

Patents

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Patents

Decision of the Enlarged Board of Appeal dated 23 March 2023 - G 2/21 (Reliance on a purported technical effect for inventive step (plausibility))

This decision concerns mainly the allowability of submitting evidence after the priority date of an EP-application for proving the invention effect.

1. The Order issued by the Enlarged Board of Appeal comprises two items:
(1) Evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for lack of inventive step of the claimed subject-matter may **not** be disregarded **solely** on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date.

(2) A patent applicant or proprietor may rely upon a **technical effect for inventive step** if the skilled person, having the common general knowledge in mind, and **based on the application as originally filed**, would derive said effect **as being encompassed by the technical teaching and embodied by the same originally disclosed invention**.

2. With respect to item (1) of the Order:

It means that an evidence for proving the technical effect will have to be accepted even if it

- had not been public before the filing date, and
- was filed later the filing date.

3. With respect to item (2) of the Order:

After having taken into consideration the three lines of case law ("*ab initio plausibility*", "*ab initio implausibility*" and "*no plausibility*"), the Enlarged Board of Appeal pronounces under item (2) of the Order that the technical effect is supposed to be

- (a) derivable (from the application and the common general knowledge)
- (b) as being encompassed by the technical teaching, and
- (c) embodied by the same originally disclosed invention.

The Enlarged Board of Appeal held that these guiding principles would allow the competent board of appeal or other deciding body to take a decision on whether or not post-published evidence may or may not be relied upon in support of an asserted technical effect when assessing whether or not the claimed subject-matter involves an inventive step.

TBK's Remarks: The applicant should be allowed to post-file evidence, e.g. including effect tests for sufficient number of other different values over the range in order to rely on this effect when formulating the problem solved by the invention for the purpose of the "problem-solution-approach" and thus, for proving inventive step.

Decision made on questions concerning assessment of entitlement to priority

On October 10, 2023, the Enlarged Board issued its long-awaited decision in consolidated cases G 1/22 and G 2/22 relating to the questions of entitlement to priority.

First question

Is the EPO competent to assess a party's entitlement to claim priority?

Second question

In a situation where inventors file a US patent application which is then used as a priority application for a later PCT application, in which the inventors (A) are named as applicants for the US only, whereas persons other than the inventors (B) are named as applicants for Europe, can the co-applicant (B) of a PCT application who is different from the inventors (A) named in the US priority application validly rely on the priority right under Article 87(1) EPC in the European phase?

Conclusion on the first question

Yes, the EPO is competent to assess whether a party is entitled to claim priority under Article 87(1) EPC, and there is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with the formal requirements (i.e. Article 88(1) EPC and the corresponding Implementing Regulations) is entitled to claim priority.

Conclusion on the second question

Yes, the above rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s).

In the above situation, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary.

TBK's remarks: It was a significant decision in the sense that the EPO's rather lenient position on this aspect is finally clarified. In particular, it is noteworthy that the Enlarged Board endorsed the interpretation of the joint filing of a PCT application as sufficient proof for an implied agreement on the joint use of the priority right, unless there were substantial indications to the contrary.

Abolition of EPO "10-day rule"

Amendments to Rules 126(2), 127(2) and 131(2) EPC, which will enter into force on **November 1, 2023**, introduce a new notification fiction for documents* served by postal services or electronic means. (*which the EPO is obliged to notify *ex officio* in accordance with Article 119 EPC)

Under the new rules, documents sent by the EPO on or after November 1, 2023, will be deemed to be delivered on the **date printed on the document**, instead of ten days after that date. Accordingly, deadlines will be calculated from the date of the document.

In case of notification irregularities, it will be up to the EPO to prove that a document was delivered and when, if a user indicates that a document was not received at all or was received exceptionally late.

If the EPO is unable to prove that a document has been delivered, the notification fiction will not apply, and a period linked to that document will not be considered to have started. The document in question will be reissued with a new date, resulting in the application of the notification fiction based on that later date.

If the EPO cannot show that a document reached the addressee within seven days of the date it bears, a period triggered by the deemed receipt of that document will be extended by the number of days by which these seven days are exceeded.

Right of prior use in case of modification of a pre-used object

In decision X ZR 61/21, the higher court of justice remitted an infringement case (of a utility model) to the higher regional court because the higher regional court

did not assess whether a modification of a prior used invention was covered by a prior use right.

According to section 12 of the German Patent Act, patents have no effect in respect of a person who, at the time the application was filed, had already begun to use the invention in Germany or had made the necessary arrangements for so doing. This also applies to utility models equivalently.

In the present case however, the circumstances were more complex in that the defendant had prior use of an invention, i.e. a product falling under an originally registered independent claim, which was later restricted with additional features. In addition, the invention used by the defendant was modified after the date of registration of the utility model such that the defendant's modified product also fell under the later restricted claim of the utility model. Therefore, the higher regional court did not grant a prior use right according to section 12 of the Patent Act because the prior used invention did not fall under the restricted claim.

