

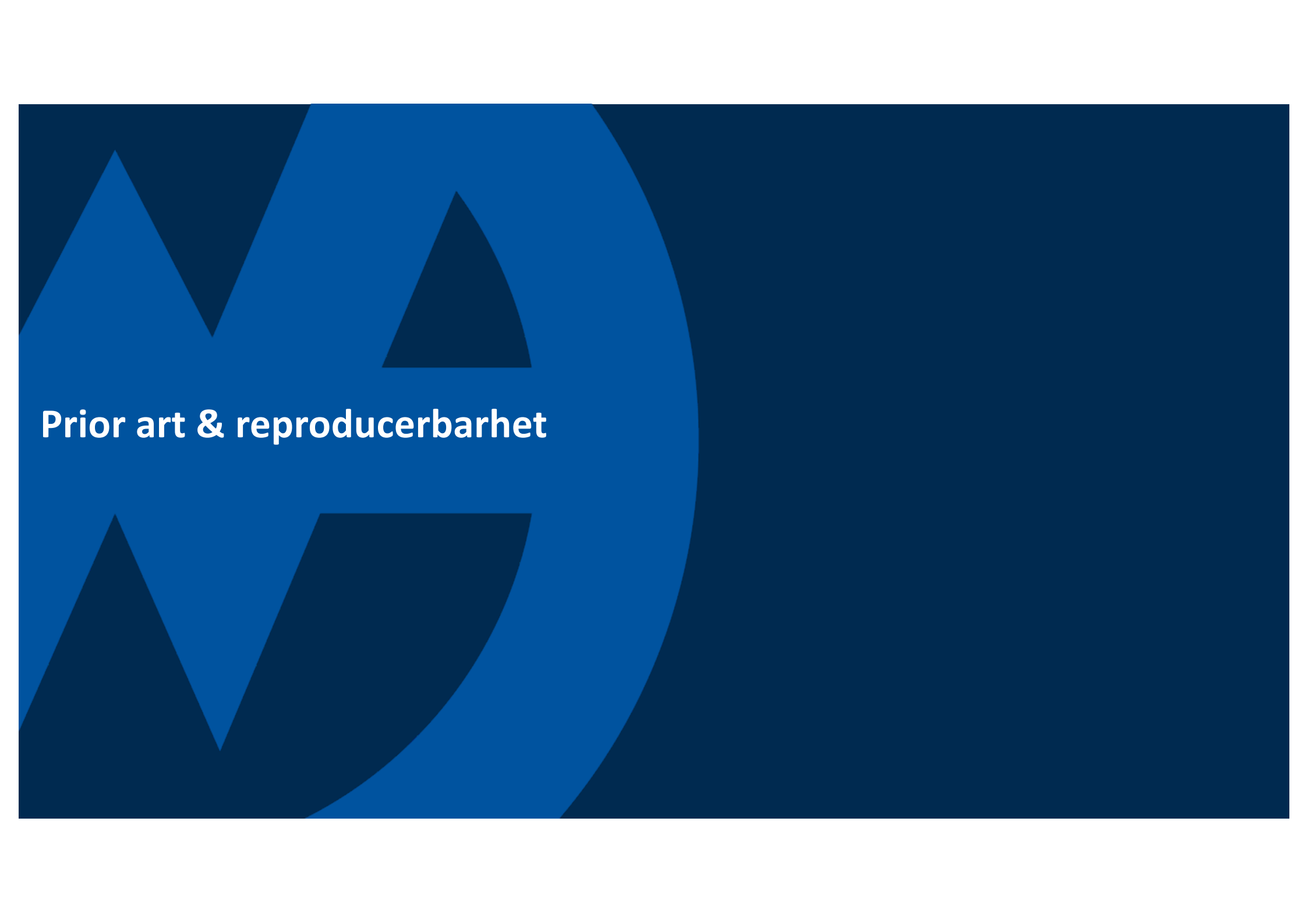
Beslut från EPO 2025

Mattias Pierrou



Innehåll

- Prior art & reproducerbarhet
 - G 1/23
 - T 1719/21
 - T 1044/23
- Beskrivningens betydelse vid kravtolkning
 - G 1/24
 - T 2027/23
 - T 1465/23
 - G 1/25 (pending) – anpassning av beskrivningen
- *Broken technical chain*
 - T 1468/21
- Kombination av 3 dokument
 - T 412/23
- Prioritet & Art 54(5)
 - T 883/23
- *Could/Would*
 - T 1109/24



Prior art & reproducerbarhet

Prior art & reproducerbarhet

- I G 1/92 (december 1992) förklarade EBOA att den kemiska sammansättningen av en produkt utgör känd teknik när produkten i sig är allmänt tillgänglig och kan analyseras och reproduceras av fackmannen, oberoende av huruvida det finns anledning till sådan analys.
- Frågan nu till EBOA identifierade två olika tolkningar av G 1/92:
 - Om sammansättningen (och därmed produkten) inte kan reproduceras,
 - i. så utgör inte produkten i dess helhet känd teknik, eller
 - ii. så är det bara produktens sammansättning som inte utgör känd teknik, medan produkten i sig och dess reproducerbara egenskaper gör det.
- G 1/23 omprövar (förtydligar/tolkar) frågan om reproducerbarheten.

