

Case Law of the Boards of Appeal of the European Patent Office

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edited by:

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Foreword to the sixth edition

Over more than thirty years, the Boards of Appeal of the European Patent Office have developed a substantial body of case law on the European Patent Convention. Since the first decision handed down in March 1979, the Boards of Appeal have settled more than 28 000 cases. In addition more than 90 decisions or opinions of the Enlarged Board of Appeal have clarified legal points of fundamental importance in order to ensure uniform application of the law.

The sixth edition of the "Case Law of the Boards of Appeal of the European Patent Office" incorporates decisions written by the end of 2009. It also takes account of a number of important decisions issued in the first two months of 2010. The book follows the same general pattern as in the previous editions, dividing the case law into topics and illustrating each by short summaries of selected decisions. The chapters have been fully revised and updated in the light of the EPC 2000 revision.

The purpose of this book is to help users of the European patent system identify the decisions they need. No summary, however careful, can replace study of the actual decision. All of the decisions handed down since 1979 can be consulted in full and free of charge on the EPO website (www.epo.org). They can be accessed via the reference number or via search terms. They are also available on the "ESPACE Legal" DVD, which is published twice a year.

I wish to take this opportunity to thank the members of our Legal Research department, who, with great commitment, have undertaken a revision of the text, harmonised and updated the comprehensive index and table of cases in the three official languages. My thanks also go to the EPO Language Service, without whose co-operation and hard work simultaneous publication in the three official languages would not have been possible. Lastly, I wish to thank all the other EPO staff who have helped produce the present publication.

This latest report on the case law of the EPO boards of appeal will provide useful and comprehensive information for everyone concerned with European patent law. Readers are also referred to the annual "Board of Appeal Case Law" Special Editions to the EPO Official Journal.

I am certain that all those who read the report will find it very useful.

Peter Messerli

Chairman of the Enlarged Board of Appeal

Vice-President Directorate-General 3

TABLE OF CONTENTS

I.	PATENTABILITY	1
A.	Patentable inventions	1
B.	Exceptions to patentability	36
C.	Novelty	63
D.	Inventive step	162
E.	The requirement of industrial applicability under Article 57 EPC	223
II.	CONDITIONS TO BE MET BY AN APPLICATION	229
A.	Sufficiency of disclosure	229
B.	Claims	251
C.	Unity of invention	292
III.	AMENDMENTS	315
A.	Article 123(2) EPC	315
B.	Article 123(3) EPC	355
C.	Relationship between Article 123(2) and Article 123(3) EPC	366
D.	Rule 139 EPC	369
E.	Standard of proof for allowing amendments and corrections	373
IV.	DIVISIONAL APPLICATIONS	375
V.	PRIORITY	397
A.	Applications giving rise to a right of priority - General issues	397
B.	Identity of invention	400
C.	First application	417
D.	Partial and multiple priorities	420
VI.	RULES COMMON TO ALL PROCEEDINGS BEFORE THE EPO	425
A.	The principle of the protection of legitimate expectations	425
B.	Right to be heard	438
C.	Oral proceedings	453
D.	Time limits, further processing and interruption of proceedings	478
E.	Re-establishment of rights	490
F.	Rules relating to Fees	533
G.	Procedural steps	537
H.	Law of evidence	544
I.	Representation	571
J.	Decisions of EPO departments	590
K.	Other procedural questions	625

L.	Interpretation of the EPC	638
M.	Right to a European patent	643
VII.	PROCEEDINGS BEFORE THE EPO	645
A.	Preliminary and formalities examination	645
B.	Examination procedure	658
C.	Special features of opposition and appeal proceedings	700
D.	Opposition procedure	763
E.	Appeal procedure	821
VIII.	PROCEEDINGS BEFORE THE DISCIPLINARY BOARD OF APPEAL	931
IX.	THE EPO ACTING AS A PCT AUTHORITY	945
A.	Competence of the boards of appeal in protest proceedings under the PCT	945
B.	The EPO as designated or elected Office	946
X.	INSTITUTIONAL MATTERS	951

DETAILED TABLE OF CONTENTS

FOREWORD TO THE SIXTH EDITION	III
READER'S GUIDE	XXXV
1. Abbreviations	XXXV
2. Citations	XXXVI
3. Case numbers	XXXVI
HEADNOTE OF OPINION G 3/08	XXXVII
I. PATENTABILITY	1
A. Patentable inventions	1
1. Patent protection for technical inventions	1
1.1. Technical character of an invention	1
1.2. Separate and independent patentability requirements	3
1.3. Absolute and relative patentability requirements	3
1.4. Examination of subject-matter or activities under Article 52 EPC	4
1.4.1 Examination independent of the contribution of the invention	4
1.4.2 Technical considerations	5
1.5. Inventions with technical and non-technical subject-matter	8
1.6. Assessment of the invention as a whole	9
2. Non-inventions under Article 52(2) and (3) EPC	10
2.1. Introduction	10
2.2. Discoveries, scientific theories and mathematical methods	12
2.2.1 Discoveries and scientific theories	12
2.2.2 Mathematical methods	13
2.3. Aesthetic creations	15
2.4. Computer-implemented inventions	16
2.4.1 General issues	16
2.4.2 Exclusion of computer programs "as such"	18
2.4.3 Claims for a computer program product	18
2.4.4 Technical character and programs for computers	20
2.4.5 Programming a computer	23
2.4.6 Control and operating programs	24
2.5. Schemes, rules and methods for performing mental acts, playing games or doing business	25
2.5.1 Methods for doing business	25
2.5.2 Methods for performing mental acts	28
2.5.3 Word-processing	30
	VII

2.6.	Presentation of information	33
B.	Exceptions to patentability	36
1.	Introduction	36
2.	Breaches of "ordre public" or morality	37
3.	Patentability of biological inventions	42
3.1.	Plants and plant varieties	42
3.2.	Animals and animal species	44
3.3.	Essentially biological processes	45
3.4.	Microbiological processes and the products thereof	48
4.	Medical methods	49
4.1.	Introduction	49
4.2.	Methods for treatment by surgery or therapy and diagnostic methods	51
4.2.1	General approach	51
4.2.2	Involvement of practitioner	51
4.3.	Surgical methods - G 1/07	51
4.3.1	Towards a new concept of "treatment by surgery"	51
4.3.2	One surgical step in a multi-step method	52
4.3.3	Treatment by surgery not limited to surgery for a therapeutic purpose	53
4.3.4	Avoiding the exclusion of methods of treatment by surgery from patent protection under Article 53(c) EPC	54
4.3.5	Data obtained during surgery	55
4.4.	Therapeutic methods	55
4.4.1	Meaning of "therapy"	55
4.4.2	Methods with both therapeutic and non-therapeutic indications	57
4.5.	Diagnostic methods - G 1/04	60
4.5.1	What constitutes "diagnostic methods"	60
4.5.2	Involvement of practitioner	61
4.5.3	The criterion "practised on the human or animal body"	61
4.5.4	Clarity of a claim relating to diagnostic methods	62
4.5.5	Scope of the exclusion	62
4.5.6	Intermediate findings of diagnostic relevance	63
4.6.	Case law applying the principles developed in G 1/04	63
C.	Novelty	63
1.	Defining the state of the art	64
1.1.	Relevant point in time	64
1.2.	European prior rights	65
1.3.	PCT applications as state of the art	65
1.4.	In-house knowledge not published before the priority date	66
1.5.	Definition of "common general knowledge"	66
1.6.	Excluded national prior rights	68
1.7.	Article 55 EPC	68
1.8.	Availability to the public	69
1.8.1	Publication	70

1.8.2	Brochures	72
1.8.3	Lectures	73
1.8.4	Abstracts of documents	73
1.8.5	Repetition of oral disclosures	74
1.8.6	Prior use	74
1.8.7	Biological material	75
1.8.8	The concept of "the public"	75
1.8.9	Obligation to maintain secrecy	77
1.9.	Issues of proof	86
1.9.1	Nature of the evidence	86
1.9.2	Burden of proof	86
1.9.3	Standard of proof	88
1.9.4	Information retrieved from the internet: proof of the date of availability	91
1.9.5	Obligation of the EPO to examine of its own motion	92
2.	Determining the content of the relevant prior art	92
2.1.	General rules of interpretation	93
2.2.	Combinations within a prior art document	96
2.3.	Taking implicit features into account	97
2.4.	Taking intrinsic features into account	99
2.5.	Taking equivalents into account	99
2.6.	Taking drawings into account	100
2.7.	Taking examples into account	101
2.8.	Assessment of prior use	102
2.9.	Broad claims	105
2.10.	Deficiencies and mistakes in a disclosure	105
2.11.	Accidental disclosure	106
2.12.	Reproducibility of the content of the disclosure	107
3.	Ascertaining differences	109
3.1.	Comparing each individual item from the prior art	109
3.2.	Distinguishing features	111
3.2.1	Difference in wording	111
3.2.2	Differences in values	112
3.2.3	Difference in composition	113
3.2.4	Inevitably obtained products	114
3.2.5	Functional features	114
3.2.6	Generic disclosure	115
3.2.7	Product claim with process features	116
3.2.8	Distinguishing features which are non-technical or involve no technical features	116
4.	Chemical inventions and selection inventions	117
4.1.	Novelty of chemical compounds and groups of compounds	118
4.1.1	Anticipation of certain compounds	119
4.1.2	Novelty of groups of substances	122
4.1.3	Novelty of enantiomers	124
4.1.4	Achieving a higher degree of purity	125
4.2.	Selection of parameter ranges	127
4.2.1	Selection from a broad range	127

4.2.2	Overlapping ranges	129
4.2.3	Multiple selection	131
4.3.	Subject-matter group	133
5.	Novelty of use	133
5.1.	First medical use	133
5.1.1	Introduction	133
5.1.2	Scope of a purpose-related product claim	134
5.1.3	Protection of a preparation in the form of a "kit-of-parts"	135
5.1.4	Further technical information as compared with the state of the art	136
5.2.	Second (or further) medical use	136
5.2.1	Introduction	136
5.2.2	Formulation of claims under the EPC 1973	138
5.2.3	Formulation of claims under Article 54(5) EPC	141
5.2.4	Novelty of the therapeutic application	144
5.3.	Second (or further) non-medical use	152
5.3.1	Novelty criteria for use claims and process claims containing a purpose feature	152
5.3.2	Statement of purpose in non-medical use claims in view of Article 52(4) EPC 1973	160
5.3.3	Novelty criteria for product claims with purpose characteristics	161
D.	Inventive step	162
1.	Introduction	162
2.	Problem and solution approach	162
3.	Closest prior art	163
3.1.	Determination of closest prior art in general	163
3.2.	Same purpose or effect	164
3.3.	Similarity of the technical problem	165
3.4.	Most promising springboard	166
3.5.	Selection of most promising starting point	166
3.6.	Improvement of a production process for a known product	168
3.7.	Old prior art documents as closest prior art	168
4.	Technical problem	170
4.1.	Determination of the technical problem	170
4.2.	Alleged advantages	170
4.3.	Formulation of the technical problem	171
4.3.1	No pointers to the solution	171
4.3.2	Problem formulated in the patent application as starting point	171
4.3.3	Formulation of partial problems - lack of unity	172
4.4.	Reformulation of the technical problem	172
4.5.	Alternative solution to a known problem	175
4.6.	Solving a technical problem - post-published documents	175
5.	"Could-would approach" and ex post facto analysis	176
6.	Expectation of success, especially in the field of genetic engineering and biotechnology	177
7.	Skilled person	180

7.1.	Definition of the skilled person	180
7.1.1	Definition	180
7.1.2	Competent skilled person - group of people as "skilled person"	182
7.1.3	Definition of the person skilled in the art in the field of biotechnology	182
7.1.4	Identification of the skilled person in the case of computer-implemented inventions	184
7.2.	Neighbouring field	184
7.3.	Skilled person - level of knowledge	186
7.4.	Everyday items from a different technical field	187
8.	Assessment of inventive step	188
8.1.	Treatment of technical and non-technical features	188
8.1.1	Technical character of the invention	188
8.1.2	Problem and solution approach	189
8.1.3	Identifying technical features	191
8.1.4	Assessment of technical effect	193
8.1.5	Formulation of the technical problem	194
8.2.	Combination invention	197
8.2.1	Existence of a combination invention	197
8.2.2	Partial problems	198
8.3.	Technical disclosure in a prior art document	199
8.4.	Features not contributing to the solution of the problem	199
8.5.	Foreseeable disadvantageous or technically non-functional modifications	200
8.6.	Substitution of materials - analogous use	200
8.7.	Combination of documents	201
8.8.	Chemical inventions	202
8.8.1	Problem and solution approach	202
8.8.2	Structural similarity	202
8.8.3	Broad claims	203
8.8.4	Intermediate products	204
8.9.	Equivalents	205
8.10.	Problem inventions	205
8.11.	New use of a known measure	206
8.12.	Obvious new use	207
8.13.	Need to improve properties	207
8.14.	Disclaimer	208
8.15.	Optimisation of parameters	208
8.16.	Small improvement in commercially used process	209
8.17.	Evidence of inventive step in the field of medicine	210
8.18.	Analogy process - envisageable product	210
8.19.	Examples on the denial of inventive step	211
8.19.1	Reversal of procedural steps	211
8.19.2	Purposive selection	211
8.19.3	Automation	211
8.19.4	Routine experiments	212
8.19.5	Simplification of complicated technology	212
8.19.6	Choice of one of several obvious solutions	212
8.19.7	Several obvious steps	213

8.19.8	Selection from obvious alternatives	213
9.	Secondary indicia in the assessment of inventive step	213
9.1.	General issues	213
9.2.	Technical prejudice	214
9.3.	Age of documents - time factor	216
9.4.	Satisfaction of a long-felt need	217
9.5.	Commercial success	217
9.6.	Market competitors	218
9.7.	Simple solution	219
9.8.	Surprising effect - bonus effect	219
9.9.	Comparative tests	221
E.	The requirement of industrial applicability under Article 57 EPC	223
1.	Notion of "industrial application"	223
1.1.	General issues	223
1.2.	Indication of a profitable use of the invention in industry	225
2.	Indicia in determining industrial applicability	227
2.1.	Methods applied in the private and personal sphere	227
2.2.	Possibility of services offered by an enterprise	228
2.3.	Other criteria - formulation of claims	228
II.	CONDITIONS TO BE MET BY AN APPLICATION	229
A.	Sufficiency of disclosure	229
1.	Parts of the application relevant for assessing sufficiency of disclosure	229
2.	Knowledge of skilled person relevant for assessing sufficiency of disclosure	229
3.	Clarity and completeness of disclosure	231
4.	Reproducibility	234
4.1.	General principles	234
4.2.	Reproducibility without undue burden	236
4.3.	Post-published documents	238
5.	The requirement of sufficiency of disclosure in the biotechnology field	239
5.1.	Clarity and completeness of disclosure	239
5.1.1	General	239
5.1.2	Factors contributing to a finding of undue burden	241
5.2.	Deposit of living material	243
5.2.1	Substantive law questions	244
5.2.2	Procedural law questions	244
6.	The relationship between Article 83 and Article 84 EPC	245
6.1.	Article 83 EPC and support from the description	245
6.2.	Article 83 EPC and clarity of claims	247
7.	Evidence	250

B.	Claims	251
1.	Clarity	252
1.1.	Principles governing the text of claims	252
1.1.1	General	252
1.1.2	Characterisation of a product by a parameter	255
1.1.3	Reference to the description or drawings	256
1.1.4	Indication of all essential features	257
1.1.5	Clarity of broad claims	259
1.1.6	Principles in connection with categories of claim	260
1.2.	Exceptions to the principles	262
1.2.1	Disclaimers	262
1.2.2	Functional features	266
1.2.3	Unspecified features and relative qualities	268
2.	Conciseness	270
2.1.	General	270
2.2.	Rule 43(2) EPC	271
2.2.1	Conditions	271
2.2.2	Burden of proof	273
2.2.3	Applicability in opposition proceedings	273
3.	Form of the claims	273
3.1.	One-part or two-part claim	274
3.2.	Particular issues in connection with two-part claims	275
4.	Claims supported by the description	275
4.1.	General principles	275
4.2.	Requirement for all essential features to be indicated in the claim	276
4.3.	Restrictions on generalising the technical information and examples adduced in the description	277
4.4.	Bringing the description into line with amended claims	279
5.	Interpretation of claims	279
5.1.	General principles	279
5.2.	Meaning of terms	280
5.3.	Using description and drawings to interpret the claims	281
5.3.1	General principles	281
5.3.2	Relevance of Article 69 EPC	282
5.3.3	Interpretation of ambiguous terms or confirmation of the text of a claim	283
5.3.4	Reading additional features and limitations into the claims	284
5.3.5	Use in the examination relating to the clarity requirement pursuant to Article 84 EPC	285
5.3.6	Scope of protection not defined with regard to infringement	287
6.	Product-by-process claims	287
6.1.	Introduction	287
6.2.	Requirement that the claimed product must be patentable	288
6.3.	Requirement that the claimed product cannot be described in any other way	290
6.4.	Combination of product and process features	290
6.5.	Extension of protection conferred by product-by-process claims	291

7.	Claims fees	291
C.	Unity of invention	292
1.	Introduction	292
2.	Unity in the context of different types of claims	293
2.1.	Plurality of independent claims	293
2.2.	Dependent claims	295
2.3.	Intermediate products	295
3.	Assessing lack of unity of invention	296
3.1.	General approach - content of claims	296
3.2.	Assessment of lack of unity by the International Searching Authority (ISA)	297
3.3.	Assessment of lack of unity in examination proceedings	299
3.3.1	Lack of unity raised at different stages of the procedure	299
3.3.2	Assessment of requests for refund of further search fees	300
3.4.	No assessment of lack of unity in opposition proceedings	301
4.	Criteria for determining lack of unity	301
4.1.	Determination of the technical problem	301
4.2.	Examination as to novelty and inventive step	302
5.	The single general inventive concept	304
5.1.	General	304
5.2.	Inventive character of the single general concept	306
5.3.	Unity of single claims defining alternatives ("Markush claims")	309
6.	Plurality of inventions and further search fees	311
6.1.	Consequences of non-payment of a further search fee	311
6.2.	Dispensing with further search fee	313
6.3.	Further invitations to pay additional search fees	313
III.	AMENDMENTS	315
A.	Article 123(2) EPC	315
1.	General issues	315
2.	Intermediate generalisation - non-disclosed combinations	324
3.	Technical contribution - addition or deletion of a feature	327
4.	Disclaimers	331
4.1.	Applicable law - decisions G 1/03 and G 2/03	331
4.2.	Decisions applying the criteria established by G 1/03 and G 2/03	332
4.3.	Review of case law prior to G 1/03 and G 2/03	338
5.	Disclosure in drawings	338
6.	The application as originally filed : formal aspects	341
6.1.	Cross-references	341
6.2.	Errors in the disclosure	342
6.2.1	Calculation errors	342
6.2.2	Incorrect structural formula	342
6.2.3	Amendment based on errors	342

6.2.4	Elimination of contradictions	343
6.3.	Subsequent addition of details	344
6.3.1	Amendments in the description of the prior art	344
6.3.2	Subsequent addition of effects	346
7.	"Tests" for assessing the allowability of an amendment	346
7.1.	Direct and unambiguous deducibility of amendments from the application as filed	347
7.2.	The "is it essential" test	352
7.3.	The "novelty test"	354
B.	Article 123(3) EPC	355
1.	General issues	356
2.	Generalisation of a feature	360
3.	Transposition of features	361
4.	Change of claim category	361
C.	Relationship between Article 123(2) and Article 123(3) EPC	366
1.	Cases of conflict	366
2.	Decision G 1/93 of the Enlarged Board of Appeal	367
3.	Resolving the conflict in exceptional cases	368
D.	Rule 139 EPC	369
1.	Relation to Article 123(2) EPC	370
2.	Obviousness of the error and the correction	371
E.	Standard of proof for allowing amendments and corrections	373
IV.	DIVISIONAL APPLICATIONS	375
1.	Subject-matter of a divisional application	375
1.1.	Introduction	375
2.	Validity of divisional applications	376
2.1.	Questions referred to the Enlarged Board of Appeal	376
2.2.	Right to amend - G 1/05	377
2.3.	Sequence of divisional applications - G 1/06	378
3.	Individual cases	379
4.	Amendments to divisional applications	381
4.1.	Link between Article 76(1) and Article 123(2) EPC	381
4.2.	Individual cases	383
5.	Double patenting	384
6.	Filing a divisional application	386
6.1.	Right to file	386
6.2.	Filing date	387

6.2.1	Amended versions of Rule 25(1) EPC 1973 and new legal basis under Rule 36(1) and (2) EPC	387
6.2.2	Case law in respect of the version of 1 October 1988	389
6.2.3	Case law in respect of the version of 2 January 2002	390
7.	Procedural questions	391
7.1.	Basic considerations	391
7.2.	Intention to file a divisional application, or right reserved to do so	392
7.3.	Designation of contracting states in a divisional application	393
7.4.	Correction of errors	394
V.	PRIORITY	397
A.	Applications giving rise to a right of priority - General issues	397
1.	Application filed in or for a state which is party to the Paris Convention or a member of the WTO	397
2.	Priority right of the applicant or his successor in title	398
3.	National deposit of industrial design	398
4.	Exhibition priority	399
5.	Postdating of the previous application	399
6.	Multiple exercise of the right of priority for one contracting state	399
B.	Identity of invention	400
1.	Disclosure in the earlier application of the invention claimed in the subsequent application	401
1.1.	Basic considerations in the interpretation of "the same invention"	401
1.2.	Amendments and disclaimers	402
1.3.	Disclosure in the previous application as a whole	402
1.4.	Reference to common general knowledge	403
1.5.	Explicit or implicit disclosure of the "essential" features in the priority document	404
1.5.1	General	404
1.5.2	Cases of non-disclosure of an essential feature	404
1.5.3	Example of disclosure of essential features of an invention	406
1.6.	Solution of the same problem	406
1.7.	Same teaching in the priority document	406
1.8.	Error margins and definitions of limits	407
1.9.	Selection from generic disclosure	409
1.10.	Inventions relating to nucleotide and amino acid sequences	410
2.	Claiming the invention disclosed in the earlier application in the subsequent application	412
2.1.	Implicit features of the technical teaching of the subsequent application	412
2.2.	Features missing with respect to the earlier application	413
2.2.1	Omission of non-essential features	413
2.2.2	Omission of indispensable features	414

3.	Enabling disclosure in the priority document	414
C.	First application	417
1.	Identity of invention	417
2.	Identity of applicant	419
D.	Partial and multiple priorities	420
1.	Publications during the priority interval	420
2.	Different priorities for different parts of a European patent application	421
3.	Multiple priorities for one claim	421
VI.	RULES COMMON TO ALL PROCEEDINGS BEFORE THE EPO	425
A.	The principle of the protection of legitimate expectations	425
1.	General issues	425
1.1.	Sources of legitimate expectations	426
1.2.	Examples of the legitimate expectations principle	426
1.3.	Limits of the legitimate expectations principle	428
1.4.	The requirement of proof	429
2.	Obligation to draw attention to easily remediable deficiencies	430
2.1.	Examples of the obligation to draw attention to easily remediable deficiencies	431
2.2.	Electronic filing of documents	432
2.3.	Limits of the obligation to draw attention to easily remediable deficiencies	433
3.	Courtesy services performed by the EPO	434
4.	Principle of legitimate expectations where the previous case law is departed from	435
4.1.	General	435
4.2.	Point in time from which a new decision which deviates from existing practice becomes generally applicable	436
B.	Right to be heard	438
1.	The general principle	438
1.1.	The definition of "grounds or evidence"	438
1.2.	Some examples of the principle	439
1.3.	Limits of the principle	440
1.4.	Right to be heard and the timing of decisions	442
2.	Right to be heard in oral proceedings	444
2.1.	Right to oral proceedings	444
2.2.	Introduction of a new claim, relevant document or new argument	444
2.2.1	Cases where new claims or relevant documents were introduced	444

2.2.2	Cases where no new claims, relevant documents or new arguments were introduced	446
2.3.	Changes after oral proceedings	446
3.	Non-appearance at oral proceedings and the right to be heard	447
3.1.	Non-appearance at oral proceedings - case law concerning G 4/92	447
3.2.	Non-appearance at oral hearings before the boards of appeal	449
4.	Article 113(2) EPC	451
4.1.	The requirement of a text agreed by the applicant	451
4.2.	Cases where the EPO is uncertain or mistaken about the approval of the text	452
C.	Oral proceedings	453
1.	Right to oral proceedings	453
1.1.	The general principle	453
1.2.	Special cases of oral proceedings before the Receiving Section	454
1.3.	Examples of the general principle	455
2.	Request for oral proceedings	455
2.1.	Wording of request	456
2.1.1	Wording constituting a request	456
2.1.2	Wording not constituting a request	456
2.2.	Withdrawal of request	457
2.3.	Further oral proceedings before the same department	458
2.4.	Auxiliary request for oral proceedings	459
2.5.	Request for oral proceedings in further prosecution proceedings	460
2.6.	Request for oral proceedings as a reply to a communication of a board of appeal	460
3.	Non-appearance at oral proceedings	461
3.1.	Right to present comments and non-attendance of a party by choice	461
3.2.	Obligation to give notice if not attending oral proceedings	461
4.	Preparation and conduct of oral proceedings	462
4.1.	Fixing or postponing the date for oral proceedings	462
4.1.1	Unavailability of a party, representative or expert	464
4.1.2	New evidence	467
4.1.3	Proceedings before a national court	467
4.2.	Curtailment of notice in the summons	467
4.3.	Communication under Article 15(1) RPBA	468
4.4.	Interpretation and application of Rule 116 EPC (former Rule 71a EPC 1973)	469
4.4.1	Examination and opposition proceedings	469
4.4.2	Appeal proceedings	472
4.5.	Location of oral proceedings	472
4.6.	Computer-generated presentations	473
4.7.	Minutes of oral proceedings (Rule 124 EPC)	474
4.8.	Costs	476
4.8.1	Apportionment of costs	476
4.8.2	Interpreting costs during oral proceedings	476

5.	Non-public oral proceedings	477
6.	Presence of assistants during deliberations of the board	477
D.	Time limits, further processing and interruption of proceedings	478
1.	Calculation, determination and extension of time limits	478
1.1.	Calculation of time limits under Rule 131 EPC	478
1.2.	Determination and extension of periods under Rule 132 EPC	478
1.2.1	Relevant criteria when time limits are extended (R. 132(2), second sentence, EPC)	479
1.2.2	Applicability of Rule 132 EPC to the Rules relating to Fees	479
1.3.	Extension of time limits ipso jure on account of public holidays or dislocations	480
1.3.1	Interruption in the delivery of mail in a Contracting State (Rule 134(2) EPC)	480
1.3.2	Dislocation of a mail service outside the contracting states (Rule 134(5) EPC)	481
1.4.	Statutory periods of grace and the fiction of observance of a time limit for fee payments	482
1.4.1	Additional period for renewal fees under Rule 51(2) EPC	482
1.4.2	Period of grace for payment of fees under Rule 85a EPC 1973	482
1.4.3	Fiction of fee payment in due time pursuant to Article 7(3) and (4) RFees	483
2.	Further processing under Article 121 EPC	484
3.	Interruption of proceedings under Rule 142 EPC	485
3.1.	Application of Rule 142 EPC by the EPO of its own motion	485
3.2.	Concept of legal incapacity (Rule 142(1)(a) and (c) EPC)	485
3.3.	Determining legal incapacity of the applicant or patent proprietor for the purpose of Rule 142(1)(a) EPC	486
3.4.	Determining legal incapacity of the representative for the purpose of Rule 142(1)(c) EPC	486
3.5.	Legal incapacity of a representative from outside the contracting states	488
3.6.	Interruption of proceedings because of insolvency (Rule 142(1)(b) EPC)	488
3.7.	Consequences of interruption of proceedings (Rule 142(4) EPC)	489
E.	Re-establishment of rights	490
1.	EPC 2000 - synopsis of changes	490
2.	Applicability of re-establishment of rights (Article 122(1) EPC)	491
2.1.	The meaning of "time limit"	491
2.2.	Loss of rights as a direct consequence by virtue of the EPC	492
2.3.	Omission of acts by applicant	492
3.	Admissibility of applications for re-establishment of rights	494
3.1.	Department competent to decide upon the application	494
3.2.	Time limits for filing an application for re-establishment (Rule 136(1) EPC)	495
3.2.1	Two-month time limit from the removal of the cause of non-compliance	496
3.2.2	One-year time limit following the expiry of the unobserved time limit	499

3.3.	Making good the omitted act	501
3.4.	Filing and substantiation of the application	501
3.5.	Correction of deficiencies in the application for re-establishment	502
4.	Time limits excluded from re-establishment under Article 122(4) and Rule 136(3) EPC	503
5.	Re-establishment in respect of time limits in PCT protest proceedings	505
6.	Parties to proceedings	506
7.	Merit of applications for re-establishment of rights	507
7.1.	Submissions to be taken into account	507
7.2.	Inability to observe a time limit	508
7.2.1	Financial difficulties	508
7.2.2	Tactical considerations	509
7.3.	General comments on due care	509
7.3.1	Introduction	509
7.3.2	Exceptional circumstances	510
7.3.3	Isolated mistake within a satisfactory system for monitoring time limits	512
7.4.	Persons required to exercise due care; requirements regarding due care	517
7.4.1	Due care on the part of the applicant	517
7.4.2	Due care on the part of the professional representative	519
7.4.3	Due care on the part of a non-authorised representative	523
7.4.4	Due care in dealing with assistants	524
7.4.5	Due care in using mail delivery services	528
8.	Rights of use under Article 122(5) EPC	529
9.	Restitutio in integrum - Interruption of proceedings	530
10.	Re-establishment in the context of the President's extension of time limits during general disruption	530
11.	Principle of proportionality	530
12.	Refund of the fee for re-establishment	532
F.	Rules relating to Fees	533
1.	General	533
2.	Payment of fees	533
2.1.	Methods of payment	533
2.2.	Debit orders	534
2.3.	Indication of purpose of payment	535
2.4.	Designation fees	535
3.	Date of payment	536
4.	Small amount lacking	536
5.	Reduction of the examination fee	537
G.	Procedural steps	537
1.	General principles	537
2.	Signatures	539
3.	Main and auxiliary requests	540
3.1.	Admissibility	540

