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AI in the UK – Not Coded by a Human, No Problem

British Patents Court deems artificial neural network invention as inherently not excluded from patentability, opens up new frontier in patenting AI in the UK.

Across both traditional and future industries, there is greater than ever interest in the benefits that adopting artificial intelligence (AI) technologies will bring, and a corresponding marked surge in the number of AI-related patent applications (ten-fold in the last ten years, by some estimates). However, one of the chief barriers to investing in IP protection for such inventions that, when implemented, typically rely on computer code to deliver their effects is the uncertainty as to whether such inventions are even protectable in law, given the statutory or judicial exclusions of the patenting of abstract ideas, computer programs, and/or mathematical methods.

In the US, the *Alice decision*¹ resulted in many AI-related applications being deemed as not defining significantly more than an abstract idea. In the EPO, the *Bentley Systems decision*² confirmed that a computer-implemented mathematical model must solve a well-defined technical problem relative to the state of the art to be patentable, with the definition of *technical excluding problems solely existing in the excluded domain of software, mathematics or business methods*.³ Finally, in the UK, the *Aerotel/Macrossan decision*⁴ set down that a computer-implemented invention had to provide a technical contribution to the art, i.e. a contribution which itself did not fall within the same excluded domains. In all three jurisdictions, it seemed until recently clear that an invention could not solely rely on the use of an AI technology such as an artificial neural network to avoid exclusion from patentability.

In a radical departure from this expected approach, the British Patents Court has handed down judgment in the case of *Emotional Perception AI's application*⁵ which not only opens up new lines of argument in favour of patenting AI-related inventions, but has forced the UK Intellectual Property Office (UKIPO) to issue an immediate guidance note⁶ confirming that it will henceforth change its examinations practice in this domain.

The event underlying this judgment was the refusal of the UKIPO to grant *Emotional Perception AI Ltd's application GB1904713.3* entitled "*Method of training a neural network to reflect emotional perception and related system and method for categorizing and finding associated content*" and relating to the training of an artificial neural network (ANN) to perceive semantic similarity or dissimilarity between media files and using the trained ANN to recommend a file which is semantically similar to a given input. The Examiner entrusted with the case took the view that the claims did not provide a technical contribution outside of an excluded domain.

The applicant took the application to an administrative hearing within the UKIPO, and argued that "the invention of the Application is an ANN-based system for providing improved file recommendations. The invention may be hardware or software implemented. The fundamental insight is in the training of the ANN which analyses the physical properties of the file by pairwise comparisons of training files. In these pairwise comparisons the distance in property space between the output (property) vectors of the ANN is converged to reflect the differences in semantic space between

¹ *Alice Corp v. CLS Bank International* at the US Supreme Court, 573 U.S. 208 (2014).

² *Bentley Systems (UK) Limited's application at the EPO's Enlarged Board of Appeal, G0001/19*.

³ See also *Danche Spirkoska Jovanov, G 1/19 – More Clarity on Computer-Implemented Simulations* at the European Patent Office (EPO), *HOFFMANN EITLE Quarterly*, June 2021, pp. 8-10.

⁴ *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application at the UK Court of Appeal, [2006] EWCA Civ 1371*.

⁵ *Emotional Perception AI Ltd v Comptroller-General of Patents* at the Patents Court [2023] EWHC 2948 (Ch).

⁶ "Examination of patent applications involving artificial neural networks (ANN)". GOV.UK, Intellectual Property Office, 2023.

the semantic vectors of each pair of files. The result is that in the trained ANN, files clustered close together in property space will in fact have similar semantic characteristics, and those far apart in property space will have dissimilar semantic characteristics. Once trained the trained ANN can then be used to identify, swiftly and accurately, files from a database which correspond semantically to a target file, and to provide – swiftly and accurately – file recommendations to a user device (over a communication network)", and that this contribution was technical and outside of an excluded domain, in particular since an ANN did not operate in the traditional way of computer software – a series of "if-then" type logical statements defined by a human programmer – but uses training data to learn the logic to solve a problem and reconfigures itself accordingly, independently of a (human) programmer.

The UKIPO Hearing Officer accepted that this was the contribution of the invention, but held that the contribution to the art was still no more than a computer program, particularly since the applicant accepted that the ANN could be implemented wholly in software. The hearing officer concluded that in essence an ANN was an abstract model which takes a numerical input, applies a series of mathematical operations, and outputs a numerical result at successive layers, and therefore a claim to an ANN or the algorithm by which it is trained, in a general and abstract sense, relates wholly to a mathematical method. Here, the application was to a file recommendation engine, which was enough to escape the mathematical method exclusion, but not the computer program exclusion. The application was therefore refused.

The applicant chose to appeal the refusal to the Patents Court, where the matter came before Sir Anthony Mann for determination.

