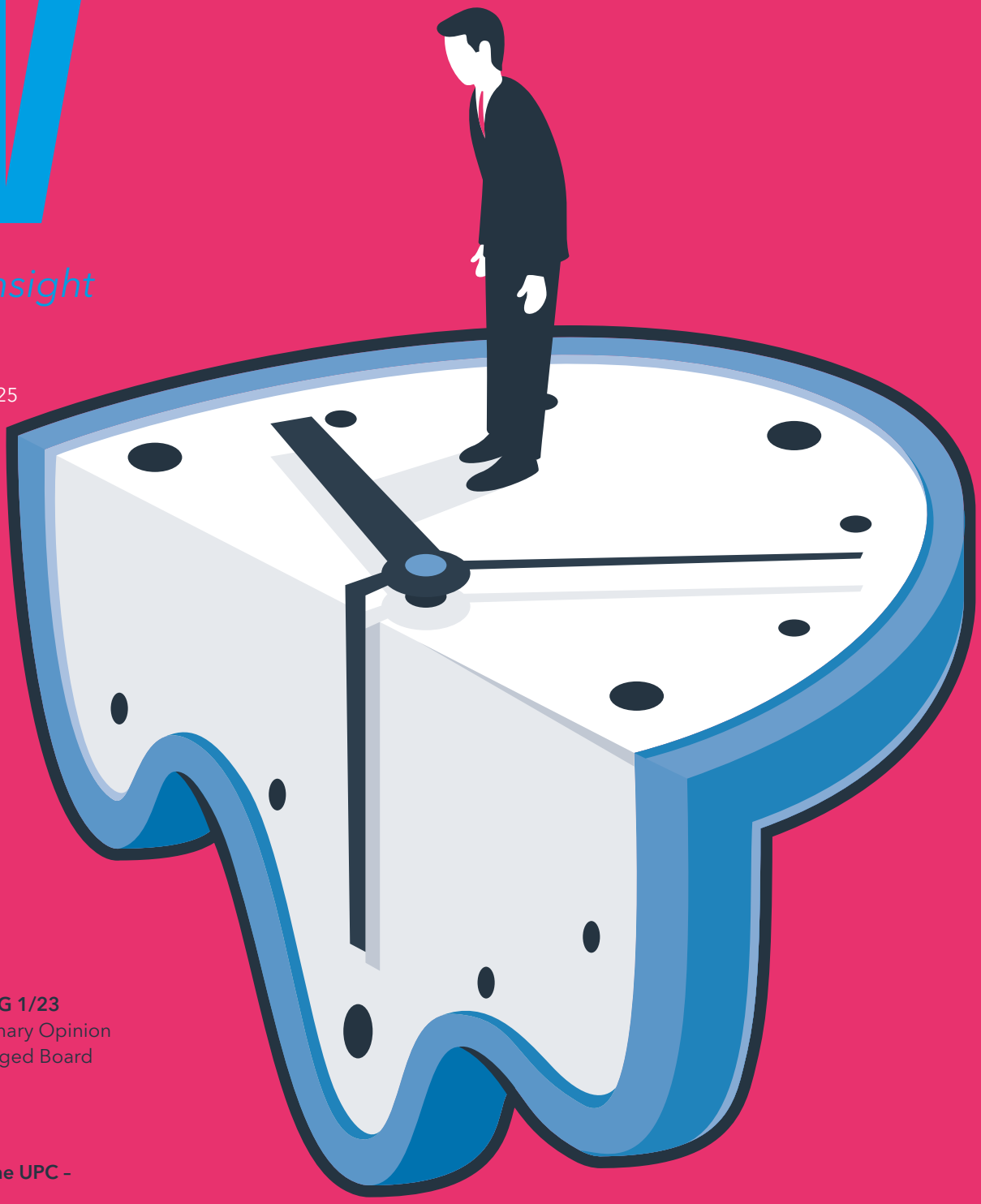
MAIWALD
INTELLECTUAL PROPERTY

MAIinsight

Issue No. 1
January 2025



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Design Law Update

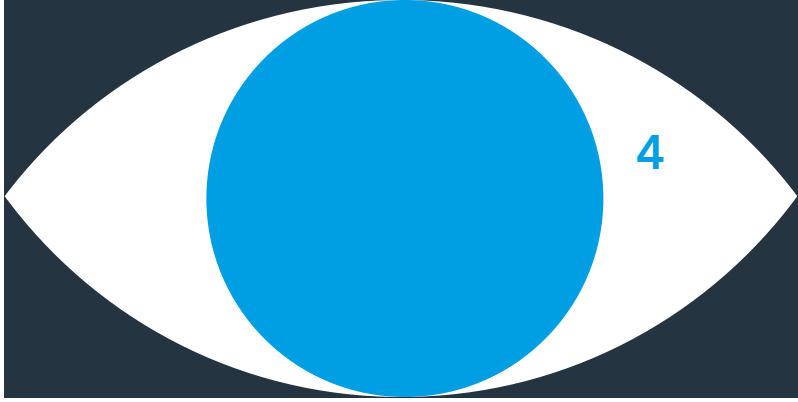
Important changes to the EU Designs system as well as the national design regulations have been approved by EU Parliament in March 2024 and voted on by the Council in October 2024. The new European Design Regulation (›EUDR‹) will begin to apply in May 2025. Provisions that require implementing secondary legislation will be applicable in July 2026.

Important changes include the following:

There will be a **name change** and Community Designs will in the future be called Registered EU Designs (REUDs) and Unregistered EU Designs (UEUDs). This change is in line with the change for trademarks many years ago that are now referred to as EU trademarks and emphasizes the importance of the EU design system that conveys protection in all EU member states.

A **new symbol** has been introduced by which, after registration, holders may now inform the public of their ownership, namely a *D in a circle*. This corresponds to the ® for registered trademarks and is useful tool to make third parties aware of existing design rights.

The **scope of protection** will be increased significantly as the definition of a design will now include non-physical objects like the movement, transition or any other sort of animation of the appearance of a product or a part thereof. The definition of product will be extended to symbols, logos, surface patterns, typographic typefaces, GUIs or even the spatial arrangement of items intended to form an interior or exterior environment like a shop layout. Further possible new products include objects of the metaverse, NFT objects as well as animations, maps and fonts. While



computer programs as such are still exempted from protection, this amendment will considerably broaden the scope of protection of designs. Further, the creation, downloading, copying, sharing or distribution of media or software recording the design to enable the manufacture of an infringing product will constitute a design infringement. In other words, the holder of a design will now be able to prohibit infringing products that are made by using 3D printing technologies. Further, at least under certain circumstances, the mere transit of a design through the EU can also be prohibited by the holder of a design.

A further important change concerns **visibility**. While protection is only granted for features of a design that can be seen in the design application, it will no longer be required that the concerned features be visible during normal use of the product. This amendment ends the current practice of EUIPO and the EU courts requiring visibility during normal use for protection and will again significantly strengthen the protection of a design.

With respect to the **application process**, it should be noted that the limitation to seven views per design will not continue to apply. Further, representation will no longer be limited to static views like drawings of photographs but may be done by providing dynamic or animated representations like videos. And finally, for multiple applications, the requirement of unity of class will be abolished so that multiple applications may contain designs in different Locarno classes.

While the holders' rights have been strengthened by the above-mentioned measures, the **defenses** available against accusation of design infringement have also been extended, namely to referential use, comment, critique and parody.

Further changes ahead concern the **national design laws of the EU member states** that **will be harmonized**.

For example, member states may no longer allow protection for **non-registered designs**. The only way to obtain protection for non-registered design will be a non-registered EU design. Non-registered national design will no longer be possible and even regarding non-registered EU designs only deliberate imitations are prohibited, accidental parallel creations remain permitted.

Further, the EU member states now have to introduce a **repair clause** according to which design protection is limited regarding component parts of complex products that are used for repairing purposes aimed at restoring the original appearance of a product, where the appearance of the component part depends on that of the complex product and the manufacturer of the spare part product complies with certain information and due diligence obligations. While design protection in this respect will of course be limited by such a repair clause, it should be noted that the European Court of Justice has so far also applied the repair clause existing for EU designs not only to »must match« parts, where the exact shape of the spare part is needed to restore the original appearance of a product like mudguards of a car, but also to products whose design may be independent of that of the rest of the product like the rims of a car. This clause is intended to liberalize the spare parts market.

Another amendment concerns **referential use and use identifying the manufacturer** of a product. Accordingly, acts carried out for the purpose of identifying or referring to a product in order to identify or refer to a product as that of the holder of the right to a design will not constitute design infringement.

While the harmonization of the national design laws and the modernization of the EU Design Regulation are to be welcomed, it remains to be seen what the authorities and courts will make of the changes and how those will prove themselves in practice.

