

Recent EPO case law

FICPI - Turkey webinar

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Enlarged Board of Appeal cases

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Boards of Appeal cases

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G1/18

Appeal inadmissible or deemed not filed?

G1/18 EBA referral

Referral by President

Notice of appeal filed and / or appeal fee paid **after** 2-month period:
appeal inadmissible or deemed not filed?

Relevant for reimbursement of appeal fee

Majority of BoA decisions: deemed not filed

Minority of BoA decisions: inadmissible

Conflicting case law since 1994

G1/18 wording of the law

	Art. 108	instead of
EN	Notice of appeal shall be filed	
DE	Die Beschwerde ist ... einzulegen	Die Beschwerdeschrift ist ... einzureichen
FR	Le recours doit être formé	L'acte de recours doit être déposé

EBA: 'notice of appeal filed' and 'appeal filed' are synonyms.

Preferably: 'appeal filed' should be *read as* 'notice of appeal filed'

Compare:

you cannot
but you

'file a re-establishment'

'file a request for re-establishment'

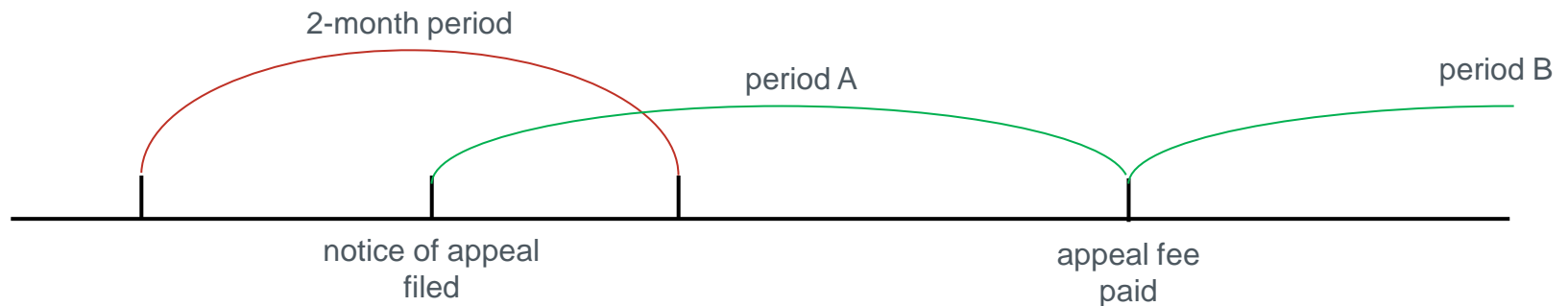
G1/18 wording of the law

Art. 108

“Notice of appeal shall be filed ... within two months

Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid. ...”

Example appeal fee paid late



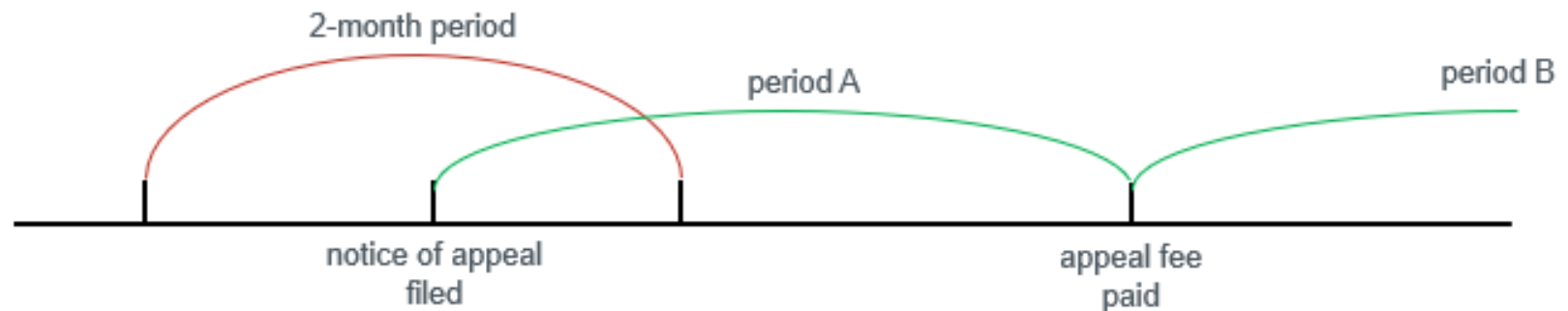
First sentence: Notice of appeal filed in due time

Art. 108 2nd sentence:

“Notice of appeal shall **not** be deemed to have been filed **until** the fee for appeal has been paid.”

Comparison EN version with DE and FR version of Art.108 →
interpretation:

“Notice of appeal shall be deemed to have been filed **not until** the fee for appeal has been paid.”



