

Case Law for the EQE

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Warning

- I am not exam committee
- I do not draft the papers
- **Do not make important life decisions based on this overview talk. 😊**

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Is this just for Paper D?

- Not really!
- In ABC, you always have to do the right thing, taking the EPC (*and its interpretation*) into account
 - In A, draft right – not really case law heavy but you never know.
 - In B, amend right – disclaimer, anyone?
 - In C, pick the right kill – partial priorities, same invention, divisional subject matter, ...
- ...in D, you have to know the law “_(`▽)`_/_”
- (In pre-exam, you need to know “everything but lite”)

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Which cases are really important?

- G decisions
 - the notorious ones, and
 - the more recent ones – but “usually” not those from last year or so (except pre-exam!)
- Case law cited in the GL
 - It’s always better to cite G / T / J than the GL... (you will look clever)
- Notorious Ts and Js (these are in the GL)
- (“White Book” usually not needed)

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Good news for Paper D (and pre-exam legal)!

- PCT is “funny” but there’s no case law!
 - (There’s no possibility to appeal)
 - PCT is ‘self-contained’
- Hands up who likes PCT tiny little bit more now. 😊

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Note about Papers BC

- There is no need to cite legal basis
- If there’s a G decision relevant to the issue, cite it
 - You will look clever, *and there may be extra mark for citing it*
- In any case, you should be able to assess correctly:
 - Validity of priority claim & effective dates of claims
 - Added matter (vis-à-vis application as filed / parent application)
 - Certain funnier aspects of novelty and IS (disclaimers, prior public use)

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G decisions that feature
“often” in papers

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G 1/15 “partial priorities”

- Typical scenario:
 - Priority application: range 3-7
 - Application as filed: range 1-10
 - Conclusion 1: effective date = PD for 3-7, = DoF for 1-2.99 & 7.01-10
 - Prior art: effective date between PD and DoF, discloses 2, 4, 6, 8
 - Conclusion 2: 3-7 survives, rest is 💀
- Claims with more than one effective date are popular in Paper C (and Paper D)

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G 1/05 & G 1/06 “impeccable pedigree”

- **G 1/05:** the test for Art. 123(2) and for Art. 76(1) is the same (no undue leniency!)
- **G 1/06:** consider:
 - EP0 (root) discloses ABC;
 - EP1 (1st gen div) discloses AB;
 - EP2 (2nd gen div) discloses C

→ Then EP2 has a problem (Art. 76(1) “invalid divisional”) because C was not in the earlier application (EP1)
- Subject matter of a divisional has to be in all predecessors
- (If EP2 is a div of EP0, that’s something else)

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G 3/89 & G 11/91 “content of application as filed”

- The content of the priority documents is not part of application as filed
- Also you can’t use priority documents to clarify / prove obvious error
- You can only use application as filed
- Consider:
 - In the application, there’s 7 mm
 - Applicant says this should be 7 cm and requests correction
 - 7 mm / 7 cm is not “immediately obvious” etc.
 - Applicant argues that priority doc discloses 7 cm so either it’s obvious or they can amend.

→ Applicant is wrong!

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G 2/98 “same invention”

- The test for the “same invention” for the purpose of Art. 87 is the same as for added subject matter in amendments
- So the test is strict!

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Disclaimers

- Disclosed disclaimer (“not A” in the application as filed)
- Undisclosed disclaimer (neither “B” nor “not B” in the application as filed)
- Disclaiming stuff disclosed positively (“C” disclosed in the application as filed but “not C” is not)
- H-V, 4 has a neat summary of how to deal with each of these situations

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Disclaimers: G 1/03

- Undisclosed disclaimer can:
 - Restore novelty over an Art. 54(3) prior art
 - Restore novelty over accidental anticipation
 - Remove subject matter excluded for non-technical reasons (“killing embryos”)
- Undisclosed disclaimer cannot:
 - Remove insufficiency
 - Remedy lack of IS
 - Serve two purposes (of which one is allowable but the other is not)

