D YOUNG[&]CO PATENT NEWSLETTER^{no.81}

February 2021

Priority right Prove it or lose it	04
5G networking Non-public networks & network slicing	06
Appeal fees Correcting incorrect appeal fee payments	08
Timing is everything Late-filed amendments affecting	10

Also: Design registrations via the Hague system - Guernsey quietly makes a welcome entrance, Financial Times Europe's leading patent law fir survey 2021.



Editorial

2021 brings with it great hope that an effective vaccine can be made available to all, and that the pandemic can be brought to a close. Our teams in Germany and the UK all continue to work remotely and we are incredibly proud of all of the staff at D Young & Co who have worked diligently to maintain service and manage portfolios on behalf of our valued clients. We would like to extend our thanks to all of our overseas friends in law firms across the world who have similarly looked after our own clients' interests.

Anthony Albutt, Editor

Events

Women in IP's Annual Event 2021

Remote access meeting, 22 February 2021 Partner Zöe Clyde-Watson will be attending this event which will look at ways that IP firms can build a more inclusive and supportive workplace.

CITMA Biennial Design Seminar

Virtual event, 03-04 March 2021 Partner Richard Burton will be attending this two-day seminar focusing on design litigation in the IPEC and international designs.

IP Inclusive's 2021 Annual Meeting Virtual event, 23 March 2021

Partner Rachel Bateman will be attending this year's annual meeting which will include committee updates and discussion about the future development of IP Inclusive.

Patent Easter Internship

Virtual event, 06-09 April 2021 Our virtual internship is open to undergraduate and postgraduate students graduating in 2022 or later.

European Biotech Patent Case Law Webinar, 27 April 2021

Partners Jennifer O'Farrell and Simon O'Brien present our regular webinar round up of important and recent European biotech case law.

AIPLA 2021 Spring Meeting

Virtual event, 12-14 May 2021 Partner Jana Bogatz will be speaking at AIPLA's Spring Meeting.

www.dyoung.com/events

Subscriptions

Email subscriptions / mailing preferences: subscriptions@dyoung.com

 \searrow

Read online and view previous issues: www.dyoung.com/newsletters

Our privacy policy is published at: www.dyoung.com/privacy

Follow us

LinkedIn: dycip.com/dyclinkedin Twitter: @dyoungip **5G** telecommunications standards

5G Unlocking innovation with ultra-reliable lowlatency communication

s its name suggests, the fifth generation (5G) of telecommunications standards for broadband cellular networks represents an enhancement over fourth generation (4G) long term evolution (LTE). However, this enhancement goes beyond the faster speeds and increased reliability we have come to expect from successive generations of those standards.

5G as a standard is directed at supporting more targeted services, such as ultra-reliable lowlatency communication (URLLC) services, which attempt to simultaneously achieve high reliability and low latency communication - two almost conflicting requirements, which present a particularly formidable problem.

While this service is not aimed at providing increased bandwidth with yet faster web browsing, it does promise significant developments in many exciting fields of technology including remote-controlled surgery, self-driving cars and industry automation.

Why do we need high reliability and low latency?

URLLC is envisaged to provide a range of mission-critical applications where latency and reliability requirements cannot be compromised.

Suppose a surgeon uses a device to transmit instructions to a robotic arm for performing a surgery remotely. Although it is imperative that the surgeon's instructions are received/processed by the robotic arm as quickly as possible (low latency), it is equally important that those instructions are received and processed successfully (high reliability). As surgical procedures are potentially life threatening, the demand on latency and reliability is very high and exceptional performance in respect of both requirements must be guaranteed.

Beyond this, the applications of URLLC are expected to extend to vehicle automation where rapid and reliable communication between a vehicle and a 5G network enable the vehicle to control itself in response to information regarding nearby traffic accidents, other vehicles or weather conditions. Furthermore, it is not surprising that the greater control provided by URLLC is expected to provide improved safety in industrial automation

Conflicting requirements

So, what do low latency and high reliability actually mean? And why is it so difficult to reconcile these requirements?

Latency (specifically, end-to-end latency) is effectively a measure of the delay of a data packet between a source and a target. It includes delays in transmitting the packet over the air, in queuing of the data packet, and any processing delays/retransmissions of the data packet if required. Reliability is defined as the probability that a data packet of a given size is successfully transferred within a given time period.

With 4G, latency is currently around 4 ms. However, 5G URLLC has a latency target of 1 ms and 99.999% reliability.

As measures taken to improve latency typically result in a decreased reliability and *vice versa*, achieving both aims simultaneously is not a trivial task.

A new design

Among the most innovative solutions is the development of pre-emptive scheduling. An entity in the radio access network known as the gNB, which forms a radio communications cell of a 5G wireless communications system, arranges for data transmission on various connections with communications devices within the cell by "scheduling" data for each service and each connection via resources



of a wireless access interface formed by the gNB. Clearly, this scheduling requires some fair distribution of these resources, which naturally takes some time. However, to meet the low-latency requirements a service supported by URLLC cannot wait for the scheduler to allocate resources of the wireless access interface with all the other services.