Period B: notice deemed to have been filed

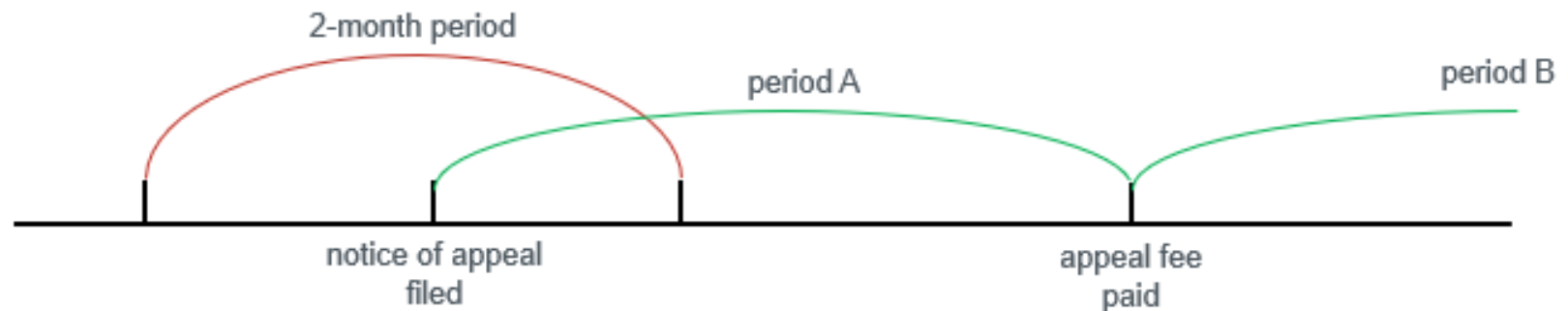
G1/18 wording of the law

Art.108: 'deemed' → legal fiction in period B

- However, notice actually filed in due time, why need legal fiction in period B?
Usually a legal fiction reverses actual situation
- Legal fiction in period B, but no legal fiction in preceding period A

Probable intention:

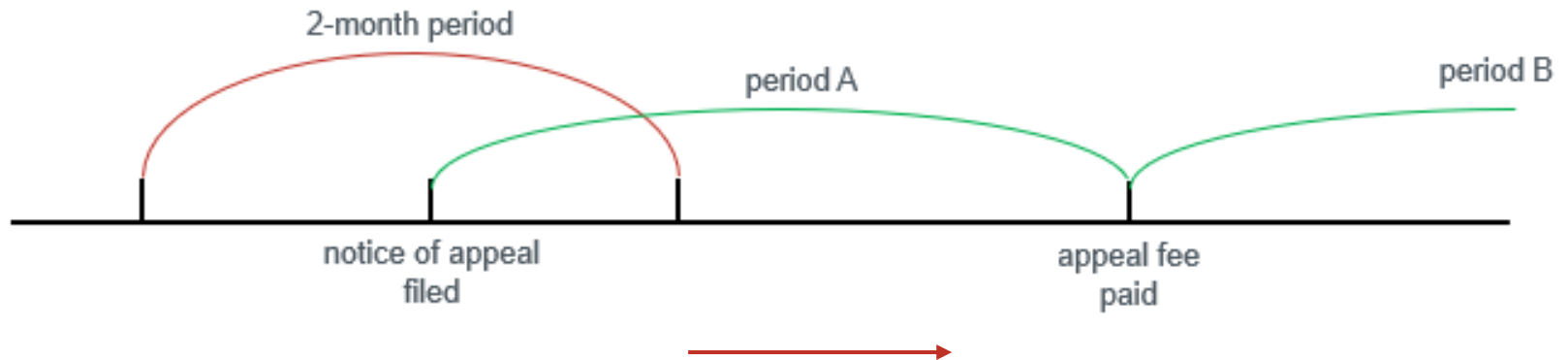
- period A: notice deemed not to have been filed (implicit)
- period B: notice deemed to have been filed (explicit)



Two possible interpretations of second sentence Art. 108

- narrow literal interpretation
- broad literal interpretation

Narrow literal interpretation of Art. 108



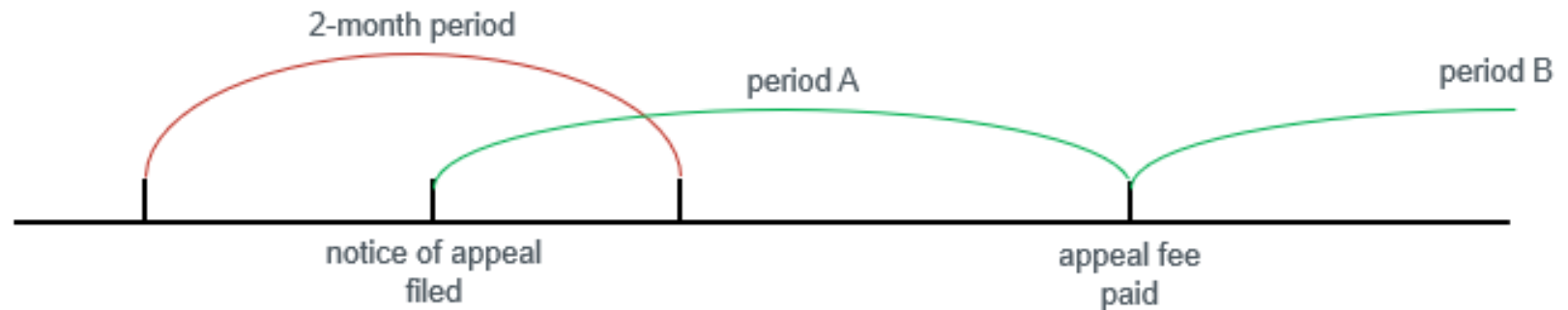
Legal fiction: date of filing notice → date of paying fee

