

turn on a legal relationship between parties such as that of a subsidiary, affiliated company.

5.2.2 Cases in which the burden of proof was reversed

a) Inventive step – furnishing of tests

In T. 570/08 the opponents had filed evidence in the form of comparative tests with the aim to support their argument that the claimed additive composition in the patent-in-suit did not solve the problem of improving lubricity and solubility of a diesel fuel oil. These results were in contrast to the tests which the patent proprietor had provided, so that the board was confronted with a series of tests leading to contradictory results. Therefore the board could not share the patent proprietor's argument that the burden of proof rested with the opponents, since the opponents' test results cast doubts on the effect allegedly achieved by the present invention. The patent proprietor could not convincingly eliminate those doubts and the patent was revoked. By contrast, the board in T. 1621/16 was satisfied that the technical report submitted with the appellant's grounds of appeal had shifted the burden of proof to the opponents, who then had to demonstrate that the technical problem in question had not been solved. Applying the balance of probabilities, the board concluded that it was technically plausible that the subject-matter of the claim solved the problem. After examining the obviousness, it held that the requirements of Art. 56 EPC were met.

b) Non-disclosure agreement

In T. 473/13 the board considered the arguments and the supporting evidence (an affidavit by the project manager and inventor of the patent in suit) submitted by the respondent (patent proprietor) to be sufficient to discharge its initial burden of proving that there had been a confidentiality agreement. The burden of proof then shifted to the intervener, which had to establish that there had been no such confidentiality agreement. The intervener had, however, presented no arguments or evidence which objectively might cast doubt on the existence of a confidentiality agreement, but had merely presented speculation in this respect. The intervener did not try to contact the utility company V, with which the patent proprietor had a co-operation, to enquire of them whether they considered a confidentiality agreement to have been in place. The intervener also did not make enquiries of other organisations active in the technical field in order to address the question whether such confidentiality agreements represented normal practice. The board concluded that the public nature of the prior use was not proven, such that it did not form part of the prior art.

c) Sufficiency of disclosure

The burden of establishing insufficiency of disclosure generally lies with the opponent. When the patent does not give any information on 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 the burden of proof by plausibly arguing that common general knowledge would not enable the skilled person to put this feature into practice. The patent proprietor then bears the burden of establishing the contrary assertion