

ANLAGE 3

LEITSÄTZE der ENTSCHEIDUNGEN
des Jahres 2009 und 2010, die in
der Sonderausgabe besprochen
wurden¹

ANNEX 3

HEADNOTES to DECISIONS
delivered in 2009 and 2010 and
discussed in the Special Edition¹

ANNEXE 3

SOMMAIRES des DECISIONS des
années 2009 et 2010 qui ont été
commentées dans l'édition
spéciale¹

Case Number: G 1/07, OJ EPO 2011, ***

Applicant: Medi-Physics, Inc.

Headword: Treatment by surgery/MEDI-PHYSICS

Date: 15.02.10

Headnote:

The questions referred to the Enlarged Board of Appeal are answered as follows:

1. A claimed imaging method, in which, when carried out, maintaining the life and health of the subject is important and which comprises or encompasses an invasive step representing a substantial physical intervention on the body which requires professional medical expertise to be carried out and which entails a substantial health risk even when carried out with the required professional care and expertise, is excluded from patentability as a method for treatment of the human or animal body by surgery pursuant to Article 53(c) EPC.

2a. A claim which comprises a step encompassing an embodiment which is a "method for treatment of the human or animal body by surgery" within the meaning of Article 53(c) EPC cannot be left to encompass that embodiment.

2b. The exclusion from patentability under Article 53(c) EPC can be avoided by disclaiming the embodiment, it being understood that in order to be patentable the claim including the disclaimer must fulfil all the requirements of the EPC and, where applicable, the requirements for a disclaimer to be allowable as defined in decisions G 1/03 and G 2/03 of the Enlarged Board of Appeal.

2c. Whether or not the wording of the claim can be amended so as to omit the surgical step without offending against the EPC must be assessed on the basis of the overall circumstances of the individual case under consideration.

3. A claimed imaging method is not to be considered as being a "treatment of the human or animal body by surgery" within the meaning of Article 53(c) EPC merely because during a surgical intervention the data obtained by the use of the method immediately allow a surgeon to decide on the course of action to be taken during a surgical intervention.

Case Number: G 2/08, OJ EPO 2010, 456

Applicant: Abbott Respiratory LLC

Headword: Dosage regime/ABBOTT RESPIRATORY

Date: 19.02.10

Headnote:

The questions referred to the Enlarged Board of Appeal are answered as follows:

Question 1: Where it is already known to use a medicament to treat an illness, Article 54(5) EPC does not exclude that this medicament be patented for use in a different treatment by therapy of the same illness.

Question 2: Such patenting is also not excluded where a dosage regime is the only feature claimed which is not comprised in the state of the art.

Question 3: Where the subject matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so-called Swiss-type claim as instituted by decision G 5/83.

A time limit of three months after publication of the present decision in the Official Journal of the European Patent Office is set in order that future applicants comply with this new situation.

¹ Diese Leitsätze erscheinen in der Anlage 3 nur in der Verfahrenssprache.

¹ These headnotes are published in Annex 3 in the language of the proceedings only.

¹ Ces sommaires ne sont publiés dans l'Annexe 3 que dans la langue de procédure.

Case Number: G 3/08, OJ EPO 2011, ***

Headword: Programs for computers

Date: 12.05.10

Headnote:

1. In exercising his or her right of referral a President of the EPO is entitled to make full use of the discretion granted by Article 112(1)(b) EPC, even if his or her appreciation of the need for a referral has changed after a relatively short time.
2. Different decisions by a single technical board of appeal in differing compositions may be the basis of an admissible referral by the President of the EPO of a point of law to the Enlarged Board of Appeal pursuant to Article 112(1)(b) EPC.
3. As the wording of Article 112(1)(b) EPC is not clear with respect to the meaning of "different/abweichende/divergent" decisions the provision has to be interpreted in the light of its object and purpose according to Article 31 of the Vienna Convention on the Law of Treaties (VCLT). The purpose of the referral right under Article 112(1)(b) EPC is to establish uniformity of law within the European patent system. Having regard to this purpose of the presidential right to refer legal questions to the Enlarged Board of Appeal the notion "different decisions" has to be understood restrictively in the sense of "conflicting decisions".
4. The notion of legal development is an additional factor which must be carefully considered when interpreting the notion of "different decision" in Article 112(1)(b) EPC. Development of the law is an essential aspect of its application, whatever method of interpretation is applied, and is therefore inherent in all judicial activity. Consequently, legal development as such cannot on its own form the basis for a referral, only because case law in new legal and/or technical fields does not always develop in linear fashion, and earlier approaches may be abandoned or modified.
5. Legal rulings are characterised not by their verdicts, but by their grounds. The Enlarged Board of Appeal may thus take obiter dicta into account in examining whether two decisions satisfy the requirements of Article 112(1)(b) EPC.
6. T 424/03, Microsoft does deviate from a view expressed in T 1173/97, IBM, concerning whether a claim to a program on a computer-readable medium necessarily avoids exclusion from patentability under Article 52(2) EPC. However this is a legitimate development of the case law and there is no divergence which would make the referral of this point to the Enlarged Board of Appeal by the President admissible.
7. The Enlarged Board of Appeal cannot identify any other inconsistencies between the grounds of the decisions which the referral by the President alleges are divergent. The referral is therefore inadmissible under Article 112(1)(b) EPC.

N° de la décision : G 4/08, JO OEB 2010, ***

Requérant : Merial

Référence : Langue de la procédure/MERIAL

Date : 16.02.10

Sommaire :

La Grande Chambre de recours, en réponse aux trois questions de droit qui lui ont été soumises, conclut que :

Question 1 : Lorsqu'une demande internationale de brevet a été déposée et publiée en vertu du PCT dans une langue officielle de l'OEB, il n'est pas possible, lors de l'entrée en phase européenne de déposer une traduction de la demande dans l'une des deux autres langues.

Question 2 : Les organes de l'OEB ne peuvent utiliser dans la procédure écrite d'une demande européenne de brevet ou d'une demande internationale en phase régionale une des langues officielles de l'OEB autre que celle de la procédure utilisée pour la demande en application de l'article 14(3) CBE.

Question 3 : Cette question est dépourvue d'objet.

Case Number: J 2/08, OJ EPO 2010, 100

Applicant: Sony Deutschland GmbH

Headword: Pending application/SONY

Date: 27.05.09

Headnote:

The following point of law is referred to the Enlarged Board of Appeal:

Is an application which has been refused by a decision of the examining division thereafter still pending within the meaning of Rule 25 EPC 1973 (Rule 36(1) EPC) until the expiry of the time limit for filing a notice of appeal, when no appeal has been filed?

Case Number: T 1068/07, OJ EPO 2011, ***

Applicant: The Scripps Research Institute

Headword: Enzymatic DNA/SCRIPPS

Date: 25.06.10

Headnote:

Question referred to the Enlarged Board of Appeal:

Does a disclaimer infringe Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed?