

The image shows a glass door with the Inspicos logo and the text 'EUROPEAN PATENT ATTORNEYS' printed on it. The background is a blurred office interior with a person sitting at a desk.

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EUROPEAN PATENT ATTORNEYS

WEBINAR

EPO case law

7 December 2023

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EUROPEAN PATENT ATTORNEYS

Agenda

- Is a signature a signature? Legal Board of Appeal decision J 5/23
- Entitlement to priority. Lessons to be learned from Enlarged Board of Appeal decision G 1/22
- Complex product prior art. Review of pending EBA referral G 1/23

Legal Board of Appeal decision J 5/23

Is a signature a signature?

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When is a signature not a signature? J5/23

- Article 72 EPC

An assignment of a European patent application shall be made in writing and shall require the signature of the parties to the contract.

- Rule 22 EPC

The transfer of a European patent application shall be recorded in the European Patent Register at the request of an interested party, upon production of documents providing evidence of such transfer.

J5/23 - background

ASSIGNEE Olympus Medical Systems Corporation.

By: /Kazuo Mikami/

Name: Kazuo Mikami

Title: Director of IP Portfolio 1

Date: 11/1/2021

- “text string signature”
- Assignment filed, as a “pure” PDF document
- No metadata, security data or certificates

J5/23 - background

- Communication from Legal Division:

"...we are unable to access the electronic certificates attached [to the signatures]..."

..."we cannot assess whether the signatures fulfil the requirements in the Notice from the European Patent Office dated 22 October 2021" (OJ EPO 2021, A86)

J5/23 - background

- **Communication from Legal Division:**

"Only the original (digital) format of the electronically signed document allows such verification. Scanned or similarly reproduced documents do not serve this purpose."

Invitation to resubmit the document with a verifiable electronic signature, or a handwritten signature, within 2 months.

J5/23 - background

- Applicant disagreed – with reference to
 - *Decision of the President, 3 March 2021*
 - *Notice from the EPO, 22 October 2021*
- Legal division did not concur – further 2 month deadline to provide a corrected signature

J5/23 - background

- Applicant disagreed again – with reference to Rule 2(2) EPC:
 - *Where the Convention provides that a document must be signed, the authenticity of the document may be confirmed by handwritten signature or other appropriate means the use of which has been permitted by the President of the European Patent Office. A document authenticated by such other means shall be deemed to meet the legal requirements of signature in the same way as a document bearing a handwritten signature which has been filed in paper form.*
- Also requested an appealable decision
- Legal Division issues a decision, rejecting the registration of the transfer
- Appeal filed

OJ EPO, 2021, A86

- Notice from the EPO, 22 October 2021
concerning electronic signatures on documents submitted
as evidence to support requests for registration of a
transfer of rights under Rule 22 EPC

OJ EPO, 2021, A86

- To facilitate communication by electronic means, the Legal Division will accept, as from the date of publication of the present notice, qualified electronic signatures, in addition to handwritten signatures, in respect of evidence filed in support of requests for registration of a transfer of rights and for registration of a licence or other rights.

OJ EPO, 2021, A86

- Reference to Regulation (EU) No 910/2014.1
- Accordingly, a qualified electronic signature is an electronic signature that
 - (a) is uniquely linked to and capable of identifying the person signing;
 - (b) is created by means that the person signing can use with a high level of confidence and over which they have sole control;
 - (c) is associated with the electronic document to be authenticated in such a way that any subsequent change in the data is detectable;
 - (d) is created by a qualified electronic signature device; and
 - (e) is based on a qualified certificate.

J5/23 - considerations

- How to define a “signature”...?
 - Dictionaries
 - The versions of Art. 72 EPC in DE/EN/FR
 - The preparatory works

J5/23 - considerations

2.4.2 The general rationale underlying Article 72 EPC is that there must be clear and unambiguous formal requirements for the transfer of a European patent application, harmonised at the level of the EPC and resulting in a sufficient level of authenticity of the assignment contract.

