



HOFFMANN EITLE

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The EPO Rules of Procedure of the Boards of Appeal (RPBA) – An Update Two Years After the Entry Into Force of the RPBA 2020 (part I)

The Rules of Procedure of the Boards of Appeal (RPBA) set out how parties must present their case in appeal proceedings at the European Patent Office (EPO). Non-compliance with the RPBA may lead to submissions being rejected as inadmissible. The present article provides some guidance on how to avoid common pitfalls at the early stage of the appeal proceedings and then goes on to examine the impact of the changes introduced into the RPBA 2020 (i.e. the new version of the RPBA which entered into force on January 1, 2020) on amendments to a party's case at later stages of the appeal proceedings.

Common pitfalls to avoid at the early stage of the appeal proceedings (and before the appeal)

Art. 12(1) RPBA¹ provides that *inter alia* the statement(s) of grounds of appeal and any replies thereto form the basis of the appeal proceedings. In that context, any request or statement² a party made during the first instance proceedings that is not expressly incorporated in the statement of grounds of appeal or the reply may not form part of the appeal proceedings. Thus, when preparing an appeal or a reply to an appeal, a party is advised to make sure that any element presented in the first instance proceedings is expressly³ incorporated into the statement of grounds of appeal or the reply, unless the element is to be consciously abandoned or is no longer relevant.⁴

Art. 12(3), first sentence, RPBA further provides that "[t]he statement of grounds of appeal and the reply shall contain a party's complete appeal case".

For the patent proprietor in opposition appeal proceedings, this notably means that any auxiliary request maintained in the appeal must be substantiated in the statement of grounds of appeal or the reply. This applies even if the opposition division did not decide upon the auxiliary request during the first instance proceedings.

For an opponent in appeal proceedings, it means that all objections against all auxiliary requests on file must

be submitted at this initial stage, without waiting for the Board to comment or decide on the admissibility of the auxiliary requests.⁵

It is risky for an opponent not to deal with an auxiliary request on file, and instead rely on the Board remitting the case to the first instance if the auxiliary request would become relevant. Indeed, in absence of timely objections being raised, a Board may simply allow the auxiliary request because there are no objections on file.

The admissibility of any amendments to a party's case relative to the framework defined in the first instance proceedings is also addressed in the RPBA, especially in Art. 12(4) and (6) thereof. A case amendment may e.g. be a new line of argumentation, new evidence or new claim amendments. Even reference to a new passage in a document already on file may in some situations constitute an amendment to a party's case.⁶

Under Art. 12(4) RPBA, if a case amendment is made with the grounds of appeal or response thereto, such an amendment is admitted only at the discretion of the Board. The appellant must draw attention to each case amendment, and for each one provide reasons as to why the case amendment was submitted only in the appeal proceedings.

¹ The references to the RPBA are references to the RPBA 2020.

² Including facts, objections, arguments, and (references to) evidence.

³ Mere references to submissions made during the first instance proceedings are generally considered insufficient.

⁴ For example, if the patent proprietor decided during the first instance proceedings to no longer defend the patent as granted, there is no longer any reason for the opponent to object to the patent in its granted form in appeal.

⁵ See for example T 1272/17 dated 23.6.2021, Reasons 7.4.1.

⁶ J 14/19 of 19.4.2021, Reasons 1.7 and 1.8.

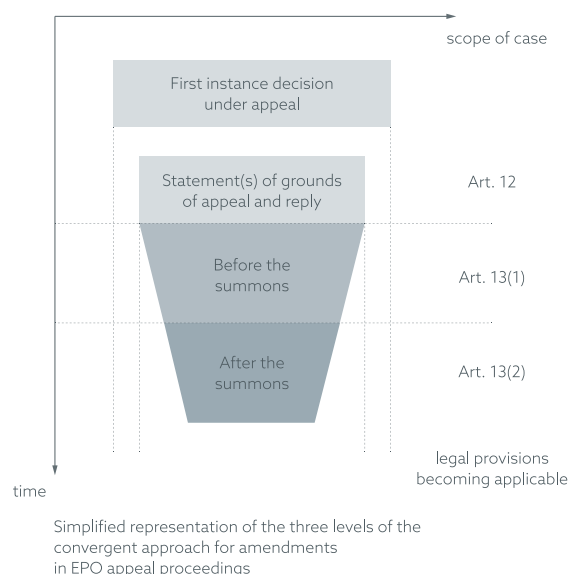
This must be done proactively, i.e. even before anyone has suggested there may be an admissibility issue. Not providing reasons may lead to the Board rejecting the case amendment as inadmissible.⁷

If it turns out that the new element could and should have been submitted during the first instance proceedings but was not, it is unlikely that the Board will admit this element in the appeal proceedings. Thus, already during the first instance proceedings, a party must consider filing any request, fact, objection, or piece of evidence if the circumstances could show that it was in a position to do so, i.e. that it was not prevented from doing so.⁸ The Boards have long considered that parties must not be allowed to shift the presentation of their case to the second instance; the appeal is intended to permit judicial review of the first instance decision, not to decide on new issues.