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Disclaimers: G 1/16

- Confirms stuff from **G 1/03**, and:
- Disclaimer cannot change technical teaching of the claim ever, **G 1/16**
- IS is assessed without the disclaimer, **G 1/16**

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Disclaimers: G 2/10

- Disclaiming stuff disclosed positively in the application as filed
- The test: is the subject-matter remaining in the claim directly and unambiguously disclosed in the application as filed?
- Beware of intermediate generalisations!
 - (I.e. if you remove something, what remains must not be unallowable IG.)
- *This is not easy to get it right* – in EQE, this tends to be relatively straightforward & the EC tend to be relatively lenient if your disclaimer is a little bit suboptimal

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G 1/09 “application pending”

- (For filing divisionals)
- **Div of a div**: the 2nd is enough (the root doesn't have to be pending)
- **Grant**: up to the eve of publication of grant (a Tues)
- **Deemed withdrawn**: until the TL expires (if it's gone, you have to further-process it) – with **renewal**, last day of the “+6m” period
- **Withdrawn**: incl. the day of withdrawal (even if div filed later than withdrawal)
- **Refused**: end of the 2m for filing notice of appeal (even if appeal not filed)
- **Stay of proceedings** (“stolen invention”): no div filing possible (but then div is one of the rightful owner's options - Art. 61(1)(b))

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“New” G decisions

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G 1/19 “simulation”

- Sim of a technical process is in principle patentable
(e.g. not excluded as non-invention, software as such)

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G 4/19 “double-patenting”

- Same description, different claims → OK
- Not OK:
 - same applicant
 - designating the same state or states
 - the claims have the same filing or priority date*
 - the claims relate to the same invention
- Do one of:
 - amend
 - withdraw overlapping designations, or
 - choose one of the applications, kill the other

*typically, divisional

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G 1/21 “videoconference OP”

- In times of covid and such, this is possible
- Even if a party disagrees

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G 2/21 “plausibility”

- EPO not allowed to disregard IS evidence submitted by applicant/proprietor just because it was not publicly available at the time of filing
- Enough for a technical effect to be derivable from application as filed by PSITA (who has their common general knowledge)

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G 1/22, G 2/22 “entitlement to priority”

- EPO can assess entitlement to priority
- EPO assumes that whoever claims priority is entitled, but this can be disproven
- This assumption applies also for PCTs...
- ...in particular if priority application is filed by a subset of applicants

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Where else does case law
tend to be important?

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Oral proceedings

- Very case-law heavy
- **G 4/92** about new evidence taking absent party by surprise
- **G 4/95** on accompanying persons speaking at OP
- ...and a bunch of Ts
- See GL E-III, they cite all the Ts there

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Oppositions and appeals

- Also very case law heavy
- The case law for oppositions is in GL part D
- Selection:
 - **G 1/84, G 9/93, G 3/97** “any person”
 - **G 4/88 & G 2/04** “transfer of opposition”
 - **G 3/99** “joint opponents”
 - **G 9/91 & G 10/91** “late filed” & **G 1/95 & G 7/95** “separate grounds”
 - **G 1/91** “unity”, **G 3/14** “clarity”
 - **G 4/91 & G 1/94** “intervention”

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Oppositions and appeals

- Some of the list (*prev slide*) applicable to appeals
- Appeals not in GL (BoA not bound by GL)
 - *Consider reading RPBA (esp. Art 12 and 14)?*

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Renewals

- The additional fee can be paid until the last day of the sixth month following the month containing the anniversary of the date of filing, **J 4/91**, r 2.7
 - A.k.a. *de ultimo ad ultimo*
- Rule 134 is applicable to the calculation of the expiry of the six-month time limit for payment of the additional fee, **J 4/91**, r 3.2
- The omission of the “you didn’t pay renewal” notification may not be invoked, **J 12/84** and **J 1/89**

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(This could go on and on, so...)

The End

All the best for the exams

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