If fee paid late → notice also filed late

After payment the notice is not 'deemed not to have been filed'
but 'deemed filed'

Hence, appeal inadmissible = minority opinion of boards

Broad literal interpretation of Art. 108



Second sentence (appeal fee) is 'temporally linked' to first sentence (notice)

Hence

- appeal fee must be paid in 2-month period
- if paid later or if not paid: notice deemed not to have been filed
= majority opinion of boards

Initiate appeal: file notice & pay fee, both within 2-month period

Broad literal interpretation

- in keeping with purpose of Art. 108
- other ways of interpretation of Art. 108 confirm:
broad literal interpretation correct
- sanction after late payment not expressly stated in Art. 108
'notice of appeal deemed not filed'
complies with general wording of R. 112
- two-step assessment is correct
first: notice deemed filed? second: appeal admissible?

Majority and minority boards:

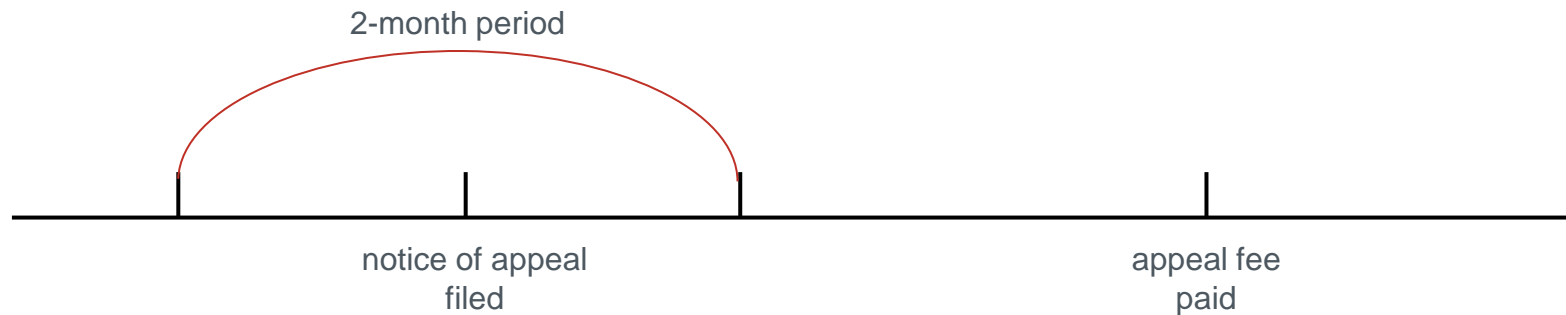
Travaux Préparatoires used as basis

EBA: sentence in Travaux Préparatoires used by minority boards
as basis is contradictory

Appeal fee

- fee due when requesting service; early paid fee is not due
- appeal fee due on filing of notice of appeal

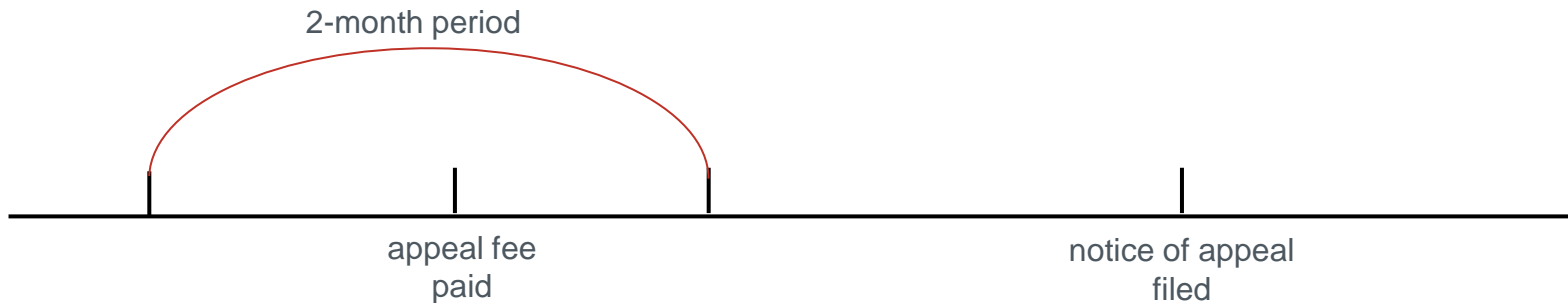
Notice filed within and payment made after two-month period