3.2.	Order of requests	541
3.3.	Examination procedure	541
3.4.	Opposition procedure	543
3.5.	Appeal procedure	544
H.	Law of evidence	544
1.	Introduction	544
2.	Admissible evidence	545
2.1.	No definitive itemisation of admissible evidence	545
2.2.	Hearing witnesses and experts	546
2.3.	Sworn statements in writing and statutory declarations	547
2.4.	Other evidence	548
3.	Taking of evidence	549
3.1.	Competent departments	549
3.2.	Time frame	549
3.3.	Taking of evidence - scope and right to be heard	549
3.4.	Keeping of evidence	552
4.	Evaluation of evidence	552
4.1.	Principle of unfettered consideration of evidence	552
4.2.	Probative value of evidence - individual cases	554
4.2.1	Evidence sufficient	554
4.2.2	Evidence insufficient	554
4.3.	"Balance of probabilities" and standard of proof - various cases	558
4.3.1	Public prior use	558
4.3.2	Content of a disclosure	560
4.3.3	Amendments	561
4.3.4	Claiming a valid priority	562
4.3.5	Abusive conduct	562
4.3.6	Formal requirements	563
4.3.7	Disciplinary matters	564
5.	Burden of proof	564
5.1.	Apportioning the burden of proof	564
5.1.1	General	564
5.1.2	Various cases	566
5.2.	Shifting of the burden of proof	569
I.	Representation	571
1.	Professional representatives	572
1.1.	List of professional representatives (Article 134(1) EPC)	572
1.2.	Duty of persons without residence nor place of business within a contracting state to be represented by a professional representative	572
1.3.	Professional representatives during the transitional period	573
1.4.	Procedural steps performed by a person other than the professional representative	574
2.	Legal practitioners entitled to act as professional representative	574

2.1.	General issues	574
2.2.	Register of legal practitioners	575
2.3.	Qualifying conditions according to Article 134(8) EPC	576
3.	Appointment of a common representative (Rule 151 EPC)	577
4.	Authorisations for appointment of a representative	579
4.1.	Filing of the authorisation	579
4.2.	General authorisations	580
4.3.	Sub-authorisations	582
4.4.	Authorisation of an association of representatives	583
5.	Oral submissions by an accompanying person	583
5.1.	General	583
5.2.	Oral submissions by former members of the boards of appeal	588
5.3.	Oral submissions by qualified patent lawyers of non-EPC contracting states	589
6.	Distinction between presentation of facts and evidence and presentation of arguments	590
J.	Decisions of EPO departments	590
1.	Right to a decision	590
2.	Composition of the competent departments of first instance	591
2.1.	Examining division	591
2.2.	Opposition division	591
3.	Suspected partiality	594
3.1.	General principles	594
3.2.	Individual cases	596
3.2.1	Members of the examining and opposition divisions	596
3.2.2	Members of the boards of appeal	598
3.2.3	Members of the Enlarged Board of Appeal	603
4.	Date of decision	603
4.1.	Entry into force of decisions	603
4.2.	Completion of the internal decision-making process	603
5.	Form of decisions	605
5.1.	General issues	605
5.2.	Inconsistency between oral and written decisions	607
5.3.	Reasons for the decision	607
5.3.1	Introduction	607
5.3.2	Reason for main and auxiliary requests	607
5.3.3	Compliance with the requirements of Rule 111(2) EPC (former Rule 68(2) EPC 1973)	608
5.3.4	Non-compliance with the requirements of Rule 111(2) EPC (former Rule 68(2) EPC 1973)	609
5.4.	Signatures on a decision	615
6.	Correction of errors in decisions	617
6.1.	General issues	617
6.2.	Errors in the printed version of the European patent specification	619

6.3.	Competence to correct a decision under Rule 140 EPC (former Rule 89 EPC 1973)	620
7.	Principles for the exercise of discretion	622
8.	Legal status of the Guidelines for Examination in the EPO	623
9.	Duties not entrusted to formalities officers	624
10.	Jurisdiction	625
K.	Other procedural questions	625
1.	Language privilege	625
1.1.	General	625
1.2.	European patent application	626
1.3.	Examination proceedings	627
1.4.	Opposition proceedings	627
1.5.	Appeal proceedings	627
1.6.	Request for or notification of fee reduction	627
1.7.	Translations	628
2.	Inspection of files	629
2.1.	General	629
2.2.	Exclusion from inspection under Rule 144 EPC	630
3.	Register of Patents	631
3.1.	General	631
3.2.	Registration of licences	631
3.3.	Transfer	631
4.	Stay of proceedings under Rule 14(1) EPC	633
4.1.	Rule 14(1) EPC (Rule 13(1) EPC 1973)	633
4.1.1	General	633
4.1.2	Opening of proceedings before a national court	634
4.2.	Rule 14(3) EPC (Rule 13(3) EPC 1973)	635
5.	Notifications	635
6.	Unity of the European patent application	638
L.	Interpretation of the EPC	638
1.	The Vienna Convention on the Law of Treaties	638
2.	Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS)	639
2.1.	The requirement for the judicial review of decisions	639
2.2.	Interpretation of Article 87 EPC in the light of TRIPS	640
3.	Interpretation of the various language texts of the EPC (Article 177 EPC)	641
4.	Interpretation of the EPC by the boards of appeal	641
4.1.	Decisions of the Administrative Council concerning a question of interpretation	641
4.2.	Taking national decisions into account	642
4.3.	Implementing Regulations	642
4.4.	Differences between national legislation and the EPC	642
5.	Allocation of responsibilities in the EPC	643

M.	Right to a European patent	643
VII.	PROCEEDINGS BEFORE THE EPO	645
A.	Preliminary and formalities examination	645
1.	Introduction	645
2.	Accordance of a date of filing - language of the filed documents	645
3.	Application documents	646
3.1.	Filing of application documents	646
3.2.	Subsequent filing of missing parts of the description or missing drawings	648
3.3.	Replacing the invention	649
3.4.	Extent of competence of the Receiving Section	649
4.	Identity of the applicant	651
5.	Designation of states	652
5.1.	Article 79(2) EPC	652
5.1.1	Article 79(2) EPC (as in force from 13.12.2007)	652
5.1.2	Article 79(2) EPC 1973 (in force from 1.7.1997 to 12.12.2007)	652
5.2.	Effect of non-payment of the designation fee	652
5.3.	Correction of designation of states in Euro-PCT applications	653
6.	Priority	654
6.1.	Filing of priority documents	654
6.2.	Correction of priority declarations	654
7.	Applicability of Article 110(3) EPC 1973 (Rule 100(3) EPC)	658
8.	Publication of the application	658
B.	Examination procedure	658
1.	Request for examination	658
1.1.	General issues	658
1.2.	Request for examination under Rule 70 EPC	660
1.3.	Amendments after receipt of the European search report	660
2.	Substantive examination of the application	661
2.1.	Communications pursuant to Article 94(3) EPC and Rule 71(1) EPC	661
2.2.	Contents of a communication according to Article 94(3) EPC and Rule 71(2) EPC	663
2.3.	Amendments after receipt of the first communication (Rule 137(3) EPC)	664
2.4.	Admissibility of further amendments (Rule 137(3) EPC)	665
2.5.	Amendments relating to unsearched subject-matter	667
2.6.	Issue of a further communication under Article 113(1) EPC	672
2.7.	Informal communications	676
2.7.1	Telephone conversations	676
2.7.2	Interviews	677
2.8.	Failure to reply to the communication from the examining division (Article 94(4) EPC)	678

2.9.	Refusal of a European patent application under Article 97(2) EPC (former Article 97(1) EPC 1973)	679
2.10.	Amendments filed before the boards of appeal	681
3.	Examination proceedings after issuance of the Rule 71(3) EPC communication	681
3.1.	Introduction	681
3.2.	Approval of the text by the applicant	682
3.2.1	Clear and unambiguous approval of the text	682
3.2.2	Rule 71(3) EPC communication refusing main and first auxiliary requests (former Rule 51(4) EPC 1973, 2002 version)	683
3.3.	Legal basis for refusing an application if no text submitted or agreed	684
3.4.	Amendments filed in reply to a communication under Rule 71(3) EPC	686
3.5.	Re-opening examination after approval of the text for grant	690
3.6.	Examination after remittal for further prosecution	690
3.7.	Amendments under Rule 71(5) EPC communication	690
3.8.	Amendments after completion of the examination procedure	692
4.	Withdrawal of the patent application or abandonment of parts thereof	693
4.1.	Withdrawal of patent application as a whole	693
4.2.	Abandonment of parts of an application	695
4.3.	Non-payment of further search fees in the case of lack of unity	696
4.4.	Non-payment of claims fees	696
5.	Consolidation of proceedings	697
6.	Entry into force of a decision to grant a European patent	697
7.	Errors in the Patent Bulletin	699
8.	Metric or SI units	700
C.	Special features of opposition and appeal proceedings	700
1.	Late submission	700
1.1.	Introduction	700
1.1.1	General	700
1.1.2	Late filing	701
1.2.	Examination as to relevance	702
1.2.1	General	702
1.2.2	Examination as to relevance with regard to G 9/91 and G 10/91	703
1.3.	Other criteria applied in the assessment of late submissions	704
1.3.1	General	704
1.3.2	Abuse of procedure	705
1.3.3	Procedural economy	707
1.3.4	Late submission of experimental data	708
1.3.5	Public prior use	709
1.4.	Consideration of late-filed facts, evidence and arguments in opposition proceedings	712
1.4.1	Submission after expiry of the period for filing the notice of opposition	712
1.4.2	Opposition divisions' exercise of discretion	712
1.4.3	Request withdrawn before the opposition division	713
1.5.	Justification for late filing	713

1.5.1	General	713
1.5.2	Justified reaction to the opposition division's decision	714
1.5.3	Change of representative	715
1.6.	Examination of the arguments	716
1.7.	Documents cited in the patent specification or search report	717
2.	Withdrawal of opposition	718
2.1.	Impact of withdrawal of opposition on proceedings before the EPO	718
2.1.1	Withdrawal of opposition during opposition proceedings	718
2.1.2	Withdrawal of the opposition during appeal proceedings	718
3.	Intervention	719
3.1.	General	719
3.2.	Intervention of an alleged infringer in opposition proceedings	720
3.3.	Admissibility of intervention in appeal proceedings	721
3.3.1	Intervener's rights in appeal proceedings	721
3.4.	Time limit	722
3.4.1	Time limit for intervention	722
3.4.2	Other time limits	722
3.5.	Assessment of procedural act	723
4.	Article 115 EPC	723
4.1.	General principles	723
4.2.	Who can make observations	724
4.3.	Time limit for observations under Article 115 EPC	724
4.3.1	General	724
4.3.2	Observations by third parties and Article 114(2) EPC	725
4.4.	Extent of scrutiny	725
4.4.1	Article 114 (1) and Article 115 EPC	725
4.5.	The nature of the observations	726
4.6.	The form the observations should take	727
4.7.	The legal position of the third party	727
4.8.	Miscellaneous provisions where Article 115 EPC is considered	728
4.8.1	Amendment of the European patent application	728
4.8.2	Interlocutory decisions in examination proceedings	728
4.8.3	Substantial procedural violation	729
4.9.	Remittal following filing of observations	729
5.	Transfer of party status	729
5.1.	Party status as opponent	729
5.1.1	Substantive requirements	729
5.1.2	Formal requirements	731
5.1.3	The Enlarged Board's decision in G 2/04	733
5.1.4	Individual cases dealing with the legal validity of transfers	734
5.2.	Party status as proprietor	736
6.	Limitation, revocation, surrender or lapse of the patent	737
6.1.	Limitation/revocation	737
6.1.1	Limitation/Revocation - Article 105a-c EPC	737
6.1.2	Requests for revocation during opposition and opposition appeal proceedings	737
6.2.	Surrender, lapse and expiry of the patent	739

6.2.1	Surrender of patent	739
6.2.2	Continuation of the opposition proceedings (Rule 84(1) EPC)	739
6.2.3	Cases concerning termination of opposition appeal proceedings	739
6.2.4	Cases concerning continuation of opposition appeal proceedings	740
7.	Apportionment of costs	740
7.1.	Principle that each party must bear its own costs	740
7.2.	Equity of a different apportionment of costs – case groups	741
7.2.1	Late submission of documents and/or requests	742
7.2.2	Acts or omissions prejudicing the timely and efficient conduct of oral proceedings	749
7.2.3	Abuse of procedure	756
7.3.	Procedural aspects	760
7.3.1	Filing a request for apportionment of costs	760
7.3.2	Competence issues	760
7.3.3	Apportionable costs	761
7.3.4	Appeal solely against the decision on costs inadmissible	762
D.	Opposition procedure	763
1.	Legal nature of opposition proceedings	763
1.1.	Introduction	763
1.2.	Contentious inter partes proceedings	764
1.3.	Only one opposition procedure where multiple oppositions	765
2.	Admissibility of the opposition	765
2.1.	Entitlement to file an opposition	765
2.1.1	Introduction	765
2.1.2	Opponent's motives irrelevant	766
2.1.3	Filing of opposition by patent proprietor or inventor	766
2.1.4	Filing of opposition on behalf of a third party - straw man	767
2.1.5	Repeated filing of an opposition by the same person	768
2.1.6	Admissibility of a joint opposition - multiple opponents	769
2.2.	Formal requirements for opposition and filing in due time	771
2.2.1	Fundamentals	771
2.2.2	Identity of the opponent	772
2.2.3	Title of the invention	773
2.2.4	Payment of the opposition fee	773
2.2.5	Other requirements	774
2.3.	Substantiation of the opposition	774
2.3.1	Legal basis for the opposition	774
2.3.2	Need to indicate facts and evidence	775
2.3.3	Various cases	778
2.3.4	Public prior use alleged in the opposition	782
2.4.	Procedural aspects of the examination of admissibility	784
3.	Substantive examination of the opposition	785
3.1.	Basic principles	785
3.2.	Examination of the legal framework of the opposition	785
3.2.1	Extent of opposition	785

3.2.2	Scope of examination of the grounds for opposition	787
3.2.3	Fresh grounds for opposition	789
3.3.	Examination of the factual framework of the opposition	796
4.	Amendments in opposition proceedings	797
4.1.	Admissibility	797
4.1.1	Basic principles	797
4.1.2	Filing date of amendments	799
4.1.3	Filing amended claims	800
4.1.4	Amendments intended to remedy a lack of clarity	804
4.2.	Substantive examination of amendments	806
4.3.	Additional search in the case of amendments	808
5.	Procedural aspects	809
5.1.	Principle of impartiality	809
5.2.	Right to be heard	809
5.2.1	Principle of equal treatment and opportunity to make comments	809
5.2.2	Invitation to file observations	810
5.2.3	Communication and invitation to file observations under R. 82(1) EPC (Rule 58(4) EPC 1973)	812
5.2.4	EPO communications to "take note" and sufficient time to submit a response	813
5.2.5	Opportunity to comment - case groups	815
5.3.	Acceleration of proceedings in the case of pending infringement proceedings	818
6.	Decisions of the opposition division	818
6.1.	Revocation of a European patent by way of a decision	818
6.2.	Interlocutory decisions	819
6.2.1	General	819
6.2.2	Maintenance of the European patent as amended	820
E.	Appeal procedure	821
1.	Legal character of appeal procedure	821
2.	Suspensive effect of the appeal	822
3.	Devolutive effect of the appeal	823
4.	Language of the proceedings	824
5.	Procedural status of the parties	825
5.1.	Parties to appeal proceedings	825
5.2.	Rights of parties under Article 107 EPC	826
6.	Extent of scrutiny	827
6.1.	Binding effect of requests - no reformatio in peius	828
6.2.	Subject-matter under examination	832
6.3.	Patentability requirements under examination	835
6.3.1	Ex parte proceedings	835
6.4.	Facts under examination - applying Article 114 EPC in appeal proceedings	836
6.5.	Arguments under examination	837
6.6.	Review of first-instance discretionary decisions	838

7.	Filing and admissibility of the appeal	838
7.1.	Transitional provisions	838
7.2.	Appealable decisions	839
7.2.1	Departments	839
7.2.2	Decisions	839
7.2.3	Interlocutory decisions	841
7.2.4	Appeals against decisions of the boards of appeal	841
7.3.	Board competent to hear a case	842
7.4.	Entitlement to appeal	843
7.4.1	Formal aspects	843
7.4.2	Party adversely affected	844
7.5.	Form and time limit of appeal	849
7.5.1	Electronic filing of appeal	849
7.5.2	Form and content of notice of appeal	850
7.5.3	Appeal filed within the time limit	853
7.5.4	Payment of appeal fee	854
7.6.	Statement of grounds of appeal	854
7.6.1	General principles	854
7.6.2	Exceptions to these principles	856
7.6.3	Change of circumstances after delivery of the decision	859
7.6.4	Reference to an earlier submission	859
7.6.5	References to other documents	860
8.	Parallel proceedings	860
9.	Conclusion of the decision-making process	860
9.1.	Closure of the substantive debate	860
9.2.	Decision taken as the file stands	861
9.3.	Proceedings after delivery of the decision	861
9.4.	Interlocutory decisions of a board	862
10.	Remittal to the department of first instance	862
10.1.	General	862
10.2.	Remittal following filing or late submission of relevant new document	862
10.2.1	General	862
10.2.2	Patent in jeopardy	864
10.2.3	New facts	864
10.3.	Remittal following substantial amendment to claims in the appeal proceedings	865
10.4.	Remittal following a substantial procedural violation	867
10.5.	Introduction of new arguments and amendment of the description	868
10.6.	Exercise of discretion to remit	868
11.	Binding effect	869
11.1.	General principles	869
11.2.	Type of remittal	871
11.2.1	Remittal only for adaptation of the description	871
11.2.2	Remittal for the continuation of proceedings	872
12.	Termination of appeal proceedings	873
12.1.	Withdrawal of the appeal	873
13.	Interlocutory revision	875

13.1.	General	875
13.2.	Reimbursement of appeal fee	876
13.3.	Substantial procedural violation	877
14.	Referral to the Enlarged Board of Appeal	878
14.1.	Ensuring uniform application of the law	879
14.2.	Important points of law	880
14.3.	Suspension of first-instance proceedings following referral to Enlarged Board	881
15.	Petition for review under Article 112a EPC	882
15.1.	General	882
15.2.	Transitional provisions	883
15.3.	Obligation to raise objections in accordance with Rule 106 EPC	883
15.4.	Contents of the petition for review in accordance with Rule 107 EPC	884
15.5.	Procedure in dealing with petitions for review in accordance with Rule 109 EPC	884
15.6.	Fundamental violation of Article 113 EPC	885
15.7.	Any other fundamental procedural defect	887
16.	Filing of amended claims in appeal proceedings	888
16.1.	Introduction	888
16.1.1	General principles	888
16.1.2	Rules of Procedure of the Boards of Appeal (RPBA)	889
16.2.	Inter partes appeals	889
16.2.1	Principles	889
16.2.2	Requests not examined by the opposition division	890
16.2.3	Dependent claims	891
16.3.	State of proceedings	892
16.3.1	General	892
16.3.2	Amendments after arrangement of the oral proceedings	893
16.3.3	Filing of requests during the oral proceedings	894
16.4.	Criteria for consideration of amended claims	897
16.4.1	Clear allowability of amended claims	897
16.4.2	Response to objections	898
16.4.3	Exercise of discretion	900
16.5.	Criteria for refusal to consider amended claims	901
16.5.1	Complexity of the amended claims	901
16.5.2	Change of subject-matter	902
16.5.3	Need for additional search	902
16.5.4	Principle of procedural economy	902
16.5.5	Amended claims not admitted with divisional applications pending	903
16.6.	Reinstating broader claims in appeal proceedings	904
16.6.1	General	904
16.6.2	Ex parte proceedings	904
16.6.3	Inter partes proceedings	904
16.7.	Circumstances extraneous to proceedings	906
16.7.1	Introduction	906
16.7.2	Change of party or representative	906
17.	Reimbursement of appeal fees	907

17.1.	General issues	908
17.2.	Allowability of the appeal	909
17.3.	Fairness	909
17.3.1	Reimbursement held to be equitable	910
17.3.2	Reimbursement held not to be equitable	910
17.4.	Substantial procedural violation	912
17.4.1	Definition	912
17.4.2	Request for oral proceedings	913
17.4.3	Right to be heard	914
17.4.4	Inadequate reasons given in the decision at first instance	919
17.4.5	Error of judgment by a department of first instance	921
17.4.6	Miscellaneous other cases	923
17.5.	Interlocutory revision	928
VIII.	PROCEEDINGS BEFORE THE DISCIPLINARY BOARD OF APPEAL	931
1.	Introduction	931
2.	European qualifying examination	932
2.1.	Formalities and conditions for enrolment	932
2.2.	Examination conditions	934
2.3.	Marking the answer papers	935
2.4.	Grades / passing the examination	937
2.5.	Substantiation of EQE decisions	937
2.6.	Appeals against decisions of the Examination Board and the Examination Secretariat	938
2.6.1	Competence of the board of appeal	938
2.6.2	Time limit for appeal / rectification of decisions	938
2.6.3	Objective review of the marks awarded	939
2.6.4	Legitimate interest	941
2.6.5	Duties of the Examination Board	941
3.	Disciplinary matters	941
3.1.	Disciplinary measures	942
3.2.	Appealability of decisions in disciplinary matters	943
4.	Code of Professional Conduct	943
4.1.	General professional obligations	943
4.2.	Professional secrecy	944
4.3.	Advertising	944
5.	Appeals against decisions of the Disciplinary Board of Appeal	944
IX.	THE EPO ACTING AS A PCT AUTHORITY	945
A.	Competence of the boards of appeal in protest proceedings under the PCT	945
1.	The transition to the simplified protest procedure	945

B.	The EPO as designated or elected Office	946
1.	Changes of procedure introduced with the revision of the EPC	947
2.	The competence of the EPO acting as designated or elected Office	947
3.	Language of the proceedings	949
X.	INSTITUTIONAL MATTERS	951
1.	Administrative Agreement with the German Patent Office	951
2.	Power under Article 23(4) EPC to amend the RPBA	952
3.	Extension Ordinances on the extension of European patents	953
4.	Referrals to the Court of Justice of the European Communities under the EC Treaty - legal status of the EPO boards of appeal	954
	TABLE OF CASES	957
	Decisions of the Disciplinary Board	957
	Decisions and opinions of the Enlarged Board of Appeal on referrals	958
	Decisions of the Legal Board of Appeal	959
	Decisions of the Enlarged Board of Appeal on petitions for review	963
	Decisions of the technical boards of appeal	964
	PCT Protests	1006
	INDEX OF CITED PROVISIONS	1009
1.	European Patent Convention	1009
	EPC 2000 – articles	1009
	EPC 1973 – articles	1011
2.	Implementing Regulations to the EPC	1016
	EPC 2000 – rules	1016
	EPC 1973 – rules	1019
3.	Rules relating to Fees	1022
4.	Patent Cooperation Treaty (articles and rules)	1022
	PCT Articles	1022
	PCT Rules	1022
5.	Regulation on the European qualifying examination for professional representatives	1023
6.	Regulation on discipline for professional representatives	1023
7.	RPEBA	1024
8.	RPBA	1024

ANNEXES	1025
1. Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office	1025
2. Rules of Procedure of the Boards of Appeal of the European Patent Office	1033
3. Transitional provisions	1043
4. Cross-reference list EPC 1973 - EPC 2000	1045
5. General Index	1051

Reader's Guide

1. Abbreviations

Art.	Article
BlfPMZ	Blatt für Patent-, Muster- und Zeichenwesen (German periodical)
Budapest Treaty	Budapest Treaty on the International Recognition of the Deposit of Microorganisms
CAFC	US Court of Appeal for the Federal Circuit
cf.	compare
Corr.	Corrigendum
DBA	Disciplinary Board of Appeal
DG	Directorate General of the European Patent Office
DPMA	German Patent Office
EC	European Community
ed.	edition
eg	for example
EPC	European Patent Convention
epi	European Patent Institute (Institute of Professional Representatives before the European Patent Office)
EPO	European Patent Office
EQE	European Qualifying Examination
et seq.	and the following
GRUR	Zeitschrift für gewerblichen Rechtsschutz und Urheberrecht (German periodical)
Guidelines	Guidelines for Examination in the European Patent Office
ie	that is
IPEA	International Preliminary Examining Authority
IPER	International Preliminary Examination Report
IRB	International Patent Institute
IRPI	French Institute for Research into Intellectual Property
ISA	International Searching Authority
ISPE Guidelines	International Search and Preliminary Examination Guidelines
no.	number
OJ	Official Journal of the European Patent Office
OJ SE	Special Edition of the Official Journal of the European Patent Office
Paris Convention	Paris Convention for the Protection of Industrial Property
PCT	Patent Cooperation Treaty
R.	Rule
RDR	Regulation on Discipline for Professional Representatives
REE	Regulation on the European Qualifying Examination for Professional Representatives
rev.	revised
RPBA	Rules of Procedure of the Boards of Appeal
RPEBA	Rules of Procedure of the Enlarged Board of Appeal
RFees	Rules relating to Fees
TRIPS	Agreement on Trade-related Aspects of Intellectual Property Rights

UPOV	International Union for the Protection of New Varieties of Plants
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization

2. Citations

(a) The articles and rules of the EPC referred to are in the version valid at the time the decision was given.

(b) The text of the EPC as revised in 2000 and which entered into force in 2007 is cited without the attribute "2000". The text valid before that is cited as "EPC 1973".

(c) The Official Journal of the EPO is cited as OJ, followed by the year of publication and page number (eg OJ 1993, 408).

(d) If a decision of a board of appeal has been **published** in the OJ the reference is given.

If a decision has **not** been **published** in the OJ, normally only the case number is cited.

In the table of cases, the bibliographic data of all cited decisions (ie reference number, the board which took the decision, the date of the decision, and - where applicable - the citation in the OJ) are listed.

3. Case numbers

The case numbers comprise a **letter** followed by a sequence of **numbers**:

G	Decisions and opinions of the Enlarged Board of Appeal on referrals
R	Decisions of the Enlarged Board of Appeal on petitions for review
J	Decisions of the Legal Board of Appeal
T	Decisions of a Technical Board of Appeal
W	Decisions of a Technical Board of Appeal on protests under R. 40.2 or 68.3 PCT
D	Decisions of the Disciplinary Board of Appeal

The number before the oblique is a **serial number**, allocated by chronological order of receipt in DG 3. The two numbers after the oblique indicate the **year of receipt** of the appeal in DG3.

Headnote of opinion G 3/08

The headnote is published in the language of the proceedings only.

1. In exercising his or her right of referral a President of the EPO is entitled to make full use of the discretion granted by Art. 112(1)(b) EPC, even if his or her appreciation of the need for a referral has changed after a relatively short time.

2. Different decisions by a single Technical Board of Appeal in differing compositions may be the basis of an admissible referral by the President of the EPO of a point of law to the Enlarged Board of Appeal pursuant to Art. 112(1)(b) EPC.

3. As the wording of Art. 112(1)(b) EPC is not clear with respect to the meaning of “different/abweichende/ divergent” decisions the provision has to be interpreted in the light of its object and purpose according to Article 31 of the Vienna Convention on the Law of Treaties (VCLT). The purpose of the referral right under Art. 112(1)(b) EPC is to establish uniformity of law within the European patent system. Having regard to this purpose of the presidential right to refer legal questions to the Enlarged Board of Appeal the notion “different decisions” has to be understood restrictively in the sense of “conflicting decisions”.

4. The notion of legal development is an additional factor which must be carefully considered when interpreting the notion of “different decision” in Art. 112(1)(b) EPC. Development of the law is an essential aspect of its application, whatever method of interpretation is applied, and is therefore inherent in all judicial activity. Consequently, legal development as such cannot on its own form the basis for a referral, only because case law in new legal and/or technical fields does not always develop in linear fashion, and earlier approaches may be abandoned or modified.

5. Legal rulings are characterised not by their verdicts, but by their grounds. The Enlarged Board of Appeal may thus take obiter dicta into account in examining whether two decisions satisfy the requirements of Art. 112(1)(b) EPC.

6. T 424/03, Microsoft does deviate from a view expressed in **T 1173/97**, IBM, concerning whether a claim to a program on a computer-readable medium necessarily avoids exclusion from patentability under Art. 52(2) EPC. However this is a legitimate development of the case law and there is no divergence which would make the referral of this point to the Enlarged Board of Appeal by the President admissible.

7. The Enlarged Board of Appeal cannot identify any other inconsistencies between the grounds of the decisions which the referral by the President alleges are divergent. The referral is therefore inadmissible under Art. 112(1)(b) EPC.

I. PATENTABILITY

The four essential pre-conditions governing the patentability of inventions under the EPC are laid down in Art. 52(1) EPC, which reads: "European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application."

A. Patentable inventions

1. Patent protection for technical inventions

The revised version of the EPC ("EPC 2000") came into effect on 13 December 2007. During the course of the revision of the EPC, Art. 52(1) EPC was brought into line with Art. 27(1), first sentence, of the TRIPS Agreement with a view to enshrining the word "technology" in the basic provision of substantive European patent law, clearly defining the scope of the EPC, and **explicitly** stating in the law that patent protection is available to **technical inventions of all kinds**. The new wording of Art. 52(1) EPC plainly expresses that patent protection is reserved for creations in the technical field (see OJ SE 4/2007, 48). The revised Art. 52 EPC applies to European patents granted and European patent applications pending on 13 December 2007 and to applications filed on or after that date. The amendment is unlikely to affect the practice of the EPO.

Art. 52(2) EPC contains a non-exhaustive list of **"non-inventions"**, that is, subject-matter or activities not to be regarded as inventions within the meaning of paragraph 1. Excluded under this provision are **in particular**: (a) discoveries, scientific theories and mathematical methods; (b) aesthetic creations; (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers; (d) presentations of information. The exclusion from patentability of the subject-matter or activities referred to applies only to the extent that a European patent application or European patent relates to such subject-matter or activities **as such** (Art. 52(3) EPC; see also OJ SE 4/2007). The EPC 2000 made no substantive changes to Art. 52(2) or (3) EPC, merely minor editorial corrections.

