

# D YOUNG & CO

## PATENT

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This edition of our newsletter explores a number of significant changes to the IP landscape in Europe. This month we cover various aspects of the UPC which is in its early stages of use. We are already seeing case law developments as litigants test the boundaries of the new forum.

We also explain the significant EPO development that is the removal of the 10-day notification rule. This will happen on 01 November 2023. Finally, we are very proud to announce that D Young & Co has once again retained its top tier ranking in Legal 500. Thank you to our clients and overseas associates who contributed to the assessment. We hope you find the edition helpful and interesting.

**Anthony Albutt, Editor**

## Events



### University Career Fairs

#### Various UK locations, Autumn 2023

We will be attending the University of Oxford Science, Engineering & Technology Fair, University of Southampton Autumn STEM Fair, University of Cambridge Life Sciences Fair and the London Engineering & Technology Careers Fair 2023 in October and November. For more information visit our website events page (link below).

### AIPLA 2023 Annual Meeting

#### Washington DC, USA, 19-21 October 2023

D Young & Co partners and patent attorneys Alan Boyd and Catherine Keetch will be attending the AIPLA Annual Meeting for three-days of networking and exchanging knowledge with other likeminded IP experts.

### TechBio UK 2023

#### London, UK, 18 October 2023

We will be supporting and exhibiting at the BIA's TechBio UK conference. Jennifer O'Farrell and Robbie Berryman will be hosting the Innovation Showcase session.

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# Inventive step? How will the UPC decide?

**T**he Unified Patent Court (UPC) is capable of deciding on the validity of those patents subject to its jurisdiction. Inventive step is often a key part of the validity of patents, but how will the UPC decide on the matter of inventive step? Often the assessment of inventive step is borne out through case law, but the UPC has a wealth of potential options to follow, and thus leaves this question somewhat unanswered.

This article looks at approaches adopted in significant territories of unitary patent (UP) member states, as well as the approach used by the Boards of Appeal of the European Patent Office (EPO).

### Where might the UPC look to find its approach to assessing inventive step?

Article 24 of the Agreement on a Unified Patent Court sets out the sources of law upon which the court shall base its decisions. Article 24(1)(c) refers to the European Patent Convention (EPC), and thus opens the door to the approach adopted by the Boards of Appeal of the EPO. Article 24(1)(e) refers to national law, and thus potentially allows for the adoption of practices from these territories. Indeed, the UPC is comprised of judges from various participating member states, and according to JUVE Patent, by number, the most represented nationalities of UPC judges are German (33.3%), French (20%), Italian (10.5%), Dutch (8.6%) and Scandinavian (6.7%). It may be reasonable to conclude that some national practices from these territories may find their way into UPC practice.

### Overview

Article 56 of the EPC states "An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art." Typically, similar provisions exist in the UP member states; such as Section 4 of the German Patents Act or Article L. 611-14 of the French Intellectual Property Code (IPC).

In order to be able to answer whether an invention involves an inventive step one must consider who the person skilled in the art is,

and how they would subsequently consider whether something is obvious or not.

### The person skilled in the art

As a first step, one must clarify the fictitious person known as the person skilled in the art or "skilled person". It is the skilled person that makes an assessment as to whether an invention possesses an inventive step.

The EPO considers the person skilled in the art as "a skilled practitioner in the relevant field of technology who is possessed of average knowledge and ability (average skilled person)". They are aware of common general knowledge and are involved in constant development in the relevant technical field. The skilled person may be considered to seek solutions in other technical fields, if prompted to do so. The skilled person may also be considered to be a group of people, if appropriate. In the majority of the five territories considered, the skilled person is considered in a similar manner.

In Germany the competent person skilled in the art is often considered a person who is skilled in the field of technology of the invention and usually is assigned to solve the task at hand. In France, however, the skilled person may be considered in a more limited manner. While French courts consider the skilled person to be a person skilled in the technical field that is linked to the invention, case law has dictated that the skilled person's professional knowledge is limited to their own area of specialisation (see decision 06-19.149 of the Court of Cassation, Commercial Division, dated 26 February 2008). While this does not necessarily exclude the skilled person possessing more general knowledge, it may become prevalent when considering whether a skilled person would consider a particular invention to be obvious.

### Approaches for assessing inventive step

The EPO have adopted a three-step problem solution approach, which is summarised in the Guidelines for Examination, Part G-VII, 5:

"In the problem-solution approach, there are three main stages:  
(i) determining the "closest prior art",

## ➤ Useful links

EPO: Agreement on a Unified Patent Court, Part 1, Chapter V, Article 24:  
[dycip.com/epo-article-24](https://dycip.com/epo-article-24)

UPC judges: a complete overview, JUVE Patent, 16 August 2023:  
[dycip.com/upcjudges](https://dycip.com/upcjudges)

EPO: European Patent Convention, Part II, Chapter I, Article 56: Inventive step:  
[dycip.com/inventive-step-article-56](https://dycip.com/inventive-step-article-56)

EPO: Guidelines for Examination, Part G: Patentability, Chapter VII: Inventive step, 3. Person skilled in the art:  
[dycip.com/epoguidelines-personskilled](https://dycip.com/epoguidelines-personskilled)

EPO: Guidelines for Examination, Part G: Patentability, Chapter VII: Inventive Step, 5. Problem-solution approach:  
[dycip.com/epoguidelines-problem-solution](https://dycip.com/epoguidelines-problem-solution)

BGH, Urteil vom 13. 1. 2015 – X ZR 41/13, “Quetiapin”:  
[dycip.com/fcj-XZR41-13-quetiapin](https://dycip.com/fcj-XZR41-13-quetiapin)

Decision 06-19.149, Court of Cassation, Commercial Division, 26 February 2008:  
[dycip.com/court-of-cassation-06-19-149](https://dycip.com/court-of-cassation-06-19-149)

UPC CFI 2/2023, Court of First Instance – Munich, Germany (local division), UPC, 19 September 2023:  
[dycip.com/upc-cfi-2-2023](https://dycip.com/upc-cfi-2-2023)

T 0606/89, EPO, 18 September 1990:  
[dycip.com/epo-t-0606-89](https://dycip.com/epo-t-0606-89)

Study on inventive step, standing committee on the law of patents (twenty-second session), WIPO, 27-31 July 2023:  
[dycip.com/wipo-inventivestep](https://dycip.com/wipo-inventivestep)

- (ii) establishing the “objective technical problem” to be solved, and
- (iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.”

The second step involves identifying distinguishing features between the claimed invention and the closest prior art before defining the objective technical problem in view of the technical effect(s) resulting from the distinguishing features.

The third step involves asking whether there is any teaching in the prior art that would (not simply could, but would) have prompted the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching. This is often referred to as the “could-would” approach, and aims to identify motivation for the skilled person to act in a particular way.

In the five territories mentioned concerning the origins of the UPC judges, the majority of these adopt similar problem-solution approaches. For example, France adopts a broadly similar three-step approach to the EPO’s problem-solution approach, as do Sweden and Italy. In the Netherlands, while the approach for assessing inventive step is primarily the same as the EPO’s problem-solution approach, other methods are not entirely excluded. Convincing reasons must be given as to why the problem-solution approach is not used in a particular case. However, perhaps unlike other jurisdictions, it has often been considered that combinations of more than two prior art documents may itself be an indication of inventiveness.

The assessment of inventive step in Germany is somewhat different to the EPO’s problem-solution approach, although it has been remarked that the same conclusions are often reached. Unlike the EPO’s problem-solution approach there is no determination of the “closest prior art”, but rather the starting point for inventive step is any reference the skilled person would realistically find without knowledge

of the invention; however, the selection of a particular reference should be justified.