During the first instance proceedings, a party is also well-advised to avoid withdrawing, abandoning, or more generally no longer maintaining⁹ a previously presented request, fact, objection, or piece of evidence if there is any chance that pursuing such an element during the appeal proceedings may be desirable. Any element which was presented but not maintained during the first instance proceedings, and then reintroduced at the appeal stage has very little chance of being admitted in the appeal proceedings, except under unusual circumstances (Art. 12(6) RPBA).

Amendments to a party's case later during the appeal proceedings

Admissibility of case amendments at later stages of the appeal proceedings are governed by Art. 13 RPBA. Art. 13(1) and 13(2) form the second and the third level respectively of the convergent approach for amendments in appeal proceedings; the first level being the aforementioned Art. 12(4).



Art. 13(1) stipulates that amendments filed after the grounds of appeal and the subsequent response term are admitted only at the Board's discretion. Significant factors influencing the Board's opinion here are, *inter alia*, (i) whether the case amendment addresses new issues that were admissibly raised by another party or the Board, (ii) procedural economy considerations, and (iii) whether the amendment, *prima facie*, overcomes open issues and does not give rise to new objections.

Art. 13(2) applies to case amendments made after the parties have been summoned to oral proceedings. It is even more restrictive and requires the filing party to present "*exceptional circumstances, which have been justified with cogent reasons*" in order for their amendments to be taken into account. Any case amendment filed at this stage is also subject to the criteria of the first and second levels of the convergent approach.¹⁰ The restrictions on case amendment are cumulative.

In order to assess how these new provisions are being applied, we carried out a search in recent appeal decisions for mentions of Art. 13(1) and 13(2) RPBA 2020.

⁷ See T 81/20 dated 10.2.2021, Reasons 1.2. In that case, the appellant-opponent brought forward objections under Article 123(2) EPC for the first time in its statement of grounds of appeal but "did not provide any reasons why it submitted the amendment only in the appeal proceedings".

⁸ See T 1456/20 of 14.6.2021, Reasons 6. In that case, the patent proprietor had filed a request in reply to the opponent's statement of grounds of appeal. The Board considered, however, that the proprietor had not been in any way prevented from filing a request corresponding to that auxiliary request during the oral proceedings before the opposition division, in particular to overcome a lack of novelty the opposition division announced in relation to a higher-ranking request. See also J 3/20 of 19.5.2020, Reasons 3.

⁹ Replacing a given auxiliary request by another is generally considered at the EPO to imply a withdrawal of the former.

¹⁰ Supplementary Publication 2, OJ EPO 2020.

Regarding Art. 13(1), we observed that the majority of its citations were made in the context of amendments made after the summons, i.e. in the final stage of the appeal procedure. This was the case in about 80% of the reviewed cases in which Art. 13(1) was cited.¹¹

