

EPO Case Law 2016

SFIRs Praxisdag
12 January 2017

The Enlarged Board of Appeal

G1/15 – Partial priority

- Case dealing with requirement for having *partial priority* for generic claims
- Referral decision: *T 557/13*, “Cold flow improvers in fuel oil”
- Consequences of no priority could be that a “post-filing date” publication of
 - priority application,
 - divisional application (or parent, if divisional at issue), or
 - parallel application with same prioritydestroys the novelty of generic claim, despite priority
- The EPO has stayed prosecution of affected pending applications and oppositions, awaiting the outcome of the decision
- The EBoA issued their order on 30 Nov 2016, but have still not issued the reasons
 - This is a first, and very odd...

G1/15 – Examples of disclosures

Priority application discloses:	Later application claims:
$R^1 = \text{CH}_3\text{CH}_2\text{CH}_3$ (i.e. "C3 alkyl")	$R^1 = \text{C3-C9 alkyl}$
[NaCl] = 8 M	[NaCl] = 4-16 M
Step 1: heat at 80-90 °C	Step 1: heat at 65-95 °C
Use of X to increase effect of Y	Use of X to increase effect of Y, Z or W
Seal which is embossed on a paper (structural feature)	Feature on a paper which can be detected (functional feature)

The disclosure of later application includes all the disclosure of priority application

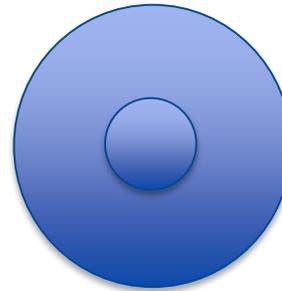
It may even have an exactly matching, dependent claim