G 1/23

The chemical composition of a product is part of the state of the art when the product as such is available to the public and can be analysed by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition.
(r. 73)

Den korrekta tolkningen av G 1/92

(available to the public betyder att produkten är “reproducerbar”)



G 1/23

I. A product put on the market before the date of filing of a European patent application **cannot be excluded from the state of the art** within the meaning of Article 54(2) EPC **for the sole reason that its composition or internal structure could not be analysed and reproduced** by the skilled person before that date.

II. Technical information about such a product which was made available to the public before the filing date forms part of the state of the art within the meaning of Article 54(2) EPC, **irrespective of whether the skilled person could analyse and reproduce the product and its composition or internal structure before that date.**

In this context, the term “reproduce” does not encompass the obtaining of the product in that form as put on the market



T 1719/21 – Ikke reproducerbar produkt som CPA

It cannot be taken from the reasoning of the Enlarged Board in G 1/23 that where a modification of a non-reproducible but commercially available product as such is necessary, then the non-reproducible product does not form the closest prior art. **What needs to be modified is part of the inventive thinking** of the skilled person in order to solve the problem addressed, **but not a consideration concerning the selection of that starting point.**

(hn)

T 1044/23 – Ikke reproducerbar produkt som CPA

Decision G 0001/23 does not exclude that a non reproducible product be selected as the closest prior art. Instead the specific circumstances of the case should be analysed.



T 1044/23 – Ikke reproducerbar produkt som CPA

The extent to which a non-reproducible product must be modified to obtain the claimed subject-matter, and the level of knowledge about that product and its manufacture required to achieve it, **are not yet relevant for determining whether the product can be regarded as the closest prior art. These aspects instead relate to later stages of the problem-solution approach**, namely identifying the distinguishing features between the product and the claimed subject-matter and/or assessing whether the skilled person, starting from that product, would have been able to obtain the claimed one.

Prior art & reproducerbarhet - Slutsats

- En produkt som finns tillgänglig på marknaden tillhör känd teknik oberoende av huruvida den kan "reproduceras" eller analyseras.
- En sådan produkt kan även utgöra närmast liggande känd teknik. Att produkten inte kan "reproduceras" måste dock tas hänsyn till vid *problem solution*-resonemanget.



Beskrivningens betydelse

G 1/24

Ska Art. 69(1), andra meningen, och Protokollet tillämpas för tolkning av kraven vid bedömning av patenterbarhet?

G 1/24

The Enlarged Board considers that neither Article 69 EPC and Article 1 of the Protocol, nor Article 84 EPC are entirely satisfactory as a basis for claim interpretation when assessing patentability. (r. 6)

- Art. 69 och Protokollet avser endast intrångsbedömningar vid nationell domstol eller UPC.
- Art. 84 avser ansökans innehåll och ger ingen vägledning för tolkning av kraven, utan anger bara vad som ska finnas i kraven.

G 1/24

The Enlarged Board thus considers that there is no clear legal basis, in terms of an article of the EPC, for claim interpretation when assessing patentability. (r.9)

[W]hat the Boards of Appeal have done is apply the wording of these articles in an analogous way to the examination of patentability under Articles 52 to 57 EPC. There is thus an existing body of case law from which the applicable principles of claim interpretation can be extracted. (r.10)

G 1/24

From this case law the following principles of claim interpretation can be extracted:

- 1) The claims are the starting point and the basis for assessing the patentability of an invention under Articles 52 to 57 EPC.
- 2) The description and any drawings are always referred to when interpreting the claims, and not just in the case of unclarity or ambiguity.

G 1/24

Första punkten, att kraven ska vara utgångspunkten och grunden för bedömning av patenterbarhet, är okontroversiell.

För andra punkten, att man alltid ska gå till (*refer to / consult*) beskrivning och ritningar vid tolkning av kraven, finns det divergerande case law.