Some commentators have remarked that to determine the closest prior art necessarily involves knowing the invention, which may be considered to introduce hindsight into any inventive step analysis. Equally, in the decision of the FCJ, X ZR 41/13, “Quetiapin”, it was specified that “the technical problem must be stated in such general and neutral terms that the question of which ideas were suggested to the expert by the state of the art with respect to this problem arises solely during the assessment of inventive step”, as opposed to necessarily considering the problem in view of the differences between the closest prior art and the selected reference. As a brief note, in some instances, secondary indicators may be used to support or show the presence of an inventive step; such unexpected technical effect, a long-felt want, or commercial success (coupled with a long-felt want). Similar secondary indicators are considered in many of the jurisdictions mentioned.

### An early insight?

A decision of the Court of First Instance of the UPC (Munich Local Division) (procedure number UPC CFI 2/2023), in respect of interim measures concerning unified patent EP 4108782, has recently published.

The decision considered, among other factors, whether the claims of EP 4108782 are novel or inventive, as alleged by the respondent. The decision states that “An important criterion in choosing the most promising starting point is the similarity of the technical task” noting that “aspects such as the designation of the subject-matter of the invention, the formulation of the original task and intended use as well as the effects to be achieved should generally be given more weight than a maximum number of identical technical features”. This statement draws some parallels with the approach adopted by the European Board of Appeal in T 0606/89; “...the claimed invention should be compared with the art concerned with a similar use which requires the minimum of structural and functional modifications”, which may be suggestive of a problem-solution type

assessment to inventive step.

While an assessment of inventive step in the this decision has only been taken to the extent necessary, and thus does not consider any particular methodology for assessing inventive step, note that the court has taken quite a strict approach to dismissing references as suitable starting points. For instance, the court dismisses references on the basis that “the court cannot see that this document suggests the invention according to the patent” or “in view of the task underlying the patent in suit”, seemingly placing a strong emphasis on the similarity of technical tasks between the references and patent in suit.

Could this be an early indication as to how the UPC will assess inventive step, and particularly in relation to selecting (or dismissing) closest prior art documents?

We note that there is a parallel pending European opposition against EP 4108782 filed by the respondents in the above matter, which seemingly uses similar documents as starting points for the assessment of inventive step. The European opposition proceedings are at an early stage, but we await further developments with interest, particularly with regard to whether the EPO will come to the same or different conclusion as the preliminary view from the UPC.

### Conclusion

Despite a potential insight offered by the decision of the Court of First Instance, precisely how and under which criteria and methodologies the UPC will assess inventive step remains to be seen.

In practical terms, when validity is at issue before a UPC court for example, it may be prudent to bear in mind the different approaches to inventive step, at least in the key UP member states, and build an inventive step position which takes account of the leading case law in the member states of the UPC, as well as before the EPO Boards of Appeal.

Author:  
**Martin Bicker**



# Unified Patent Court

## Four months since the start, what have we learnt?

**A**fter a frantic start to 2023 with opt-out strategy discussions and decisions, followed by bulk opt-out filings via the UPC case management system, 01 June 2023 saw the long-awaited beginning of the Unified Patent Court (UPC).

We are now four months into the new system, and have started to see some orders and decisions from a few of the UPC divisions.

The number of proceedings and parties involved have been widely reported. They include existing parties in litigation (for example, Amgen v Sanofi battling over Amgen's patent EP 2 215 124; and AIM Sport v Supponor in a dispute over AIM's patent EP 3 295 663) as well as a few surprises (for example Agfa NV v Gucci following Agfa's enforcement of their patent EP 3 388 490). Unsurprisingly, however, the UPC has been prompt in progressing the actions filed and we have started to get a sense of how certain issues will be handled. Some of these are briefly summarised below.

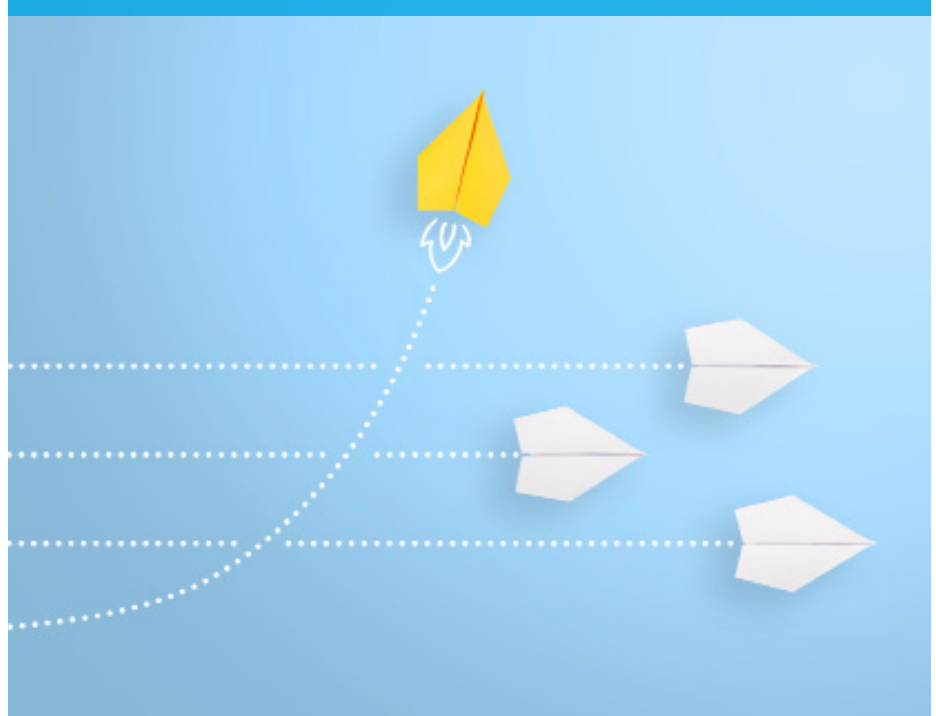
### Which UPC division?

According to Article 33(1) of the UPC Agreement (UPCA) infringement actions shall be brought before the UPC local division hosted by the contracting member state, where the infringement has occurred or where the defendant/ one of the defendants has its residence or (principal) place of business, or the UPC regional division in which that contracting member state participates. If the contracting member state concerned does not host a local division, and does not participate in a regional division, actions shall be brought before the central division.

According to Article 33(4) UPCA revocation actions shall be brought before the central division. If an action for infringement between the same parties relating to the same patent has been brought before a local or a regional division, the revocation action(s) may only be brought before the same local or regional division.

However, what happens when a revocation

### Four months into the launch of the UPC what are the notable decisions to date?



action is filed **on the same day** as the infringement action involving the same parties and the same patent?

This question was answered by the Munich central division in the dispute between Sanofi and Amgen over EP 2 215 124. Namely, that it depends on who filed first on that day.

Both parties filed their respective actions on 01 June 2023, the first day of the UPC.

The case management system was offline meaning that both parties had to file hard copies. Amgen filed its infringement action at the Munich local division at 11:45am, but Sanofi managed to file its revocation action designating the Munich central division at 11:26am. Sanofi filed its action at the UPC registry in Luxembourg (which was challenged by Amgen).

The application of Article 33(3) UPCA is dealt with by Rule 37 Rules of Procedure (RoP). Rule 37(1) RoP requires the panel of judges to issue an order as soon as possible after

the closure of the written procedure and decide by way of the order how to proceed. The parties must be given an opportunity to be heard (respecting Rule 264 RoP) and the panel must provide brief reasons in its order for its decision. Following an oral hearing by videoconference on 17 August 2023 before the UPC central division, an order was therefore issued by András Kupecz (the legal member of the UPC central division). The order is dated 24 August 2023, and rejected Amgen's request for the case to be heard by the Munich local division. Kupecz reasoned that "have been brought" within the meaning of Article 33(4) UPCA must be interpreted with the "ordinary meaning of the terms in their context and in the light of the object and purpose of the UPCA...to promote the concentration of proceedings between the same parties on the same patent in one division". Kupecz noted that otherwise proceedings would be inefficient and could lead to conflicting decisions within the UPC.