1.1. Technical character of an invention

It has been part of the European legal tradition that patent protection should be reserved for technical creations (see e. g. **T 22/85**, OJ 1990, 12; **T 154/04**, OJ 2008, 46). The use of the term "invention" in Art. 52(1) EPC 1973 in conjunction with the so-called "exclusion provisions" of Art. 52(2) and (3) EPC 1973 was interpreted by the boards of appeal as **implying** a requirement of technical character or technicality to be fulfilled by an invention as claimed in order to be patentable. Thus an invention may be an invention within the meaning of Art. 52(1) EPC if, for example, a technical effect is achieved by the invention or if **technical considerations** are required to carry out the invention. The term "invention" is to be construed as "subject-matter having technical character" (**T 931/95**, OJ 2001, 441; **T 258/03**, OJ 2004, 575; **T 619/02**, OJ 2007, 63). According to **T 930/05**, the mere fact that the list of items not to be regarded as inventions in accordance with Art. 52(2) EPC 1973 was non-exhaustive, ("in particular"), indicated that

there was a common criterion for exclusion which these items shared and which could serve as the basis for possible additions to the list. The enumeration of typical non-inventions in Art. 52(2) EPC 1973 covered subjects whose common feature was a lack of technical character. The catalogue of exclusions under Art. 52(2) EPC 1973, with its reference to Art. 52(1) EPC 1973, was to be regarded as a negative definition of the concept of invention.

Under the EPC 2000, the new wording of Art. 52(1) EPC plainly expresses that patent protection is reserved for inventions in the **technical** field. In order to be patentable, the subject-matter claimed must therefore have a "technical character" or, to be more precise, involve a "technical teaching", i.e. an instruction addressed to a skilled person as to how to solve a particular technical problem using particular technical means (see OJ SE 4/2007).

In **T 1173/97** (OJ 1999, 609) and **T 935/97** the board stated that within the context of the application of the EPC the technical character of an invention was generally accepted as an essential requirement for its patentability. In **T 931/95** (OJ 2001, 441) the board held that technical character was an implicit requirement of the Convention to be met by an invention in order to be an invention within the meaning of Art. 52(1) EPC 1973, following decisions **T 1173/97** and **T 935/97** (see also **T 1543/06**).

In **T 619/02** (OJ 2007, 63) the board stated that, as had long been accepted, (see in this respect decisions **T 22/85**, OJ 1990, 12, **T 931/95**, OJ 2001, 441, and **T 258/03**, OJ 2004, 575), the technical character of an invention constituted a fundamental prerequisite inherent to Art. 52 EPC 1973 - and was formulated as an explicit requirement in Art. 52(1) EPC. Thus, technical character constituted a ***conditio sine-qua-non*** to be met by an invention susceptible of patent protection under the EPC.

In **T 154/04** (OJ 2008, 46) the board summarised the main principles underlying the relevant jurisprudence of the boards of appeal. The board held that "technical character" was an **implicit requisite** of an "invention" within the meaning of Art. 52(1) EPC 1973 (requirement of "technicality"). Art. 52(2) EPC 1973 did not exclude from patentability any subject matter or activity having a technical character, even if linked to items listed in this provision since these items were **only excluded "as such"** (Art. 52(3) EPC 1973). In examining the patentability of an invention in respect of a claim, the claim had to be construed to determine the technical features of the invention, i.e. the features which contributed to the technical character of the invention (see also **T 931/95**, OJ 2001, 441, **T 914/02** and **T 1543/06**). The board observed that the intention of Art. 52(3) EPC 1973 was clearly to ensure that anything which had previously been a patentable invention under conventional patentability criteria should remain patentable under the European Patent Convention. Taking into account the object and purpose of the patentability requirements and the legal practice in the contracting states to the EPO, the boards of appeal had considered the technical character of the invention to be the underlying criterion required by paragraphs 2 and 3 of Art. 52 EPC 1973. It had indeed always been common ground that creations in engineering and technology were entitled to patent protection under the European Patent Convention. The enumeration of typical "non-inventions" in Art. 52(2) EPC 1973 covered subjects whose common feature was a lack

of technical character. The formulation of the law was ultimately derived from the classical notion of invention adopted, which distinguished between practical scientific applications and intellectual achievements in general.

1.2. Separate and independent patentability requirements

According to **T 154/04** (OJ 2008, 46), it was clear from the wording of Art. 52(1) EPC 1973 and the use of the term "invention" in the context of the criteria for patentability, that the requirements of invention, novelty, inventive step, and susceptibility of industrial application were separate and independent criteria, which might give rise to concurrent objections under any of these requirements. Novelty, in particular, was not a requisite of an invention within the meaning of Art. 52(1) EPC 1973, but a separate patentability requirement. This construction of Art. 52(1) EPC 1973 had a clear basis in the case law of the Enlarged Board of Appeal (**G 2/88** (OJ 1990, 93), points 7.2, 7.3 and 8 of the Reasons, and **G 1/95** (OJ 1996, 615), points 4 ff. of the Reasons).

In **T 1543/06** of 29 June 2007 the board stated that Art. 52(1) EPC 1973 in conjunction with Arts. 52(2) and (3) EPC 1973 was generally interpreted as implying that a technical character was required in order for a claimed invention to be patentable (see Case Law of the Boards of Appeal of the EPO, Edition 2006). Whereas the technical character was previously assessed using the "contribution approach", recent case law had abandoned this approach in favour of one which recognised the requirement of technical character as separate from, and independent of, the remaining requirements of Art. 52(1) EPC 1973, in particular novelty and inventive step, compliance with which could therefore be assessed without having recourse to the prior art.

1.3. Absolute and relative patentability requirements

In **T 154/04**, OJ 2008, 46, the board also indicated that the examination of whether there was an invention within the meaning of Art. 52(1) to (3) EPC 1973 should be strictly separated from and not confused with the examination of the other three patentability requirements referred to in Art. 52(1) EPC 1973. It distinguished the concept of "invention" as a general and absolute requirement of patentability from a) the relative criteria, novelty and inventive step, (which, in an ordinary popular sense, were understood to be the attributes of any invention), and b) the requirement of industrial applicability. Decisive for the presence of a (potentially patentable) invention was the inherent character of the claimed subject-matter. The distinction between the absolute requirement of invention and the relative requirements of novelty and inventive step was not unknown in national case law. See for example, the Court of Appeal (England and Wales) in the judgment in *re Genentech Inc.'s Patent* [1989] R.P.C. 147, pages 262 f, the German Federal Court of Justice (Supreme Court) in decision X ZB 20/03 - *Elektronischer Zahlungsverkehr* [Electronic banking] of 24 May 2004 (points II 3. b) (1) and II 4 of the Reasons). These views were entirely consistent with the legal concept of "invention" applied by the board in the context of Art. 52(1) to (3) EPC 1973, which had not to be confused with the layman's ordinary understanding of an invention as a novel, and often also inventive, contribution to the known art. Using these two very different concepts of an invention in one breath would be a legal fallacy.

1.4. Examination of subject-matter or activities under Article 52 EPC

According to **T 258/03** (OJ 2004, 575), the verification that claimed subject-matter was an invention within the meaning of Art. 52(1) EPC 1973 was, in principle, a prerequisite for the examination in respect of novelty, inventive step and industrial application, since these latter requirements were defined only for inventions (see Art. 54(1), 56, and 57 EPC 1973). The structure of the EPC therefore suggested that it should be possible to determine whether subject-matter was excluded under Art. 52(2) EPC 1973 without any knowledge of the state of the art (including common general knowledge) (see also **T 154/04**, OJ 2008, 46).

1.4.1 Examination independent of the contribution of the invention

In order to assess whether the claimed subject-matter was an invention within the meaning of Art. 52(1) EPC 1973, the boards of appeal applied, in their earlier case law, the so-called "contribution approach", according to which an invention had a technical character if it provided a technical contribution to the state of the art in a field not excluded from patentability under Art. 52(2) EPC 1973 (see **T 121/85**, **T 38/86**, OJ 1990, 384; **T 95/86**, **T 603/89**, OJ 1992, 230; **T 71/91**, **T 236/91**, **T 833/91**, **T 77/92**). The idea behind the so-called contribution approach applied by earlier jurisprudence of the boards of appeal was that the EPC 1973 only permitted patenting "in those cases in which the invention involves some contribution to the art in a field not excluded from patentability" (**T 38/86**, OJ 1990, 384). In other words, in order to assess the first requirement, i.e. the presence of an invention within the meaning of Art. 52(1) EPC 1973, a criterion was established which relied on meeting further requirements mentioned in that Article, in particular novelty and/or inventive step. Thus, some prior art was taken into account when determining whether subject-matter was excluded under Art. 52(2) and (3) EPC 1973 (see **T 769/92**, OJ 1995, 525).

However, in more recent decisions of the boards, any comparison with the prior art was found to be inappropriate for determining whether or not an invention was present. In **T 1173/97** (OJ 1999, 609) the board held that determining the technical contribution an invention achieves with respect to the prior art is more appropriate for the purpose of examining novelty and inventive step than for deciding on possible exclusion under Art. 52(2) and (3) EPC 1973. In **T 931/95** (OJ 2001, 441) it was stated that there is no basis in the EPC for distinguishing between "new features" of an invention and features of that invention which are known from the prior art, when examining whether the invention concerned may be considered to be an invention within the meaning of Art. 52(1) EPC 1973. Thus there is no basis in the EPC for applying the so-called contribution approach for this purpose (see also **T 258/03**, OJ 2004, 575; and **T 1001/99**).

In **T 388/04** (OJ 2007, 16), the board held that the extent to which subject-matter or activities are excluded from patentability under Art. 52(2) and (3) EPC 1973 was notionally distinct from, and could be considered independently of the question of inventive step. Therefore, the board felt free to assess the extent to which the claimed method was excluded from patentability before any examination of inventive step. No technical means were described in the application at all.

In **T 619/02** (OJ 2007, 63) the board held that the technical character of an invention was an inherent attribute independent of the actual contribution of the invention to the state of the art (**T 931/95**, OJ 2001, 441, and **T 258/03**) and consequently the potential of the claimed method to solve a problem of a technical nature should be discernible from the aspects of the method actually claimed.

1.4.2 Technical considerations

There might be an invention within the meaning of Art. 52(1) EPC 1973 if, for example, a **technical effect was achieved** by the invention or if **technical considerations were required** to carry out the invention (see **T 931/95**, OJ 2001, 441).

T 769/92 (OJ 1995, 525) concerned an invention relating to the internal functioning of a computer. In this decision (commented on in **T 1173/97**, OJ 1999, 609) the fact that technical considerations were required in order to arrive at the invention was considered to **lend sufficient technical character** to the invention as claimed for it to avoid exclusion from patentability under Art. 52(2)(c) and (3) EPC 1973, whereas no importance was attributed to the specific use of the system as a whole. The board held that an invention comprising functional features implemented by software (computer programs) was not excluded from patentability under Art. 52(2)(c) and (3) EPC 1973 if technical considerations concerning particulars of the solution of the problem the invention solved were required in order to carry out that same invention. Such technical considerations lent a technical nature to the invention in that they implied a technical problem to be solved by (implicit) technical features. An invention of this kind was considered not to pertain to a computer program as such for the purpose of Art. 52(3) EPC 1973. As stated in the decision, non-exclusion from patentability could not be destroyed by an **additional feature** which as such would itself be excluded.

In **T 914/02** the board stated that having technical character was an implicit requirement of the Convention to be met by an invention within the meaning of Art. 52(1) EPC 1973. The involvement of technical considerations, however, was **not sufficient** for a method, which might exclusively be carried out mentally, to have technical character. In fact, other non-inventions listed in Art. 52(2) EPC 1973, such as scientific theories, but also computer programs, typically involved technical considerations. Technical character could be provided through the technical implementation of the method, resulting in the method providing a tangible, technical effect, such as the provision of a physical entity as the resulting product, or a non-abstract activity, such as through the use of technical means.

In **T 38/86** (OJ 1990, 384) the board stated that the **use of technical means** for carrying out a method, partly or entirely without human intervention, which, if performed by a human being, would require him to perform mental acts, **might**, having regard to Art. 52(3) EPC 1973, **render** such a method a technical process or method and thus an invention within the meaning of Art. 52(1) EPC 1973.

In **T 641/00** (OJ 2003, 352) the board held that an invention within the meaning of Art. 52 EPC 1973 could **only be made up of those features** which contributed to the technical character.

In **T 172/03** the board noted that, according to the case law and practice of the EPO, the patentability of an invention, for which inventive step was a requirement, had to arise from **features and aspects of the invention** from which a technical solution to a technical problem could be inferred and which were thus of a **technical character** (see e.g. **T 931/95**, OJ 2001, 441 and **T 641/00**, OJ 2003, 352). In the case of a **mixed-type invention** (including non-technical aspects), examination for patentability normally required an analysis of the invention and the construction of the claims to determine the technical content of the claims as a prerequisite step (see, in respect of inventive step, **T 931/95** and **T 641/00**, OJ 2003, 352). The required analysis of claim features was possible only *ex post facto*, i.e. with knowledge of the patent application and the invention to which it related.

In **T 471/05** the board noted that the criteria for the technical character of a claimed invention implicitly presupposed that the claimed subject-matter defining the matter for which protection was sought related to a physical entity or a physical activity (see **T 619/02**). The board observed that it could not be denied that the method defined in claim 1 of the main request could be carried out using some physical means (e.g. a block of optical material to be gradually shaped into an optical system so as to satisfy the algebraic condition specified in the claim), or using some technical means (e.g. a computer to determine the optical specifications of the optical system design), or in the form of a physical activity that resulted in a physical entity (e.g. when the claimed step of "making a design of the optical system" was implemented by the manufacture of the design as actually claimed in claim 5), and that such implementations of the claimed method constituted physical, technical activities not excluded from patent protection (see, for instance, decisions **T 914/02** and **T 258/03**, OJ 2004, 575). Nonetheless, the board found that the claimed method did not require the use of technical means and, as noted above, **the method was not restricted to physical, technical implementations**, and the fact that the claimed method encompassed non-excluded implementations such as those mentioned above did not overcome the fact that the claimed method also encompassed excluded subject-matter (**T 914/02**, points 2 and 3; **T 388/04**, OJ 2007, 16; **T 453/91** and **T 930/05**). Thus, as long as the claimed design method was not confined to physical, technical implementations, the claimed subject-matter encompassed embodiments excluded from patentability under Art. 52(1) to 52(3) EPC 1973 and was not entitled to patent protection under the EPC.

In **T 306/04** the board pointed out that **the mere possibility** of serving a technical purpose or of solving a technical problem was not sufficient to avoid exclusion under Art. 52(2) and (3) EPC 1973 (see also **T 388/04**, OJ 2007, 16).

In **T 258/03** (OJ 2004, 575) the board held that a method involving technical means was an invention within the meaning of Art. 52(1) EPC 1973 (as distinguished from decision **T 931/95**, OJ 2001, 441). The board stated that what mattered, having regard to the concept of "invention" within the meaning of Art. 52(1) EPC 1973, was the presence of

technical character which could be inferred from the physical features of an entity or the nature of an activity, or could be conferred on a non-technical activity by the use of technical means. In particular, the board held that the latter could not be considered to be a non-invention "as such" within the meaning of Art. 52(2) and (3) EPC 1973. Hence, in the board's view, activities falling within the concept of a non-invention "as such" would typically represent purely abstract concepts devoid of any technical implications. The board stated that its comparatively broad interpretation of the term "invention" in Art. 52(1) EPC 1973 would include activities which are so familiar that their technical character tends to be overlooked, such as the act of writing using pen and paper. However, this did not imply that all methods involving the use of technical means were patentable. They still have to be new, represent a non-obvious technical solution to a technical problem, and be susceptible of industrial application.

In **T 619/02** (OJ 2007, 63) the board noted that a technical invention is generally useful and practical within the generic meaning of these terms, but the reverse is not necessarily true, i.e. not every "practical art" and not every entity or activity that is practical or useful is necessarily technical in the patent law sense (see **T 388/04**, OJ 2007, 16). It was noted that in some national patent law systems, "useful" is the counterpart to the requirement of industrial applicability set out in Art. 57 EPC 1973 (see TRIPS Agreement, Note 5 to Art. 27(1)); however, this special meaning of the term does not necessarily convey technical character either. Accordingly, considerations of usefulness and practicality are no substitute for, or criteria equivalent to the prerequisite of technical character inherent in the EPC. Similar considerations applied to the appellant's further contention that the result of the method was saleable and could be commercialised. The board concluded that neither the fact that the result of the claimed method might be usable in a technical or in an industrial activity, nor the fact that the result may be qualified as being useful, practical or saleable expressed a sufficient condition to establish the technical character either of the result of the method, or of the method itself.

The board stated that in addition - and independently of the possible conceptual connections between the concept of technical character and the (non-exhaustive) list of exclusions under Art. 52(2) EPC 1973, the prerequisite of technical character inherent in the EPC amounted to the exclusion from patent protection of entities, activities, etc. that did not qualify as technical. Accordingly, the prerequisite of **technical character could not be considered to be fulfilled** by an invention which, although possibly encompassing technical embodiments, also encompassed ways of implementing it that did not qualify as technical. It followed that an invention was susceptible of patent protection within the meaning of Art. 52(1) EPC 1973 if, and only if the invention as claimed included aspects that imparted technical character to essentially all ways of performing the invention. An analogous condition applied in fact to the exclusions from patentability under Art. 52(2) EPC 1973, as illustrated by decision **T 914/02**, in which the corresponding board rejected a claim directed to an invention involving technical considerations and encompassing technical embodiments (point 3 of the Reasons) on the grounds that the invention as claimed could also be exclusively performed by purely mental acts excluded from patentability under Art. 52(2)(c) EPC 1973.

1.5. Inventions with technical and non-technical subject-matter

Mixed inventions are inventions having both technical and non-technical features, where "non-technical" relates to matter which, under Art. 52(2) EPC, is not to be regarded as an invention within the meaning of Art. 52(1) EPC (**T 1543/06**).

In **T 154/04** (OJ 2008, 46) the board stated that in examining the patentability of an invention in respect of a claim, the claim must be construed to determine the technical features of the invention, i.e. the features which contribute to the technical character of the invention. It is legitimate to have a **mix of technical and "non-technical" features** appearing in a claim, in which the non-technical features may even form a dominating part of the claimed subject matter. Novelty and inventive step, however, can be based only on technical features, which thus have to be clearly defined in the claim. Non-technical features, to the extent that they do not interact with the technical subject-matter of the claim, solve a technical problem, i.e. non-technical features "as such", do not provide a technical contribution to the prior art and are thus ignored in assessing novelty and inventive step (see also **T 641/00**, OJ 2003, 352, **T 1505/05**). A summary of the methodology applied by the boards of appeal can be found in **T 1543/06**.

In **T 258/03** (OJ 2004, 575) the board noted that taking into account both the fact that a mix of technical and non-technical features may be regarded as an invention within the meaning of Art. 52(1) EPC 1973, and the fact that **prior art should not be considered** when deciding whether claimed subject-matter is such an invention, a compelling reason for not refusing subject-matter consisting of technical and non-technical features under Art. 52(2) EPC 1973 is simply that the technical features may in themselves turn out to fulfil all the requirements of Art. 52(1) EPC 1973. Moreover, it is often difficult to separate a claim into technical and non-technical features, and an invention may have technical aspects which are hidden in a largely non-technical context. Such technical aspects may be easier to identify within the framework of the examination as to inventive step, which, in accordance with the jurisprudence of the boards of appeal, is concerned with the technical aspects of an invention. Thus, in addition to the restrictive wording of Art. 52(3) EPC 1973 limiting the applicability of Art. 52(2) EPC 1973, there may be practical reasons for generally regarding mixes of technical and non-technical features as inventions within the meaning of Art. 52(1) EPC 1973.

In **G 1/04** (OJ 2006, 334) the Enlarged Board referred to **T 603/89** (OJ 1992, 230) and found that the subject-matter of a claim including technical and non-technical features may satisfy the requirements of Art. 52(1) EPC 1973 if the non-technical features interact with the technical features in order to bring about a technical effect. It stated that, since the diagnostic methods referred to in Art. 52(4) EPC 1973 were inventions within the meaning of Art. 52(1) EPC 1973, it followed that, in a situation where the deductive medical or veterinary decision phase was a purely intellectual exercise, i.e. a step of a non-technical nature, such a method must necessarily further include preceding steps of a technical nature, in order to satisfy the requirements of Art. 52(1) EPC 1973.

In **T 820/92** (OJ 1995, 113) the board noted that, whilst Art. 52(2) EPC 1973 provided that certain activities of an abstract and intellectual character could not be regarded as

inventions, Art. 52(3) EPC 1973 provided that this exclusion should apply only to the activities as such. This had been interpreted as meaning only that a claim directed to such activities per se was not allowable, but that a claim was allowable where the interaction of such an activity with something else could be regarded as an invention. This contrasted with the position under Art. 52(4) EPC 1973, which prevented the methods specified from being patented, even though they might otherwise be considered as an invention susceptible of industrial application as required by Art. 52(1) EPC 1973. The board pointed out that no provision similar to Art. 52(3) EPC 1973 limited the exclusion of Art. 52(4) EPC 1973 (see also **T 82/93**, OJ 1996, 274).

In **T 1054/96** (OJ 1998, 511) the board considered that the different wording used in Art. 53(b) EPC 1973 and in Art. 52(2) EPC 1973, and the fact that these exceptions from patentability were in different Articles was intended to emphasise that there was a difference in legal category between the Art. 52(2) EPC 1973 exceptions relating to matter which as such was not regarded as an invention, and the Art. 53(b) EPC 1973 exceptions for which patents were not to be granted, even though they could be regarded as inventions.

1.6. Assessment of the invention as a whole

Decision **T 26/86** (OJ 1988, 19) examined whether an X-ray apparatus incorporating a data processing unit operating in accordance with a routine was patentable. The board considered that the claim related neither to a computer program on its own and divorced from any technical application, nor to a computer program in the form of a recording on a data carrier, nor to a known, general purpose computer in combination with a computer program. It found instead that the routine in accordance with which the X-ray apparatus operated produced a technical effect, i.e. it controlled the X-ray tubes so that, by establishing a certain parameter priority, optimum exposure was combined with adequate protection against overloading of the X-ray tubes. The invention was therefore patentable irrespective of whether or not the X-ray apparatus without this computer program formed part of the state of the art. The board held that an invention **must be assessed as a whole**. If it made use of both technical and non-technical means, the use of non-technical means did not detract from the technical character of the overall teaching. The Convention does not prohibit the patenting of inventions consisting of a mix of technical and non-technical elements. The board therefore regarded it as unnecessary to weigh up the technical and non-technical features in a claim in order to decide whether it related to a computer program as such. If the invention defined in the claim used technical means, its patentability was not ruled out by Art. 52(2)(c) and (3) EPC 1973 and it could be protected if it met the requirements of Art. 52 to 57 EPC 1973.

In **T 603/89** (OJ 1992, 230) the board held that the subject-matter of a "mix" claim was not excluded from patentability under Art. 52(2) and (3) EPC 1973 when, but only when, the **non-technical elements interacted** with the known technical elements in order to produce a technical effect. Thus, the board considered that when there was an interaction between the technical and non-technical elements, and the mix as a whole solved a technical problem, it was not excluded from patentability (see **T 26/86**, OJ 1988, 19). In the absence of such an interaction - when the technical elements were only a

support for the non-technical elements but did not otherwise co-operate therewith - the invention did not make use of technical means and could not therefore be granted (see **T 158/88**, OJ 1991, 566).

In **T 209/91** the board upheld the principle formulated in **T 26/86** (OJ 1988, 19) that the patentability of an invention making use of both technical and non-technical features could not be ruled out a priori. A claim must be assessed as a whole; the fact that it included non-technical features did not detract from the technical character of the overall teaching, **provided these features** also helped to bring about the technical effect.

In **T 1001/99** the board stated that the examination as to an exclusion from patentability, by reference to Art. 52(2) EPC 1973, had to be based on the subject-matter of the claim as a whole, rather than on the contribution which the subject-matter claimed added to the known art even if this subject-matter was considered as a whole to determine whether the subject-matter as a whole related to an invention within the meaning of Art. 52(1) EPC 1973. Pursuant to Art. 52(3) EPC 1973 this could **only be denied if** the claimed subject-matter related to non-technical subject-matter, for example to a method for performing mental acts or other items listed in Art. 52(2) EPC 1973, "as such" which meant that it was limited to this subject-matter, e.g a mental act, without involving technical aspects, for example required technical considerations, implied technical effects or a technical problem solved.

In **T 553/02**, the board concluded that a claim directed to a product comprising a composition of matter (in this case a bleaching composition) and to instructions for use of the product, where the instructions had no technical effect on the product, was not excluded from patentability under Art. 52(2) EPC 1973, since the claim had a technical meaning and defined the technical features necessary for the definition of the claimed subject-matter, i.e. a product comprising a bleaching composition. Whether the claimed product was novel or not was, in this case, irrelevant for the purposes of evaluating patentability (see e.g. **T 931/95**, OJ 2001, 441). The board noted also that this conclusion confirmed what was set out in the Guidelines for Examination in the EPO. In fact section C-IV 2.2 specified that exclusion from patentability under Art. 52(2) EPC 1973 applied only to the extent to which the application related to the excluded subject-matter as such (which in the case at issue it did not), and also that the content of the claim should be considered as a whole in order to decide whether the claimed subject-matter had a technical character; furthermore, section C-IV 2.3, discussing presentations of information, dealt with claims directed to the presentation of information as such or with claims directed to a process or a product (apparatus) for presenting information and not with a claim such as the present one, directed to two separate entities, a physical product and information having no technical effect on the claimed physical product.

2. Non-inventions under Article 52(2) and (3) EPC

2.1. Introduction

"European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial

application." Art. 52(1) EPC expresses the fundamental maxim of the general entitlement to patent protection for any inventions in all technical fields. Any **limitation** to the general entitlement to patent protection is thus not a matter of judicial discretion, but must have a clear legal basis in the EPC.

Art. 52(2) EPC lists subject-matter or activities **not regarded** as inventions within the meaning of Art. 52(1) EPC. It states that **in particular** the following shall not be regarded as inventions within the meaning of paragraph 1; (a) discoveries, scientific theories and mathematical methods; (b) aesthetic creations; (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers; (d) presentations of information.

Art. 52(3) EPC states that paragraph (2) shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a European patent application or European patent relates to such subject-matter or activities **as such**.

In **T 854/90** (OJ 1993, 669) the board noted that the boards of appeal had already emphasised the necessity for claimed subject-matter or a claimed activity to have a **technical character** if it was to be considered as an invention within the meaning of Art. 52(1) EPC 1973. In particular, in decision **T 22/85** (OJ 1990, 12), the board stated with reference to the excluded subject-matter and activities set out in Art. 52(2)(c) EPC 1973 that "Whatever their differences, these exclusions have in common that they refer to activities which do not aim at any direct technical result but are rather of an abstract and intellectual character".

In **T 154/04** (OJ 2008, 46) the board stated that the enumeration of typical non-inventions in Art. 52(2) EPC 1973 covers subjects whose common feature was a substantial lack of technical character. Art. 52(2) EPC 1973 was merely a negative, non-exhaustive list of what should not be regarded as an invention within the meaning of Art. 52(1) EPC 1973. It was the clear intention of the contracting states that this list of "excluded" subject matter should not be given too broad a scope of application. Thus Art. 52(3) EPC 1973 was introduced as a bar to such a broad interpretation of Art. 52(2) EPC 1973. By referring explicitly to the "patentability of the subject-matter or activities", paragraph 3 actually enshrined the entitlement to patent protection for the non-inventions enumerated in paragraph 2 -- albeit restricting this entitlement by excluding patentability "to the extent to which the European patent application or European patent relates to such subject matter or activities as such". That no paradigm shift was intended may also be seen from the fact that e.g. Switzerland as a contracting state considered it unnecessary ("überflüssig") to include the contents of Art. 52(2) and (3) EPC 1973 in the national regulations when harmonising them with the EPC 1973 (see "Botschaft des Bundesrates an die Bundesversammlung über drei Patentübereinkommen und die Änderung des Patentgesetzes", 76.021, 24 March 1976, page 67).

Further, the board held that "technical character" was an implicit requisite of an "invention" within the meaning of Art. 52(1) EPC 1973 (requirement of "technicality"). Art. 52(2) EPC 1973 **did not exclude from patentability** any subject matter or activity having technical character, even if linked to items listed in this provision since these

items are **only excluded "as such"** (Art. 52(3) EPC 1973). In examining the patentability of an invention in respect of a claim, the claim had to be construed to determine the technical features of the invention, i.e. the features which contribute to the technical character of the invention. These principles had indeed a clear and consistent basis in the Convention and in the case law of the boards of appeal and the Enlarged Board of Appeal, in particular (see also **T 931/95**, OJ 2001, 441, **T 914/02**).

2.2. Discoveries, scientific theories and mathematical methods

Art. 52 EPC sets out in paragraph (2) (a)-(d) a non-exhaustive list of items which are not regarded as an invention. This includes "Discoveries, scientific theories and mathematical methods" in (a). These activities share the common feature that they do not aim at any direct technical result but are rather of an abstract and intellectual character (see **T 338/00**, **T 22/85**, OJ 1990, 12, **T 854/90**, OJ 1993, 669).

2.2.1 Discoveries and scientific theories

In **G 2/88** (OJ 1990, 93) the Enlarged Board of Appeal considered a claim to a new use of a known compound (the new purpose of such use being the only potentially novel feature). It held that, if on its proper construction the claim contains no technical feature which reflects such new use, and the wording of the claim which refers to such new use is merely mental in nature and does not define a technical feature, then the claim contains no novel technical feature and is invalid under Art. 54(1) and (2) EPC 1973 (because the only technical features in the claim are known). In relation to such a claim having no novel technical feature, there is no need to consider whether the claimed invention was in respect of a discovery or is otherwise excluded from patentability by virtue of Art. 52(2) EPC 1973. Depending upon the particular wording of a particular claim, the above construction was not the only possible construction of a claim concerning the new use of a known compound, however. In particular cases it may clearly be necessary to consider and decide whether a claimed invention is a discovery within the meaning of Art. 52(2)(a) EPC 1973. An essential first step in such consideration is to construe the claim so as to determine its technical features. If, after such determination, it is clear that the claimed invention relates to a discovery or other excluded subject-matter "as such" (Art. 52(3) EPC 1973), then the exclusion of Art. 52(2) EPC 1973 applies. In this connection, as was recognised in **T 208/84** (OJ 1987, 14) (which dealt with a mathematical method rather than a discovery, but the same principle applies), the fact that the idea or concept underlying the claimed subject-matter resides in a discovery does not necessarily mean that the claimed subject-matter is a discovery "as such". In a particular case, it is possible that there may be concurrent objections under Art. 54(1) and (2) EPC 1973 and under Art. 52(2) and (3) EPC 1973. They are, however, distinct objections.

