

# EPO Boards of Appeal

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## Disclaimers – G 2/10

- T 1107/06
  - *“A disclaimer does not infringe Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed.”*
- T 1050/99
  - *“...there is a basis in the application for the subject-matter which is excluded in the claim. However, that subject-matter is presented as a part of the invention, not as an area which should be excluded or avoided.”*
- T 1068/07
  - *“Does a disclaimer infringe Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed?”*

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## Disclaimers – G 2/10

- The EBoA concludes that the test must be that, after the amendment/disclaimer, the skilled person may not be presented with new technical information.
- *“An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Article 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.”*

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## New requests before the BoA - RPBA 12(4)

- Rules of Procedure of the Boards of Appeal, § 12(4)
  - “Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties [...] shall be taken into account [...]”

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## New requests before the BoA - RPBA 12(4)

- T 23/10, T 144/09
  - During first instance oral proceedings, the OD had invited the proprietor to address an “added subject-matter issue”, but the proprietor did not. Upon appeal, the proprietor’s various requests addressing the same issue were not admitted into the proceedings.

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## New requests before the BoA - RPBA 12(4)

- T 1705/07
  - The opposed patent contained both method claims, composition claims and use claims. The OD found the method claims to lack an inventive step, and since these method claims were present in all requests, no decision was necessary on the inventiveness of the composition and use claims.
  - During appeal, auxiliary requests were filed where the method claims had been cancelled. These were not admitted because the appellant “cannot be allowed to take advantage of his own negligence to get the case remitted back to the first instance”.

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## And it gets worse...

- T 379/09
  - Patent was revoked by OD for lack of disclosure and lack of inventive step (claims 7 and 9).
  - Decision appealed, and final requests filed one month before oral proceedings before the Board of Appeal.
  - Claims 7 and 9 were deleted in the final requests to overcome the objections.
  - Problem: Only claims 7 and 9 were assessed by the OD for inventive step. No assessment was made concerning inventive step for the other claims.
  - Admission of the requests would require remittal to OD.
  - Requests not admitted. Appeal dismissed!

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## ...and even worse...

- T 1067/08
  - Concerned a broadening amendment during oral proceedings. With the summons to oral proceedings, the OD pointed out that a feature extended beyond the original disclosure, and the proprietor filed narrowing amendments. During oral proceedings, the OD found that the requirements of Art. 123(2) were still not met. The proprietor then filed a new main request of broader scope, which was not admitted.
  - Upon appeal, the Board agreed with the OD. The proprietor should have realized that such request had to be filed in advance of the oral proceedings, having regard to the legitimate interests of the other parties involved.

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## ...and only slightly better

- T 848/09
  - Patent revoked by OD for lack of inventive step concerning claim 1.
  - New main and auxiliary requests filed with the appeal grounds.
  - Opponent/respondent argued that the new requests should not be admitted, referring to RPBA and previous decisions.
  - Main request was admitted, because it was filed already with the appeal grounds and contained only limitation to a dependent claim.
  - Auxiliary requests were not admitted because limitations were not previously in dependent claims (taken from the description).
  - Main request lacked inventive step...
  - Appeal dismissed.

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## Surgical methods- Decisions after G 1/07

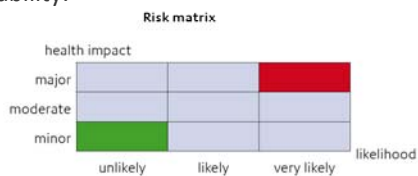
- G 1/07
  - “A claimed imaging method, in which, when carried out, maintaining the life and health of the subject is important and which comprises or encompasses an invasive step representing a substantial physical intervention on the body which requires professional medical expertise to be carried out and which entails a substantial health risk even when carried out with the required professional care and expertise, is excluded from patentability as a method for treatment of the human or animal body by surgery pursuant to Article 53(c) EPC.”

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## Surgical methods – T 663/02

- “The fact that an intravenous injection of magnetic resonance contrast agent can be delegated by a physician to a qualified paramedical professional indicates that such an injection may be considered as representing a minor routine intervention which does not imply a substantial health risk...”
- Proposes the use of a health-risk matrix for assessing exclusion from patentability.