This is best explained by way of example: assume a transmission is scheduled from a gNB to a user equipment (UE) such as a smartphone on all available radio resources with a long transmission time interval (TTI) (downlink transmission). The gNB may subsequently detect that URLLC data is to be transmitted and, in order to satisfy the low-latency requirements of URLLC, the URLLC data must be sent as soon as possible. To achieve the low latency the gNB allows the URLLC to pre-empt or effectively queue jump to usurp communications resources which may have been previously allocated by the gNB to another service. Pre-emptive scheduling allows the gNB to overwrite a part of the ongoing transmission with the

urgent URLLC data, drastically decreasing the latency for the URLLC data. Clearly, the trade-off here is that the part of the original transmission which was overwritten is lost. However, the gNB may transmit a pre-emption indicator (PI) to the UE, informing it of which part of the transmission was affected so that the UE takes account of this during decoding.

Similarly, for URLLC transmissions from the UE to the gNB (uplink transmission), a similar pause-resume scheme exists in which the URLLC data can take radio resources which the gNB had already allocated to a different device.

Other means of reducing latency include grant-free uplink in which a UE can transmit URLLC data to a gNB without first requesting radio resources. Additionally, the introduction of new radio (NR) numerology in 5G has created the possibility of mini-slot based scheduling. Previously, transmissions could only be scheduled in "slots" which last 14 OFDM symbols. Mini-slot based scheduling allows URLLC transmissions to start on any OFDM symbol and only last as many symbols as is required for the communication.

What about reliability? Reliability is largely dependent on the quality of the radio link between the UE and gNB. The signal to interference plus noise ratio (SINR) is typically used as a measure of the reliability of a radio link. A high SINR means a high reliability and vice versa. Accordingly, measures which enhance signal power and/or mitigate the effects of interference increase reliability.

To meet the stringent reliability requirements of URLLC, the SINR can be further increased by implementing multiple antennas at the transmitter and/or receiver (this is known as "micro-diversity"). Currently, the preferred mode for maximising diversity (and therefore reliability) is the "single-user single-stream" mode in which multiple antennas on a transmitting device are used to transmit multiple data streams to the same end-point.

Furthermore, reliability may be increased using pro-active repetition schemes. For example, a scheme known as "K repetitions" allows a UE to obtain "K" times the resources required for a transmissions so that if no acknowledgement is received for a particular transmission, the UE can transmit the data packet again (up to K times).

Conclusion

The next generation of telecommunications standards for broadband cellular networks promises much more than faster download speeds for web browsing or reduced buffering delays when streaming video. 5G URLLC services are aimed towards, and tackle head on, some of the riskiest and most rewarding areas of automation for replacing wired with wireless connectivity.

While we may still be some distance away from a complete automation of surgeries, vehicles and industry robots, the significant advancements pioneered by 5G URLLC services in simultaneously improving reliability and latency bring it closer to realisation.

Authors:

Jonathan DeVile & Sean McCann

www.dyoung.com/newsletters

Claiming priority

Priority right Prove it or lose it

n a recent appeal decision (T 407/15), an application was refused as obvious after the applicant failed to prove it had the right to claim priority.

The University of Western Ontario appealed against the EPO's decision to refuse its application, EP2252901A. The application claimed priority from two US provisional applications, filed by applicantinventors who were not applicants of the subsequent PCT application.

During the appeal proceedings, the Board of Appeal identified an article published by the inventors between the priority dates and the filing date. The article was considered to be particularly relevant to the claimed subject matter. As a result, the validity of the priority claims became pertinent to the application's patentability.

Article 87(1) EPC states that "Any person who has duly filed [...] an application for a patent, [...] 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".

According to established EPO practice, all applicants of a priority application, or their successors in title, must be applicants of the subsequent application for a valid claim to priority.

The EPO's "all applicants" approach to priority was recently confirmed in the widely reported appeal decision T 844/18 (see our summary article: "CRISPR patent appeal decision: EPO maintains "all applicants" approach to priority", 21 December 2020: https://dycip.com/all-applicants-priority). In addition, any transfer of the right to claim priority must have occurred in advance of the filing date of the subsequent application. Although other jurisdictions allow retroactive transfers of priority rights, they are not accepted by the EPO.