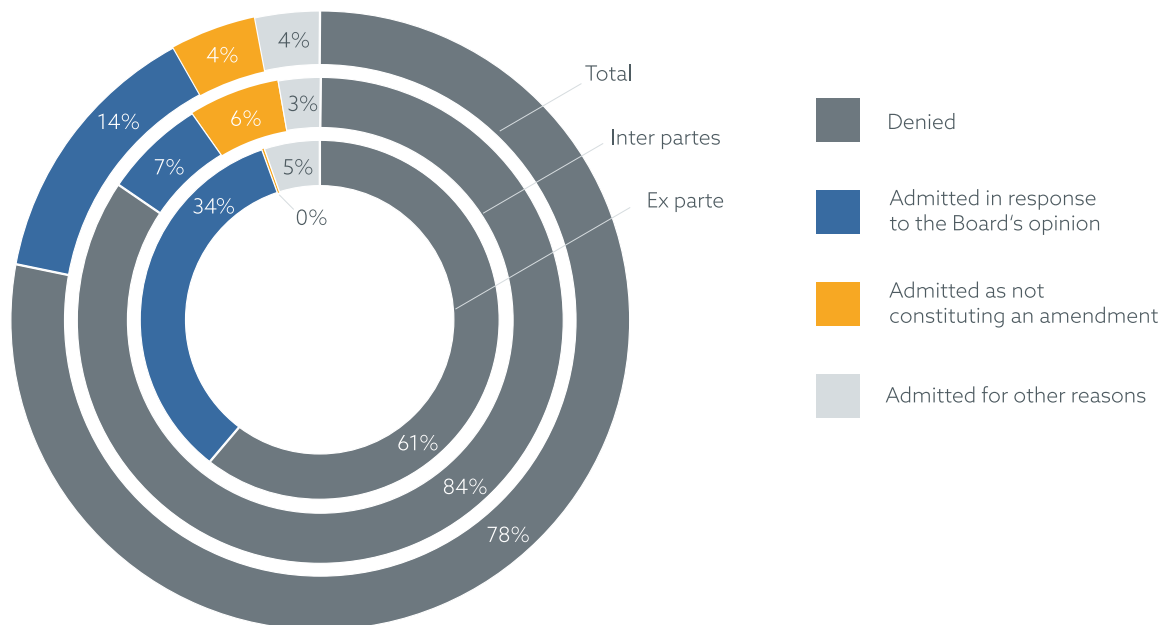
Further, in 84% of those cases, the amendments were not admitted. These statistics suggest that the majority of later-stage amendments occur after the summons and that it is somewhat rare to see case amendments in the “middle” part of the appeal procedure.

As for the admission statistics under Art. 13(2), the Boards generally take a strong line and tend not to admit late-filed case amendments. In 140 reviewed decisions, only 22% of such requests were admitted. Further, a clear difference was observed between *ex parte* proceedings (appeals arising from a refusal of a patent application) and *inter partes* proceedings (appeals in opposition cases).

We also reviewed the decisions where amendments were allowed, to try to get a clearer picture of what “exceptional circumstances” are most often accepted.

A common situation is when an amendment has been made in response to a new point raised by the Board in its preliminary opinion.¹² For this to work, the Board must have expressed something which goes significantly beyond what was presented by the parties in their written arguments, and which is material to the outcome of the case.

Another commonly accepted line of reasoning is that no amendment to the case has taken place. So there is space to argue that a minor change is not a “case amendment” within the meaning of the RPBA. For example, the mere deletion of subject matter, for instance by deleting claims or options from claims may not be considered a case amendment under some circumstances.¹³ Quite often the correction of errors will also not be considered a case amendment.¹⁴ Further elaboration of existing arguments e.g. by references to further case law has also been found not to constitute a case amendment.¹⁵



Admissibility of case amendments under Art. 13(2) RPBA

¹¹ See for example T 1767/16 of 16.04.2021, Reasons 5.1-5.4, which was entirely made based on the criteria of Art. 13(1), and T 15/19 of 19.10.2021, Reasons 1.1.4-1.2.4, which was judged against both Art. 13(1) and 13(2).

¹² For instance, in T 977/18 of 24.06.2021 (see Reasons 6.1), an auxiliary request was admitted because it addressed a new clarity objection raised by the Board in its preliminary opinion.

¹³ T 914/18 of 28.06.2021, Reasons 4.1.

¹⁴ T 2167/17 of 20.04.2021, Reasons 3-4.

¹⁵ T 2988/18 of 21.04.2021, Reasons 1.4.

Conclusion

The appeal proceedings at the EPO aim at reviewing the case decided upon by the first instance department. The admissibility of any case amendment at the initial stage of the appeal is subject to specific provisions laid out in the RPBA and stricter and stricter criteria apply in the later stages of the appeal proceedings, as also laid out in the RPBA. The Boards have developed an understanding of what a case amendment is and when it can be admitted into the proceedings. Our review of the recent case law shows what types of case amendments may be accepted.

In the next issue of *HOFFMANNEITLE Quarterly*, we will review the situations in which the Boards tend to remit appeal cases to the first instance, under Art. 11 RPBA.

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Recent EPO Case Law on Sufficiency: How Much Disclosure is Enough?

Sufficiency of disclosure is one of the fundamental requirements for the grant of a European patent, and lack of sufficiency is one of the grounds on which a patent may be revoked in opposition proceedings before the EPO. Recent decisions of the Technical Boards of Appeal shed some light on the sufficiency assessment. However, uncertainty remains.

