



EPO update

The Federation continually engages with the European Patent Office (EPO) to provide input to consultations, on matters relating to implementing and on ancillary regulations to the European Patent Convention (EPC) and to procedures of the EPO. The Federation maintains ongoing working relationships with EPO representatives including meetings with the President and Directors throughout the year.

Notable Decisions of the Boards of Appeal of the EPO

T 1085/13

In decision T 1085/13, the board considered the novelty of a claimed compound, the claim stipulating it having a specified purity. Distinguishing T 990/96, the board found that a claim defining a compound having a certain purity lacks novelty over a prior art disclosure describing the same compound only if the prior art discloses the claimed purity (at least implicitly). For example, the prior art may disclose a method for preparing the compound that inevitably results in the purity as claimed. According to the board, such a claim does not lack novelty if the disclosure of the prior art needs to be supplemented, for example by suitable (further) purification methods allowing the skilled person to arrive at the claimed purity.

The question of whether such (further) purification methods for the prior art compound are within the common general knowledge of those skilled in the art and, if applied, would result in the claimed purity, is not relevant to novelty, but is rather a matter to be considered in the assessment of inventive step (reasons 3.7, 3.8).

T 1845/14

Decision T 1845/14 concerns an unclear parameter defined in a claim where required values of the parameter essential for solving a problem underlying the invention are indicated in the specification. The board found that the ability of the skilled person to solve that problem by reproducing what is claimed is not a suitable criterion for assessing sufficiency of disclosure when the problem (or an effect derivable from it) is not explicitly or implicitly part of the definition of the claimed subject matter (point 9.8 of the Reasons).

G 1/18

Enlarged Board opinion G 1/18 addressed the referral by the President of the EPO of questions regarding the admissibility of an appeal in cases of a failure to observe the two-month time limit under Article 108 EPC owing to belated payment of the appeal fee and/or belated filing of the notice of appeal. The motivation for the referral relates to the rules for refund of all or part of the appeal fee since there can be no reimbursement if an appeal is inadmissible (Rule 103(1) EPC), as distinct from the situation if the appeal is instead considered not to have been filed.

In its opinion G 1/18, the Enlarged Board takes the view that the consequence in law of a failure to observe the two-month time limit under Article 108 EPC is that the appeal is deemed not to have been filed, and not that it is to be rejected as inadmissible, and that accordingly, the appeal fee will be reimbursed in such cases. In so finding, the Enlarged Board has endorsed the prevailing view in the Boards' case law.

G 2/19

Enlarged Board decision G 2/19 relates to the right of a third party (within the meaning of Article 115 EPC) who has appealed against a decision to grant a European patent to be heard.

Further, the decision considers whether oral proceedings of the Boards of Appeal at their location in Haar infringes Articles 113(1) and 116(1) EPC.

The Enlarged Board confirmed that a third party within the meaning of Article 115 EPC is not entitled to appeal and has no right to be heard by a Board of Appeal. Further, the board confirmed that oral proceedings held in Haar do not infringe Articles 113 (1) and 116 (1) EPC.

Pending Referrals to the Enlarged Board of Appeal of the EPO

G 1/19

In the interlocutory decision T 0489/14, the board considers the question of patentability of a computer-implemented simulation method involving the simulation of the movement of pedestrians through a building structure. The board referred questions of the technical nature of such inventions to the Enlarged Board as referral G 1/19. The referral is widely seen as potentially significant, not just for simulation methods but also for potential implications for the approach to assessing the patentability of many computer-implemented inventions.

In its interlocutory decision T 0489/14, the board deviates from existing case law in T 1227/05 (Circuit Simulation I/Infineon) according to which a step of a computer-implemented method “may contribute to the technical character of a method only to the extent that it serves a technical purpose of the method ... provided the method is functionally limited to that technical purpose” (reason 3.1). Further, the board in T 0489/14 consider that “a technical effect requires, at a minimum, a direct link with physical reality, such as a change in or a measurement of a physical entity”. Both these conclusions by the board are inconsistent with the prevailing approach to patentability assessment for computer-implemented methods as adopted by the EPO in the Guidelines for Examination.

The IP Federation filed a brief as *amicus curiae* in G 1/19 that is available to view at tinyurl.com/IPFedAmicusG1-19. A decision of the Enlarged Board is expected in 2020.

G 3/19

The referral by the President of the EPO of questions in G 3/19 concerns the relationship between the Implementing Regulations and Articles of the EPC and, specifically, the relationship between Rule 28(2) EPC and Article 53(b) EPC in respect of the patentability of plants or animals exclusively obtained by means of an essentially biological process.

Article 53(b) EPC recites “Patents shall not be granted for ... plant or animal varieties or essentially biological processes for the production of plants or animals”. This is identical to the wording of Article 4(1)(b) of the EU Biotech directive (98/44/EC). The EPO Enlarged Board of Appeal delivered identical decisions in G 2/12 and G 2/13 (referred to as Tomatoes II and Broccoli II), stating that “the process exclusion in Article 53(b) EPC does not extend to ... product-by-process claims” (Final Conclusion 3). Subsequently, the EPO Administrative Council amended Rule 28 EPC by inclusion of new provision, Rule 28(2) EPC (decision of the Administrative Council CA/D 6/17), which entered into force on 1st July 2017. The new rule states “Under Article 53(b), European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process”.

In December 2018, an EPO Board of Appeal in case T 1063/18 (Pepper) concluded that the new Rule 28(2) EPC is in conflict with Article 53(b) EPC as interpreted by the prior Enlarged Board decisions G 2/12 and G 2/13.

The pending referral G 3/19 thus seeks the Enlarged Board’s opinion on two questions: whether Article 53 EPC can be clarified in the Implementing Regulations without the clarification being *a priori* limited by the interpretation of the Article given in an earlier decision of the Enlarged Board; and whether the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process according to Rule 28(2) EPC is in conformity with Article 53(b) EPC.

The IP Federation filed a brief as *amicus curiae* in G 3/19 that is available to view at tinyurl.com/IPFedAmicusG3-19. A decision of the Enlarged Board is expected in 2020.

Procedural Developments at the EPO

EPO Proposals for Streamlining the Patent Grant Procedure

In 2019 the EPO has developed proposals with the objective of streamlining procedures before the Office. A number of these are summarised below.

- The Office proposes to extend the existing “PCT-Direct” procedure, according to which an applicant may file a substantive response to a written opinion of a European search of an earlier application, to additionally apply to second filing Euro-direct applications. According to this proposal, an applicant may efficiently address citations and observations made in respect of a search for an earlier application in a subsequent EP filing.
- The Office proposes improvements to communications between applicants/representatives and the EPO in respect of applications. Proposals include: improvements to the identification of responsible EPO interlocutors for cases; clear identification of available methods of communication with EPO interlocutors; inclusion of a clear indication within a communication of an exact date by which an action or response of a party is due; increasing the use of telephone communication with examiners; and the use of Skype for Business for streamlined collaboration between the EPO and users.
- In view of legal and operational considerations and with an ambition for administrative simplification, the Office proposes to stop notifying inventors of their designation in respect of patent applications. Additionally, the EPO is exploring options for revising the current legal framework governing the publication of inventors’ data that would allow a more balanced reconciliation of all their different interests, i.e. their moral rights to be named in European patent applications and patents, and their legitimate right for better protection of personal data.
- The Office proposes to abolish the notification by registered letter with advice of delivery, while noting that the burden of proof of delivery continues to rest with the Office.
- The Office is further exploring making available cited documents (in particular, non-patent documents) online to parties to proceedings.

Scott Roberts, 21 November 2019