In the present case, each of the US provisional applications specified that the University of Western Ontario was an assignee on their respective filing dates (and therefore in advance of the PCT filing date). However, no further detail of the assignment was included. The Board of Appeal decided that this was not sufficient evidence to establish a valid transfer of the right to claim priority from the earlier applications. In particular, the Board of Appeal reasoned: "This is a consequence of the fact that the filing of a first application gives rise to two different and independent rights, namely the right to the application in question, and the right of priority. While... the priority documents... appear to provide evidence of a transfer of the right to a patent, it is silent as to any right of priority based on said filings." The EPC and the Paris Convention do not specify formal requirements for a valid transfer of priority rights. However, it is established EPO practice that an applicant/proprietor bears the burden of proving succession in title when the validity of a priority claim is called into question. Therefore, the University of Western Ontario was asked to provide evidence that it was entitled to claim priority from the earlier US provisional applications. However, it failed

In T 407/15 the applicant failed to prove the right to claim priority

Designs

Design registrations via the Hague system Guernsey quietly makes a welcome entrance

to do so. Consequently, the Board of Appeal decided that the application was not entitled to priority, and the claims were found to be obvious in light of the intervening disclosure.

According to established EPO case law, the independence of a priority right and the right to an application does not mean that a valid transfer of a priority right inevitably requires a separate and express assignment declaration. As such, the explicit transfer of a priority right may not be essential, when other evidence is sufficient. For example, in T 205/14 and T 517/14, an expert witness attesting to the applicant's inherent right to claim priority from an application based on its employees' service inventions, under Israeli law (the law of the country of employment and place of business), was considered adequate evidence of a right to claim priority. In addition, in the interlocutory decision of the opposition division relating to EP2203462B, an assignment of "the entire right, title and interest in and to any and all Letters Patent which may be granted therefor" was considered to implicitly include the right to claim priority, under US law (the law of the country of the priority filing, and the law governing the legal relationship between the parties).

It is clear from T 407/15 that merely indicating the transfer of the right to a priority application may not be sufficient to prove that the priority right had also been transferred.

Comment

Given that an applicant's/proprietor's right to claim priority in advance of the filing date may need to be proven for patentability, where not all of the applicants of a priority application are listed on the subsequent application, we recommend that an assignment is executed that specifically mentions the transfer of the right to claim priority.

Author:

Laura Jennings

ith respect to the international Hague design registration system, proposed law changes by The Bailiwick of Guernsey will soon mean that future Hague design registrations, which designate the UK, will additionally be extended to cover Guernsey free of charge, and without the need for any separate re-registration before the Guernsey design registry.

Specifically, once the above change in the law has been finally effected, which at the time of writing is currently advertised for implementation as 23 March 2021, any future design registration protection obtained in Guernsey via the Hague system will be preserved for as long as the UK designation of the Hague design registration is maintained, and kept in force.

For completeness, it is understood that the above change in design law for Guernsey will only be afforded to future UK design registrations obtained via the Hague system, and not to UK design registrations applied for via the UK Intellectual Property Office (UKIPO) directly. Thus for these latter design registrations covering the UK, registered design protection in Guernsey will only be possible via re-registering the UK design registration before the Guernsey design registry, along with paying the necessary re-registration fees in respect of the same.

The proposed change in the design law of Guernsey will no doubt be of welcome news to many, and provides another glowing reminder of the potential power of the Hague system in being able to offer truly international design registration protection across many territories of the world.

Guernsey aside, for those seeking design registration protection in the UK more generally, careful thought should still be given as to whether such protection might be best obtained through the Hague system, or by way of a separate UK registered design application made to the UKIPO. Indeed, the latter route via the UKIPO still has its own notable advantages over the Hague system.

In the above respect, a design registration application made to the UKIPO directly can often be pushed through to registration much more quickly (that is, in a mere matter of days) compared with a Hague design application designating the UK alongside other territories.

Crucially as well, a single UK registered design application made via the UKIPO can cover multiple designs relating to any combination of subject matters, and which are not necessarily all in the same main Locarno Classification heading (these headings ranging from 01-32). In contrast, a Hague design registration designating the UK can only relate to multiple designs in so far as the subject matter of all of these multiple designs falls under the same main Locarno Classification heading.

In summary therefore, for those seeking registered design protection in the UK, careful consideration should be given as to which route may be the most effective depending on the circumstances of the case.

For a better understanding as to which route may be most appropriate to your given circumstances, please do not hesitate to contact one of the members of our design team who would be pleased to advise.

Author: William Burrell

Useful link

WIPO information notice "Hague System – United Kingdom Extends Ratification of the 1999 Geneva Act to Guernsey":

http://dycip.com/hague-guernsey

www.dyoung.com/newsletters

5G networks / IOT

5G networking Non-public networks & network slicing

significant aspect of fifthgeneration (5G) networking is its support for the internet of things (IOT). The IOT broadly refers to the increasing integration of different classes of devices within wireless networks. As part of this drive towards universal connectivity, an ever-growing range of smart devices is now available - from watches, to cars, to household appliances – all configured to seamlessly connect to online applications via wireless telecommunications.

In parallel with the growth of the IOT, the advent of 5G networking is drastically increasing data transfer rates and reducing congestion and latency, leading to a dramatic increase in the density of devices which can be supported in a given network.

