



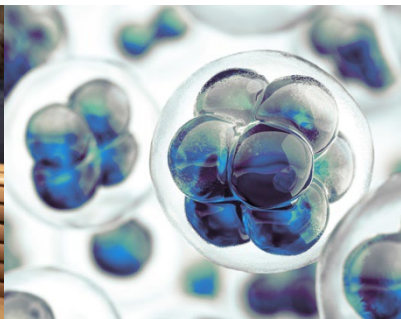
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Is it (really) too late?



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Presenter



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- Patent examiners (M&M, HBC)
- Members of the opposition directorate
- Examination Matters since 2017
- EQE, CEIPI tutor (RM)
- Technical field: mechanics & physics (SD), chemistry (RM)



Content

- Introduction
- Practical cases
- Conclusions

Discretionary power

- A114(2) EPC: EPO may disregard facts or evidence which are not submitted in due time by the parties
 - examination on admissibility
- R116(1) EPC: New facts and evidence filed after the final date set for making written submissions in preparation for OP need not be considered, **unless subject of proceedings has changed**
- More restrictive in 2nd instance (Articles 12-13 RPBA)

Strategy for 1st instance proceedings



- File everything as early as possible?
- File selected submissions depending of other parties' submissions / opinion from O.D.?
- Wait until R.116 final date?

Strategy for 1st instance proceedings



Submissions by Opponent(s) after 9-month oppo. period or Proprietor after 4-month TL to reply to NoO are deemed late filed **unless** the submissions could not have been presented earlier

Case Law IV.C.1.2.1

Case I – Question



4m before OP: P files an amended set of claims to overcome existing objections to its previous MR.

@OP: O files a document to show that the new MR lacks novelty.

Would the OD admit the document in the proceedings?

- 1- Yes, it is a legitimate response to P's new MR
- 2- No, it is late-filed (after 9-month period)
- 3- It depends on the nature of the amendments

Case I – Answer



- 1- Yes, it is a legitimate response to P's new MR
- 2- No, it is late-filed (after 9-month period)
- 3- It depends on the nature of the amendments**
 - **The amendments involve the addition of features from the description:**
O could not have expected such a change in the subject of proceedings. The new document could not have been filed earlier and is a direct response to said change. Therefore the document is not late filed. O is allowed to submit new facts and evidence, and maybe even a new ground for opposition.
 - **The amendment is a combination of granted claims:** the filed document is treated as late-filed since O should expect such an amendment and should have provided the document within the 9 month opposition period. The document will be admitted only if prima facie relevant.

Case Ia – Question



1m before OP: O files D5, which in addition to D3, filed with the NoO, destroys the novelty of the granted claims.

@OP: P files a new set of claims to deal also with the anticipation caused by D5.

Would the OD admit the set of claims in the proceedings?

- 1- Yes, it is a legitimate response to the filing of D5 by O
- 2- It depends on the admissibility of D5

Case Ia – Answer



- 1- Yes, it is a legitimate response to the filing of D5 by O
- 2- It depends on the admissibility of D5**
 - **If D5 is admitted into the proceedings (i.e. prima facie highly relevant):**
The claims submitted by P are a legitimate response to the filing of D5 and should be admitted into the proceedings. Both parties will also be given the opportunity to comment on the submission and eventually time to study them.
 - **If D5 is not admitted into the proceedings:** The filing of the claims is not a direct response to a change in the subject of proceedings and is therefore late. Admissibility will be discussed. Claims must be clearly allowable and based on features present in the granted claims (i.e. not taken from the description). The stage of the procedure will also be taken into account (procedural efficiency).

Types of submissions

- Evidence
- Facts
- Set of claims
- Opposition grounds
- *Arguments*

Facts, evidence, arguments?

- allegation of prior use
- filing of experimental data
- testimony of a witness
- "..claim 1 lacks IS in view of D1+D2.."
- "T939/92"
- "..feature X is obvious in view of par. 3 of D1 because.."
- "..filing of handbook X to illustrate CGK in the field.."

Please, type in the chat box: "F" (fact), "E" (evidence) or "A" (argument)

Facts, evidence, arguments?