In **T 1538/05** the board noted that, speaking very generally, an invention must be of a technical character and must solve a technical problem with - at least partially - technical means. It found that the claims at issue related to the discovery of a scientific theory rather than a technical teaching. The appellant claimed to have discovered a magnetic force that was hitherto unknown, and as a consequence thereof, established that

theories such as the Heisenberg uncertainty principle as well as Einstein's theory of relativity were wrong. These were scientific theories or discoveries of the laws of nature different from those established. Neither the claims, nor the description, nor the numerous letters sent by the appellant gave any indication of a clear technical teaching. It was not sufficient in this respect that the patent description indicated to which patent classifications the invention could belong or for which classifications the invention could serve. The above deficiencies thus made the invention unpatentable under Art. 52 EPC 1973, which explicitly excluded discoveries, scientific theories and mathematical methods.

The appellant pointed out that his physical theories and discoveries had not been well understood by the EPO's examiners, by the board of appeal and also by established physicists. The board noted that this could well be so. The board was in no position to determine whether these physical theories and discoveries were correct or not. Yet, the board observed that an office for granting patents and a board of appeal could not be a discussion forum for new physical theories unless these were unambiguously proven, were of a technical nature and capable of industrial application. It was clear to the board that the subject-matter claimed by the appellant was not patentable, as the appellant had not demonstrated that they were of a technical nature and that the invention could be applied to processes or devices. To what extent the appellant's physical theories were correct would be a matter for academic debate, and the appropriate forum for the applicant's theories would be a physics journal. In this respect, the board found it notable that, according to the appellant, a leading French physicist had not understood the theories at issue, nor had the appellant succeeded in having his theories published by an established journal.

2.2.2 Mathematical methods

In **T 208/84** (OJ 1987, 14) the method Claims 1-7 and 12 were directed to methods for digitally processing images. One basic issue to be decided was whether or not such a method was excluded from patentability under Art. 52(2) and (3) EPC 1973 on the ground that it was a mathematical method as such. The board noted that there could be little doubt that any processing operation on an electric signal can be described in mathematical terms. The characteristic of a filter, for example, can be expressed in terms of a mathematical formula. A basic difference between a mathematical method and a technical process can be seen, however, in the fact that a mathematical method or a mathematical algorithm is carried out on numbers (whatever these numbers may represent) and also provides a result also in numerical form, the mathematical method or algorithm being only an abstract concept prescribing how to operate on the numbers. No direct technical result is produced by the method as such. In contrast, if a mathematical method is used in a technical process, that process is carried out on a physical entity (which may be a material object but equally an image stored as an electric signal) by some technical means implementing the method and provides as its result a certain change in that entity. The technical means might include a computer comprising suitable hardware or an appropriately programmed general purpose computer. The board was, therefore, of the opinion that, even if the idea underlying an invention may be considered to reside in a mathematical method, a claim directed to a technical process in which the

method is used does not seek protection for the mathematical method as such. In contrast, a "method for digitally filtering data" remains an abstract notion not distinguished from a mathematical method as long as it is not specified what physical entity was represented by the data and it forms the subject of a technical process, i.e. a process which is susceptible of industrial application (see also **T 1161/04**).

In **T 59/93** method Claim 1 was to be understood as defining, by the steps it comprised, the functional features, in operation, of an interactive draw graphic system, normally implemented by a program-controlled computer, its operator being the user. In steps (e), (g) and (h), mathematical methods were implied for calculating coordinates, lines and an angle. The board noted that mathematical methods as such would be excluded from patentability by Art. 52(2)(a) in conjunction with (3) EPC 1973. However, clearly, the claim did not relate to a mathematical method as such; it did not define any formula according to which the calculations should be performed. Rather, the calculating steps mentioned were only means, or tools, used within the overall method claimed, for entering a rotation angle value into a draw graphic system. The graphic objects to be rotated were not restricted, by their meaning or information content, to business graphics such as pie charts, bar graphs, etc. No objection, therefore, could be raised under Art. 52(2)(c) in conjunction with (3) EPC 1973 that the claimed method would be doing business as such.

In **T 212/94** Claim 1 was directed to the encoding of data representing audio information or image information for transmission in a communication system in accordance with a codebook (i.e. an assignment rule) specified in the claim. Although the idea underlying the invention - the novel algorithm defining the codebook as a mathematical function - could be considered to be a mathematical method, the claim was directed to the use of the assignment rule in the processing of audio or image signals, which were themselves physical entities. The entities and relationships featuring in the problem solved by the invention were not purely abstract mathematical ones. The claimed method solved a technical problem. Following the VICOM decision (**T 208/84**, OJ 1987, 14), the board found that the subject-matter of the claim did not relate to a mathematical method as such and was not excluded from patentability by the provisions of Art. 52(2)(a) and (3) EPC 1973. This finding also applied, for analogous reasons, to the apparatus claim.

In **T 953/94**, claim 1 of the main request related to a method of generating with a digital computer a data analysis of the cyclical behaviour of a curve represented by a plurality of plots relating two parameters to one another. The board held that such a method could not be regarded as a patentable invention, because an analysis of the cyclical behaviour of a curve was clearly a mathematical method excluded as such from patentability. The reference to a digital computer only had the effect of indicating that the claimed method was carried out with the aid of a computer, i.e. a programmable general-purpose computer, functioning under the control of a program excluded as such from patentability. The fact that the description disclosed examples in both non-technical and technical fields was confirmation that the problem solved by the claimed mathematical method was independent of any field of application and could thus lie, in the case at issue, only in the mathematical and not in a technical field.

2.3. Aesthetic creations

An aesthetic creation relates by definition to an article (e.g. a painting or sculpture) having aspects which are other than technical and the appreciation of which is essentially subjective. The aesthetic effect itself is not patentable, neither in a product nor a process claim. Nevertheless, if an aesthetic effect is obtained by a technical structure or other technical means, although the aesthetic effect itself is not patentable, the means of obtaining it may be.

In **T 686/90** the board was called upon to decide whether the feature "work of art in the style of stained glass" meant that it was excluded from patentability under Art. 52(2)(b) EPC 1973. The board held that functional information referring to general aesthetic creations did not define an aesthetic creation as such, at least provided that and insofar as such information adequately identified technical features of the subject-matter of the claim. Since an aesthetic creation (not formally specified) as the stated purpose, together with the other features, adequately defined a technical subject-matter in the claim, there was no aesthetic creation as such. For this reason there could be no objection to the claim under Art. 52(2)(b) EPC 1973 on the basis of Art. 52(3) EPC 1973.

In **T 962/91**, on the other hand, the board held that the practical problem underlying the invention - as disclosed - involved concealing irregularities occurring in the outer region and detracting from the appearance of the information carrier by means of matting in such a way that these so-called errors were not apparent to the observer. The board agreed with the examining division that errors of this kind in no way impair the technical operation of the information carrier. This meant that the use of the matting as claimed for the purpose of concealing errors was not designed to solve a technical problem but was confined to the attainment of an aesthetic effect.

In decision **T 119/88** (OJ 1990, 395) the subject-matter of the application in question related to a flexible disk jacket made of a plastic sheet presenting to the outside world a surface colour of a certain minimum light intensity. The board first of all stated that the feature of having a specific colour as such did not constitute a technical feature indicating that an object or device was entirely or partly covered by that colour; however, the board did not rule out the possibility that this did not hold in all circumstances. The feature taken by itself might not seem to reveal any technical aspect, but its technical or non-technical character could be decided by the effect it brought about after being added to an object which did not comprise the feature before. In the case in point, the board concluded that the alleged resistance to fingerprints was a purely aesthetic effect which contributed nothing technical to the invention concerned (Art. 52(2)(b) EPC 1973) and the advantage of easy classification by colour represented a non-technical effect in the form of a presentation of information. As such it was excluded from patentability under Art. 52(2)(d) and (3) EPC 1973.

2.4. Computer-implemented inventions

2.4.1 General issues

The non-patentability of computer programs as such does not preclude the patenting of computer-implemented inventions. If the claimed subject-matter has a technical character it is not excluded from patentability by the provisions of Art. 52(2) and (3) EPC.

In **T 1173/97** (OJ 1999, 609) the board noted that Art. 27(1) TRIPS states that "patents shall be available for any inventions, whether **products or processes**, in all fields of technology". The board found it was the clear intention of TRIPS not to exclude from patentability any inventions, whatever field of technology they belong to, and therefore, in particular, not to exclude programs for computers as mentioned in and excluded under Art. 52(2)(c) EPC 1973. The board noted that claims explicitly directed to computer programs were not allowed until recent years. According to the early case law of the boards of appeal, the view was taken on a number of occasions that exclusion under Art. 52(2)(c) and (3) EPC 1973 applied to all computer programs, independently of their contents, that is, independently of what the program could do or perform when loaded into an appropriate computer. To make a distinction between programs with a technical character and those with a non-technical character would not be allowed under such reasoning. Some examples of such reasoning could be found for instance in decisions **T 26/86** (OJ 1988, 19, point 3.1 of the Reasons), **T 110/90** (OJ 1994, 557, point 5 of the Reasons), **T 164/92** (OJ 1995, 305, Corr. 387) and **T 204/93** (point 3.13 of the Reasons). For example, in **T 204/93**, the board held that computer programs as such, independent of their application, were not patentable irrespective of their content, even if that content happened to be such as to make it useful, when run, for controlling a technical process. The board ruled that, "similarly", a programmer's activity of programming was, "as a mental act", not patentable, irrespective of whether the resulting program could be used to control a technical process, and that automating that activity in a way which did not involve any unconventional means did not render that programming method patentable either, independently of the content of the resulting program.

In **T 935/97** and **T 1173/97** (OJ 1999, 609) the board of appeal decided that the practice of the EPO under Art. 52(2) and (3) EPC 1973 should be changed in certain respects in relation to claims to computer programs. In these decisions it was held that the exclusion of computer programs "as such" did not encompass all programs for computers. The board held that a computer program product is not excluded from patentability under Art. 52(2) and (3) EPC 1973 if the program, when running on a computer or loaded into a computer, brings about, or is capable of bringing about, a technical effect which goes beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it is run. Furthermore, the board was of the opinion that with regard to the exclusions under Art. 52(2) and (3) EPC 1973, it does not make any difference whether a computer program is claimed by itself or as a record on a carrier (following decision **T 163/85**, OJ 1990, 379).

In **T 208/84** (OJ 1987, 14) the board held that even if the idea underlying an invention may be considered to reside in a mathematical method, a claim directed to a technical

process in which the method is used does not seek protection for the mathematical method as such. A claim directed to a technical process carried out under the control of a program (whether by means of hardware or software) cannot be regarded as relating to a computer program as such. In addition, a claim which can be considered as being directed to a computer set up to operate in accordance with a specified program (whether by means of hardware or software) for controlling or carrying out a technical process cannot be regarded as relating to a computer program as such (see headnote). In this case it was held that the method according to the invention was not excluded from patentability, because it constituted a technical process which was carried out on a physical entity. This entity might be a material object but equally an image stored as an electric signal. Thus the said method was neither a mathematical method as such nor a computer program as such (see also **T 1173/97**, OJ 1999, 609).

The President of the EPO, making use of her power under Art. 112(1)(b) EPC, has made a referral to the Enlarged Board of Appeal on several points of law relating to the application of the exclusion of computer programs as such, and the limits of patentability in the field of computing. In the summary of the referral, it was noted that, as the EPC 1973 was drafted, the feeling was that it was better not to define the exclusion precisely in law, but rather that the matter should be left in the hands of the EPO and the national courts. Nevertheless, diverging decisions of the boards of appeal had created uncertainty, and answers to the questions arising from these decisions were necessary to enable the further, harmonious development of case law in this field. There were concerns, also expressed by national courts and the public, that some decisions of the boards of appeal had given too restrictive an interpretation of the breadth of the exclusion. It was clearly stated by the President of the EPO that the European Patent Office should play the leading role in harmonising the practice of patent offices within Europe.

The main questions referred read as follows:

- 1: Can a computer program only be excluded as a computer program as such if it is explicitly claimed as a computer program?
- 2: Can a claim in the area of computer programs avoid exclusion under Art. 52(2)(c) and (3) EPC merely by explicitly mentioning the use of a computer or a computer-readable data storage medium?
- 3: Must a claimed feature cause a technical effect on a physical entity in the real world in order to contribute to the technical character of the claim?
- 4: Does the activity of programming a computer necessarily involve technical considerations?

The Enlarged Board of Appeal gave its opinion on the President's referral in **G 3/08** (see headnote on page XXXVII).

2.4.2 Exclusion of computer programs "as such"

The exclusion of computer programs as such under Art. 52(2) and (3) EPC is of key importance in this field.

In **T 1173/97** (OJ 1999, 609) the board noted that Art. 52(3) EPC 1973 established an important limitation to the scope of this exclusion under Art. 52(2)(c) EPC 1973. According to Art. 52(3) EPC 1973, the exclusion applied only to the extent to which a European patent application or a European patent related to programs for computers "as such". The combination of the two provisions (Art. 52(2) and (3) EPC 1973) demonstrated that the legislators did not want to exclude from patentability all programs for computers. In other words the fact that only patent applications relating to programs for computers as such were excluded from patentability meant that patentability could be allowed for patent applications relating to programs for computers where the latter were not considered to be programs for computers as such. In order to establish the scope of the exclusion from patentability of programs for computers, it was necessary to determine the exact meaning of the expression "as such". This could result in the identification of those programs for computers which, as a result of not being considered programs for computers as such, were open to patentability. According to the case law of the boards of appeal, a claim directed to the use of a computer program for the solution of a technical problem could not be regarded as seeking protection for the program as such within the meaning of Art. 52(2)(c) and (3) EPC 1973, even if the basic idea underlying the invention could be considered to reside in the computer program itself, as illustrated, for example, by decisions **T 208/84** (OJ 1987, 14) and **T 115/85** (OJ 1990, 30). The case law thus allows an invention to be patentable when the basic idea underlying the invention resides in the computer program itself.

2.4.3 Claims for a computer program product

In **T 1173/97** (OJ 1999, 609) and **T 935/97** the claims were directed to a computer program product and had to be examined from the point of view of what may be called "the further technical effect", which, if present, could lead to the subject-matter not being excluded under Art. 52(2) and (3) EPC 1973. The board stated that every computer program product produced an effect when the program concerned was made to run on a computer. The effect only showed in physical reality when the program was being run. Thus the computer program product itself did not directly disclose the said effect in physical reality. It only disclosed the effect when being run and consequently only possessed the "potential" to produce said effect. This effect might also be technical in the sense explained in reason 6 of the decision, in which case it constituted the "further technical effect" mentioned there. This meant that a computer program product might possess the potential to produce a "further" technical effect.

Once it had been clearly established that a specific computer program product, when run on a computer, brought about a technical effect in the above sense, the board saw no good reason for distinguishing between a direct technical effect on the one hand and the potential to produce a technical effect, which could be considered as an indirect technical effect, on the other hand. A computer program product might therefore possess a

technical character because it has the potential to cause a predetermined further technical effect in the above sense. According to the above, having technical character means not being excluded from patentability under the "as such" provision pursuant to Art. 52(3) EPC 1973. The board held that a computer program product having the potential to cause a predetermined further technical effect was, in principle, not excluded from patentability under Art. 52(2) and (3) EPC 1973. Consequently, computer program products were not excluded from patentability under all circumstances.

The board further held that a computer program product which (implicitly) comprised all the features of a patentable method (for operating a computer, for instance) was therefore in principle considered as not being excluded from patentability under Art. 52(2) and (3) EPC 1973. For the board it was self-evident that a claim to such a computer program product had to **comprise all the features** which assured the patentability of the method it was intended to carry out when being run on a computer. When this computer program product was loaded into a computer, the programmed computer constitutes an apparatus which in turn was able to carry out the said method. The board pointed out that **wording the claim** for a computer program product in this way also ensured that, when the hardware worked according to its predetermined procedures, its internal physical changes carried out by the program were not relevant per se in determining whether an invention (as claimed) was patentable (see e.g. **T 22/85**, OJ 1990, 12).

T 424/03 concerned an application disclosing a method of providing expanded clipboard formats for transferring data between formats. The clipboard was a storage area used in the common computer commands "cut", "copy" and "paste". Claim 1 related to a method implemented in a computer system. A computer system including a memory (clipboard) was a technical means, and consequently the claimed method had technical character in accordance with established case law. Moreover, the board emphasised that **a method implemented in a computer system** represented a sequence of steps actually performed and achieving an effect, and not a sequence of computer-executable instructions (i.e. **a computer program**) which just had the potential of achieving such an effect when loaded into, and run on, a computer. The board held that the claim category of a computer-implemented method was **distinguished from** that of a computer program. Even though a method, in particular a method of operating a computer, might be put into practice with the help of a computer program, a claim relating to such a method did not claim a computer program in the category of a computer program. Hence, in the case at issue, claim 1 could not relate to a computer program as such.

The board also considered that the claimed method steps contributed to the technical character of the invention. These steps solved a technical problem by technical means in that functional data structures (clipboard formats) were used independently of any cognitive content (see **T 1194/97**, OJ 2000, 525) in order to enhance the internal operation of a computer system with a view to facilitating the exchange of data among various application programs. The claimed steps thus provided a general purpose computer with a further functionality - the computer assisted the user in transferring non-file data into files.

In the same case claim 5 was directed to a computer-readable medium having computer-executable instructions (i.e. a computer program) on it to cause the computer system to perform the claimed method. The board found that the subject-matter of claim 5 had technical character since it related to a computer-readable medium, i.e. a technical product involving a carrier (see **T 258/03**, OJ 2004, 575). Moreover, the computer-executable instructions had the potential of achieving the above-mentioned further technical effect of enhancing the internal operation of the computer, which went beyond the elementary interaction of any hardware and software of data processing (**T 1173/97**, OJ 1999, 609). The computer program recorded on the medium was therefore not considered to be a computer program as such, and thus also contributed to the technical character of the claimed subject-matter.

In the referral to the Enlarged Board of Appeal **G 3/08**, the President of the EPO considered that decision **T 424/03** placed emphasis on the manner in which the computer program was claimed, whereas **T 1173/97** (OJ 1999, 609) had placed the emphasis on the function of the computer program (does the claimed program have technical character?) rather than the manner in which it is claimed (e.g. as a computer program, a computer program product or a computer-implemented method). This divergence concerned the application of the exclusion of computer programs as such and was emphasised (see **G 3/08**, Question 1 above). It was stated that if one were to follow the reasoning of **T 424/03**, overcoming the exclusion of programs for computers would become a formality, merely requiring formulation of the claim as a computer implemented method or as a computer program product. The Enlarged Board of Appeal gave its opinion on the President's referral in **G 3/08** (see headnote on page XXXVII).

2.4.4 Technical character and programs for computers

It is established case law that if the subject-matter of a claim has technical character, then it is not excluded from patentability under Art. 52(2) and (3) EPC.

In the referral **G 3/08** (see above), the President of the EPO observed inter alia that in the case of claims in the area of programs for computers (worded, for instance, explicitly as programs for computers or as methods carried out by computers), there was uncertainty about when exactly features could confer technical character on such claims (see Question 2, above). It was also noted that according to decisions **T 163/85** and **T 190/94**, a technical effect **on a physical entity** in the real world was required. This was, however, not the case in **T 125/01** and **T 424/03** (see referral **G 3/08**, Question 3, above). In these decisions the technical effects were essentially confined to the respective computer programs. The President of the EPO stated that regardless of the question whether exclusion under Art. 52(2) and (3) EPC could be avoided simply by choosing an appropriate form of claim, it would always be necessary to evaluate the effects caused by individual features or combinations of features to determine whether they contribute to the technical character of a claim. Determining this contribution was always relevant for evaluating the further requirements of the EPC (such as inventive step).

In **T 1173/97** (OJ 1999, 609) and **T 935/97** the board found that a computer program must be considered to be patentable when it has technical character. For the purpose of interpreting the exclusion from patentability of programs for computers under Art. 52(2) and (3) EPC 1973, the board assumed that **programs for computers** could not be considered as having a technical character for the very reason that they are programs for computers. This means that physical modifications of the hardware (causing, for instance, electrical currents) deriving from the execution of the instructions given by programs for computers cannot per se constitute the technical character required for avoiding the exclusion of those programs. Although such modifications may be considered to be technical, they are a common feature of all those programs for computers which have been made suitable for being run on a computer, and therefore cannot be used to distinguish programs for computers with a technical character from programs for computers as such. It was thus necessary to look elsewhere for technical character in the above sense: It could be found in the **further effects** deriving from the execution (by the hardware) of the instructions given by the computer program. Where said further effects have a technical character or where they cause the software to solve a technical problem, an invention which brings about such an effect may be considered an invention, which could, in principle, be the subject-matter of a patent. The board concluded that on condition that they were able to produce a technical effect in the above sense, all computer programs must be considered as inventions within the meaning of Art. 52(1) EPC 1973, and may be the subject-matter of a patent if the other requirements provided for by the EPC are satisfied. The board found that the considerations above were in line with the main stream in the case law of the boards of appeal of the EPO. As far as patentability was concerned the boards had so far required inventions to possess technical character. To the board's knowledge there were no decisions in which a board of appeal had attributed a technical character to a computer program for the sole reason that the program was destined to be used in a technical apparatus, namely a computer.

In **T 1177/97** claim 1 was directed to a method for translation between natural languages; accordingly, it used various linguistic terms and involved linguistic aspects of the translation process. The board raised the question whether such linguistic concepts and methods could form part of a technical invention at all. It referred to EPO case law which provided various examples showing that even the automation of such methods did not make good a lack of technical character (e.g. **T 52/85**). On the other hand, coded information had been considered, on a case-by-case basis, as a patentable entity, i.a. **T 163/85** (OJ 1990, 379), **T 1194/97** (OJ 2000, 525) and **T 769/92** (OJ 1995, 525). The board confirmed that, in accordance with this case law, it seemed to be common ground that the use of a piece of information in a technical system, or its usability for that purpose, could confer a technical character on the information itself, in that it reflected the properties of the technical system, for instance by being specifically formatted and/or processed. When used in or processed by the technical system, such information could be part of a technical solution to a technical problem and thus form the basis for a technical contribution of the invention to the prior art.

In so far as technical character was concerned, the board stressed that it should be irrelevant that the piece of information was used or processed by a conventional

computer, or any other conventional information processing apparatus, since the circumstance that such an apparatus had become a conventional article for everyday use did not deprive it of its technical character, just as a hammer still had to be regarded as a technical tool even though its use had been known for millennia. The board thus came to the conclusion that information and methods related to linguistics could in principle assume a technical character if they were used in a computer system and formed part of a technical problem solution. Implementing a function on a computer system always involved technical considerations, at least implicitly, and meant in substance that the functionality of a technical system was increased. The implementation of the information and methods related to linguistics as a computerised translation process similarly required technical considerations and thus provided a technical aspect to per se non-technical things such as dictionaries, word matching or the translation of compound expressions into a corresponding meaning. Features or aspects of the method which reflected only peculiarities of the field of linguistics, however, had to be ignored in assessing inventive step.

In **T 158/88** (OJ 1991, 566) the board noted that **the statement that technical means** (e.g a visual display unit) **are to be used** to carry out the claimed process was not alone sufficient to render patentable within the meaning of Art. 52(1) EPC 1973 a process which in essence constituted a computer program as such. A computer program was not considered part of a technical operating procedure if the claimed teaching merely modified the data and produced no effects beyond information processing. A computer program did not become part of a technical operating method if the teaching claimed was confined to changing data and did not trigger any effect over and above mere data processing. When examining whether the method in question served to solve a technical problem which could make the program defined in the claim patentable as part of a teaching on technical operations, the board came to the following conclusion; where the data to be processed according to a claimed method represented neither operating parameters nor a device, nor had a physical or technical effect on the way the device worked, and no technical problem was solved by the claimed method, the invention defined in the claim did not make use of any technical means and in accordance with Art. 52(2)(c) and (3) EPC 1973 could not be regarded as a patentable invention within the meaning of Art. 52(1) EPC 1973.

In **T 1227/05** (OJ 2007, 574) the application related to a computer-implemented method with mathematical steps for simulating the performance of a circuit subject to $1/f$ noise. $1/f$ noise can be simulated by feeding suitable random numbers into the circuit model. The board concluded that, as the method according to independent claim 1 or 2 was computer-implemented, it used technical means and by that very token had technical character (see **T 258/03**, OJ 2004, 575 and **T 914/02**). The board then discussed which other features contributed, in its view, to the technical character of the method, as only such features might and had to be considered for the purpose of assessing inventive step (see **T 641/00**, OJ 2003, 352). Beyond its implementation, a procedural step might contribute to the technical character of a method only to the extent that it serves a technical purpose of the method. The board was persuaded that simulation of a circuit subject to $1/f$ noise constituted an adequately defined technical purpose for a computer-implemented method, provided that the method was functionally limited to that technical

purpose. Specific technical applications for computer-implemented simulation methods were themselves to be regarded as modern technical methods which formed an essential part of the fabrication process and preceded actual production, mostly as an intermediate step. In that light, such simulation methods could not be denied a technical effect merely on the grounds that they did not yet incorporate the physical end product.

In **T 421/06** the application was based on claims similar to those in **T 1227/05**. The simulation method extended the sequence of random numbers generating 1/f noise, whereas the method disclosed in **T 1227/05** generated a fixed number of random numbers, corresponding to the intended number of simulation steps, as a "batch" in advance, in order to make them available for the following circuit simulation. The board concluded that the claimed simulation of a circuit did not constitute a mathematical method as such or a computer program as such, although mathematical formulae and computer instructions were used in carrying out the simulation. Even where the invention was preceded by an intellectual or mathematical activity, the claimed result could not be equated with that activity. The claims did not relate to the devising of a simulation method, but to a simulation method that could no longer be carried out by purely intellectual or mathematical means. Thus the simulation performed technical tasks which were typical of the work of a modern engineer. All the steps relevant to the circuit simulation, i.e. including the mathematically expressed claim features, contributed to the technical character of the simulation method according to claim 1 or 2 and could therefore also establish the novelty of the method vis-à-vis the previous application.

In **T 1351/04** the application related to a computer-executable index file creation method and device and a file search method and apparatus. The board held that an index file containing information to be used for searching a file was a technical means since it determined the way the computer searched information, which was a technical task. A computer-executable method of creating such an index file could therefore be regarded as a method of manufacturing a technical means, also having technical character.

2.4.5 Programming a computer

It is not specified in the EPC whether, or under which circumstances, the activity associated with creating programs for computers, i.e. programming a computer, is a technical activity which is in principle patentable, or a non-technical activity which is as such excluded from patentability. In **G 3/08** the President of the EPO has referred this point of law to the Enlarged Board of Appeal (see above Question 4).

In this referral the President of the EPO referred to **T 1177/97**, where the board found that "implementing a function on a computer system always involves, at least implicitly, technical considerations". The reference to 'computer routines' makes clear that this implementation consisted of programming the computer (see also **T 172/03**). According to the referral the answer to this question affects the definition of the person skilled in the art, and consequently the nature of problems that can be presented as the objective technical problem. Therefore, it is of key importance in the field of computer technology that there is clarity concerning the skills attributable to the skilled person. Contrary to these decisions **T 833/91**, **T 204/93** and **T 769/92** (OJ 1995, 525) considered

programming to be a mental act of the programmer. The Enlarged Board of Appeal gave its opinion on the President's referral in **G 3/08** (see headnote on page XXXVII).

In **T 204/93**, the claimed invention related to the art of generating "concrete" software programs (i.e. those written in a particular programming language). These "concrete" software programs were generated from supplied "generic" specifications, which were program components or modules written in a more generally usable language, so they had to be "translated" before insertion into the "concrete" program. The principle of using named program modules, stored elsewhere, in a computer program to be generated, resembled, except for the level of language used, the well-known calling-up of stored sub-routines in main programs. As far as the claimed subject-matter was concerned, the board did not dispute that it would improve the efficiency of the programmer. However, this did not mean that the computer would work in an essentially new way from a technical point of view. Computer programs were not patentable irrespective of their content, i.e. even if that content happened to be such as to make it useful, when run, for controlling a technical process. Similarly, a programmer's activity of programming, would, as a mental act, not be patentable, irrespective of whether the resulting program could be used to control a technical process; finally, automating that activity, in a way which did not involve any unconventional means, would not render that programming method patentable either, irrespective of the content of the resulting program. The board in **T 1173/97** (OJ 1999, 609) was of the opinion that in decision **T 204/93** a programmer's activity of programming constituted a mental act excluded as such under Art. 52(2)(c) and (3) EPC 1973 and that the activity of programming was also excluded from patentability, because of the exclusion of computer programs, and because automating that activity (e.g. by means of a computer program) did not involve any unconventional means which were able to overcome the exclusion, which, in the end, was apparently based on a combination of the exclusions of schemes, rules and methods for performing mental acts as such and of computer programs as such, under Art. 52(2)(c) and (3) EPC 1973.

In **T 833/91** the board held that programs for computers as such were expressly excluded from patentability and a programmer's activity would involve performing mental acts and therefore also fall within the exclusions under Art. 52(2)(c) EPC 1973.

In **T 769/92** (OJ 1995, 525) the board held that mere programming as such would be excluded from patentability by virtue of the fact that it is an activity, which essentially involves mental acts excluded from patentability under Art. 52(2)(c) EPC 1973, and, in addition, only results in computer programs, which are also excluded under the same provision. However, the implementation, in the claimed system and by the claimed method, of the said "interface" in the form of said "transfer slip" is not merely an act of programming but rather concerns a stage of activities involving technical considerations to be carried out before programming can start.