5G capabilities are rapidly expanding the range of IOT (and IIOT) use cases which can be viably supported.

Industrial internet of things

An important subset of the IOT is the industrial internet of things (IIOT), in which networked sensors, robots, user terminals, actuators and other devices are provided with wireless connectivity to support new use cases within industry. A key distinguisher of the IIOT over the broader IOT is the consequence of failure. Whereas much of the IOT is concerned with non-critical applications such as fitness trackers and household appliances, where congestion, latency, reliability and system failure are not of significant consequence, such factors may be mission-critical in the IIOT. In domains such as oil and gas, manufacturing, power generation, and healthcare, communication delays or system failures may at best have significant economic implications, and at worst be endangering to life.

Exemplary IIOT use cases include the use of networked robots for performing surgery or manufacturing tasks, the use of networked sensing arrays to monitor industrial processes (for example the operation of an oil refinery or nuclear power station), and the use of networked microphones, cameras and monitors for live television broadcasting. In common with many use cases in the IIOT, each of these use cases involves stringent service requirements, such as low latency, and / or high data throughput, reliability, security and quality of service (QoS).

Ultra-reliable low-latency communication In order to meet such requirements, the 5G standard supports features including ultrareliable low-latency communication (URLLC) for time-critical use cases such as robotic surgery and vehicle-to-vehicle communication; enhanced mobile broadband (eMBB) for applications requiring high bandwidth internet access (for example, virtual reality), and massive machine type communication (mMTC) to extend internet access to high-density arrays of low-power sensors, meters, and remote monitoring devices.

Public land mobile networks (PLMNs)

In general, 5G telecommunication systems will be deployed as public land mobile networks (PLMN), under the operation of a mobile network operator, providing simultaneous support for a large ecosystem of devices spanning a wide variety of use cases. However, for many IIOT use cases, particularly those with significant security, reliability and flexibility requirements, the use of a PLMN may be unattractive. For example, in a use case such as robotic-assisted surgery, varying QoS resulting from wider traffic flows on a PLMN may be highly detrimental to reliability and latency, both of which are critical safety requirements. In use cases such as a nuclear power station or military installation, where security is a significant concern, the transmission of sensitive data over a PLMN may be considered inappropriate. Historically, such use cases have gravitated towards the use of distinct local networks. for example a private network implemented using Ethernet, Wi-Fi, or Bluetooth protocols.

Non-public networks (NPNs)

With the advent of 5G comes support for non-public networks (NPN), which seek to combine the security and configurability benefits of a private network with the significant advantages of 5G (for example, support for URLLC, eMBB and mMTC).

NPN benefits

The use of an NPN brings a number of distinct benefits, including:

- Further **reliability and latency gains** (by siting 5G network functions and service applications as close as possible to the devices supported by the network).
- Full configurability (allowing the operator to optimise all aspects of network operation to a specific usage case)
- Integrity and accountability of traffic flows (providing enhanced security).
- Isolation from the public domain (reducing the risk of malicious attacks and exposure to PLMN system outages).
- Independent operation (allowing the operator complete control over authorisation and authentication of devices in the network).

Stand-alone non-public networks (SNPNs) A key feature of how 5G implements NPNs, when compared to classical private networks, is the flexibility in the degree of integration between the NPN and one or more PLMNs providing coverage to the NPN site.

At one end of the spectrum is a truly stand-alone NPN (SNPN), defined by its physical separation from any of the network functions usually provided by a PLMN. Accordingly a SNPN uses physically distinct radio resources, subscriber database, and dedicated hardware to support both the radio-access network (RAN) and the core network (CN) components of the system. In this sense, an SNPN is in effect a scaled-down PLMN with a restricted subscriber set. A SNPN may link to a PLMN via an edge node with a firewall (to provide access to, for example, voice services), but in the most stringently separated deployments, user equipments (UEs) within the SNPN will not communicate directly with the PLMN over the air interface.

PLMNs, NPNs and SNPNs For some use cases in the IIOT, the



benefits of independence from a PLMN may justify the overheads of setting up and maintaining a standalone SNPN.

In many instances, a degree of integration between an NPN and one or more PLMNs may be advantageous.

In a first case, RAN hardware supporting the NPN may be shared with a PLMN, while other network functions of the NPN remain physically separate from the PLMN (that is, the NPN provides its own user plane gateway, core network and subscriber database).

In a second case, the NPN again shares the RAN with a PLMN, but further relies on the PLMN to provide control plane functions and the subscriber database.

In a third case, the NPN is fully hosted by a PLMN, in that the PLMN provides all the network functions of the NPN. In this

latter scenario, public network traffic and NPN network traffic are treated as distinct parts of the PLMN, an approach achieved via virtualisation of network functions, as supported by the 5G standard. A benefit of this latter approach is that NPN subscribers are by definition subscribers of the PLMN which hosts the NPN, enabling roaming of NPN UEs (for example, user terminals or vehicles) in the wider PLMN to be easily implemented.

