

EPO Case Law 2015

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The Enlarged Board of Appeal

G 2/12 – Tomatoes II

- The exclusion of essentially biological processes for the production of plants in Article 53(b) EPC does not have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit.
- In particular, the fact that the only method available at the filing date for generating the claimed subject-matter is an essentially biological process [...] does not render a claim directed to plants or plant material other than a plant variety unallowable.
- In the circumstances, it is of no relevance that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53(b) EPC.

G 2/13 – Broccoli II

- The exclusion of essentially biological processes for the production of plants in Article 53(b) does not have a negative effect on the allowability of a product claim directed to plants or plant material such as plant parts.
- **The fact that the process features of a product-by-process claim directed to plants or plant material other than a plant variety define an essentially biological process for the production of plants does not render the claim unallowable.**
- The fact that the only method available at the filing date for generating the claimed subject-matter is an essentially biological process [...] does not render a claim directed to plants or plant material other than a plant variety unallowable.
- In the circumstances, it is of no relevance that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53(b).

G 1/14 – Inadmissible or deemed not filed?

- This, and parallel case G 2/14, aimed to unify divergent case law concerning whether an appeal is “inadmissible” or “deemed not filed”, when filing the appeal and/or payment of the appeal fee is not in compliance with Article 108 EPC, e.g. too late.
- The Enlarged Board corrected the referring TBA on a totally separate formal issue, suddenly making the appeal in question timely filed, and the question to the EBA moot.
- The referring case in G 2/14 was withdrawn.
- No resolution of the issue...

G 3/14 – Clarity during opposition

In considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC.

The view of the EBoA is best explained using a number of examples:

G 3/14 – Clarity during opposition

(cont'd)

The decision defines a number of different kinds of amendments:

- Type B – Cases where an entire dependent claim is introduced into an independent claim.
- Type A(i) – Cases where a dependent claim contains within it alternative embodiments, and one of the alternative embodiments is introduced into an independent claim.
- Type A(ii) – Cases where a feature from a dependent claim is introduced into an independent claim, where that feature was previously connected with other features of that dependent claim.
- Deletion of an entire independent claim (usually with any dependent claims).
- Deletion of some dependent claims entirely.
- Deleting wording from a claim, thereby narrowing its scope but leaving a pre-existing unclear feature.
- Deleting optional features from a (dependent or independent) claim.

G 3/14 – Type B Cases

(cont'd)

Cases where an entire dependent claim is introduced into an independent claim.

In reality, this kind of amendment consists of striking out the original independent claim and then writing out the previous dependent claim in full.

As granted:

1. A product comprising X.
2. The product of claim 1, wherein the amount of X is substantial.

As amended:

1. A product comprising a substantial amount of X.

No examination for compliance with Article 84

G 3/14 – Type A(i) Cases

(cont'd)

Cases where a dependent claim contains within it alternative embodiments, and one of the alternative embodiments is introduced into an independent claim.

In essence, this kind of amendment is the same as Type B above, but the granted dependent claim contained alternatives. The dependent claim could just as well have been written as two or more dependent claims without alternatives.

As granted:

1. A product comprising X.
2. The product of claim 1, further comprising a substantial amount of Y or Z.

As amended:

1. A product comprising a X and also a substantial amount of Z.

No examination for compliance with Article 84

G 3/14 – Type A(ii) Cases

(cont'd)

Cases where a feature from a dependent claim is introduced into an independent claim, where that feature was previously connected with other features of that dependent claim.

The EBoA confirms that where an alleged lack of compliance with Article 84 is introduced by such an amendment, the claims may be examined for such compliance.

Examination for compliance with Article 84 possible



G 3/14 – Other Cases

(cont'd)

Deletion of one or more independent claims (usually with any dependent claim) leaving other independent claims untouched.

Deletion of some dependent claims entirely.

Deletion of wording (e.g. alternatives or examples) from a granted claim, thereby narrowing its scope but leaving a pre-existing unclear feature.

Deletion of optional features from a granted claim.

No examination for compliance with Article 84

Questions pending before the EBoA

G 1/15 – *Partial priorities*

Highly anticipated, with bearing on the hot topic of “poisonous divisionals”

Referring decision T557/13 worth reading



The Technical Boards of Appeal

T 286/10 – Standard of proof for internet citations

- When an internet disclosure is cited (by an opponent) as prior art, should the standard of proof then be
 - beyond all reasonable doubt, or
 - balance of probabilities?
- The board found no legal basis for applying a stricter standard for internet disclosures than for other prior art disclosures, i.e. a balance of probabilities should be applied. An internet disclosure is *not* a kind of "prior use".
- In this case, the board considered an online newspaper (www.jacksonville.com) and a well reputed web archive (www.archive.org) to be sufficiently reliable sources, such that the burden of proof was switched to the other party to prove non-availability.
- This is probably a fairly reliable case. The Chairman is also a member of the EBA, and the EPO summarizes the case in the Case Law Report for 2014.

T 2001/12 – Article 83 revisited

- An objection of insufficient disclosure under Article 83 cannot legitimately be based on an argument that the application would not enable a skilled person to achieve a non-claimed technical effect.
- A doubt that the invention as claimed is capable of solving the problem defined in the application may have the following consequences:
 - a) If the question arises because the claim fails to specify those features which are disclosed in the application as providing the solution to the problem, then the description and claims are inconsistent in relation to the definition of the invention, and an objection under Article 84 may properly arise (lack of essential features).
 - b) If this is not the case, but, having regard to the prior art, and irrespective of what may be asserted in the description, it does not appear credible that the invention as claimed would actually be capable of solving the problem, then an objection under Article 56 may be raised.

Reading List

Reading List

- **T 557/13** *Referring case in G 1/15*
- T 1360/11 Broad class and ranges when limiting the class
- T 2130/11 Disclaimers (G 1/03) and Art. 84
- T 37/12 Handwritten amendments OK during OP before a BoA
- T 236/12 Alleged extension of scope by amending to original (low quality) drawings
- T 1363/12 Confirming strict standard for Art. 123(2), correcting “softer” Guidelines
- T 81/14 Product-by-process claims

Thank you!

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