

casting doubt on the alleged solution of the problem. If the opponent succeeds, the burden of proof shifts to the patent proprietor who must then prove its assertions (see e.g. T.1797/09). Where, however, the opponent succeeds in casting serious doubt on the persuasiveness of the patentee's evidence merely by arguing that this evidence was subject to **erroneous evaluation** by the examining division, this allegation may render the patentee's evidence inappropriate but cannot justify the conclusion that the invention fails to solve the existing technical problem. Such allegation does not discharge the opponent from the burden of submitting convincing counter-evidence that the claimed subject-matter cannot solve the technical problem (T.596/99).

The appellant relied upon experimental reports. However, these tests did not prove its allegations beyond all reasonable doubt. The proprietor (appellant) submitted that the burden of proof lay with the respondents (opponents) to show that the amendments did in fact extend the protection conferred (Art.123(3) EPC). However, it was the proprietor (appellant), who had amended the patent as granted and who was responsible for demonstrating, beyond all reasonable doubt, that said amendment did not extend the protection conferred (T.2285/09).

Reversely, the patentee cannot relieve itself of the burden of providing **counter-evidence** for facts it alleges by simply stating that all the evidence was within the power of its opponent (with reference to T.472/92, OJ 1998, 161;), without providing proof for the contention that it is not within its power to obtain counter-evidence (T.254/98). As far as apportioning the burden of proof is concerned, it is irrelevant whether or not the patentee can access the requisite evidence more easily than the opponent (T.1162/07; see also T.1710/12).

5.1.2 Individual cases

a) Novelty

For the purpose of assessing novelty, the party alleging that the inevitable outcome of a prior art disclosure is in contradiction with the explicit disclosure of the cited prior art has not only the burden of reproducing the earlier disclosure in such a way as to demonstrate that the alleged inevitable outcome has occurred, but also the burden of proving convincingly that if any significant deviation from the conditions specified in the earlier disclosure are not material to the outcome (T.204/00; see also T.396/89).

In T.713/01 the appellant denied the existence of an "enabling" disclosure in D2 with regard to the preparation of polymers in the presence of a solubilised lithium pyrrolidide initiator by reference to T.124/87 (OJ 1989, 491) and T.206/83 (OJ 1987, 5). The board held that the only difference between D2 and the claim wording did not qualify as a distinguishing feature of the claimed product because that **"product-by-process" feature** was not detectable on the product by a reliably distinguishing property. In this context, the board added that in proceedings before the examining division the burden of proof for an allegedly distinguishing "product-by-process" feature lay with the applicant (see further T.205/83, OJ 1985, 363 and T.279/84). Decision T.713/01 was clearly concerned with the question of burden of proof in examination proceedings (T.1912/10).