Admissibility of late inventive step attacks at the EPO

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Two decisions T 0184/17 and T 0603/14 were recently issued concerning admissibility of late inventive step attacks on appeal. Both cases were decided under the old Rules of Procedure of the Boards of Appeal (RPBA), but will likely still be relevant under the increased procedural stringency of the new RPBA.

T 0184/17 – A Tea Decision – Coffee Grounds Not Fresh

This case relates to a process for preparing a beverage from tea leaves. The prior art has the claimed process features, but refers specifically to coffee rather than tea.

The Board of Appeal disagreed with the first instance decision of lack of novelty, and so the opponent switched to arguing lack of inventive step. The proprietor argued that this was an inadmissible fresh ground of opposition.

As noted in the decision, it was held in G7/95 that novelty and inventive step are different grounds of opposition, and held in G10/91 that fresh grounds for opposition may in principle not be introduced at the appeal stage, unless agreed by the patentee. On the other hand, it was noted in G1/95 that subject-matter found to lack novelty would inevitably be unallowable on the ground of inventive step, and in T 131/01 that substantiation of lack of inventive step is not generally possible after substantiating lack of novelty.

For the present case, the Board noted that the inventive step argument was based on the same factual and evidentiary framework (same cited passages and teachings) as for the previous novelty arguments, and that an opponent cannot discuss both novelty and inventive step based on the same facts, without self-contradiction.

In this limited circumstance, the Board decided that the inventive step argument was not a fresh ground of opposition, and could be admitted without consulting the patentee.

As a minor further point, the Board decided that the formal absence of a tick for inventive step on the opposition form is not decisive.

T 0603/14 – Cables insulated against inventive step attack

This was a more classical situation for a late filed inventive step attack, against a patent regarding cable insulation. The opponent raised a new attack in the appeal oral proceedings, using a new closest prior art that was previously used for novelty.

The opponent argued that the new inventive step attack was a reaction to the Board's preliminary opinion, which was positive on novelty. The opponent further argued that inventive step attacks based on a document previously used only for novelty should not come as a surprise to the patentee.

Despite the parallels to the above case where the attack was admitted, the Board used their discretion under Article 13(1) RPBA to refuse to admit the new attack because:

1. There were no new points in their preliminary opinion which could be identified to trigger the opponent's reaction.
2. The attack was not raised at the earliest possible opportunity (i.e. in writing before the hearing). Instead, the new attack was presented late in the oral proceedings.
3. It would be unreasonable to consider a new combination of documents in the hearing, without giving the proprietor time to consider a response, and therefore the new attack could not be considered without compromising procedural efficiency. The proprietor cannot be expected to anticipate arbitrary combinations of the documents on file.

Applicability of the decisions

In T 0184/17, the Board stressed in the decision that this outcome was based on a narrow set of circumstances where the inventive step attack was based on substantially the same factual and evidentiary framework as the novelty attack, implying that the decision is unlikely to be widely applicable.

T 0603/14 highlights the fact that, although new stricter Rules of Procedure have been introduced for the Boards of Appeal, the existing case-law based rules for admissibility of new arguments were already strict, limiting the extent of the change.

Nevertheless, there are some opposition practice points to take away from these cases:

1. As an opponent, formally raise inventive step wherever novelty is raised, so that you are less likely to be confined to novelty later in procedure.
2. As a patentee, "procedural efficiency" is an effective mantra on appeal for warding off new attacks, regardless of their substantive merit.
3. Either way, react early in appeal procedure, to maximise the chance that new arguments are admitted. Making new arguments just before, or even during, the hearing may be too late.