

As far as issues relating to patentability requirements are concerned, the burden of proof in **examination proceedings** cannot lie initially with the applicant. If an examining division raises an objection, it must be appropriately substantiated. In T 578/06 the examining division had failed to provide such substantiation. Also, the passage in the "Case Law of the Boards of Appeal of the EPO" (see paragraph immediately above) could not support its view that in ex parte proceedings the applicant has the burden of proof for facts in his favour, as it appeared to have been taken out of its context. In this respect, the board clarified that all the procedural situations referred to in this passage were those where, in response to a substantiated objection from the examining division, the applicant was required to support its contention.

It is not sufficient in **opposition proceedings** for the opponent to impugn a granted patent with an assertion which cannot be substantiated. And if the EPO is unable to establish the facts of its own motion, the proprietor is given the benefit of the doubt (T 219/83, OJ 1986, 211, 328; see also T 293/87 and T 459/87). According to T 200/94 (following established case law), if a board's investigation does not enable it to verify beyond reasonable doubt the facts alleged, this goes to the detriment of the party needing to prove them, i.e. the party who relies on these facts. In **appeal proceedings**, the party's status as opponent makes no difference when it comes to assigning the burden of proof (this follows also from T 740/90, T 270/90, OJ 1993, 725 and T 381/87, OJ 1990, 213). Parties to proceedings bear separate burdens of proving the facts they allege, and if a fact that is material to the decision is not proven, then the decision goes against the party that failed to discharge that burden. In T 1469/08, the appellant (opponent), who was alleging prior use, argued that all the prostheses in question, whatever their article code and batch of manufacture, had the same structure as the one submitted as evidence to the EPO, but failed to provide any evidence to support that (the board cited T 270/90, OJ 1993, 725, point 2.1 of the Reasons; T 355/97, point 2.5 of the Reasons).

In T 998/04 the board emphasised as an obiter dictum that the burden of proof for alleged lack of patentability lay with the opponent and could not be dispensed with by requesting the board to carry out its own investigations, in particular, by summoning four named witnesses, by commissioning an **independent expert** to carry out experimental tests and by allowing individuals from the appellant company to attend any tests and to question witnesses or experts. Moreover, granting these requests would not be consistent with the character of the post-grant opposition proceedings under the EPC which were in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment (see G 9/91, OJ 1993, 408, point 2 of the Reasons). If the opponent disputes the existence of novelty, an inventive step or the reproducibility of the invention, it bears the burden of proof in this respect at first and second instance (e.g. T 762/04; T 382/93; T 16/87, OJ 1992, 212; T 182/89, OJ 1991, 391). In case of uncertainty about a prior-art disclosure, the patentee should be given the benefit of the doubt (T 1003/96; see also T 230/92, T 345/86, T 601/91 and T 968/91).

A technical problem set out in a patent is considered to be credibly solved by a claimed invention if there are no reasons to assume the contrary. Under such circumstances, the burden is normally on the opponent to prove the opposite or at least provide evidence