- notice deemed not filed
- appeal fee no longer due
- appeal fee to be reimbursed

Appeal fee

Payment within and notice filed after two-month period or no notice filed



- payment made before due date = filing of notice of appeal
- date of payment postponed to date of filing notice
- appeal does not exist
- appeal fee to be reimbursed

Conclusion

		(Notice of) appeal	
		filed in due time	filed late
Appeal fee	paid in due time	appeal initiated	deemed not filed
	paid late	deemed not filed	deemed not filed

Appeal fee reimbursed if notice of appeal is deemed not filed
Also if appeal fee paid and no notice of appeal filed

G1/18 effect on other legal fictions in EPC

G1/18

interpretation of legal fiction ‘deemed to have been filed’
important for other, similar legal fictions in EPC

R1/18

filing request for re-establishment within two-month period,
“The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid.”

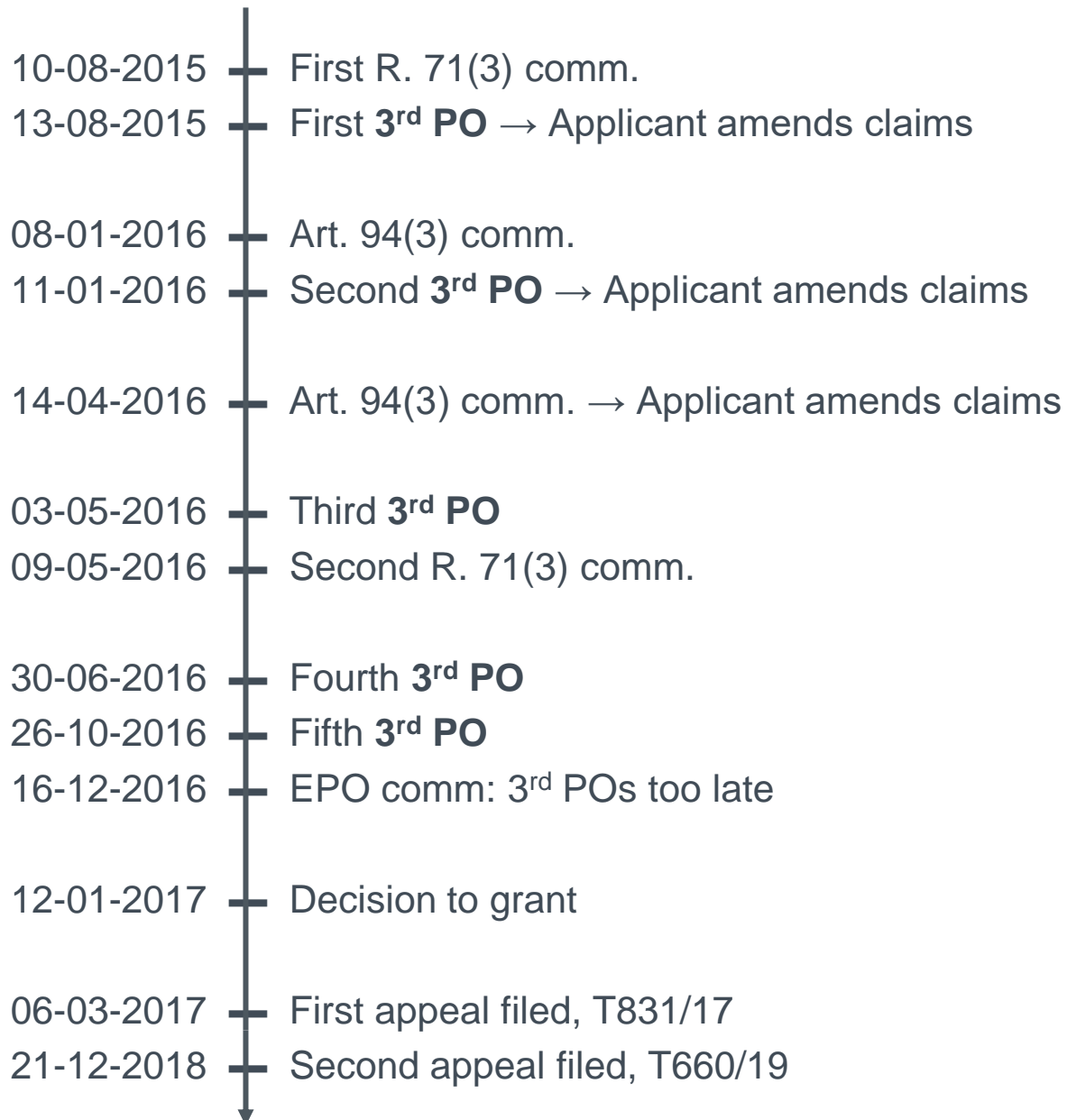
EBA

interpretation of G1/18 not directly applicable to R. 136(1)

G2/19

Right to oral proceedings
&
Haar

G2/19 Grant procedure



Appellant = third party

Third party cannot use opposition to resolve clarity issues in granted patent

Hence, he files appeal to re-open grant proceedings

Third party requests oral proceedings in appeal and, when summoned to Haar, requests move to Munich, Haar not being mentioned in Art. 6(2) EPC

BoA, three questions to EBA

Q.1 Right to oral proceedings limited if appeal is manifestly inadmissible?