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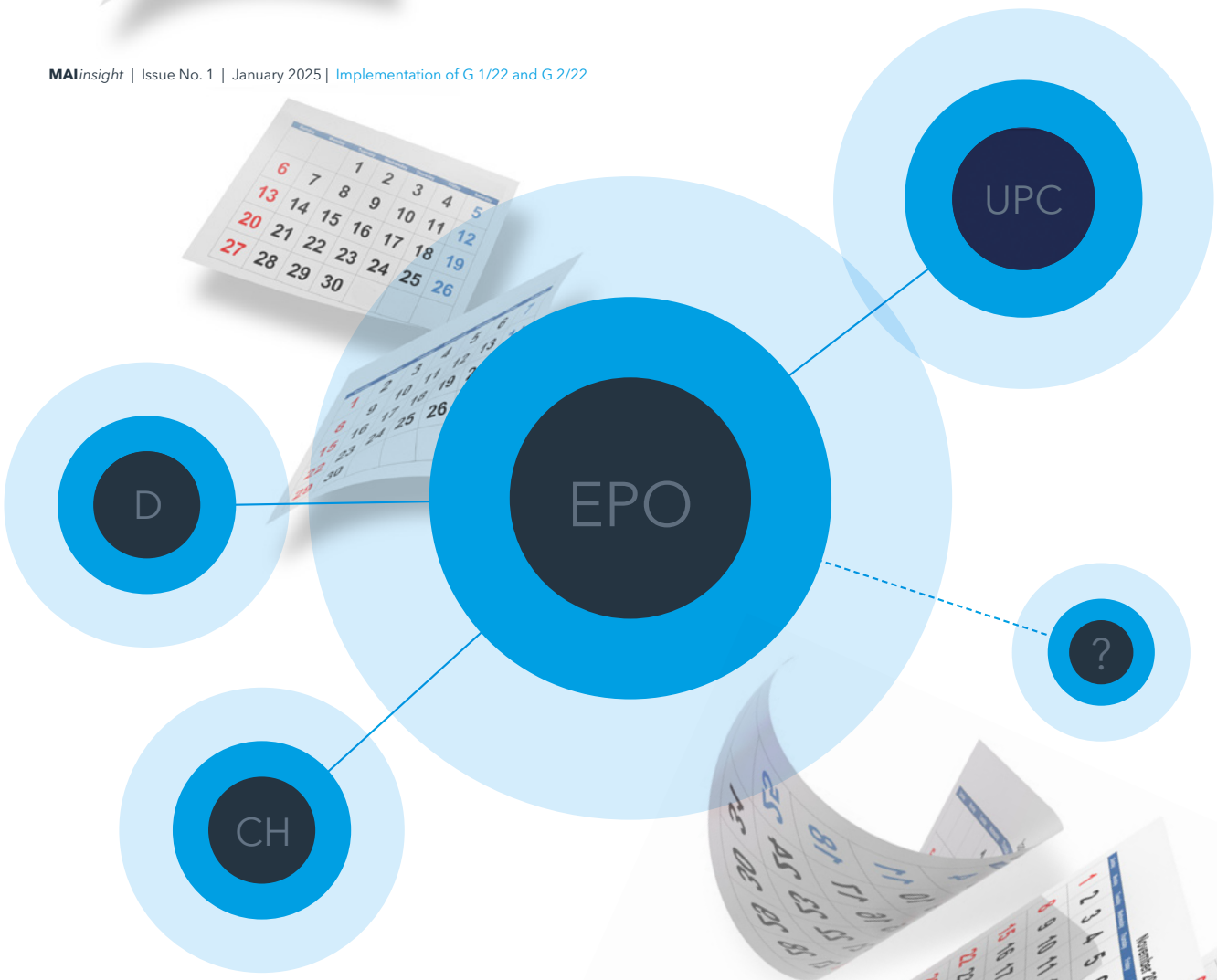


Implementation of G 1/22 and G 2/22 by the EPO and various Courts

EPO decision G 1/22 and G 2/22

Introduction

The EPO strictly distinguishes between the right to the invention/patent (initially with the inventor) and the right to priority (arising with the priority filing and, therefore, initially with the applicant of the priority application) (e.g. T 1201/14). The right to the invention/patent relates to the entitlement to the invention and is governed by national law. According to G 1/22 (consolidated with G 2/22) of the Enlarged Board of Appeal of the EPO, the right to priority relating to the entitlement to the priority (»formal priority right«) is created under the autonomous law of the EPC and governed by Art. 87 to 89 EPC (within the framework of the Paris Convention). The EPC provides no formal requirements for the transfer of the priority right, such as regarding formalities or retroactive transfers. Therefore, according to G 1/22, the lowest formal requirements are applicable (Reasons 99, 100).

Introduction of a rebuttable presumption approach

In G 1/22, the Enlarged Board of Appeal has established a strong rebuttable presumption that the applicant is entitled to claim priority, in general (Headnote I). **This shifts the burden of proof to the effect that the party contesting the right to priority must more or less prove that this right is actually lacking.** The presumption is a strong one (G 1/22, Reasons 110). The intention of the Enlarged Board of Appeal was to ensure that the priority is challenged less frequently in opposition proceedings (G 1/22, Reasons 117).

Introduction of an implied agreement approach

The Enlarged Board of Appeal also established the concept of an implied agreement. In the case underlying G 1/22, the mere fact of the joint filing of a subsequent PCT application is sufficient for the parties to apparently have entered into an implied agreement to the effect that an additional subsequent applicant may invoke the priority right conferred by the filing of the priority application by another subsequent applicant or other subsequent applicants (G 1/22, Headnote II).

Outlook

The first cases in which the EPO Opposition Divisions and Boards of Appeal implement the new concepts introduced by the Enlarged Board of Appeal in G 1/22 are out; also other courts, such as the German Federal Supreme Court, the Federal Patent Court of Switzerland and the UPC have referred to these new concepts. To what extent these have been adopted, is discussed in the following.

EPO: T 2360/19

While there have been a few instances in which the Boards of Appeal have followed G 1/22 where there was no attempt at rebuttal (e.g. T 2643/16), T 2360/19 is the first occasion on which the Boards of Appeal have dealt with an attempt to rebut the rebuttable assumption. This is perhaps not surprising: After all, in G 1/22, the Enlarged Board referred to T 844/18, which dealt with EP 2 771 468, the parent patent to the patents under appeal in T 2360/19, several times despite not being concerned with this patent family (see Reasons 29, 33, 39, 47, 58, 91, 128, and 137 of G 1/22). Similarly, the Broad Institute, one of the proprietors of EP 2 771 468 B1 and its divisional patents, submitted an Amicus curiae brief in G 1/22.

The priority situation in T 844/18 and T 2360/19, which pertain to the Broad Institute's, MIT's and Harvard College's (hereinafter collectively referred to as »the Broad«) key patent family directed to use of CRISPR/Cas9 in eukaryotes, is complex. The patents draw the priority of 12 priority applications, P1 to P12, as depicted below:

Of particular importance are the first (P1) and second (P2) priority applications, which were filed before (P1) or at the same time (P2) as a scientific publication by members of the same group, Mali et al. Science. 2013 Feb 15; 339(6121):823-6. Mali et al. discloses the use of CRISPR/Cas9 (with one NLS on Cas9) in eukaryotes. Loss of at least P1 and P2 would therefore result in a lack of novelty over Mali et al. in this respect. Crucially, P1 and P2 (along with P5 and P11) list Luciano Marraffini of the Rockefeller University as an applicant, while the PCT application lists neither Mr. Marraffini nor the Rockefeller University. Mr. Marraffini automatically assigned his right to P1 and P2 to the Rockefeller University per his employment contract, and neither he nor the Rockefeller University had formally assigned the right to P1 and P2 to the Broad.

Following the »all applicants« approach, the Opposition Division held that there was no entitlement to P1 and P2 in parent patent EP 2 771 468 and divisional patents EP 2 784 162, EP 2 764 103 and EP 2 896 607. Due to Mali et al. becoming full prior art as a result, the Opposition Division revoked EP 2 771 468, EP 2 784 162, and EP 2 764 103 for lack of novelty and maintained EP 2 896 607 in a severely narrowed form. In T 844/18, which dealt with parent patent EP 2 771 468, the Board confirmed the Opposition Division's decision and finally revoked the patent.

Upon the referral to the Enlarged Board, the Broad requested consolidation of the appeal proceedings for divisional patents EP 2 784 162, EP 2 764 103 and EP 2 896 607 in T 2360/19 and a stay of proceedings while G 1/22 was pending. This request was granted by the Board, and evidently served the Broad well.

The Enlarged Board, referring to T 844/18, held in G 1/22 that *»[a]n agreement (regardless of its form) can only be held against parties who were involved in the facts establishing the agreement. Co-applicants for the priority application who were not involved in the subsequent application may not be deemed to have consented to the reliance on the priority right by the other co-applicants for the priority application (a situation underlying e.g. T 844/18). **The subsequent applicant(s) may however still be entitled to claim priority since the rebuttable presumption of entitlement does not depend on whether the involved applicants acted as co-applicants at any stage**«* (Reasons 128; emphasis added).

The Enlarged Board further stated, again referring to T 844/18, that »*[i]n specific contexts, a priority applicant missing from the subsequent application may have reasons to claim the title to the subsequent application (in proceedings before national courts) or may possess evidence to rebut the presumption of priority entitlement in proceedings before the EPO*« (G 1/22, Reasons 137).

That is, it appears that the Enlarged Board already hinted at how the matter of priority should have been handled in T 844/18, providing clear guidance to the Board handling T 2360/19.