This may be reassuring for those who feared



bifurcation of validity and infringement proceedings would be “the norm” at the UPC.

It also provides some insight into how other provisions of the UPC Agreement may be interpreted, that is, with the ordinary meaning of terms and to provide efficient and consistent decisions within the UPC.

Consequently, “have been brought” within Article 33(4) UPCA was interpreted as “the objective act of lodging a Statement of claim by the claimant in case of an infringement action or a Statement of revocation in case of a revocation action”. As Sanofi lodged their statement of revocation first, the case will be heard at the central division in Munich.

Kupecz also dismissed Amgen’s challenge to the hard-copy filing at the UPC registry in Luxembourg. Rule 4.2 RoP was applicable, and again the “ordinary” or “plain” reading of the rule was decisive along with the “notion of the UPC as “one Court” with “one Registry”. Kupecz explained how Rule 4.2 gave parties a choice in the situation where it is impossible to lodge a document electronically, that choice was either file (i) at “the Registry” or (ii) at “a sub-registry”. A “Registry” is defined by Articles 6, 10(1) and 10(2) UPCA and includes the Registry in Luxembourg.

Amgen was given leave to appeal.

#### Ex Partes preliminary injunction

According to Articles 60(5) and 62(5) UPCA, in cases where a patent proprietor could be subject to irreparable harm or where there is demonstrable risk of evidence being destroyed, the UPC has power to grant *ex parte* (without the other party being heard) provisional and protective measures including preliminary injunctions. This procedure is known from, for example, preliminary injunction proceedings in Germany, and was handed down by the Dusseldorf local division in the dispute between myStromer AG vs Revolt Zycling AG on infringement of myStromer’s EP 2 546 134.

*Ex parte* provisional measures require exceptional circumstances, and in addition

to the reasons why provisional measures are necessary the claimant must provide:

1. Reasons for not hearing the defendant, and
2. Information about any prior correspondence between the parties concerning the alleged infringement. (Rule 206 RoP)

Due to the limited publication of documents by the UPC, it is unknown exactly what reasons were presented by myStromer AG, but the Dusseldorf local division seemingly agreed that there were exceptional circumstances and acted quickly to grant an *ex parte* preliminary injunction against Revolt Zycling AG. The preliminary injunction was granted on the same day as its application and it is understood that the request was made in the context of a trade fair.

The local division indicated that the patent was sufficiently valid. The patent had not been opposed at the EPO or the subject of any national nullity proceedings but the defendant had equally not provided relevant prior art. The defendant had filed a protective letter at the UPC (essentially a pre-emptive statement of defence), but this was sent to the claimant on the same day the preliminary injunction request was filed. Some speculate that this could have contributed to the issuance of an *ex parte* preliminary injunction.

A final point of interest in this case is that the request for the preliminary injunction in “all countries of the UPC where the patent is in force” was not allowed. The claimant was required to list the specific countries and in doing so, made a mistake and omitted Austria. Hence, the preliminary injunction was only granted for Germany, Netherlands, France and/or Italy. A correction was requested but this was refused by the UPC.

#### Opt-out withdrawal

Finally, although the decision is not yet available on the UPC website, Juve Patent has reported on the Helsinki local division’s interpretation of Article 83(4) UPCA, that is, the ability to withdraw an opt-out if a national action has been brought.

Article 83(4) UPCA is part of the transitional provisions and states that: **“Unless an action has already been brought before a national court, proprietors of or applicants for European patents or holders of supplementary protection certificates issued for a product protected by a European patent who made use of the opt-out in accordance with paragraph 3 shall be entitled to withdraw their opt-out at any moment.”**

AIM Sport opted-out EP 3 295 663 during the sunrise period and requested that the opt-out be withdrawn on 05 July 2023. On the same day, it filed an infringement action against Supponor, including an application for provisional measures. In response, Supponor lodged a preliminary objection including a challenge to the withdrawal of the opt-out.

Both parties were heard before the Helsinki local division on 21 September 2023.

It has been reported that the Helsinki local division rejected AIM Sport’s case including their request for a preliminary injunction against Supponor because the opt-out withdrawal was not valid. Despite AIM Sport arguing that Article 83(4) UPCA can only refer to proceedings filed after the start of the UPC, (after 01 June 2023) the judges disagreed. EP 3 295 663 had been the subject of several national proceedings prior to 01 June 2023, including German infringement and nullity proceedings in 2022. Hence, AIM was not permitted to withdraw the opt-out.

It is expected that an appeal will be filed, but in the meantime this is a significant decision for proprietors and applicants who opted-out their European patents/applications during the sunrise period and since 01 June 2023.

According to the Helsinki local division’s interpretation of Article 83(4), an opt-out would be permanent for any patents that had been subject to national actions prior to the UPC.

Author:  
Rachel Bateman



# AIM Sports strikes out Supponor under fire

**A**dvertising at sporting events is big business. It is reported that the advertising market for soccer alone is estimated to be worth almost €100 million. The advertising boards around the outside of the pitch are viewed by a global audience. However, advertisers on the in-stadium advertising boards may not always sell their goods or services in the overseas countries where the match is broadcast. Therefore, virtual advertising allows the in-stadium advertising boards to be replaced in live broadcasts overseas with alternative content.

This is a particularly niche area of technology, and two of the major players in this area have had an ongoing patent dispute in Europe over the last couple of years.

## AIM Sports v Supponor

AIM Sports issued various patent infringement claims against Supponor, alleging that the Supponor SVB System infringes a number of national patents derived from EP 3 295 663 B1.

This European patent relates to technology associated with occlusion. In other words, when a player runs in front of the in-stadium advertising board, the virtual advertising must account for this in the live broadcast. Patent infringement actions have been brought in the German court, the UK court and more recently the Helsinki Local Division of the UPC.

## German proceedings

In Germany, virtual advertising technology has been in use since 2015. Both AIM Sports and Supponor have their technology approved for use in Germany by the German Football League, with

major German clubs working with one or both of Supponor and AIM Sports.

At the time of the action, Supponor worked closely with a sport marketing company called Sportfive in the field of virtual marketing of advertisements for Bundesliga clubs; Supponor provided the technology whilst Sportfive marketed the ad spaces globally.

AIM Sports brought parallel actions against both Supponor and Sportfive for infringement of its patent in Germany.

In March 2022 the Munich Regional Court found that London-based Supponor infringed AIM's patent, and ordered the company to discontinue sales, pay damages, provide information and destroy the products. In addition, in the parallel action, Sportfive was banned from using Supponor's technology. In the summer of 2022 a hearing held that AIM Sports' patent was valid.

Both the infringement and validity decisions are currently under appeal.

## United Kingdom

In February 2023, the English High Court (Meade J sitting) held that the United Kingdom designation of EP 3 295 663 B1 was both valid and infringed. There was an interesting procedural point during the trial. Supponor alleged that AIM Sports should not be allowed to assert that claim 12 was valid, because it had previously accepted that claim 1 was invalid and that neither claim 1 nor claim 13 would be defended.

However, since claim 13 was very similar to claim 12, Supponor's position was that the latter must also be invalid. Supponor relied on an earlier decision from Meade J in *Promptu v Sky* [2021] EWHC 2021 (Pat), wherein he noted that the patentee was trying to act inconsistently with a previous concession it had made regarding claim validity.

