



HL knowledge hub (II)
Top cited Appeal cases by technical fields

Our information resource for in-house IP counsel on case law in Opposition Appeals.

The 28 Technical Boards of Appeal that deal with opposition appeals are considered by the EPO to fall into four broad groups (see diagram) based on the technologies involved in the cases they handle:

- Mechanics
- Chemistry
- Physics
- Electricity

Of the total of 16,000 or so decided opposition appeals, about 7500 were decided by mechanics boards. These cases referenced around 6800 earlier appeal decisions – cited by one or more of the parties, the Opposition Division or the Board of Appeal. Chemistry boards have decided about 6300 opposition appeals which referenced around 13,300 earlier appeal decisions. Physics and electricity boards have decided each about 1500 opposition appeals which referenced a similar number of earlier appeal decisions¹. It seems that opposition appeals in the field of chemistry make reference or resort to “case law” significantly more often than opposition appeals in other fields.

Tables A, B, C and D (see page 2 ff) indicate the all-time top 25 cited cases referenced in opposition appeal decisions of mechanics, chemistry, physics and electricity boards. These top 25 cited cases account for around 20% of the total “case law” references in each field.

TECHNICAL BOARDS OF APPEAL



Mechanics

- 3.2.01
- 3.2.02
- 3.2.03
- 3.2.04
- 3.2.05
- 3.2.06
- 3.2.07
- 3.2.08



Chemistry / Life Sciences

- 3.3.01
- 3.3.02
- 3.3.03
- 3.3.04
- 3.3.05
- 3.3.06
- 3.3.07
- 3.3.08
- 3.3.09
- 3.3.10



Physics

- 3.4.01
- 3.4.02
- 3.4.03



Electricity / Communications / Computing

- 3.5.01
- 3.5.02
- 3.5.03
- 3.5.04
- 3.5.05
- 3.5.06
- 3.5.07

For more information or queries, please contact:

James Ward - Partner

E: jward@haseltinlake.com

Tel: +49 (0) 896 227 1760

¹Espace Legal DVD, June 2014 edition

Table A

RANK		Case	No. of times cited	MECHANICS (Boards 3.2.xx) TOP 25	
1	2	G10/91	204	Examination of oppositions/appeals/ (President of EPO)	Grounds of opposition
2	1	G9/91	179	Power to examine/ROHM & HAAS	Extent of opposition
3	8	T2/83	108	Simethicone tablet/RIDER	Problem invention
4	4	G9/92	74	Non-appealing party/BMW	Prohibition of reformatio in peius
5	35	T169/83	72	Wall element/VEREINIGTE METALLWERKE	Inclusion in claims of features from drawings
6	17	G1/99	60	Reformatio in peius/3M	Exception to prohibition
7	38	T56/87	59	Ion chamber/SCANDITRONIX	Technical teaching of prior art document
8	5	G1/93	56	Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS	No technical contribution - harmless added matter
8	16	G4/93	56	Non-appealing party/MOTOROLA	Prohibition of reformatio in peius
10	11	T153/85	50	Alternative claims/AMOCO CORP	Combining prior art - incorporation by reference
11	6	T1002/92	48	Queueing system/PETTERSON	Late filed facts, evidence, arguments
12	12	T219/83	47	Zeolites/BASF	Onus of proof – benefit of doubt
13	18	T73/84	46	Revocation by the patent proprietor/SMS SCHLOEMAN-SIEMAG	Proprietor disapproves text of patent
14	44	T222/85	46	Inadmissibility/PPG	(In)sufficiency of notice of opposition
15	7	T301/87	45	Alpha-interferons/BIOGEN	Lack of clarity
16	3	G2/88	43	Friction reducing additive/MOBIL OIL III	Use of known compound for particular purpose
17	84	T37/85	41	Pouring ladles/MANNESMANN	Obviousness of combination of features
17	45	T328/87	41	Admissibility/THOMSON-BRANDT	Admissibility of opposition based on prior use
19	52	T176/84	39	Pencil sharpener/MÖBIUS	Same problem in broader/ neighbouring field
20	35	T229/85	37	Etching process/SCHMID	Formulation of problem. Simplicity of solution
20	67	T1067/97	37	Development processing of presensitized plates/FUJI PHOTO	Extracting isolated feature from combination
22	21	G7/95	35	Fresh grounds of Opposition/ETHICON INC	Different grounds of opposition
22	10	G2/98	35	Claiming priority of “same invention”/ (President of EPO)	Requirement for acknowledging priority claim
22	73	T204/83	35	Venturi/CHARBONNAGES	Teaching from drawings
22	31	T156/84	35	Pressure swing adsorption/AIR PRODUCTS	Late filed documents. EPO “own motion” exam?