G1/15 –Graphic representation

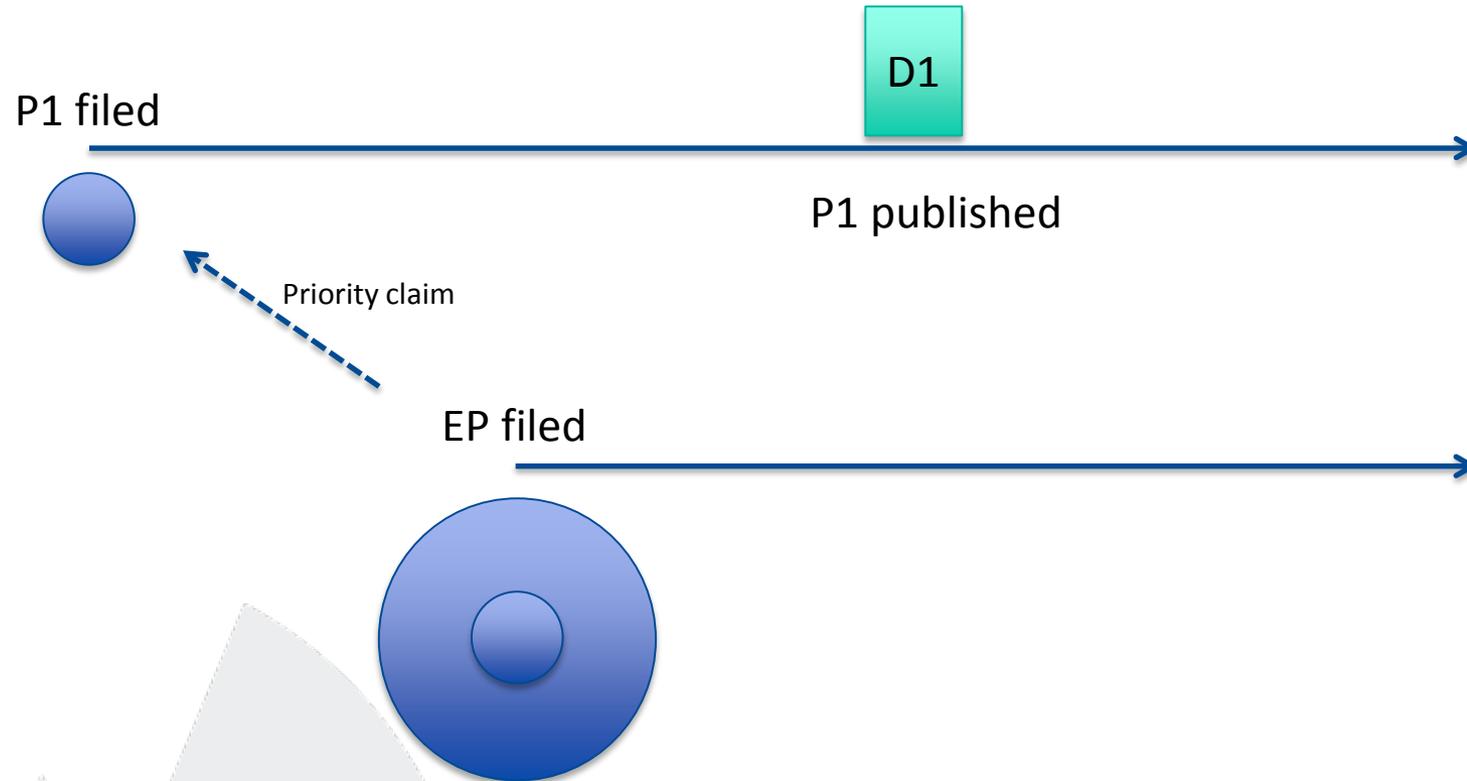
Priority application disclosure



Later application claim

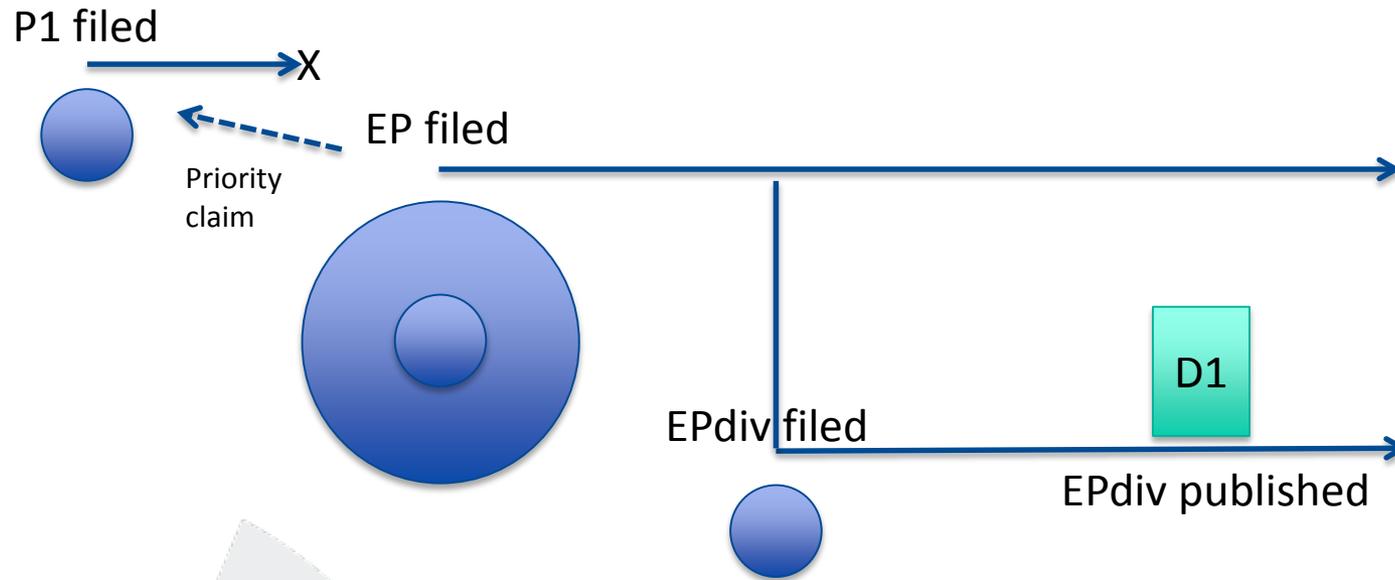


G1/15 – Problem scenario I – “poisonous priority”



