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PATENTANWÄLTE

T 1127/16 - Determination of the scope of protection of a patent claim at the EPO in contradiction to the positive disclosure in the description

With decision T 1127/16 of the Technical Board of Appeal 3.5.03, the decision-making practice of the Boards of Appeal of the European Patent has moved even further away from the national practice of the member states of the European Patent Organisation with regard to the question of the extent to which the subject-matter of the patent claims must be interpreted in the light of the description and the drawings. While the Boards of Appeal have already in the past tended towards the view that the claims of a European patent must be intelligible in themselves[1], the present decision ultimately states that the description of the patent may not be taken into account if the claim with its wording can, in principle, make sense, even if this sense is contrary to what is disclosed by what is obviously intended in the description. But more on this in detail:

The question in dispute was whether a feature included in claim 1 during the examination procedure was originally disclosed and thus in accordance with Article 123(2) EPC. This feature (g) is reproduced in the grounds of the board of appeal's decision with its three sub-features as follows:

(g1) evaluating a preference to determine a preferred network of the plurality of transmission networks,

(g2) wherein the preference comprises a preference list identifying a selection of the plurality of broadcast networks in order of preference

(g3) and identifying the highest in preference of the plurality of broadcast networks in the preference list that is available

According to the opponents' view, which was ultimately shared by the Board of Appeal, this feature was to be understood as a procedural step in which, with regard to feature (g1), it was a matter of „evaluating a preference ...", whereby with regard to feature (g2) of the „preference" a „preference list identifying a selection of the plurality of broadcast networks in order of preference" was to be provided. Furthermore, this „preference list" should also satisfy feature (g3) „and identifying the highest in preference of the plurality of broadcast networks in the preference list that is available". Feature (g3) should therefore be another feature of the list according to this view.

The board did not accept that this feature (g3) was intended to describe a further procedural step, since - unlike the transition from the description of the „evaluating" step to the description of the list - no comma had been placed. Such a list, which also satisfied feature (g3) „identifying the highest in preference of the

[1] Decisions T 1279/04, T 1404/05, T 197/10 and T 1018/02 of the Boards of Appeal of the EPO

plurality of broadcast networks in the preference list that is available", was not, in the board's view, originally disclosed.

There is also nothing to contradict this in so far as (g3) went back to the original claim 6, which said:

> 6. The method of claim 5, wherein evaluating a preference to determine a preferred network comprises identifying the highest in preference of the plurality of broadcast networks in the preference list that is available.

Quite obviously, therefore, feature (g3) described in the original claim 6 concerned a further step in the process and not a characteristic of the list, so that in any case the original claim 6 could not support the Board of Appeal's understanding of feature (g3).

The fact that feature (g3) was intended to be a process step and not another feature of the list was also apparent, inter alia, from paragraph 0040 of the patent specification. At this point, at the latest, it was clear from the patent specification what was actually meant by feature (g3). However, instead of basing the understanding of the claim on what could be inferred from the granted patent as a whole, taking paragraph 0040 into account, the board of appeal refused to take the description into account, citing the previous case law of the boards of appeal[2], since, as explained at the beginning, the wording of the granted patent claim 1 made sense in itself.

In Our Own Affairs : EQE Preparatory Courses 2021

If the pandemic situation allows, our office will offer two free two-day preparatory courses for the C and D parts of the European Qualifying Examination (EQE exam) in 2021. The courses will be held on Monday/Tuesday, November 22/23, and Saturday/Sunday, December 4/5, 2021. Both courses are identical in content, so attending one course is sufficient.

The course content is primarily focused on appropriate exam techniques as well as strategies for avoiding mistakes in order to be able to successfully tackle the C and D parts of the EQE exam with these skills. It has been our experience that well-prepared exam materials significantly increase the chances of success. Therefore, we want to provide the participants with the necessary methodological knowledge in this course. In this respect, the course is to be understood as a supplement to the participants' own preparation of the legal fundamentals of the EPC. Instead, participants will learn how to convert their technical knowledge of the EPC into as many points as possible for passing the C and D parts of the EQE examination. The courses take place in Düsseldorf at our premises in Speditionstr. 21 and are free of charge. Speakers of the course are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Dr. Aloys Hüttermann.

