European Patent Academy Seminar: EPO Boards of Appeal and Key Decisions

Munich, 22nd October 2013

The Mock Trial

Summary

A mock appeal based on a simple mechanical patent showed attorneys how to prepare for an appeal oral proceedings and how to conduct themselves during the hearing. In the course of some three hours such bread-and-butter issues as addressing the board, filing citations or new claims in good time, dealing with inventive step, making claim amendments during the hearing and the value of internet citations were demonstrated and discussed.

How does one act before the Boards of Appeal? Is it more or less the same as before an examining or opposition division? What are the pitfalls and peculiarities? With these questions in mind the European Patent Academy organised a Mock Trial, intended to be as realistic as possible.

The Board hearing the Mock Trial was made up of Marie-Bernadette Tardo-Dino as legal member and Bernhard Noll as rapporteur, both of whom are serving board members, together with the recently retired Alec Clelland as chairman. The representatives were Susan Kirsch, acting for the Appellant/Opponent, and Gabriele Leissler-Gerstl for the Patentee/Respondent. It was not an easy task for two highly competent representatives since – as the chairman explained at the start – their job was not merely to show the audience how to do it but also how not to do it: in other words to make deliberate mistakes.

The Case

The case is easily explained. It is based on a genuine appeal - T300/98 – with changes in the facts (and the outcome) in the interests of clarity and simplicity. Although the primary purpose was to explain procedure rather than substantive law, a brief introduction to the technology will be helpful.

The invention is concerned with attaching flexible hoses to pipes based on the so-called “Oetiker” clamp, which enables clamping of a hose by means of a simple crimping action. US3082498, which is acknowledged prior art, shows the basic principle at Fig 2.

A loop or ear (“ear-like means” in the terminology of the patent) is crimped to tighten the clamp, for example to fix a hose to a pipe. The problem with such a clamp is the air gap at the ear, which can deform the hose. The patent, EP503609B, is said to solve this problem by splitting the clamp over part of its circumference. There is an ear on each side of the split and the ears are circumferentially spaced, so that each ear only leaves a gap of half the width and the remaining half is smooth.
Claim 1 of the granted patent has in its characterising part "plastically deformable ear-like means having two generally outwardly extending leg portions interconnected by a generally longitudinally extending bridging portion disposed angularly to the leg portions, the at least one pair of plastically deformable ear-like means being operable to tighten the clamp structure about an object to be fastened upon contraction of the ear-like means by plastic deformation thereof".

There was one auxiliary request filed with the response to the grounds of appeal, which elaborates on the construction of the ears: "the plastically deformable ear-like means (15a,15b) being spaced at such a circumferential distance as to be operable to tighten the clamp structure about an object to be fastened upon plastic deformation thereof by simultaneous contraction of the ear-like means.”.

There was a single prior art document in the proceedings, D1, CA1310475A, said to have been cited by the opponent in the opposition (in fact a late published family member of the document in the actual appeal proceedings). As in the patent, the clamp is split over part of its circumference. There are two circumferentially spaced "corrugations" 1d on each side of the split so arranged that each corrugation only leaves a gap of half the width and the remaining half is smooth. Tightening is achieved by the tightening/joining means 2,3. According to page 4, lines 2 and 3 the corrugations are during tightening "slightly deformed elastically, and are flattened".

The Mock Trial

The scene is now set. The chairman opened the proceedings and asked the parties to confirm their requests. Ms Kirsch set the ball rolling by asking for the patent to be revoked and then requested that she be permitted to record the proceedings. She pointed out that the EPC and the Rules of Procedure are silent on the issue. The Board refused the request, pointing out that the Notice of VP3 of 16 July 2007 made clear that only EPO employees are allowed to use any kind of recording device. The Board had no intention either of making a recording or permitting anyone else to do so. It was observed that this was a highly sensitive issue, given that all laptops and even some pens can record.