Article 83 EPC requires a patent application to disclose the claimed invention sufficiently clearly and completely for it to be performed by the skilled person without undue burden, taking into account the common general knowledge. Generally speaking, the EPO seldom refuses patent applications for lack of sufficiency. However, sufficiency objections are not uncommon in certain technical fields, particularly life sciences. Once raised, an objection of lack of sufficiency may be difficult to overcome in view of the restrictions on the admittance of supplementary technical information.

Sufficiency attacks are common in post-grant opposition proceedings. Whilst such attacks usually fail, there are steps opponents can take in order to increase their chances of success.

Medical Use Claims

Medical use claims which recite a therapeutic effect are susceptible to sufficiency objections since the therapeutic effect is a functional feature of the claim.¹ In such cases, it is necessary to establish that the claimed therapeutic effect can plausibly be achieved based on the application, the prior art and the common general knowledge. Evidence filed after the effective date of the claims cannot be the sole basis for compliance with Article 83 EPC.²

In the opposition appeal decision T 0184/16,³ Technical Board of Appeal 3.3.02 adopted a generous approach to the sufficiency assessment in respect of a claim directed to novel compounds for the treatment of diabetes-related disorders. The Board acknowledged compliance with Article 83 EPC in spite of the absence

of relevant experimental data in the patent. Prior art cited in the patent was taken as supporting the claimed therapeutic effect on the basis that it disclosed compounds having the same core structure as the claimed compounds. Consequently, post-filed experimental data was taken into consideration as confirmation of the claimed therapeutic effect. The Board stated that *"for plausibility of a claimed effect to be acknowledged, it is enough if there are no prima facie serious doubts that the effect can be obtained and conversely no a priori reason and indication in the common general knowledge that the effect cannot be obtained"*.

It is also notable that the Board drew a distinction between sufficiency and obviousness, thereby providing some comfort for those who worry that referring to prior art in support of sufficiency will undermine the inventive step assessment.

In T 0966/18,⁴ Board 3.3.04 had to decide whether the Opposition Division was correct in revoking a patent for lack of sufficient disclosure in respect of a claim directed to a composition comprising the protein α -synuclein or an anti- α -synuclein antibody for use in the treatment of, *inter alia*, Parkinson's disease. The patent contained pre-clinical data relating to tests on a small number of mice, as well as *in vitro* data showing the binding activity of the claimed antibodies. In contrast to the Opposition Division, the Board decided that the pre-clinical data in the patent made the claimed therapeutic effect plausible. It also helped the Patentee that a link between α -synuclein aggregation and Parkinson's disease was suggested in academic literature published before the priority date.

¹T 0609/02 of 27.10.2004

²T 1045/13 of 23.10.2017

³T 0184/16 of 12.12.2019

⁴T 0966/18 of 10.11.2020

In the more recent decision T 2015/20,⁵ Board 3.3.07 disagreed with the Examining Division and acknowledged compliance with Article 83 EPC in respect of a medical use claim directed to a specific dose of acilidium bromide for use in the treatment of asthma, even though the experimental data in the application related to the treatment of chronic obstructive pulmonary disease (COPD) rather than asthma. The Board considered it enough that the prior art did not cast doubt on the statement of therapeutic utility, and the definition of this utility in the claims did not run contrary to prevailing opinion. It helped the Applicant that asthma and COPD were known to have certain mechanistic features in common.

These decisions of different Boards of Appeal confirm that absolute proof of a claimed therapeutic effect is not required. Certainly, clinical data is not essential. Compliance with Article 83 EPC may be acknowledged even if the application as filed contains no relevant experimental data. In such cases, the teaching of the prior art may be decisive.

Parameters

Parameters (characteristic values) are another type of feature which can cause sufficiency problems before the EPO. It is good practice to ensure that an application contains a complete definition of any parameters which appear in the claims, including the methods for their determination. This is especially important for unconventional parameters.

In T 1050/16,⁶ the Board of Appeal held that a claim directed to a "pant-type absorbent article" did not comply with Article 83 EPC because of the feature "the length of the crotch portion is between 10% and 40% of the entire length of the article as measured in an extended state of the article". According to the Board, it was not possible for the skilled person to determine the length of the crotch portion for any article shape other than the specific shape shown in the drawings. The patent did not contain a general teaching as to the boundaries of the crotch portion. On this basis, the Board concluded that the skilled person was faced with an impossible burden to perform the claimed invention over the entire scope of the claim.