In contrast, in this case, the judge confirmed that he did not purport to decide any point of principle in *Promptu*, and in any event

that he considered Supponor's argument was erroneous in three respects.

1. AIM Sports in fact had not admitted claim 13 was invalid if claim 1 was, but rather had dropped claim 13 for pragmatic reasons;
2. AIM Sports had not admitted that claim 12 was invalid if claim 13 was; and
3. AIM Sports had never admitted that claim 12 was invalid in any event.

In closing, the judge heeded that patentees ought not to be discouraged from narrowing down their case by making admissions about claims in the way AIM Sports had done for fear of unforeseen consequences.

The decision is under appeal with a trial date set for spring 2024.

## Product development

It is interesting to note that just after the issuance of the infringement decision in Germany, the German Football League approved the use of a new generation of the product by Supponor called the Supponor Air which, unlike the Supponor SVB, is entirely software based.

The Supponor SVB (the product found to be infringing the patent in Germany and the United Kingdom) required some dedicated perimeter technology and camera systems. However, the Supponor Air does not require any dedicated hardware.

Supponor has indicated that it does not feel this new generation of technology infringes the patent, and confirmed in February 2023 that it has discontinued sales of the infringing product. Of course, whether AIM

## AIM Sports struck out against Supponor, issuing various patent infringement claims



Sports agrees that this new generation does not infringe remains to be seen.

### UPC

In July 2023, AIM Sports filed an infringement action against Supponor (UK) and several of its subsidiaries at the Helsinki Local Division for a preliminary injunction against the Finnish subsidiary of Supponor.

This particular aspect of the dispute is interesting from a UPC perspective, as the EP patent was initially opted out of the UPC on 12 May 2023 (after the German proceedings had commenced), and the opt-out was withdrawn prior to the infringement action being filed. Although the infringement action had many aspects to it, the court actually only focussed on one; did the UPC have jurisdiction over the case at all?

The point at issue was whether the opt-out withdrawal was valid.

Ultimately, it was decided that AIM Sports was not permitted to withdraw the opt-out.

This particular point of law is considered in more detail in our article, UPC: four months since the start, what have we learnt?

It is unclear why AIM Sports changed its mind and tried to bring an action before the UPC.

It may be that with the success it had in the German and UK courts the possibility of an injunction covering all the UPC contracting states with one action could have been appealing. However, with Supponor stating that it discontinued sales of the infringing product, such an injunction for ongoing sales would not have been very powerful.

Alternatively, the UPC action may have been brought because Union of European Football Associations (UEFA – football's European governing body) is currently tendering for various technologies for 2024 onwards, and AIM Sports may feel that bringing an action before the UPC could strengthen its commercial position against Supponor in any tendering process.

### Conclusion

In many situations where there is a very limited number of competing technologies, and these are aiming for the same market, the injunction is more commercially important than the damages. This is because one of (if not the only) competing technology is removed from the market, allowing the patentee to control the market. However, in this case, the power of the injunction was dramatically reduced by the infringer releasing a product that, it claimed, did not infringe the patent.

It remains to be seen if AIM Sports will allege infringement of its patents by the new generation of Supponor products. If it does then the battle between these two companies will begin again.

We will report when the various Courts of Appeal issue their decisions in the coming months.

### Author:

Jonathan Jackson





# UP & UPC statistics

## Unitary patent requests, Unified Patent Court opt out and revocation actions

### Useful links

Guide to the unitary patent (UP):  
[dycip.com/up-guide](https://dycip.com/up-guide)

Guide to the Unified Patent Court (UPC):  
[dycip.com/upc-guide](https://dycip.com/upc-guide)

UPC opt-out FAQs guide:  
[dycip.com/upc-opt-out-faqs](https://dycip.com/upc-opt-out-faqs)

EPO statistics and trends: unitary patent:  
[dycip.com/epo-up-statistics](https://dycip.com/epo-up-statistics)

The UP & UPC system firstly provides patent owners with the option of, following grant of a European patent application, obtaining a new unitary patent (UP), providing protection for up to seventeen contracting EU states of the UPC agreement in a **single** patent. The protection will depend on the ratification status of the EU states when the UP is granted. Secondly, the agreement establishes the new international UPC for patent litigation in states which are both members of the European Patent Convention (EPC) and member states of the UPC agreement.

This article will briefly review how the new system has operated in practice in its first few months in force.

### Unitary patent

As of mid-September 2023 around 560,000 existing European patents and applications have been opted-out from the jurisdiction of the UPC. The significant interest in opting out existing patents and applications from the jurisdiction of the UPC raises the question of how extensive the uptake of the new option to obtain a unitary patent would be once the system came into force.

Following an initial spike in July 2023 when the UPC came into force, the number of requests for a unitary patent now seem to have settled somewhat. In August 2023, 2,532 requests for unitary effect were filed. To put this figure in context, in 2022 the EPO granted around 80,000 patents, which is around 6,700 a month. Assuming patents are being granted at a similar rate in 2023, the number of requests in August 2023 would represent **around 40%** of granted patents.

Interestingly, there is a marked difference in early take-up of the unitary patent based on the country in which the applicant is based. The table above shows the number of requests for a unitary patent filed as of 17 September 2023, broken down by the country of residence of the applicant. The total number of European applications filed by applicants from each country in 2022 is provided for reference.

Country	European patent applications (2022)	UP requests (as of 17 September 2023)
USA	48,088	1,327
Germany	24,684	1,834
Japan	21,576	319
China	19,041	492
France	10,900	738
South Korea	10,367	220
Switzerland	9,008	536
Netherlands	6,806	343
UK	5,697	410

As can be seen, there appears to be a significantly higher take-up of the unitary patent thus far from applicants based in Europe, especially those in Germany, France, and the UK. In contrast, the take-up by applicants from outside Europe, such as in the USA and China, is lower. Notably, Japanese applicants have a particularly low number of requests thus far for unitary patents based on the total number of applications filed. It is not clear what is causing this differential in take-up.

One possible explanation could be that European applicants are more familiar with the new system and hence more confident in obtaining a unitary patent at this early stage. It could also be the case that protection in the many EU states provided by the unitary patent could be more attractive for European applicants compared with those from further afield, where protection in only a few of the larger European states may be desired. It should also be remembered that certain important European states are not covered by the unitary patent, such as the UK, Switzerland, and Spain.

More time will be needed for a clearer picture to emerge of how widely the unitary patent will be adopted. However, the initial data appears to suggest a reasonably high level of up-take, given that the system is only a few months old, especially amongst applicants based in Europe. Further statistics on the unitary patent can be found on the EPO's website (see useful links, above right).

### Unified Patent Court

Despite the large number of opt-outs filed by patent owners and applicants for their existing portfolios, there remain many European patents that have not been opted out and hence that fall under the UPC's jurisdiction. Thus, we have already seen a number of actions being brought at the UPC in its first few months in operation. As of 17 September 2023, thirty-seven infringement actions and seven revocation actions have been initiated at the UPC. Since defendants have three months to file their defence, which may include a counterclaim for revocation, it is expected that the number of revocation actions will rise rapidly over the next few months as alleged infringers file their defence.

It remains to be seen whether the UPC will prove a popular forum for revocation actions where there is no corresponding infringement action. Only six such actions have been filed to date: for context, around 4,000 oppositions are filed each year at the EPO. This may change as more cases are heard by the UPC and the case law develops. Another factor could be the higher costs involved with revocation at the UPC: the fee is currently €20,000 for filing a revocation action at the UPC, compared with €880 for filing an opposition at the EPO.

The picture will no doubt become clearer over the coming months. We will continue to monitor developments and provide updates as necessary.