The Opponents in T 2360/19 then attempted to rebut the rebuttable assumption based on a heated public disagreement in the United States in which Mr. Marraffini and the Rockefeller University sought to have Mr. Marraffini be named as one of the inventors and the Rockefeller University be named as one of the proprietors of the PCT application underlying the European patents at stake in T 2360/19. This inventorship and ownership dispute was resolved only in January 2018 by independent arbitration, which determined that Mr. Marraffini should not be named as an inventor and the Rockefeller University should be named as a proprietor. The dispute was not concerned with the right to priority, and the opponents argued that it followed that a) there was no explicit agreement about a transfer of priority rights, and b) it could not be presumed that there was an implicit transfer, either.

The Board however held that the priority dates of P1 and P2 were indeed validly claimed and referred to G 1/22 in this regard. The Board reiterated that the rebuttable presumption »*involves the **reversal of the burden of proof**, i.e. the party challenging the subsequent applicant's entitlement to priority has to prove that this entitlement is missing. Just raising speculative doubts - even if these are „serious» as in the words of the Enlarged Board (G 1/22, Reasons 110, 113) - is not sufficient: **to put into question the subsequent applicant's entitlement to priority, (full) evidence would be needed*** (see reasons 110, 126)« (T 2360/19, Reasons 9; emphasis added). The Board held that since the inventorship dispute was not concerned with priority entitlement, it indeed does not provide evidence that the Broad is entitled to the priority rights they claim. However, according to the Board, »*this is precisely what the presumption in G 1/22 states: that the appellants do not have to provide such evidence, but the opponents have to rebut the presumption*« (T 2360/19, Reasons 16).

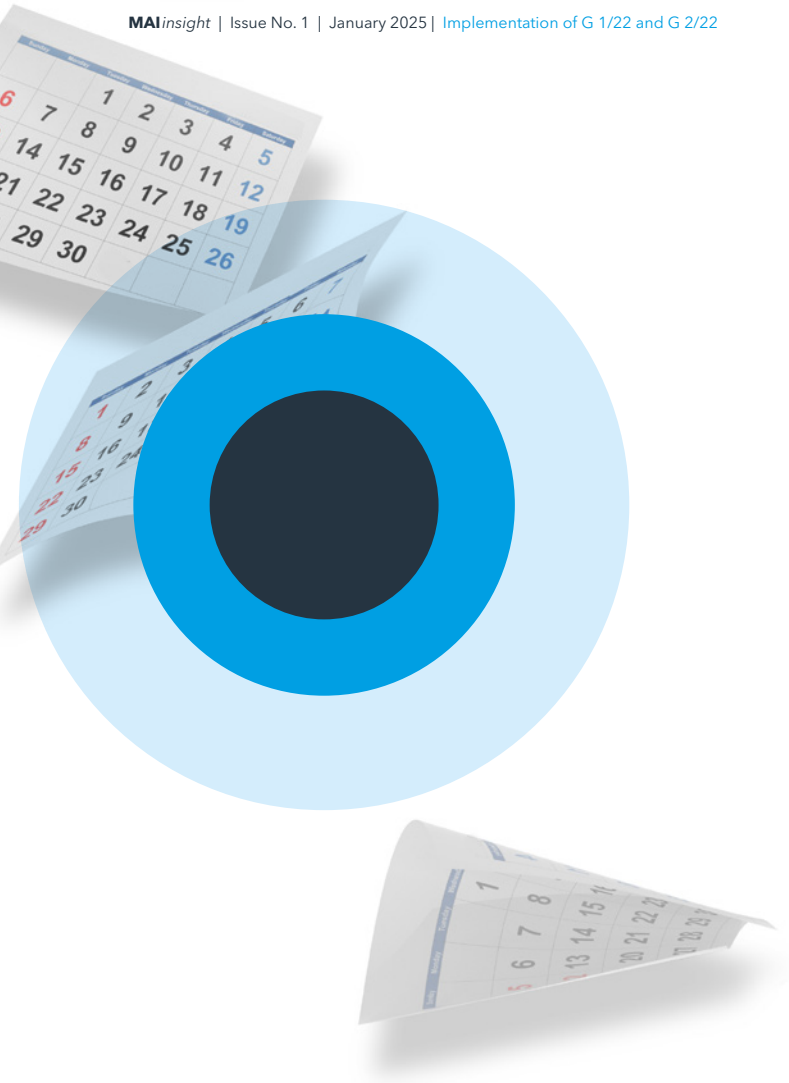
As a consequence, the Board found that there was »*no evidence that rebuts this presumption in the present case*« (see Reason 17) and that, since the inventorship dispute had in the meantime been settled, »*[i]f at all, there is evidence to the contrary, which supports the presumption of an implied transfer agreement*« (T 2360/19, Reasons 18). Interestingly, the Board held that the very fact that Mr. Marraffini and the Rockefeller University sought to be added as inventor and proprietor, respectively, made it »*not credible that Marraffini or the Rockefeller University would have acted in a way to invalidate the priority claim of a patent they were seeking to be named as inventor of, and owner of, respectively*« (T 2360/19, Reasons 21). Finally, the Board clarified that »*even in the absence of any evidence regarding the settlement of the inventorship dispute, the result would have been the same, based on the presumption of a valid priority claim, which has neither been rebutted by this nor any other evidence on file (see again G 1/22, reasons 100)*» (T 2360/19, Reasons 25). Therefore, the Board found the priority claims to be valid and remitted the case to the Opposition Division for further prosecution.

T 2360/19 thus seems to solidify that it will **essentially be impossible** to rebut the rebuttable presumption of validity, effectively removing „all applicant» objections from opponents' arsenals. This is especially evident from the fact that T 2360/19, in accordance with G 1/22, notes that priority entitlement may be decided in national proceedings but also outside the courts, by way of amicable settlement or arbitration, but that »*there is always a party who is entitled to claim priority and that this right is not »lost« somewhere in an inventorship dispute*« (T 2360/19, Reasons 26).

Germany

The German Federal Supreme Court referred to G 1/22 for the first time in the decision Sorafenib-Tosylat (X ZR 83/21) of November 2023. The headnote says that the joint filing of a PCT application in which the applicant of the priority application is named for one or more designated states, and another applicant (more precisely »person«) is named for one or more other designated states, implies an agreement of the applicants (more precisely »parties involved«) that the other applicant (more precisely »person«) is entitled to claim priority. The Senate expressly adopted G 1/22 and the strong, rebuttable presumption established therein in this regard, stating that the G-decision is well founded (margin no. 110, 111).

In line with this, the headnote of the decision Sorafenib-Tosylat says that in nullity proceedings the burden of proof regarding the requirements for a valid priority claim is with the Plaintiff. This shifts away from previous German case law according to which the burden of proof for lack of entitlement to priority was with the Plaintiff (BeckRS 2013, 13744; GRUR 2022, 353).



The German Federal Supreme Court further states in its decision that **contracts the Defendant (Proprietor) had submitted do not exclude that individual agreements, possibly conclusively, exist** (margin no. 116). This is in line with established German case law that no formal transfer of a priority right is required (X ZR 49/12 – Fahrzeugscheibe; X ZR 14/17 – Drahtloses Kommunikationsnetz).

However, here, the German Federal Supreme Court did not expressly refer to the autonomy of the EPC as regards the formal priority right nor indicate potential constellations indeed allowing to rebut the presumption. In this regard, concerns have been raised in the literature to what extent the Federal Supreme Court actually adopts the new EPO practice (GRUR Patent 2024, 236, margin no. 19). Specifically, **it remains to be seen whether the German Federal Supreme Court will indeed interpret the burden of proof being with the Plaintiff as corresponding to the EPO's strong rebuttable presumption for the validity of the priority entitlement**. The Enlarged Board expressly - and correctly - notes the national courts' freedom in this regard, in particular that national courts are not bound by the EPO's assessment (G 1/22, Reasons 115).

In the later decision Happy Bit (X ZR 74/21) of January 2024, the German Federal Supreme Court confirmed the Sorafenib-Tosylat decision and presented a similar reasoning.

Switzerland

Switzerland has also since followed G 1/22 in decision O2022_007 of 5 March 2024 by the Federal Patent Court of Switzerland (Mepha Pharma AG vs Bristol-Myers Squibb Holdings Ireland Unlimited Company), albeit not in all points. In this case, the proprietor of the priority application was a different entity than the proprietor of the later patent.

The Swiss Federal Patent Court addressed G 1/22's reversal of the burden of proof established in Reasons 110 and 113 in detail and determined that, while any decisions by the Boards of Appeal of the EPO are not binding for Swiss courts but should be considered when interpreting Swiss law, the reversal cannot be applied to Switzerland: »***The burden of proof*** *that WO 652 validly claims the priority of the first application US 165 therefore* ***lies with the defendant as the holder of the property rights***« (Reasons 29; emphasis added). Apparently, Switzerland thus maintains that the burden of proof for establishing entitlement to priority remains with the proprietor, contrary to G 1/22. This appears to be a consequence of Art. 20(1) of the Swiss Patent Act, expressly requiring the proprietor to prove the existence of the priority right in the case of legal proceedings.

However, in an interesting twist, the Swiss Federal Patent Court then went on to establish that »*while the assessment of evidence by the Enlarged Board of Appeal is not binding for Swiss courts (E. 29), Swiss courts can of course follow the considerations of the Enlarged Board of Appeal if they are convincing.*« (Reason 30).