- allegation of prior use **Fact**
- filing of experimental data **Evidence**
- "...claim 1 lacks IS in view of D1+D2.." **Evidence, Facts and Arguments**
- "T939/92" **Argument (T861/93)**
- "...feature X is obvious in view of par. 3 of D1 because.." **Argument based on evidence**
- "...filing of handbook X to illustrate CGK in the field.." **Evidence but merely alleging that a feature is part of CGK is mostly treated as Argument**

Admissibility: late-filed facts, evidence

- **prima facie relevance** (T1002/92, GL E-VI,2)
- state of the procedure
- reasons for belated submission
 - abuse of procedure?
- complexity
- procedural economy

Admissibility: late-filed claims

- "clear allowability" (T1634/09, GL E-VI, 2 and H-II, 2.7.1)
 - procedural expediency/abuse of procedure
 - reasons for belated submission
 - reasonable expectation that opponents familiarise themselves with proposed amendments in time available (CL IV.D.4.1.1)
 - nature of the amendments
 - convergence (H-III, 3.3.1.2)
- + Rule 80 EPC

Admissibility: late-filed experimental evidence

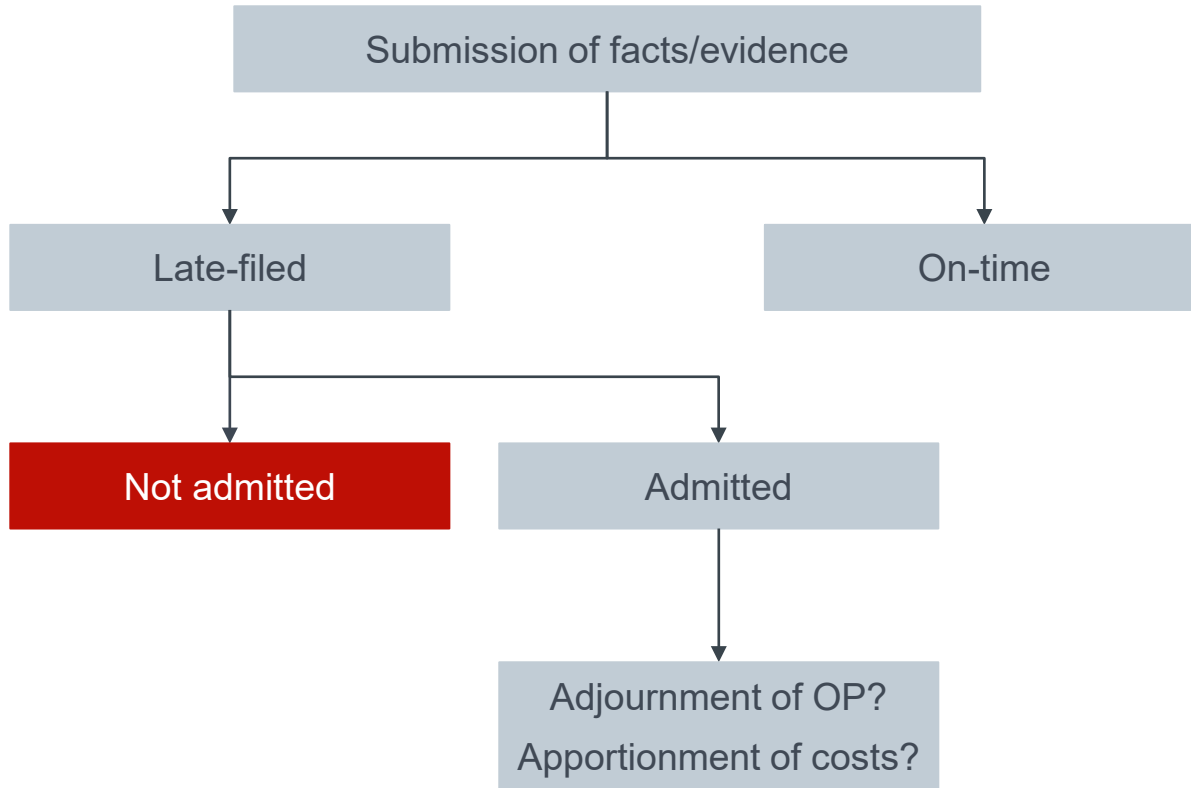
Admissibility, Art. 114 / R116(1)

- late filed? or legitimate and direct reaction to other party submission / invitation from O.D.?
- if late filed, prima facie relevance?

