Evidence in EPO Proceedings

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## General Principles

- Who carries the burden of proof during prosecution?
- Who bears the burden during opposition?
- Exceptions
- Who bears the burden during appeal?
- Summary
Context in which this arises
• Is a document prior art?
• Is a prior art disclosure inherently novelty-destroying?
• Is a given technical difference associated with a technical effect?
• Is a public prior use proven?
• And many more...
Relevant EPC provisions???
Art. 117 Means and taking of evidence

In proceedings before the European Patent Office the means of giving or obtaining evidence shall include the following:
(a) hearing the parties;
(b) requests for information;
(c) production of documents;
(d) hearing witnesses;
(e) opinions by experts;
(f) inspection;
(g) sworn statements in writing.
Questions:

• What level of proof is needed?
• Who has the burden of proof?
Article 125 Reference to general principles

In the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of procedural law generally recognised in the Contracting States.
Continental European Law:

• (full) conviction of the judge.

“...personal conviction [...] in doubtful cases, the judge may and must be content with a degree of certainty useful for practical life that silences doubt without completely excluding it.” (German Bundesgerichtshof; BGH NJW 1970, 946)

“a court must be convinced of the truth of a factual allegation based on objective grounds. Absolute certainty is not required. It is sufficient if the court has no serious doubt or any remaining doubt appears insubstantial.” (Swiss Bundesgericht; BGE 130 III 321 sect. 3.2).
Common law:

• Balance of probabilities („preponderance of the evidence“) for civil cases
• Proof beyond reasonable doubt in criminal cases
• (US: further intermediate standard of proof known as “clear and convincing evidence”, which is applicable in certain civil cases)
What does balance of probabilities mean?

„If the evidence is such that the tribunal can say ‘we think it more probable than not’ then the burden is discharged, but if the probabilities are equal it is not.”

*(Miller vs. Minister of Pensions, 3 All ER 372 (1947), 373 sq.)*
What does balance of probabilities mean?

"The balance of probability standard means that a court is satisfied an event occurred if the court considers that, on the evidence, the occurrence of the event was more likely than not. When assessing the probabilities the court will have in mind as a factor (...) that the more serious the allegation the less likely it is that the event occurred and, hence, the stronger should be the evidence before the court concludes that the allegation is established on the balance of probability. Fraud is usually less likely than negligence. Deliberate physical injury is usually less likely than accidental physical injury. ... The more improbable the event, the stronger must be the evidence that it did occur before, on the balance of probability, its occurrence will be established."

Lord Nicholls in a family case
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Lunes de patentes, November 14, 2016
G IV.12-7.5.3

It is a general principle that, when raising objections, the burden of proof lies initially with the examiner. This means that objections must be reasoned and substantiated, and must show that, on the balance of probabilities, the objection is well-founded. If this is done, it is then up to the applicant to prove otherwise - the burden of proof shifts to the applicant.
According to this standard, it is not sufficient that the alleged fact (e.g. the publication date) is merely probable; the examining division must be convinced that it is correct. It does mean, however, that proof beyond reasonable doubt ("up to the hilt") of the alleged fact is not required.
T 578/06 – First instance

• Invention: Somatostatin (S) to prolong life of transplanted pancreatic islet cells

• Data available: *in vitro* data showing that S has effect on insulin production

• Examining Division: need comparative data on cell survival with and without S to prove the effect

• Refusal due to lack of inventive step: applicant had burden to show effect once the objection of lack of plausibility had been raised
Who bears the burden during prosecution?

T 578/06 – Appeal

• First instance decision wrong
• The ED never provided any substantiated reasoning as to why they thought the invention would not work
• Applicant only has burden of proof if there are substantiated doubts
T 578/06 – Appeal

14. The boards of appeal have indeed dealt with cases where, in the context of the assessment of inventive step, there could only be an invention if the application made it at least **plausible** that its teaching did indeed solve the problem it purported to solve and in which to establish plausibility the disclosure of experimental results in a patent application, or, under certain circumstances, by post-published evidence, was considered necessary (see decision T 716/08 of 19 August 2010, points 14 to 16 for a summary of the case law).