That is, despite holding that the reversal of the burden of proof cannot be in agreement with Swiss law, the Swiss Federal Patent Court **still applies the Enlarged Board's rebuttable assumption** (which the Enlarged Board intends to entail the reversal of the burden of proof). Indeed, the Swiss Federal Patent Court holds: »*Rather,* ***it can be assumed*** *that BMS Pharma provided the documents in the knowledge that BMS Company needed them to claim the priority of the initial application US 165 and agreed to this use*« and that »*[t]his is not one of the ›rare exceptional cases‹ referred to by the Enlarged Board of Appeal which would overturn the conclusion that the subsequent applicant, who had access to the priority documents, acted with the consent of the first applicant*« (see Reason 30, emphasis added).

It remains to be seen, however, if, and if so, how, Switzerland will apply the rebuttable presumption in an »all applicants« approach where one or more applicants are missing, but others remain.

UPC

In the decision concerning the proceedings UPC_CFI_255/2023 and UPC_CFI_15/2023 dated 19 July 2024, the Court of the First Instance of the Central Division (Paris seat) dealt with a priority issue. In the case underlying this decision, allegedly only the rights to the invention/patent were expressly assigned from the applicant of the priority application to the applicants of the subsequent application, but not the right to priority.

The Panel recognized that the priority right is distinct from the right to the subsequent patent (application). As such, the priority right is not automatically transferred with the transfer of the right to the title, but requires a specific dispositive act (margin no. 87 of the decision). The Panel concluded that there is a rebuttable presumption to priority in favor of the subsequent applicant (margin no. 90), as »*all these facts establish a rebuttable presumption of the entitlement to priority in favor of the subsequent applicant, provided the latter can demonstrate the acquisition of the right to the title.*« In this case, since the Plaintiff »*has* ***not provided any evidence to suggest that the priority rights were the subject of a separate dispositive act in favor of third parties or that the original applicants intended to retain them instead of transferring them along with the rights to the title****, the presumption is not rebutted*« (margin no. 91). The Panel acknowledged that agreements regarding the transfer to the right to the invention rarely address a transfer of the priority right, which is implicitly treated as a mere ancillary right to the right to the subsequent application (margin no. 88).

Here, it appears that the UPC looked more closely at the priority issue than the EPO would have done, as the rebuttable presumption was only established since the Proprietor could prove the acquisition of the right to the invention/patent. It remains to be seen whether the UPC will indeed adopt the same, strong rebuttable presumption as established by the EPO.

Discussion and Summary

Although a number of jurisdictions appear to »like« the EPO approach, it remains to be seen whether these and other courts will indeed implement the criteria for rebutting the strong presumption in the same, very strict way as the EPO. For example, under German law, the matter may boil down to the question whether the Plaintiff has fulfilled their burden of proof, rather than whether a strong presumption has been rebutted. Also, national courts (possibly not the UPC) dealing with issues regarding entitlement to the invention may take another approach regarding the entitlement to the priority right as well.

Before the EPO, it may practically be impossible to invalidate the formal priority claim, as successfully rebutting the presumption may realistically be limited to situations involving acting under bad faith, e.g. involving a criminal act in the sense of stealing information on priority documents and filing thereof. The EPO's drivenness on validity of the formal priority has the consequence that the likelihood for a patent to be revoked for lack of patentability is reduced. Hence, **more patents are expected to survive EPO opposition proceedings**.

For patents that have survived EPO opposition proceedings due to the EPO's presumption that the formal priority claim is valid, there may be another, more »promising« opportunity to challenge the validity, namely in subsequent invalidity proceedings before the UPC or before national courts (against national parts of the EP patent). Hence, it may turn out that EP patents actually having »formal priority issues« are more successfully attackable in other invalidation proceedings than EPO opposition proceedings.

From another point of view, this may mean that, prior to G 1/22, the situation may have occurred that an EP patent was revoked because of (prior art only relevant due to) lack of the formal priority right in EPO opposition proceedings. The revocation of the patent by the EPO would have rendered any national, possibly more lenient practice on formal priority issues void. However, by way of the new concepts of G 1/22, the **EPO allows national courts/the UPC to hand down a final decision on the formal priority claim**. This may result in a shift of substantive examination of the validity of the formal priority claim to proceedings outside the EPO.

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Update on G 1/23

The Preliminary Opinion of the Enlarged Board of Appeal on the Referral ›Solar cell‹

Introduction into the matter of G 1/23

After receiving a multitude of Amicus curiae briefs, observations by the Opponent and the Proprietor from the interlocutory decision T 438/19, and comments from the EPO President, the Enlarged Board of Appeal has issued their Preliminary Opinion in the Referral G 1/23 (›Solar cell‹).

G 1/23 is essentially concerned with the question if reproducibility should be a requirement for products put on the market to form part of the state of the art within the meaning of Article 54(2) EPC, and, if so, to what extent.

More specifically, the questions are as follows:

1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its **composition or internal structure could not be analysed and reproduced** without undue burden by the skilled person before that date?
2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Article 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?
3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of opinion G 1/92? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?

This referral can be seen as the culmination of the diverging jurisprudence emerging subsequent to G 1/92, in which such a reproducibility requirement for commercial products was introduced. Especially in the field of polymer chemistry, this requirement has proven to be rather critical, as the reproduction, in particular the identical reproduction of polymers, is historically difficult if not impossible.

In their Preliminary Opinion, the Enlarged Board has taken a rather philosophical perspective on reproducibility with far reaching implications for other types of state of the art, such as written disclosures.

Summary of the Preliminary Opinion of the Enlarged Board of Appeal

The Enlarged Board preliminarily concludes that there is no legal basis for a reproducibility requirement for products put on the market. Although they acknowledge that this would somewhat deviate from the well-established case law regarding the enablement requirement for written disclosures originally based on T 206/83, the Enlarged Board also emphasizes that *»general acceptance in the case law cannot substitute a lacking legal basis of a legal concept, in particular where other interpretations also appear reasonable«* (par. 21).

In addition to a lack of legal basis for the reproducibility requirement, the Enlarged Board further elaborates that basically *»everything under the sun«* (par. 27) would be excluded from the state of the art under this requirement,

as somewhere in every reproduction chain a starting material would have to be used, which itself is not reproducible, such as for example chemical elements (par. 29).

In the opinion of the Enlarged Board, this further implies that written disclosures would also not be enabled, as the materials used to reproduce the written teaching would again not be reproducible.

Accordingly, the Enlarged Board is of the opinion that this consequence of the reproducibility requirement, i.e., the exclusion of physically existing products from the state of the art, directly contradicts everyday experience and that such a legal fiction was not intended by G 1/92 (par. 26).

As a solution to this predicament, the Enlarged Board proposes to assume that *»the enablement requirement foreseen by G 1/92 is also satisfied by the non-reproducible product in its readily available form, so that a* ***physical product is by definition enabled by being put on the market****«* (par. 32, emphasis added).

Consequentially, non-reproducible commercial products with all their analysable properties and features would form part of the state of the art.

Regarding non-analysable features, the Enlarged Board considers it undisputed that such non-analysable features would not form part of the state of the art (par. 31).

In conclusion, the current proposition of the Enlarged Board for the answers to the referred questions is that Question 1 has to be answered with »no«, so that a lack of reproducibility does not lead to the exclusion of a commercial product from the state of the art. Question 2 regarding technical information of an irreproducible product would be answered in the affirmative and Question 3 concerned with the degree of reproducibility would be moot for this combination of answers.

Remarks

The proposed assumption that a physical product is by definition enabled by being put on the market seems to be an elegant solution to the depicted issues and also appears to not interfere with the established case law for written disclosures. Overall, this approach seems to represent the reality quite adequately as commercial products are valuable assets for the skilled person and their exclusion from the start of the art would be rather unfounded. Further, unwanted consequences of a reproducibility requirement such as subsequent patenting of an already existing product can be avoided and uncertainties regarding the necessary degree of reproduction or about what constitutes the composition or internal structure of a product would no longer have to be addressed.

However, some of the issues that were raised in the Amicus curiae briefs or the observations by the parties still remain in need of clarification.

For example, would the commercial product, in particular the available technical information thereof, cease to be state of the art when the product is no longer available on the market?

Will the EPO introduce a concept similar to the›on-sale bar‹ limitation known from the USPTO (35 U.S.C. § 102) that grants an inventor a grace period of 1 year before the commercial product becomes state of the art when the commercial product is put on the market by the inventor himself?

At least for the latter question an affirmative answer seems rather improbable, since the EPO generally does not grant grace periods for filing applications after an inventor's own prior public disclosure, contrary to other jurisdictions such as the US or Germany (for utility models).

Outlook

Since the Oral Proceedings in proceedings concerning the interlocutory decision T 438/19 are scheduled to take place 15 to 17 October 2025, a decision on G 1/23 can be expected next summer. It will be highly interesting to see if the Enlarged Board will deviate from their current position as elaborated in their Preliminary Opinion and if they will give further guidance for some of the remaining issues that the Preliminary Opinion does not address.