Where the NPN is fully or partially integrated with a PLMN, 5G enables logical separation of the NPN and public network functions of the PLMN, in order to enable delivery of a required QoS for the NPN, which, as set out above, may be essential for meeting the often stringent latency and reliability requirements imposed by IIOT use cases.

Where the NPN is integrated with a PLMN, dedicated network slicing, also supported by 5G, can provide an additional element of security not afforded by conventional network protocols used to support private networks (for example, WiFi), by maintaining complete logical distinction between NPN and public traffic within the PLMN.

The optimal degree of separation between the NPN and the PLMN, ranging from fullphysical separation at one extreme (a SNPN) and full integration with a PLMN at the other, with partial integration at varying degrees of physical and / or logical separation in the middle, is a trade-off between a variety of factors. Where significant flexibility is required to create, configure, scale, operate and monitor network functions, such as in an automated manufacturing context (such as a factory), this may only be achievable via a physically distinct SNPN. This is because individual use cases in the IIOT may have highly divergent requirements to those for which a standard PLMN is optimised. Conversely, the significant overheads involved in establishing and maintaining an SNPN may mitigate towards an NPN fully or partially integrated with a PLMN.

Authors: Samuel Keyes & Darren Lewis

www.dyoung.com/newsletters

EPO appeal process / fees

Appeal fees Correcting incorrect appeal fee payments

t the European Patent Office (EPO) the appeal process is usually the last chance to have arguments considered. However, the appeal process can be complicated with a number of procedural steps that must be followed in order to avoid risking the appeal being considered to be inadmissible. In T 0444/20. the incorrect appeal fee was paid.

Background

The examining division issued a decision dated 15 October 2019 to refuse an application filed by LG Display Company, Ltd. The deadline for filing an appeal was consequently 02 January 2020 (taking holidays into account). The appellant's representative filed a notice of appeal on 20 December 2019, which was therefore in time. However, the representative incorrectly paid EUR 1,880 for the appeal fee.

It is worth noting that earlier in 2019, the EPO had changed the appeal fee to a twotier system. Whereas the appeal fee had previously been EUR 1,880 for everyone, the appeal fee was increased for "large entities" and the correct amount for this applicant had actually increased to EUR 2,255.

On 09 January 2020 (after the deadline for filing an appeal had passed), the representative was informed that the conditions for a reduced appeal fee were not met and that either a declaration that the applicant was entitled to the reduced fee must be filed, or the shortfall must be paid. The representative responded by paying the shortfall.

In its provisional opinion dated 14 April 2020, the Board of Appeal indicated that despite the shortfall having been paid, the appeal fee had not been paid in time and therefore the appeal was deemed not filed.



Overlooking small underpayments In its provisional opinion, the Board of Appeal first considered whether the underpayment constituted a small amount under Article 8, RFees, which could therefore be ignored.

The Board of Appeal agreed with earlier case law (and notices in official journals) that Article 8 was to be interpreted to be referring to "insignificant" or "negligible" underpayments, for example, from unexpected bank transfer costs, currency exchange rates and so on and that this clearly excluded the much larger underpayment in question.

The Board of Appeal also noted that the underpayment amount was equal to the appeal fee discount being given to small entities. The Board of Appeal found it unlikely that such an amount could be considered to be small since the discount was presumably intended to be a genuine financial assistance to small entities.

The Board of Appeal also considered

whether overlooking the underpayment was reasonable (another requirement of Article 8). Again, the Board of Appeal concluded that this was not the case. In particular, the Board of Appeal noted that the EPO had introduced a six-month grace period after the change to the appeal fee and overlooking the underpayment would undermine the point of this grace period.

Legitimate expectations

In J2/87, it was decided that an erroneous communication from the EPO, that caused the applicant to take an incorrect action, was null and void in its entirety. In the present case, the EPO had notified the representative that the shortfall in the appeal fee could be paid and the representative had reacted accordingly.

Here, the Board of Appeal ruled that J2/87 did not apply because J2/87 was referring to a situation in which a miscommunication caused the applicant to take incorrect action. In contrast, the representative in the present case had already taken

GCC patents

UP & UPC German ratification of the UPC on hold

the incorrect action themselves by filing the incorrect amount for the appeal fee. This situation was not affected by the EPO's erroneous communication stating that the shortfall could be paid.

Correction under Rule 139 EPC

In response to the Board of Appeal's provisional opinion, the representative filed a request for correction under Rule 139 EPC.

The correction was requested to be made to the representative's notice of appeal dated 20 December 2019 to correct the amount that was to be paid (from EUR 1,880 to EUR 2,255). The representative argued that legal certainty was not breached, because the intention to pay the appeal fee was clear from the notice of appeal.

The representative also cited T 317/19, in which the board had ruled that Rule 139 EPC could be used to correct the payment of the appeal fee.