EBOA avfärdar nu den tidigare case law som säger att man bara ska gå till beskrivning och ritningar om kravet är oklart eller tvetydigt, eftersom det går emot principerna enligt Art. 69 och praxis i nationell domstol och UPC.

G 1/24

The claims are the starting point and the basis for assessing the patentability of an invention under Articles 52 to 57 EPC. **The description and drawings shall always be consulted** to interpret the claims when assessing the patentability of an invention under Articles 52 to 57 EPC, and not only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation.

T 2027/23 – Tolkning av G 1/24

A claim should not be interpreted, based on features set out in embodiments of an invention, as having a meaning *narrower* than the wording of the claim as understood by the person skilled in the art. In cases of discrepancy between the claim language and the description, it falls upon the patentee to remedy this incongruence by amending the claim. It is not the task of the Boards of Appeal to reach such alignment by way of interpretative somersaults. (hn)



T 2027/23 – Tolkning av G 1/24

From decision **G 1/24**, the board can identify three major takeaways:

- First, **the wording of the claims forms the "basis"** for their interpretation **and**, for the purpose of interpreting the claims, **the description and the drawings should always be "consulted" or "referred to"**. G 1/24 is, however, silent as to the very purpose of such "consultation" or "reference".
- Second, **discrepancies** in claim interpretation practice **between national courts, the UPC and the Boards of Appeal are undesirable and should thus be avoided**. 
- Third, it is up to a patentee to remedy discrepancies between the description and the claims. In other words, **patentees are the masters of their fate**.

T 2027/23 – Tolkning av G 1/24

- The board finds no authority for interpreting a claim more narrowly than the wording of the claim as understood by the person skilled in the art would allow.
- First, because "consulting the description" does not imply any specific result of such consultation. /.../ [According to] **G 1/24**, *"the claims are the starting point and the basis for assessing the patentability of an invention"*, and **the present board would like to add that, in line with UPC_CoA_335/2023, second headnote, the claims are the "decisive basis".**
- Second, such interpretation would **contradict the well-established jurisprudence** of the Boards of Appeal.



T 2027/23 – Tolkning av G 1/24

Third, such an interpretation **would directly contradict** the second takeaway from decision **G 1/24**, namely **a harmonised claim interpretation between national courts or the UPC and the Boards of Appeal**. For a long time, it has been considered unsatisfactory that patentees could get away with different claim interpretations for validity, on the one hand, and for infringement on the other.

T 1465/23 – Tillämpning av G 1/24

For the purposes of claim construction regarding claim 1 as granted, the board, in accordance with the finding of the Enlarged Board of Appeal in **G 1/24**, has "consulted" and "referred to" the present patent description and drawings **to define the skilled reader** from whose perspective or view point a claim is to be interpreted.

(r.2.4)



T 1465/23 – Tillämpning av G 1/24

In the relevant technical field, terms relating to communication protocols have typically a stable and well-understood meaning. Therefore, /.../ **these terms are not to be re-interpreted** or understood in a more limited way in the light of the specific embodiments of the patent description...

G 1/25 (pending) – Anpassning av beskrivningen?

- 1. If the claims of a European patent are amended during opposition proceedings or opposition-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent, **is it necessary**, to comply with the requirements of the EPC, **to adapt the description to the amended claims** so as to remove the inconsistency?
- 2. If the first question is answered in the affirmative, **which requirement(s) of the EPC necessitate(s) such an adaptation?**
- 3. Would the answer to questions 1 and 2 be different if the claims of a European patent **application** are amended during examination proceedings or examination-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent application?



Technical Boards of Appeal

T 1468/21 – *Broken technical chain*

- Principen *the broken technical chain fallacy* (etablerad i tex. T 1670/07) innebär att uppfinningshöjd normalt saknas om den tekniska effekten hos en metod är beroende av användarens beslut eller input. Den tekniska kedjan från särdrag till effekt blir därmed bruten.
- Här konstateras dock att detta inte är fallet, eftersom användaren endast matar in objektiv information (öppningskod för en paketbox) utan att utföra något subjektivt val eller någon mental aktivitet.
- Det faktum att processen måhända stoppas om användaren inte matar in koden, eller matar in fel kod, ska inte ses som en *broken technical chain* eftersom detta inte utgör någon bruten teknisk kedja på grund av användarens subjektiva ingrepp, utan snarare som en felaktig användning av systemet.