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## Surgical methods – T 1075/06

- *“Venipuncture of blood donors and the extraction of blood from a donor’s body represent substantial physical interventions on the body which require professional medical expertise to be carried out and which entail a substantial health risk even when carried out with the required professional care and expertise.”*
- *“A method claim comprising steps encompassing such procedures [...] is excluded from patentability under Article 53(c) EPC.”*

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## Transfer of opposition – T 1421/05

- The status of opponent remains with the transferor in absence of there being filed with the EPO (a) evidence of the transfer, and (b) a request to recognise the transfer of opponent status.
- If the transferor ceases to exist but has a universal successor, the status of opponent can be passed to that successor. The mere possibility of abuse does not prevent opponent status from passing this way; the proprietor must prove relevant acts of abuse.
- An appeal filed by mistake in the name of an opponent who no longer exists but who has a universal successor is admissible. If necessary, correction of the appellant’s name may be filed.

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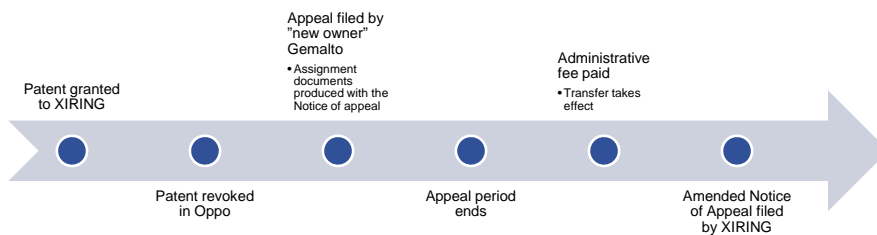
## Registering a transfer – T 128/10

- Registering a transfer requires (R 22, R 85)
  - The filing of a request for a transfer by the interested party,
  - the production of documents providing evidence of the transfer, and
  - payment of the administrative fee.
- If these requirements are met on different dates, the transfer shall have effect when all are fulfilled.

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## Consequence of T 128/10



- Amended Notice of Appeal filed after appeal period - Inadmissible
- XIRING no longer adversely affected – Inadmissible
- Correction of original Notice of Appeal not possible because there was no deficiency (true intention to appeal in the name of Gemalto)
- Appeal rejected as inadmissible!

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## Therapeutic method– T 1635/09

- Use of contraceptives (non-therapeutic effect) at such concentrations that side-effects are reduced or prevented (therapeutic effect) is a therapeutic method excluded from patentability under Art 53(c).
- Inclusion of the wording "non-therapeutic use" does not make the subject-matter patentable.
- Change of category to "use for manufacturing" is not allowable under Art. 123(3) because it would encompass also the products directly obtained.
- Change of category to purpose-related product is also not allowable because it extends to the product.

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## Claim Construction – T 1789/09

- Claimed feature (absorbing capacity): *"at least ~~45 ml/100 g~~"*  
30-60 ml/100 g
- Prior art example: ~~39 ml/100 g~~  
26-52 ml/100 g
- Novelty problem?
- Yes! The method for determining absorbing capacity has an inaccuracy of measurement of +/- 1/3. Both the claimed feature and the prior art example must be construed against this backdrop.
- Considerable overlap of ranges leads to lack of novelty!

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## **“Substantially circular” – T971/10**

- “[...] a particular technical term has to be given the meaning it usually has in the particular technical field concerned.”
- “This means that [in this case] the term “circular” [...] never means ‘exactly’ or ‘perfectly’ circular but only circular within those tolerances which are usual in the manufacture of such apparatuses.
- “As a consequence, the use of the term “substantially” in combination with “circular” [...] suggests that deviations are included which are larger than those accepted tolerances. Since there is no explanation of what the deviations might be, the terms become vague and undefined with the result that it is no longer possible to determine the extent of protection conferred by the application [...]”

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## **Third Party Observations – T 146/07**

- Anonymously (i.e. unsigned) filed third party observations must be disregarded altogether unless they trigger a further procedural act.
  - The anonymous observations may be adopted by a party as its own.
  - The anonymous observations may trigger objections by the competent organ of the EPO.
- In line with G 1/03 and G 2/03 in which the Enlarged Board of Appeal refused to take into account an anonymously filed third party statement.

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## Amazon "1-click patent" – T 1244/07

- Revoked by the BoA for lack of inventive step.
- "Single action" (1-click) shopping counted from which point? A regular shopping cart is also a single action shopping once you are at the check-out page.
- Closest prior art was an article describing "Implementing a Web Shopping Cart"
- Only difference from prior art was that purchaser's information is not inputted when ordering, but looked up in a table. This was non-inventive in view of, *inter alia*, cookie technology.

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## Amazon "1-click patent" – T 1244/07

- Corresponding US patent
  - Has survived re-examination, but neither D1 nor the skilled person's appreciation of cookie technology was discussed.
- Corresponding CA patent
  - Use of cookie technology for retrieving purchaser-specific information as considered *per se* obvious, but single action ordering was considered to be non-obvious. D1 was never discussed.

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