Q.2 If the answer is yes, is the appeal inadmissible in this particular situation?

Q.3 Does holding oral proceedings in Haar infringe Article 116 EPC if appellant requested move to Munich?

- Q.1 not admissible, too general
- Q.1 and Q.2 combined

Answer to first question about oral proceedings

- Right to oral proceedings not absolute
- Exception if oral proceedings do not make sense, as in this case
- Third party is not party to proceedings
 - not party to proceedings because of Art. 115 EPC
 - not party to previous proceedings (Art. 107 EPC)
 - he is 'de facto party', who has no procedural rights
 - hence, no right to oral proceedings

Broad answer on narrow question in reason B.II.8 and C.I:

There is no right to oral proceedings for a de facto party if he was not party to previous/present proceedings or requests a goal inadmissible in appeal.

Answer to second question about Haar

- Move of boards from Munich to Haar does not affect jurisprudence of boards
- Relocation may however affect right of a party to be heard.
 - Only if place or time of oral proceedings are chosen entirely out of the usual framework: could be regarded as unwillingness of boards to deal with a case.
 - seriously not the case with relocation from Munich to Haar
 - alleged violation of right to be heard does not go beyond perceived lack of inconvenience.

EBA did not check legal basis of relocation and whether Haar is covered by Art. 6(2) EPC.

Note EBA: necessity of spatial separation of the boards from the administrative departments more important than city limits of Munich.

G3/19

Peppers

T10~~X~~/18



Art. 53(b)



R. 28(2)

Excl. e.b. processes

Excl. products by e.b. processes

G3/19

- interpretation of Art. 53(b) not fixed for once and all by G2/12, development of interpretation is possible
- interpretation may change because of developments, EBA uses for that purpose the 'dynamic interpretation'
- new R.28(2) is such a development:
 - G2/12 out
 - Art. 53(b) & R. 28(2) no longer in conflict.

Board of Appeal cases

How does case law develop?

How did the criteria for novelty of a sub-range change?

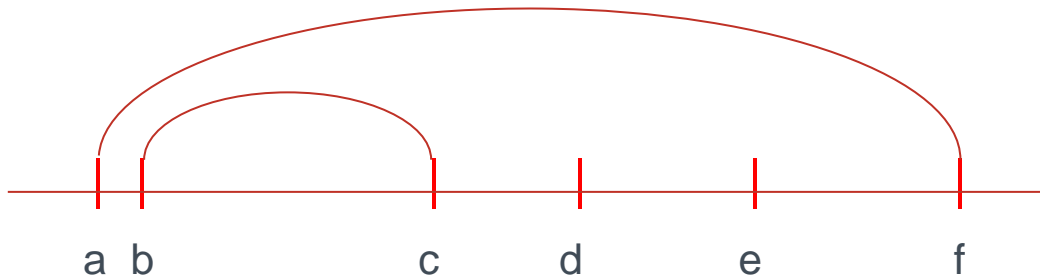
Criteria for novelty of sub-range selected from broad range
(GL G-VI,8(ii), edition 2018)

1. sub-range narrow
2. sub-range far removed from known points in broad range and from end-points
3. sub-range not arbitrary but purposive selection having different effect

How did the criteria for novelty of a sub-range change?

Criteria for novelty of sub-range **b-c** selected from broad range **a-f**
(G-VI, 8(ii), edition 2018)

1. sub-range narrow (**b-c** \ll **a-f**)
2. sub-range far removed from known points in broad range and from endpoints (**b-c** far from **a**, **d**, **e** and **f**)
3. sub-range not arbitrary but purposive selection having different effect (**other effect in b-c than in a-f**)



T198/84 origin of criteria

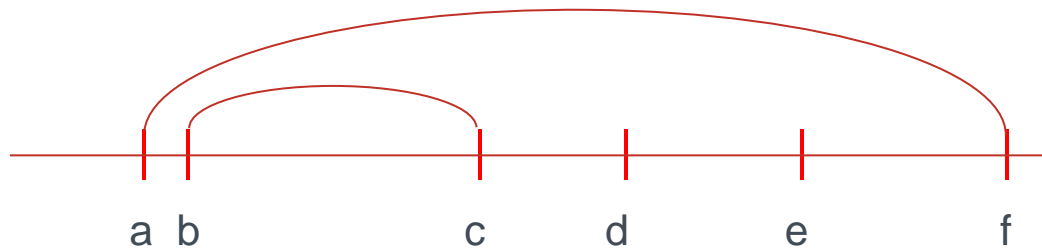
No 'end points' in criterion 2

All later BoA decisions: no 'end points'