The Court first considered the technical operation of an ANN as follows: "An ANN consists of layers of neurons which, anthropomorphising somewhat, are akin to the neurons in the brain. They are arranged in layers and connected to each other, or at least some others, and to layers below. Each neuron is capable of processing inputs and producing an output which is passed on to other neurons in other layers, save that the last layer produces an output from the system and not to another layer. The processing is done according to internal instructions and further processes such as weights and

biases applied by the neurons. Thus one feeds data in at the "top" and it is processed down through the layers in accordance with the states of the neurons, each applying its weights and biases and passing the result on, until the result of the processing is reflected in an output at the bottom. The ANN is capable of learning how to process by training." The Court considered an ANN as, as described, a piece of hardware, but one the operation of which could be emulated in software form, which would deliver the same effects, albeit usually slower than a purely hardware ANN.

The Court then considered the decision of the UKIPO, and came to the view that, on this basis, a hardware-implemented ANN was a computer (as it processes data, but not necessarily because it runs things called a program) and a software-emulated ANN necessarily involved a computer. In case of a hardware ANN, there is no computer program to which the exclusion applies. Regarding an emulated ANN, the Court differentiated between the training part and the part in which a computer operates the trained ANN. The emulated ANN, not implementing code given to it by a human, is not considered a program for a computer. With regard to a program which achieves, or initiates, the training of the ANN, the Court considered this to involve the setting of training objectives (by a computer programming activity), but considered that the corresponding claim goes beyond that programming level and therefore concluded that the claim is not to a computer program. Further, the Court considered whether a computer program which emulated a hardware ANN gave a technical contribution beyond software. The Court reasoned that an emulated ANN, in substance, is operating at a different level from the underlying software on the computer, and it is operating in the same way as the hardware ANN. The Court reached the view that if the latter is not operating a program, then neither is the emulation.

Having reached the view that neither the hardware-implemented nor software-implemented ANN is merely operating a computer program, and briefly considering whether taking into account the training program would change this view, the Court then concluded that neither the claim nor its contribution to the art constituted a computer program, citing the contribution as provision of improved file recommendations via a sophisticated learning process and operation of the ANN, which embodied itself in the transmission of a chosen file. The transmission results

from a file having been identified as being semantically similar by the application of technical criteria which the system has worked out for itself, in a technical way.

The Court concluded by remarking that even if this were not the case, provision of a trained ANN could be a technical effect as such, and could be regarded as a technical advance, in particular if it were identified by reference to the training that it received.

It is notable that, for procedural reasons, the Court did not consider whether the invention would be excluded as relating to a mathematical method rather than a computer program. However, on the basis of the analysis provided by the Court, it does not seem that the Court would have reached a different conclusion, in particular in view of the focus of the Court on the hardware construction of the ANN, its emulation in software as providing the same results as the hardware, and the additional technical effect of providing improved file recommendations, had the mathematical method point been considered.

Of course, this judgment is specific to ANNs, and does not address other AI models such as random forests, support vector machines, or evolutionary algorithms. Moreover, the judgment is given at first instance, and the Court of Appeal or Supreme Court may yet take a contrary position in a future case. However, for the time being at least, where an AI model can be conceptualised as hardware or hardware emulated in software, this judgment gives a clear direction that the model and its applications should in principle be patentable.

As a result, the UKIPO has updated its statutory guidance to explain that British patent examiners should no longer object to inventions involving ANNs under the “*program for a computer*” exclusion. This stands in stark contrast to the guidance⁷ offered by the EPO to its examiners, that “*Artificial intelligence and machine learning are based on computational models and algorithms for classification, clustering, regression and dimensionality reduction, such as neural networks, genetic algorithms, support vector machines, k-means, kernel regression and discriminant analysis. Such computational models and algorithms are per se of an abstract mathematical nature, irrespective of whether they can be “trained” based on training data.*”

At the heart of this decision is a finding that an ANN is a particular type of computer, which does not execute a program as such, and such is untouched by the exception to patentability for computer programs. In particular, the Court took a relatively narrow view of programming to exclude the process of training an ANN if that is restricted to setting the training objectives in terms of the structure of the ANN (if in software).

In traditional programming, there is a computer, which has access to data, and which executes a program, a defined series of steps, to produce an output. In contrast, the Court saw the ANN as operating on data to generate output without having been programmed specifically to do so, writing that it is not correct to view the whole thing (i.e. training and the subsequent emulated ANN) as some sort of overall programming activity for the purposes of the exclusion, as the Hearing Officer might have thought.

There of course is room for substantial debate, both practical and philosophical, as to whether the Court’s approach is one that could universally be accepted. Many simulation tasks can be performed on analogue, i.e. fully hardware-implemented computers⁸ for which no specific programming is required. Computer programs, themselves, are compiled and executed as machine code and ultimately in the interactions of very large numbers of electronic switches. It might legitimately be asked where the difference lies between a claim to a computer performing a set of method steps and a computer configured by code to emulate analogue or digital hardware which performs those steps. For this reason, the impact of the present decision is likely to be limited to inventions involving ANNs and anything which can be argued conceptually to resemble them, rather than prompting a wholesale revision of the UK’s approach to computer-implemented inventions.

