

ANLAGE 3

LEIT- UND ORIENTIERUNGS-SÄTZE¹ der veröffentlichten (bzw. zur Veröffentlichung vorgesehenen) **ENTSCHEIDUNGEN** des Jahres 2016; Vorlageentscheidungen finden sich in Anlage 4

ANNEX 3

HEADNOTES/CATCHWORDS¹ to 2016 **DECISIONS** which have been (or will be) published; please see Annex 4 for referrals

ANNEXE 3

SOMMAIRES/EXERGUES¹ des **DÉCISIONS** de l'année 2016 publiées (ou dont la publication est prévue) ; les décisions de saisine se trouvent dans l'annexe 4

Case Number: G 1/15
Date: 29 November 2016
Patent proprietor/Appellant: Infineum USA L.P.
Opponent/Respondent: Clariant Produkte (Deutschland) GmbH
Catchword:

Under the EPC, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic "OR" claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect.

Case Number: T 577/11 – 3.2.05
Date: 14 April 2016
Patent Proprietor/Appellant: Tenaris Connections Ltd
Respondent/Opponent: Vallourec Oil and Gas France

Catchword:

1. Continuation of the appeal proceedings after first oral proceedings before the board with the scheduling of second oral proceedings is not, as such, a reason for admitting new submissions filed after the first oral proceedings (see Reasons, point 2.3).

2. If the debate on a particular topic had been closed without announcement of a decision on the matter, the board has discretion over whether or not it re-opens the debate and over the extent to which it does so (see Reasons, point 3.1).

3. For a claimed priority to be valid pursuant to Article 87(1) EPC 1973, the applicant of a subsequent application claiming priority from an earlier application (priority application) who is not the person who filed the priority application must, when the subsequent application is filed, be that person's successor in title in respect of the priority application or of the right to claim priority. A succession in title that occurs after the filing date of the subsequent application is not sufficient to comply with the requirements of Article 87(1) EPC 1973 (see Reasons, point 6.5).

4. Where the applicant of the priority application and the applicant of the subsequent application contractually agree that (only) economic ownership ("*economische eigendom*" under Dutch law) of the priority application and the right to claim its priority is to be transferred to the subsequent applicant, this is not sufficient to consider the latter a successor in title within the meaning of Article 87(1) EPC 1973 (see Reasons, point 6.6.2).

Case Number: T 437/14 – 3.3.09
Date: 17 October 2016
Patent proprietor 1/Appellant: The Trustees of Princeton University
Patent proprietor 2/Appellant: The University of Southern California
Opponent 1/Appellant: Merck Patent GmbH
Opponent 3/Appellant: BASF SE

Catchword:

The following questions are referred to the Enlarged Board of Appeal for decision:

1. Is the standard referred to in G 2/10 for the allowability of disclosed disclaimers under Article 123(2) EPC, i.e. whether the skilled person would, using common general knowledge, regard the subject-matter remaining in the claim after the introduction

¹ Diese Leit- und Orientierungssätze erscheinen in der Anlage 3 nur in der Verfahrenssprache.

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

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

of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed, also to be applied to claims containing undisclosed disclaimers?

2. If the answer to the first question is yes, is G 1/03 set aside as regards the exceptions relating to undisclosed disclaimers defined in its answer 2.1?

3. If the answer to the second question is no, i.e. if the exceptions relating to undisclosed disclaimers defined in answer 2.1 of G 1/03 apply in addition to the standard referred to in G 2/10, may this standard be modified in view of these exceptions?

Case Number: T 1691/15 – 3.2.07, OJ 2017, A15

Date: 27 July 2016

Patent proprietor/Respondent: Nestec S.A.

Opponent/Appellant: Franssen, Guy Jacques

Catchword:

Exchanges between an opponent and the EPO which have a substantive and/or procedural bearing on the case in opposition proceedings, even if dealt with by the Directorate Quality Support in the context of a complaint handling system, should be communicated without delay to the other party/parties, as any other submission of a party or communication of the EPO in opposition proceedings. Such an exchange with a substantive and/or procedural bearing on the case should figure, by definition, in the public part of the file (see reasons, point 3).