Registration is now possible (please state your full name and employer) at eqe@mhpatent.de.

The board of appeal also rejected the patent proprietor's request to refer the case to the Enlarged Board of Appeal, as - contrary to the patent proprietor's opinion - there was no reason to fear a deviation from decision T 131/15. That decision dealt with a situation in which the literal and isolated consideration of an expression in a granted claim would have the effect of excluding all disclosed embodiments from the scope of protection. However, in that situation, if a definition of the term could be derived from the patent itself, by which at least some of the disclosed embodiments would have to be subsumed under the claim, then, in assessing compliance with the requirements of Article 123(3) EPC, the scope of protection should normally be considered to include at least what would fall under the claim according to that definition. However, the board did not see such a situation here, since at least some of the embodiments in principle (but

[2] Decision T 1202/07 of the Boards of Appeal of the EPO

without describing this) allowed a process as disclosed by the granted claim 1 in the board's view.

One could now take this decision as an opportunity to warn against being too careless with the original disclosure in the European grant procedure. One could also point out that this practice of the European Patent Office poses a problem that could cause patent applicants to choose national applications instead of a European application for really important inventions. Finally, experience shows that at the German Patent and Trade Mark Office, for example, a practical examination is regularly carried out which takes into account how the invention described in the application as a whole is understood by a person skilled in the art.

The actual problem of the present decision becomes apparent, however, when it is compared with the practice in the contracting states, e.g. with the practice in Germany. While the German Federal Court of Justice, for example, has come closer and closer to the practice of the European Patent Office in its assessment of the concept of novelty[3], the Boards of Appeal of the European Patent Office seem to be moving further and further away from the national practice in Germany with the present case law.

Contrary to the board's decision in the present case, according to established German practice, the content of the patent claims is decisive for the scope of protection, i.e. neither the patent specification in its entirety nor the literal wording of the claim[4]. The content of the patent claims does not correspond to the wording but to the literal sense of the claims and has to be determined by interpretation, always, irrespective of whether the claims contain ambiguities or contradictions[5]. The interpretation of the patent claim is therefore always required and must not be omitted even if the wording of the claim appears to be unambiguous, since the description of the patent can define terms independently. As is well known, the patent specification is its own dictionary[6]. The same principles[7] apply to the interpretation in opposition proceedings, nullity proceedings and infringement proceedings. The interpretation of the claims against the background of the description and the drawings is therefore not only necessary in the case of infringement or for the question of the extension of the scope of protection (Article 123(3) EPC), as has been postulated in part by the boards of appeal[8]. This would also not be appropriate, since the scope of protection defining the right to prohibit can ultimately only endure if it is new and inventive compared to the prior art. The concept of the scope of protection must therefore always be the same for the question of protectability and for the question of patent infringement.

Again, these aspects have not been taken into account by the Board of Appeal responsible here. It is questionable whether it is even an issue for the Boards of Appeal whether their case law is in line with the applicable practice in the

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3 BGH - X ZR 89/07 Olanzapine

4 BGH - X ZR 172/04 Decay time measuring device

5 BGH - X ZR 43/13 Rotor elements

6 BGH - X ZR 85/96 clamping screw, BGH - X ZR 198/01 one-piece material, but also decisions T1321/04, T 1089/11 and T 25/15 of the Boards of Appeal of the EPO

7 BGH GRUR 07, 859 Information transmission procedure I

8 Decisions T 1279/04, T 2221/10 and T 1646/12 of the Boards of Appeal of the EPO

member states. In any case, Article 64(3) EPC cannot be a justification for the Boards of Appeal to assess the question of the protectability of a patent, which includes the question of original disclosure, differently in European examination and opposition proceedings than, for example, in German invalidity proceedings, since this provision only concerns the treatment of infringement of a European patent, which is to be dealt with under national law. Nevertheless, at present it seems that, at least with regard to the original disclosure, the final grant of a patent before the European Patent Office is tantamount to passing through the eye of the needle[9], opening up the kingdom of heaven of national German jurisdiction to the patent proprietor.