T 412/23 – Kombination av 3 dokument

When the teachings of three documents are combined, this has to be **done** - in circumstances such as the present ones - **step by step**, i.e. in a first step, the teaching of another document is combined on the basis of the teaching or embodiment of the closest state of the art. In a second step, it must then be examined whether the skilled person would also combine the result of this combination with the teaching of the third document. In doing so, the context of the initial situation as well as the complexity and specific technical context of each document or embodiment has to be taken into account. (r. 2.5.9)

T 883/23 – G 2/98 & A 54(5)

- Patentet avsåg *liposomal irinotecan* för behandling av cancer, varvid *liposomal irinotecan* administreras i kombination med oxaliplatin i angivna mängder.
- BOA kom fram till att prioritetsdokumentet inte visade den specifika kombinationen som en del av en effektiv och tolererbar kombinationsbehandling. Detta trots att den specifika kombinationen fanns omnämnd i prioritetsdokumentet, men bara som ett förslag till doseskaleringsstudier (och där endast som en lägsta dos vid de-eskalering för det fall att högre doser inte tolererades).
- Valet av just den lägsta doskombinationen (enligt patentet) för effektiv och tolererbar behandling innebar därför att ny information tillförts som inte framgick av prioritetsdokumentet.



T 883/23 – G 2/98 & A 54(5)

The Enlarged Board of Appeal determined in G 2/98 that it is a condition for the compliance with the requirement of "the same invention" that the claimed subject-matter is directly and unambiguously derivable from the earlier application. However, the Enlarged Board did not conclude that the requirement of "the same invention" is necessarily satisfied if this condition is fulfilled, irrespective of any technical information associated with the claimed subject-matter, which is only described in the subsequent patent application.

(hn: r. 1.5)



T 1109/24 – Could/Would

- Vid bedömning av uppfinningshöjd resoneras ofta kring vad fackmannen *hade kunnat göra* (could) och *skulle göra* (would).
- För att fackmannen *skulle göra* (would) något, är det en förutsättning att det *hade kunnat göras* (could).
- Ofta är *could*-frågan sådan att det inte krävs någon större motivering, om ens någon. Men *could*-frågan kan inte bortses ifrån när det saknas uppenbar, realistisk väg från utgångspunkten till den patentsökta uppfinningen.
- Detta är fallet om de kännetecknande särdragen inte rimligen kan kombineras med närmast liggande känd teknik så att den patentsökta uppfinningen erhålls. Då kan inte uppfinningen vara uppenbar i ljuset av närmast liggande känd teknik, och frågan om huruvida de kännetecknande särdragen ger någon teknisk effekt utöver känd teknik blir i grunden meningslös.

Läslista

- G 2/24
Status för en *intervener* vid appeal
- T 1561/23
Tolkning av G 1/24. Se r. 2.10.
- T 1849/23
Tolkning av G 1/24. Särdrag i krav breddat i ljuset av beskrivningen. Specialfall.
- T 1999/23
Tolkning av G 1/24. Avvikande definition av term i beskrivningen leder *inte* till snävare tolkning av kravet.



Några utdrag från G 1/23

G 1/23

[I]t remains that the requirement of reproducibility of the state of the art, the reproducibility excluding the mere obtaining of the product from the market or taking it from nature, leads to the result that no material in the physical world would belong to the state of the art. (r. 63)

In practice, a chemist as a skilled person would have to turn to readily available products much sooner, already before arriving at the lowest level of the raw materials. (r. 64)

G 1/23

The assumption that the skilled person would ignore non-reproducible products cannot hold. Rather, the opposite is true: the skilled person cannot achieve anything without non-reproducible, but otherwise available products. /.../ Readily available products cannot be excluded from the common general knowledge of the skilled person, hence also not from the state of the art within the meaning of Article 54(2) EPC. (r. 67)

Första tolkningen av G 1/92 avfärdas.

G 1/23

[A]ll the starting materials used by the skilled person must be selected on the basis of their desired properties, which in turn are determined by the composition of the material. /.../ Its composition must be known and consciously exploited by the skilled person, even where they would not be able to reproduce the composition by a different route. The non-reproducible property, the composition, cannot be ignored or disregarded, or else there will be no material left for the skilled person to work with. (r. 70)

Andra tolkningen av G 1/92 avfärdas.

G 1/23

The contradictions of an enablement requirement set up by G 1/92 disappear if the condition of reproducibility in the answer of G 1/92 can be interpreted as **including the obtaining of the product from the market in its readily available form**. Put differently, the expected reproducibility of the product must be understood in a broader sense, namely as the **ability of the skilled person to obtain and possess the physical product**. This would mean that the requirement would be **inherently fulfilled by a product put on the market...** (r.73)

Tack



Learn more about us:

awa.com



Follow our updates on LinkedIn:

[AWA](#)



Stay up to date on IP news:

awapoint.com