As a final comment, the question of whether the EPO would have reached a similar conclusion as the UK Patents Court on this invention may be somewhat speculative. On the one hand, since neither the ANN nor an application to classifying and/or transmitting files may be considered sufficient to confer technicality (taking into account the EPO’s BDGB Enterprise Software decision⁹ relating to a computerised method for classifying text documents), some scepticism may

⁷ EPO Guidelines for Examination, G-II-3.3.1.

⁸ Analog computer. In Wikipedia. Retrieved 15:14, December 5, 2023, from https://en.wikipedia.org/w/index.php?title=Analog_computer&oldid=1185871122

⁹ BDGB Enterprise Software’s application at the EPO Board of Appeal, T 1358/09.

be in order. On the other hand, the EPO may be open to arguments distinguishing traditional computer programming from technology in which an ANN learns from experience without being told how to do it by a human being. Therefore, regardless of the practical and philosophical debates this decision will doubtless inspire, the Emotional Perception AI decision opens up new possibilities for obtaining protection of AI-related inventions at least in the UK, where other patent offices might take a more restrictive view. Moreover, since UK infringement law has recognised¹⁰ infringement even when elements of a client-server system are outside the UK, patent protection in the UK for cloud-enabled AI technologies remains valuable. Thought should therefore be given to prosecuting a GB patent application alongside an EP application in relation to AI technologies, to maximise the prospects of obtaining an enforceable right.

Mark A.G. Jones

D.Phil., M.Sc. (Physics)
Partner | British and European Patent Attorney |
UPC Representative
HE Mechanical Engineering practice group



Axel T. Esser

Dr. rer. nat., Dipl.-Phys.
Partner | German and European Patent Attorney
HE Electrical Engineering & Digital Technologies practice group



¹⁰ Menashe B M Ltd v William Hill Organisation Ltd in the UK Court of Appeal, [2002] EWCA 397 (Pat).

G1/22 and G2/22: The EPO's Enlarged Board of Appeal Decision on the Entitlement to Priority

The decision of the Enlarged Board of Appeal (EBA) in the cases G1/22 and G2/22 concerns the right to claim priority from an earlier application under Art. 87(1) EPC. It specifically addresses the aspect of who is entitled to claim priority for its subsequent application, i.e. it regards the so-called "formal priority".

The decision is a remarkable reversal of the previous EPO case law. According to the EBA, the applicant is presumed to be entitled to claim priority, shifting the burden of proof to the party challenging the validity of the priority claim (the "Challenger"). Although this presumption is rebuttable, it is a strong presumption so the Challenger must demonstrate that specific facts raise serious doubts as to the applicant's entitlement to priority. The EBA also held that the priority right, and any related assignments thereof, are subject only to the autonomous law of the EPC and not any national law. As the EPC does not contain any provisions on assignments of priority rights, this means that the lowest standards established by any national law are to be applied and that informal or tacit assignments of priority rights are to be accepted by the EPO in almost all circumstances.

As the EBA also emphasizes, national courts and the UPC are not bound by the EPO's decision. These courts are operating under more comprehensive statutory provisions, for example conflict of laws rules, which may prevent them from following the EPO in all aspects of the decision. Challenges to the formal priority may therefore in the future have more chances of success in national nullity or revocation actions. Despite the EBA decision, it therefore remains best practice to properly document any transfer of priority right before filing the subsequent application.

Background

The right to claim priority for a European patent application is set forth in Articles 87 to 89 EPC. Art. 87(1) EPC reads:

***Any person who has duly filed** [...] an application for a patent, a utility model or a utility certificate, **or his successor in title**, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application. (emphasis added)*

It follows from this provision that the right to claim priority belongs to the "person who has duly filed" the priority application, unless it has been transferred to a "successor in title". Thus, one of the conditions for a valid claim of priority is that the applicant of the subsequent application is the person to whom the priority right belongs, i.e. that this person is entitled to claim priority for the subsequent application.

While, in the first few decades of the EPO, the entitlement to priority was rarely challenged in EPO proceedings, in the last decade or so it has become common practice to contest formal priority in opposition proceedings, at least where the applicant(s) of the opposed patent were not also the applicant(s) of the priority application. Since the burden of proof was generally held to be on the patentees, for the opponents it was sufficient to point out the difference in applicants. Then patentees had to prove that the priority right was acquired prior to the filing of the subsequent application. Since information about such transfers was usually entirely in the hands of the patentees, the standard of proof was mostly held to be the very strict "beyond reasonable doubt" standard. Patentees faced a very high threshold which could usually only be overcome by contemporary written evidence.