2.4.6 Control and operating programs

In **T 6/83** (OJ 1990, 5) the board found that an invention relating to the co-ordination and control of the internal communication between programs and data files held at different

processors in a data processing system having a plurality of interconnected data processors in a telecommunications network, the features of which were not concerned with the nature of the data and the way in which a particular application program operated on them, was to be regarded as solving a problem which was essentially technical. The control program was therefore comparable to the conventional operating programs required for any computer to coordinate its internal basic functions and thereby permit the running of a number of programs for specific applications. Such an invention was to be regarded as solving a problem which was essentially technical and thus an invention within the meaning of Art. 52(1) EPC 1973.

In **T 26/86** (OJ 1988, 19) the board took the view that, while an ordinary computer program used in a general-purpose computer certainly transforms mathematical values into electric signals with the aid of natural forces, the electric signals concerned amount to no more than a reproduction of information and could not in themselves be regarded as a technical effect. The computer program used in a general-purpose computer was thus considered to be a program as such and hence excluded from patentability under Art. 52(2)(c) EPC 1973. But if the program controls the operation of a conventional general-purpose computer so as technically to alter its functioning, the unit consisting of program and computer combined may be a patentable invention.

2.5. Schemes, rules and methods for performing mental acts, playing games or doing business

2.5.1 Methods for doing business

Pure business methods as such are not patentable (Art. 52(2) and (3) EPC 1973), (see e.g. **T 931/95**, OJ 2001, 441).

In **T 769/92** (OJ 1995, 525) the applicant claimed a computer system for plural types of independent management including at least financial and inventory management and a method for operating said system. Data for the various types of management which could be performed independently from each other with this system could be inputted using a single "transfer slip", in the form of an image displayed on the screen of the display unit of the computer system, for example. Although financial and inventory management would generally fall under "doing business", the board held that the invention was not excluded from patentability under Art. 52(2)(c) and (3) EPC 1973. In its view the particular kinds of management mentioned were not decisive; the fact that they were of different "specific" types to be performed "independently" of each other was found to be important. The application contained the teaching to provide, in the memory unit of the computer system, certain files and processing means for storing and further processing the data entered and causing the processing unit to perform these functions. The implementation of this teaching required the application of technical considerations. In the board's view the non-exclusion from patentability also applied to inventions where technical considerations were applied concerning particulars of their implementation. The very need for such technical considerations implied the occurrence of an at least implicit technical problem to be solved and at least implicit technical features solving this problem. Furthermore, the provision of the single transfer slip required the application of

technical considerations. This "user interface" implied that, in effect, independent financial and inventory management systems were combined by a common input device allowing data entered for use in one of the said systems also to be used, if required, in the other system. The implementation of such an interface in the claimed computer system was not merely an act of programming, but rather concerned a stage of activities involving technical considerations to be carried out before programming could start. However, it was established board of appeal practice to allow patentability for a mix of technical and non-technical features.

In **T 931/95** (OJ 2001, 441) the board addressed the patentability of inventions relating to business methods. Claim 1 of the main request was directed to a **method** for controlling a pension benefits program by administering at least one subscriber employer account. The board stated that if the method was technical or, in other words, had a technical character, it still might be a method for doing business, but not a method for doing business as such. However, all the features of claim 1, i.e. the individual steps defining the claimed method, were steps of processing and producing information having purely administrative, actuarial and/or financial character. Processing and producing such information were typical steps of business and economic methods. Thus the invention as claimed did not go beyond a method of doing business as such and was excluded from patentability under Art. 52(2)(c) EPC 1973 in conjunction with Art. 52(3) EPC 1973. The board added that using technical means for a purely non-technical purpose and/or for processing purely non-technical information did not necessarily confer technical character on any such individual steps of use or on the method as a whole. The mere occurrence of technical features in a claim did not turn the subject-matter of the claim into an invention within the meaning of Art. 52(1) EPC 1973.

Further, the board found that a computer system suitably programmed for use in a particular field, even if that was the field of business and economy, had the character of a concrete **apparatus** in the sense of a physical entity, man-made for a utilitarian purpose and was thus an invention within the meaning of Art. 52(1) EPC 1973. This distinction with regard to patentability between a **method for doing business** and an **apparatus suited to perform such a method** was justified in the light of the wording of Art. 52(2)(c) EPC 1973, according to which "schemes, rules and methods" were non-patentable categories in the field of economy and business, but the category of "apparatus" in the sense of "physical entity" or "product" was not mentioned in Art. 52(2) EPC 1973. This meant that, if a claim was directed to such an entity, the formal category of such a claim did in fact imply **physical** features of the claimed subject-matter which could qualify as technical features of the invention concerned and thus be relevant for its patentability. An apparatus constituting a physical entity or concrete product suitable for performing or supporting an **economic activity**, was an invention within the meaning of Art. 52(1) EPC 1973.

In **T 258/03** (OJ 2004, 575) the board considered that the wording of Art. 52(2)(c) EPC 1973, according to which "schemes, rules and methods for performing mental acts, playing games or doing business" were not to be regarded as inventions within the meaning of Art. 52(1) EPC 1973. The board was not convinced that this wording imposed a different treatment of claims directed to activities and claims directed to

entities for carrying out these activities. What mattered having regard to the concept of "invention" within the meaning of Art. 52(1) EPC 1973 was **the presence of technical character** which might be implied by the physical features of an entity or the nature of an activity, or might be conferred on a non-technical activity by the use of technical means. In the board's view, activities falling within the notion of a non-invention as such would typically represent purely abstract concepts devoid of any technical implications. The board held that a **method** involving technical means is an invention within the meaning of Art. 52(1) EPC 1973 (as distinguished from decision **T 931/95**). The board noted that previous decisions of the boards of appeal had held that the use of technical means for carrying out a method for performing mental acts, partly or entirely without human intervention, might, having regard to Art. 52(3) EPC 1973, render such a method, a technical process or method and therefore an invention within the meaning of Art. 52(1) EPC 1973" (**T 38/86**, OJ 1990, 384, **T 769/92**). However, method steps consisting of modifications to a business scheme and aimed at **circumventing a technical problem** rather than solving it by technical means could not contribute to the technical character of the subject-matter claimed.

For the reasons above the board also held that the **apparatus** of claim 3 was an invention within the meaning of Art. 52(1) EPC 1973, since it comprised features which were clearly technical such as a "server computer", "client computers" and a "network". This conclusion was in conformity with decision **T 931/95**. The board stated that this line of reasoning was independent of the category of the claim.

In **T 854/90** (OJ 1993, 669), a computer manufacturer applied to patent a method for operating an electronic self-service machine (e.g. cash dispenser) which could be accessed using any machine-readable card. A prospective user first had to insert such a card to enable its identification data to be stored; he then keyed in credit information about himself onto an "electronic application form", thereby permitting a decision to be taken on whether to authorise him as a user. Once authorised, he could access the system using that same card. The board ruled that this was not patentable - parts of the method claimed were merely instructions for using the machine, and although technical components were used, this did not alter the fact that what was being claimed was a method for doing business as such.

In **T 636/88** claim 1 was for a method of distributing material transported in bulk by ship: on the quayside a weighing and bagging apparatus was mounted which could be shipped in standard containers and was used to unload and bag the material before moving on to the next port. The other claims were directed to the bagging apparatus itself. The board, however, took the view that the method claimed clearly did have technical character, involving as it did the use of technical equipment (bagging apparatus) to achieve a technical end (the production of sealed, weighted bags of the material in question).

In **T 1002/92** (OJ 1995, 605), a system was claimed for determining the queue sequence for serving customers at a plurality of service points. The system gave the customer the possibility to select one particular service point; it comprised, in particular, a turn-number

allocating unit, terminals for each service point, an information unit which indicated the particular turn-number and the particular free service point to the customer.

The board held that the wording of the claim left no doubt that protection was sought for a three-dimensional object with certain capacities - the claim defined a technical item clearly belonging to the category of an apparatus with constructional components which were characterised in terms of their functions. Summarising, the board took the view that the claim was directed to an apparatus which comprised, *inter alia*, computer hardware operating according to a particular computer program. The program-determined output signal of the hardware was used for an automatic control of the operation of another system component (the information unit) and thus solved a problem which was completely of a technical nature. Moreover, the fact that one of the practical applications of the system concerned the service of customers via "business equipment" did not mean that the claimed subject-matter must be equated with a method for doing business as such.

In **T 59/93** method claim 1 was to be understood as defining, by the steps it comprised, the functional features, in operation, of an interactive draw graphic system, normally implemented by a program-controlled computer, its operator being the user. In steps (e), (g) and (h), mathematical methods were implied for calculating coordinates, lines and an angle. The board noted that mathematical methods as such would be excluded from patentability by Art. 52(2)(a) in conjunction with (3) EPC 1973. However, clearly, the claim did not relate to a mathematical method as such; it did not define any formula according to which the calculations should be performed. Rather, the calculating steps mentioned were only means, or tools, used within the overall method claimed, for entering a rotation angle value into a draw graphic system. The graphic objects to be rotated were not restricted, by their meaning or information content, to business graphics such as pie charts, bar graphs, etc. No objection, therefore, could be raised under Art. 52(2)(c) in conjunction with (3) EPC 1973 that the claimed method would be doing business as such.

2.5.2 Methods for performing mental acts

The use of technical means for carrying out a method for performing mental acts, partly or entirely without human intervention, might, having regard to Art. 52(3) EPC 1973, render such a method a technical process or method and therefore an invention within the meaning of Art. 52(1) EPC 1973 (**T 38/86**, OJ 1990, 384, headnote III); (see also **T 258/03**, OJ 2004, 575).

T 51/84 (OJ 1986, 226) concerned a process for protecting sound-recording carriers against counterfeiting by applying a coded distinctive mark. The board held that this process came under the heading of matter excluded from patentability under Art. 52(2)(c) and (3) EPC 1973, because the claim focused solely on procedural steps which could be carried out by a person in whatever way he chose, and did not indicate or presuppose technical means for carrying them out.

In **T 453/91** the product claim directed to a VLSI-chip was held novel and inventive. The method also claimed for the physical VLSI-chip design, however, was rejected because these claims only referred to the individual steps of designing such a chip and therefore could be interpreted as merely delivering a "design" in the form of an image of something which did not exist in the real world and which might or might not become a real object. The result of the method would not necessarily be a "physical entity" as defined in decision **T 208/84** (OJ 1987, 14). The board, however, allowed method claims which contained not only the steps of chip designing but also the feature "materially producing the chip so designed". This claim was considered to be clearly restricted to a process of manufacturing a real (physical) object having technical features and thus to a technical process.

In **T 125/04** the board cited **T 244/00**, stating that, in general, the task of designing diagrams was non-technical. This was so even if the diagrams arguably conveyed information in a way which a viewer might intuitively regard as particularly appealing, lucid or logical.

In **T 49/04** the application related to a method and an apparatus for enhancing the presentation of a text in a natural language on a (computer) display. Technical Board of Appeal 3.4.03 followed **T 643/00** rather than **T 125/04** (both decisions by the Technical Board 3.5.01, albeit with a different composition) and stated that technical aspects could not be ruled out in the design and use of a graphic interface. Furthermore, the presentation of natural language text on a display in a manner which improved readability, enabling users to perform their task more efficiently, related to **how**, i.e. by what physical arrangement of the text, cognitive content was conveyed to the reader and could thus be considered as contributing to a technical solution to a technical problem.

In **T 603/89** (OJ 1992, 230) the invention consisted of an apparatus for and a method of learning how to play a keyboard instrument, where numbers corresponding to notes on a sheet of music also appeared on the keys. The technical feature claimed was the marking of the keys. Patentability was ruled out by Art. 52(2)(c) and (d) EPC 1973. Since the key markings were merely known technical features, the contribution made by the claimed invention to the working of the teaching apparatus lay solely in the content of the information displayed, not in the apparatus itself. The invention was not based on a technical problem, but on an improvement to a teaching method, which was equivalent to an improvement to a method for performing mental acts.

In **T 474/98** claims 1 to 3 did not claim programs for computers or methods for performing mental acts as such, since the steps of digitally measuring parameters and converting measured values into differing coordinate values were linked to further method steps such as the comparison of values, judging of parameters and carrying out the step of edging a lens i.e. steps which were clearly technical. Summarizing, claims 1 and 3 did not claim a mental act or program as such, but rather indicated a chain of steps to be carried out: (a) to achieve a result, namely whether or not a pre-edged lens could be fitted into a spectacle frame and, (b) edging a lens according to the configuration of the selected spectacle frame. Under these circumstances the requirements of Art. 52(2)(c) and (3) EPC 1973 were met.

In **T 27/97** the appellant (opponent) interpreted the claim to mean that its subject-matter, despite the statement that a method for use in electronic systems was involved, was confined to purely intellectual methods and thus excluded by Art. 52(2)(c) EPC 1973. The board disagreed, ruling that, according to claim 1, the application claimed a method, for use in electronic systems, of encrypting or decrypting a message (represented in the form of a digital word using RSA-type public-key algorithms). So the invention was clearly a method in the computer and telecommunications field and thus not excluded under Art. 52(2) and (3) EPC 1973, even if based on an abstract algorithm or mathematical method.

2.5.3 Word-processing

Decision **T 115/85** (OJ 1990, 30) concerned a method for displaying one of a set of predetermined messages comprising a phrase made up of a number of words, each message indicating a specific event which might occur in the input-output device of a word processing system which also included a keyboard, a display and a memory.

The board observed that automatically giving visual indications of conditions prevailing in an apparatus or a system was basically a technical problem. The application proposed a solution to this technical problem involving the use of a computer program and certain tables stored in a memory. It adopted the principle laid down in decision **T 208/84**: an invention which would be patentable in accordance with conventional patentability criteria should not be excluded from protection by the mere fact that for its implementation modern technical means in the form of a computer program are used. However, it did not follow from this that conversely a computer program could under all circumstances be considered as constituting technical means. In the case in question the subject-matter of the claim, phrased in functional terms, was not barred from protection by Art. 52(2)(c) and (3) EPC 1973.

In **T 22/85** (OJ 1990, 12) the same board had to decide on the patentability of a method for automatically abstracting and storing an input document in an information storage and retrieval system and a corresponding method for retrieving a document from the system. The board observed that the described method fell within the category of activities defined in Art. 52(2)(c) EPC 1973. It considered that the mere setting out of the sequence of steps necessary to perform the activity in terms of functions or functional means to be realised with the aid of conventional computer hardware elements did not import any technical considerations and could therefore neither lend a technical character to the activity nor to the claimed subject-matter considered as a whole, any more than solving a mathematical equation could be regarded as a technical activity when a conventional calculation machine is used.

In **T 186/86** the board noted that the activity of editing a text is principally concerned with linguistic and lay-out features of a text but, when performed with the aid of a machine (text processor), will have to include further steps for, inter alia, presenting to the human operator the text to be edited in a form suitable for that purpose, as well as steps for storing and/or reproducing the finalised text. The whole editing method, however, has for its purpose the creation of a text having a desired information content and lay-out, which

means that the method as such aims at solving a problem which is essentially of a non-technical nature. The board was therefore of the opinion that the activity of text editing as such must be considered as falling within the category of schemes, rules and methods for performing mental acts, and is excluded from patentability under Art. 52(2)(c) and (3) EPC 1973. The board found that, in order to carry out in practice an activity excluded as such under Art. 52(2)(c) EPC 1973, some means may be used which themselves could be qualified as technical e.g. a computer controlled by appropriate software. A claim directed to an excluded activity but at the same time containing such technical features would not appear to be unallowable under all circumstances. In the case at issue the method defined in claim 1 was realised by a suitable computer program run on a conventional text processor as was apparent from the description. Claim 1 set out a sequence of data processing steps which were required to effect, under the control of said program, the editing method according to the present application, including an interactive step in which a human operator entered the changes he wished to make to the text. The operations performed did not go beyond the processing of data involving conventional techniques of entering, storing, displaying, converting and transferring data which did not represent a physical entity. Therefore, once the steps of the editing method in question have been defined, the implementation of the technical means to be used in these steps, at least at the level of generality specified in claim 1, involves no more than the straightforward application of conventional techniques. The board held, in conformity with its decision in case **T 22/85**, commented on above, that the mere setting out of the sequence of steps necessary to perform an activity, excluded as such from patentability under Art. 52(2) and (3) EPC 1973, in terms of functions or functional means to be realised with the aid of conventional computer hardware elements does not import any technical considerations and cannot, therefore, lend a technical character to that activity and thereby overcome the exclusion from patentability.

In **T 38/86** (OJ 1990, 384) the board first of all had to assess the patentability of a method for automatically detecting and replacing linguistic expressions which exceeded a predetermined level of understanding in a list of linguistic expressions. The board was of the opinion that a person who wished to carry out such a task using his skills and judgment would perform purely mental acts within the meaning of Art. 52(2)(c) EPC 1973; the schemes, rules and methods used in performing such mental acts were not inventions within the meaning of Art. 52(1) EPC 1973. The board stated that the use of technical means for carrying out a method, partly or entirely without human intervention, which, if performed by a human being, would require him to perform mental acts, **might**, having regard to Art. 52(3) EPC 1973, render such a method a technical process or method and thus an invention within the meaning of Art. 52(1) EPC 1973. Since patentability was excluded only to the extent to which the patent application related to excluded subject-matter or activities as such, it appeared to be the intention of the Convention to permit patenting in those cases in which the invention involved a contribution to the art in a field not excluded from patentability. In the case in point this condition was not satisfied: once the steps of the method for performing the mental acts in question had been defined, the implementation of the technical means to be used in those steps involved no more than the straightforward application of conventional techniques and had therefore to be considered obvious to a person skilled in the art. If a claim for an apparatus (here, a word processing system) for carrying out a method did

not specify any technical features beyond those already comprised in a claim pertaining to said method and furthermore did not define the apparatus in terms of its physical structure, but only in functional terms corresponding to the steps of that method, the board stated that the claimed apparatus did not contribute anything more to the art than the method, in spite of the fact that the claim was formulated in a different category. In such cases, if the method was excluded from patentability, so was the apparatus.

Decision **T 38/86** was confirmed by decision **T 121/85**. The claims related to word processing carried out by a word processing system including a processor controlled by a computer program. The board concluded that nothing in the disclosure pointed to a contribution, such as a program, going beyond the fields of linguistics and computer functioning directly derived from the linguistic rules to be applied (the applicant had claimed software solutions to the linguistic problem of checking the spelling of a word). Thus the claim was excluded from patentability under Art. 52(2)(c) and (3) EPC 1973.

In **T 95/86** the applicant had claimed a method of text editing. The board found the activity of editing a text to be principally concerned with its linguistic and layout features. The editing of a text as such - even performed with the aid of a machine - therefore fell within the category of schemes, rules and methods for performing mental acts which under Art. 52(2)(c) and (3) EPC 1973 were not patentable. The board took the view that the mere setting out of the sequence of steps necessary to perform an activity - excluded as such from patentability - did not import any technical considerations, even if those steps were described as functions or functional means to be implemented with the aid of conventional computer hardware elements.

In **T 110/90** (OJ 1994, 557) the invention was for a method of transforming a first editable document form prepared using a batch word processing system into a second editable document form for use on an interactive or batch word processing system. Following **T 163/85** (OJ 1990, 379) the board found that control items (e.g. printer control items) included in a text represented in the form of digital data were characteristic of the word-processing system in which they occurred in that they were characteristic of the technical internal working of that system. Such control items therefore represented technical features of the word-processing system in which they occurred. Consequently, transforming control items which represented technical features belonging to one word-processing system into those belonging to another word-processing system constituted a method of a technical nature.

In **T 71/91** the board considered the patentability of an electronic document system consisting of a plurality of processors or workstations which received and transmitted documents in the form of a data stream. The data represented both the contents of a document and information on the kind of processing to be performed relative to it. If a processor detected processing information which it was not capable of performing, that information was not merely ignored but was stored in a memory and retrieved when the data stream was transmitted to another processor. The data stream was thus reconstituted and the transmitted data was substantially the same as the received data, no information having been lost. The board held, following **T 38/86** (OJ 1990, 384), that it was clear that the claimed subject-matter made a contribution to the art in a field not

excluded from patentability. The board also pointed out that in an analogous case, **T 110/90** (OJ 1994, 557), the "control of hardware such as a printer" was held not to be excluded under Art. 52(2)(c) EPC 1973, since it was not concerned with "the linguistic meaning of words of the text". Similarly, in the case before the board, the data to be processed was also distinct from the content of the document itself.

The interrelationship of excluded and non-excluded features was considered in **T 236/91**. Following **T 208/84** (OJ 1987, 14), **T 38/86** (OJ 1990, 384) and **T 26/86** (OJ 1988, 19), the board reiterated that while the Convention did not prohibit the patenting of inventions consisting of a mix of excluded and non-excluded features, and since patentability was excluded only to the extent to which the patent application related to excluded subject-matter or activities as such, it appeared to be the intention of the Convention to permit patenting (only) in those cases in which the invention involved a contribution to the art in a field not excluded from patentability.

Applying this to the case at issue, the board found that even after the claimed computer had been found not to be obvious, it had still to be decided whether or not a technical contribution to the art had been made by the non-obvious feature or features of that computer. The gist of the claimed invention, in the board's view, could be seen in the fact that a sentence in natural language was parsed not only after it had been entered completely into the computer, but step by step after each word or phrase had been entered and that depending on the result of this parsing, a new menu presenting only a selection of possible continuations of the sentence was created; a selection which could not be predefined by the designer of the computer. In this sense, the internal working of the computer as claimed was not conventional and should, in the opinion of the board, be regarded as a technical effect.

2.6. Presentation of information

A presentation of information defined solely by the content of the information is not patentable. This applies whether the claim is directed to the presentation of the information per se or to processes and apparatus for presenting information.

In **T 163/85** (OJ 1990, 379), regarding a colour television signal characterised by technical features of the system in which it occurred, the board considered it appropriate to distinguish between two kinds of information when discussing its presentation; according to this distinction, a TV system solely characterised by the information per se, e.g. moving pictures modulated on a standard TV signal, might fall under the exclusion of Art. 52(2)(d) and (3) EPC 1973, but not a TV signal defined in terms which inherently comprised the technical features of the TV system in which it occurred; as the list of exclusions from patentability set out in Art. 52(2) EPC 1973 (in conjunction with Art. 52(3) EPC 1973) was not exhaustive in view of the phrase "in particular", the exclusion might arguably be generalised to subject-matter which was essentially abstract in character, non-physical and therefore not characterised by technical features within the meaning of R. 29(1) EPC 1973.

In **T 125/04** the board was of the opinion that, in general, the task of designing diagrams was non-technical (see **T 244/00** of 15 November 2001). This was so even if the diagrams arguably conveyed information in way which a viewer might intuitively regard as particularly appealing, lucid or logical.

In **T 77/92**, the invention concerned a method of selecting, in emergency situations, the correct patient treatment values, namely drug dosage, defibrillation technique energy and/or apparatus size. The method comprised measuring the body length of the emergency patient using a particular tape and rapidly selecting the said correct patient treatment values without the exercise of clinical expertise, calculation or reference to other data sources. The particular tape used had increments of heel-to-crown length, each increment bearing indications of the correct treatment value appropriate to that increment and predetermined by a co-relation between the measured heel-to-crown height of a patient and a correct treatment value. According to the established case law, for an invention not to be excluded from patentability, the board had to consider, in the case before it, whether the subject-matter claimed, which had to be assessed as a whole, was technical in character or provided a technical contribution to the prior art, i.e. a contribution in a field not excluded from patentability. After having defined the prior art, the board concluded that the decision under appeal did not adequately evaluate the co-relation between the heel-to-crown length of a patient and each of the treatment values provided on the measuring tape. This co-relation between the measured length and the information on the tape measure resulted in the tape used in the claimed methods becoming a new gauge for directly measuring the patient treatment values, just as an altimeter is obtained merely by replacing the scale of a pressure gauge with a scale indicating altitude. Such a new gauge for directly measuring the patient treatment values was clearly technical in character.

Further to **T 115/85** (OJ 1990, 30) the board ruled in **T 362/90** that the automatic visual display of the conditions prevailing or desirable in an apparatus or system was basically a technical problem. A claim directed to a device displaying (especially in heavy goods vehicles) both the gear in use and (by evaluating signals about engine performance) the best gear to be in, was not unpatentable under Art. 52(2)(d) EPC 1973, even if it did involve non-technical features relating to the presentation of information.

T 115/85 was taken into consideration by the board in **T 790/92**, where it was held that displaying messages indicating a specific event which might occur in the device in a processing system was basically a technical problem because, it involved the internal functioning of a device. In the case at issue, however, the board stated that it was not such a "technical" event or condition concerning the functioning of a device and therefore posing a technical problem which would give rise to a message, but a discrepancy between the information presented by the chart and the information the chart was normally intended to present. The board held that such a discrepancy between normal and modified presentations of information could not be considered to be of a technical nature.

In **T 887/92** one of the objects of the invention was to render the usual HELP facility provided with many computer programs more user-friendly. The board held that

automatically giving visual indications about conditions prevailing in an apparatus or system was basically a technical problem. Thus, the displaying of only valid commands in the help panel had technical character, because it clearly reflected the status or condition of the system. The computer program on which step (1) relied was considered to constitute a technical means for carrying out the invention.

In **T 599/93** a configuration for simultaneously displaying several images on one (computer) screen was claimed. The screen was divided into four sections, for example by means of one horizontal and one vertical demarcation line. The board was of the view that imparting information on events in a screen window by changing the colour of the relevant surface of the setting mark was not of a technical nature (no information was given for example on the operating status of the claimed configuration), but merely drew the user's attention to particular contents of the relevant images and thus served to present information within the meaning of Art. 52(2)(d) EPC 1973.

In **T 1194/97** (OJ 2000, 525) the patent application concerned a two-part picture retrieval system comprising a record carrier and a read device, i.e. two separate but cooperative articles which could be sold separately, but each of which was specially adapted to implement complementary aspects of the same inventive idea. Claim 1 was directed to the system while claim 4 sought to protect the record carrier per se. In accordance with a standard claiming practice with inventions of this kind - colloquially referred to as "bow and arrow" or "plug and socket" inventions - the record carrier of claim 4 was specified as being "for use in the system as claimed in claim 1". The examining division had interpreted claim 4 as specifying a known record carrier having data stored thereon, said data having no unambiguous technical function, and had concluded, with reference to Art. 52(2)(d) EPC 1973, that "for the purposes of assessing the technical merits of the record carrier, what is stored on the record carrier is effectively a mere presentation of information". The board regarded the examining division's interpretation of claim 4 as a misconstruction of the effect of the "for use" phrase. It pointed out that, on a proper construction of this phrase the record carrier of claim 4 had technical functional features - line numbers, coded picture lines and addresses and synchronisations - which were adapted to cooperate with corresponding means in the read device to provide a picture retrieval system (see also **T 643/00**).

Applying and extending the ratio decidendi of **T 163/85** by analogy, the board held that the record carrier of claim 4 was not excluded under Art. 52(2)(d) and (3) EPC 1973, since it had functional data recorded thereon, in particular a data structure of picture line synchronisations, line numbers and addresses. In order to lend additional support to its view in relation to a data structure product, the board also referred to decision **T 1173/97** (OJ 1999, 609) and, in particular, to the observation made in that decision at point 9.4 of the reasons to the effect that the predetermined potential technical effect of a program recorded on a carrier could endow such a product with technical character sufficient to overcome the exclusions under Art. 52(2) and (3) EPC 1973.

B. Exceptions to patentability

1. Introduction

As part of the EPC 2000 revision, several amendments were made to Art. 53 EPC. However, these are unlikely to affect the EPO's practice (see OJ SE 4/2007):

Art. 53(a) EPC was brought into line with Art. 27(2) of the TRIPS Agreement and Art. 6(1) of Directive 98/44/EC on the legal protection of biological inventions. These exclude from patentability only those inventions whose commercial exploitation has to be proscribed to protect "ordre public" and morality. Consequently, the words "publication or" were deleted from Art. 53(a) EPC and the term "commercial" added (MR/2/00, 45). In the German version, moreover, the term "Tierarten" in Art. 53(b) EPC was replaced by "Tierrassen" to bring it into line with the EC Directive and R. 23c(b) EPC 1973 (MR/2/00, 45).

In addition, the exclusion of medical methods which had previously been enshrined in Art. 52(4) EPC 1973 was transferred to Art. 53 EPC. These methods had formerly been excluded from patentability through the legal fiction that they were not susceptible of industrial application. However, since medical methods are excluded from patentability mainly in the light of public health considerations, it appeared appropriate to include these inventions also under exceptions to patentability (MR/2/00, 45).

Accordingly, Art. 53 EPC, which applies without restriction to European patents and patent applications since the EPC 2000 entered into force, now defines three exceptions to patentability: (a) inventions the commercial exploitation of which would be contrary to 'ordre public' or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States; (b) plant varieties or animal species or essentially biological processes for the production of plants or animals; this does not apply to microbiological processes or the products thereof; (c) methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

The provisions of R. 23b to 23e EPC 1973 (R. 26 to 29 EPC) are substantively unchanged (see OJ SE 5/2007).

The case law indicates that any exceptions to patentability must be narrowly construed. In respect of Art. 53(a) EPC 1973, see **T 356/93** (OJ 1995, 545) and **T 866/01**, but also **T 1374/04** (OJ 2007, 313); in respect of Art. 53(b) EPC 1973, see **T 320/87** (OJ 1990, 71), **T 19/90** (OJ 1990, 476) and **T 315/03** (OJ 2006, 15); regarding Art. 53(c) EPC (Art. 52(4) EPC 1973) see **T 144/83** (OJ 1986, 301), **T 385/86** (OJ 1988, 308) and **G 1/04** (OJ 2006, 334). Given the ratio legis of the individual provisions, however, this narrow interpretation produces different results: a claim which embraces plant/animal varieties, but does not claim them individually, is not excluded from patentability under Art. 53(b) EPC 1973 (**G 1/98**, OJ 2000, 111; **T 19/90**, OJ 1990, 476; **T 315/03**, OJ 2006,

15). According to the established case law of the boards of appeal, a method claim falls under the prohibition of Art. 52(4) EPC 1973 (Art. 53(c) EPC) if it includes at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by surgery or therapy (see Chapter I.B.4.2). By contrast, several method steps are required to define a diagnostic method within the meaning of Art. 52(4) EPC 1973 (Art. 53(c) EPC) owing to the inherent and inescapable multi-step nature of such a method (**G 1/04**, OJ 2006, 334). In **T 19/90** it was also stated that the object and purpose of the law (ratio legis) was not merely a matter of the legislator's intention at the time when the law was adopted, but also of their presumed intention in the light of changes in circumstances which had taken place since then.

