

EPO Boards of Appeal – Selected topics

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Topics

- Internet disclosures (revisited...)
- Transfer of priority rights
- Purpose-limited product protection [Art. 54(5)]
- List of further decisions

Internet disclosures

In **T 545/08** (*ex parte*), the recent case law was confirmed. With respect to “beyond reasonable doubt” vs. “on the balance of probabilities” the following was noted.

While the above-described standards of proof clearly differ on a conceptual level, in most cases adhering to one or the other in judicial practice does not need to lead to divergent results if the standard of “balance of probabilities” is applied with some qualification.

Thus, the facts on which any finding of public availability is based must be established with a sufficient degree of certainty in order to convince the competent organ of the EPO in view of all the relevant evidence that they have indeed occurred. This holds true even if the determination is made on the basis of probabilities and not on the basis of absolute certainty (“beyond any reasonable doubt”).

Summary – Internet disclosures

- The level of proof required for determining date of public availability of an internet disclosure is the balance of probabilities (not “up to the hilt”).
- The balance of probabilities does not mean “more likely than not”.
- The principle of free evaluation of evidence is applied, meaning that each piece of evidence is given a weight according to its probative value.
- Far-going investigations and presentation of supporting evidence may be required.
- The EPO must be convinced that the alleged date of availability is correct.
- A generally reliable source can create a presumption of availability on a certain date (e.g. an established on-line newspaper mentioning a publication date or Wayback Machine showing an archive date).

Conclusions (mine...)

- Since the EPO must be convinced that the alleged publication date is correct...
 - ...it may be fairly easy to cast doubt over the date of availability when EPO cites an internet disclosure as prior art, particularly since the EPO cannot be expected to conduct comprehensive investigations.
 - ...it can become very difficult to prove date of availability for an Opponent, particularly since the Proprietor will do everything to tear down each piece of evidence.
- Note that proof up to the hilt may still be required in situations where the information relied on resides exclusively or primarily with (i.e. is under the control of) the party who makes the submission.

Transfer of the priority right

In **T 577/11**, the Board noted

For a claimed priority to be valid /.../ the applicant of a subsequent application claiming priority from an earlier application (priority application) who is not the person who filed the priority application must, when the subsequent application is filed, be that person's successor in title in respect of the priority application or of the right to claim priority. A succession in title that occurs after the filing date of the subsequent application is not sufficient /.../.

In **T 205/14**, it was concluded that

...the validity of [a transfer of right of priority] is a matter of national law. [The law of the state in which the subsequent filing was made is not relevant.]

-> Choice of law?

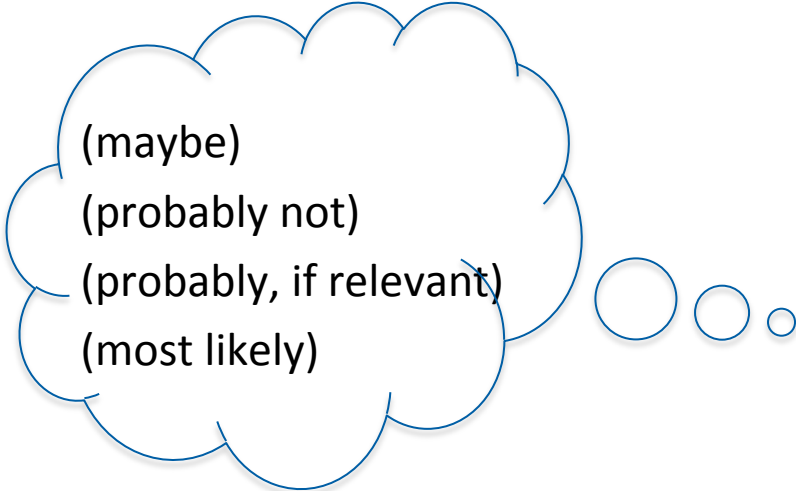
Transfer of the priority right

In **T 1201/14**, the standard of proof applied was “beyond reasonable doubt” because the information concerning a transfer of the priority right resided with one party only.

The Board reminded that retroactive transfers of the right of priority are typically not accepted under the EPC. The particular situation here (US style *nunc pro tunc* assignment) was not accepted either.

It was noted that the choice of law had not been established in the jurisprudence of the Boards of Appeal.

- *Lex originis*
- *Lex loci protectionis*
- *Lex loci contractus*
- *Lex domicilii*



(maybe)
(probably not)
(probably, if relevant)
(most likely)

My guess...

Substance or composition? [Art. 54(5)]

In **T 1758/15**, the claimed subject-matter could be novel only if it fulfilled the requirements for purpose-limited product protection under Art. 54(5).

Art. 54(5) can impart novelty only to substances or compositions. Since any material from which a device is made is in principle a "substance or composition", this cannot be what is meant by the article. A narrower interpretation is required.

The Board analysed G 5/83 (Swiss-type claims), and noted that a "substance or composition" is interpreted as being "the active agent or ingredient".

In the present case, the claimed subject-matter was a filler material for injection, in order to reduce radiation-induced side effects on sensitive organs.

Substance or composition? (cont.)

The Board noted that the technical effect is achieved by a mechanical displacement of the sensitive tissue relative to the target tissue. The mechanical displacement is achieved by the accumulated mass of the filler material between the two tissues, i.e. by the 3D macrostructure.

The accumulated mass of the filler material does not, however, qualify as a chemical entity or composition of chemical entities in the sense of G 5/83. Although made up of particular chemical molecules like collagen, which have some influence on the characteristics of the resulting mass, /.../ the effect is achieved by the macroscopic 3D form and the position of the mass. /.../ That the material has some indirect influence on the characteristics of the resulting solid structure does not make the material the active principle.

Further potentially interesting decisions

- T 1852/13 – Three-step essentiality test should not be used anymore (“gold standard”)
- T 971/11 – RPBA, Article 12(4) and admission of requests
- T 2129/14 – Reformatio in peius; sequential order of “escape route” in G 1/99
- T 1691/15 – Notification of all correspondence to all parties



Thank you!