Many of these cases originate from priority applications filed in the U.S., mostly preceding the America Invents Act (AIA) when U.S. patent applications had to be filed by the inventors. This often resulted in a situation where a priority application was filed in the name of employee inventors, and where the subsequent PCT application named the employee inventors as applicants for the U.S. only and the employer as applicant for all other designated states. This scenario is referred to herein as “PCT joint applicants” scenario.

Where the entitlement to priority was decisive for the outcome of the case, the Opposition Divisions and Boards of Appeal therefore pored over assignments, other contemporary documents and expert opinions on national law, and revoked patents when the proprietor could not sufficiently demonstrate to have acquired the priority right prior to the filing of the application underlying the patent in dispute. One of the most high-profile cases was the Broad Institute’s CRISPR-Cas patent (T 844/18), which was revoked by the Board of Appeal without referring questions to the EBA.

Eventually, Technical Board of Appeal 3.3.04 referred questions in this respect to the EBA in cases T 1513/17 and T 2719/19, in consolidated proceedings. These questions were:

- I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?
- II. If question I is answered in 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 the case 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?

The EBA decision

On October 10, 2023, the EBA answered the referred questions in its decision in G 1/22 and G2/22.

As regards the first question, i.e. the competence of the EPO to assess the entitlement to claim priority under Art. 87(1) EPC (“formal priority”), the EBA agreed with the position of the referring Board of Appeal and held that the EPO must assess whether the applicant(s) were entitled to claim priority.

At the same time, however, the EBA – quite creatively – introduces a novel legal concept, the rebuttable presumption of priority. According thereto, the applicant claiming priority is presumed to be entitled to claim priority, which shifts the burden of proof to the Challenger. As will be addressed below, the details of this presumption and its legal basis make it very difficult for a Challenger to rebut this presumption.

The EBA provides a similarly nuanced answer to the second question, namely whether applicants for the territory of the EPC in a PCT application are entitled to claim priority if the PCT application is filed jointly with the applicant(s) of the priority application whereby the latter are only applicants in the PCT application for a territory other than the territory of European regional patent protection (“PCT joint applicants approach”). The EBA appears not convinced that in such a situation the applicant for the EPC territory could be deemed to be entitled to the priority right, i.e. without requiring any transfer of the priority right, but it does not provide a definitive answer to this legal question. According to the EBA, the rebuttable presumption in most cases should lead to the same result since the joint filing of the PCT application implies an agreement between the co-applicants, unless there are substantial factual indications to the contrary.

The EBA decision renders inapplicable a quite extensive body of case law and prior practice by the EPO's Opposition Divisions and Boards of Appeal. It completely reverses the positions and chances of success of patentee and opponent when challenging priority. We expect that the routine challenges of formal priority in EPO proceedings will come to an end and that such cases will become as rare as in the first years of the EPO, if not rarer. The EBA itself also expects its decision to have such a dampening effect:

*The rebuttable presumption concerning priority entitlement [...] **substantially limits** the possibility of third parties, including opponents, to successfully challenge priority entitlement.*
(Reason 117; emphasis added)

To be clear, this decision by the highest judicial body of the EPO is not binding on national courts or the Unified Patent Court (UPC), although the decision, which is well-reasoned, may be persuasive. Therefore, it remains best practice to properly document any transfer of priority right before filing the subsequent application.

It should also be noted that this decision will not always favor patentees. Where the opponent relies on an Art. 54(3) EPC document for a novelty attack and if the Art. 54(3) EPC status of the document depends on its priority being valid, the rebuttable presumption of validity of the formal priority also applies. In such cases it will be the patentee who must provide specific facts supporting serious doubts as to the validity of the priority claimed in the prior art patent document.

The priority as a right under the autonomous law of the EPC

As part of its reasoning, the EBA also categorizes the priority right as an autonomous right under the EPC which is not subject to any national laws. Since the EPC does not contain any conflict of laws rules, in the past, it was intensely debated which national laws govern the transfer of a priority right. The EBA has put an end to these debates. Because the priority right is held to be an autonomous right under the EPC, the priority right and any transfer of this right are only to be assessed under the EPC, according to the EBA. The application of national laws for assessing the validity of a (purported) transfer of a priority right is thus excluded.

Given that the EPC also does not contain any property or contract law provisions for the transfer of priority rights and does not impose any requirements for such transfers, the EBA concludes:

*[...] the EPO should adapt itself to **the lowest standards established under national laws** and accept informal or tacit transfers of priority rights **under almost any circumstances.***
(Reasons 99, emphasis added).

While it will have to be awaited how the decision is implemented in practice by the Opposition Divisions and Boards of Appeal, it is very likely that arguments such as that a transfer is not in writing, not signed by both parties, that the priority right is not explicitly mentioned in an assignment, or that it is not a present assignment but a mere undertaking to assign, will not prevail in opposition proceedings anymore. The transfer will likely be deemed to have taken place by informal or tacit assignments "under almost any circumstances", as the EBA writes.