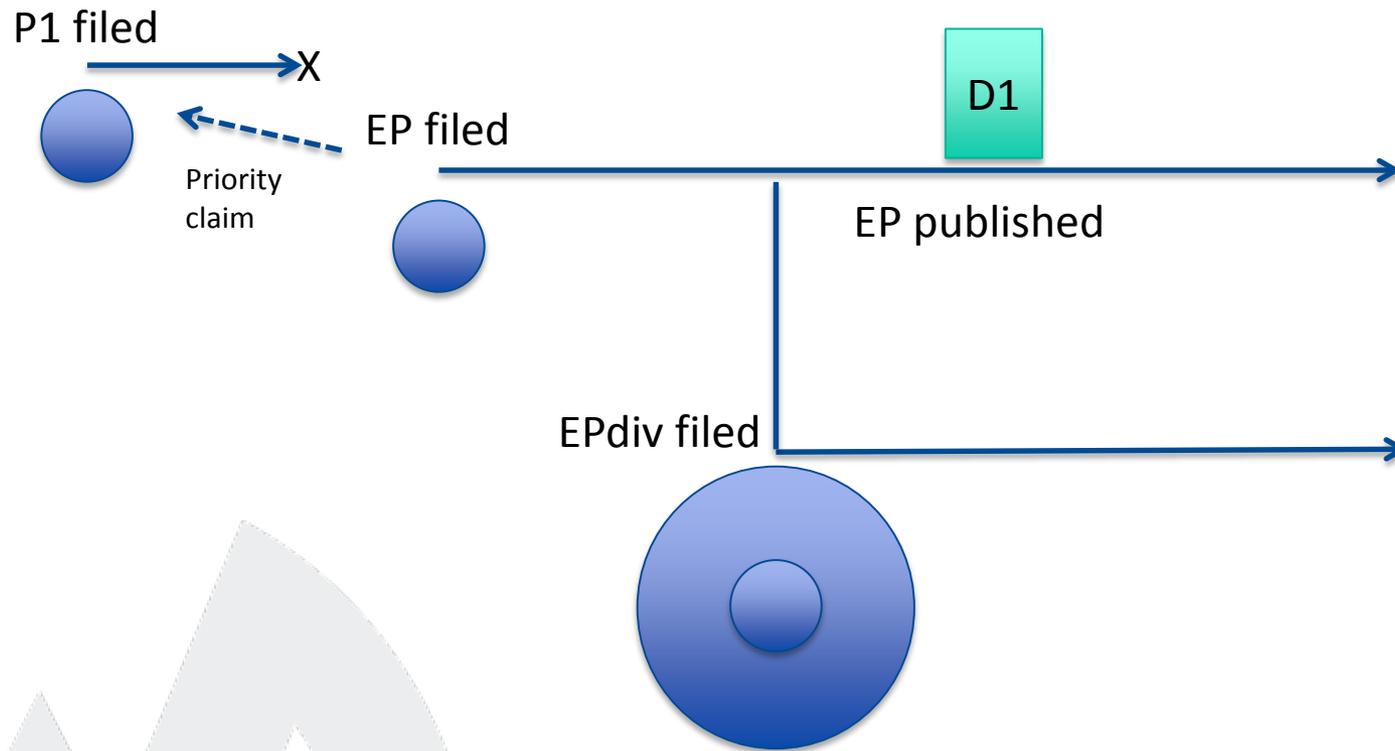
Is the EP claim novel over D1?

G1/15 – Problem scenario IIA – “toxic divisional”