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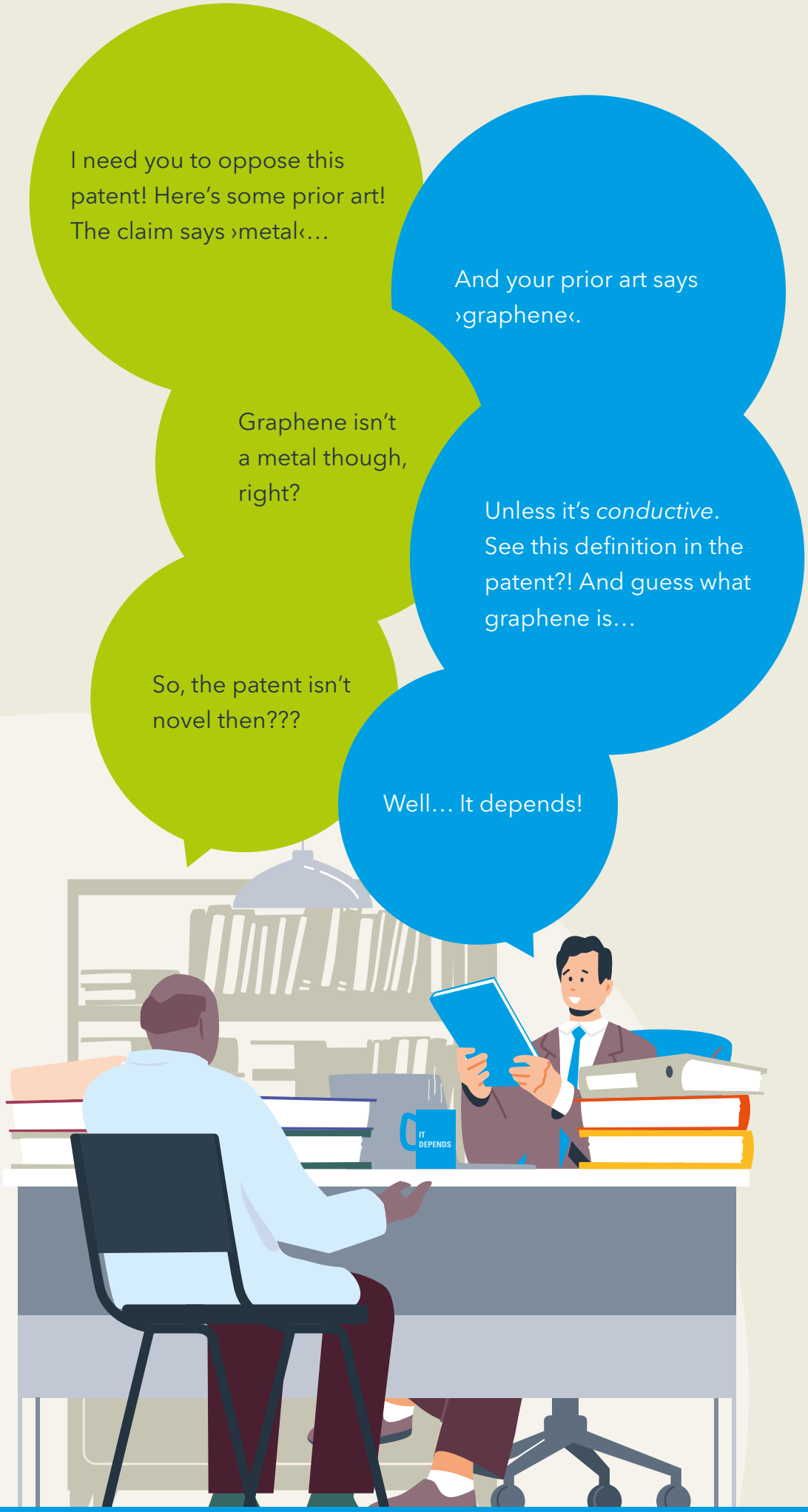

I need you to oppose this patent! Here's some prior art! The claim says ›metal‹…
And your prior art says ›graphene‹.
Graphene isn't a metal though, right?
Unless it's *conductive*. See this definition in the patent?! And guess what graphene is…
So, the patent isn't novel then???
Well… It depends!
IT DEPENDS

Referral G 1/24 ›Heated aerosol‹

Claim interpretation and assessment of patentability

Introduction

Picture this: A patent attorney is sitting in the office. A client asking to oppose a patent that was recently granted by the EPO, providing a selection of prior art, and requesting an estimate of the chances of the patent being revoked by the EPO. The patent attorney studies the documents and the prior art ›kind off‹ anticipates the subject matter of the granted claims. Kind off – or as a patent attorney might more likely put it: »It depends!«

The patent claim relates to a component comprising a ›metal‹; a term that has a clear and defined meaning to the skilled person. On the other hand, the prior art component is made of graphene.

The specification of the patent to be opposed defines the term ›metal‹ as anything that is electrically conductive. Thus, the definition according to the specification includes materials such as graphene consisting of carbon (a non-metal) which – as the skilled person knows from the common general knowledge – is electrically conductive. On the other hand, such definition may be considered to exclude the metal bismuth, a rare metal which has a very low conductivity to electricity under standard conditions, from the claim.

Whereas the wording of the granted claim read in isolation may be clear and thus excludes a component made of graphene (rendering the claim novel), reading the claim in the light of the patent specification may cover such a component made of graphene.

The interpretation of the claim thus becomes crucial: If the specification of the opposed patent is taken into account (and thus, what might have been intended when the applicant filed the application), the prior art is novelty destroying for the opposed patent. If, on the other hand, the claim is interpreted in isolation accepting the common definition of the term ›metal‹, the subject matter may be novel.

So, what are the ›chances of the patent being revoked‹ in the opposition proceedings? – It depends?!

The case underlying G 1/24

The recent referral to the Enlarged Board of Appeal, G 1/24, addresses how inconsistencies between the skilled person's understanding of a term used in a claim and a definition of said term in the specification affect patent prosecution and opposition at the European Patent Office (EPO). The decision is anticipated to significantly affect daily practice, particularly in how claims are drafted, amended, and assessed.

The case underlying G 1/24 originates from T 0439/22, a case involving a patent on ›heat-not-burn‹ tobacco products (European Patent EP 3 076 804). The primary issue revolves around how patent claims should be interpreted in general and the term ›gathered sheet‹ used in the claims in particular.

In answering the question of how to interpret the term ›gathered sheet‹, the referring Board faced divergent interpretations regarding whether the term ›gathered sheet‹ should be understood strictly based on its literal meaning or interpreted in light of the description provided in the patent.

The referring Board of Appeal considers that said interpretation is decisive for the case:

In the first instance, the Opposition Division had interpreted the term ›gathered sheet‹ in view of the skilled person's common general knowledge as evidenced by an article in online encyclopedia Wikipedia with the title ›Gather (sewing)‹, i.e. that the term ›gathered sheet‹ had to be interpreted as a sheet that is geometrically modified into a complex shape in analogy to ›gathering‹ as used as a sewing technique (see Decision of the Opposition Division, item 7.2). In other words, a ›gathered sheet‹ is a sheet that has been given a three-dimensional structure, e.g. by being folded along lines to occupy three-dimensional space.

Applying said interpretation, the referring Board came to the conclusion that the subject matter of the opposed patent is novel and inventive over the prior art.

On the other hand, the referring Board observed that the patent specification contains a broader definition of the term ›gathered‹, supporting that a sheet of tobacco material is convoluted, forwarded, or otherwise compressed or constricted substantially transverse the to the cylindrical axis of the rod. In other words, the definition of the term ›gathered‹ as used in the opposed patent is broader than what the skilled person would understand from the common general knowledge, i.e. the definition includes embodiments of a sheet being convoluted, such as spirally wound.

Applying said broader interpretation, the referring Board concluded that the subject matter of the opposed patent lacks novelty in view of prior art D1 as cited by the Opponent.

Therefore, the interpretation of the terms used in the claim of the opposed patent was considered to be decisive for the case: When considering the wording of the claim in isolation, the subject matter of the opposed patent is novel and inventive. When considering the definition of the term in the specification of the opposed patent, the subject matter of the opposed patent would lack novelty or inventive step.