If admitted: right to be heard, Art. 113(1)

- enough time to run counter-experiments? (T2415/09)

Consequence of admission/non-admission



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- Introduction
- **Practical cases**
- Conclusions

Case II – Question



NoO: sufficiency of disclosure objected and supported by one piece of evidence.

Summons to OP: "...the submitted evidence is not enough to prove that feature X as defined in claim 1 cannot be reproduced by the person skilled in the art..".

4d before OP: opponent files **new experimental evidence**.

Would it be admitted into the proceedings?

- 1- No, it is too late
- 2- It may be admitted into the proceedings

Case II – Answer



1- No, it is too late

2- It may be admitted into the proceedings

- **If the new evidence addresses the points raised by OD, then it can be regarded as a direct reaction to the OD's preliminary opinion:** it is then part of the proceedings (no discretionary power to exercise, no prima facie assessment). Upon request of the other parties, OP may be however adjourned (to allow them to study it and react)
- **If not:** it will be treated as late-filed experimental data and its admissibility will be discussed (prima facie relevance). Upon request, OP may be adjourned and a decision on apportionment may ensue at the end of the second oral proceedings (in this case O is likely to bear the costs of the 2nd OP).

(see T1738/12)

Case III – Question



Notice of opposition: patent solely attacked for lack of novelty in view of D1.

3m before OP: O files D2 and states that the S-M of MR is also not **inventive** in view of D1+D2.

@OP: P contests the admissibility of the new attack.

Would the attack be admitted into the proceedings?

- 1- It depends on its *prima facie* relevance
- 2- No, it is not a direct response to a previous change in the course of the proceedings

Case III – Answer



- ☒ **1- It depends on its *prima facie* relevance**
- ☐ 2- No, it is not a direct response to a previous change in the course of the proceedings

Only if *prima facie* relevant (G10/91).

The lack of inventive step is a fresh ground of opposition (G7/95). Both, the new ground and the document D2 are late-filed as they are not a direct response to other party's submission, so that their admissibility will be assessed.

The discussion on the admissibility of the fresh ground will include the *prima facie* relevance of D2 regarding the lack of inventive step. Therefore if the new ground is found *prima facie* relevant, then D2 substantiating this ground is automatically admitted into the proceedings.

Case IIIa – Question



EPO Form 2300: all grounds of opposition selected.

Notice of opposition: only the grounds of novelty and inventive step (over D1-D3) substantiated.

3m before OP: O attacks the **MR for being insufficiently disclosed** and files **D4** to support it.

@OP: P contests the admissibility.

Would the attack be admitted into the proceedings?

- 1- Yes, it was raised within the 9-month period
- 2- No, it was filed late
- 3- It depends on its *prima facie* relevance

Case IIIa – Answer



- 1- Yes, it was raised within the 9-month period
- 2- No, it was filed late
- 3- It depends on its *prima facie* relevance

Only if *prima facie* relevant (G10/91).

A ground of opposition, which has been referred to in the NoO or in Form 2300 but not substantiated during the opposition period is deemed **not** to have been invoked (i.e. non-existent) (e.g. T222/85, T105/94).

If O intends to use it later on in the proceedings it will be regarded as a late-filed ground and its admissibility will be subject to its *prima facie* relevance .

If admitted, the late-filed evidence accompanying this ground (D4) will be automatically admitted (no need for a separate discussion).

Case IIIb – Question



EPO Form 2300: lack of novelty and lack of IS selected.

NoO: MR not novel and not inventive over D1, but only the lack of novelty substantiated.

@OP: proprietor contests the admissibility of the lack of IS.

Would the attack be admitted into the proceedings?