Ms Leissler-Gerstl opened in German. The chairman stopped her and noted that the language of the proceedings was English. She said she had made a request for interpreters but no such request could be found in the file. Rule 4(1) EPC requires a month's notice and the Board held this had not been given. Fortunately for the audience Ms Leissler-Gerstl speaks excellent English and was able to make her request in English: that the patent be maintained as granted (or putting the same thing another way, that the appeal be dismissed).
It’s normal for the appellant to open the debate and Ms Kirsch went to town on the clarity of claim 1. There were many vague and imprecise terms, such as “at least approximately” and “corresponding substantially” – and that’s before even getting to the characterising part. But, asked the board, is this a ground of opposition or appeal? Well no, admitted Ms Kirsch, but how could anyone understand the claim without interpreting these unclear terms, some of which had no counterpart in the description? Nevertheless she went on to discuss inventive step in relation to D1, pointing out that the patent said that the preamble of claim 1 was known from D1, which also showed a clamp structure with corrugations corresponding to the “ear-like means” of claim 1. Although the claim specified that these were “plastically deformable” the corrugations of D1 served the same function and even if the claim was novel (which it might well not be) it was part of the skilled person’s common general knowledge to provide “ears” which were “plastically deformable”.

So the issue was clear: what is meant by “plastically deformable”? Ms Leissler-Gerstl argued that D1 taught a clamp structure tightened by means of a clip 2,3. Admittedly there were corrugations but these were said to be elastically rather than plastically deformable and served to compensate for hose creep rather than aiding tightening.

In support of this argument Ms Leissler-Gerstl produced a print-out from Wikipedia. When asked by the chairman why it hadn’t been filed before she pointed out that common general knowledge could be shown at any time.

The Board was sceptical. Wikipedia is notoriously easy to change; what proof was there that the article had not been changed, say, yesterday? Although there were dating facilities such as the “Wayback Machine” of archive.org, the boards were generally sceptical about internet citations. The print-out was not admitted.

Ms Kirsch then argued that the patentee’s comments depended on two imprecise terms – plastic and elastic – being different. The patent failed to define what was meant by “plastic” and the term did not imply permanency – think of the children’s modelling clay “plasticine” for example. In fact, there was a hint in the patent at column 3 line 8 that the ears were elastic. It would be obvious to the skilled person that the corrugations of D1 were both elastic and plastic.

Normally inventive step objections are raised in terms of “problem and solution” and the chairman expressed surprise that neither party had mentioned this. Mr Kirsch then argued that D1 had a split circumference and had solved the problem of hose deformation at the gap created by the ear. This could not then be the problem solved by the invention. Ms Leissler-Gerstl was of a different opinion: the invention was concerned with thin, rigid hoses under high pressure whereas in D1 the corrugations merely compensated for hose creep. There was no comparison.

And there the matter rested. But before the Board deliberated the audience was asked to vote: inventive or obvious? The majority thought “obvious” but the board disagreed! It took the view that the appellant had not proven that D1 showed plastic – as opposed to elastic – deformation.

Since this meant that the appellant’s only request had been refused the board was ready to give a decision and was about to do so when Ms Kirsch filed a further request. The debate had not been closed, which meant she was free to do so. She asked for a further document to be admitted to exemplify common general knowledge, D2, US 4315348.

Ms Leissler-Gerstl was outraged that a document be filed so late in the proceedings and the two attorneys had a heated argument. The chairman interrupted them and pointed out the importance of addressing the board rather than each other. The issue was a tricky one since even if not explicitly in the proceedings D2 was from the patentee and was acknowledged prior art.

The Board deliberated. It had given an opinion based on D1 but not a decision. It had not closed the debate and although in normal circumstances it was unlikely that a board would admit a document so late in the day it was prepared to allow Ms Kirsch to discuss D2 to see whether it was prima facie highly relevant (cf decision T1002/92).
D2 is also concerned with the problem of gap-free clamping and solves it by means of an insert. It refers to a plastically deformable “Oetiker” ear. Ms Kirsch argued that the skilled person, starting out from D1, would appreciate that the corrugations could be made plastically deformable as shown in D2. One could even reach the same conclusion starting out from D2 as closest prior art.

Ms Leissler-Gerstl on the other hand argued that that starting out from D1 the only realistic problem was to replace the catch 2,3 which enabled the clamp to be made of flat rather than cylindrical stock. Admittedly the invention did not exclude such a catch but the corrugations of D1 served a different purpose to the ear of D2 and were not comparable.

The Board deliberated and gave the opinion that claim 1 of the main request lacked an inventive step having regard to the disclosure of D1 in the light of the common general knowledge as represented by D2. This of course implies that D2 was admitted into the proceedings, even if not explicitly stated.

Since the main request was not allowable the Board went on to consider claim 1 of the 1st auxiliary request, filed in response to the appeal. This added to claim 1 of the main request “the plastically deformable ear-like means (15a,15b) being spaced at such a circumferential distance as to be operable to tighten the clamp structure about an object to be fastened upon plastic deformation thereof by simultaneous contraction of the ear-like means.”.