### Authors:

Rachel Bateman & Khalil Davis





# Greentech gets the green light

## Accelerating patent applications towards grant

Following the UK Intellectual Property Office's (UKIPO's) recent release of official patent statistics for 2022, which includes a report on the increasing popularity of the Green Channel for patent applications, this article explores the options available to applicants wishing to accelerate processing of their green and eco-friendly inventions both in the UK and elsewhere.

### Green Channel

In the UK the Green Channel allows applicants to request accelerated processing of their patent application if the invention to which it relates has an environmental benefit. This service is free of charge and, according to the UKIPO, is available to patent applicants who make a "reasonable assertion" as to the environmental benefit of their invention. While obvious examples such as solar panel and wind turbine inventions would likely meet this threshold, in some cases explanation may be required to justify the environmental benefit provided.

Examples of recently accepted reasons include:

- reducing use of environmentally-damaging materials (for example, single-use plastics);
- reducing water usage;
- using less raw material;
- reducing the number and duration of read and write operations associated with data processing, thus leading to reduced energy consumption; and
- reducing the volume of waste sent to landfill by providing a product with increased lifespan.

Requests for the Green Channel must be made in writing at the time of filing the application or later, and indicate:

- how the invention of the patent application is environmentally-friendly; and
- which actions are to be accelerated from search, examination, combined search and examination, and/or publication.

In 2022 the UKIPO received a record number

### The popularity of the Green Channel for patent applications is increasing



of Green Channel requests, up 9.3% from 2021, which had set the previous record.

### Climate Change Mitigation Pilot Program

A comparable scheme is available in the USA where the recently launched Climate Change Mitigation Pilot Program (which replaces the previously available Green Technology Pilot Program) allows applicants to request expedited processing of the first office action for applications with an environmental benefit. To take advantage of the Climate Change Mitigation Pilot Program a request should be filed with the filing of the application or entry into the US national phase (or within 30 days of doing so) and the application should relate to a product or process that mitigates climate change by:

- removing greenhouse gases already present in the atmosphere;
- reducing and/or preventing additional greenhouse gas emissions; and/or
- monitoring, tracking, and/or verifying greenhouse gas emission reductions.

### China

Accelerated processing of environmentally beneficial application is also available in China, with the China National Intellectual Property Administration (CNIPA) providing accelerated examination for applications relating to energy saving, environmental protection, and new energy, along with several other fast-moving technology areas. Where the CNIPA approves this prioritised examination it will aim to issue the first office action within 45 days and

have the case closed within a year. To achieve this, it should be noted that the time limit for responding to an office action from the CNIPA is reduced to two months.

### Japan

In Japan accelerated examination is available for green technology related applications, such as inventions having an energy-saving effect or that contribute to CO<sub>2</sub> reduction. To take advantage of this accelerated examination, a written request can be filed with explanation describing the eligibility of the application for the programme.

### Other countries

Many other jurisdictions offer systems for accelerating processing of green and eco-friendly inventions, so if you have an invention in one of these areas it is worth considering whether you can take advantage of the opportunities.

It should also be appreciated that many patent offices offer schemes for accelerating prosecution for inventions that are not environmentally related. These schemes may therefore be used even where no dedicated green channel is provided, or where your invention does not meet a scheme's eligibility requirements.

Should you wish to discuss the options available for accelerating processing of your green invention, please get in touch with your usual D Young and Co representative.

### Authors:

William Smith & Nathan Turnbull



## T 56/21

# The ongoing saga of description amendments

**T**he European Patent Office (EPO) stands alone as the only patent authority that requires amendments to be undertaken, prior to grant, to bring the description in line with the scope of the allowed claims. This is a time-intensive and, therefore, a cost-intensive obligation that raises a number of potential risks, including added matter, reduced protection in national jurisdictions under the doctrine of equivalents, along with potential implications for claim interpretation.

The requirement has been justified by the EPO on the grounds of increased clarity and consistency, particularly for third parties. However, it has been argued that this requirement places an undue burden on applicants and fails to find legal basis in the European Patent Convention (EPC). Although description amendments are currently required by EPO practice, there has been diverging treatment in case law, with some Boards of Appeal treating description amendments as mandatory under the EPC and other Boards of Appeal disagreeing.

Examples of decisions where a Board of Appeal has treated description amendments as mandatory include T 1024/18, T 2766/17, T 2293/18, T 121/20, T 1516/20 and T 3097/19. Examples of decisions where a Board of Appeal has not treated description amendments as mandatory include T 1989/18, T 1444/20 and T 2194/19.

**The ongoing case of T 56/21 is one in which the patentee has appealed against the decision of the examining division to refuse EP 15700545.5 in the absence of description amendments.**

This article briefly reviews the description amendment landscape and comments on T 56/21.

### **EPO Guidelines for Examination**

Historically, relatively minimal description

amendments were required under European practice. However, requirements have become increasingly onerous, crystallising in the 2021 version of the EPO Guidelines for Examination. The latest version of the guidelines, released in March 2023, state that applicants should delete subject matter no longer covered by the allowed claims or explicitly state that such subject-matter does not fall within the scope of the invention. Furthermore, claim-like clauses should be deleted on the basis of inconsistency with the scope of protection, leading to lack of clarity, irrelevancy, or unnecessary duplication.

**The EPO Guidelines for Examination provide instructions on the practice and procedure to be followed, but are not legally binding on the EPO Boards of Appeal. Hence the legal basis for the description amendment requirement is an issue of ongoing debate in the case law.**

Those Boards of Appeal in favour of description amendments have found support in Article 84 EPC as well as Article 69(1) and Rules 42(1)(c) and 48(1)(c) EPC. These provisions will be discussed in turn.

### **Article 84 EPC**

Article 84 EPC provides, first, that the claims shall define the subject matter for which protection is sought and, second, that the claims shall be clear and concise and be supported by the description.

Where Boards of Appeal have not considered description amendments mandatory, it has been emphasised that Article 84 EPC requires the claims to be clear in-and-of-themselves, without reference to the description (for example, T 1989/18, Reasons 4-5). The support for claims in the description is also noted as being required only to the extent that the claims should not include subject matter that does not have basis in the description. As such, additional subject matter in the

description that does not appear in the claims is not prohibited and should not give rise to inconsistency. Furthermore, where the claims are clear, no lack of clarity arises from further embodiments in the description.

In contrast, where Boards of Appeal have considered description amendments mandatory, it has been held that the requirements of clarity and support are separate and that merely providing a part of the description which gives support to the claims appears at odds with the support requirement of Article 84 EPC (T 1024/18, Reasons 3.1.8-3.1.9). However, the reasoning behind this position seems circular.

In addition to the legal basis in Article 84 EPC, there appears to be tension between case law in which clear claims are treated as self-contained in the context of claim interpretation, such that the description cannot be used in determining definition of subject-matter, (for example, T 1473/19, T 1127/16, and T 169/20) and case law treating claims (and the scope of protection conferred thereby) as capable of being rendered unclear if the description is not amended in line with the allowed claims.

### **Article 69(1) EPC**

Article 69(1) EPC provides that the extent of protection afforded by a European patent shall be determined by the claims and allows the description and drawings to be used to interpret the claims. Where Boards of Appeal have not considered description amendments mandatory it has been held that this article is not concerned with the definition of the subject-matter sought to be protected by a claim, rather it determines how the claims should be interpreted to determine the scope of protection and is thus not relevant to description amendments (T 1989/18, Reason 6).