- 1- Yes
- 2- No, it was filed late
- 3- It depends on its *prima facie* relevance

Case IIIb – Answer



1- Yes

2- No, it was filed late

3- It depends on its prima facie relevance

The new attack is admissible (T131/01)

Where the ground of lack of novelty has been substantiated pursuant to R76(2)c EPC **on the basis of a single prior art document**, a specific substantiation of the ground of IS based on the same document is neither necessary nor generally possible without contradicting the reasoning presented in support of the lack of novelty. In such a case, the objection of lack of inventive step is part of the proceedings and has to be assessed without examination of prima facie relevance.

Case IV – Question



NoO: MR lacks novelty over D1 and lacks inventive step over D2.

@OP: O argues that MR also lacks novelty over D2.

Would the attack be admitted into the proceedings?

- 1- Yes
- 2- It depends on the examination of D2

Case IV – Answer



- 1- Yes
- 2- It depends on the examination of D2

Novelty and inventive step are not fresh grounds of opposition. D1 and D2 have been filed within the 9-month period so that they are **not** late-filed evidence.

If the lack of novelty over D2 relies on the same embodiment(s) cited in NoO, it would normally be considered as new arguments. Hence no discretionary power for discussing the admissibility of the attack (i.e. already part of the proceedings).

If the lack of novelty over D2 relies on non-previously used embodiments of D2, this could amount to the filing of new facts. The admissibility would therefore be discussed on the basis of prima facie relevance.

Case IVa – Question



NoO: MR lacks IS in view of D1 in combination with D2.

@OP: O argues that MR also lacks IS in view of D2 in combination with D1.

Would the attack be admitted into the proceedings?

- 1- Yes
- 2- No

Case IVa – Answer



- 1- Yes (e.g. T92/92)
- 2- No

The ground (IS) and evidence (D1-D2) were timely filed.

The new attack based on D2+D1 would be merely considered as the filing of new arguments.

Case V – Question



NoO: MR not novel over D1.

P replies 3m later by filing ARs 1-4, each incorporating different technical features from the description and going in different directions.

@OP: opponent contests the admissibility of ARs 1-4.

Would the new sets of claims be admitted into the proceedings?

1- Yes

2- No

Case V – Answer



1- Yes

2- No

ARs 1-4 have been timely filed (within 4 months) by P with his letter of reply to the NoO. As a result, they are part of the proceedings and no examination on admissibility will follow. OD has no discretionary power to call into question their admissibility. In particular the non-convergence of the ARs cannot be invoked against their admissibility. This criteria is only used in case of late-filed requests.

Case Va – Question



NoO: MR not novel over D1.

1m before OP: P files ARs 1-4, each incorporating different technical features and going in different directions.

@OP: O contests the admissibility of ARs 1-4.

Would the new sets of claims be admitted into the proceedings?

- 1- Yes
- 2- No
- 3- Admissibility will need to be assessed

Case Va – Answer



- 1- Yes
- 2- No
- 3- Admissibility will need to be assessed**

ARs 1-4 are late-filed (filed after the 2 month time limit under R116 EPC). **Their admissibility will be assessed during the OP on the basis of the relevant criteria** ("clear allowability", convergence, nature of the amendments, etc:).

The admissibility of each request may even be discussed separately.

Case Vb – Question



NoO: all grounds of opposition invoked and substantiated.

@OP: OD admits D5, filed by O, for being prima facie highly relevant to the issue of novelty of MR.

P requests to file a new set of claims dealing with the new objection. However, the new set of claims raises new objections under Articles 123(2) and 84 EPC.

Would the new set of claims be admitted into the proceedings?

- 1- Yes
- 2- No, not clearly allowable

Case Vb – Answer



1- Yes (T2038/08)

2- No, not clearly allowable

The set of claims filed during OP constitute a direct response to the admission of D5. OD has no discretionary power to disregard the request of P.

In this case, OD cannot apply the criterion of "clear allowability" because the new set of claims is not late-filed.

Poll results – Question



How many correct answers?

- Between 9 and 11
- Between 6 and 8
- Between 1 and 5

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Conclusions



File requests, facts and evidence as early as possible

- raise & substantiate all grounds of opposition w/i the 9-month period under Article 99 EPC
 - experimental evidence
 - taking of evidence
-



If not possible

- prima facie relevance/allowability
 - change in subject of proceedings
-



Raise objection on admissibility as early as possible