Patents and COVID-19 - Is there anything to report here?

2020 was and 2021 remains a special year due to the new Corona virus and the pandemic it triggered.

First reports came from China in late 2019, and the virus was made available to the scientific community on 10 January 2020, when Chinese researchers uploaded its genome to Genbank (NCBI reference sequence: NC_045512.2). The International Committee on Taxonomy of Viruses (ICTV) named the new virus „severe acute respiratory syndrome coronavirus 2 (SARS-CoV-2)“ on 11 February 2020. On the same day, the WHO announced „COVID-19“ as the name for this new disease on 11 February 2020.

Since then, the world has changed. Vaccines have been developed at record speed, and discussions have flared up about their equitable distribution. Voices are also being raised calling for the suspension of patent protection for COVID 19 vaccines, as such patents are blamed for limited access to this vaccine, especially in emerging countries.

Wait a minute - patents? Aren‘t patent applications only published 18 months after the priority date? And hasn‘t SARS-CoV-2 only been known for less than 18 months?

Time for a patent search. Here is what we found in the various databases:

Database	Search query	Number of hits
Orbit	(Questel)(Sars-Cov-2)/TI/AB/CLMS/DESC/ODES	0
Espacenet	SARS-COV-2 (title or summary)	430
Google	Patents„SARS-COV-2“ (search term)	1753

[9] Based on Mark 10:25

OK, this is surprising. How can we find 1753 patent documents in April 2021 for a search term that was coined only 14 months earlier? Well, probably not that surprising. We analysed the hits and found the following types of documents:

Type	Example	Data
German utility model, usually published within 3 to 6 months after application	DE202020105116U1 („Reagents and uses for the diagnosis of SARS-CoV-2 infection“)	Priority date: 2020-02-20 Publication date: 2020-10-06
Patent application that has a priority date before February 2020 and a filing date after February 2020, where the content of the 2nd application has been „enriched“ by adding references to SARS-CoV-2	WO2020260716A2 („Substrate kit system and method for biological assays“) Application refers to substrate kit for virus detection, language on SARS-CoV-2 added to PCT application text	Priority date: 2019-06-27 (priority application does not mention SARS-CoV-2 yet) PCT filing date: 2020-06-29
US Continuation in Part („CIP“) with a priority date before and a filing date after February 2020, with disclosure related to SARS-CoV-2 added to the content of the CIP application.	WO2020260716A2 („Substrate kit system and method for biological assays“) Application relates to synthetic carbon particles (SCP) for filtering virus-containing fluids, disclosure on SARS-CoV-2 was added to PCT	Priority date: 2014-04-17 (Priority application does not mention SARS-CoV-2) CIP registration date: 2020-11-06
Patent application published earlier than 18 months at the request of the applicant	WO2021002776A1 („Immunobiological agent for inducing specific immunity against SARS-CoV-2“)	Priority date: 2020-04-23 PCT Filing date: 2020-07-30 Publication date: 2021-01-07
	CN202010177710 („Monoclonal antibody for resisting novel coronavirus and application thereof“)	Priority date: 2020-03-13 Publication date: 2020-03-13

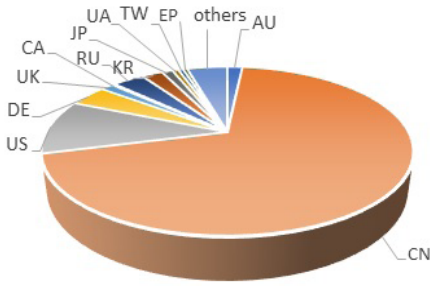
Type	Example	Data
Patent which has a priority date after February 2020 but has already been granted	US10967368B1 ("Method for reducing clinical false positives and negatives in the detection of SARS-CoV-2")	Priority date: 2020-08-19 Publication date of B1: 2021-04-06
Patent application titles routinely published by the UKIPO („phantom applications")	GB202015240D0 ("SARS-Cov-2 Antibodies") [content not available)	Priority date: 2020-03-12 Publication date: 2020-11-11

This explains most of the hits found in the Google patent search. However, 32 cases could be identified that have an actual filing date before 11 February 2020. How is this possible - did the authors have some secret knowledge or a time machine?