2.4.3 More specifically, the signature requirement in Article 72 EPC ensures that the assignment contract becomes clearly attributable to the signing parties when they put their names on the contract in a distinctive manner, thereby creating an objectively verifiable link between signature and signatory. This is commensurate with the importance of this legal transaction, which "has the effect of making a patent application the property of another person" (J 7/21, Reasons 4.4).

J5/23 - considerations

2.4.5 It would be at odds with this rationale if...any type of text in electronic form referring to the name of a person were considered a "signature" within the meaning of Article 72 EPC

J5/23 – conclusions

In the absence of a different definition in the Implementing Regulations, the term "signature" in Article 72 EPC must be understood as referring to a handwritten depiction of someone's name (Reasons 2.9).

- i.e. print, sign and scan an assignment document

J5/23 - conclusions

- What about Rule 2(2) EPC?

J5/23 - conclusions

- Rule 2 EPC is limited to formal requirements for filing documents at the EPO.
- The relationship covered by Rule 2 EPC is between the EPO (an authority) and a party to the proceedings.
- The relationship in assignment contracts is different.
- Rule 2 EPC is not an implementation of Art. 72 EPC.

OJ EPO, 2021, A42

- What about the decision of the EPO President, 14 May 2021?
- Allowing signatures on documents to be filed in the form of
 - enhanced electronic signature
 - a reproduction of the signature
 - text string signature */John Doe/*



J5/23 – comments on *OJ EPO, 2021, A42*

- **Relates solely to the formal requirements for filing documents**
 - Rule 2 (2) EPC
 - Not Art. 72 EPC
- **This cannot provide legal basis for a text string signature on an assignment document.**

OJ EPO, 2021, A86

- What about the Notice from the EPO, 22 October 2021?

J5/23 – comments on *OJ EPO 2021, A86*

2.8.3 The Notice's aim of "facilitat[ing] communication by electronic means" with users is commendable.

In the context of Article 72 EPC, however, a notice from the EPO is the wrong means to achieve this. While a notice from the EPO may be a source of legitimate expectations..., it is, as such, only a document providing information.

J5/23 – comments on OJ EPO 2021, A86

2.8.3 [*cont...*] In particular, the Notice is not a legal instrument passed by a competent legislative body, so it can neither implement nor specify any articles of the EPC (or, for that matter, of the Implementing Regulations to it).

[It]...therefore is not to be taken into account for a systematic interpretation of Article 72 EPC.

Hence, the contents of the Notice have no bearing on the interpretation of the term "signature" in Article 72 EPC.

J5/23 - comments

- What other “*Notices from the EPO*” or “*Decisions from the President*” may be out there, which have weak legal basis?
- Board commented that the legislator could redefine the term “*signature*” by amending the Implementing Regulations

J5/23 - comments

- **Autumn meeting of SACEPO Working Party on Rules 31.10.2023**
 - “Second basket” of legal changes
 - During the meeting, the EPO’s proposal to align signature requirements within the patent grant process was also discussed. This simplification initiative seeks to align all signature requirements...including in proceedings before the Legal Division

J5/23 - practical recommendations

- Only applies to Assignments – not filing documents
- Not clear whether J5/23 would have retrospective effect
- Review your portfolio for assignments
 - “Wet” signature is strongly recommended
 - Print, sign and scan the document
 - File a confirmatory assignment?
 - Countersign (double-sign) an existing assignment?

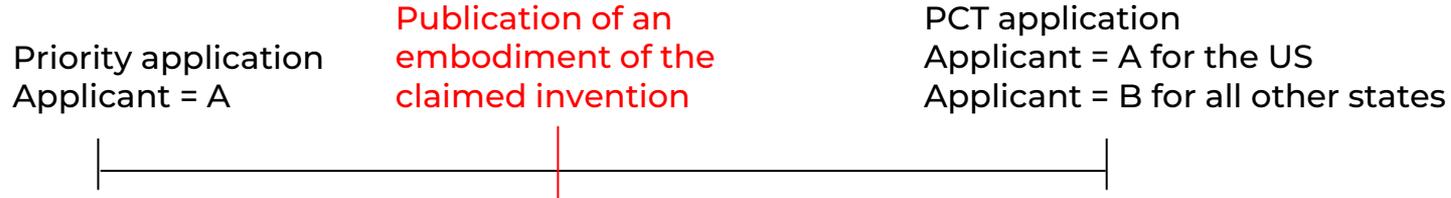
Priority – EBA Decision in case G 1/22 & G 2/22