In an interlocutory decision of T 0444/20, the Board of Appeal ruled that the correction was acceptable.

Following the guidance of G1/12, the Board of Appeal agreed that:

- a. The fact that the new appeal fee for small entities was the same as the old appeal fee could give rise to confusion.
- b. No explicit declaration was given as to the eligibility of the entity for the reduced appeal fee, suggesting that the representative was not aware of the law change.
- c. The applicant was, quite obviously, not entitled to the reduction due to its large size.

The Board of Appeal also noted that other parties (such as those in T 317/19) had

www.dyoung.com/newsletters

also been confused by the fee change, and also that the request for correction was quickly filed when the Board of Appeal had issued its preliminary opinion indicating that the appeal fee was incorrectly paid.

Conclusions

It is noteworthy that both T 0444/20 and T 317/19 concluded that in using Rule 139 to correct the instruction to debit a certain amount of money, this implicitly also corrects the actual underpayment itself (that is, the physical transfer of money).

Rule 139 is able to not only correct an error in a document, but can also correct acts that were correctly performed based on that error.

Of course, the full extent of this is not necessarily clear and it remains preferable to avoid the situation altogether!

As an auxiliary request, the representative had applied for re-establishment of the period for paying the appeal fee. However, this was not considered to be necessary since the application of Rule 139 EPC was accepted.

The appeal process remains procedurally complicated and a good knowledge of legal procedure and remedies can be extremely helpful in avoiding potential pitfalls.

Author: Alan Boyd



Tialins-Suergen Gross



We have drawn from our experience of *ex parte* and *inter partes* oral proceedings before the EPO by video conference to prepare a guide for participants covering what to expect and how best to prepare. The guide includes our handy client "Checklist for ViCo": www.dyoung.com/vico-guide

www.dyoung.com/upandupc



s will be recalled, after the Bundesrat, the Upper House of the German Parliament, had passed the ratification bill of the Unified Patent Court

Agreement (UPCA) on 18 December 2020, two complaints, 2 BvR 2216/20 and 2 BvR 2217/20, were filed with the Federal Constitutional Court in Karlsruhe.

As before, the Federal Constitutional Court has asked the Federal President, Frank-Walter Steinmeier, to wait with execution of the bill, and his spokesperson has indicated the federal president will wait.

The second complaint is accompanied by a request to oblige the involved institutions by an interim order to desist from completing the ratification of the UPCA until the Federal Constitutional Court has decided on the merits of this second complaint.

Author: Hanns-Juergen Grosse

EPO appeals

Timing is everything Late-filed amendments affecting procedural economy

t has become increasingly challenging for parties to have new requests, facts, evidence and/or objections admitted into appeal proceedings; more so following the introduction of the revised Rules of Procedure of the Boards of Appeal (RPBA) on 01 January 2020¹, which arguably codified what practitioners had been experiencing.

An EPO appeal is not intended to be a complete re-examination of a case. Under the revised RPBA², a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based. Any part of a party's case that does not relate to this is considered to be an amendment which will only be admitted into proceedings at the discretion of the Board of Appeal. When deciding whether to allow an amendment the Board of Appeal will consider the complexity of the amendment, the suitability of the amendment to address issues which led to the decision, and the need for procedural economy.3 The onus on a party to demonstrate the admissibility of an amendment becomes increasing greater the later on in appeal proceedings the amendment is put forward.

Decisions T 1439/16,

T1480/16 and T 0482/19 (which were all issued after 01 January 2020) provide some guidance on late-filed amendments to a case which involves deleting claims from a claim request.

T 1439/16

In T 1439/16, an appeal decision concerning an opposition division's decision to maintain patent EP2161223 in an amended form, the Board of Appeal considered (i) whether a latefiled request in which claims had been deleted could be admitted and (ii) whether arguments against this admitted late-filed request could be admitted during oral proceedings.

In this case, the summons to oral proceedings

was issued on 23 August 2019. Then, on 12 December 2019, the Board of Appeal issued a preliminary non-binding opinion in which they indicated that: claim one of the patent as maintained in opposition proceedings appeared to contain added subject-matter; the subject-matter of claims 8 and 9 appeared to be new; and the subject-matter of claims 1, 2, 8 and 9 appeared to be inventive. Shortly afterwards, on 30 December 2019, the patentee filed substantive comments and auxiliary claim requests 1-6. During the appeal hearing on 02 September 2020⁴, the patentee requested that the patent be maintained on the basis of auxiliary request 6. The opponent argued that the request was late-filed and should not be admitted.

Findings of the Board of Appeal in T 1439/16

The Board of Appeal agreed that auxiliary request 6 had been filed late because the patentee's complete case should have been submitted with the reply to the grounds of appeal. However, the Board of Appeal went on to point out that amendments to a party's case filed after the summons to oral proceedings are not to be dismissed a priori but their admittance is subject to the Board's discretion⁵. In addition, the Board of Appeal noted that by deleting claim 1 the patentee had not introduced new subjectmatter but rather had "reduced the disputed subject-matter", in particular the issue of added subject-matter had been resolved. Further, the Board of Appeal noted "the amendment is not at all detrimental to procedural economy, but rather in its favour".