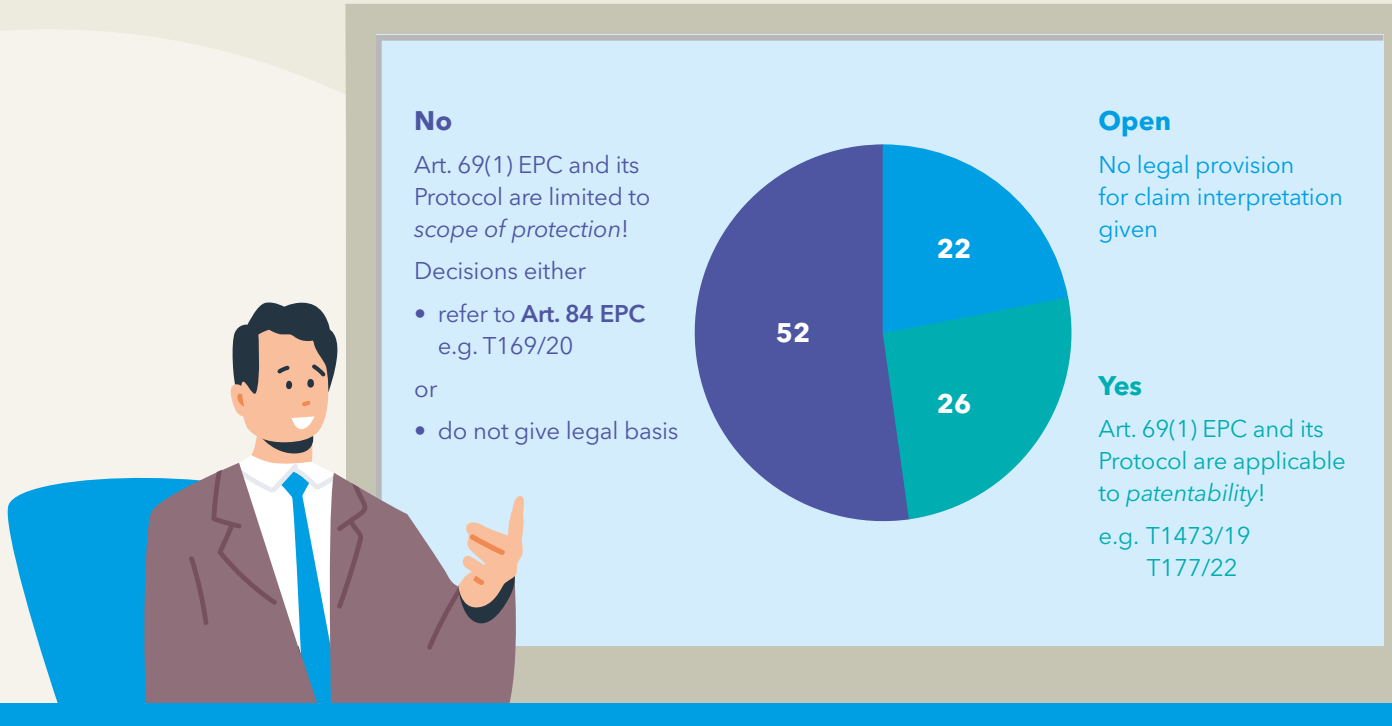
The referral questions and the Amicus curiae briefs

The first issue as considered by the referring Board was whether the European Patent Convention (EPC) even provides a **legal basis that allows to interpret the claims of an application or patent beyond its literal meaning.**

The referring Board concluded that there are two possible legal bases for interpreting the claims:

One of the legal bases as identified by the EPO Boards of Appeal was Art. 84 EPC, which stipulates that the claims define the subject matter for which protection is sought. The second legal basis was found to be Art. 69(1) EPC, which is directed to the scope of protection conferred by a European patent or European patent application, whereas the latter article appeared to be favored by the referring Board. However, Art. 69(1) EPC and the Protocol thereon are directed to the scope of protection (which may cover equivalents), not to the assessment of patentability.

The referring Board faced divergent case law on the question of the correct legal basis for interpreting a claim and identified 100 decisions since 2008 dealing with the question of claim interpretation (cf. T 439/22, reasons 3.2 and 3.3). In essence, the following approaches were identified by the referring Board:



A total of 52 decisions found that Art. 69(1) EPC and its Protocol do not constitute a legal basis for claim interpretation. Instead, they either referred to Art. 84 EPC (e.g., T 169/20), or no legal basis was identified at all. Furthermore, 22 decisions were found to acknowledge the need for claim interpretation. However, said decisions allegedly do not give a legal basis for claim interpretation at all. Only 26 decisions were identified that actually found Art. 69(1) EPC to constitute a legal basis for claim interpretation given in the EPC.

The referring Board facing said diverging case law, hence, referred the following question to the Enlarged Board of Appeal to clarify the legal situation and to provide legal certainty from a dogmatic point of view:

1. *Is Article 69(1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC to be applied on the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC?*

Art. 69(1) EPC is the only provision within the EPC that would allow to interpret a claim in view of the specification. For further clarification of the case at hand underlying T 439/22, the referring Board also referred second and third questions to the Enlarged Board of Appeal as follows:

2. *May the description and figures be consulted when interpreting the claims to assess patentability and, if so, may this be done generally or only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation?*
3. *May a definition or similar information on a term used in the claims which is explicitly given in the description be disregarded when interpreting the claims to assess patentability and, if so, under what conditions?*

These referral questions underscore a fundamental tension: Balancing the plain language of claims with the broader context provided by the description and drawings.

The relevance of these questions is highlighted by the fact that several members of the public and institutions have formulated their opinion on these questions in the form of Amicus curiae briefs by the official term of 15 November 2024: A total of 26 amicus curiae briefs were received.

The majority of the European patent attorney community (as far as their opinion could be derived from the Amicus curiae briefs) might generally be of the opinion that the specification should be taken into account when interpreting the terms used in a claim, even when the person skilled in the art finds a claim read in isolation clear. As becomes apparent from the Amicus curiae briefs filed by numerous parties, it appears to be the majority's view that the specification (and figures) of the patent or patent application is to be considered when interpreting the claims.

However, it also becomes clear from the Amicus curiae briefs that the answer to the second and third questions may depend on the question whether a term in a claim is to be interpreted more narrowly or broader than its literal meaning.

There appears to be no dispute (neither in the case law nor in the Amicus curiae briefs) that a term as used in a claim may not be interpreted more narrowly than the understanding of the skilled person in view of the common general knowledge in view of the specification. If, however, an applicant/patentee chooses to define the term, such as the term "metal", in a way that is broader than the understanding of the skilled person in view of the common general knowledge, there appears to be no doubt that said applicant/patentee should be held to such interpretation when assessing patentability.

In other words, the patent attorney community (as far as their opinion can be derived from the Amicus curiae briefs on file) may favor taking the description into account when interpreting claim, at least in situations where the specification contains a definition that goes beyond the understanding of the skilled person in scope.

Outlook

While the President of the EPO has recently decided that examination and opposition proceedings before the first instances of the EPO are not to be stayed in view of the pending referral G 1/24, several Boards of Appeal have decided to await the decision of the Enlarged Board of Appeal.

The Enlarged Board of Appeal recently summoned the parties to **oral proceedings on 28 March 2025**, which underlines its intention to clarify the situation quickly. A written decision may thus be expected in mid-2025.

The outcome of the referral G 1/24 will directly impact how patent applications are ideally to be drafted, examined, and opposed, with implications for both applicants/patentees and third parties.

Clearer guidelines on whether the description needs to be adapted to amended claims will streamline examination proceedings. Applicants may face more or fewer requests to amend the description, depending on the Enlarged Board's decision.

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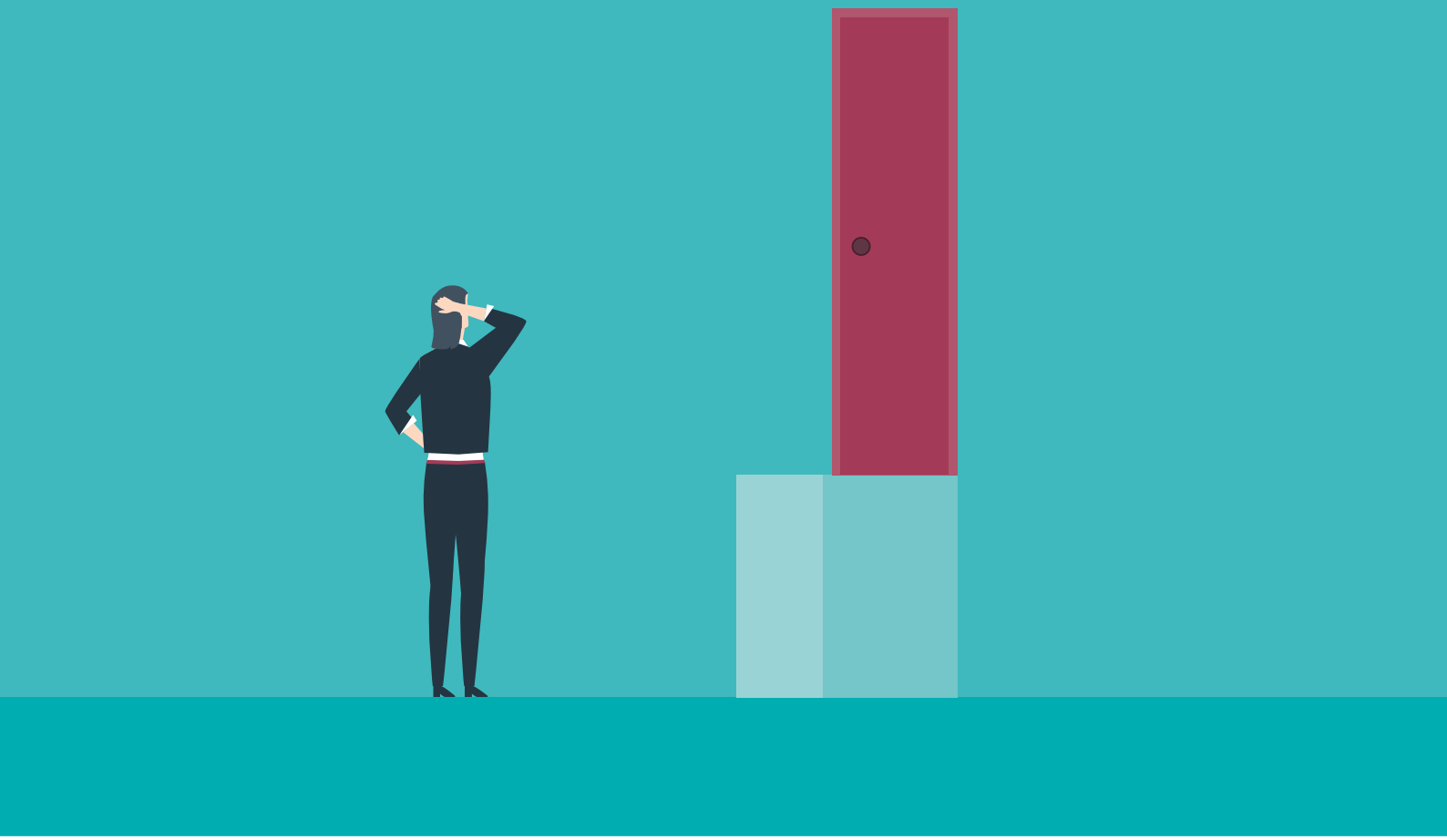


Return to the UPC – but how?