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G 1/22 & G 2/22 of 10 October 2023

Consolidated case re. entitlement to priority



Referring decisions – T 1513/17 & T 2719/19

- US priority application (provisional) naming three inventors as applicant
- PCT application naming
 - the three inventors as applicants for the US (“applicant A”)
 - Alexion Pharmaceuticals and the University of Western Ontario as applicant for all other states (“applicant B”)
- Two of the inventors had not assigned their right to the US provisional application to “applicant B”
- The invention had been published in the priority interval
- In respect of EP 1 755 674, the Opposition Division held that the claim to priority was invalid and revoked the patent in view of the prior art published in the priority interval
- In respect of a divisional application, EP 16160321.2, the Examining Division likewise held that the claim to priority was invalid and refused the application

Questions referred

- I. Is the EPO competent to assess whether a party is entitled to claim priority under Art. 87(1) EPC?
- II. If question I is answered to the affirmative: Can a party B validly rely on the priority right claimed in a PCT application for the purpose of claiming priority rights under Article 87(1) EPC in cases where
 - (1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and
 - (2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and
 - (3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

Basic legal provisions

- EPC priority is not governed by the Paris Convention
- However, the provisions of the EPC are intended not to contravene the basic principles of the Paris Convention
- Art. 87(1) EPC: “Any person who has duly filed ... or his successor in title, shall enjoy ... a right of priority” – Nearly identical wording in Art. 4A(1) of the Paris Convention
- EPC Art. 88: “An applicant desiring to take advantage of the priority of a previous application shall file a declaration of priority and any other document required, in accordance with the Implementing Regulations”
- EBA: The concept of priority serves the purpose of facilitating international patent protection

"Joint applicants approach" – T 1933/12

- A is applicant for the priority application
- A and B are joint applicants for the later application
- Party B can benefit from the priority right to which its co-applicant A is entitled
- A separate transfer of the priority right to party B is not needed
- Does the "joint applicants approach" also apply in the context of PCT applications
- The referring decisions noted that the "PCT joint applicants approach" was a disputed concept

The autonomous law of the EPC

- As opposed to questions of entitlement to the right to invention which are governed by national law, priority rights are autonomous rights under the EPC and should be assessed only in the context of the EPC
- The autonomous law of the EPC
 - should not establish higher formal requirements than those established under national laws
 - should not require that the assignment has to be in writing or has to be signed
 - does not necessarily require that the transfer of the right to priority has been concluded before the filing of the subsequent application
- If there are jurisdictions that allow an ex post transfer of priority rights, the EPO should not apply higher standards

Rebuttable presumption of entitlement to claim priority

- Under Rule 53(1) EPC, a copy of the priority application must be filed with the EPO within 16 months after the priority date
- Publication of the priority application normally occurs 18 months after the priority date
- The fulfilment the formal requirements of Art. 88(1) EPC can be seen as strong factual evidence of the priority applicant's approval of the subsequent applicant's entitlement to priority
- The presumption of entitlement to priority should be rebuttable since in rare exceptional cases it may not exist

The rebuttable presumption - conclusions

- The entitlement to priority should be presumed to exist
- It cannot be excluded that in the context of the rebuttal of the presumption national laws need to be considered

PCT applications - the concept of an implied agreement

- The joint filing of the PCT application sufficiently proves that the parties entered into an implied agreement allowing party B to rely on the priority right established by the filing of the priority application by party A
- To put into question the implied agreement, evidence would be needed that an agreement on the use of the priority right has not been reached or is fundamentally flawed
- The EBA leaves open the validity of the "PCT joint applicants approach" but endorses the concept of an implied agreement
- In the absence of substantial factual indications to the contrary, the joint filing of the subsequent PCT application sufficiently proves that an implied or informal agreement exists

Answers to the questions posed

- The EPO is competent to assess whether a party is entitled to claim priority under Art. 87(1) EPC.
- There is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority.
- The rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s).
- In a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary.