However, the higher regional court stated that the protection of the prior user cannot be undermined by a subsequent restriction of the property right. Even though, prior use of subject-matter falling under an originally granted independent claim cannot cover prior use for every possible modification, a later restriction of a claim cannot eliminate a prior use right under two conditions:

- if the modification was obvious to the person skilled in the art, who was in possession of the invention, or
- if the modification is not connected to an additional advantage pointed out in the patent or utility model.

If one of these two conditions is met, prior use right also covers modifications of a prior used invention and furthermore, it is irrelevant under what circumstances or why a patent or utility model was further restricted.

Appeal proceedings: consideration of amendments despite the absence of exceptional circumstances

The European Patent Office's Board of Appeal clarifies how they intend to apply Article 13(2) RPBA 2020 by adopting a more flexible approach regarding admitting amendments and requests during appeal proceedings.

The Facts of the Case

The application was about a broadband patch antenna. The Board in its preliminary opinion raised an objection of added subject-matter against Claim 1. During oral proceedings, the Board objected to various requests by the appellant. The appellant made amendments deleting features from claim 1. After noticing that the deletion of the same feature had been overlooked in claim 12, the appellant again made amendments to correct that oversight.

The Decision of the Board

The basic rule is that amendments are not considered unless there are exceptional circumstances justified by cogent reasons (by the submitting party). The leeway for deviating from this rule lies in the expression "in principle," which the Board understood roughly as "as a rule," meaning that the provision's basic rule was not entirely without exception. The Board understood that wording as laying down a basic rule but leaving some limited leeway for exceptions. In this decision, the Board clarifies its position by ruling that this leeway, when applied, meant that **an amendment can be considered despite the absence of exceptional circumstances justified by cogent reasons.**

Combination of features from two lists - Gold standard

Summary

The Board of Appeal in T 1133/21 decided on May 26, 2023, that the mere fact that features are described in the application as filed in terms of lists of more or less converging alternatives does not give the proprietor a "*carte blanche*" for freely combining features selected from a first list with features selected from a second list disclosed in the application as filed.

Respondent's position

The respondent argued that the amended claim 1, which requires multiple selections to arrive at the claimed subject-matter starting from claim 1 as originally filed, is nonetheless admissible because the teaching of the application as filed taught toward the claimed combination of features.

In particular, it was argued that selecting a preferred range from a list of converging alternative ranges was to be treated as a mere restriction of an already disclosed range and not an arbitrary selection. Since, in accordance with T 1621/16, the selection of a more or less preferred range from a list of converging alternative ranges was to be treated as a mere restriction of an already disclosed range and not an arbitrary selection, claim 1 could not contain added subject-matter.

Board's position

The board argued that decision T 1621/16 does not provide for an exception to the gold standard. It requires, in fact, that a claim amended on the basis of multiple selections from lists of converging alternatives may only be considered to meet the requirements of Article 123(2) EPC if the application as filed includes a pointer to the combination of features resulting from the multiple selections.

The assessment of whether an amendment meets the gold standard depends on several factors, and is to be decided on a case-by-case basis. Factors which may play a role in the assessment are, inter-alia, the number of alternatives disclosed in the application; the length, convergence and any preference in the lists of enumerated features; and the presence of examples pointing to a combination of features. For instance, if the values in a number of examples are clustered within specific ranges, this may provide a pointer to those ranges.

TBK's remarks: This decision sets a more stringent standard as regards the "*two-list principle*". In particular, the applicant should take care when amending claims, insofar as the mere argument that the selection derives from a convergent list is not considered sufficient, and further pointer might be necessary to establish the

admissibility of such amendments, in order to consider the amendment “*directly and unambiguously disclosed*” in the sense of Article 123(2) EPC.

Designs

Invalidity action against RCD – visibility of “inside” consumable parts

In case T-617/21, an application for a declaration of invalidity of a registered community design (RCD) directed towards an Electrode was rejected. The defended community design is special in that it is directed to only the Electrode. In Figure 1, the Electrode, a cartridge, in which the Electrode is to be placed, and a torch for plasma cutting, on which the cartridge is to be mounted, are illustrated.