GL 2005: Three criteria for first time in Guidelines

'end points' introduced

GL 2019: still with 'end points'



First instance: b-c not novel

Second instance: b-c novel

2008, T1131/06: 3rd criterion not for novelty but for inventive step

Since 2008:

- Some boards: 2 criteria
- Other boards: 3 criteria
- CLBA: summary with 3 criteria, summary of conflicting case law
- GL: 3 criteria

Early 2019: GL going to drop 3rd criterion

CLBA 9th edition, July 2019:

- summary with 3 criteria, summary of conflicting case law

October 2019, confusion among users:

- Article in *epi Information*: Refer all three criteria to EBA
- Article in *epi Information*: maintain 3rd criterion
- President epi sends letter to President EPO: refer third criterion to EBA

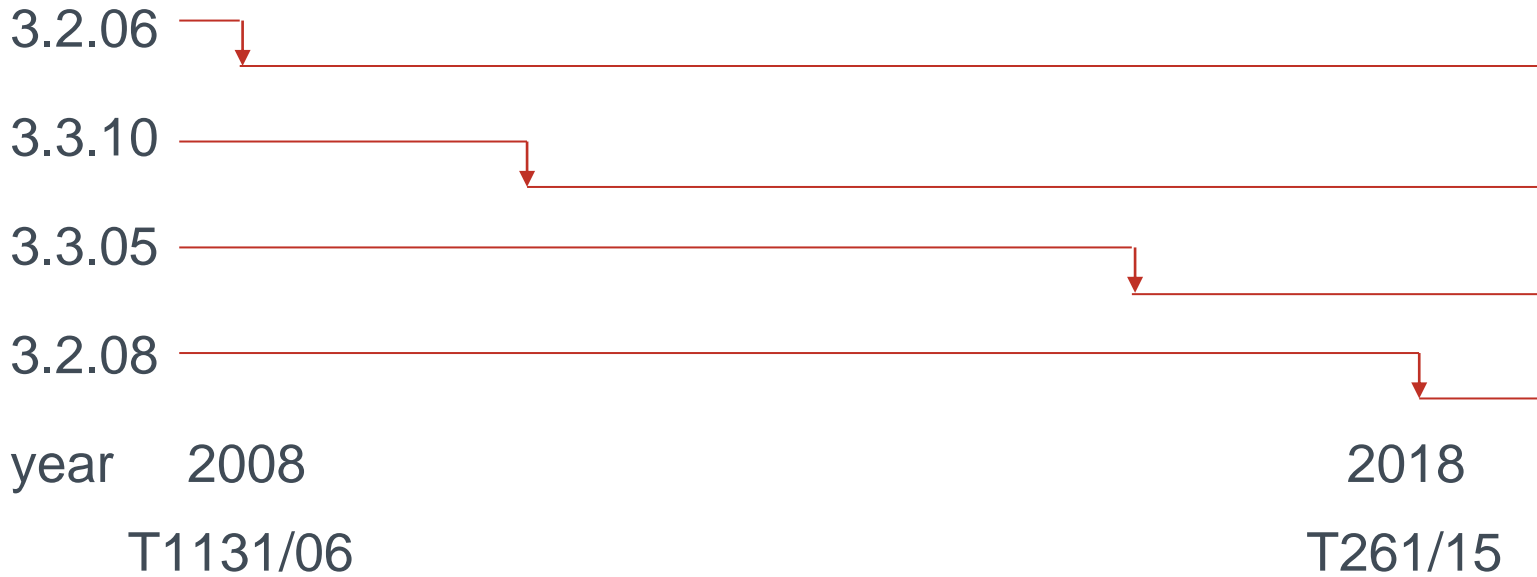
November 2019, clarity from DG5

- Letter EPO to President epi, published in *epi Information*
- explaining developments

Analysis of decisions by DG5

Most decisions on novelty of sub-ranges dealt with by four boards

Boards



After a ten years' period boards do not use third criterion anymore
(in general)

Hence, DG1/5 changes Guidelines

Users: ten years of conflicting case law



EPO: normal development of case law in ten years

Communication

- DG1/5 ↔ DG3 not much communication;
GL 2019 ≠ CLBA 9th ed.
- DG1/5 → users little and sometimes unclear
communication;
information about 3rd criterion is exception:
collateral benefit of request for referral

Ten years of legal uncertainty
Can it be shorter, please?

T1621/16

Selection from multiple convergent lists

Claim 1 as filed

Dishwashing detergent comprising

0.1% to 20% of surfactant A; at least 5% of surfactant B; ...