In contrast, where Boards of Appeal have considered description amendments mandatory, it has been reasoned that as the description is used to interpret the claims under Article 69(1) EPC, the claims only clearly define the scope of protection pursuant to Article 84 EPC, if they are not

## Useful links

*Guidelines for Examination, Part F: The European Patent Application, Chapter IV – Claims (Art. 84 and formal requirements), 4.3 Inconsistencies:*  
[dycip.com/epo-guidelines-inconsistencies](https://dycip.com/epo-guidelines-inconsistencies)

*Guidelines for Examination, Part F: The European Patent Application, Chapter IV – Claims (Art. 84 and formal requirements), 4.4 General Statements, “spirit of the invention”, claim-like causes:*  
[dycip.com/epo-guidelines-general](https://dycip.com/epo-guidelines-general)

*European Patent Convention, 17th edition, November 2020:* [dycip.com/epc-17](https://dycip.com/epc-17)

inconsistent with the description (T 3097/19, Reasons 27-34). It has been further reasoned that where there is inconsistency the skilled person would be confused regarding the scope of protection.

A particularly fraught issue appears to be whether in order to be supported under Article 84 EPC it is enough that the subject matter of the claims is found in the description, or whether it is necessary that **all** embodiments are encompassed by the scope of the claims and **only** such embodiments are present (or otherwise marked). As the EPO is not involved in enforcement and does not determine the scope of protection afforded by the claims, it is perhaps questionable whether the EPO should be at all involved in indicating embodiments that the claims do or do not encompass.

### Rule 42(1)(c) EPC and Rule 48(1)(c)

Rule 42(1)(c) EPC concerns the content of the description and requires that the invention be disclosed in a manner that allows the invention and the advantages thereof to be understood. Rule 48(1)(c) EPC concerns prohibited subject matter and requires that an application does not contain obviously irrelevant or unnecessary subject matter.

These rules have not been cited frequently by Boards of Appeal supporting description amendments. However, Boards of Appeal not supporting description amendments have pointed out that the aim of Rule 42(1)(c) EPC is to ensure that the invention can be understood and that a requirement to adapt the description is simply not what this provision says (T 2194/19, Reason 6.2.3). It has also been observed that contravention of Rule 48(1)(c) EPC is not seen to provide sufficient reason for refusal of an application. Accordingly, it would be counterintuitive to treat this rule as justifying refusal of a patent (T 1989/18 and T 1444/20).

In T 56/21, recognising the divergence in case law, a communication from the Board of Appeal has requested the appellant's comments on a potential question to be referred to the Enlarged Board of Appeal. The proposed referral question reads:

### The EPO requires amendments to be undertaken prior to grant



“Is there a lack of clarity of a claim or a lack of support of a claim by the description within the meaning of Article 84 EPC if a part of the disclosure of the invention in the description and/or drawings of an application (e.g. an embodiment of the invention, an example or a claim-like clause) is not encompassed by the subject-matter for which protection is sought (“inconsistency in scope between the description and/or drawings and the claims”) and can an application consequently be refused based on Article 84 EPC if the applicant does not remove the inconsistency in scope between the description and/or drawings and the claims by way of amendment of the description (“adaptation of the description”)?”

The Board of Appeal acknowledged that EPO practice and early case law “is difficult to reconcile with the case law on clarity requiring that claims should be clear in themselves without having to resort to the description for an interpretation” (Reason 3.1).

The Board of Appeal also expressed the opinion at reason 3.2.2 that:

“Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC concern the effects of European patents (and applications) in the Contracting States. **It is not for the Office to harmonise the extent of protection conferred by European patents (and applications) by bringing the description and/or the drawings of any application or patent in agreement with the amended claims held allowable.**” (Emphasis added)

Interestingly, T 56/21 involves the same Board of Appeal 3.3.04 and the same applicant as T 1989/18 cited above. The legal board member is also the same as in both T 1989/18 and T 1444/20 cited above. The applicant has three months in which to file observations or submit claim amendments (with the latest date for filing falling on 31 October 2023).

An Enlarged Board of Appeal decision providing clarity on this matter would be welcomed.

### Authors:

Rachel Bateman & Tegan Stockdale





# T 1946/21

## The deadline for transferring right to priority

### Case details at a glance

Jurisdiction: European Patent Office

Decision level: Board of Appeal

Parties: : Bestway Europe Spa & Bestway

Deutschland GmbH and Intex Recreation Corp

Citation: T 1946/21

Date: 05 May 2023

Decision: [dycip.com/t-1946-21](https://dycip.com/t-1946-21)

In T 1946/21, the European Patent Office (EPO) Board of Appeal decided on when a transfer of a right to priority must be effective for a valid claim to priority for a subsequent European patent application.

### Background

The decision concerned an appeal by the opponent to a European patent that claimed priority from an earlier Chinese application. The proprietor of the European patent had acquired the right to priority on the last day of the twelve-month priority period and filed the subsequent European application on the same day.

The opponent asserted that the proprietor did not have a right to priority before the filing date and so the priority claim should be invalid. Since the Chinese application had been published before the filing date of the European patent, the Chinese application would be citable as prior art if the priority claim was invalid. The assertion of an invalid priority claim therefore was critical to the opponent's principal argument of lack of novelty.

### The appeal

The opponent proposed two main lines of argument in support of the assertion of an invalid priority claim:

1. The precise wording of previous case law (for example, in T 1201/14 and T 0577/11) and the EPO Guidelines state that the transfer must have taken place "before the filing date" of the later application. The opponent relied on this wording to argue that the transfer must have occurred at least on the day before the filing date.

2. The smallest unit of time under the European Patent Convention (EPC) is one day, such as when calculating time periods for deadlines. To suggest smaller units would cause unequal treatment of applicants (for example, filing by post would not provide an exact time of filing whereas filing online would). Additionally, since official EPO documents do not mark a date and time it would be uncertain as to whether the event for one document occurred before another. The opponent therefore argued that, for legal certainty, the transfer must have taken place at least one day before filing the subsequent application.

The proprietor argued that Article 87 granted the right to priority to the successor in title without defining any further requirements as to how this status was achieved. To deprive the proprietor of their legitimate right to priority would be without any good reason.

The proprietor further highlighted that the case law cited by the opponent was not entirely decisive as to whether the transfer must have taken place the day before the filing date.

### The Board of Appeal's reasoning

The Board of Appeal largely agreed with the reasoning put forward by the proprietor, noting that Article 87 does not set any condition to enjoy the right of priority other than being the applicant or successor in title of the priority application. Accordingly, the Board of Appeal found that there is no express requirement in law to support the opponent's position.

The Board of Appeal saw no reason to imply such a requirement into law either. Doing so would mean that the successor in title would have to wait until the day after a transfer of right to enjoy that right. During that waiting time, neither the transferor nor the transferee would be able to make use of their priority right. The Board of Appeal saw no convincing reason to implement such a restriction.

In relation to the opponent's arguments for legal certainty and equal treatment of applicants, the Board of Appeal noted that it has always been the responsibility of the applicant/proprietor to demonstrate that their priority right is valid. The responsibility is equal among all applicants and whether or not the right is demonstrated is a question of fact that must be proven. Accordingly, the Board of Appeal decided that the arguments in relation to the smallest unit of time were irrelevant, and did not see any reason for legal uncertainty or unequal treatment of applicants.

### Conclusions and recommendations

This decision gives some certainty, in that the exact deadline for transferring the right to priority is the moment that the subsequent application is filed. However, applicants should bear the Board of Appeal's reminder in mind: it is the applicant's responsibility to demonstrate that the transfer took place before filing the subsequent application. This can be easily demonstrated when the transfer of priority takes place at least one day before the subsequent application is filed. On the other hand, if both events take place on the same day it would not be as clear-cut. So applicants should consider the types of evidence that should be kept to demonstrate a valid right to priority.

