

# ROUNDUP OF RECENT IP- RELATED DECISIONS IN THE EU

EU-JAPAN-POLICY SEMINAR  
TOKYO 30/11/2018

ZACC

# RECENT IP-DECISIONS IN THE EU

## NOVEMBER 30, 2018

### IP-Related Decisions in the EU...?

#### A Selection is to be made:

From which countries to report?

Has the decision influence on the EU?

Is it of interest for a Japanese audience?

From the Field of Infringement, of Validity or of Prosecution?

# RECENT IP-DECISIONS IN THE EU

## NOVEMBER 30, 2018

### Topics:

#### Infringement:

Decisions from the German Federal Court of Justice

#### Validity (and Patentability):

Decisions from the EPO

# RECENT IP-DECISIONS IN THE EU

## NOVEMBER 30, 2018

FIRST OF ALL, THOUGH:

WHY FOCUS REGARDING VALIDITY ONLY ON THE EPO?

# RECENT IP-DECISIONS IN THE EU

## NOVEMBER 30, 2018

An Example: Eli Lilly's "pemetrexed" patent (EP 1 313 508)

- 03/08/2016: EPO Opposition Proceedings Terminated: Patent maintained
- 14/06/2016: Infringement under Doctrine of Equivalence by German Supreme Court
  - Followed by similar decisions in UK, Switzerland and Italy
- 17/07/2018: The European patent is revoked in its entirety by the German Federal Patent Court for lack of inventive step in nullity.

# RECENT IP-DECISIONS IN THE EU

## NOVEMBER 30, 2018

- The German Federal Patent Court emphasized that the conclusion is not in contradiction to the Opposition Division of the EPO, as other prior art had been considered.

Still,...

- There is also own experience on this:
  - Omeprazole (“Prilosec”)
  - CEIPI Course in Strasbourg for the UPC: Mock trial and “EPONIA”

# RECENT IP-DECISIONS IN THE EU

## NOVEMBER 30, 2018

### National Decisions vs. EPO Decisions on validity:

#### National Decisions on validity:

- Based on and embedded in national tradition
- Efforts taken to harmonize between national jurisdictions

#### EPO Decisions on validity:

- Starting from national tradition but jointly developing by different (EU) nations
- Always more based on a formal approach (for transparency)

So, given that the Unitary Patent System will also end bifurcation  
the EPO decisions are chosen for validity

# RECENT DECISIONS AT THE BGH NOVEMBER 30, 2018

## Decisions by the German Supreme Court (BGH):

1. X ZR 120/15, of 16/05/2017; “Abdichtsystem”
  - Supplying infringing products abroad makes the supplier potentially liable if he was aware that the products reach the German market through his customers.



# RECENT DECISIONS AT THE BGH NOVEMBER 30, 2018

## Decisions by the German Supreme Court (BGH):

### X ZR 120/15, of 16/05/2017; “Abdichtsystem”

- A supplier of infringing products who is located abroad and is supplying the products to a customer who is also abroad is – in principle – not responsible for controlling the further use of his product by his customer.
- Still, this supplier might become responsible for this if he becomes aware of facts that make it appear likely that his customer delivers to the German market where patent protection exists.
- Patent infringement then potentially becomes relevant if a patent infringement occurred or is likely to occur.

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

### Trends looking at a few aspects of EPO Decisions:

- 1. Last Enlarged Board Decision (G01/16): Disclaimer**
- 2. Late Filed documents**
- 3. Support (The difficulties of features taken from the description)**
  - Intermediate Generalization**

# RECENT IP-DECISIONS IN THE EU

## NOVEMBER 30, 2018

### Focus of the EPO (Reflected in the Decisions):

EPO focusses on:

- Development of Tools (logical to and usable for more than **30 nations**)
- Speeding up processes
- Making the decisions predictable
  - Not necessarily the best (or “right”) decision, but...

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

### Part 1: Decision of the Enlarged Board of Appeal:

- G 01/16:

- Decision of December 2017
- Subject: The undisclosed Disclaimer (DISCLAIMER III)
  - What is the undisclosed disclaimer and what is it good for?
- History: Preceding Decisions G1/03 and G2/10
- Rectification?
- Headnotes:
  - Practical considerations

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

### Part 1: Decision of the Enlarged Board of Appeal:

#### G 01/16:

- What is the undisclosed disclaimer and what is it good for?
  - An undisclosed disclaimer is a disclaimer introduced into a (likely independent) claim, with which a part of the scope of the claim is defined as being excluded from the scope of the claim.
  - The wording (or the excluded subject) of the disclaimer is not properly disclosed in the description and thus - in general - would contradict Art. 123(2) EPC. Thus, the disclaimer is “undisclosed”.
  - It serves the purpose of excluding subject matter from the claim that would otherwise give rise to objections under EPC, e.g. lack of novelty.
  - It is (or was) most often used to exclude subject matter of “older rights”, European patent applications having a prior time rank but are published after the filing (priority) date of the younger (Art. 54(3) EPC).