The Board asked Ms Leissler-Gerstl to confirm that the passages could be found in the originally filed application. To her embarrassment she had to admit not having a copy of the application to hand.

Ms Kirsch then objected to the new wording, which she argued was unclear (Article 84 EPC) and added subject-matter (Article 123(2) EPC) in that only some features of a group of features were introduced, so that it was based on an intermediate generalization.

The Board agreed. The claim was held to be unclear and therefore not allowable.

But before the Board could give a final decision to revoke the patent, Ms Leissler-Gerstl said she had been taken by surprise by the filing of D2 and it was only fair that she be allowed to file a new request in response. She asked that the hearing be interrupted to allow her to do so.

If one party is permitted to file a new document, surely it’s only fair that the other party be allowed to respond in the same way? The trouble was, Ms Leissler-Gerstl might have thought she’d filed a request but she hadn’t: she’d asked to be allowed to file a request, and since there was no actual request on the table the result could easily have been sudden death for the patent. But the board was merciful, perhaps bearing in mind that the appellant had been allowed to introduce a new document.

In fact, Ms Leissler-Gerstl filed a claim for each of two requests: a second auxiliary request directed to the longitudinal portions of the ears being “provided with reinforcing means (18) formed by a shallow, generally pan-shaped depression the bottom of which is substantially flat” and a third auxiliary request which was a modified version of the 1st auxiliary request and specified that the ears were “spaced a predetermined circumferential distance from one another defined by an angle α which subtends an angle extending through the centre of the bridging portion (17) of one ear-like means to the centre of
the bridging portion (17) of the other ear-like means, the angle \( \alpha \) being maintained constant upon simultaneous contraction of the ear-like means by plastic deformation thereof by an appropriate tool”.

The board was not happy. Why two requests, and why only a single claim each time when the granted claim set consisted of 8 claims? And why were the requests not signed and dated? A complete set of claims should always be filed. Ms Leissler-Gerstl felt it was self-evident that granted claims 2 to 8 should be present.

Commenting on the second auxiliary request, Ms Kirsch thought that some of the subject matter of granted claim 8 was now in claim 1, so simply adding the existing claims would not do. She also asked for time to consider the amendments, either by way of an adjournment or referring the case back to the first instance. It was possible a further search might be needed. There were in any case clarity issues: what was a “shallow, generally pan-shaped depression”, and how flat is “substantially flat”? Again there was a problem with intermediate generalization: only some features of claim 8 had been taken into claim 1. Ms Leissler-Gerstl on the other hand argued that the pan-shaped feature was clear in itself and stood alone.

The board asked the audience: would you admit this request? The majority would not, which was also the board’s view. It was not admitted.

On the third auxiliary request Ms Kirsch again pleaded for time to consider it but nevertheless raised clarity and added subject-matter objections. What did “plastic deformation …by an appropriate tool” mean? Was the tool part of the claim? And the expression “an angle which subtends an angle” seemed to her to be meaningless. Ms Leissler-Gerstl argued that the skilled person in the art would have no practical difficulty in interpreting the wording. This was a straightforward mechanical case and not a complex chemical patent!

The Decision

Having heard the arguments, the board closed the debate and asked the parties to confirm their requests. Ms Kirsch maintained the request that the decision under appeal be set aside and the patent revoked. Ms Leissler-Gerstl requested that the appeal be dismissed and that in the alternative the patent be maintained on the basis of one of the first, second and third auxiliary requests, taken in that order.

The board then deliberated and gave its decision: the patent is revoked. Which is exactly the decision Board 3.2.1 came to in case T300/98.

Procedural points to take into account

So what procedural points stand out from the mock trial? Here are some (in no particular order) to be thinking about:

- File everything as early as possible. Anything filed after the initial statement of grounds or the response is only admitted if the Board exercises its discretion. Although not discussed much in the trial, the Rules of Procedure of the Boards of Appeal, particularly Rules 12 and 13, are essential reading.
- Take care that any amendments comply with Article 123(2) EPC. Objection of intermediate generalization arises regularly with amendments. You will need the originally filed application to argue this.
- Note the board’s scepticism about internet citations.
• Watch out for all the little issues which can show unfamiliarity with the system: asking to record, not using the language of the proceedings (and not requesting interpreters), not providing dated and signed copies of all the claims of a request.
• If you are caught by surprise, for example by a new request or citation, ask for time to consider it.
• Finally, have confidence in your arguments. A good attorney really can make all the difference!