In this case, the proprietor successfully proved the time of the transfer using an entry in a notarial journal by a US notary who had witnessed the assignment of the priority right, copies of emails, and several affidavits from the notary and employees of the transferor/transferee. Evidence for the time of filing of the application was the filing receipt that specifies the second at which the application was received by the online filing system.

The deadline for transferring the right to priority is when the subsequent application is filed





## Useful links

T 1201/14 (Transfer of right of priority),  
EPO Boards of Appeal, 09 February  
2017: [dycip.com/t-1201-14](http://dycip.com/t-1201-14)

T 0577/11 (Entitlement to priority),  
EPO Boards of Appeal, 14 April  
2016: [dycip.com/t-0577-11](http://dycip.com/t-0577-11)

EPO Guidelines for Examination:  
Part A, Chapter III, 6.1 Claim  
to Priority: General Remarks:  
[dycip.com/epoguidelines-priorityclaim](http://dycip.com/epoguidelines-priorityclaim)

Fortunately for applicants, this appears to be a fairly low evidential burden that should be met with any well-kept internal records system. It is also clear that if filing a subsequent application close to a deadline, applicants should certainly avoid filing by post, and instead make use of online filing to obtain a time-stamped filing receipt.

For prospective opponents, however, there are significant risks in commencing an opposition with a priority attack, since most of the above evidence is not publicly available. Although the filing receipt will be visible on the European Patent Register, there is no requirement to publish assignments of priority documents in Europe. Without this evidence it would be very risky to start opposition proceedings (including paying all of the fees), only for the proprietor to produce the necessary evidence to entirely negate this line of attack.

When considering whether to file an opposition it could be reasonable to include a priority attack if the applicants for the first and subsequent applications are different. However, there should be strong back-up attacks in case the proprietor can produce sufficient evidence as in this case.

In a worst case scenario this would be dealt with fairly quickly at the beginning of the opposition proceedings before moving onto stronger attacks. However, in a best case scenario, the priority attack could give rise to a very strong novelty attack based on the priority document (if published). These possible strategies should be discussed with a patent attorney before any significant steps are taken.

Finally, it is worth noting that the Board of Appeal did not formally decide whether the proprietor's evidence was sufficient since it was not contested by the opponent. Perhaps in future cases the quality of evidence for when the transfer took place may be assessed with more scrutiny.

## Author:

John Cameron



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## Computer implemented inventions

# Computer implemented inventions at the EPO Patent application tips

Computer implemented inventions at the EPO: [www.dyoung.com/cii-patent-tips](http://www.dyoung.com/cii-patent-tips)



European law is far from straightforward when it comes to assessing the patentability of computer implemented inventions (CIIs). Over the years a number of tests and terms have appeared, all of which are interlinked and are easy to misapply.

In this guide we have summarised the law and provide a series of tips for writing a CII patent application so as to put it in the best shape for examination before the European Patent Office (EPO).

This report will be of particular interest to start-ups, spin-outs, inventors, academic

institutions, technology transfer departments, SMEs and established companies using computer implemented inventions to drive innovation, as well as anyone with an interest in patent strategy and IP protection.

The report has been written by European patent attorneys Anton Baker, Alan Boyd, Ben Hunter and Keith Daly.

For further information about the contents of this report please contact a member of our electronics, engineering & IT patent team.

D YOUNG & CO  
INTELLECTUAL  
PROPERTY

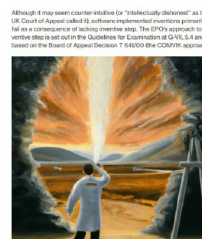
## Computer implemented inventions at the EPO Patent application tips



European law is far from straightforward when it comes to assessing the patentability of computer implemented inventions (CIIs). Over the years, a number of tests and terms have appeared – all of which are interlinked and are easy to misapply. In this guide, we have summarised the law and provide a series of tips for writing a CII patent application so as to put it in the best shape for examination before the European Patent Office (EPO).

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01 The COMVIK approach  
02 Technical and non-technical subject-matter  
03 Subjective effects  
04 Claims tips  
05 Descriptions tips  
06 Partners and authors  
07 Contact

## → The COMVIK approach Guidelines for Examination G-VII, 5.4



In brief, the COMVIK approach can be summarised as follows:

- Identify the differences between your invention and the closest prior art.
- Identify which of these differences are technical, that is, the differences that do not fall in one of the excluded subject-matter categories as set out in Article 52(2) EPC. If there are no such differences, then the invention is excluded under Article 52(2).
- Consider which of the per se non-technical features (features which do not fall into one of the excluded subject-matter categories set out in Article 52(2) EPC) interact with the technical features such that they contribute to the technical character of the claim. For instance, using a resistor for timing control to open window shutters.
- Formulate an objective technical problem to be solved over the closest prior art, which is to achieve the technical effect achieved by those differences that contribute to technical character or are themselves technical.
- The non-technical features that do not contribute to achieving the technical effect of the remaining features form a "requirements specification" and are effectively struck out from the claim when considering inventive step. A useful guideline for whether subject-matter should qualify for the requirements specification is to consider who you would ask to solve the problem. If you would ask an engineer then that subject-matter must be considered for inventive step and if you would ask a business consultant, then that subject-matter can appear in a requirements specification.

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[www.dyoung.com/cii-patent-tips](http://www.dyoung.com/cii-patent-tips)

# A new digital age European Patent Office scraps the ten-day rule

In November 2022 the European Patent Office (EPO) announced that the ten-day rule, the regime for determining the date on which communications are deemed notified for the purposes of calculating time limits, will be scrapped.

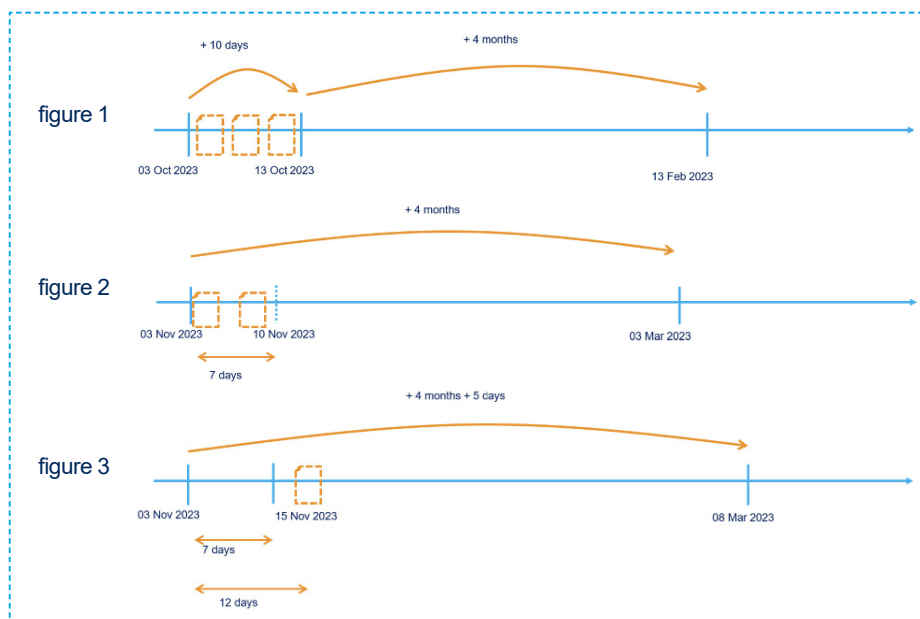
This change, which comes into force on 01 November 2023, will amend Rules 126 and 127 of the European Patent Convention, which currently state that by default communications are deemed to have been notified ten days after they are issued. This ten-day period was introduced when the primary means of delivering communications from the EPO was via post, and was intended to account for potential delays in the postal services. In practice this period provides an additional ten days to respond to a time limit set in many communications.