The EBA even slightly opens the door to retroactive assignments, albeit in an obiter remark only. Thus, in the rare cases where this may be necessary, a retroactive assignment may be attempted.

The only aspect where the EBA sees limited room for national law to apply relating to a priority right is regarding "*the existence of legal entities being parties in transfers of priority rights*".

Note, however, that these points expressly do not apply to the right to a European patent. The EBA emphasizes and confirms the distinction between a right to a European patent and a priority right. While the right to a European patent originates in the inventor, the right to priority originates in the person filing the priority application. And, most importantly, the right to the subsequent patent remains subject to national laws and will continue to be assessed by national courts (Articles 60 and 61 EPC).

The effects and justification of the rebuttable presumption

The rebuttable presumption that an applicant is entitled to claim priority (*formal priority*) firstly reverses the burden of proof. The burden is now on the Challenger. In addition, the EBA considers it to be a "strong presumption," meaning that the Challenger must provide specific facts that raise serious doubts as to the subsequent applicant's entitlement to priority. Mere speculation is not sufficient. The bar for rebutting this presumption is therefore set very high:

*The presumption should be rebuttable since **in rare exceptional cases** the priority applicant may have legitimate reasons not to allow the subsequent applicant to rely on the priority. Such circumstances could, for example, be related to bad faith behaviour on the side of the subsequent applicant or to the outcome of other proceedings such as litigation before national courts about the title to the subsequent application.*

(Reasons 108, emphasis added)

As justification for the rebuttable presumption the EBA considers mainly: (i) the absence of formal requirements for the transfer of the right (which follows from the categorization as an autonomous right under the EPC), (ii) a balancing of the respective interests and, most importantly, (iii) the cooperation between the applicant of the priority application and the applicant of the subsequent application, which almost always is factually indispensable.

Regarding (ii), the EBA confirms an earlier decision of the Board of Appeal (T 15/01), which had already underlined the purpose of the priority right, namely to facilitate international patent protection. Inventors and their successors in title accordingly have a legitimate expectation that their international patent protection should not be jeopardized by inadvertently failing to comply with not objectively justified formal requirements. In the EBA's view, the general public's interest in legal certainty is also served, as the rebuttable presumption means that the right to priority can generally be relied upon, unless there are specific reasons that give rise to serious doubts. And while opponents may have an interest in challenging a lack of priority entitlement, the EBA notes that under the EPC third parties can never fully rely on the invalidity of the priority right. To illustrate this point, the EBA refers to the situation where a third person is entitled to the patent. Such a person can file their own patent application which under the EPC is deemed entitled to the priority of the application filed by the "wrong applicant" (Articles 61(1) and 76(1) EPC).

A central consideration in the EBA decision is (iii), the necessary collaboration of the applicant of the priority application. To be able to claim priority from an earlier application, usually the extensive and timely cooperation of the applicant of the priority application is required. A priority application is usually not published or otherwise made available to third parties before the expiry of the 12-month period for claiming priority in the subsequent application, and the applicant of the subsequent application must file a copy of the priority application certified as correct by the authority where the priority application was filed (Rule 53(1) EPC, Article 4D(1) Paris Convention). The EBA therefore held that the act of claiming priority itself already constitutes strong factual evidence of the priority applicant's consent to the claim of priority by the subsequent applicant.

It follows from this consideration and the further explanations in the decision that a key to successfully challenging formal priority in the future will likely be to present specific facts which disprove that the right holder of the priority right must have cooperated with the applicant of the subsequent application, and thus implicitly agreed to a transfer of the priority right.

The rebuttable presumption is limited to the entitlement aspect of priority. For example, the applicant must still ensure they fulfill all procedural requirements for claiming priority under Article 88(1) EPC.

The PCT joint applicant approach

Regarding the *PCT joint applicants approach*, as described above, the EBA considered the joint filing of the PCT application as sufficient evidence of an implied, tacit agreement conferring the right to benefit from the priority for the EPC territory, absent substantial factual indications to the contrary. The EBA also noted that this does not eliminate the “all applicants approach”, i.e. the requirement that all applicants of the priority application must either be co-applicants of the subsequent application, or must have transferred their priority right, but notes that the rebuttable presumption also applies in this case.

Consequences in practice

For patentees:

- the risk of losing the priority on formal grounds in EPO opposition proceedings is now significantly reduced;
- the opponent must raise substantial doubts which can overcome the *strong presumption*, in particular against the expectation that the initial holder of the priority right has consented to the filing of the subsequent application; and
- in the unlikely scenario that an opponent presents “specific facts [which] support serious doubts about the subsequent applicant’s entitlement to priority”, the patentee should consider submitting additional evidence (e.g., declarations) confirming the existence of the (tacit) consent and/or, as a last resort, aim to obtain a retroactive assignment.