Living matter is not generally excluded from patentability under the EPC. Past case law on this issue is not affected by the amendments to the EPC.

It was held in **T 356/93** (OJ 1995, 545) that seeds and plants per se should not constitute an exception to patentability under Art. 53(a) EPC 1973 merely because they represented 'living' matter, or on the ground that plant genetic resources should remain the 'common heritage of mankind'.

Referring to Art. 53(b) EPC 1973, the board in **T 49/83** (OJ 1984, 112) stated that no general exclusion of inventions in the sphere of animate nature could be inferred from the Convention. According to **T 19/90** (OJ 1990, 476), the exception to patentability under Art. 53(b) EPC 1973 applies to certain categories of animals but not to animals as such. The Enlarged Board stated in **G 1/98** (OJ 2000, 111) that a claim wherein specific plant varieties are not individually claimed is not excluded from patentability under Art. 53(b) EPC 1973, even though it may embrace plant varieties.

2. Breaches of "ordre public" or morality

In the past, this issue has arisen mainly in connection with biotechnological inventions.

One of the most important cases concerned a patent relating to **transgenic animals having an increased probability of developing cancer**. The application had initially been refused by the Examining Division on the grounds of Art. 53(b) EPC 1973, which prevented the patenting of animal varieties, and of insufficiency of disclosure under Art. 83 EPC 1973, since it could not be assumed that the only examples in the application, namely mice, could be extended to all other animals. Art. 53(a) EPC 1973, which excluded patents for inventions the publication or exploitation of which would be contrary to "ordre public" or morality, was also considered. However, it was concluded that patent law was not appropriate for resolving the potential problems thereby raised.

The applicant appealed against that decision and, in **T 19/90** (OJ 1990, 476), it was held that Art. 53(b) EPC 1973 applied to certain categories of animals but not to animals as such; and that, in the absence of serious doubts substantiated by verifiable facts, there was no reason to refuse the application under Art. 83 EPC 1973 on the ground that it involved an extrapolation from mice to mammals in general. As regards Art. 53(a) EPC 1973, the board expressed the view that in cases such as this of genetic manipulation of

animals by the insertion of an activated oncogene, there were compelling reasons to consider this Article. As this had not been done at the level of the first instance, the board remitted the case to the examining division with the instruction to carry out a careful **weighing up** of the suffering of animals and possible risks to the environment on the one hand, and the invention's usefulness to mankind on the other, before deciding whether to grant or refuse the patent application.

In its decision (OJ 1992, 588), the examining division finally granted a patent. Seventeen oppositions were filed against it based in particular on Art. 53(a) and (b) EPC 1973, as exploitation of the invention would be contrary to morality and "ordre public" and some of the claims were to animal varieties. It was maintained in amended form with independent claims directed to rodents. Appeals were filed against this decision by several of the opponents. These came before the board in **T 315/03** (OJ 2006, 15). Its findings concerning Art. 53(a) EPC 1973 are summarised below (on the issue of the non-patentability of animal varieties under Art. 53(b) EPC 1973, see point 3.2 below).

The board held that R. 23b to 23e EPC 1973 (new R. 26 to 29 EPC), applied to cases such as the one at issue which was pending on the date when, as provided for by the legislator, those Rules took effect (1.9.1999).

R. 23d EPC 1973 specified that European patents should not be granted under Art. 53(a) EPC 1973 for four categories of biotechnological inventions. The board decided that a case falling within one of these categories had ipso facto to be denied a patent under Art. 53(a) EPC 1973 and there would be no need to consider that Article further. However, a case which did not fall within one of those categories had still to be considered further under Art. 53(a) EPC 1973. Thus, in cases falling within it, R. 23d EPC 1973 inserted an objection under Art. 53(a) EPC 1973 (a "R. 23d type" Art. 53(a) EPC 1973 objection), which, depending on the facts and thus on the outcome of the test, might be either additional or alternative to an objection under Art. 53(a) EPC 1973 itself (a "real" Art. 53(a) EPC 1973 objection) as developed by the case law. This latter objection required an assessment as to whether or not exploitation of the invention would be contrary to morality or "ordre public".

One of the four categories under R. 23d EPC 1973 provided that European patents should not be granted in respect of processes for modifying the genetic identity of animals which were likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes. The board rejected submissions that this Rule was ultra vires or inconsistent either with the principle of narrow construction of exclusions or with the previous law.

Furthermore, this test according to R. 23d(d) EPC 1973 required **only** three matters to be considered: animal suffering, medical benefit and the necessary correspondence between the two in terms of the animals in question. The level of proof was the same for both animal suffering and substantial medical benefit, namely a likelihood.

In the assessment of a "real" Art. 53(a) EPC 1973 objection, no single definition of morality based on e.g. economic or religious principles represented an accepted

standard in European culture. Opinion poll evidence was of very limited value for the reasons given in **T 356/93** (OJ 1995, 545), where many drawbacks were identified, ranging from the type and the number of questions posed within one poll, through the size and representative nature of the cross-section of the population polled, to the manner of interpretation of the results obtained.

In **T 315/03** (OJ 2006, 15) the board held that, in animal manipulation cases, the test in **T 19/90** (OJ 1990, 476) was appropriate. This differed in several respects from the test in R. 23d(d) EPC 1973, most importantly by allowing matters other than animal suffering and medical benefit to be taken into account. Whereas the R. 23d(d) EPC 1973 test only required a likelihood of animal suffering, however minor, and a likelihood of achieving a medical benefit, the test in the present decision required a "careful weighing up" of the matters to be balanced. This clearly allowed an appraisal of animal suffering, of environmental risks and of the feasibility of using non-animal alternatives. A wider range of benefits to mankind than the substantial medical benefit found in R. 23d(d) EPC 1973 could also be considered. Since the test in the said decision was "mainly" the basis of assessment, further arguments as to the appropriate standard of morality or "ordre public" could additionally be considered, but all arguments had to be supported by evidence.

Assessment of both a "R. 23d type" (now "R. 28 type") and a "real" Art. 53(a) EPC 1973 objection was to be made as of the filing or priority date of the patent or application in suit. Evidence arising thereafter might be taken into account provided it was directed to the position at that date.

The board found that claims directed to rodents failed the R. 23d(d) EPC 1973 test and had therefore to be refused under Art. 53(a) EPC 1973, as the patent disclosed a likelihood of animal suffering but not a likelihood of medical benefit when applying the invention to this generic class of animals. The same conclusion would have been reached under a "real" Art. 53(a) EPC 1973 assessment. However, both tests were satisfied when the invention was restricted to mice.

The issue of morality had also been raised in **T 356/93** (OJ 1995, 545), this time in connection with plants. The object of the invention was **plants and seeds resistant to a particular class of herbicides** so that they could be selectively protected against weeds and fungal diseases. This was achieved by stably integrating into the genome of the plants a heterologous DNA encoding a protein capable of inactivating or neutralising the herbicides. The patent was opposed under Art. 53(a) EPC 1973, in particular on the grounds that the exploitation of the invention was likely to cause serious damage to the environment.

The board acknowledged that it might be difficult to judge whether or not a claimed subject-matter was contrary to "ordre public" or morality, but that nonetheless, the provisions of Art. 53(a) EPC 1973 could not be disregarded. Each particular case had to be considered on its merits.

The board defined the concept of "**ordre public**" as covering the protection of public security and the physical integrity of individuals as part of society. It also encompassed the protection of the environment. Accordingly, inventions the exploitation of which was likely to seriously prejudice the environment were to be excluded from patentability as being contrary to "ordre public".

The concept of **morality** was related to the belief that some behaviour was right and acceptable whereas other behaviour was wrong, this belief being founded on the totality of the accepted norms which were deeply rooted in a particular culture. For the purposes of the EPC, the culture in question was the culture inherent in European society and civilisation. Accordingly, inventions the exploitation of which was not in conformity with the conventionally accepted standards of conduct pertaining to this culture were to be excluded from patentability as being contrary to morality.

Thus, the question to be decided in respect of Art. 53(a) EPC 1973 was whether the exploitation of any of the claimed subject-matter was likely to seriously prejudice the environment or whether it related to a misuse or destructive use of plant biotechnological techniques.

In the view of the board, the revocation of a patent under Art. 53(a) EPC 1973 on the grounds that the exploitation of the invention would seriously prejudice the environment presupposed that the threat to the environment be sufficiently substantiated at the time the decision to revoke the patent was taken by the EPO.

In the specific case the board held that, although the documents submitted by the appellant (opponent) provided evidence of possible hazards from the application of genetic engineering techniques to plants, they did not lead to the definite conclusion that the exploitation of any of the claimed subject-matter would seriously prejudice the environment.

Moreover, the board found that none of the claims related to subject-matter which could lead to a misuse or destructive use of plant biotechnological techniques because they concerned activities (production of plants and seeds, protection of plants from weeds or fungal diseases) and products (plant cells, plants, seeds) which could not be considered to be wrong as such in the light of the conventionally accepted standards of conduct of European culture. Plant biotechnology per se could not be regarded as being more contrary to public morality than traditional selective breeding.

For these reasons, the board concluded that Art. 53(a) EPC 1973 did not constitute a bar to patentability in this particular case.

Regarding the compatibility with Art. 53(a) EPC 1973 of an invention involving genetically modified, herbicide-resistant plants, see also **T 475/01**.

The patent in suit in **T 272/95** (OJ 1999, 590) concerned "Molecular cloning and characterization of a further gene sequence coding for human relaxin". In the opposition proceedings, the opposition division decided that an invention concerning a human gene

did not constitute an exception to patentability because it would not be universally regarded as outrageous.

On appeal by the opponents, the board considered R. 23e(2) EPC 1973 (new R. 29(2) EPC). This Rule defined which **biological material originating from the human body** might be patented ("an element isolated from the human body or otherwise produced by means of a technical process including the sequence or partial sequence of a gene [...], even if the structure of that element is identical to that of a natural element"). Having regard to Art. 164(2) EPC 1973, the board then had to examine whether or not the new rules insofar as they related to Art. 53(a) EPC 1973 were in conformity with that Article. Following **G 1/98** (OJ 2000, 111), the board adopted the view that the rules related to the articles were to be only interpretative. They only gave a more detailed interpretation of the meaning of Art. 53 EPC 1973 as intended from its inception, and hence were applicable to cases already pending before their introduction.

It thus followed from the text of the Rule itself that the subject-matter was not to be considered as an exception to patentability under Art. 53(a) EPC 1973 (i.e. inventions contrary to "ordre public" or morality).

The invention in **T 1213/05** related to the **human BRCA1 gene isolated** from the genome, mutant forms of that gene and its use in the diagnosis of predisposition to **breast and ovarian cancer**. The board held that the EPC contained no provision establishing a requirement for applicants to submit evidence of a previous informed consent of the donor of the cells or benefit sharing agreement. Directive 98/44/EC which had to be used as supplementary means of interpretation (R. 23b(1) EPC 1973) stated in its Recital 26 that "... the person from whose body the material is taken must have had an opportunity of expressing free and informed consent thereto, in accordance with national law". The legislator had thus not provided for a procedure of verifying the informed consent in the framework of the grant of biological patents under the EPC. The board referred to ECJ judgment C-377/98 concerning the application for annulment of the Directive, where the Court had rejected the plea of the Kingdom of the Netherlands that the absence of a provision requiring verification of the consent of the donor or recipient of products obtained by biotechnological means undermined the right to self-determination. The Directive concerned only the grant of patents and therefore did not extend to activities before and after grant, whether they involved research or the use of the patented products.

Concerning the argument of opponent 2 that the socio-economic consequences of the patenting of the claimed subject-matter should be considered under Art. 53(a) EPC 1973, the board pointed out that Art. 53(a) referred to the "exploitation of the invention" not to the "exploitation of the patent".

One of the questions referred to the Enlarged Board of Appeal in **T 1374/04** (OJ 2007, 313) concerned the issue of whether R. 23d (c) EPC 1973 (now R. 28(c) EPC) forbade the patenting of claims relating to products (here: **human embryonic stem cell cultures**) which at the filing date could be prepared exclusively by a method which necessarily involved the destruction of the human embryos from which the said products

were derived, if the said method was not part of the claims. The Enlarged Board of Appeal stated in **G 2/06** (OJ 2009, 306) that R. 28(c) EPC forbids the patenting of claims relating to products which - as described in the application - at the filing date could be prepared exclusively by a method which necessarily involved the destruction of the human embryos from which the said products are derived, even if the said method is not part of the claims. In this context it is not of relevance that after the filing date the same products could be obtained without having to recur to a method necessarily involving the destruction of human embryos.

According to **T 522/04**, it followed from **G 2/06** (OJ 2009, 306) that also methods involving the destruction of human embryos are to be regarded as non patentable. In the present case, the contested claim was directed to a method of proliferating *in vitro* a clonal population of neural crest stem cells of mammalian origin. This clearly included cells of human origin. The argument of the appellant (applicant) that the cells referred to in the claimed method could be obtained not only from embryos but also from the adult peripheral and central nervous system, was not supported by the application as filed. Since the only teaching of how to prepare human neural crest stem cell cultures was the use (involving their destruction) of human embryos, the board concluded that at the filing date **human** neural crest stem cells could be prepared exclusively by a method which necessarily involved the destruction of human embryos - with the inescapable result that the invention fell under the prohibition of Art. 53(a) EPC combined with R. 28(c) EPC.

3. Patentability of biological inventions

3.1. Plants and plant varieties

According to Art. 53(b) EPC (whose revised version in this respect contains no amendments), a patent shall not be granted if the claimed subject-matter is directed to plant varieties. If a product claim does not specify any particular plant variety, but a **technical teaching which can be embodied in an unspecified number of plant varieties**, the subject-matter of the claimed invention does not relate to a plant variety or varieties within the meaning of Art. 53(b) EPC. Thus, a patent shall not be granted for a single plant variety but can be granted if varieties may fall within the scope of the claims. If plant varieties are individually claimed, they are not patentable, irrespective of how they were made (**G 1/98**, OJ 2000, 111). The term 'plant variety' is defined in R. 26(4) EPC (R. 23b(4) EPC 1973) as follows: "Any plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety are fully met, can be:

- (a) defined by the expression of the characteristics that results from a given genotype or combination of genotypes,
- (b) distinguished from any other plant grouping by the expression of at least one of the said characteristics, and
- (c) considered as a unit with regard to its suitability for being propagated unchanged."

The Enlarged Board came to the conclusion in **G 1/98** that a correct interpretation of Art. 53(b) EPC 1973 did not exclude the granting of patents for transgenic plants, where specific plant varieties were not identified, even if the claims embraced inter alia plant varieties. The Enlarged Board took the view that Art. 53(b) EPC 1973 defined the borderline between patent protection and plant variety protection. The extent of the exclusion for patents was the obverse of the availability of plant variety rights. Since plant variety rights were only granted for specific plant varieties and not for technical teachings which could be implemented in an indefinite number of plant varieties, it was not sufficient for the exclusion from patent protection in Art. 53(b) EPC 1973 to apply that one or more plant varieties were embraced or might be embraced by the claims of the patent application (see also **T 475/01**).

The Enlarged Board further held that Art. 64(2) EPC 1973 should not be taken into consideration when a claim to a process for the production of a plant variety was examined, in conformity with the established case law according to which the protection conferred by a process patent was extended to the **products obtained directly by the process**, even if the products were not patentable per se (see Chapters II.B.6.1 and 6.2).

Finally, the Enlarged Board held that the exception to patentability in Art. 53(b), first half-sentence, EPC 1973, applied to plant varieties irrespective of the way in which they were produced. Therefore, plant varieties containing genes introduced into an ancestral plant by recombinant gene technology were excluded from patentability. The underlying reason for this was that the exclusion in Art. 53(b) EPC 1973 was made to serve the purpose of excluding from patentability subject-matter which was eligible for protection under the plant breeders' rights system. It did not make any difference for the requirements under the UPOV Convention or under the Regulation on Plant Variety Rights, whether a variety was obtained by traditional breeding techniques or genetic engineering. This meant that the term 'plant variety' was appropriate for defining the borderline between patent protection and plant breeders' rights protection irrespective of the origin of the variety. The argument that the legislator of the Convention did not envisage the possibility of **genetically modified plant varieties** and for this reason could not have had the intention of excluding them from patentability could not be accepted - laws were not restricted in their application to situations known to the legislator.

Some of the earlier decisions on this issue are now only of historical interest; others, however, have been confirmed by **G 1/98** (see above) or later decisions:

T 49/83 (OJ 1984, 112) first defined the term 'plant varieties' as a multiplicity of plants which were largely the same in their characteristics and remained the same within specific tolerances after every propagation cycle. Following on from this, the board in **T 320/87** (OJ 1990, 71) concluded that **hybrid seed and plants**, lacking stability in some trait of the whole generation population, could not be classified as plant varieties within the meaning of Art. 53(b) EPC 1973. In this regard, see also **T 788/07** according to which hybrid seed or plants thereof were not considered as units with regard to their "suitability for being propagated unchanged" (R. 26(4)(c) EPC; formerly R. 23b(4)(c) EPC 1973)

and were therefore not regarded as plant varieties which were excluded from patentability.

In **T 356/93** (OJ 1995, 545) the board held that **plant cells** as such, which modern technology allows to culture much like bacteria and yeasts, could not be considered to fall under the definition of a plant or of a plant variety. This was confirmed by **G 1/98** (see above), which stated that plant cells should be treated like micro organisms.

However, the board's conclusion in **T 356/93** that a product claim which embraced within its subject-matter "plant varieties" was not patentable under Art. 53(b), first half-sentence, EPC 1973, was overruled by **G 1/98**.

3.2. Animals and animal species

As part of the EPC revision, the term "Tierarten" in the German version of Art. 53(b) EPC was replaced by "Tierrassen" to bring it into line with the EC Directive and R. 23c(b) EPC 1973 (R. 27(b) EPC) (see MR/2/00, 45). The case law to date already arrived at a uniform interpretation without any reference to a taxonomic category in a particular language version.

The boards of appeal have asserted the general principle that the exception to patentability under Art. 53(b) EPC 1973 applies to certain categories of animals, but **not to animals as such** (e.g. **T 19/90**, OJ 1990, 476).

In interpreting the term "animal varieties" the board in this decision emphasised the narrow interpretation to be given to the provisions of Art. 53(b) EPC 1973. Bearing in mind that for animals - unlike plant varieties - no other industrial property right was available, the board decided that the exception to patentability under Art. 53(b) EPC 1973 applied to certain categories of animals but not to animals as such. It thus constituted no bar to patentability for subject-matter which was not covered by any of the terms "animal varieties", "races animales" or "Tierarten".

In the same decision the board stated that under Art. 53(b) EPC 1973, the general principle of patentability contained in Art. 52(1) EPC 1973 was restored for inventions involving microbiological processes and the products of such processes. The bar on patenting under Art. 53(b), first half-sentence, EPC 1973, did not extend to the products of a micro-biological process which were patentable under Art. 53(b), second half-sentence, EPC 1973. Thus patents were held to be grantable for **animals produced by a microbiological process**, although this term was not defined.

Concerning the patentability of animals, it was held in **T 315/03** (OJ 2006, 15) that, in an assessment under Art. 53(b) EPC 1973, the principle enunciated in **G 1/98** (OJ 2000, 111) concerning plants and "plant varieties" should also be followed in the case of animals. This meant that a patent could not be granted for a single animal variety (or species or race, depending on which language text of the EPC 1973 was used) but could be granted if varieties might fall within the scope of its claims.

The definition of animal variety (or species or race) by reference to taxonomical rank would be consistent with the position in relation to plant varieties and also in the interest of legal certainty. It would allow assessment under Art. 53(b) EPC 1973 as interpreted by R. 23c(b) EPC 1973 to be made by considering whether the technical feasibility of the invention was not confined to a particular animal variety (or species or race).

The board further pointed out that the different terms used in each official language were inconsistent and denoted different taxonomical categories. Thus strict compliance with Art. 177(1) EPC 1973 - which provided that the three texts of the EPC 1973 were equally authentic - would lead to the absurd result that the outcome of an Art. 53(b) EPC 1973 objection would depend on the language of the case, with German having the highest taxonomic order "species" ("Tierarten") and thereby offering the widest objection.

The board did not agree with the assertion of some of the opponent appellants that the transgenic mice of the patent were a new species because they inherited one particular characteristic, namely an increased probability of developing tumours. This was not enough to create a new species when the possible "starting material" might be any of a whole genus of animals, namely all mice.

Nor could the board agree that a process which included genetic manipulation could be "an essentially biological process", the latter being defined in R. 23b(5) EPC 1973 as consisting "entirely of natural phenomena such as crossing or selection".

The board therefore held that Art. 53(b) EPC 1973 did not exclude the patentability of the claims amended to encompass only mice and maintained the patent on that basis.

3.3. Essentially biological processes

Processes for the production of plants or animals are not patentable (under either the old or the revised version of the EPC) if they are essentially biological processes. Non-essentially biological processes, on the other hand, are patentable.

Several decisions explain that a process which includes the **transformation** of cells or tissue with recombinant DNA is not an "essentially biological process" within the meaning of Art. 53(b) EPC.

In **T 19/90** (OJ 1990, 476) the board agreed that the process claims for the production of transgenic non-human mammals through chromosomal incorporation of an activated oncogene sequence into the genome of the non-human mammal did not involve an "essentially biological process" within the meaning of Art. 53(b) EPC 1973. The product claim for the genetically-manipulated animal included descendants not directly genetically manipulated themselves but produced by the essentially biological process of sexual reproduction. The board held that this was a product claim defined in terms of the process by which it was produced and that a product-by-process claim remained a product claim irrespective of the process it referred to.

In **T 356/93** (OJ 1995, 545) the board had to decide on a process for producing plants which comprised transforming plant cells or tissue with recombinant DNA and subsequently regenerating and replicating the plants or seeds. Following **T 320/87** (OJ 1990, 71), the board held that the process as a whole was not "essentially biological" within the meaning of Art. 53(b) EPC 1973, because the transformation step, regardless of whether or not its performance depended on chance, was an essential technical step which had a decisive impact on the desired final result and could not occur without human intervention.

In **T 315/03** (OJ 2006, 15) the board found that a process which included genetic manipulation could not be "an essentially biological process", the latter being defined in R. 23b(5) EPC 1973 (which was added by virtue of a decision of the Administrative Council of 16.6.1999 and entered into force on 1.9.1999, OJ 1999, 437) as consisting "entirely of natural phenomena such as crossing or selection".

The referrals in cases **T 83/05** and **T 1242/06**, which are currently pending as **G 2/07** and **G 1/08**, concern plant breeding processes in which the essence of the method is "classical" plant breeding technology.

In **T 83/05** the board referred the following questions to the Enlarged Board of Appeal:

1. Does a non-microbiological process for the production of plants which contains the steps of crossing and selecting plants escape the exclusion of Art. 53(b) EPC 1973 merely because it contains, as a further step or as part of any of the steps of crossing and selection, an additional feature of a technical nature?
2. If question 1 is answered in the negative, what are the relevant criteria for distinguishing non microbiological plant production processes excluded from patent protection under Art. 53(b) EPC 1973 from non excluded ones? In particular, is it relevant where the essence of the claimed invention lies and/or whether the additional feature of a technical nature contributes something to the claimed invention beyond a trivial level?

The respondent (patent proprietor) claims a method for the production of brassica oleracea with elevated levels of the anticarcinogenic compounds 4-MSB GSL or 3-MSP GSL or both, which method comprises (a) crossing one of two specified wild Brassica species with broccoli double haploid breeding lines, (b) selecting hybrids with elevated levels of said compounds, (c) backcrossing and selecting plants with the genetic combination encoding the expression of elevated levels of said compounds and (d) selecting a broccoli line with a specified level of said compounds, and wherein molecular markers are used in steps (b) and (c).

In the referral decision the board pointed out that Art. 53(b) EPC 1973 had been interpreted differently by the boards, on the one hand, and by the Administrative Council, when introducing R. 23b(5) EPC 1973, on the other. Whereas in **T 320/87** and **T 356/93** it was held that the applicability of the exclusion had to be judged on the basis of the essence of the invention, taking into account the totality of human intervention and its

impact on the result achieved, R. 23b(5) EPC 1973 limits the meaning to processes consisting "entirely of natural phenomena such as crossing and selection". The board took the view that the introduction of R. 23b(5) EPC 1973 did not finally settle the question as to what the correct approach was and developed three lines of argument to put into question or to limit the applicability of this rule.

In the case at issue the outcome depends on the question as to which of the two approaches (judgment on the basis of the essence of the invention or restrictive approach as provided in R. 23b(5) EPC 1973) prevails, as, in the board's judgment, neither the use of molecular markers, nor the use of a double haploid strain as starting material, nor the human intervention necessary to cross the wild Brassica strains with the broccoli breeding lines were able to contribute anything beyond a trivial level to the claimed invention. The board saw the technical problem to be solved rather in the identification of wild Brassica species which can be used to increase the level of the anticarcinogenic compounds when used in a cross with a commercial cultivar.

In case **T 1242/06**, the same board in a different composition referred three questions of law to the Enlarged Board of Appeal, questions 2 and 3 corresponding to a large extent to questions 2 and 3 above. Question 1 asks whether a non-microbiological process for the production of plants consisting of steps of crossing and selecting plants falls under the exclusion of Art. 53(b) EPC (not substantially amended in the course of the revision of the EPC) only if these steps reflect and correspond to phenomena which could occur in nature without human intervention.

Claim 1 of appellant I's main request and auxiliary request I related to a method for breeding tomato plants that produce tomatoes with reduced fruit water content. The board considered that if the interpretation of Art. 53(b) EPC 1973 in decision **T 320/87** (where the necessity for human intervention alone was not regarded as a sufficient criterion for its not being "essentially biological") was still the correct one, the subject-matter of claim 1 of appellant I's main request and auxiliary request I would not escape the exclusion. The arguments put forward by appellant I in order to show that the claimed method required a high level of human intervention could not alter the conclusion that the essence of the method was "classical" plant breeding technology. Neither the necessity of an interspecific cross nor the choice of an unusual selection criterion nor the existence of technical steps such as weighing and drying take the claimed method outside the realm of classical plant breeding technology which frequently uses corresponding elements of human intervention.

According to decision **T 320/87** (OJ 1990, 71) cited above, whether or not a (non-microbiological) process was to be considered as "essentially biological" within the meaning of Art. 53(b) EPC 1973 had to be judged on the basis of the **essence of the invention**, taking into account the totality of human intervention and its impact on the result achieved. The necessity for human intervention alone was not a sufficient criterion for its not being "essentially biological". Human interference might only mean that the process was not a "purely biological" process, without contributing anything beyond a trivial level. It was further not a matter simply of whether such intervention was of a quantitative or qualitative character.

In this particular case, it was concluded that the claimed processes for the preparation of hybrid plants did not constitute an exception to patentability because they represented an essential modification of known biological and classical breeders' processes, and the efficiency and high yield associated with the product showed important technological character.

3.4. Microbiological processes and the products thereof

Art. 53(b), second half-sentence, EPC contains a minor, purely editorial amendment vis-à-vis EPC 1973 in the English version only, and is otherwise unchanged.

In **T 356/93** (OJ 1995, 545) the board referred to **T 19/90** (OJ 1990, 476), which held that animal varieties were patentable if they were the product of a microbiological process within the meaning of Art. 53(b), second half-sentence, EPC 1973, and concluded that this principle applied *mutatis mutandis* to plant varieties. The board then defined the term "micro-organism" as including not only bacteria and yeasts, but also fungi, algae, protozoa and human, animal and plant cells, i.e. all generally unicellular organisms with dimensions beneath the limits of vision which can be propagated and manipulated in a laboratory, including plasmids and viruses.

Accordingly, the board interpreted the term "microbiological" as qualifying technical activities in which direct use was made of micro-organisms. These included not only traditional fermentation and biotransformation processes, but also the manipulation of micro-organisms by genetic engineering or fusion techniques, the production or modification of products in recombinant systems, etc., i.e. briefly all activities in which an integrated use is made of biochemical and microbiological techniques, including genetic and chemical engineering techniques, in order to exploit the capacities of microbes and cultured cells.

The board thus defined the concept of "microbiological processes" under Art. 53(b) EPC 1973 as processes in which micro-organisms are used to make or modify products or in which new micro-organisms are developed for specific uses. The concept of "the products thereof" encompassed, in the board's view, products which were made or modified by micro-organisms as well as new micro-organisms as such.

Although the Enlarged Board confirmed in **G 1/98** (OJ 2000, 111) the above definition of "micro organism", it went on to say that processes of genetic engineering are not identical with microbiological processes. The term microbiological processes in Art. 53(b) EPC 1973 was used as synonymous with processes using micro-organisms. Micro-organisms are different from the parts of living beings used for the genetic modification of plants. To treat genetically-modified plants as products of microbiological processes within the meaning of Art. 53(b), second half-sentence, EPC 1973, would disregard the purpose of the exclusion of plant varieties in Art. 53(b) EPC 1973, i.e. excluding from patentability subject-matter which was eligible for protection under the plant breeders' rights system. Therefore, the Enlarged Board took the view that it did not make any difference for the requirements under the UPOV Convention or under the Regulation on Plant Variety Rights, how a variety was obtained. Whether a plant variety

was the result of traditional breeding techniques, or whether genetic engineering was used to obtain a distinct plant grouping, did not matter. This meant that the term "plant variety" was appropriate for defining the borderline between patent protection and plant breeders' rights protection irrespective of the origin of the variety.

Examining the patentability of the claimed plant grouping, the board, in **T 356/93**, also addressed the issue whether **multi-step processes** for producing plants which include at least one **microbiological process step** (e.g. the transformation of cells with recombinant DNA) as a whole could be considered to represent "microbiological processes" within the meaning of Art. 53(b), second half-sentence, EPC 1973, and whether, owing to this, the products of such processes (e.g. plants) might be regarded as being "the products thereof" for the purposes of this provision.