Well, the explanation is simple - these hits are due to an error in Google's search algorithm. Take, for example, EP1644414A2 („Binding molecules against SARS-coronavirus and uses thereof"), which is assigned to Janssen, has a priority date of 2003-07-22 and was filed on 2004-07-21. Although this application was found in the Google patent search with the search term „SARS-CoV-2", it does not actually mention this term, nor does it mention the term „SARS-CoV-1". Only the term „SARS-CoV" is mentioned.

Two other points are interesting:

(I) When analysing the Google patent search results, it becomes clear that the majority of applications come from China, as can be seen in the following graph:



Therefore, Chinese applicants seem to use this new term extensively in their patent applications and seek early publication. It should be noted that in China, applicants can request early publication of their patent applications, whereupon CNIPA conducts a preliminary examination and publishes the application immediately thereafter (unless it is rejected).

(II) Further, none of the patents and patent applications found in the Google patent search relate to any of the vaccines that have been developed at record speed. These vaccines are listed in the following table.

Moderna	BioNTech	Curevac	J&J/ Janssen	AstraZeneca	Gamaleya Inst	Novavax	Inovio
mRNA-1273	BNT162b2	CVnCoV	Ad26.COV2.S	AZD1222	Sputnik V	NVX-	INO-4800
mRNA			Viral vector			Recombinant protein	DNA plasmid (pGX9501)

Well, there is one exception. Gamaleya's vaccine Sputnik V is protected by a patent family (RU2720614C1, WO2021002776A) that has a priority date of 2020-04-23. RU2720614C1 was already granted on 2020-05-12, and the corresponding PCT application with application number PCT/RU2020/000344) was already published in English on 2021-01-07. However, similar to the approval process to which Sputnik V was subjected, one should not underestimate the political pressure that drove this patent family.

News from the G 1/21 (video conference)

As already reported[10], there has been a request from a board of appeal to the Enlarged Board of Appeal as to whether it is compatible with Art. 116 EPC to schedule oral proceedings as a video conference even without the consent of one or both parties.

There are some updates to report here. Firstly, as expected, the proceedings have now been given the file number G1/21.

Interestingly, the Board of Appeal in question decided to uphold the referral, although in the meantime the requesting party had withdrawn its corresponding request. Obviously, there is also a great interest in legal certainty on the part of the Boards of Appeal here.

The Enlarged Board of Appeal giving priority to this case can be seen from the fact that, on the one hand, amicus curiae briefs have been admitted, but only until 27 April 2021, and that a date for oral proceedings has already been set, namely 28 May 2021[11]. Interestingly, this oral hearing itself will be held by video conference (Zoom).

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[10] see our newsletters 12/2020 and 3/2021

[11] see corresponding communication of the Enlarged Board of Appeal of 24 March 2021: https://www.epo.org/law-practice/case-law-appeals/communications/2021/20210324.html

It is also worth mentioning that the President of the European Patent Office has decided not to suspend the corresponding proceedings before the Examining and Opposition Divisions despite the pending referral; these will continue to take place by video conference - even if one of the parties requests otherwise[12].

Of course, this decision has no relevance for the Boards of Appeal. Here it can be heard that oral proceedings were sometimes scheduled by video conference despite a corresponding request and reference to G1/21, but sometimes the summonses were cancelled again.

An early oral hearing is no indication of an early decision - in G1/19 (simulations)[13] it took almost nine months until the decision was issued after the oral hearing. In view of the practical relevance of the decision, however, it is to be expected that a decision - similar to the „Haar" decision G2/19[14] - will be published this summer.

[12] see corresponding communication of 24 March 2021: https://www.epo.org/news-events/news/2021/20210324a.html

[13] see our newsletter 5/2021

[14] see our Newsletter 6/2019

In Our Own Affairs

We wish your relatives, employees, colleagues and of course yourself all the best for the current, still difficult time.

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