For opponents:

- conversely, challenging the formal right to priority of the patentee will require arguments that go beyond mere speculation or lack of formalities, so that only challenging the (tacit) consent by the priority right holder appears to have a significant chance of success; and
- where the opponent relies on an Art. 54(3) EPC document for a novelty attack and if the Art. 54(3) EPC status of the document depends on its priority being valid, the rebuttable presumption of validity of the formal priority will also apply, meaning that it will be up to the patentee to raise specific facts supporting serious doubts about the validity of the priority claimed in the prior art patent document.

Clemens Tobias Steins

Dr. jur., Master of Laws
(University College Dublin)

Partner | Attorney-at-law,
Certified Specialist IP Lawyer
| UPC Representative

HE Patent Litigation &
Contracts practice group



Nicolas Douxchamps

Ir. (Electrical Engineering)

Partner | Belgian and
European Patent Attorney |
UPC Representative

HE Electrical Engineering &
Digital Technologies practice
group



Double Trouble: Double Patenting at the EPO

Before the European Patent Office (EPO), most practitioners are familiar with the expression *"It is a principle of procedural law generally recognised in the contracting states that two patents cannot be granted to the same applicant for the **same subject-matter**."*¹ On the basis of this principle, applicants have been facing double patenting objections before the EPO for years, despite there not being any specific legal basis in this regard in the EPC.

G 4/19 intervened by placing a sticking plaster on the issue and introducing the legal basis for the prohibition of double patenting under Article 125 EPC, as a principle agreed upon by the Member States of the European Patent Organisation when setting up the EPC.

G 4/19 focuses on the procedural aspects of double patenting, leaving open to interpretation what is meant by "same subject matter".

What does "same subject matter" actually mean?

On a closer inspection, one can see that in the Guidelines for Examination, Part G-IV 5.4, at least three different terms are used to describe the subject matter to which double patenting applies. It opens with a passage explaining that *two patents cannot be granted to the same applicant for the **same subject-matter***. It then goes on to say: *"In cases where there are two or more European applications from the same applicant designating the same state or states and the claims of those applications have the same filing or priority date and relate to the same invention, the applicant should be required to perform one of the following: amend one or more of the applications in such a manner that the subject-matter of the claims of the applications is **not identical** or withdraw overlapping designations, or choose which one of those applications is to proceed to grant."* (emphasis added).

Does this mean that the prohibition of double patenting applies when the subject matter is "identical"? And if this is correct, what is meant by identical? The EPO normally uses "direct and unambiguous" when assessing disclosures, and it is not clear how this relates to "identical".

The Guidelines do not answer this question, and instead explain that "overlapping subject matter" is not enough for an objection of double patenting to be raised. This is yet another meaning to consider with little concrete guidance.

¹ Guidelines for Examination in the European Patent Office, G-IV 5.4.

To make things even more complicated, it seems that when it comes to the subject matter to be considered it is not even clear which claims should be reviewed. This is illustrated in the two diverging decisions discussed below, where the Boards went in opposite directions on the meaning of "same subject matter" in the context of double patenting.

Board 3.4.03 in T 2907/19 was relatively lax on this point, allowing an application to grant with claim 1 corresponding to dependent claim 2 of the parent. The Board did not comment on the slight differences in wording between claim 1 of the divisional and claim 2 of the parent. Instead, they focussed on the comparison only of claim 1 of the parent and the divisional and concluded:

*"Independent claim 1 of the fifth auxiliary request is different from independent claim 1 of the granted parent application and **thus does not define the same subject-matter**. Hence, the prohibition of double patenting is not pertinent to the claims of the fifth auxiliary request. This is not precluded by the fact that claim 1 of the fifth auxiliary request corresponds to dependent claim 2 of the granted parent application".*

Thus, it seems for Board 3.4.03 that the critical factor was whether the independent claims cover the same subject matter.

However, Board 3.3.04 did not apply this approach in their reasoning in T 1128/19. In this second case, the claim of the divisional related to the combination of dependent claims from the granted patent, together with some further differences in wording. Nonetheless, the Board refused the request on grounds of double patenting.

In their reasoning the Board noted the following points:

"6. As noted in the decision under appeal (see point 15.1), claim 1 of the main request is a combination of claims 1 and 4 and a single embodiment (aa) from claim 5 of the granted patent. The wording of claim 1 of the application under appeal differs from that of the above mentioned claims of the patent in that it specifies that the first binding domain "is an antigen-interaction site".

7. As also noted in the decision under appeal, the subject-matter of claim 1 of the main request is an explicit alternative defined in the claims of the parent patent, being a combination of claim 1 and 4 and embodiment (aa) of claim 5 as granted."

Accordingly, contrary to Board 3.4.03 in T 2907/19, Board 3.3.04 in T 1128/19 based their decision on the granted claims as a whole and not only the independent claims.

It will be interesting to see which of the two approaches the Boards of Appeal will follow in the future, or whether the divergence will lead to a referral to the Enlarged Board of Appeal, so as to settle this legal question.

