
This report covers recently published decisions of interest from the Boards of Appeal of the European Patent Office. It is one of a series of reports that Bristows produces regularly for publication in the CIPA Journal. This report has been published in the July 2009 issue of the CIPA Journal and includes decisions of the Technical Boards of Appeal on divisionals, inventive step, sufficiency and amendment, and a decision from the EBA on EPO procedure.

EPO DECISIONS

Notes:


Divisionals (Rule 25 EPC 1973, Rule 36(1) EPC 2000)

**J 0002/08: Device Diagnostics / Sony Deutschland GmbH**

LBA Decision of 27 May 2009

Chairman: B. Gunzel
Members: T. Bokor and S. Hoffmann

This situation arose from an interesting set of circumstances. The divisional was filed in the period between the parent application being refused by the Examining Division and the deadline for the patentee to appeal that decision. The patentee discussed the possibility of filing a divisional with the members of the Examining Division immediately after the oral proceedings, and they had agreed to the patentee’s request that they send out the written decision sufficiently late for the patentee to prepare its divisional application. The divisional was then filed before the written decision was circulated. However, when no appeal of the decision on the parent application was filed within the prescribed time period, the Receiving Section informed the patentee that the divisional would not be processed.

As EPC 1973 was in operation at the relevant time, the LBA was faced with the task of deciding whether the intended parent application was “pending” for the purposes of Rule 23(1) EPC 1973 in these circumstances. Pointing to an EPO Notice (OJ EPO 2002, 112) and G 12/91, the Receiving Section had considered it was “beyond any doubt” this was not the case.

The patentee, on the other hand, argued with reference to amongst other things procedural practice in other jurisdictions that, notwithstanding the fact it had not filed an appeal, the parent application was still pending at the relevant time. If the LBA would not set the decision aside, the patentee requested that several questions on when applications can be treated as pending be referred to the EBA, and even went so far as to request the Board suggest to the EPO President that she use her
powers under Article 10(2)(c) EPC to propose appropriate amendments to the EPC to clarify matters.

After a comprehensive consideration of the issues, the LBA concluded that a question should be referred, albeit it considered the questions proposed by the patentee not to be relevant. Instead, it decided to refer the following question:

"Is an application which has been refused by a decision of the Examining Division thereafter still pending within the meaning of rule 25 of the EPC 1973 (rule 36(1) of the EPC 2000) until the expiry of the time limit for filing a notice of appeal, when no appeal has been filed?"

In doing so, the LBA noted that the EPC does not provide an answer to this question, and suggested that the German and French equivalents of the term "pending" referred to provided no further guidance. It considered that determination of the time point up to which divisionals can be filed was a point of law of fundamental importance, justifying the referral.

Whist important, this is probably not a situation that will arise very often, with some commentators (on IPKat for example) posing the question as to why the applicant had not hedged its bets by filing a divisional application shortly before the hearing on the parent application took place.

**Inventive Step**
(Article 56 EPC)

**T 0738/04: Circuit and its method of operation / Microchip technology Inc.**

TBA Decision of 11 December 2008

Chairman: B. Schachenmann
Members: P. Fontenay, G. Assi, F. Neumann and K. Garnett

This is a decision of the TBA in respect of an appeal from the Opposition Division rejecting the appellant’s opposition because, inter alia, it had not provided sufficient evidence that prior art D6 relied upon against inventive step had been made available to the public before the priority date of the patent in suit. On appeal, the appellant/opponent filed new prior art D10 in order to further prove lack of inventive step.