The board held that "technical processes including a microbiological step" could not simply be equated with "microbiological processes". Nor could the resulting final products of such a process (e.g. plant varieties) be defined as "products of a microbiological process" within the meaning of the said provision.

The particular plant claimed was produced by a multi-step process which, in addition to the initial microbiological process step of transforming plant cells or tissue with recombinant DNA, comprised the step of regenerating plants from the transformed plant cells or tissue and the step of reproducing the plant material. The board held that the plant was not the product of a microbiological process. Although the initial microbiological process step undoubtedly had a decisive impact on the final result, because by virtue of this step the plant acquired its characterising feature which was transmitted throughout generations, the claimed plant was not merely the result of this (microbiological) initial step. The subsequent steps of regenerating and reproducing the plants had an important added value and contributed, although in a different manner, to the final result as well.

The board therefore concluded that, regardless of the decisive impact that the microbiological process step had on the final result, the multi-step process whereby the claimed plant was produced was **not a microbiological process** within the meaning of Art. 53(b), second half-sentence, EPC 1973, and that, accordingly, such a plant could not be considered to be "the product of a microbiological process".

R. 26(6) EPC (R. 23b(6) EPC 1973) defines a "microbiological process" as any process involving or performed upon or resulting in microbiological material. The boards have not yet issued a decision interpreting this definition.

4. Medical methods

4.1. Introduction

Art. 53(c) EPC states that European patents shall not be granted in respect of methods for treatment of the human or animal body by surgery or therapy and diagnostic methods

practised on the human or animal body; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

Consequently, the exclusion of methods of treatment and diagnostic methods formerly referred to in Art. 52(4) EPC 1973 has been added to the two exceptions to patentability and reappears in the new Art. 53(c) EPC. While these surgical or therapeutic methods constitute inventions, they were excluded from patentability by the fiction of their lack of industrial applicability. It was undesirable to uphold this fiction since methods of treatment and diagnostic methods are excluded from patentability in the interests of public health. It was therefore preferable to include these inventions in the exceptions to patentability in order to group the three categories of exceptions to patentability together in Art. 53(a), (b) and (c) EPC. Thus, a change in the EPO's current practice regarding these inventions is not envisaged (confirmed in **G 1/07**, OJ 2011, ^{***}, point 3.3.2.1 of the Reasons).

Further, as Art. 27(3)(a) TRIPs states that "diagnostic, therapeutic and surgical methods for the treatment of humans or animals" may be excluded from patentability, it was appropriate to transfer Art. 52(4) EPC 1973 to Art. 53(c) EPC with the aim of bringing the EPC into line with the TRIPs agreement (MR/2/00, p. 45).

In three (almost) identical decisions **G 1/83** in German, **G 5/83** in English and **G 6/83** in French, the Enlarged Board stated that the intention of Art. 52(4) EPC 1973 (now Art. 53(c) EPC) was only to prevent non-commercial and non-industrial medical and veterinary activities from being restrained by patent rights (applied, e.g. in **T 245/87**, OJ 1989, 171).

In **G 1/04** (OJ 2006, 334) the Enlarged Board of Appeal stated, with reference to diagnostic methods, that their exclusion from patentability under Art. 52(4) EPC 1973 (now Art. 53(c) EPC) seemed actually to be based on socio-ethical and public health considerations. Medical and veterinary practitioners should be free to take the action they considered suited to diagnosing illnesses by means of investigative methods. Consequently, the policy behind the legal fiction in Art. 54(4) EPC 1973 appeared to be aimed at ensuring that those who carried out diagnostic methods as part of the medical treatment of humans or veterinary treatment of animals were not inhibited by patents (referring to **T 116/85**).

In **G 1/07**, a decision concerning treatment by surgery, the Enlarged Board noted that the exclusion under Art. 52(4) EPC 1973 had been deliberately maintained by the legislator, thereby confirming the principle that medical and veterinary practitioners' freedom to use the best available treatments to the benefit of their patients, uninhibited by any worry that some treatment might be covered by a patent, should be protected by excluding these activities from patentability.

4.2. Methods for treatment by surgery or therapy and diagnostic methods

4.2.1 General approach

In the case law of the boards of appeal a distinction is made in the approach to methods for treatment by surgery or therapy on the one hand and diagnostic methods on the other. The leading cases are **G 1/04** (OJ 2006, 334) concerning diagnostic methods, and **G 1/07** (OJ 2011, ***) concerning treatment by surgery. With regard to the previous case law, please refer to the 5th edition of this book.

An important difference between the two approaches is that, whilst a method claim falls under the prohibition on patenting methods for treatment by therapy or surgery if it comprises or encompasses at least **one** feature defining a physical activity or action that constitutes a method step for treatment of a human or animal body by surgery or therapy (**G 1/07**), a much narrower interpretation of Art. 52(4) EPC 1973 was applied with regard to the exclusion from patentability of diagnostic methods in **G 1/04** (see paragraph 4.5 below).

4.2.2 Involvement of practitioner

In **G 1/04** (OJ 2006, 334), concerning diagnostic methods, the Enlarged Board held that whether or not a method is a diagnostic method within the meaning of Art. 52(4) EPC 1973 (now Art. 53(c) EPC) may neither depend on the participation of a medical or veterinary practitioner nor on the fact that all method steps can also, or only, be practised by medical or technical support staff, the patient himself or herself, or an automated system. The Enlarged Board in **G 1/04** highlighted the difficulty, if not impossibility, of defining the persons that were considered to be such practitioners on a European level within the framework of the EPC. For reasons of legal certainty, the European patent grant procedure should not be rendered dependent on the involvement of such practitioners. See also point 4.5 below, diagnostic methods - G 1/04.

Referring to **G 1/04**, the Enlarged Board of Appeal in **G 1/07** (a decision concerning treatment by surgery) confirmed that whether or not a method is excluded from patentability under Art. 53(c) EPC cannot depend on the person carrying it out. The Enlarged Board in **G 1/07** found that, although the findings in **G 1/04** related to diagnostic methods, they dealt quite generally with the exclusion from patentability under Art. 52(4) EPC 1973 and were thus equally valid with respect to the other exclusion conditions contained in the new Art. 53(c) EPC.

4.3. Surgical methods - G 1/07

4.3.1 Towards a new concept of "treatment by surgery"

In **G 1/07** the Enlarged Board of Appeal disapproved of the broad construction of interventions of a surgical nature corresponding to the practice of the EPO, such as in decisions **T 182/90** and **T 35/99**, namely that all methods involving irreversible damage to or destruction of living cells or tissues of the living body were regarded as non-

insignificant interventions and thus as surgical treatments, irrespective of the underlying mechanism of the intervention (e.g. mechanical, electrical, thermal, chemical). According to the Enlarged Board this view was overly broad when considering today's technical reality. The definition given obiter dicta in **G 1/04** that "'any physical intervention" on the human or animal body..." is a method of surgery within the meaning of Art. 52(4) EPC 1973 appeared too broad.

The Enlarged Board found itself unable to give a definition which would delimit the exact boundaries of a new concept of treatment by surgery. The field of methods which potentially involves surgical steps is vast, so that each category of class will have to be assessed on its own merits. The approach adopted so far was considered unsatisfactory.

A narrower understanding of "treatment by surgery" was required. Any definition of the term "treatment by surgery" must cover the kind of interventions which represent the core of the medical profession's activities, i.e. the kind of interventions for which their members are specifically trained and for which they assume particular responsibility. Such a narrower understanding rules out uncritical methods involving only a minor invention and no substantial health risks.

The required medical expertise and the health risk involved may not be the only criteria which may be used to determine that a claimed method actually is a "treatment by surgery" within the meaning of Art. 53(c) EPC. It appears that what is to be understood by "surgery" in the medical sense is to a large extent a matter of convention. Thus, in order to be surgical, it is not necessary that the intervention be invasive or that tissues be penetrated (**T 5/04**). The scope of what is surgery may change with time and with new technical developments emerging, as was already acknowledged in decision **T 182/90**.

With regard to the facts of the case the Enlarged Board decided in **G 1/07** that a claimed imaging method, in which, when carried out, maintaining the life and health of the subject is important and which comprises or encompasses an invasive step representing a substantial physical intervention on the body which requires professional medical expertise to be carried out and which entails a substantial health risk even when carried out with the required professional care and expertise, is excluded from patentability as a method for treatment of the human or animal body by surgery pursuant to Art. 53(c) EPC.

4.3.2 One surgical step in a multi-step method

In **G 1/07** (OJ 2011, ***) the Enlarged Board upheld the principle confirmed in opinion **G 1/04** (OJ 2006, 334) and underlying the whole body of practice and jurisprudence hitherto (see e.g. **T 820/92** (OJ 1995, 113)), that a method claim falls under the prohibition on patenting methods for treatment by therapy or surgery now under Art. 53(c) EPC if it comprises or encompasses **at least one** feature defining a physical activity or action that constitutes a method step for treatment of a human or animal body by surgery or therapy.

The Enlarged Board stated that, during the course of the revision of the EPC, the European legislator deliberately maintained the exclusions under Art. 52(4) EPC 1973 in what is now Art. 53(c) EPC. The principle was thereby confirmed that medical and veterinary practitioners' freedom to use the best available treatments to the benefit of their patients, uninhibited by any worry that some treatment might be covered by a patent, is protected by excluding these activities from patentability. Excluding from patentability also multi-step methods which comprise or encompass a therapeutic or a surgical step serves to give full effect to that legislative purpose. Therefore, the principle developed in the jurisprudence that the presence of one therapeutic or surgical step in a multi-step method excludes that method from patentability is not only formally justified by the fact that the exclusion under Art. 53(c) EPC does not contain any limitation as to the defined methods being excluded only when claimed as such. More importantly, it is also justified as to substance, i.e. it enables the legislative purpose served by the exclusion to be achieved.

4.3.3 Treatment by surgery not limited to surgery for a therapeutic purpose

In **G 1/07** (OJ 2011, ***) the Enlarged Board of Appeal concluded that neither the legal history nor the object and purpose of the exclusions from patentability in Art. 53(c) EPC (formerly Art. 52(4) EPC 1973) would justify a limitation of the term "treatment by surgery" to curative surgery (overruling **T 383/03**). Such a limitation would be contrary to the ordinary understanding of the word "surgery" as referring to the nature of the treatment rather than its purpose, and contrary to the fact that Art. 53(c) EPC defines three separate alternative exclusions thereby suggesting that these are not merely identical in scope. The Enlarged Board of Appeal observed in **G 1/07** that the comparison between **T 383/03** and **T 1172/03** showed how inconsistent the decisions to be made could become if the term "treatment by surgery" was seen as limited to therapeutic surgery only.

The Enlarged Board in **G 1/07** also considered the obiter dicta statement in **G 1/04** that "methods of surgery within the meaning of Art. 52(4) EPC 1973 include any physical interventions on the human or animal body in which maintaining the life and health of the subject is of paramount importance." In **G 1/07** it was stated that this definition cannot be understood in the sense that the opinion **G 1/04** thereby endorsed the view that the term "treatment by surgery" is limited to therapeutic surgery. Saying that treatments by surgery include any physical interventions on the human or animal body "in which maintaining the life and health of the subject is of paramount importance" is not equivalent to saying that the term "treatment by surgery" is limited to therapeutic methods. On the contrary, the definition fits in very well with the previously established jurisprudence, decisions **T 182/90** and **T 35/99** having held that the term surgical treatment embraces those interventions which, whatever their specific purpose, give priority to maintaining the life and health of the human or animal body on which they are performed.

4.3.4 Avoiding the exclusion of methods of treatment by surgery from patent protection under Article 53(c) EPC

a) Claim cannot be left to encompass surgical step

The Enlarged Board in **G 1/07** (OJ 2011, ***) confirmed the established case law of the boards of appeal, according to which a claim encompassing an embodiment which was excluded from patentability under Art. 52(4) EPC 1973 (now Art. 53(c) EPC), could not be left unamended.

This was not, as argued by the appellant, altered by the finding of the Enlarged Board in **G 1/98** (OJ 2000, 111), that a claim wherein specific plant varieties were not individually claimed was not excluded from patentability under Art. 53(b) EPC 1973, even though it might embrace plant varieties. In this decision the Enlarged Board specifically stated that, as regards Art. 53(b) EPC 1973 the idea underlying the provision was quite different from that of Art. 52(4) EPC 1973: 'In [Art. 52(4) EPC 1973], gaps in the protection of eligible subject-matter are deliberately accepted in order to free from restraint non-commercial and non-industrial medical and veterinary activities (**G 5/83** OJ 1985, 64)'. According to the Enlarged Board in **G 1/07**, decision **G 1/98** therefore confirmed the principle that a claim which encompasses an embodiment which is excluded from patentability under Art. 53(c) EPC cannot be left to encompass that embodiment.

b) Disclaimer

The Enlarged Board in **G 1/07** went on to say that the exclusion from patentability under Art. 53(c) EPC can be avoided by disclaiming an embodiment, it being understood that in order to be patentable the claim including the disclaimer must fulfil all the requirements of the EPC and, where applicable, the requirements for a disclaimer to be allowable as defined in decisions **G 1/03** (OJ 2004, 413) and **G 2/03** (OJ 2004, 448). Whether or not the wording of a claim can be amended so as to omit the surgical step without offending against the EPC must be assessed on the basis of the overall circumstances of the individual case under consideration.

c) Methods only concerning the operation of a device

A typical class of cases in which the invention would be fully defined without requiring the presence of the potentially surgical step as a positive feature of the claim would be cases in which the invention only concerns the operating of a device. With respect to such inventions the boards of appeal have constantly held that a method which is only concerned with the operating of a device without any functional link between the claimed method and the effects produced by the device on the body does not qualify at all as a method for treatment within the meaning of Art. 52(4) EPC 1973 (**T 245/87**, OJ 1989, 171, **T 789/96**, OJ 2002, 364). If, on the contrary, there is such a functional link the method is excluded from patentability (**T 82/93**, OJ 1996, 274).

4.3.5 Data obtained during surgery

On the particular facts of the case before it, the Enlarged Board held in **G 1/07** that a claimed imaging method is not to be considered as being a "treatment of the human or animal body by surgery" within the meaning of Art. 53(c) EPC merely because during a surgical intervention the data obtained by the use of the method immediately allow a surgeon to decide on the course of action to be taken during a surgical intervention.

4.4. Therapeutic methods

In **G 1/07** the Enlarged Board emphasised the difficulty of providing a definition of the term "treatment by surgery." The boards of appeal would be better suited to define the boundaries of a more narrowly construed concept of "treatment by surgery" in situations other than the one underlying the referral. The boards of appeal may choose a similar case-by-case approach with regard to the concept of treatment by therapy. Set out below is the case law of the boards of appeal prior to decision **G 1/07**.

4.4.1 Meaning of "therapy"

The first definition of the term was given in **T 144/83** (OJ 1986, 301). According to this decision, therapy relates to the treatment of a disease in general or to a curative treatment in the narrow sense as well as the alleviation of the symptoms of pain and suffering.

It is established case law that a prophylactic treatment, aimed at maintaining health by preventing ill effects that would otherwise arise, amounts to a method for treatment by therapy as referred to in Art. 53(c) EPC, and that therapy is not limited to treatments which restore health by curing diseases which have already arisen (see e.g., **G 5/83**, OJ 1985, 64). Both prophylactic and curative methods of treating disease are covered by the word therapy, since both are directed to the maintenance or restoration of health (**T 19/86**, OJ 1989, 24; **T 290/86**, OJ 1992, 414; **T 438/91**, **T 820/92**, OJ 1995, 113).

In **T 81/84** (OJ 1988, 207) the question arose whether or not the character of menstrual discomfort manifesting itself for instance in intense headaches and other painful symptoms was such that its treatment should fall under the category of therapeutic treatment. The board found that the concept of therapy should **not** be construed **narrowly**. There were many chemical agents which were used by physicians to relieve pain, discomfort and incapacity. Although at least some of such and similar experiences might have been caused by natural circumstances (e.g. menstruation, pregnancy or age, etc.) or by a reaction to situations in the human environment (e.g. atmospheric conditions provoking tiredness, headaches, etc.), these overlapped with and were often indistinguishable from symptoms of a disease or an injury. The board noted that It would be impossible and undesirable to distinguish between basic and symptomatic therapy, i.e. healing or cure and **mere relief**. The use of medicaments might be called for whenever the human body was suffering from a disease, illness, pain or discomfort or incapacity, and the administration thereof could provide or contribute to either full or partial healing, or relief or restoration of fitness. The board concluded that **irrespective**

of the origin of pain, discomfort or incapacity, its relief, by the administration of an appropriate agent, was to be construed as therapy or therapeutic use within the meaning of Art. 52(4) EPC 1973.

In **T 24/91** (OJ 1995, 512) the board observed that the term "therapy" was not restricted to curing a disease and removing its causes. Rather, this term covered any treatment which was designed to cure, alleviate, remove or lessen the symptoms of, or prevent or reduce the possibility of contracting any disorder or malfunction of the human or animal body. The board found that the claimed process removed, **by treatment of the patient's eye**, the symptoms of myopia, hyperopia and astigmatism and was therefore a therapeutic treatment.

According to decision **T 774/89** the purpose of therapy was invariably to restore the organism from a pathological to its original condition, or to prevent pathology in the first place whereas a non-therapeutic improvement of performance took as its starting point a normal state (to be defined).

In **T 469/94** the board observed that the patentability of the subject matter depended on the **nature of the treatment**. The question at issue was whether increasing the acetylcholine level in the brain and tissue and thereby reducing the perception of fatigue in a person about to participate in major exercise or having completed major exercise counts as therapeutic or non-therapeutic treatment of the human body. The board noted that the condition of fatigue induced by the performance of exercises was a transitory physiological condition caused by natural circumstances and removable by simple rest. Simple training was generally known to retard the perception of fatigue. Pain or serious suffering did not appear to be manifestations of fatigue, which therefore was not comparable with the pathological state typical of a disease or an injury. The board observed that the treatment for reducing the perception of fatigue was not even comparable with the relief of pain, discomfort and incapacity (see above **T 81/84**, OJ 1988, 207).

In **T 74/93** (OJ 1995, 712) the claimed invention related to alicyclic compounds and their contraceptive use. The product claims and a claim for the process of preparation of a contraceptive composition by formulating the claimed compounds with a non-toxic carrier were not objected to. However, the application was refused by the examining division because claim 5, which was directed to the use of a contraceptive composition (e.g. a cream) comprising these compounds for applying to the cervix of a female capable of conception, was not susceptible of industrial application as required by Art. 57 EPC 1973 in so far as the compound was to be applied to the cervix of a human female.

The board took the view that a method of contraception was not excluded per se from patentability under the aspects of industrial application as stipulated in Art. 57 as well as in Art. 52(4), first sentence, EPC 1973 (now Art. 53(c) EPC). Pregnancy was not an illness and therefore its prevention was not in general therapy according to Art. 53(c) EPC (for a specific case see **T 820/92**, OJ 1995, 113). It seems to have been widely accepted in the contracting states that such methods may be susceptible of industrial application. However, it was not sufficient for such methods to be susceptible of

industrial application in general. Rather, the invention as claimed in the specific case had to fulfil the requirement of Art. 57 EPC 1973 (see chapter I.E., requirement of industrial applicability under Art. 57 EPC).

In **T 241/95** (OJ 2001, 103) the board held that the selective occupation of a hormone receptor could not be considered as a therapeutic application; the discovery that a substance selectively binds the serotonin receptor, even if this represented an important piece of scientific knowledge, still had to find a practical application as a defined, real treatment of a pathological condition in order to make a technical contribution to the art and to be considered as an invention eligible for patent protection.

In **G 1/07** (OJ 2011, ***) the Enlarged Board of Appeal pointed out that it was the express wording of Art. 53(c) EPC that only therapeutic methods were excluded from patentability (and thus cosmetic methods were not) and the exclusion could not be extended to treatments which were not therapeutic in character (**T 1172/03** making reference to **T 144/83**, OJ 1986, 301).

4.4.2 Methods with both therapeutic and non-therapeutic indications

Whether or not a claimed invention is excluded from patentability under Art. 53(c) EPC depends upon the wording of the claim in question (see **T 820/92**, OJ 1995, 113; **T 290/86**, OJ 1992, 414; **T 780/89**, OJ 1993, 440 and **T 1077/93**).

a) Inevitable and inextricably linked therapeutic effect of the claimed method

In **T 116/85** (OJ 1989, 13) the board held that a claimed method was excluded from patentability under Art. 52(4) EPC 1973 (now Art. 53(c) EPC), if it rendered the therapeutic treatment of animals necessary, even though the therapeutic treatment of animals was commonly an aspect of agriculture, and agricultural methods were in general potentially patentable subject-matter. Here, however, the board did not consider it possible as a matter of law to draw a distinction between such a method as carried out by a farmer and the same method when carried out by a veterinarian, and to say that the method, when carried out by a farmer, was an industrial activity and, when carried out by a veterinarian, was a therapeutic treatment not patentable under Art. 52(4) EPC 1973.

According to **T 780/89** (OJ 1993, 440) the secondary effect of a therapeutic treatment did not render it patentable. The claim in question related to a method of general immunostimulation for animals. The applicant argued, inter alia, that this served to increase meat production and that the method was therefore not being used as a means of therapy. However, the board regarded the effect of increasing meat production as a consequence of the improvement in the animals' health. Moreover, the general stimulation of the immune system was integrally linked to the specific prophylactic function of safeguarding against particular infections.

In **T 438/91** the patentee contended that the main purpose of the claimed process was to increase the weight of the animals which effect was separable from the effect of prevention or cure of scours. This latter was merely a beneficial side effect. It was

necessary to decide whether or not a method for breeding domestic animals in claims 1 and 2 related to a therapeutic or prophylactic treatment. The board noted that two effects were observed as a result of the breeding method claimed: (a) the remedying of scours and, (b) a weight increase in the animals being bred. The board found that, in the light of the patent disclosure, the two effects were linked by the single action of feeding the animals, and that the intention was to obtain both effects at the same time in animals suffering from scours (treatment by therapy) and to prevent the latter complaint in those animals which did not already have it (treatment by prophylaxis). In conclusion, the board was of the opinion that the subject-matter of claims 1 and 2 related to a therapeutic or prophylactic treatment of domestic animals and thus fell within the prohibition on patentability set out in Art. 52(4) EPC 1973.

In **T 290/86** (OJ 1992, 414) no method claim was considered allowable because the disclosed method of eliminating plaque inevitably had the therapeutic effect of preventing caries and periodontal disease; it therefore fell under the prohibition of Art. 52(4) EPC 1973 (now Art. 53(c) EPC) irrespective of the fact that the removal of plaque could also have the cosmetic effect of improving the appearance of the teeth. The board took the view that whether or not a claimed invention was excluded from patentability under Art. 52(4) EPC 1973 depended in particular on the wording of the claim in question. If the claimed invention was not directed solely to a cosmetic effect, but was also **necessarily defining** a treatment of the human body by therapy as well, such a claim was excluded from patentability (distinguishing **T 144/83**, OJ 1986, 301). The board held that if the claimed use of a chemical product **inevitably always had a therapeutic effect** as well as a cosmetic effect the invention as claimed necessarily defined a treatment of the human body by therapy and was not patentable.

In **T 1077/93** the opposition division had concluded that the claimed invention was not a non-patentable therapeutic method within the meaning of Art. 52(4) EPC 1973, but a cosmetic treatment. Claims 1 and 11 related to the use of the cupric complex of 3,5-Diisopropyl salicylic acid (referred to in the following as CuDIPS) as a cosmetic product or in a cosmetic composition, and to a cosmetic treatment process, based on the use of this complex, for the protection of the human epidermis. The purpose of the patented composition was to protect the human epidermis against ultraviolet radiation: notably, to reduce the intensity of erythema, recognised as the most spectacular form of damage to the skin by sunlight, and of skin-level cellular changes such as the formation of degenerated and necrotised keratinocytes, generally known by the term "sunburn cells (SBC)". The appellant lodged an appeal against this decision of the opposition division. In its ruling, the board cited the point, already explored in **T 820/92** (OJ 1995, 113), that exclusion from patentability under Art. 52(4) EPC 1973 (now Art. 53(c) EPC) could not be prevented by a purely formal rewording of the claim to qualify the purpose of the process, in its indivisible entirety, as non-therapeutic. The board took the view that the examination as to patentability of claims 1 and 11 necessitated an examination of the mechanism by which CuDIPS acted, and of the relationship between all its effects. The board concluded that at least part of the protective effect did not derive from a simple filtering at the level of the skin surface, but rather from an interaction with the cellular mechanisms in the epidermis, with the purpose of preventing a pathological state (erythema); therefore the process had a genuine therapeutic effect.

b) Therapeutic and non-therapeutic effects distinguishable

In **T 144/83** (OJ 1986, 301) the board accepted the patentability of a claim worded in such a way that it clearly sought protection for a method of treating the human body for cosmetic purposes but not for the therapeutic application which was also possible. The board pointed out that the language of the claim in question "clearly covered a method of cosmetic use and was unrelated to the therapy of a human or animal body in the ordinary sense. This was because weight loss, like weight gain, is normally not dictated as a desirable effect by medical considerations at all." On the facts of the case, the board considered that it might be **difficult to distinguish** between loss of weight to improve bodily appearance (cosmetic treatment) and loss of weight to treat obesity (therapeutic treatment), but that this should not be allowed to work to the disadvantage of an applicant who, according to the **wording of his claim**, sought patent **protection for cosmetic treatment** but not for the therapeutic treatment as such. Therefore, the board held that the fact that a chemical product had both a cosmetic and a therapeutic effect when used to treat the human or animal body did not render the cosmetic treatment unpatentable. Art. 52(4) EPC 1973 (now Art. 53(c) EPC) was to be construed narrowly so that it did not disadvantage an applicant seeking patent protection for the cosmetic treatment only (but see also **G 1/07** on this point).

In **T 36/83** (OJ 1986, 295) the description expressly disclosed **two very different** properties of a compound used in the treatment of comedones, i.e. its anti-bacterial and its hygienic action. The application showed that pharmaceutical and cosmetic preparations could have very similar, if not identical, forms. The distinction was clearly set out in the description as filed. The board decided that the cosmetic application of a product which also had a therapeutic use was patentable, since the applicants had **only claimed** in respect of "use as a cosmetic product". The use of the term "cosmetic" was held to be sufficiently precise, although the cosmetic treatment according to the application might also **incidentally** involve a medical treatment.

In **T 584/88** claim 1 was directed to the use of a substance to manufacture a means for the treatment by therapy of unhealthy snoring, and claim 15 to the use of the substance against irritating snoring. Claim 1, by describing the snoring as "damaging to health", ensured that it only covered use of the substance to manufacture means serving to treat symptoms of morbidity. Claim 15 covered only irritating as opposed to morbid snoring; this use could not therefore be considered a method for treatment by therapy. The board allowed both claims: snoring was generally considered irritating rather than morbid, but some medical specialists had warned that frequent loud snoring was unhealthy. If so, then combating snoring was a preventive (prophylactic) method for treatment by therapy; otherwise it was more comparable with cosmetic treatment of the human body. The dividing line between irritating and unhealthy snoring was difficult to draw. The board, following **T 36/83** (OJ 1986, 295) and **T 144/83** (OJ 1986, 301), therefore decided to allow both types of claim together.

In **T 774/89** the board accepted the patentability of using a medication to increase milk production in cows, because it was evident that the success of the treatment did not

depend on the animals' state of health, and the insertion in the claim of the term "non-therapeutic" served as a **disclaimer**, excluding the therapeutic effects of the medication.

In **T 469/94** it had to be ascertained whether the non-therapeutic effect according to the application at issue was distinguishable from the therapeutic effect of choline. The board found that the two effects of choline were not inseparably linked or correlated but, on the contrary, were readily distinguishable because they involved **groups of persons** (or patients) undoubtedly distinct. The one consisted of patients known to have a muscular disease, muscular injury or epilepsy, whereas the second comprised healthy persons who would receive no therapeutic benefit from the treatment. Moreover, the times necessary for appreciating the different effects (days for the therapeutic effect and minutes or hours for the non-therapeutic effect) would appear to be so different that no unwanted overlap of the treatment could occur. Therefore, the board held that the claim in question was directed to a non-therapeutic method.

4.5. Diagnostic methods - G 1/04

Under Art. 53(c) EPC diagnostic methods practised on the human or animal body are also excluded from patentability.

The President of the EPO, making use of his power under Art. 112(1)(b) EPC 1973, made a referral to the Enlarged Board of Appeal on points of law relating to the interpretation of the term "diagnostic methods practised on the human or animal body" within the meaning of Art. 52(4) EPC 1973 (now Art. 53(c) EPC). The Enlarged Board of Appeal emphasised in opinion **G 1/04** (OJ 2006, 334) that its interpretation of the scope of the exclusion from patentability under Art. 52(4) EPC 1973 in respect of diagnostic methods practised on the human or animal body would remain valid under the EPC 2000.

4.5.1 What constitutes "diagnostic methods"

One of the main questions referred was the following:

Are "diagnostic methods practised on the human or animal body" only those methods containing all the procedural steps to be carried out when making a medical diagnosis, or is a claimed method a "diagnostic method" even if it only contains one procedural step that can be used for diagnostic purposes or relates to the diagnosis?

In **G 1/04** (OJ 2006, 334) the Enlarged Board of Appeal answered this question as follows:

In order that the subject-matter of a claim relating to a diagnostic method practised on the human or animal body falls under the prohibition of Article 52(4) EPC, the claim is to include the features relating to: (i) the diagnosis for curative purposes *stricto sensu* representing the deductive medical or veterinary decision phase as a purely intellectual exercise, (ii) the preceding steps which are constitutive for making that diagnosis, and

(iii) the specific interactions with the human or animal body which occur when carrying those out among these preceding steps which are of a technical nature.

The Enlarged Board of Appeal pointed out that the **surgical or therapeutic** nature of a method claim could be established perfectly by a single method step without contravening Art. 84 EPC 1973. **Diagnostic** methods, however, differed in this respect from the methods of surgery and therapy. The method steps to be carried out prior to making a diagnosis as an intellectual exercise were related to examination, data gathering and comparison. If only one of the preceding steps which were constitutive for making such a diagnosis were lacking, there was no diagnostic method, but at best a method of data acquisition or data processing that could be used in a diagnostic method (see **T 385/86**). It followed that, whilst the surgical or therapeutic nature of a method claim could be achieved by a single method step, several method steps were required to define a diagnostic method within the meaning of Art. 52(4) EPC 1973 due to the **inherent and inescapable multi-step** nature of such a method.

