was not limited to texts of patent applications or patents. When the RPBA sought to specifically address the issue of amendments of such texts, it expressly referred to "an amendment to a patent application or patent" (see Art. 12(4), fourth sentence, or Art. 13(1), fourth sentence, RPBA). This understanding was also confirmed in the explanatory remarks to Art. 12(2) RPBA (see Supplementary publication 2, OJ EPO 2020, 17). The board concluded that a request for non-admittance of an objection filed after the initial phase of the appeal proceedings constituted an amendment to the party's appeal case.

The respondent also argued that the request for non-admittance of the "new line of attack" should be admitted into the proceedings due to exceptional circumstances, as the appellant had failed to identify the "new line of attack" as an amendment in its statement of grounds of appeal and to give reasons why it had not been raised before the opposition division, contrary to what was required by Art. 12(4) RPBA. The appellant had countered that this objection was not "new" as it had been raised during oral proceedings before the opposition division.

The board held that, even assuming in the respondent's favour that this objection was indeed raised for the first time in the appellant's statement of grounds of appeal, the circumstances of the present case were neither exceptional nor could they justify the filing of the respondent's request for non-admittance only after the board's communication. The board pointed out that it was for the party itself to assess whether there is – in its opinion – an amendment to the other party's case and how to respond to it.

The board rejected the respondent's argument that the board was under the obligation, ex officio, to assess and decide on admittance of the "new line of attack". It explained that a board may indeed examine of its own motion the question of whether an objection was filed "late", since it was not restricted to the facts, evidence and arguments provided by the parties and the relief sought (Art. 114(1), second sentence, EPC). Moreover, Art. 114(2) EPC gave the board the power to "disregard facts or evidence" which are not submitted in due time. However, the fact that Art. 114(2) EPC stated that the EPO (therefore a board of appeal), "may" do so, also meant, that a board was not obliged ex officio to examine whether a submission was made "in due time". In the board's view such an obligation could also not be inferred from the principle of ex officio examination laid down in Art. 114(1), first sentence, EPC. In general, the principle of ex officio examination was to be applied in opposition appeal proceedings in a more restrictive manner (cf. G 9/91, point 18 of the Reasons), which was due to the fact that such proceedings could be regarded as essentially party-driven. In addition, this principle did not go so far as to require a board to examine whether an objection was late filed. Such an understanding of Art. 114(1), first sentence, EPC would be difficult to reconcile with the power given under Art. 114(2) EPC that may or may not be used. The board disagreed with point 27 of the Reasons of decision T 1006/21 in this respect.

108-09-24

Article 13(2) RPBA | T 0172/22 | Board 3.2.07
Article 13(2) RPBA 2020

Case Number	T 0172/22
Board	3.2.07
Date of decision	2024.05.07
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	Article 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment to a party's case (yes) – deletion of claims – late-filed auxiliary request – should have been submitted in opposition proceedings (yes) – shift of the discussion – admitted (no)
Cited decisions	T 0156/15, T 1569/17, T 0494/18, T 2229/19, T 2295/19, T 1800/21
Case Law Book	V.A.4.2.2d), V.A.4.5.5g), 10th edition

In [T 172/22](#) the opponent (appellant) had lodged an appeal against the decision of the opposition division concerning maintenance of the patent in amended form on the basis of the then auxiliary request 42 (main request in appeal). The respondent (proprietor) submitted auxiliary requests 42a and 72a during oral proceedings before the board.

Auxiliary request 42a corresponded to the main request with claims 1 to 3 deleted and was filed after the board had communicated its intermediary conclusion that claim 1 of the main request did not meet the requirements of inventive step. The respondent asserted that, according to T 1800/21, even if the submission of auxiliary request 42a was to be considered as an amendment to its case, the deletion of an entire category of claims would be admissible under Art. 13(2) RPBA.

Recalling that the question of whether a deletion of a category of claims amounted to an amendment was answered differently by the boards, the present board was of the view that the filing of a new set of claims had to be regarded as an amendment to the appeal case, even if only a category of claims was deleted. Its admittance was therefore subject to the board's discretion (see e.g. T 494/18, T 2295/19, T 1569/17, T 2229/19).

The board observed that the relevant objection on inventive step against claim 1 of the main request was already present in the opposition proceedings. The respondent would have been in the position to submit this request at least with its reply to the statement of the grounds of appeal. Thus, for this reason alone, there were no exceptional circumstances that could justify the filing of this new set of claims at this stage.