The UPC Local Division Helsinki and Court of Appeal on the requirements for an opt-in

Already in the first few months, the UPC had to deal with one of the most important, if not the most important question arising during the transitional period: Under which specific circumstances is it possible to withdraw an opt-out pursuant to Article 83(4) UPCA in view of national proceedings pending for the same patent?

In the case AIM Sport v Supponor (UPC_CFI_214/2023), the Local Division (LD) Helsinki ruled on 20 October 2023 that European patents which have been opted out are permanently excluded from the jurisdiction of the UPC if national proceedings were still pending at the time the UPCA, and thus the UPC, entered into force on 1 June 2023. On 12 November 2024, the Court of Appeal (CoA) (UPC_CoA_489/2023, UPC_CoA_500/2023) took a different view and found that Art. 83(4) UPCA only refers to actions which are brought before a national court **during the transitional regime**, i.e. after June 1, 2023.

Facts

In the case at hand, the opt-out was declared during the sunrise period on 12 May 2023, with regard to AIM Sport's European patent EP 3 295 663. The withdrawal of the opt-out (›opt-in‹) was filed on 5 July 2023. On the same

day, the patent owner lodged an infringement action (ACT_545571/2023), also including a request for provisional measures (ACT_551054/2023) against Supponor. At the time of both the opt-out and the opt-in declarations, and thus also on June 1, 2023, appeal proceedings regarding an infringement action and a nullity action relating to this patent, which had commenced in 2020, were still pending before German courts.

Decision

These decisions essentially concern the interpretation of Art. 83(4) UPCA and Rule 5.8 RoP and in particular the terms ›action‹ and ›has already been brought‹.

The panels of both instances of the UPC agreed that the term ›**action**‹ in Art. 83(4) UPCA refers not only to infringement and revocation actions, but to all actions mentioned in Art. 32(1) UPCA over which the UPC has jurisdiction.

However, the CoA assessed the significance of Art. 83(4) UPCA in the overall context of Art. 83 UPCA, which tellingly bears the title ›Transitional regime‹, differently than the LD Helsinki. In the CoA's opinion, both the system and the purpose of Art. 83 UCPA do not allow any other conclusion than that all the provisions therein relate to the duration of the transitional period. In particular, the term ›action‹ used in the various paragraphs of Art. 83(4) UPCA is to be understood uniformly: According to para. 1, parallel jurisdiction of the national courts and the UPC only exists during this period. The effect of opting-out under para. 3 only exists from the beginning of the transitional period, i.e. from June 1, 2023, and the term ›action‹ in para. 3 necessarily refers to actions brought during the transition period. Finally, para. 5 also evidently refers to actions brought during the transitional period. The panel sees no reason why the term ›action‹ in para. 4 should be interpreted differently.

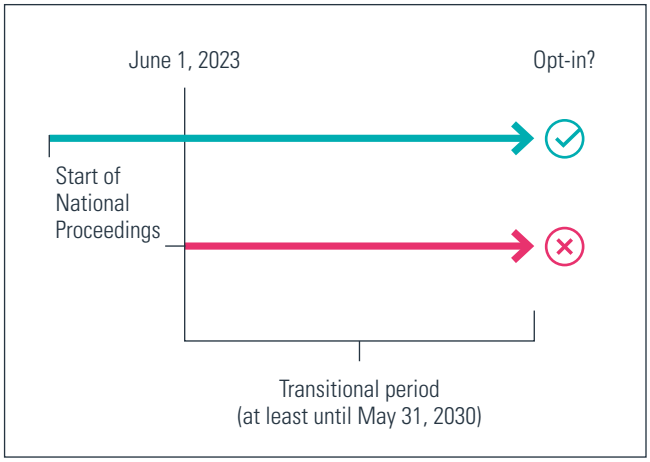
According to the CoA, Art. 83 UPCA is about respecting the rights and expectations of European patent owners and giving them the opportunity to gain more confidence in the functioning of the UPC before subjecting their patents to the new system. The opt-in option serves to reverse the consequences of an earlier opt-out and to use the UPC as soon as this confidence has been gained (UPC_CoA_489/2023, UPC_CoA_500/2023, paragraph 30, emphasis added):

»[O]bject and purpose of Art. 83 UPCA is not to prevent parallel litigation and contradictory decisions, but to provide the mechanism for the transitional regime during which the patent proprietor is given a choice to opt out from the UPC jurisdiction and undo that choice later...«

Therefore, the term ›has already been brought‹ in the context of Art. 83(4) UPCA is to be understood to mean an action brought before a national court after the transitional regime came into existence.

Takeaway

The phrase ›unless an action has already been brought before a national court‹ in Art. 83(4) UPCA only refers to actions brought after 1 June 2023. National litigation brought prior to this date, whether still pending or not, is not covered by the transitional regime of Art. 83 UPCA and does, therefore, not conflict with an effective opt-in.



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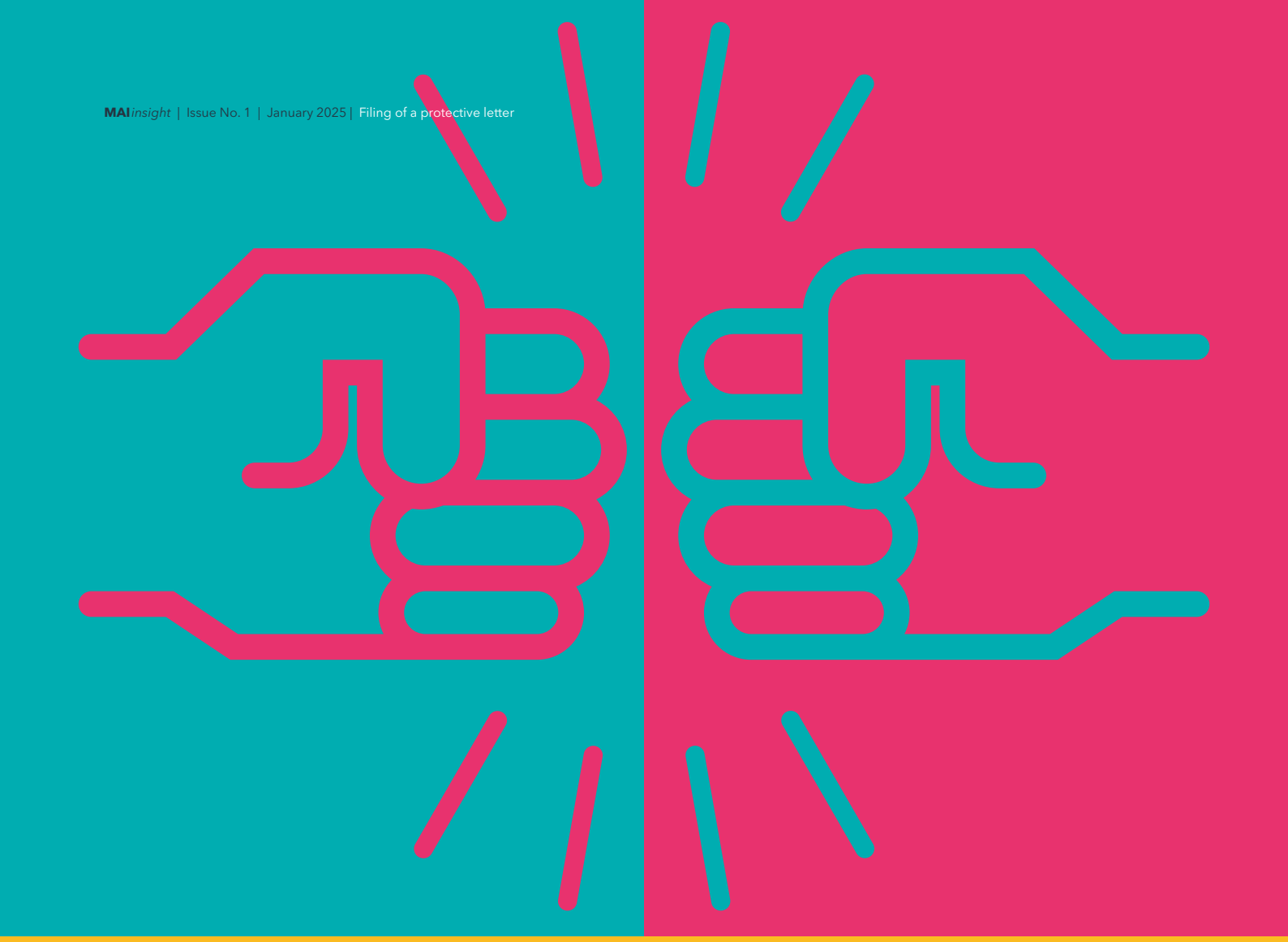


Filing of a protective letter before German Courts and before the Unified Patent Court

An effective and established procedural tool in comparison

Introduction

Filing a protective letter can be a very effective strategic tool when anti-cipating a provisional injunction (PI) based on alleged patent infringement. In Germany, a protective letter (›Schutzschrift‹) is a precautionary measure that allows a would-be infringer to proactively present their non-infringement and/or invalidity arguments to the court in anticipation of an ex parte injunction being sought by the patent owner. This mechanism is also recognized in the framework of the Unified Patent Court (UPC), albeit with some procedural differences.