Claim 1 as amended

Dishwashing detergent comprising

0.2% to 3% of surfactant A; 15% to 25% of surfactant B; ...

Description:

Surf. A. “from 0.1% to 20%, preferably from 0.2% to 5%,
more preferably from 0.2% to 3%”

Surf. B “at least 5%, preferably from 5% to 40% and
more preferably from 15% to 30% and even more preferably
at 15% to 25%”

Amendment = combination of selections from converging lists

Amendment must comply with Art. 123(2)

[Amendment by selection of a **single element from one list** does not extend subject-matter (G-VI, 8(i))]

Amendment by combination selections of **single elements from multiple lists** in general extends subject-matter

Each element of a list is a distinct feature. A combination of such distinct features leads to a singling out of an invention from among several alternatives, which cannot be anticipated by the public

However, the combination is allowed if there is a pointer in the application to the combination, e.g. the combination is disclosed in the description or is defined in the dependent claims

Amendment by **deletion of elements from multiple lists**

e.g. amending A1, A2, A3 and B1, B2, B3
to A2, A3 and B1, B3

The amendment converges the scope of the claim

Amendment by deletion is allowed, provided

- the combination is merely restricting the scope without singling out an undisclosed invention
- the combination does not provide an undisclosed technical contribution

Amendment by **selecting from multiple converging lists**

The elements of a converging list are not individual, distinct features but more or less restricted versions of the same features

Hence, a selection from multiple converging lists restricts the scope of the claim.

Similar to deletion of elements for multiple lists; therefore allowable, provided that

- the combination of selections is supported by application as filed, e.g. by a specific example disclosed in the description or defined in the claims, falling within the scope of the claim.
- the combination has not an undisclosed technical advantage.

Claim 1

board allowed amendment containing combination of selections from one non-convergent list and nine convergent lists.

Message

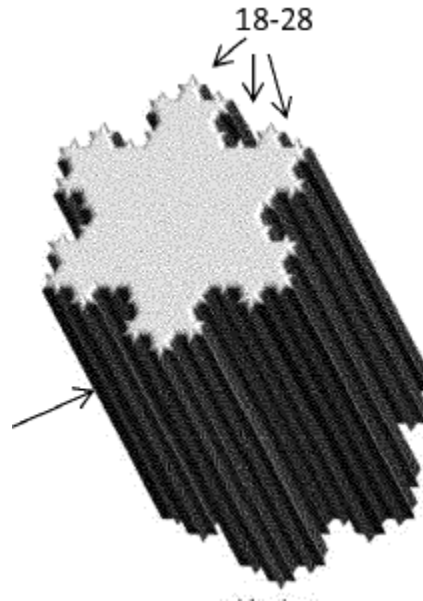
when drafting patent application including lists,
make lists convergent, e.g. by adding 'preferred, more preferred ...'

allows any combination of selections from multiple lists
selection from list need not be most preferred element in list

EP18275163

Machine as inventor

Invention: food container having fractal circumference



Inventor: Dabus = AI machine

Applicant is owner of machine, hence right to patent
≠ employer

Decision Receiving Section

- inventor must be natural person (implied by EPC)
- machine has not a legal personality → cannot enjoy or exercise rights.
- giving machine a name insufficient to give it legal personality
- application refused

Applicant has filed a notice of appeal

Probably test case to have AI as inventor, because AI may be able to devise non-obvious solutions

T703/19

Good faith and warning of missing payment

Appellant filed electronically notice of appeal and debit order

No method of payment indicated in debit order

Appellant pays appeal fee after 2-month appeal period and requests to regard appeal fee as being timely paid,
EPO should have sent warning about omission under good faith

Board agreed with appellant and regarded appeal fee as being paid in due time

Summary of good faith and missing payment

- Party responsible for avoiding loss of rights
- However, EPO must warn party under good faith (G2/97)
 - if a deficiency is readily identifiable
 - notice of appeal refers to attached payment and it is not attached, a warning must be issued.
 - the debit order has deficiencies: a warning must be issued
 - notice of appeal does not refer to payment and no debit order attached: no warning of missing payment
 - and if it can be corrected in due time
 - one month sufficient for noticing error, informing party and correction by party
 - one or two weeks is insufficient

T317/19


Correction of payment

Appellant filed electronically notice of appeal and debit order

Notice of appeal:

We are paying the appeal fee from our deposit account no. 28050721 by way of the attached fee sheet. If this fee represents an underpayment, or if any further fees are due at this time in order for this appeal to be validly filed, we authorise the deduction of the shortfall from the above-referenced deposit account.