Life after G 1/22 & G2/22

- The risk of loss of priority due to lack of identity between the priority applicant(s) and the EP/PCT applicant(s) is significantly reduced
- However, entitlement to priority can still be challenged under national law
- It is still highly recommendable to ensure an unbroken chain of written assignments from the inventors to the subsequent applicant(s)

Referral G1/23

T0438/19 – Solar Cell Sealing Material

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G1/23 - Principles

- A product is available on the market or described in the literature
- Its internal structure/composition is unknown
- Reverse engineering and/or analysis is required.
- E.g. polymer materials or minerals, but also biological cells, software, electronics and complex mechanics

G 1/92 – Availability to the public

1. The chemical composition of a product is state of the art when the product as such is available to the public and can be analysed and reproduced by the skilled person [without undue burden] irrespective of whether or not particular reasons can be identified for analysing the composition.

2. The same principle applies mutatis mutandis to any other product.

T0438/19 – technical background

- Example 3 of document D1 disclosed a polymer ENGAGE® 8400, but no synthesis of it.
- The properties of ENGAGE® 8400 were known from D1, D2, D3 and D5, and fulfilled the parameters of claim 1.
- The opponent argued – with reference to G1/92 – that a skilled person could analyse ENGAGE® 8400, that it was “disclosed”, and that claim 1 would thus lack inventive step over D1, Example 3

T0438/19 – technical background

- Proprietor – no, ENGAGE® 8400 has not been made “available to the public” – not enabled
- An exact analysis of ENGAGE® 8400 has not been made
- Reverse-engineering such a polymer – including catalysts and reaction conditions – would constitute a research programme.
- It would be undue burden to provide a polymer that is not just “similar to” but exactly the same as ENGAGE® 8400.
- Therefore Ex. 3 of D1 is not closest prior art.

T0438/19 – Divergent Case Law

Three aspects were identified, where case law has diverged in interpreting G1/92 :

- (i) the interpretation of “available to the public” (the product itself, or merely its chemical composition?)

- (ii) the degree of detail required for the analysis of said product (exact composition required?)

- (iii) the requirements for the reproducibility of the product (exact reproduction required?)

T0438/19 – (i) “available to the public”

If a product put on the market could not be analysed or reproduced..case law has developed in two ways...

(a) the product itself was state of the art, but its chemical composition (or internal structure) was not state of the art (T 946/04; T 1666/16)

OR

(b) the product itself was not state of the art, thus its chemical composition or internal structure is not state of the art either (T 370/02; T 2045/09; T 1833/14; T 23/11).

T0438/19 – (i) “available to the public”

If..(a) the product itself was state of the art, but its chemical composition (or internal structure) was not state of the art

- The product could still be used as a starting point for the assessment of inventive step

- Particularly if new facts came to light

T0438/19 – (i) “available to the public”

If ..(b) the product itself was not state of the art, thus including its chemical composition or internal structure

- The product cannot be used as a starting point for the assessment of inventive step

T0438/19 – (ii) the degree of detail required

- T 946/04 – The exact composition of the sold product must be determinable.
- T877/11 – “at least the main components” can be determined without difficulty
- T2458/09 – The absence of certainty about the knowledge of some structural elements of a product did not disqualify that product as the closest prior art (e.g. impurities).

T0438/19 – (iii) reproducibility

- T 1833/14 – can the skilled person prepare the product in all its properties, not only those specified in the relevant claim
- T1540/12 – “reproducibility” as per G1/92 does not require a full reproduction of the product
- T1452/16 – “reproducibility” addresses only whether the combination of the features in the claim are present.

T0438/19 – referred questions

1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?

T0438/19 – referred questions

2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Article 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?

T0438/19 – referred questions

3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of opinion G 1/92?

In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?

G1/23 – comments

- Seems artificial to “ignore” a commercial product as state of the art.
 - All parties in the referring decision agreed that ENGAGE® 8400 was commercially available.

Thanks for your attention!

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