Thus, the Board of Appeal used its discretion to admit the auxiliary request into proceedings.

The admission of the auxiliary request caused the opponent to raise a new added subject-matter argument against the subject of claim 7 of this request (which corresponded to claim 8 of the patent as maintained by the opposition division).

The Board of Appeal highlighted that the statement of grounds of appeal shall contain a party's complete case⁶. In addition, they pointed out that it was the choice of the opponent to raise an added subject-matter objection to only claim 1 of the patent as maintained.

The Board of Appeal noted that submitting the added subject-matter objection for the first time at oral proceedings is detrimental to procedural economy because the opponent had been aware of the claim request for some six months before oral proceedings and, thus, could have submitted the objection well before oral proceedings to allow both the patentee and the Board of Appeal to prepare for discussion. The Board of Appeal considered that it was a "surprising attack". For procedural fairness and the right to be heard, the patentee needed an opportunity to react to the new objection (for example, by filing new auxiliary claim requests) and this would delay proceedings.

The Board of Appeal used its discretion⁷ to not admit the objection of added subject-matter into the proceedings.

T 1480/16

T 1480/16⁸ is an appeal decision concerning the decision of the opposition division to maintain EP2455267 in an amended form. In this case, the Board of Appeal considered whether the deletion of one category of claims in auxiliary request 5 compared to auxiliary request 3 would be considered as an amendment to the submission.

The patentee filed auxiliary request 5 during oral proceedings. Auxiliary request five differed from auxiliary request 3 (submitted earlier during the appeal process) in that the method claims were deleted and the word "simultaneously" was included in claim 1.

The opponent argued that auxiliary request 5 should not be admitted as it was late-filed.

Findings of the Board of Appeal in T 1480/16

The Board of Appeal held that the deletion of method claims in auxiliary request 5 compared to auxiliary request 3 was not a change and the addition of the term "simultaneously" explicitly expresses what the opposition division had implicitly inferred and did not require further restriction. The Board

Useful links

- T 1439/16: http://dycip.com/t1439-16
- T 1480/16: http://dycip.com/t1480-16
- T 0482/19: http://dycip.com/t0482-19

Notes

- 1. In particular, Article 12 (4) to (6).
- 2. See Article 12 (2) and (4).
- 3. Under the old RPBA the Board of Appeal took into account everything in the grounds of appeal or the reply thereto. Under the new RPBA, it is now no longer the case that everything presented at the outset of appeal proceedings is included in appeal proceedings. The admittance of an amendment to a party's case made at the outset of the appeal proceedings is now subject to the discretion of the Board.
- 4. Oral proceedings had been originally scheduled for 12 May 2020 but, due to disruptions caused by Covid-19, they were rescheduled.
- 5. Article 13(1) RPBA 2020 and Article 13(3) RPBA 2007, in combination with Article 25(1) and (3) RBPA 2020.
- 6. Article 12(3)RPBA 2020 and Article 12(2) RPBA 2007.
- 7. Under Article 13(1) RPBA and Article 13(3) RPBA 2007.
- 8. This decision was issued in German as no English translation was provided by the EPO. Our comments on this decision are based on a machine translation.

T 1439/16, T1480/16 & T 0482/19 offer guidance on late-filed amendments to cases involving deleting claims from claim requests



of Appeal noted that the discussion of novelty and inventive step would be the same. Thus, the Board of Appeal used its discretion to admit auxiliary request 5 into the proceedings.

T 0482/19

In T 0482/19, an appeal decision concerning the decision of the opposition division to maintain EP2649896 in an amended form based on auxiliary request 2, the Board of Appeal considered whether the deletion of one category of claims would necessitate the discussion of a new issue.

The patentee filed new auxiliary requests 12 and 13 one month before oral proceedings. Auxiliary request 12 was based on the claims as granted and auxiliary request 13 was based on the claims allowed during opposition proceedings. In both of these requests, the product claims were deleted but the method of manufacturing claims was retained. The patentee argued that the new requests were not an amendment to the case because they contained no new subject-matter and thus Article 13 RPBA was not applicable. The opponents had not raised any objections to the method claims but had only objected to the product claims.

The opponents asserted that auxiliary requests 12 and 13 should not be admitted as they were late-filed.

Findings of the Board of Appeal in T 0482/19

The Board of Appeal pointed out that this case differed from T 1480/16. The Board of Appeal noted that in both auxiliary requests 12 and 13 of T 0482/19 the method claims were more limited than the deleted product

claims. The Board of Appeal observed that these additional features of the method claims had not featured in the appeal procedure because the submissions of all parties had related to the product claims that had been present in all of the previous requests on file. The Board of Appeal held that the additional features of the method claims required consideration (in particular in relation to the issue of inventive step) and this would result in a substantial and unexpected change in the discussion at oral proceedings. The Board of Appeal noted that the patentee had not provided any reasons why the requests were filed at such a late stage of the procedure.