Moreover, the deletion of all claims directed to a steel sheet for hot press forming (independent claim 1 and dependent claims 2 and 3) would de facto have required a discussion on the remaining independent claims 4 and 7 of the main request (claims 1 and 4 of auxiliary request 42a), even though this had so far appeared unnecessary and was contrary to the requirements of convergence and procedural economy (Art. 13(1) RPBA). In fact, a request without claims directed to the steel sheet in question but with remaining unamended independent claim 7 of the main request had never been filed by the respondent in the appeal proceedings. This would have imposed a shift of the discussion towards claim 7 of the main request, which was not included in any of the following auxiliary requests. In the board's view, the filing of auxiliary request 42a at this stage in the proceedings was a procedural "salami" tactic to determine which of the remaining independent claims of the main request could be kept unchanged, aimed at establishing an allowable set of claims. This could not be allowed, as it would be contrary to procedural economy (Art. 13(1) RPBA, cf. T 156/15). As a result, T 1800/21 did not apply in the present case. For the sake of completeness only, the board added that even if auxiliary request 42a were to be admitted into the proceedings, it still would not meet the requirements of Art. 123(2) EPC.

The board then turned to auxiliary request 72a, which was filed as a reaction to the admittance of two new documents and the shift of the board's preliminary opinion on Art. 123(2) EPC. The relevant objection on added subject-matter was already present in the opposition proceedings and the respondent could have submitted this request at least with its reply to the statement of the grounds of appeal. A proprietor had to consider the possibility that the board could agree with a raised objection against the maintenance of the patent and had to react promptly. The change in the board's preliminary opinion did not constitute exceptional circumstances that could justify the admittance of auxiliary request 72a. Furthermore, the new documents were not decisive for the conclusions drawn with respect to Art. 123(2) EPC. The respondent had also failed to demonstrate that this amendment would not give rise to new objections that would have to be examined for the first time during the oral proceedings before the board, in detriment to procedural economy. Thus, the board did not admit auxiliary request 72a into the appeal proceedings either.

In conclusion, the decision under appeal had to be set aside, and in the absence of an admissible and allowable request, the patent had to be revoked.

Article 15(5) RPBA | T 0196/22 | Board 3.2.04
Article 15(5) RPBA 2020

Case Number	T 0196/22
Board	3.2.04
Date of decision	2024.01.12
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 112(1)(a), 113, 116 EPC
EPC Rules	
RPBA	Article 15(5) RPBA 2020
Other legal provisions	
Keywords	oral proceedings before board of appeal – right to be heard – re-opening of the debate (no) – referral to the Enlarged Board (no)
Cited decisions	
Case Law Book	III.C.7.9. , V.B.2.3.1. , 10th edition

In [T 196/22](#) the respondent (patent proprietor) requested to be given time to formulate two questions that should be referred to the Enlarged Board, the first relating to the interpretation of synergy and the second to the standard for not admitting auxiliary requests into the proceedings (here: 11a, 12, 12a or 14a). While the respondent acknowledged that the discussion on these points had been closed and that the board had announced its conclusions with regard to synergy and had taken the decision not to admit the above auxiliary requests into the proceedings, they argued that the necessity of a referral lay in the board's conclusions, which could only be known once the board had reached them.

The board recalled that during the discussions on the above two points, the respondent had neither explicitly requested a referral, nor argued that these issues were of fundamental importance or that the board when coming to a certain conclusion would be deviating from previous case law. Furthermore, since the board's communication expressing its provisional opinion had mentioned both the question of synergy and the question of problems with late-filed requests, the representative had not been confronted with new issues that might have taken him by surprise.

The board took the view that it should not give a party time to formulate questions for a potential referral with regard to points that had already been discussed and decided, for the following reasons.

Oral proceedings were meant to put the deciding body, in this case the board, in a position to decide on the issues in dispute. The board explained that in order to do so, the procedure was structured into different stages, and once a certain stage had been concluded, a party may no longer be able or allowed to undertake certain procedural acts. Once an issue had been discussed in oral proceedings, the board closed the debate on this issue, deliberated thereupon and announced its conclusions. The board was unlikely to reopen the discussion once the parties had been properly heard and the board felt in a position to form an opinion.

According to the board, the respondent's request for time in order to formulate questions to the Enlarged Board could have had, in the case at issue, no other purpose but to reopen a debate that had already been concluded. As the board had already reached its conclusions, a reopening of the discussion was at the discretion of the board, and the board decided that no such reopening had been opportune or necessary.

As to the respondent's argument that the point they wanted to make with the referral had only become pertinent once the board had reached its conclusions, the board found that reopening the discussion on any issue relevant to the decision was subject to the procedural avenues that were available. With regard to a decision rendered by the boards of appeal, the only judicial remedy was a petition for review, as had been pointed out to the respondent during the oral proceedings. In addition, the board held that if the respondent was correct in its argumentation, parties to an oral hearing would be entitled to request a referral to the Enlarged Board every time the board reached an adverse conclusion. Should a party to proceedings before the boards of appeal be convinced that certain questions merit the attention of the Enlarged Board, this argument should be made before or during the discussion on this question, but certainly not afterwards.

The board concluded that, for these reasons, it was within its discretion to refuse a request by a party for time to formulate questions to the Enlarged Board, the only purpose for which could be to reopen a debate that had already been closed and upon which the board had relied to reach its conclusions.

038-03-24



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