Debit order:



	Payment	
1	Method of payment	Not specified
2	Refund/Reimbursement	
	Reimbursement (if any) to be made to EPO deposit account:	28050721
	Account holder:	Forresters

EPO communication

- Debit order not filed in correct format → appeal fee not debited

However, debit order was filed in correct format

Tel. call patent attorney with EPO:

- Report of call in EPO file:
 - no rectification under R. 139 possible, only by re-establishment of rights
- According to patent attorney:
 - debit order not carried out because of insufficient information in debit order
 - no rectification under R. 139 possible, only by re-establishment of rights

Reconstruction

- Debit order not carried out because of missing information, method of payment not specified
- Statement in Notice of appeal regarded as debit order
- Statement not filed in correct XML format
- Hence, debit order in Notice of appeal not carried out
- EPO sends communication: debit order not filed in correct format

GL (2019) A-X, 7.1.1: No R. 139 correction for payments

Earlier case law: R. 139 may not be applied generally, as it would circumvent requirements for re-establishment

Decision BoA T317/19

- G1/12 of 30-04-2014:
 - R. 139 may be applied to any document filed with the EPO
- Thus also to debit orders

- Four requirements for application of R. 139 taken from G1/12
 - correction or error must introduce what was originally intended
 - heavy burden of proof for requester
 - error may be incorrect statement or an omission
 - request must be filed without delay
- Three further requirements from case law on R. 139
 - legal certainty for parties
 - legal certainty for the public
 - no long unclear legal status of application
- All requirements complied with: debit order retroactively corrected
- Sufficient balance in deposit account on day of filing debit order: that day regarded as the date of payment

J8/19

Correction of payment

Appellant had paid old amount of appeal fee using an electronic debit order and requested correction under R. 139

Decision BoA

- major part of decision literally identical to T317/19
different boards! → broad support for general application R.139
- extra requirement to application of R. 139:
error should be an excusable oversight

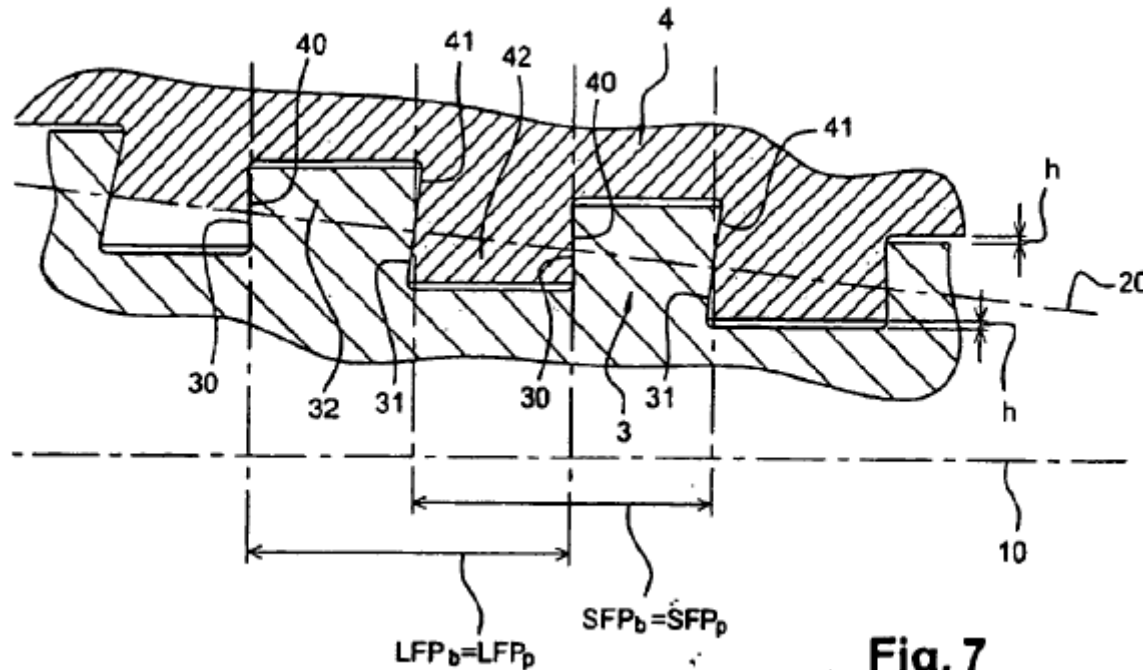
Comments

- Will GL be changed in April 2021?
- Extra requirements cause legal uncertainty
- Can R. 139 be used to correct bank transfer?

T1943/15

Measurements in drawings

Does prior art disclose claimed ratio of dimensions in a threaded connection of two tubes?



Good summary of case law about measurements in drawings

Type of drawing	dimension derivable?	ratio of dimensions x and y derivable?	comment
Construction drawing	yes	yes	T204/83
Precise schematic drawing	no	yes	if the patent drawing resembles a construction drawing, T422/95
Schematic drawing	no	no	T204/83; T1664/06; T451/88
		yes	if the measured features are essential items of the invention, T748/91
		yes	if $x \gg y$, T748/91; T422/95; T1313/04
		no	if $x > 0.2y$, T1943/15 r.4.5
		no	if $x = y$, T1943/15 r.4.5

Thank you