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Step by Step towards Inventive Step – Determining the Closest Prior Art comes first (R 5/13 et al.)

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In the oral proceedings held in the EPO appeal case **T 1760/11** the Board of Appeal (BoA) 3.3.01 selected one single closest prior art (CPA) document for the inventive step assessment and then denied the opponents the opportunity to present inventive step attacks starting from other CPAs. Petitions for review under Article 112a EPC were filed. The BoA's denial did not constitute a violation of the right to be heard, said the Enlarged Board of Appeal (EBA) in the decisions **R 5/13** and (identical) **R 9/13** to **R13/13**.

The underlying Case of T 1760/11

The issue under discussion was the assessment of inventive step. The Opposition Division had earlier revoked the patent *inter alia* for lack of inventive step starting from **D1** as the CPA. During the written appeal proceedings, the opponents maintained their choice of **D1** as the CPA while the patent proprietor considered **D2** or **D11** to be the CPA.

During the oral proceedings, after having rejected proprietor's main request, the BoA selected **D2** as the CPA for the assessment of the inventive step of the first auxiliary request. Starting from **D2** the debate followed the commonly applied problem solution approach (PSA), the BoA concluding that the claims under discussion were based on an inventive step. The opponents' request to then also discuss the inventive step based on **D1** or **D11** as alternative CPA was refused by the BoA, and the patent was consequently maintained in amended form.

Also, a request for referral to the EBA was rejected by the BoA. This also formed part of the petitions for review, but will not be dealt with any further here.

The Petitions for Review

Several of the opponents ("petitioners") filed a petition under Article 112a EPC, alleging *inter alia* that the conduct of the appeal proceedings involved a fundamental infringement of the petitioners' right to be heard (Articles 112a(2)(c) and 113(1) EPC). In their view, the BoA took its decision without allowing them to complete their submissions on inventive step, and particularly with respect to **D1** as an alternative CPA. In support of their petitions, essentially three lines of argument were submitted:

- 1) The CPA could only be determined at the end of a complete discussion of the inventive step and

thus the selection of the CPA should have been open for discussion during all stages of the PSA.

2) The BoA failed to inform the parties of their intention to select **D2** as the (only) CPA, so that the BoA's choice came as a surprise and there was no time to react appropriately.

3) In any case, D1 should have been considered as an alternative realistic starting point (CPA) for the discussion of the inventive step.

The EBA's Decision and Reasoning

With respect to the three lines of argument outlined above the EBA's considerations were as follows.

1) In their decision, the EBA confirmed the PSA as the key element for the assessment of inventive step at the European Patent Office. The PSA includes three main stages of (i) determining the CPA, (ii) establishing an *objective technical problem* to be solved by the claimed invention, and (iii) considering whether the claimed invention, starting from the CPA and in view of the objective technical problem, was obvious to the skilled person. The EBA outlined that, as a matter of logic, these steps are generally carried out in this order since the CPA is the starting point for the assessment of inventive step and the two further steps can only be carried out on the basis of this CPA. For the case at stake, the EBA confirmed that in their view the BoA properly followed this procedure.

As regards the selection of **D2** as the (only) CPA for use in steps (ii) and (iii) of the PSA, the EBA noted that the correct application of the PSA as a well-established multi-step procedure for assessing the inventive step of a patent claim is a matter of substantive law. This also applies with respect to the first step thereof, i.e. the determination of the CPA and irrespective of whether one single document or a plurality of documents is taken as the starting point. Further, the EBA pointed to the fact that review proceedings under Article 112a EPC are confined to procedural defects, while a technical review is outside the jurisdiction of the EBA. Thus, a potentially incorrect determination of the CPA, as concerning substantial matter, is not open to a petition for review under Article 112a EPC.

In addition, the EBA explicitly disagreed with the petitioners' position that the determination of the CPA can be concluded only after the subsequent steps (ii) and (iii) had been gone through, and thus should have been open for discussion during all stages of the PSA. In the EBA's view this is not only excluded by the internal logic of the PSA (see above) but also would contravene the principle of procedural economy.

According to this principle the BoA is obliged to focus on those points that are relevant for the decision. In the EBA's view, this includes a stage-by-stage application of the PSA for assessing the inventive step and justifies the restriction of the discussion in steps (ii) and (iii) to the case arising in view of this selected CPA. As this, at least in the EBA's view, has been properly followed by the BoA, no breach of procedural law occurred.

2) With respect to the alleged failure of the BoA to inform the parties of their intention to select **D2** as the (only) CPA, the EBA also disagreed. In their view the communication annexed to the summons already included a hint that **D2** would have to be considered when determining the CPA. Also, the discussion of this issue during the hearing was started on one day and continued on the next day. Thus, the EBA found that the parties had been informed and that there was sufficient

time for them to react appropriately.

3) Finally, the EBA could also not see a procedural defect in the BoA's refusal to consider **D1** (and possibly **D11**) as alternative realistic starting point (CPA) for the discussion of the inventive step. In their view, the BoA exhaustively discussed this issue with the parties, and provided its reasons for not allowing multiple CPAs in that specific case. Thus, the petitioners' arguments have been noted and considered, and therefore the right to be heard (Article 113(1) EPC) has been obeyed.

Conclusion and Message to take Home

According to the EBA, it is in line with the EPC (in particular Art. 113(1) EPC) if, once the parties have been heard on the subject of determining the CPA and a decision has been taken on the choice of the CPA, alternative PSAs starting from different documents are excluded. However, this in our view does not mean that an assessment of the inventive step starting from different CPAs in multiple PSAs will be excluded in the future. That this is possible has been established in **T 21/08** referred to by the petitioners. The EBA did not question the principles outlined in this decision. Also, the EBA explicitly referred to the possibility of determining a plurality of documents as alternative starting point, see point 13 of the Reasons for the Decision.

What the EBA decided is that the CPA is not to be determined on the basis of considerations of other stages of the PSA (see e.g. point 17 of the Reasons) but rather in advance of the steps (ii) and (iii) of the PSA. Once the CPA, i.e. the one or more feasible starting point(s), has been determined, subsequent discussion of inventive step on the basis of other starting points would not be in line with a systematic application of the PSA.

For the users of the EP patent system, the decisions **R 5/13** and **R 9/13** to **R 13/13** underline that the PSA is the main and foremost method of assessing inventive step. Further, it is confirmed by the EBA that the three general stages of the PSA are to be carried out one after another (*step-by-step*).

Thus, if one wishes to assess inventive step starting from more than one document as the CPA, this should clearly and expressly be submitted at an early stage of the discussion of the inventive step, and reasons should be given why those multiple starting points are each reasonable starting points for further development. Without such reasoning, following the present decisions, it would be relatively easy for an opposition division or a BoA to reject such a submission under considerations of procedural economy without running into a risk of committing a breach of the right to be heard according to Article 113(1) EPC.

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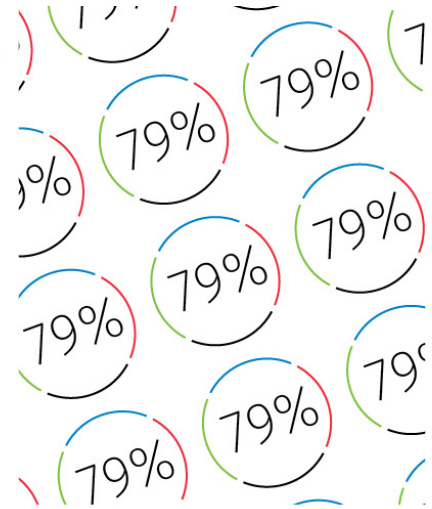
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