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

### G 01/16

- History: Preceding Decisions G1/03 and G2/10
  - Decisions G1/03 (and G2/03) dealt with the allowability of undisclosed disclaimers.
    - G 1/03 developed specific criteria to be applied in determining the allowability of such undisclosed disclaimers, but did not explicitly address the matter of the relevance of a so-called “gold standard test” as developed in G2/10 (below).
  - Decision G2/10 dealt with the allowability of disclosed disclaimers.
    - G2/10 applied an existing specific criteria (the “gold standard test”) to determine the allowability of disclosed disclaimers. Still, even though G2/10 referred in principle to disclosed disclaimers, in various points the decision hinted at that these criteria would also be applicable to the undisclosed disclaimer (G1/03). This made undisclosed disclaimers (especially over Art 54(3) in practice no longer applicable and somewhat contradicted and derailed G2/03.
    - Golden standard: “what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of these documents as filed.” (G3/98)

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- G 01/16: Headnotes

- For the purpose of considering whether a claim amended by the introduction of an undisclosed disclaimer is allowable under Article 123(2) EPC, the disclaimer must fulfil one of the criteria set out in point 2.1 of the order of decision G 1/03.
- The introduction of such a disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. The disclaimer may not remove more than necessary either to restore novelty or to disclaim subject-matter excluded from patentability for nontechnical reasons.

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

### G 01/16: Practical considerations:

First a disclaimer must fulfill the criteria set up under 2.1 of G01/03, thus either:

- restore novelty art under Article 54(3) EPC;
- restore novelty over an accidental anticipation under Article 54(2) EPC; or
- disclaim excluded subject-matter under Articles 52 to 57 EPC.

Then, the disclaimer may not help the applicant overcoming:

- objections for lack of inventive step; or
- objections for lack of sufficiency of disclosure.

Finally, the disclaimer may not remove more than necessary.

A very praxis-orientated decision.



# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- Late Filed Requests

General Remark (1/2):

There is a growing tendency in the EPO to consider many requests as laid filed. Especially the Boards of Appeal considers Requests filed after the Grounds of Appeal were filed very often as already late filed. This is – in principle – covered by the right of the BoA to be admitted and considered at the board's discretion (Article 13(1) RPBA).

It has become increasingly important to develop the strategy already at the very beginning of the appeal.

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- Late Filed Requests

General Remark (2/2):

Late filed Auxiliary Requests are – at the discretion of the Board – very often admissible, though, if

- the scope of discussion is not increased and
- the claims are clearly allowable.

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- Part 2-1: Late Filed Requests
- T 1385/13 (May 2018):
  - The Main Request and the 1<sup>st</sup> Auxiliary Request were filed 1 month before the Oral Proceedings in a one-sided proceeding.
  - They were not admitted into the proceedings as not helping the procedure.
  - Please note that this was even rejected in a one-sided proceeding.

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- Late Filed Requests

- T 830/14 (May 2018):

- The 1<sup>st</sup> Auxiliary Request filed 20 days before the Oral Proceedings in an opposition case was not admitted:
  - Late filed
  - Issues of support (Art. 123(2) EPC)
- The 2<sup>nd</sup> Auxiliary Request filed also 20 days before the Oral Proceedings in an opposition case was admitted:
  - Being just a modification of a Request filed in Response to the Appeal,
  - not raising any formal issues and
  - not having been objected-to by the appellant

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- Late Filed Requests
- T 0382/14 (May 2018):
  - Opposition
  - The Auxiliary Request was filed in the oral proceedings.
  - The Request was admitted into the proceedings as clearly allowable and as not broadening the discussion.

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- Lack of Support (Feature from Description)

### General Remark (1/3):

Again, there is a well-known tendency in the EPO to take a very tough view on support during Examination Proceedings.

Still, often a feature taken from the description offers the preferred way to overcome an objection of novelty/inventive step, even though being more difficult on support than a feature from the claims.

Even if the applicant succeeds in convincing the Examining Division of sufficient support, this brings a potential complication into any following Opposition.

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- Lack of Support (Feature from Description)

General Remark (2/3):

Even if the Opposition Division accepts the support (Art. 123(2) EPC) of claim 1 of the granted patent with the feature from the description, fallback positions are difficult.

Opposed to combining features from claims, the support then has to be found in relation to the part of the description, where the respective feature in granted claim 1 is described. This can be difficult and often leads to limited choices for defending against novelty/inventive step attacks as the fitting new feature might not be disclosed in relation to the feature from the description that was part of granted claim 1.

This is a severe limitation in your options.

# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- Lack of Support (Feature from Description)

General Remark (3/3):

Thus, please take this into consideration if looking for a solution to overcome novelty or inventive step objections during EPO Examination:

- A feature from the description might offer the broadest scope of protection,
- If a feature from the claims is the 2<sup>nd</sup> best choice, though, please give it also a thought in the light of the above.

Also please consider this when preparing a claim set.

The EPO remains constantly adamant in their stance on support.



# RECENT DECISIONS AT THE EPO

## NOVEMBER 30, 2018

- Lack of Support (Description)
- T 2003/14 (September 2018):
  - The Patent as granted (Main Request) was considered not inventive.
  - The 1<sup>st</sup> Auxiliary Request contained additional features from claim 2 as granted as well as from a part of the description relating to a Figure 2:
    - The addition from claim 2 was not problematic
    - The addition from the description was considered to have left out features that were linked to the feature taken up. Thus, it was considered an intermediate generalization.

**THANK YOU** FOR YOUR ATTENTION

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