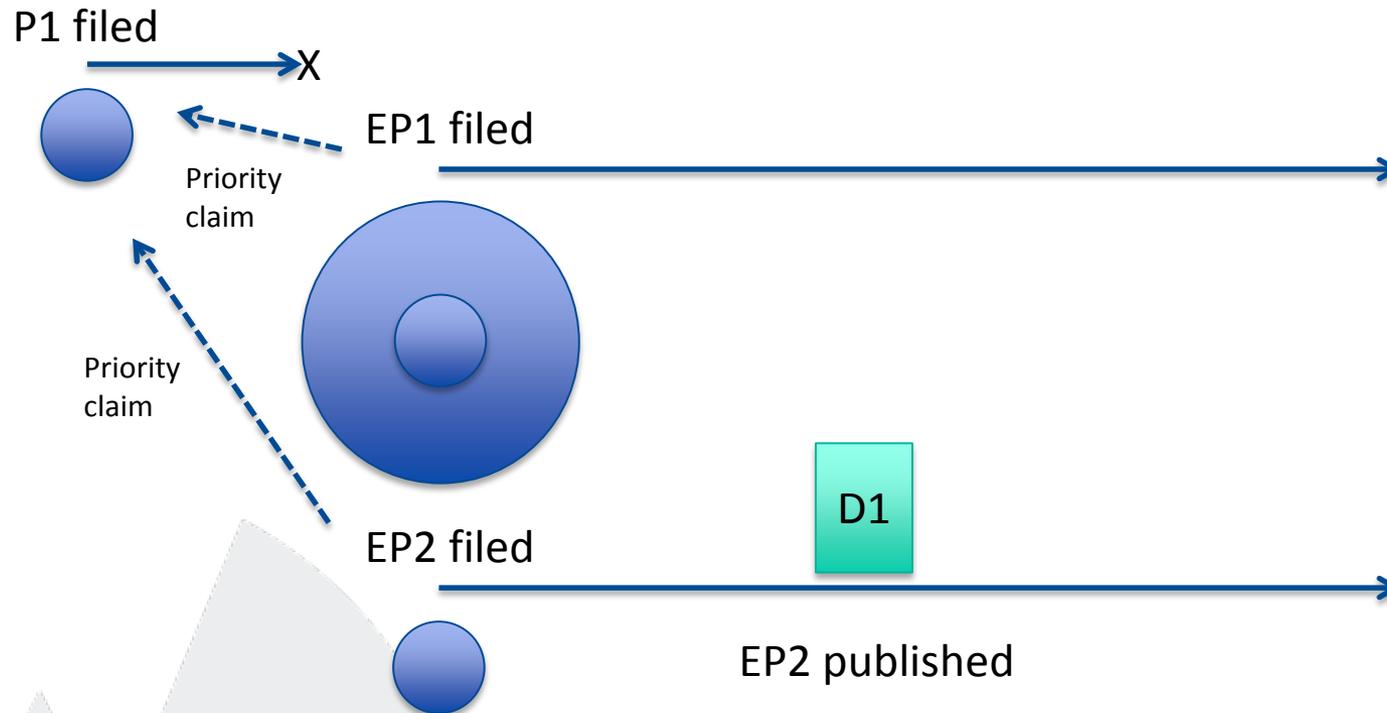
Is the EP claim novel over D1?

G1/15 – Problem scenario IIB – “toxic parent”



Is the EPdiv claim novel over D1?

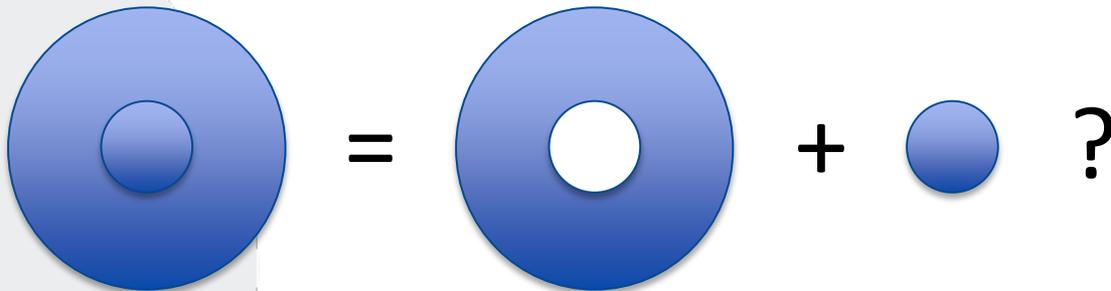
G1/15 – Problem scenario III – parallel cases



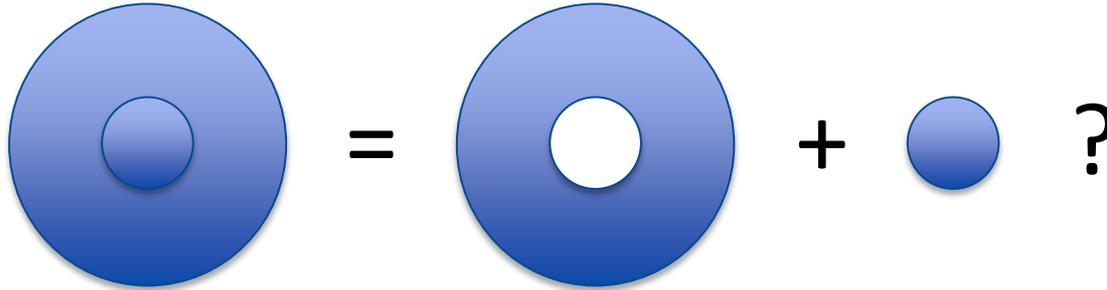
Is the EP1 claim novel over D1?