The Board’s decision is a clear illustration of the stringent burden of proof required at the EPO when it comes to availability to the public. Following oral proceedings in which evidence was taken from a witness under Rule 72(1) EPC 1973 the TBA failed to be convinced that new evidence D10 (admissible by virtue of the failure of the argument relying on D6 during Opposition) had been publicly available. In its view, "absolute conviction" is required, or proof “up to the hilt” (T 472/92) rather than mere balance of probabilities. The high burden reflected the factual asymmetry resulting from the opponent having unilateral access to the available evidence. Here, the fact that D10 was demonstrably a draft document raised a fatal doubt as to whether it was circulated (cf T 202/97). The TBA also concurred with the Opposition Division in its analysis of the availability of D6. With both D6 and D10 unavailable, the challenge to inventive step failed. The Board commented that an opponent should, from the outset of opposition proceedings, identify the prior art which has the highest chance of success, including the prospects for proving public availability.

Having also dismissed the appellant’s case regarding lack of sufficiency, the Board dismissed the appeal and the patent was maintained in its granted form.

**Sufficiency of disclosure (Article 83 EPC)**

**T 0608/07: Polymerisation process / Ineos Europe Limited**

This decision of the TBA highlights the care that needs to be taken where an insufficiency objection arises out of an ambiguity.
The patent was revoked by the Opposition Division on the ground of insufficiency (Article 83 EPC), on the basis that in order for the skilled person to work the invention over the whole scope of the claims it was necessary to know what was meant by a particular integer that the Division had held to be ambiguous.

On appeal, the TBA accepted indirect evidence from documents submitted by the patentee as to how the allegedly ambiguous term would have been understood by the person skilled in the art. The context of the general knowledge enabled the person skilled in the art to arrive at and/or identify the claimed process, and on this basis the Board held that the patent as granted was sufficient in enabling the skilled person to work the invention over the whole of the scope of the claims.

Furthermore, the Board made some general comments on the issue of alleged insufficiency arising through ambiguity. Although an ambiguity might lead to an insufficiency objection, it had to be borne in mind that ambiguity of the kind identified in the present case, and in the case of T 256/87 on which the opponent relied, also relates to the scope of the claims under Article 84 EPC. However, Article 84 is not itself a ground of opposition and therefore care had to be taken to ensure that an insufficiency objection arising out of an ambiguity was not merely a hidden objection under Article 84. For insufficiency arising out of ambiguity, it was not enough (according to the Board) to show that an ambiguity exists, for example at the edge of the claims. Instead, it will normally be necessary to show that the ambiguity deprived the person skilled in the art of the promise of the invention. In the present case, the opponent had not shown that the ambiguity permeated the whole claim or was associated with an undue burden; merely that it was significant at the edges of the claim (decision of the High Court of England and Wales in Zipfer Ltd v Markem Systems Ltd [2008] EWHC 1379 was cited with approval).

Rather than remit the patent back to the Opposition Division for further consideration of the opponent’s grounds of lack of novelty and inventive step, the TBA made use of the discretion given it to it by Article 111(1) EPC to further examine the case. The reasons for exercising the discretion were that the opponent’s objections had been on file for over a year and the patentee had not commented on those objections, nor on the opponent’s request for a final decision by the TBA. The patent was held to be novel, but the main and auxiliary requests were all held to lack inventive step.

Here, the TBA refused an appeal against a decision of the Examining Division to reject a patent application on the basis that it was not sufficiently disclosed. The main claim was to the use of compounds which could stimulate the soluble guanylate cyclase enzyme independently of the heme group present in its structure for the production of medicaments for the treatment of cardiovascular disorders. Compounds known from the prior art stimulated soluble guanylate cyclise through a heme-dependent route.

The applicant argued that the broad claim language was justified in the light of the special contribution made by the patent to the state of the art. The applicant also argued in relation to sufficiency that the application set out in detail how to test any compound for the particular functional feature. The applicant asserted that the tests were simple and quick and would not be an undue burden on the skilled person.

The TBA held that the claim to chemical compounds defined by reference to a function was a ‘reach-through’ claim. The claim covered all compounds with that function including compounds that had not been structurally defined at the priority date and thus it also covered future inventions. It stated that a definition of a chemical compound based purely on its functional features can only be allowed in the exceptional cases where the invention cannot otherwise be defined more precisely without unreasonably restricting the scope of the technical contribution.
In the TBA’s view, an applicant is only entitled to protection for his actual contribution to the state of the art. Limitation of the claimed subject matter to the actual invention disclosed in the application was not only reasonable but required. Patent protection is not designed to reserve for the applicant an undeveloped research field but serves to protect actual results of successful research work as a reward for concrete technical results being made available to the public.