(The second column in the table indicates overall rank, across all opposition appeal decisions in all fields, of the case concerned.)

Table B

RANK		Case	No. of times cited	CHEMISTRY (Boards 3.3.xx) TOP 25	
1	1	G9/91	327	Power to examine/ROHM & HAAS	Extent of opposition
2	2	G10/91	282	Examination of oppositions/appeals/ (President of EPO)	Grounds of opposition
3	3	G2/88	197	Friction reducing additive/MOBIL OIL III	Use of known compound for particular purpose
4	9	G1/03	146	Admissibility of disclaimer/PPG	Undisclosed disclaimers
5	7	T301/87	126	Alpha-interferons/BIOGEN	Lack of clarity
6	12	T219/83	122	Zeolites/BASF	Onus of proof – benefit of doubt
7	10	G2/98	120	Claiming priority of “same invention”/ (President of EPO)	Requirement for acknowledging priority claim
8	14	T939/92	118	Triazoles/AGREVO	Inventive step based on alleged technical effect
9	6	T1002/92	115	Queueing system/PETTERSON	Late filed facts, evidence, arguments
10	4	G9/92	113	Non-appealing party/BMW	Prohibition of reformatio in peius
11	5	G1/93	111	Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS	No technical contribution - harmless added matter
12	13	T409/91	106	Fuel Oils/EXXON	Sufficiency, support, balance of probabilities
13	11	T153/85	98	Alternative claims/AMOCO CORP	Combining prior art - incorporation by reference
14	20	T20/81	97	Aryloxybenzaldehydes/SHELL	Alleged advantages – sufficient evidence
15	22	T12/81	87	Diastereomers/BAYER	Inevitable but undetected result etc.
16	19	T435/91	86	Detergents/UNILEVER	Functional definition. Fit for generalization
17	14	G4/92	83	Basis of decisions/(President of the EPO)	Party absent from oral hearing etc.
18	31	T197/86	78	Photographic couplers/KODAK	Comparative tests
19	34	T19/90	77	Onco-mouse/HARVARD	Patentability of animals/transgenic animals
20	28	T666/89	73	Washing composition/UNILEVER	Overlapping ranges etc.
21	37	G5/83	72	Second medical indication/EISAI	-
21	460	G1/92	72	Availability to the public/(President of EPO)	Analysis of composition
23	8	T2/83	69	Simethicone tablet/RIDER	Problem invention
23	24	T270/90	69	Polyphenylene ether compositions/ ASAHI	Degree of proof – balance of probabilities
25	41	T181/82	69	Spiro compounds/CIBA GEIGY	Comparative tests

(The second column in the table indicates overall rank, across all opposition appeal decisions in all fields, of the case concerned.)