One for the Mechanics

The recent decision T 2773/18⁷ highlights the difficulties faced by opponents when arguing lack of sufficiency in respect of mechanical inventions. The claims at issue were directed to a wind turbine comprising a cooling device capable of guiding air introduced into an upper part of the wind turbine towards a lower part, such that the air can subsequently ascend into a middle part and cool heat-generating equipment located in the middle part. The Opponent argued that there was a lack of sufficient disclosure in respect of embodiments in which the air inlet is located close to sea level, since such embodiments are not able to achieve the effect disclosed in the description of avoiding the presence of sea water in the air entering the wind turbine.

The Board was not impressed with the Opponent's arguments. The Board acknowledged compliance with Article 83 EPC on the basis that it would be straightforward for the skilled person to identify suitable positions for the air inlet. The skilled person would exclude embodiments in which the air inlet is positioned so low that the air entering the wind turbine contains a significant amount of sea water. According to the Board, the Opponent had misapplied case law developed in the field of chemistry in connection with ranges.

G 2/21

Uncertainty concerning the assessment under Article 83 EPC arises from case G 2/21, which is currently pending before the Enlarged Board of Appeal. Certain questions have been referred to the Enlarged Board in connection with inventive step. These questions concern the extent to which evidence of a technical effect made available after the filing date can be taken into account. The Enlarged Board has been asked to consider whether the appropriate standard for the admittance of such evidence is that the skilled person would have considered the effect plausible at the filing date (*ab initio* plausibility) or that the skilled person would have seen no reason to consider the effect implausible at the filing date (*ab initio* implausibility), based on the information in the application and the common general knowledge.

⁵T 2015/20 of 23.2.2021

⁶T 1050/16 of 17.12.2019

⁷T 2773/18 of 17.5.2021

Although the questions referred to the Enlarged Board are in the context of inventive step, the decision of the Technical Board which referred the questions acknowledges that they are relevant to Article 83 EPC in respect of claims which recite a technical effect, e.g. medical use claims. T 0184/16 and T 2015/20 are referenced as examples of cases in which the generous ab initio implausibility standard was applied.

Summary

Sufficiency is usually less of a concern than other issues such as novelty and inventive step. Nonetheless, applicants should ensure that the claimed invention is described in enough detail to allow it to be performed without difficulty across the full scope of the claims. If the claims define a technical effect, the application should contain enough information to make it plausible that the effect can be achieved. In such cases, it is recommended to include relevant experimental data in the application.

Opponents should look to submit evidence which shows that there are serious doubts regarding the performance of the invention in question. Clarity or support attacks dressed up as sufficiency attacks are unlikely to succeed.

The Enlarged Board's decision in G 2/21 is eagerly awaited, in order to see how the decision impacts the assessment under Article 83 EPC.

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Speculative Examples at the EPO - a Road to Nowhere?

In the EPO Board of Appeal decision T 2842/18¹, the Board considered that a statement about a hypothetical therapeutic effect in the application as filed could not constitute a direct and unambiguous disclosure for claiming the therapeutic effect. This has implications on how to draft patent applications to be prosecuted at the EPO, in particular with regard to medical use applications.

The background: Article 123(2) EPC

According to Art. 123(2) EPC, a European patent application or European patent may not be amended in a way that extends beyond the original disclosure of the application as filed. This has the aim to provide legal certainty for third parties by preventing applicants from adding subject-matter that is not disclosed in the application as filed. In G 2/10, the EPO Enlarged Board of Appeal developed the "gold standard" for assessing amendments under Art. 123(2) EPC, which is applied in all instances of the EPO: any amendment to a European patent application or European patent (including claims, description, and drawings) must be directly and unambiguously derivable from the application as filed, taking common general knowledge into account.

The issues in T 2842/18

In T 2842/18, the EPO Board of Appeal rejected an appeal from the patent proprietor against the Opposition Division's decision to revoke the patent for lack of inventive step. While the Opposition Division had held that the claimed subject-matter met the requirements of Art. 123(2) EPC, the Board disagreed and dismissed the appeal.