Arianna Bartolini

Ph.D. (Chemistry), M.Sc. (Chemistry)

Italian and European Patent Attorney

HE Chemistry practice group



Adam Lacy

D.Phil., M.Chem.

Partner | British and European Patent Attorney

HE Chemistry practice group



When Does an Application Fail the Controversial New EPO Plausibility Test

European patent attorneys are still grappling with the meaning of the new standard for relying on post-published data for inventive step laid down in plausibility decision G 2/21. Here our London Partner Adam Lacy and Munich Partner Stephan Disser review T 258/21, which is the first decision to apply the new test to conclude that new data cannot be relied upon.

G 2/21 headnote point II held that:

A patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention.

The wording of this test left many questions unanswered.¹ T 258/21 helps EPO users understand how the Boards of Appeal might apply the test going forward, by giving an example of when the test is not met. The application and claim at issue related to Clevidipine for use in a method of reducing ischemic stroke damage (ISD), but the application included no evidence that this medical use was in fact achieved (see reason 1.3.1).

Despite the lack of evidence, the medical use of reducing ISD was not considered insufficiently disclosed due to the teaching in the closest prior art showing that this agent can be used to treat another type of stroke (reason 1.4.3). However, applicant wasn't allowed to use new data to show that Clevidipine delivers improved activity and reduced side-effects compared to other antihypertensive agents in treating ISD. This effect was, according to the Board, not "derivable", although "activity" and absence of "side effects" are mentioned in general terms in the application as filed:

...the Board notes that this effect was neither contemplated nor even suggested in the original application. Indeed the original application did not mention any comparison to other anti-hypertensive agents and it encompassed the treatment of both hemorrhagic and ischemic stroke (see e.g. original page 3, second paragraph). It follows that this technical effect relied upon by the applicant cannot be taken into account for the assessment of inventive step in accordance with G 2/21. Moreover, even if said technical effect would have been derivable from the original application...

Although the Board's conclusion might be useful when faced with a similar pattern of facts, unfortunately the decision isn't particularly clear on how exactly the test is applied making it difficult to draw general conclusions.

¹ See Thorsten Bausch, Adam Lacy, Plausibility in G2/21: has the elephant left the room? Kluwer Patent Blog, 29 March 2023; and Daniel Offenbartl-Stiegert, Lasse Weinmann, G 2/21: The End of "Plausibility"? *HOFFMANN EITLÉ Quarterly*, June 2023, pp. 10-14.

What can be said is that the Board interprets "derive" in the G 2/21 test as "contemplate" or "suggest". Meanwhile, "encompassed by the technical teaching" in the test doesn't seem to stretch to situations where the effect is a subset of one mentioned, i.e. the treatment of a specific type of stroke where others were discussed at a general level in the application as filed. That said, it is possible that the case fails the "embodied by the same originally disclosed invention" limb of the test instead – unfortunately the decision isn't particularly clear on this.

In our view, this decision is significant as it is the first to conclude that new data can't be relied upon. It is limited though in the sense that it doesn't provide detailed explanations on how the Board actually applied the test. We hope that slowly, through the development of the case law, the meaning of the controversial test in G 2/21 will begin to emerge to improve legal certainty on this important point in Europe. We are keeping our fingers crossed and eyes peeled.

Adam Lacy

D.Phil., M.Chem.
Partner | British and
European Patent Attorney
HE Chemistry practice group



Stephan Disser

Dr. phil. nat., Dipl.-Chem.
Partner | German and
European Patent Attorney
HE Chemistry practice group



Preservation of Evidence as a Provisional Measure Under the UPCA

On June 13 and 14, 2023, the Unified Patent Court's (UPC) Local Division in Milan granted two applications for preserving evidence (ex parte provisional measure) filed on June 12 and 13, 2023, while an international trade fair was taking place on June 6-14, 2023.¹

The Local Division proved to be extremely fast. The two decisions were issued within a day of the filing of the respective application.

The decisions were based in particular on the presumption of validity of the patent, on the evidence filed being considered sufficient to consider an infringement likely, and on the requirement of extreme urgency being fulfilled due to the imminent conclusion of the trade fair.

Facts

Oerlikon Textile GmbH & Co. KG (hereinafter: Oerlikon), the sole proprietor of European patent EP 2 145 848 B1 (hereinafter: the patent) lodged two applications for preserving evidence (requests for ex parte provisional measures) against two competitors on June 12 and 13, 2023, at the UPC's Milan (IT) Local Division.

Specifically, during the International Textile Machinery Association (ITMA) trade fair that took place in Rho (MI) on June 6-14, 2023, Himson Engineering Private Limited (Himson) and Bhagat Group (Bhagat), respectively, presented "false twist texturing machines" at their exhibition booths, which were considered by Oerlikon's patent attorney to infringe the patent.

Oerlikon's applications were aimed at obtaining copies of all technical, promotional and/or commercial documentation, in any format, relating to the respective textile machines displayed at the booths.