Table C

RANK		Case	No. of times cited	PHYSICS (Boards 3.4.xx) TOP 25	
1	2	G10/91	62	Examination of oppositions/appeals/ (President of EPO)	Grounds of opposition
2	1	G9/91	44	Power to examine/ROHM & HAAS	Extent of opposition
3	4	G9/92	24	Non-appealing party/BMW	Prohibition of reformatio in peius
4	5	G1/93	23	Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS	No technical contribution - harmless added matter
5	6	T1002/92	22	Queueing system/PETERSON	Late filed facts, evidence, arguments
6	3	G2/88	20	Friction reducing additive/MOBIL OIL III	Use of known compound for particular purpose
7	16	G4/93	18	Non-appealing party/MOTOROLA	Prohibition of reformatio in peius
8	11	T153/85	15	Alternative claims/AMOCO CORP	Combining prior art - incorporation by reference
9	14	G4/92	14	Basis of decisions/(President of the EPO)	Party absent from oral hearing etc.
10	10	G2/98	13	Claiming priority of "same invention"/ (President of EPO)	Requirement for acknowledging priority claim
10	13	T156/84	13	Pressure swing adsorption/AIR PRODUCTS	Late filed documents. EPO "own motion" exam?
12	21	G7/95	12	Fresh grounds of Opposition/ ETHICON INC	Different grounds of opposition
13	65	G7/93	11	Late amendments/WHITBY RESEARCH	Exercise of discretion
13	29	G4/95	11	Representation/BOGASKY	Oral submissions by an accompanying person
13	52	T176/84	11	Pencil sharpener/MÖBIUS	Same problem in broader/ neighbouring field
13	45	T328/87	11	Admissibility/THOMSON-BRANDT	Admissibility of opposition based on prior use
17	57	T95/83	10	Late submission of amendment/AISIN	Only in exceptional circumstances
17	41	T220/83	10	Grounds for appeal/HÜLS	Inadequate content of grounds of appeal
17	121	T93/89	10	Polyvinyl ester dispersion/HOECHST	Public prior use. When, where, how, by whom etc.
20	61	G1/84	9	Opposition by proprietor/MOBIL OIL	-
20	61	T406/86	9	Trichloroethylene/WACKER	Amendments - discretion
20	46	T182/89	9	Extent of opposition/SUMITOMO	Insufficiency. Burden of proof
23	23	G1/95	8	Fresh grounds of Opposition/DE LA RUE	Different grounds of opposition
23	191	T17/86	8	Refrigeration plant/SATAM BRANDT	Limit claims by features from description
23	51	T237/86	8	Abandoned patent/SMS	Patentee abandons patent

(The second column in the table indicates overall rank, across all opposition appeal decisions in all fields, of the case concerned.)

Table D

RANK		Case	No. of times cited	ELECTRICITY (Boards 3.5.xx) TOP 25	
1	1	G9/91	63	Power to examine/ROHM & HAAS	Extent of opposition
2	2	G10/91	42	Examination of oppositions/appeals/ (President of EPO)	Grounds of opposition
3	6	T1002/92	23	Queueing system/PETTERSON	Late filed facts, evidence, arguments
4	4	G9/92	21	Non-appealing party/BMW	Prohibition of reformatio in peius
4	5	G1/93	21	Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS	No technical contribution - harmless added matter
6	23	G1/95	14	Fresh grounds of Opposition/DE LA RUE	Different grounds of opposition
6	82	T536/88	14	Dust-tight folding carton/BADISCHE KARTONFABRIK	Document cited in patent as closest prior art
8	17	G1/99	13	Reformatio in peius/3M	Exception to prohibition
9	191	T641/00	12	Two identities/COMVIK	Problem & solution - non-technical features
9	11	T153/85	12	Alternative claims/AMOCO CORP	Combining prior art - incorporation by reference
9	30	T472/92	12	Joint venture/SEKISUI	Prior use – proof to the hilt
12	40	G8/91	11	Withdrawal of appeal/BELL	Termination of appeal proceedings
12	21	G7/95	11	Fresh grounds of Opposition/ ETHICON INC	Different grounds of opposition
14	31	T186/84	10	Request from patent proprietor for revocation/BASF	No substantive examination of merits
14	113	T633/97	10	Optical members/HERAEUS	Exercise of discretion
16	10	G2/98	9	Claiming priority of “same invention”/ (President of EPO)	Requirement for acknowledging priority claim
17	3	G2/88	8	Friction reducing additive/ MOBIL OIL III	Use of known compound for particular purpose
17	46	T326/87	8	Polyamide compositions/DU PONT	Exercise of discretion - Remittal
17	519	T1053/98	8	Data communication apparatus/ CANON	Formulation of problem - Non-technical features
20	41	G1/86	7	Re-establishment of appellant/ opponent rights/VOEST ALPINE	Late grounds of appeal
20	14	G4/92	7	Basis of decisions/(President of the EPO)	Party absent from oral hearing etc.
20	16	G4/93	7	Non-appealing party/MOTOROLA	Prohibition of reformatio in peius
20	29	G4/95	7	Representation/BOGASKY	Oral submissions by an accompanying person
20	202	J10/07	7	Subsequent filing of drawings/ AMAZONEN-WERKE	EPC1973 or EPC2000?
20	460	T208/84	7	Computer-related invention/VICOM	Computer program as such?