The amended claims related to a specific dosage regimen for a specific second medical use, a retreatment dosage schedule of rituximab for use in preventing or slowing down the progression in structural joint damage and erosion caused by rheumatoid arthritis. The therapeutic effect had no basis in the original claims or in the general part of the description. A *verbatim* recitation of the therapeutic effect was found only in an example contained in the description, i.e. Example 3, which disclosed a hypothetical study outline for a clinical trial

to evaluate the efficacy of retreatment with rituximab. However, no results of the retreatment protocol were presented in the example. Rather the example stated that "[i]t is **expected** that re-treatment under the protocol herein (or with a different CD20 antibody) will be effective in preventing or slowing down the progression in structural joint damage and erosion caused by RA".²

Statements directed to an uncertain therapeutic effect cannot be used to amend the claims

The Board held that the above statement "expresse[d] an expectation of what the outcome of the clinical trial might be" and "the skilled person would derive from the passage in question that the above-mentioned effect might or might not be achieved. The skilled person would not conclude that the effect was definitely achieved."³

Specifically, when looking at the disclosure of Example 3 as a whole, the Board found that it confirmed the uncertainty expressed above, as the skilled person would immediately realize that the proposed clinical study had yet to be carried out and that "the primary objective of the proposed study was 'to evaluate the efficacy of retreatment with rituximab' and that the purpose of this retreatment was to 'potentially prevent disease progression'". Further, in the Board's view, "[t]he skilled person would understand that there were uncertainties about whether or not the effects to be tested for were achievable and that these uncertainties made the study necessary."⁴

¹T 2842/18 of 1.10.2020.

²Application as filed, page 129, lines 20 to 22; emphasis added.

³T 2842/18, reasons 45.

⁴*Ibid.*, reasons 48.

The Board concluded that the claimed therapeutic effect was not directly and unambiguously derivable from Example 3, as there were doubts, expressed in the application itself, that the therapeutic effect could indeed be obtained by the retreatment dosage regimen.

Plausibility does not matter when assessing compliance with Art. 123(2) EPC

Plausibility of a medical use does not require absolute proof and clinical trials are not always necessary, as outlined in the [preceding article by Matthew Birkett](#). Does that tie in with the present decision? The Board repeatedly emphasized that they did not consider plausibility aspects for their assessment of Art. 123(2) EPC⁵. The Board pointed out that *"the criteria for the assessment of direct and unambiguous disclosure of a claimed therapeutic effect are independent of, for example, the presence of data or the assessment of plausibility of the claimed effect. Indeed, there could be direct and unambiguous disclosure of a therapeutic effect that is not plausible at all."*

Guidance for the practice

T 2842/18 once again confirms the EPO's stringent standard for amendments which allows no room for any doubt. When drafting a patent application that is going to be prosecuted in Europe, applicants should bear in mind that a speculative disclosure in the description cannot be used as a basis for amendments after filing. Hypothetical clinical trial outlines or studies are however regularly found in patent applications that relate to specific medical uses. If the applicant or patentee has to amend the claims, e.g., in view of the prior art, and can only rely on an uncertain, speculative disclosure as basis, such an amendment concerning the therapeutic effect in the claim will in all likelihood not be allowable. In the worst case, this may even lead to refusal of the application or revocation of the patent.

In order to comply with the EPO's "gold standard", the application should ideally include concrete statements, e.g., in the form of dependent claims, to serve as a basis for amendments.

Furthermore, in order to establish novelty, it might be helpful to check whether any speculative statements regarding the feature in question are included in the prior art disclosure. Such statements may possibly render the disclosure ambiguous and not anticipatory. Similar considerations of course apply for added-matter objections in oppositions, as in T 2842/18.

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⁵ *Ibid.*, reasons 53-57.

Three-Dimensional Trademarks in the European Union - Guerlain v EUIPO, General Court of the European Union, Judgment of July 14, 2021, Case T-488/20

Guerlain recently succeeded in obtaining trademark protection for a three-dimensional EU trademark for the shape of one of their lipsticks – a remarkable victory since the EUIPO's requirements for obtaining a 3D-mark have become increasingly strict and are currently very hard to fulfil. The decision provides hope for obtaining trademark protection for product shapes which deviate from the norms and customs of their sector.

Guerlain, the LVMH-owned luxury French perfume, cosmetics and skincare house, applied for registration of a three-dimensional EU trademark for the shape of one of their lipsticks, as illustrated below:



Guerlain did not accept the dismissal by the First Board of Appeal and filed an action with the General Court of the European Union.

The General Court of the European Union annulled the decision of the Board of Appeal. It was of the opinion that the mark applied for had distinctive character because it departs significantly from the norm and customs of the lipstick sector.