G1/15 – Issues

- The narrow disclosure, when published, always has an effective date going back to the priority application P1
- This disclosure could, in theory, be applied against the novelty of the later application, if later application lacks priority
 - Broader claim has later effective date
 - The narrower disclosure was filed earlier, published later (“Art 54(3) prior art”)
- Saving the broader claim requires acknowledgment of **partial priority** for 



G1/15



- Guidance may be available in previous decision G2/98:
*The use of a generic term or formula in a claim for which multiple priorities are claimed [...] is perfectly acceptable [...], provided that it gives rise to the claiming of **a limited number of clearly defined alternative subject-matters.*** (emphasis added)

...but does this help...?

- Some EPO Boards of Appeal have answered NO, leading to invalidity
- Other Boards have been less strict, and answered YES

G1/15



The order from the Enlarged Board 30 November 2016:

*Under the EPC, entitlement to partial priority **may not be refused** for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic “OR”-claim) **provided** that said alternative subject-matter has been **disclosed for the first time**, directly, or at least implicitly, unambiguously and in an enabling manner **in the priority document**. **No other substantive conditions or limitations apply** in this respect.*

- Priority is valid to the extent necessary to protect against D1
- The broad claim is interpreted as divided into the alternatives
 - i) what is in the priority application
 - ii) what is not in the priority application
- For i), there is priority back to P1
- For ii), there is no novelty problem



Question pending before the EBoA

G 1/16 – *Disclaimers*

G 2/10 says that a disclaimer is only allowable if the subject-matter remaining after the disclaimer fulfils the disclosure requirement

G 1/03 says that an undisclosed disclaimer (i.e. lacking basis in application) is OK under limited circumstances

G 1/16: Given the “gold standard” maintained by the EPO in prohibiting amendments that introduce subject-matter not disclosed in the application as filed, how can these two decisions be reconciled?

The Technical Boards of Appeal

T 1841/11 – Selection of closest prior art

In **T 1841/11**, the problem-solution approach was discussed. In particular, the selection of the closest prior art was at issue.

The closest prior art should normally relate to the same or at least a similar purpose or objective as the claimed invention. Even if prior art relating to the same purpose is available, **it is not excluded that a document relating to a *similar* purpose** might be considered to represent **a better or equally plausible choice of prior art**.

If prior art relating to a *similar* purpose is selected despite the availability of prior art relating to the *same* purpose, there will generally be at least one feature in the claim appearing as a difference over the prior art. However, such difference may not legitimately be invoked in support of inventive step.

Any argument that such difference would not be straightforward to incorporate would indicate that **this prior art is not a promising starting point** (i.e. not the closest prior art).

T 2227/11 – Level of proof for internet disclosure

Previous cases *T 1134/06* (2007) and *T 1875/06* (2008) required proof beyond reasonable doubt (“up to the hilt”) for establishing public availability of internet disclosure.

In August 2009, the EPO published a Notice stating that free evaluation of evidence should be applied, and that the standard of proof should be the “balance of probabilities”.

In *T 286/10*, the level of proof for availability of internet disclosures was (again) considered. In addition to endorsing the EPO Notice, this decision states:

- Internet disclosures are **not** comparable to prior use situations
- It can be **presumed** that a web page was publicly available on a certain date if that web page has been archived by www.archive.org (“Wayback Machine”) at that date.

T 2227/11 – Level of proof for internet disclosure

In **T 2227/11**, the appellant/applicant disputed that two prior art documents retrieved from the internet were valid prior art. They referred to *T 1134/06* and submitted that availability of internet disclosures should be proved beyond any reasonable doubt.

The Board, however, again confirmed the practice laid down in the EPO Notice, i.e. the appropriate standard of proof for internet citations is the **balance of probabilities**.

The Board also noted that there may be **difficulties** in assessing the authenticity of the publication date and contents. These may require **far-reaching investigations** and the provision of **supporting evidence**. However, the fact that the matter is complicated doesn't imply that a stricter standard of proof should be adopted.

Reading List

Reading List

- **T 437/14** *Disclaimers and Art 123(2) – referring case in G 1/16*
- T 353/14 Availability of internet citation (dates, file sizes, Wayback Machine)
- T 2369/10 (Still) no “medical indication” claims for devices
- T 967/10 Clarity of product-by-process claim
- T 971/11 Procedural; admissibility of documents in appeal
- T 1673/11 Change from Swiss-type to 54(5) claim means scope is enlarged
- T 2440/12 Sale of software is prior use of encoded method (*cf* G 1/92 for chem)
- T 2191/13 Characterizing feature only in the mind of the inventor – not novel

Thank you!