As evidence for the alleged infringement, Oerlikon's application, regarding Himson, encompassed copies of two brochures for technical and commercial presentation of the allegedly infringing machines and a technical opinion from an expert appointed by Oerlikon, and, regarding Bhagat, encompassed four photographic reproductions of the machine displayed at their booth, a copy of a billboard at the same booth, a technical opinion from an expert appointed by Oerlikon, and a video showing the machine referenced by the QR code printed on a business card found at the booth.

Oerlikon declared its intention to bring an action on the merits to establish the infringement with the adoption of the consequent measures of injunction, fixing of penalty, seizure, damages, and publication of the decision.

¹ Oerlikon (DE) vs. Himson (IN) / Bhagat (IN), CFI 127/2023.

Reasons

The Local Division declared itself competent for urgent proceedings and, based on the "*forum commissi delicti*"² criterion, declared itself geographically competent, as the ITMA trade fair took place in Milan.

The Division also established that Oerlikon was the sole proprietor of the patent, no opposition against the patent had been filed before the EPO, no opt-out declaration for the patent had been made, and no protective letter had been filed in accordance with Rule 207 RoP.

The Division in both cases based its decision upon the principle of having identified sufficient legal basis to bring legal action ("*fumus boni iuris*") upon having assessed the prospects of success on the merits of the case. The sufficient basis concerned in particular the presumption of validity of the patent, having positive evidence, at least circumstantially, for an infringement of the patent, having found the requirement of extreme urgency ("*periculum in mora*"; Rule 194(4) RoP) to be fulfilled in view of the imminent conclusion of the international trade fair, as well as the requested measures being deemed proportionate.

The Division further held that the prerequisites of Article 60(5) UPCA and Rule 197(1) RoP for deciding without the prior hearing of the defendant ("*inaudita altera parte*") were met, as a) time constraints would not have allowed the parties to convene before the end of the trade fair, and b) there would have been a risk that the evidence would have been destroyed or ceased to be accessible once the trade fair was over.

Oerlikon was authorized to proceed through the territorially competent bailiff and an expert appointed by the Division to acquire copies of all technical, promotional and/or commercial documentation, in any format, relating to the textile machines. A written report concerning the acquired evidence was to be drawn up during the enforcement of the order. Oerlikon was awarded the right to be represented by attorneys-at-law and external technical experts during the process of drawing up the report. The acquired evidence was to be used only during the future proceedings on the merits of the case (Rule 196(2) RoP).

Finally, the measure was immediately enforceable pursuant to Rule 196(3) RoP. Himson and Bhagat were informed about the possibility to ask the Court for a review of the order to preserve evidence within 30 days from the enforcement date of the order. Regarding the trials to the merits, the Local Division was called to decide within one year.

Take-away message

The Milan Local Division proved that the UPC can timely grant temporary remedies in the form of provisional measures.

The discussed cases demonstrate that an ex parte decision by the UPC regarding the preserving of evidence can be taken within one day of an application being lodged.

It may be of particular interest to patentees to consider making use of the possibilities offered by the UPC to try obtaining inspection orders or grants for other temporary remedies in the form of provisional measures, especially in those cases where national courts are known to offer fewer possibilities or to be comparably slow.

Thomas Wyder

Ph.D. (Physics), M.Sc.
(Physics)

Partner | German, Dutch and
European Patent Attorney |
UPC Representative

HE Mechanical Engineering
practice group



Stephan Steinmüller

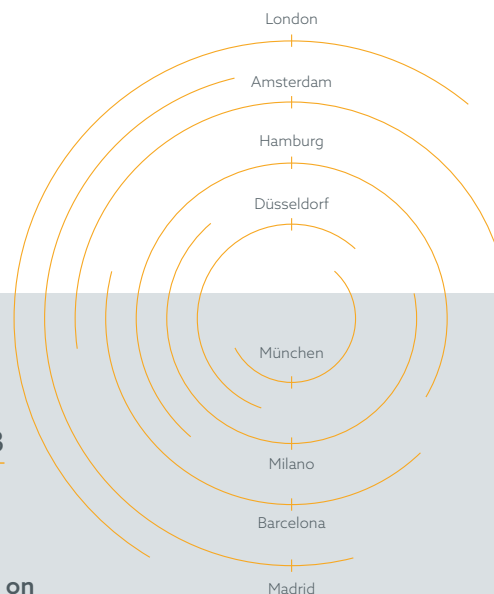
Ph.D. (Physics), Dipl.-Phys.

Partner | German and
European Patent Attorney |
UPC Representative

HE Mechanical Engineering
practice group



² The courts of the State where the infringement took place – the so-called "*forum delicti commissi*" – can declare jurisdiction.



HOFFMANN EITLE | Patent- und Rechtsanwälte PartmbB

Arabellastraße 30 | 81925 München
P +49 89 924090 | F +49 89 918356
pm@hoffmanneitle.com | www.hoffmanneitle.com

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