The EUIPO refused registration of the mark since, in their view, the mark lacked distinctive character. It was argued that the mark did not sufficiently deviate from the norms and customs of the relevant industry.

Guerlain lodged an appeal with the EUIPO. The appeal was dismissed by the First Board of Appeal. The Board insisted that the common lipsticks existing on the market were not substantially different from the one for which trademark protection was sought, arguing the lipsticks on the market were all cylindrical in shape and consumers were used to oval containers. In this context, the First Board of Appeal referenced the following pictures:

Regarding its assessment, the General Court firstly recalled that the standards for assessing the distinctive character of a three-dimensional mark consisting of the shape of a product itself are no different from those applicable to other kind of marks.

Source for the illustrations:

- <https://curia.europa.eu/juris/document/document.jsf?text=&docid=244146&pageIndex=0&doclang=FR&mode=req&dir=&occ=first&part=1&cid=391829>

The General Court further outlined that novelty and originality of a product shape are not relevant criteria with regard to the distinctive character of a trademark. Instead, a 3D mark must significantly differ from the norms and common shapes of the relevant goods offered on the market.

To determine whether the shape of a product is commonly used on the market, the General Court found that the norms and customs of the sector cannot be reduced merely to the statistically most common form, but must include all the shapes which the consumer is accustomed to seeing on the market.

Taking into account the images depicted above which were taken into consideration by the Board of Appeal as constituting the norms and customs of the sector concerned, the General Court found that the shape at issue is uncommon for a lipstick and differs from any other shape existing on the market.

Consequently, the General Court found that the relevant public would be surprised by the shape and would perceive it as departing significantly from the norms and customs of the lipstick sector, and it is therefore capable of fulfilling the function of indicating commercial origin, thus permitting it to be registered.

Guerlain's victory should give hope for obtaining trademark protection for product shapes which include uncommon features.

The main advantage of a three-dimensional trademark is that the mark does not need to be new at the time of filing but can be filed even after years of presence on the market. Further, a trademark provides protection for an unlimited time.

Despite the recent decision of the General Court giving cause for a certain degree of optimism, the EUIPO's examination regarding three-dimensional trademark applications will presumably continue to be strict. Community Design Applications can therefore sometimes take less time and be less expensive.

In contrast to the protection provided by a 3D trademark, the protection provided by a Community Design Application ends after 25 years. Moreover, in order to derive rights from a Community Design, the shape of the product has to be new. Which option is preferable depends on the circumstances of the individual case.

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Clarity of Claims at the EPO: Pursuing Broad Claims Without Being Vague

Article 84 EPC stipulates that the claims shall be *clear* and concise and be supported by the description. In practice, this clarity requirement is of high relevance as many examiners at the European Patent Office (EPO) raise clarity objections which often appear to be guided more by a tendency to require the applicant to incorporate technical details of implementation into the claim. Despite many decisions by the Boards of Appeal on the issue of clarity, there is no robust and definite test that can be used to effectively contain this tendency, and applicants therefore often choose to further limit the claims to avoid dragging out the examination procedure.

Naturally, this often leads to unwanted claim limitations which makes enforcement more challenging. This situation differs from the practice at the German Patent and Trademark Office where examiners have effectively given up raising clarity objections due to case law emphasizing that clarity is not even a requirement applicable under German patent law.

Against this background, recent decision T 0935/14¹ by the EPO Boards of Appeal provides further guidance on the clarity of claims by exploring the concept of *vagueness*. This addresses the underlying principle that, under European practice, a broad claim is not unclear *per se* but a wording may become vague if (i) it prevents an unambiguous distinction from the prior art or if (ii) the wording has different but equally valid claim interpretations. The latter scenario notoriously refers to cases where the wording can be understood in different ways all of which should also be sufficiently disclosed.

T 0935/14 concerns a system and method for providing access for a terminal device to a messaging service normally accessed from a (trusted) mobile device.

Accessing the messaging service from a terminal device (e.g. a desktop computer) may ease use of the messaging service, for example because an actual keyboard, a larger screen etc. can be used. The Board considered claims in which three types of associated accounts were defined which arguably were, however, only distinguished by their name and the content of the messages that would go through these accounts and would include unique identifiers. Even the applicant acknowledged that there was overlap between the definitions of these accounts, and the Board considered that these accounts could not be distinguished. On the basis of the specifics of this case, the Board provided the following guidance.