15. The board re-emphasizes in this context however that this case law considers the **establishment of plausibility only relevant** when examining inventive step if the case at hand allows the **substantiation of doubts** about the suitability of the claimed invention to solve the technical problem addressed and when it is thus far from straightforward that the claimed invention solves the formulated problem.
T 19/90– First instance

- Invention: transgenic mammal having an increased probability of developing neoplasms
- Data available: only for mice
- Examining Division: unlikely that the same genetic manipulation could be successfully performed on other mammals without inventive skill
- Refusal due to lack of sufficient disclosure: claim not reproducible over entire claim scope
T 19/90 – Appeal

• Unsuitability of unspecified variants immaterial as long as suitable variants known
• Evidence that invention works with at least one other mammal
• The Board is not “itself aware of any verifiable facts which could cast serious doubts on the possibility for a skilled person to carry out the invention as claimed”.
T 1616/09– First instance
• Invention: DNA methylation inhibitor & anti-neoplastic agent for cancer treatment
• Description: improved (synergistic) effect
• Examining Division: no data to show improved effect
• Refusal due to lack of sufficient disclosure
Who bears the burden during prosecution?

T 1616/09 – Appeal

• Anti-neoplastic agents are, by definition, used to treat cancer.
• No reasons, based on verifiable facts, to believe that DNA methylation inhibitor would interfere in a negative way
• Improved (synergistic) effect not in the claims and thus is relevant only for inventive step.
• Sufficiency of disclosure fulfilled; remittal to first instance.
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Who bears the burden during opposition?

• Opponent bears burden of proof to show that a ground of revocation is justified
  • For inventive step – need a problem-solution analysis which makes it more likely than not that the skilled person would have reached invention in an obvious way

• Each party bears the burden of proof for facts in his favour
  • Factual matters not directly related to patentability
  • And also some facts which can play an important role in patentability analysis
Who bears the burden during opposition?

Example: T 1056/01 – the any-way-up cup
Who bears the burden during opposition?

T 1056/01 - Opponent

• D1 published in the priority year
• No priority as the prio doc was not the first application
• An earlier application existed and was withdrawn
• UKIPO published withdrawal in their journal on 13 May
• Therefore, the earlier application was (likely) still pending at the UKIPO at the time the priority application was filed (7 April)
T 1056/01 - Patentee

• UKIPO date of publication of withdrawal was not the same as the date of withdrawal
• UKIPO did not record or publish the actual date of withdrawal
• The Opponent had not proven that the first application was still pending on 7 April
• As this was part of Opponent’s novelty attack, Opponent had the burden of proof
• If doubt exists, Patentee should get the benefit of doubt
Who bears the burden during opposition?

T 1056/01 – Board

• Date of withdrawal is a fact in patentee’s favour
• Patentee has the burden of proof for such facts
• Possibility that it was withdrawn in time not enough to save priority
• Priority not acknowledged
Who bears the burden during opposition?

Technical Effects – *Situation 1*

• An advantage is mentioned and supported by evidence
• Is it plausible that the effect is achieved?
• Critical evaluation on balance of probability
• If plausible, the advantage can be relied on
• Then the Opponent has the burden of proof
Who bears the burden during opposition?

Technical Effects – *Situation 2*

- No data in the patent, but an advantage is mentioned
- Is it plausible that this is achieved?
  - In chemistry and life sciences, usually not
- If not, then advantage cannot be relied on
- Then Opponent does not have to submit evidence that the alleged advantage is not found
- See e.g. T 355/97 and T 90/11
Technical Effects – *Situation 3 – T1797/09*

Solution of the problem addressed in the patent, but no data to support corresponding effect

*A technical problem set out in a patent is considered to be credibly solved by a claimed invention if there exist no reasons to assume the contrary. In such circumstances, it is normally the Opponent's burden to prove the opposite or at least provide evidence casting doubt on the alleged solution of the problem. If no such evidence is provided, the benefit of doubt is given to the Patent Proprietor. However, if the Opponent succeeds to cast reasonable doubt on the alleged effect, the burden to prove its allegations is shifted to the Patent Proprietor.*
Technical Effects – Situation 4

T 596/99– First instance

• Problem: improving the low temperature impact strength of toughened PET compositions known from D1

• Patentee’s evidence (in patent & filed during examination) convinced Examining Division that problem is solved

• Opponent: Patentee’s evidence insufficient

• Opposition Division: patent revoked for lack of inventive step
Technical Effects – Situation 4
T 596/99– Appeal

In the present case the Appellant therefore rightly stressed that, even if the Respondent/Opponent had been successful in its efforts to cast serious doubts on the persuasiveness of Appellant’s evidence, this would not justify the conclusion that the invention failed to solve the existing technical problem, but only that the evidence was inappropriate. For the Respondent to actually prove that the subject-matter of Claim 1 was unable to solve said problem it would have necessary to submit convincing counter-evidence.
Technical Effects

• At the point where a decision is made, the totality of the evidence is evaluated.
• The OD then decides if it is plausible that there is an effect.
  • Over the whole scope (T 939/92)
• Quality of evidence can play a role.
Public prior use – T55/01

• Key question: TV produced at least 4 months before priority date publically available?