However, with over 99% of communications from the EPO now being received digitally, the impact of postal delays is minimal, and the ten-day rule now largely just serves to provide an extra few days to meet certain time limits. Therefore, as part of the EPO's digital transformation, the EPO will amend the rules to remove the ten-day rule and introduce a different safeguard adapted from the Patent Cooperation Treaty (PCT).

## The ten-day rule

The current rules (which will remain in place for all communications dated up to and including 31 October 2023) introduce a legal fiction where notification of a communication from the EPO is deemed to occur ten days after the date of the communication.

This principle of the ten-day rule is illustrated in the timeline above (figure 1). A communication issued by the EPO dated 03 October 2023 is expected to arrive within ten days of the date it was issued by the EPO (that is, by 13 October 2023). The time limit set by the communication (for example a four month time period) begins ten days after the date of the communication, in this case 13 October 2023. The deadline for responding to the communication is therefore effectively 13 February 2024, rather than 03 February 2024.



## The new rule

Under the new rules, which apply to all communications dated 01 November 2023 and later, time limits run from the date of the communication. This is shown in the timeline above (figure 2), where the time limit set by a communication (for example, a four-month time period) begins on the date of the communication. In this scenario the communication is expected to be received within seven days of issue, but this seven-day period is now included in the time limit set by the communication (for example, a four-month time period). As the vast majority of communications are now received from the EPO digitally, communications can be downloaded as soon as they are issued by the EPO. To provide a safeguard in case there are delays in the delivery of communications, the new rules introduce a safeguard measure similar to that provided under the PCT. Specifically, if the EPO could not show that a communication reached its addressee within seven days of the date of the communication the period for reply would be extended by the number of days by which the seven days was exceeded.

This is shown in the example timeline above (figure 3) where a communication arriving twelve days after the date of the

communication leads to an additional five days being added to the period to reply. However, it is important to note that this additional period must be requested and is not added to the deadline automatically.

## Conclusion

The removal of the ten-day rule will spell an end to a familiar regime for time limit calculations. While there will be a transitional period of at least six months, where pending communications have different time limit rules applied based on the date of each communication, eventually this change will lead to a simpler system for calculating time limits where all time limits can be calculated in the same way.

It should be noted that this change to Rules 126 and 127 EPC only affects time limits which are set based on the date of the communication. Time limits set by the European Patent Convention (EPC), or other legal statute, such as the deadline for filing a divisional application or the deadline for filing an EPO opposition, are unaffected by this change. Other safeguards and extensions are also provided by the EPO.

**Author:**  
Andrew Cockerell



# EPO guidance Mixed-mode (hybrid) oral proceedings

In this article, we discuss an interesting development in which oral proceedings were held in a mixed-mode (hybrid) format where one party was heard “in-person” and the other party was heard by videoconference.

## Background

Mandatory videoconferencing was introduced at the European Patent Office (EPO) during the Covid-19 pandemic. Since the start of 2023 videoconferencing has been the default format of oral proceedings before the Examining Divisions and Opposition Divisions, following a decision issued by the EPO: only if there are serious reasons against holding the oral proceedings by videoconference, and the division permits it, will proceedings in opposition be conducted in-person. This decision, however, does not apply to the Boards of Appeal. Under Article 15a Rules of Procedure of The Boards of Appeal (RPBA), the Boards of Appeal have the discretion to hold proceedings by videoconferencing if they consider it appropriate, either upon request by a party or its own motion.

Notably, in the much discussed case G 1/21, the Enlarged Board of Appeal determined that the limitations of video technology make videoconferencing a suboptimal format for oral proceedings. In this case it was held that in-person oral proceedings are the “gold-standard” and should be the default option in the absence of a disruption (such as the Covid-19 pandemic).

Thus, during the written procedure leading to oral proceedings, it is important for parties to the proceedings to provide detailed reasons for or against an in-person hearing. Merely expressing a preference for a particular format is not sufficient. For practical suggestions on factors that could be considered when preparing arguments for or against an in-person hearing please see our article “EPO guidance: requesting “in-person” or ViCo oral proceedings”.

The use of videoconferencing, in particular at the Boards of Appeal, is not yet settled and, as discussed below, the case law continues to evolve around its use.

## Case law developments

T 1501/20 is a decision by the Board of Appeal. In this case, the parties were summoned to oral proceedings on 14 July 2023.

For the appellant-opponent this day was a national holiday and they requested that the oral proceedings be postponed or held as a videoconference. However, the respondent-proprietor objected to videoconferencing for the reason that it would be much easier to coordinate between the respondent’s legal representative and the respondent’s participating employees in the context of an in-person hearing. Subsequent to these requests, it was agreed between the parties to conduct oral proceedings in a mixed-mode. Thus, during the hearing, the respondent-proprietor’s representatives and employees were at the premises of the EPO and the appellant-opponent participated by videoconference.

In its decision, the Board of Appeal confirmed that a national holiday is not sufficient grounds for postponing oral proceedings unless a holiday or trip has already been booked. Further, it held that a postponement could not occur for procedural considerations.

The Board of Appeal considered G 1/21 and confirmed that Article 15(a) does not provide legal basis for conducting oral proceedings by videoconferencing against the will of one of the parties to the proceedings, unless there is a general emergency restricting the abilities of the parties to attend in-person at the EPO’s premises.

The Board of Appeal in T 1501/20 allowed oral proceedings to be held in a hybrid hearing (mixed-mode) because both parties had consented to that format.

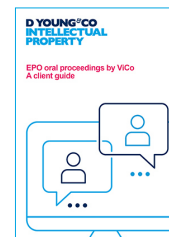
T 1946/21 is another decision which discusses the issue of a mixed-mode hearing. In this case, a request was made by one party for the representative to attend in-person but for the other attendees in the party to be heard by videoconference. No request had been filed by this representative detailing who these other attendees were and why they were relevant to the case. The Board of Appeal held that, in the

## Useful links

EPO guidance: requesting in-person or ViCo oral proceedings, 01 August 2023: [dycip.com/epo-vico-inperson](https://dycip.com/epo-vico-inperson)

T 1946/21: the deadline for transferring right to priority: [dycip.com/t194621-priority-deadline](https://dycip.com/t194621-priority-deadline)

Guide to ViCo at the EPO: [dycip.com/vicoguide](https://dycip.com/vicoguide)



absence of any such request, there were no reasons which would outweigh the increased technical and organisation complexity caused by setting up and operating an additional parallel hybrid channel while running in-person proceedings at which all parties are represented and in which all attendees may participate.

## Practice points

Balancing the requests by various parties to an oral proceedings for in-person or videoconferencing is not always straightforward for the EPO. There is discretion for an Examining Division or an Opposition Division to allow in-person proceedings, and discretion for a Board of Appeal to allow videoconferencing.

- The Board of Appeal, at least, seems willing to allow mixed-mode hearings under some circumstances.
- It seems that the EPO will require all parties to the proceedings to agree (or at least not object) to the mixed-mode.
- If you would prefer to use videoconferencing at the Board of Appeal and another party would prefer in-person proceedings then consideration should be given to approaching the other party to see if they would be willing to allow mixed-mode.
- If mixed-mode is required only for “other attendees” to a proceedings then details of who these other attendees are as well as an explanation of their relevance to the case and reasoning for the mixed-mode request should be provided to the EPO.
- If a mixed-mode hearing does not suit your requirements then consideration should be given to writing to the EPO accordingly.

We are well equipped to carry out oral proceedings by videoconference and have extensive experience in doing so.

If you have any questions about oral proceedings by videoconference, please review our “Guide to ViCo at the EPO” or speak to your D Young & Co representative.

**Author:**  
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# D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

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- G 2/21: is plausibility still relevant at the EPO?

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