(A) Claim construction is not a purely linguistic exercise

Under European practice, claim construction is *not* a purely linguistic exercise in which only illogical interpretations are ruled out. Instead, it is the skilled person who construes the claim with a mind willing to understand so as to arrive at a claim interpretation that is *technically* sensible. This raises the question of which level of definition leads to an interpretation that makes technical sense.

(B) Technical consistency

Before further addressing this question, the Board introduced a *prerequisite* for arriving at such a technically sensible claim interpretation which is that the claim is technically consistent. That is, even if two features are individually clear, these two features nevertheless have to be consistent with each other from a technical point of view to arrive at a clear claim.

¹T 0935/14 of 28.4.2021.

(C) 'Broad but clear' vs. 'Broad and vague'

The Board further distinguished between broad but clear claims, on the one hand, and broad and vague claims, on the other hand, on the basis of whether the *borders* of the scope of protection can be clearly inferred by the skilled person. More specifically, the Board emphasized, for this border test, whether some *further technical features appear to be implied* by a broad wording, in particular in view of the technical function of the features. If it would not be clear what these implied features precisely are, then the claimed features have to be considered vague and not clear. For the case before the Board involving multiple accounts of potentially overlapping definition, the Board considered that the claim failed in view of these considerations as it was not clear which other features may be implied so that the accounts could be effectively differentiated.

(D) Minimal claim construction

As a further consideration, the Board introduced the concept of minimal claim construction which is a claim interpretation *without* further implied features. Accordingly, it should be checked whether a claim is technically consistent. For the case before the Board, however, not considering any further implied feature would have led to a scenario in which one of the accounts would be created but not used, thus leading to a technical inconsistency. In that context, the Board held that one potential account creation (in which a server merely checks whether identification data are properly formatted) may fall under a *literal reading* but this would still leave out technical questions of how the account is used. In conclusion, the test should be whether some further technical features need to be read into the claim so that the claim makes technical sense. If it is not clear what those implied further technical features *precisely* are, then the claim is vague and thus not clear.

Conclusion

T 0935/14 provides further guidance for drafting broad claims that are not vague. While this decision may still give examiners room to argue that a broad feature can only be fully understood technically if a precise and therefore detailed definition is used, the decision provides important tools to distinguish between broadness and vagueness and to effectively respond to broadness objections disguised as vagueness objections.

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UPC Update: Austria's Federal Council Approved Ratification of the Protocol for Provisional Application – Unified Patent Court About to Be Established and Preparatory Phase to Commence

On December 2, 2021 the Federal Council (*Bundesrat*) of the Austrian Parliament unanimously decided not to object to the bill passed by the National Council (*Nationalrat*) on November 19, 2021, providing the legislative basis for Austria's ratification of the Protocol for Provisional Application (PPA) of the Unified Patent Court Agreement (UPCA). This approval concludes the parliamentary process. The following three formal steps still remain until Austria can finally deposit the ratification: authentication by the Federal President, counter-signature by the Federal Chancellor, and the publication in the Federal Gazette. These are expected to be finalized by the end of this or beginning of next year.

After being the first state to ratify the UPCA back in 2013, Austria will now also be the final country to complete the minimum of thirteen UPCA signatories required for the PPA to enter into force. Thereby, the Unified Patent Court will be established as a court common to the contracting member states for settling disputes relating to European patents and European patents with unitary effect. It will also mark the beginning of a preparatory phase during which all necessary legal, financial, HR, IT and infrastructure preparations are to be concluded for the court to fully function from the day it opens its doors. The Preparatory Committee expects this preparatory phase to take approximately eight months.

The last three months of the preparatory phase (i.e. expected late Q2 / early Q3) will be a window of opportunity for proprietors of European patents, patent applications, and supplementary protection certificates to opt out from the competence of the UPC, before they can be locked in by a third party complaint filed at the UPC.

To opt out their patent rights in an orderly fashion, proprietors should start planning early if and how to make use of the opt-out mechanism. For more details, see the [article published by the same authors](#) in the September 2021 edition of *HOFFMANNEITLE Quarterly*, and the [Questions and Answers](#) on HOFFMANN EITLE website.

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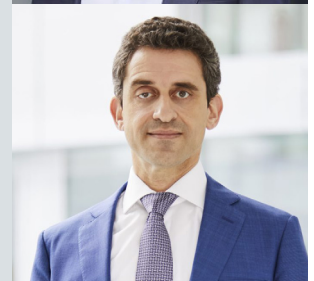


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