• Board: “highly implausible that such goods, whilst being mass-produced, accumulate in some hidden location”.

• Applying the standard of balance of probabilities, TVs deemed to have been publically available.
Company paper– T597/07

• Priority date 13.9.1994
• Product information D1 (Cetiol HE) of company H with printing date 08/1992
• H had patent application PA claiming a formulation with filing date 20.9.1993
• D1 would be novelty destroying if D1 publically available prior to 20.9.1993
• Board: This fact renders it more unlikely than not that D1 was NOT publically available
Who bears the burden during opposition?

Also note T750/94:

...the more serious the issue, the more convincing must the evidence be to support it!
General principles

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Two exceptions:

• Different standard of proof
• Reversal of burden of proof
Who bears the burden during opposition?

Exception 1: higher standard of proof

If all the evidence in support of the invoked prior use lays within the power and knowledge of the opponent invoking it, e.g. in case prior use is opponent’s own prior use

‟up to the hilt‟
Exception 1: higher standard of proof

T 106/11

• Prior art revealed formulation with Cetiol HE
• Cetiol HE was not opponent‘s product
• Opponent submitted evidence on chemical formulation of Cetiol HE, supporting their case of lack of novelty
• What is the right standard: balance of probabilities or „up to the hilt“?
Exception 1: higher standard of proof

T 106/11

• Board: The right standard is „up to the hilt“ because
  • Opponent had relied on manufacturer of Cetiol HE for providing missing information, without carrying out itself any independent analysis of the commercial products available
  • If composition as submitted by Opponent were to be acknowledged as the true composition of Cetiol HE, this would lead with a strong likelihood to the revocation of the patent
Exception 2: reversal of burden of proof

T 131/03

• Claim defined pigment particles by their geometry
• Data submitted by opponent establish a strong presumption that geometry is inherently disclosed in document E5.

„In the face of such strong presumption, the appellant – who incidentally had freely chosen to define the invention by way of unusual parameters – could not simply claim the benefit of doubt: the burden of proving that the product obtained from the teaching of E5 did not exhibit the claimed parameters had actually switched to his side and it was his duty to provide convincing evidence in support of this allegation.“
Exception 2: reversal of burden of proof
T 63/08

• Claim defined method for ignition in a combustion engine wherein flame kernels having a size of 1 mm or more is generated.
• No data in patent

„When the patent does not give any information of how a feature of the invention can be put into practice, only a weak presumption exists that the invention is sufficiently disclosed. In such case, the opponent can discharge his burden by plausibly arguing that common general knowledge would not enable the skilled person to put this feature into practice. The patent proprietor then has the burden of proof for contrary assertion that common general knowledge would indeed enable the skilled person to carry out the invention.“
### General principles

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Appeal

Appellant has the burden of proof in showing that the first instance decision was wrong

Is there a reversal of the burden of proof?

Is the Board bound by OD’s evaluation of data/technical effects?
Who bears the burden during appeal?

Appeal – T18/00

• OD revoked patent for lack of inventive step
• Board: OD’s definition of the objective technical problem wrong since it contained pointer to the solution
• Key issue: Is the problem solved over entire claim scope?
• Detailed arguments on this issue only presented at oral proceedings in appeal
Appeal – T18/00

• Burden of proof for the allegation that improvement is not achieved over entire claim scope rests on the person who has made this allegation, i.e. the opponent (T219/83; T 939/92)

• Once the OD has revoked the patent, the burden of proof shifts to the proprietor (T585/92)

• The Board had doubts and gave the parties the opportunity to submit further evidence on this point by remitting the case to the first instance
Appeal – T 385/08
• OD: claimed combination inventive in view of data proving a synergistic effect
• Board: Effect acknowledged only for a specific combination, but not over entire claim scope
• Patent revoked!

SURPRISE!
The evaluation of the strength of the evidence is essentially a subjective decision, and, as such, it comes close to decisions made as a matter of discretion (as opposed to an evaluation of the technical content of the evidence, which is a matter of fact). To overturn a discretionary decision of the Opposition Division, it is not sufficient to state that the discretion could have been exercised differently, but that it was exercised manifestly wrong.
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Who has initial burden of proof?

- In *ex parte* cases: Examiner
- For assertions: He who asserts
- For invalidity: Opponent
- For facts in your favour: You
- For technical effects: Patentee / Applicant
- On appeal: Appellant
Thank you for your attention

For any questions – JRenken@HoffmannEitle.com