The TBA confirmed that the requirement of sufficiency is only fulfilled where the claimed invention can be carried out by the skilled person without undue burden across the entire breadth of the claims (T 409/91 and T 435/91). The test set out in the application allowed the skilled person to establish the absence or presence of the functional feature, but it gave him no guidance as to how to select the applicable chemical compounds. In the absence of any direction on how the compounds should be chosen from an unlimited stock of possible compounds, the skilled person would be required to use trial and error to test randomly selected chemical compounds for the particular function. This would amount to a research program and thus to an undue burden (T 435/91). The application did not therefore fulfil the requirements of Article 83 EPC.

Amendment (Article 123(1) EPC), including during examination (Article 94(3) EPC)

T 2321/08: Apparatus and method for transmitting / receiving signal in a communication system / Samsung Electronics Co. Ltd.

TBA Decision of 11 May 2009

Chairman: M. Ruggiu
Members: J.-M. Cannard and P. Mühlens

In this appeal, the TBA explored the meaning of Rule 42(1)(b) (content of the description) and the applicant’s right to amend the specification at the examination stage under Art 94(3). The decision confirms that an applicant is not required to cite in the description of the specification all prior art known to it at the time the application is filed.

The point arose because the Examining Division had rejected the application in question because the applicant had not cited a particular prior art document of which it was aware. Furthermore, it refused to allow the applicant an opportunity to amend the specification to make good an alleged defect. The TBA noted that the relevant rule – Rule 27(1)(b) EPC 1973 (which applied because the application was filed before the entry into force of EPC 2000), identical to Rule 42(1)(b) in all significant respects – gave applicants a discretion to cite relevant prior art. Despite the more restrictive wording of the German language version of the rule, the TBA confirmed that it merely recommended, not mandated, the inclusion of such citations in the description as originally filed.

On this basis alone, the Examining Division had been wrong to reject the application. Additionally, the Examining Division erred further by refusing to allow the applicant an opportunity to amend the specification to make good an alleged defect. The TBA pointed to the general principle in the case law of the Boards of Appeal, and G1/05 in particular, that failure to meet the requirements of the EPC can be cured by amendments during examination, pursuant to Art 94(3), in conjunction with Art 123(1), which requires that an applicant must be given at least one opportunity to amend.

The TBA therefore remitted the application back to the Examining Division to resume prosecution and refunded the appeal fee on the basis that a substantial procedural violation had occurred.

EPO Procedure
This is another decision on a petition under Rule 112a EPC which has been rejected by the EBA. The EBA agreed with the reasoning of the Technical Board whose decision (T 0221/06 reported at the end of last year) was under consideration in the petition and the ruling serves to further underline the perils of making too many complicated claim requests in EPO proceedings.

In the appeal decision under consideration, the patentee’s grounds of appeal had requested the patent be maintained on the basis of the main request or one of 15 auxiliary ones. Furthermore, in addition to the usual sequential numbering of the claims, each claim was given a letter such that the claims were annotated 1A to 1G, 2A to 2E, 3A to 3C, 4A, 5A, 5B, 6A and 7A. These annotations were in a table entitled “Annex A – Claim Combinations and Requests” to show which claims went in which requests, and a further Annex B showed how the additional features of each claim compared with the main request. Additionally, the grounds of appeal included a statement that the patentee was ready to file further requests if the auxiliary requests filed were not acceptable.

Rejecting the patentee’s arguments that it had not been given the right to be heard and that not all of the claims had been considered, the EBA roundly rejected the petition. In doing so, it quoted the TBA’s ruling in T 0221/06 confirming that this sort of “pick and mix” approach was “doomed to failure”