Germany

For Germany, a protective letter allowing the alleged infringer (defendant) to present detailed counter arguments against potential claims is regulated in Sec. 945a German Code of Civil Procedure. Filing a protective letter is typically more cost effective than challenging an injunction after it has been granted (the current filing fee is € 83, and the legal cost of drafting the letter depends on the complexity of the case, but typically amounts to a few thousand euros). Germany's centralized registry (›Schutz-schriftenregister‹) ensures that the letter is accessible to

all relevant courts, which is particularly useful in patent disputes where multiple courts may have jurisdiction. A German protective letter is effective immediately; a receipt confirmation is usually issued within 20 to 30 minutes after filing, and the invoice for the filing fee is issued shortly afterwards.

German protective letters must be written in the German language, in accordance with the language requirements of the local courts. It is possible to withdraw the protective letter and to re-file an updated version of the protective letter, allowing for adjustments to reflect new developments. However, the validity of a protective letter is limited to six months, so it must be re-filed to extend its duration.

UPC

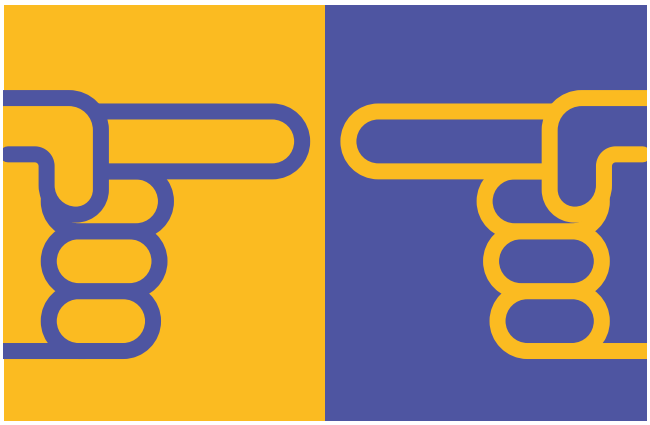
The UPC allows for the filing of protective letters designed to harmonize practices across member states (Rule 207 Rules of Procedures). A protective letter before the UPC provides broad jurisdictional coverage, making it a comprehensive defense strategy for pan-European disputes.

The language of the patent determines the language of the protective letter, ensuring its relevance in all jurisdictions. The filing costs are higher than in Germany (€ 200), but the protective letter covers a broader territory, making it a practical choice for cross-border disputes.

As protective letters are often prepared and filed under time-pressure, it should be noted that the effective date of the protective letter is confirmed only after a formal examination by the clerks of the UPC has been completed, which in the experience of the author may take a few days, and which also only starts once the UPC has received payment of the filing fees, which should therefore be transferred as soon as possible. This is different to the filing of a protective letter in Germany, as detailed above.

The validity of a protective letter before the UPC is also limited to six months, but it can also be extended by filing an extension request (€ 100). However, unlike in Germany, it is not possible to withdraw and re-file an updated version of the letter before the UPC. This means that the initial drafting must be particularly comprehensive and carefully considered. While it is possible to file another protective letter for the same patent, it is currently unclear how the UPC will deal with multiple parallel protective letters with different content.

Despite the benefits of filing a protective letter before the UPC, a few uncertainties remain. The UPC's procedural framework is still evolving, and parties may encounter difficulties in navigating its requirements. Moreover, as the UPC is a relatively new court, the long-term effectiveness of protective letters in influencing court decisions remains uncertain.



Strategic considerations

The decision to file a protective letter involves a nuanced balancing of advantages and potential disadvantages, alongside a careful evaluation of strategic and jurisdictional factors. On the one hand, a protective letter allows the defendant to proactively shape the legal and factual framework of the case, ensuring that the court does not rely solely on the patent owner's arguments. By framing the issues in a favorable manner, the defendant can reduce the risk of an ex parte injunction being granted. On the other hand, such submissions may inadvertently reveal defense strategies and provide an opportunity for the patent owner to refine their arguments or address potential weaknesses.

Timing is critical, and the letter should be filed as soon as the risk of a potential ex parte injunction request becomes apparent, such as upon receipt of a formal warning letter from the patent owner.

The content of the protective letter should comprehensively address the issues at stake: These may include the absence of infringement, procedural irregularities, and grounds for invalidity of the patent at issue. A thorough jurisdictional analysis is equally important, particularly in cases involving European bundle patents that may fall under the jurisdictions of both national courts and the UPC.

A key difference between filing a protective letter in Germany and before the UPC is the approach to examining attacks against the validity of the patent in dispute, due to the bifurcated system in Germany. In Germany, the requirements for assessing the validity of the patent vary from court to court. For example, the Higher Regional Courts in Düsseldorf, Karlsruhe and Munich usually require that the patent in question has already survived at least one validity proceeding, such as an opposition or nullity action. The Munich Regional Court, on the other hand, does not consider a prior validity assessment necessary and only seriously considers invalidity arguments in a protective letter if an invalidity action is already pending. While the ECJ's decision in Case C-44/21 of 28 April 2022 criticizes, in line with the view of the Munich Regional Court, the requirement in German case law that patents must have

survived first-instance validity proceeding for a preliminary injunction to be issued, this does not, in the author's view, require any changes to the established principles of the Higher Regional Courts. The ECJ's interpretation does not relieve German courts of the need to examine the prospects of success of invalidity attacks in each individual case, especially where the validity of the patent is not evident. In contrast to these different standards in Germany, the UPC does not impose a direct link between the initiation of invalidity proceedings and the assessment of invalidity attacks. Instead, it takes a holistic approach, weighing the likelihood of success of an opposition against both the interests of the patent owner and the potential risks of an unjustified preliminary injunction. As a result, protective letters filed before the UPC must not only address specific objections, but must also be strategically aligned with the UPC's uniform standards, which differ from the divergent approaches taken by German courts.

In cases the patent owner has opted out of the UPC framework, a dual approach may be advisable, meaning filing of protective letters before German courts and before the UPC. As long as no national infringement or invalidity proceedings are pending (and had been initiated after the start of the UPC, see the corresponding article in this issue), there remains the possibility that the patent owner may, for strategic reasons, declare a withdrawal of the opt-out (›opt-in‹) and subsequently file an application for a PI before the UPC. Such a scenario underlines the importance of a coordinated defense strategy to mitigate procedural risks.

Confidentiality concerns are another significant factor. While filing of a protective letter may provide an early opportunity to present a substantive defense, sharing the defensive argument could be strategically dis-advantageous. In fact, it is – at least theoretically – possible for a third party to request access to the case file, which means that statements made in a protective letter could come to the attention of third parties. While the UPC framework leaves room for such access, the situation in Germany is fundamentally different. In Germany, the protective letter is only made available to the patent owner, and only if the patent owner has actually filed an application for a PI. Access by third parties is therefore categorically excluded in German proceedings, providing an additional layer of confidentiality for the contents of the protective letter. Therefore, the decision to file protective letters, and in which jurisdictions, should be carefully considered in light of the specific circumstances of the case.

Lastly, the potential recovery of reasonable costs for the preparation and filing of a protective letter adds a practical incentive. Both German and UPC frameworks allow cost recovery if a PI application is ultimately rejected by the court.

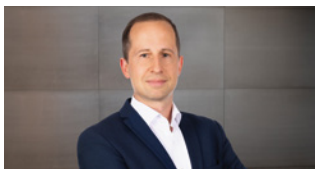
Such cost recovery mechanisms may provide additional justification for filing a well-prepared protective letter, which can serve not only as a procedural safeguard but also as a cost-effective defense tool.

In summary, while protective letters offer significant strategic advantages, their use must be carefully tailored to the specific circumstances of each case. A well-calibrated approach, taking into account timing, content, jurisdiction, confidentiality and cost recovery, can maximize their benefits while mitigating the associated risks.

Conclusion

Filing a protective letter can be a powerful tool to protect a party's interests in would-be patent litigation, in Germany and before the UPC. However, it requires a sophisticated understanding of procedural nuances, strategic implications, and potential risks. When used effectively, a protective letter can significantly influence the outcome of PI proceedings and mitigate the risk of unfavorable preliminary rulings.

On the issue of ex parte PIs, the general takeaway is the need to file or at least to be prepared to swiftly file a detailed protective letter including the alleged infringer's best arguments on both validity and non-infringement. While the existence of such a protective letter may be crucial to the court's consideration of whether the defendant has been sufficiently heard, in most cases, however, parties are well advised to file a detailed protective letter including all aspects of their potential defense.



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