The Board of Appeal held that the new auxiliary requests constituted an amendment of the patentee's case and they were inadmissible.

Practical considerations in view of T 1439/16, T 1480/16 and T 0482/19

It has become increasingly important for parties to file all relevant requests, facts objections and/or evidence in first instance proceedings and for the appeal (or reply to an appeal) to contain a party's complete case.

Consideration of "procedural economy" is one of the factors taken into account by the Board of Appeal when deciding to use its discretion to allow an amendment to a case.

Amendments to a case, such as claim deletions, which reduce the disputed subjectmatter and/or resolve a disputed issue are likely to be admitted (even if requested at a late stage in the appeal process) because they favour procedural economy. In particular, it seems that amendments to a case in which claims are deleted will be admitted if no additional discussion is required of issues (for example, the discussion of an issue such as novelty and/or inventive step would be the same). However, if the deletion of claims necessitates the discussion of a new issue or requires substantial additional discussion for the remaining claims (for example, the discussion of an issue such as novelty and/ or inventive step is not the same because of the presence of an additional feature in the remaining claims) then the amendment to the case is unlikely to be admitted - especially if filed at a late stage in the proceedings.

Further, amendments to a case (such as introducing a new attack) which means that a respondent should be given the opportunity to react (such as filing additional claim requests) are unlikely to be admitted because they are detrimental to procedural economy – especially if submitted at a late stage in appeal proceedings (such as during oral proceedings).

Comment

Regardless of the type of amendment, if you need to amend your case then the amendment should be filed (together with supporting reasoning) as soon as possible in the appeal process in order to improve your chances of the amendment to your case being admitted.

Author: Stephanie Wroe

Information

D YOUNG[®]CO INTELLECTUAL PROPERTY

And finally...

Survey participation request

Financial Times Europe's leading patent law firm survey 2021



e would like to seek your support in nominating D Young & Co as part of a survey by the Financial Times on Europe's leading patent law firms.

The survey, conducted by market research institute Statista, is looking to identify leading firms and individual patent attorneys either in general terms, or in specific areas of expertise. The results of the survey will be published in a special report in the FT this summer. All responses will be anonymised for publication and self-recommendations are not allowed. The survey is available in English, German, French and Italian.

Surveys have to be completed by 13 March 2021 and in return for every completed survey the FT will make a small donation to the International Committee of the Red Cross and Red Crescent (ICRC/ICRC).

If you are willing to participate in the survey, please register on the FT website here: https://dycip.com/ft-2021

To update your mailing preferences or to unsubscribe from this newsletter, please send your details to subscriptions@dyoung.com. Our privacy policy is available to view online at www.dyoung.com/privacy.

This newsletter is intended as general information only and is not legal or other professional advice. This newsletter does not take into account individual circumstances and may not reflect recent changes in the law. For advice in relation to any specific situation, please contact your usual D Young & Co advisor.

D Young & Co LLP is a limited liability partnership and is registered in England and Wales with registered number OC352154. A list of members of the LLP is displayed at our registered office. Our registered office is at 120 Holborn, London, EC1N 2DY. D Young & Co LLP is regulated by the Intellectual Property Regulation Board.

Copyright 2021. D Young & Co LLP. All rights reserved. 'D Young & Co', 'D Young & Co Intellectual Property' and the D Young & Co logo are registered trade marks of D Young & Co LLP.

Contributors



Partner, Patent Attorney Alan Boyd awb@dyoung.com www.dyoung.com/ alanboyd



Senior Associate, Patent Attorno William Burrell wnb@dyoung.com www.dyoung.com/ williamburrell



Partner, Patent Attorney Jonathan Devile jdv@dyoung.com www.dyoung.com/ jonathandevile



Partner, Patent Attorney Hanns-Juergen Grosse hjg@dyoung.com www.dyoung.com/ hanns-juergengrosse



Associate, Patent Attorney Laura Jennings lej@dyoung.com www.dyoung.com/ laurajennings



Technical Assistant Samuel Keyes sdk@dyoung.com www.dyoung.com/ samuelkeyes



Partner, Patent Attorney Darren Lewis djl@dyoung.com www.dyoung.com/ darrenlewis



Technical Assistant Sean McCann smm@dyoung.com/ www.dyoung.com/ seanmccann

Associate, Patent Attorney Stephanie Wroe sfw@dyoung.com www.dyoung.com/ stephaniewroe



ney

www.dyoung.com/newsletters

Contact details

T +44 (0)20 7269 8550

F +44 (0)20 7269 8555

mail@dyoung.com

www.dyoung.com

London

Munich Southampton