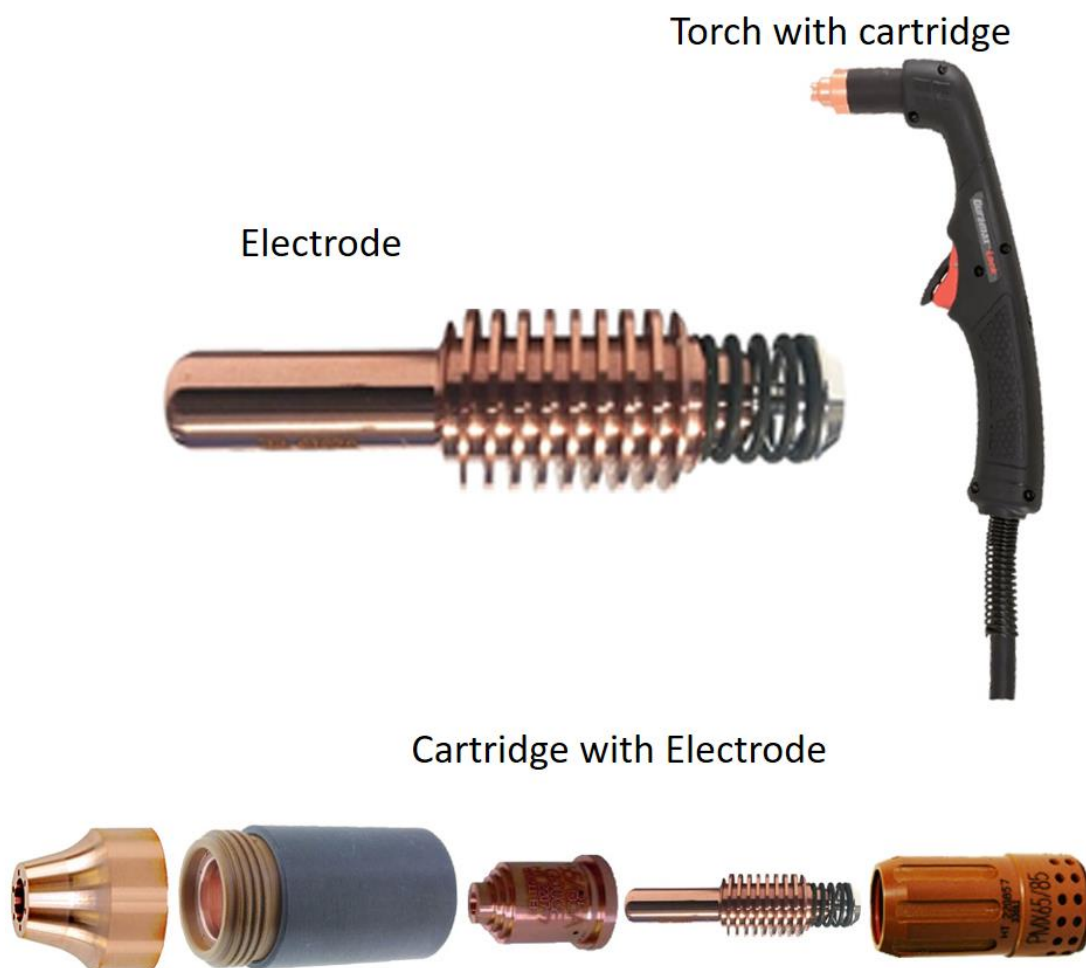


Figure 1

In this regard, it is also important that the Electrode has a lifespan of approximately four to six hours of usage and typically, a user using the torch replaces the Electrode himself.

In addition, the Electrode, when being placed in the cartridge, is not visible.

Therefore, the applicant for declaration of invalidity argued that the Electrode would be part of a complex product (the plasma cutting system) and would not be visible during normal use of that product. According Art. 4(2) of Regulation No 6/2002, a design applied to product, which constitutes a component part of a complex product, needs to fulfill the following two criteria:

- a. the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
- b. to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character

Considering that during use of the torch, the Electrode itself is not visible, this judgment comprises two interesting decisions.

1. Regarding visibility, the board stated that "owing, in particular, to the consumable nature of the Electrode at issue, the end user, who regularly purchases and replaces Electrodes, is able to perceive and assess its characteristics, irrespective of whether the Electrode remains visible once inserted into the torch."

That is, a consumable part of a product, which is not visible during normal usage of the product may be considered visible, anyway, if a user would perform actions with the consumable itself during normal usage, e.g. replacing and/or purchasing the consumable on a regular basis.

2. Regarding classifying the Electrode as a component part of a complex product, it was decided that the Electrode is a stand-alone product. That is, the criteria of Art. 4(2) of Regulation No 6/2002 do not need to be fulfilled.

In more detail, the Court of Justice has defined the concept of 'component part of a complex product' as covering multiple components, intended to be assembled into a complex industrial or handicraft item, which can be replaced permitting disassembly and re-assembly of such an item, without which the complex product could not be subject to normal use.

Reasons for not classifying the Electrode as a component part of a complex product are:

- When the Electrode is replaced, the cutting system and the torch are not disassembled and re-assembled, i.e. the Electrode may be changed without unmounting other components of the torch.
- The Electrode and the torch are commonly advertised and sold separately and different Electrodes and torches may be interchanged. Thus, the Electrode and the torch represent separate (stand-alone) products instead of a complex product, of which the Electrode is only a component part.

For the reasons summarized above, the community design was maintained. Hence, this decision is a great example that also parts, which are typically used in combination with a more complex device may be protected through designs even though such parts would not even be visible during usage of the more complex product. Especially if additional actions, in which the normally not visible parts become visible have to be performed for ensuring a long-term usage, such parts may be protected through registered designs. Such additional actions could for example be buying and replacing or cleaning said parts.

Alternatively, if a consumable part could be used with multiple products e.g. of different product lines, this may also be a strong argument why the consumable part should not be classified as a component part of a complex product.

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