(The second column in the table indicates overall rank, across all opposition appeal decisions in all fields, of the case concerned.)

Life Sciences/Biotech - Most popular opposition appeal decisions

It appears that chemistry boards 3.3.04 and 3.3.08 regularly handle opposition appeals concerned with life sciences or “biotech”.

Around 1000 opposition appeals have been decided by boards 3.3.04 and 3.3.08. These cases referenced around 3550 earlier appeal decisions – cited by one or more of the parties, the Opposition Division or the Board of Appeal. Compared with opposition appeals in other fields (e.g. mechanics, physics,

electricity and even chemistry in general), it seems that opposition appeals in the field of life sciences/biotech much more often make reference or resort to “case law”.

The following table E indicates the all-time top 25 cited cases referenced in opposition appeal decisions of boards 3.3.04 and 3.3.08. These top 25 cited cases account for around 20% of the total “case law” references in those decisions.

Table E

RANK		Case	No. of times cited	Life sciences/Biotech (Boards 3.3.04 + 3.3.08)	
1	34	T19/90	66	Onco-mouse/HARVARD	Patentability of animals/transgenic animals
2	1	G9/91	57	Power to examine/ROHM & HAAS	Extent of opposition
3	2	G10/91	54	Examination of oppositions/appeals/ (President of EPO)	Grounds of opposition
3	10	G2/98	54	Claiming priority of “same invention”/ (President of EPO)	Requirement for acknowledging priority claim
5	3	G2/88	50	Friction reducing additive/ MOBILOIL III	Use of known compound for particular purpose
6	9	G1/03	41	Admissibility of disclaimer/PPG	Undisclosed disclaimers
7	13	T409/91	40	Fuel Oils/EXXON	Sufficiency, support, balance of probabilities
7	76	T296/93	40	HBV antigen production/BIOGEN	Same invention. Expectation of success etc.
9	4	G9/92	38	Non-appealing party/BMW	Prohibition of reformatio in peius
10	14	T939/92	36	Triazoles/AGREVO	Inventive step based on alleged technical effect
11	7	T301/87	35	Alpha-interferons/BIOGEN	Lack of clarity
12	46	T292/85	30	Polypeptide expression/GENENTECH	Sufficiency
13	19	T435/91	28	Detergents/UNILEVER	Functional definition. Fit for generalization
14	5	G1/93	26	Limiting feature/ADVANCED SEMICONDUCTOR PRODUCTS	No technical contribution - harmless added matter
14	116	T81/87	26	Preprorennin/Collaborative	Priority. Missing essential features
14	103	T694/92	26	Modifying plant cells/MYCOGEN PLANT SCIENCE	Actual technical contribution. Scope of claim
17	37	G5/83	24	Second medical indication/EISAI	-
18	38	T190/99	23	Woven slide fastener stringer/YKK	Mind willing to understand
19	129	T923/92	22	Human t-PA	Sufficiency. Priority
19	151	T412/93	22	Erythropoietin/KIRIN-AMGEN	Sufficiency. No best mode requirement
21	151	G1/98	20	Transgenic plant/NOVARTIS II	Plant varieties
22	176	T1329/04	19	Factor 9/JOHN HOPKINS	Plausible solution of technical problem
22	182	T612/92	19	Monocotyledonous plants/ RIJKSUNIVERSITEIT LEIDEN	Sufficiency
24	26	G4/88	17	Transfer of Opposition/DELTA	Transfer as part of business assets
24	23	G1/95	17	Fresh grounds of Opposition/DE LA RUE	Different grounds of opposition

(The second column in the table indicates overall rank, across all opposition appeal decisions in all fields, of the case concerned.)