4.5.2 Involvement of practitioner

A further question referred to the Enlarged Board of Appeal concerned to what extent the involvement of a practitioner was decisive.

In **G 1/04** (OJ 2006, 334) the Enlarged Board of Appeal held that the classification of an activity as having a diagnostic character did not depend on who was involved. The wording of Art. 52(4) EPC 1973 (now Art. 53(c) EPC) was unequivocal in that the exclusion related only to the method, and not to the person carrying out the method. To allow the grant of a European patent to depend on the involvement of such a person would therefore introduce legal uncertainty into the patent granting procedure. Thus, whether or not a method was a diagnostic method within the meaning of Art. 52(4) EPC 1973 should depend neither on the participation of a medical or veterinary practitioner, through being present or bearing the responsibility, nor on the fact that all method steps could also, or only, be practised by medical or non-medical support staff, the patient himself or herself or an automated system (see also **G 1/07** (OJ 2011, ***). Moreover, no distinction is to be made in this context between essential method steps having diagnostic character and non-essential method steps lacking it. See also paragraph 4.2.2 above.

4.5.3 The criterion "practised on the human or animal body"

A further question referred to the Enlarged Board of Appeal concerned the criterion "practised on the human or animal body."

Art. 52(4) EPC 1973 required that, to be excluded from patent protection, diagnostic methods had to be practised on the human or animal body. The Enlarged Board of Appeal held that in a diagnostic method under Art. 52(4) EPC 1973 (now Art. 53(c) EPC), **the method steps of a technical nature belonging to the preceding steps** which were constitutive for making the diagnosis for curative purposes *stricto sensu* must satisfy the criterion "practised on the human or animal body".

It could be inferred from the fact that Art. 52(4) EPC 1973 further referred to methods of surgery and therapy that these diagnostic methods served curative purposes and were thus meant to be practised on the living human or animal body. The criterion "practised on the human or animal body" was to be considered only in respect of method steps of a technical nature. Thus, it did not apply to diagnosis for curative purposes *stricto sensu*, i.e. the deductive decision phase, which as a purely intellectual exercise could not be practised on the human or animal body.

Art. 52(4) EPC 1973 did not require a specific type and intensity of interaction with the human or animal body; a preceding step of a technical nature thus satisfied the criterion "practised on the human or animal body" if its performance implied any interaction with the human or animal body, necessitating the presence of the latter.

Further, the grant of a European patent in respect of a diagnostic method which included preceding method steps of a technical nature carried out by a device did not contravene Art. 52(4) EPC 1973, because the performance of the respective method steps did not satisfy the criterion "practised on the human or animal body". However, in the event of patent protection, it would normally be sufficient to purchase the device in question in order to be entitled to carry out such a method. In cases where the same diagnostic conclusions could be reached by a method not including the use of the device, those carrying it out would not be inhibited by the patent. Therefore, medical or veterinary practitioners could not be considered to be hampered by the existence of such a patent.

4.5.4 Clarity of a claim relating to diagnostic methods

In **G 1/04** (OJ 2006, 334) the Enlarged Board of Appeal noted that if diagnosis as the deductive medical or veterinary decision phase was a purely intellectual exercise, the feature pertaining to the diagnosis for curative purposes and the features relating to the preceding steps which were constitutive for making the diagnosis represented the essential features of a diagnostic method within the meaning of Art. 52(4) EPC 1973. Thus, in order to satisfy the requirements of Art. 84 EPC 1973, an independent claim relating to such a method had to include these features. If a non-technical feature was to be regarded as constitutive for defining the invention, it had likewise to be included as an essential feature in the independent claim.

4.5.5 Scope of the exclusion

The scope of the exclusion from patentability under Art. 52(4) EPC 1973 (now Art. 53(c) EPC) in respect of **diagnostic methods** was to be **interpreted narrowly**. Thus, for the subject-matter of a claim relating to a diagnostic method practised on the human or animal body to fall under the prohibition of Art. 52(4) EPC 1973, the claim must - in view of Art. 84 EPC 1973 - include the feature pertaining to the diagnosis for curative purposes as a purely intellectual exercise representing the deductive medical or veterinary decision phase, as well as the features relating to (i) the preceding steps which were constitutive for making the diagnosis, and (ii) the specific interactions with the human or animal body which occurred when carrying out those of the said preceding steps which were of a technical nature.

4.5.6 Intermediate findings of diagnostic relevance

The Enlarged Board of Appeal stated that intermediate findings of diagnostic relevance must not be confounded with diagnosis for curative purposes *stricto sensu*, which consisted in attributing the detected deviation to a particular clinical picture. It followed that a method for obtaining such results or findings did not constitute a sufficient basis for denying patentability by virtue of Art. 52(4) EPC 1973. To decide otherwise would give rise to such a broad interpretation of the scope of the exclusion from patentability under Art. 52(4) EPC 1973 - with regard to diagnostic methods - that it could hardly be reconciled with the requirement of legal certainty.

4.6. Case law applying the principles developed in G 1/04

In **T 1197/02** the invention related to a method of assessing the presence of glaucomatous damage to the visual system of a subject. The board explained that since the criterion "practised on the human or animal body" in Art. 52(4) EPC 1973 was to be considered only in respect of method steps which are of a technical nature (points 6.4.1 and 6.4.4 of **G 1/04**, OJ 2006, 334), it neither applied to the deductive decision phase, nor to those steps which consisted in comparing the data collected in the examination phase with standard values and in finding a significant deviation resulting from the comparison. These activities were principally of a non-technical nature and normally not practised on the human or animal body. It followed that in most cases, only the step which referred to the examination phase and involved the collection of data could actually be of a technical nature and, therefore, concerned with the criterion "practised on the human or animal body". Additional intermediate steps which concerned for example the adjustment or preparation of the apparatus with which the collection of data would be performed could be introduced into a method claim for completeness. However, since these additional features were not part of one of the steps necessary for making the diagnosis, they were to be ignored when assessing the diagnostic character of the method. The issue of whether or not these intermediate features were of a technical nature and practised on the human or animal body was, therefore, irrelevant for this question.

In **T 143/04** claim 1 at issue related to a method of diagnosing Alzheimer's disease in a living subject. The board noted that data processing using an automated apparatus was not actually part of the examination phase which involved the data collection phase, but it resulted from a subsequent, technical step, intermediate between the data collection and the comparison of these collected data with standard values. Such intermediate steps were not to be considered when assessing the diagnostic character of the method. The claim at issue included all the features of a diagnostic method practised on the human or animal body as defined in the opinion **G 1/04**. The patenting of such a method was prohibited by Art. 52(4) EPC 1973.

C. Novelty

Art. 52(1) EPC sets out four requirements to be fulfilled by a patentable invention: there must be an invention, and if there is an invention, it must satisfy the requirements of

novelty, inventive step, and industrial applicability. The four requirements are essentially separate and independent criteria of patentability, which may give rise to concurrent objections. Novelty, in particular, is not a requisite of an invention within the meaning of Art. 52(1) EPC, but a separate requirement of patentability (see **T 154/04**, OJ 2008, 46).

An invention can be patented only if it is new. An invention is considered to be new if it does not form part of the state of the art. The purpose of Art. 54(1) EPC is to prevent the state of the art being patented again (**T 12/81**, OJ 1982, 296; **T 198/84**, OJ 1985, 209).

The first step in deciding whether an invention is new is to define the prior art, the relevant part of that art, and the content of that relevant art. The next is to compare the invention with the prior art thus defined, and see whether the invention differs from it. If it does, the invention is novel.

As part of the EPC 2000 revision, several amendments were made to Art. 54 EPC. Art. 54(1) and (2) EPC remained unchanged. In Art. 54 (3) EPC 1973 a reference to Art. 93 EPC was removed. Art. 54(4) EPC 1973 was deleted, so that any European application falling under Art. 54(3) EPC constitutes prior art with effect for all the EPC contracting states at the time of its publication. The amendment to Art. 54(5) EPC 1973 (now Art. 54(4) EPC) took account of the deletion of Art. 54(4) EPC 1973 and the incorporation of Art. 52(4) EPC 1973 into Art. 53(c) EPC (Exceptions to patentability). Apart from this editorial amendment the substance of this Article is unchanged. New Art. 54(5) EPC now eliminates any legal uncertainty on the patentability of further medical uses. It unambiguously permits purpose-related product protection for each further new medical use of a substance or composition already known as a medicine (see OJ SE 4/2007).

1. Defining the state of the art

Under Art. 54(2) EPC 1973, the state of the art comprises everything made available to the public by means of a written or oral description, by use, or in any other way, **before** the filing or priority date of the European patent application.

1.1. Relevant point in time

An application with the same filing or priority date as the application to be examined is not part of the state of the art (see **T 123/82**).

According to the boards' established case law, the prior art's content is to be interpreted in the manner in which it would have been understood by the skilled person at the time it was made available. In particular, for ascertaining the disclosure of a document forming part of the state of the art within the meaning of Art. 54(2) EPC 1973, the relevant date is that of publication. Interpreting a document using knowledge which only became available to the relevant experts between the publication date of the cited prior art and the filing or priority date of the application to be examined or the patent in dispute is an issue relating to inventive-step, not novelty (see **T 205/91**, **T 965/92**, **T 590/94**). In **T 74/90** the board did, however, consider how a skilled person would have understood a citation on the filing date of the patent in suit.

1.2. European prior rights

Pursuant to Art. 54(3) EPC 1973, in order to preclude double patenting, European patent applications having an earlier filing or priority date than the filing or priority date of a second European patent application, and which are published on or after the filing date of that second application, are considered to form part of the state of the art for the purpose of examining the novelty of this second patent application. Former Art. 54(4) EPC 1973 confined the prior art effect under Art. 54(3) EPC 1973 to the minimum necessary to avoid a collision of rights, i.e. to those contracting states which are designated in both the earlier and the second application. As part of the revision of the EPC, Art. 54(4) EPC 1973 was deleted, so that any European application falling under Art. 54(3) EPC constitutes prior art with effect for all the EPC contracting states at the time of its publication. Accordingly, R. 87 EPC 1973 has been amended (see R. 138 EPC) and R. 23a EPC 1973 deleted. The revised Art. 54(3) EPC is applicable to European patent applications filed on or after the time of EPC 2000 entry into force. The deleted Art. 54(4) EPC 1973 is still applicable to European patents already granted and applications pending at the time of EPC 2000 entry into force.

In **J 5/81** (OJ 1982, 155) the board held that a published European patent application became part of the state of the art under Art. 54(3) EPC 1973, with retroactive effect as from its filing date or priority date, for assessing applications filed after that filing date or priority date but prior to its publication, but that this should only apply if such a "prior application" was still in existence at the time of publication.

In **T 447/92** the whole contents of an earlier document within the meaning of Art. 54(3) and (4) EPC 1973 had to be considered as forming part of the state of the art as far as novelty was concerned. The board pointed out that the boards of appeal had consistently applied a very restrictive interpretation of disclosure in order to reduce the risk of self-collision. To do otherwise would, in the board's view, undesirably undermine the exclusion from consideration of documents within the meaning of Art. 54(3) EPC 1973 when deciding whether there had been an inventive step under Art. 56, second sentence, EPC 1973.

1.3. PCT applications as state of the art

An international application not yet published and for which the EPO is a designated Office is considered as comprised in the state of the art in accordance with Art. 54(3) EPC 1973 i.e. with effect from its filing or priority date, as soon as it has been filed at the EPO in an official language and the national fee has been paid (Art. 153 (3) - (5) EPC; Art. 158(2) and (3) EPC 1973).

In **T 404/93** the European patent application was limited to the contracting states Italy (IT), Netherlands (NL) and Sweden (SE) in view of an earlier international application, published after the filing date of the former. The board noted that the earlier PCT application had mentioned several EPC contracting states, including IT, NL and SE, as being designated for a European patent. However, when the earlier application had entered the European phase, no designation fees had been paid for IT, NL and SE.

Accordingly, the board found that the earlier international application was not comprised in the state of the art under Art. 54(3) EPC 1973 for IT, NL and SE (see also **T 623/93**).

In **T 622/91** the respondent (patent proprietor) requested that the decision under appeal be set aside and the patent maintained for all designated contracting states. Two earlier international applications and the European patent had designated the contracting state France (FR). The board noted that the requirements of Art. 158(2) EPC 1973 (now Art. 153(3) and (4) EPC and R. 159 EPC) were fulfilled, and considered the international applications as comprised in the state of the art relevant to the patent in suit in accordance with Art. 54(3) and Art. 158(1) EPC 1973 (now Art. 153(5) EPC). The board went on to examine claim 1 of the main request and found that the earlier application was novelty-destroying in so far as the same contracting state FR was designated.

1.4. In-house knowledge not published before the priority date

In **T 1001/98** the board did not consider it appropriate either for itself or for the examining division to base an assessment of substantive patentability (novelty and inventive step) upon subject-matter not identified as forming part of the state of the art within the meaning of Art. 54(2) EPC 1973. That was consistent with a number of previous decisions of the boards of appeal (such as **T 654/92**). In view of the appellant's declaration that the arrangement of figures 7(a) and 7(b) of the patent application was in-house knowledge not published before the priority date of the patent and given that the European search report did not reveal any corresponding document, the board reached the conclusion that the arrangement concerned could not be treated as being comprised in the state of the art within the meaning of Art. 54(2) EPC 1973. It therefore did not consider this arrangement relevant to substantive patentability. By the same token, the reasoning in the examining division's decision, to the extent that it relied on that arrangement, could not be followed.

1.5. Definition of "common general knowledge"

In **T 890/02** (OJ 2005, 497) the board dealt with the definition of "common general knowledge". It noted that the common general knowledge of the person skilled in the art had been defined by the boards of appeal as being normally represented by encyclopaedias, textbooks, dictionaries and handbooks on the subject in question (see inter alia **T 766/91**, **T 206/83**, OJ 1987, 5; **T 234/93**). In several cases, however, and by way of exception, patent specifications and scientific publications had also been considered to form part of common general knowledge. In particular, special considerations prevailed when a field of research was so new that technical knowledge was not yet available from textbooks (see **T 51/87** OJ 1991, 177; **T 772/89**).

It went on to state that in all those cases the boards had acknowledged that the skilled person did not have the entire technology readily accessible, and that they had identified three important aspects - common to all cases - for correctly assessing the common general knowledge of the person skilled in the art.

First, the skills of such a person included not only having basic general knowledge of the particular prior art, but also knowing where to find such information, be it in a collection of relevant studies (see **T 676/94**), a scientific publication or a patent specification (see **T 51/87** and **T 772/89**).

Second, it could not be expected that, in order to identify this common general knowledge, the skilled person would carry out a comprehensive search of the literature covering virtually the whole state of the art. No undue effort in the way of such a search could be required of the person skilled in the art (see **T 171/84**, OJ 1986, 95; **T 206/83**; **T 676/94**).

Third, the information found had to be unambiguous and usable in a direct and straightforward manner without doubts or further investigation (see **T 206/83**).

These three aspects actually corresponded to the classic steps of (a) picking the **right** reference book (handbook, encyclopaedia, etc.) from the bookshelf in the library, (b) looking at the **appropriate** entry without any significant effort, and (c) getting the **correct** information or unambiguous data that could be used without further investigation.

It followed that for each case the common general knowledge of the skilled person working in a particular technical field had to be decided on its own merits, based on the facts and evidence of the case.

In the case at issue the applicant had equated a search in the EMBL database to a search in the Chemical Abstracts database. The board noted however that the Chemical Abstracts database, as acknowledged in the case law, embraced virtually the entire prior art and represented much more than the common general knowledge expected of the skilled person (see **T 206/83**). It was evident from the content of the EMBL database with regard to DNA sequences that that database was different from the Chemical Abstracts database or other bibliographic databases such as Biological Abstracts, EMBASE, etc. Those bibliographic databases aimed to summarise the complete disclosure of a scientific publication, conference, etc. by supplying an abstract and providing several searchable fields (descriptors). Owing to the amount and the quality of their information, it was usually necessary to have a sophisticated search strategy for finding the desired data. It was not sufficient to query a bibliographic database with an enzyme name or an EC number alone, as the number of results obtained would be too great to look at and useful information would not be available without further limitation by an additional query. Moreover, the kind of information retrieved - the content of the abstract - could not be anticipated before the search had actually been made, and it was usually, by its nature, incomplete or insufficient and consequently required consultation of the original publication. Thus, in contrast to the EMBL database, in which a straight query (enzyme name or EC number) usually produced a reasonable number of results with clear information (nucleotide sequences), in the bibliographic databases neither the required search strategy (query) nor the results (abstracts) were clear and straightforward.

Hence the board held that, whilst not being *stricto sensu* encyclopaedias or handbooks, databases (a) which were known to the skilled person as the right source for obtaining the required information, (b) from which that information could be retrieved without undue burden, and (c) which provided it in a straightforward and unambiguous manner without need for further investigation, represented common general knowledge as defined in the case law.

1.6. Excluded national prior rights

In **T 550/88** (OJ 1992, 117) the board made it clear that, on the proper interpretation of Art. 54(3) EPC 1973, prior national rights were not comprised in the state of the art. As to the references to Part VIII of the Convention made by the appellants, the board found that they rather confirmed that the effect of a prior national right upon a European patent was a matter purely for national law, whereas the effect of a prior European application upon a European patent was specifically provided for in Art. 54(3) EPC 1973 (which might also be a ground for revocation under national laws by virtue of Art. 138(1)(a) EPC 1973). In other words, the combined effect of Articles 138(1) and 139 EPC 1973 was to provide an additional possible ground for revocation under national laws based upon the existence of a prior national right, which was not available under Art. 54 EPC 1973.

In the board's view, it was clear that the wording of Art. 54(3) EPC 1973 was intended deliberately to exclude national applications from having the prior art effect therein stated in respect of a European patent. At the time the EPC 1973 had entered into force it had still been uncertain whether the national laws of contracting states would include the same prior right effect as set out in Art. 54(3) EPC 1973. Even now, the national law in Switzerland provided for a different prior right effect ("prior claim") from that set out in Art. 54(3) EPC 1973 ("whole contents"). The omission of prior national rights from Art. 54(3) EPC 1973 had been made in the context of such international uncertainty. The board went on to note that if Art. 54(3) EPC 1973 were to include prior national rights, the result would be a legal inconsistency particularly as far as Switzerland was concerned, having regard to Art. 139(2) EPC 1973 - in an opposition to a European patent before the EPO in which a national prior right was relied upon under Art. 54(3) EPC 1973, the conflict would be resolved in accordance with the "whole contents" system of Art. 54(3) EPC 1973, whereas in revocation proceedings under national law in Switzerland in respect of the European patent the same conflict would be resolved pursuant to Art. 139(2) EPC 1973 in accordance with the prior claim system (Art. 7a Swiss Federal Patent Act).

1.7. Article 55 EPC

Art. 55 EPC, the text of which was amended only slightly as part of the revision of the EPC, specifies two instances in which a prior disclosure of the invention is not to be taken into consideration as part of the state of the art under Art. 54 EPC; if it was due to, or in consequence of (a) an evident abuse in relation to the applicant or his legal predecessor, or (b) the fact that the applicant or his legal predecessor had displayed the invention at an official international exhibition.

In consolidated cases **G 3/98** (OJ 2001, 62) and **G 2/99** (OJ 2001, 83), the Enlarged Board ruled that, when calculating the six-month period under Art. 55(1) EPC 1973, the relevant date is that of the actual filing of the European patent application, not the priority date.

In **T 173/83** (OJ 1987, 465) the board ruled that there would be evident abuse within the meaning of Art. 55(1)(a) EPC 1973 if it emerged clearly and unquestionably that a third party had not been authorised to communicate to other persons the information received. Thus there was abuse not only when there was the intention to harm, but also when a third party acted in such a way as to risk causing harm to the inventor, or when this third party failed to honour the declaration of mutual trust linking him to the inventor.

In **T 585/92** (OJ 1996, 129) a patent application had been filed in Brazil on 14.7.1976 and originally claimed priority from several GB applications, the earliest having a filing date of 15.7.1975. Under Brazilian patent law, it would have been due for publication on 16.8.1977. However, the applicant abandoned all the claimed priorities, which ought to have delayed the publication for a further twelve months. Notwithstanding this abandonment of priority, the application was erroneously published before the priority date of the patent in suit. The board found that where a patent application was published early by a government agency as a result of an error, this was not of necessity an abuse in relation to the applicant within the meaning of Art. 55(1)(a) EPC 1973, however unfortunate and detrimental its consequences might turn out to be. In order to determine whether there was an abuse within the meaning of Art. 55(1)(a) EPC 1973, the state of mind of the "abuser" was of importance. The published Brazilian application was considered to form part of the state of the art.

In **T 436/92** the board found that deliberate intention to harm the other party would constitute evident abuse, as would also, probably, knowledge of the possibility of harm resulting from a planned breach of confidentiality. The state of mind of the "abuser" was of central importance (confirming **T 585/92**). The board held that the appellant had not proven, on the balance of probability, that the publications had occurred in violation of the tacitly agreed confidentiality. In other words, the publication was not an evident abuse within the meaning of Art. 55(1) EPC 1973.

1.8. Availability to the public

The state of the art comprises what has been made available to the public.

Board of appeal case law has established that the theoretical possibility of having access to information renders it available to the public (**T 444/88**), whatever the means by which the invention was made accessible, and - in the case of prior use - irrespective of whether there were particular reasons for analysing the product (**G 1/92**, OJ 1993, 27). This decision supersedes **T 93/89** (OJ 1992, 718), **T 114/90** and **T 62/87** on this point. It is not relevant, as a matter of law, whether on that date a member of the public actually saw the document or knew that it was available (**T 381/87**, OJ 1990, 213).

Particular problems may arise, depending on how the information is made available.

1.8.1 Publication

In **T 611/95** a research institute known in the field was in possession of a **report** anticipating the invention, which anyone could view at the institute or order from it on request. Two papers published prior to the priority date referred to this report and indicated where it could be obtained.

In the board's view, the report was therefore publicly available. As far as availability to the public was concerned, the institute was not to be equated with a library, but the information in the documents had indicated to experts in the field that anyone could inspect or order the report there.

In **T 842/91** the subject-matter of the claimed invention was included in a **book** to be published. Shortly before the priority date, the patent proprietor gave permission to the publisher to disclose the contents of the book as follows "[...] I hereby grant the book's publisher unrestricted rights of publication and waive any claims arising therefrom". Moreover, the opponent claimed that as a seminar including the subject-matter had been given shortly after the priority date, it was possible that the article had been distributed before the priority date. The board held that although the patent proprietor had clearly given the publisher permission to make the claimed subject-matter available to the public, this could not of itself amount to actually making it available. Nor could it be assumed merely from the permission given or the date of the seminar that copies had in fact been made available before the priority date.

In **T 37/96** the board had to decide on the public availability of some prior-art documents. Two of them were **typical company papers**.

The board held that unlike scientific or technical journals, such papers could not be assumed to have automatically made their way into the public domain. On the contrary, whether they had indeed been available to the public on a given date depended on the particular circumstances and the evidence available.

T 877/98 raised the question whether a **German patent** had become publicly available upon notification of the grant decision if the application had not been published previously.

The board took the view that the patent had not become available until publication of grant in the patent bulletin; only from that point on was the file open for inspection. It thus endorsed the view of the German Federal Patents Court (decision of 23.12.1994, 4W(pat)41/94, BIfPMZ 1995, 324).

In **T 165/96**, technical information about a feature of the invention had been disclosed, prior to the date of filing of the European patent application in question, in an insert in a **minor small-ads newspaper** (circulation: 24, 000) distributed in the suburbs of Copenhagen.

The patent proprietor argued that in view of the newspaper's limited circulation and readership ("man on the street" in suburban Copenhagen) the information in question had effectively remained confidential and could not be regarded as forming part of the state of the art within the meaning of Art. 54(2) EPC 1973; the document should therefore not be admitted in the appeal proceedings. He also felt that scientific or technical information published before filing, in a non-technical or non-scientific context, outside the scope of the state of the art concerned, and with no references or distinguishing features enabling it to be found again afterwards, should not be regarded as directly available to the public without undue burden as per **G 1/92** (OJ 1993, 27).

The board ruled that, *pace* the patentee, publication in such a manner fulfilled the necessary and sufficient conditions for citing a disclosure against the patent. Information was "available" once people could theoretically become aware of it. A publication did not have to fulfil any specific criteria of form or layout in order to qualify as a citable disclosure.

On the "undue burden" argument, the board noted that the patentee's interpretation would introduce into the consideration of novelty precisely that subjective element which in **G 1/92** the Enlarged Board had sought to exclude. That argument was therefore not valid.

In **T 314/99** it was undisputed that the **diploma thesis** arrived in the archive of the Chemistry Department Library of the University of Hamburg before the priority date. However, in the board's judgment, the diploma thesis did not by its mere arrival in the archive become publicly available, since that did not mean it was as of that point in time catalogued or otherwise prepared for the public to acquire knowledge of it, and because without such means of information the public would remain unaware of its existence.

In **T 328/00** the potentially anticipatory document was a booklet containing the programming and operating instructions for the claimed system. The booklet bore the imprint "January 80" (twelve years before the priority date) on its front page and the heading "software code from November 1980" on its last page. A booklet containing the programming and operating instructions of a device and having the characteristics of this document was usually addressed to the users that had purchased the device. Other documents gave indications that the system disclosed in the booklet was intended to be freely available on the market. The board held it was reasonable to assume that the booklet had been drawn up twelve years before the priority date, had been issued for public use, and had been made available to the public within the twelve-year period.

In **T 1030/00** the board held that Art. 54(2) EPC 1973 did not require that a written description be made available free of charge for it to be considered to be made available to the public.

In **T 1137/97** document D1 had already been cited in the search report from the EPO. It was argued in the opposition that it had been inadequately considered during examination. In response the patentee challenged its being prior art at all, and submitted evidence from three different libraries in the Netherlands, including the opponent's, that

the copy of document D1 present in those libraries had not reached them until after the priority date of the patent in suit.

The board noted that the strength of the presumption in favour of the accuracy of a "Received" date marking appearing on the copy of a journal in a library as evidence of the actual date when the journal was made available to the public would depend on the library routine used. The board did not accept a handwritten date on the cover of a journal in view of other evidence. Thus document D1 did not form prior art pursuant to Art. 54(2) EPC 1973.

In **T 315/02** the board said that a patent application not yet published in its country of origin could form part of the state of the art within the meaning of Art. 54(2) EPC 1973 if it was accessible to the public as a priority document for a published European application (Art. 128(4) EPC 1973).

In **T 267/03** it was ruled that binoculars depicted photographically in a book on binoculars, with the manufacturer's name and an approximate date of manufacture ("ca. 1960") far earlier than the date of filing of the patent in suit, constituted prior art for that patent in respect of the binoculars' internal structure.

In **T 355/07** the board held that German utility models were considered publicly available as of their date of entry in the Register of utility models of the German Patent and Trademark Office (DPMA) so that they represented prior art in terms of Art. 54(2) EPC. It was not relevant whether on that date a member of the public actually inspected the file.

1.8.2 Brochures

In **T 804/05**, document E1 was a commercial brochure normally distributed among potential customers to inform them of new products. Contrary to the appellant's view, the decision in **T 743/89** was indeed to be deemed relevant to the issue of whether and when the brochure was made available to the public, the board in the earlier case having concluded that, in the absence of any evidence to the contrary provided by the patentee, it had to be assumed that the brochure in question had been made available to the public within the seven months between the date of the brochure and the priority date of the patent in suit.

In the case before the board the relevant date of E1 was 18 months before the priority date of the patent in suit, and it was therefore right to assume that the brochure had been distributed in the intervening period. The decisions cited by the appellant related to different circumstances for the following reasons. In **T 37/96** the citation was not a commercial brochure but an operating manual filed as evidence of prior use; operating manuals and commercial brochures did not serve comparable purposes. In **T 543/95**, although the cited document was a commercial brochure, it had no date of printing or publication. As the disclosure in the brochure came no closer to the subject-matter of claim 1 than the other cited documents discussed in the proceedings, it was of no significance for the decision whether or not the subject matter was available to the public

before the priority date. The board concluded that E1 therefore formed part of the state of the art within the meaning of Art. 54(2) EPC 1973.

1.8.3 Lectures

In **T 1212/97** the opponent had submitted that the invention was made available to the public by a lecture given some days before the priority date to an audience of some hundred to two hundred persons. The question to resolve was whether there was any safe and satisfactory evidence regarding the content of what was made available to the public by the lecture.

The board held that the content of the lecture was not a matter which was capable of being put beyond reasonable doubt by any evidence given by the lecturer alone. The lecturer's evidence could be taken as defining the maximum amount of knowledge that may have been conveyed to the audience, but could not be relied on to establish even what minimum of new knowledge was necessarily conveyed to the audience. Evidence of the lecturer's intentions or impression as to what was conveyed to the audience could not even be treated as making out a *prima facie* case that such information was actually made available to the public, certainly in terms of information that would have been new to the audience. Account had to be taken of the fact that a lecture was ephemeral, so that the manner or speed of presentation might affect its comprehensibility. Even an audio or video tape recording made of the lecture, unless publicly available, would have to be treated with caution, if several hearings or viewings were necessary to extract all the information. Information appearing in each of the contemporary written notes made at the lecture by at least two members of the audience could usually be regarded as sufficient, whereas information in the notes of a single member of the audience might be inadequate, this reflecting the thoughts of the listener rather than solely the content of the lecture. If the lecturer read his lecture from a typescript or manuscript, or the lecturer wrote up his lecture subsequently, and the lecture was subsequently published in that form as part of the proceedings, then the written version might be taken as some evidence of the contents of the lecture, though with some caution as there would be no guarantee that a script was completely and comprehensibly read, or that a write-up was not amplified. Most useful would be a handout given to the public at the lecture, containing a summary of the most important parts of the lecture and copies of the slides shown.

None of those types of evidence were available in this case. The board was also forced to the conclusion that there was no safe and satisfactory evidence that the information conveyed in the lecture could be treated as having been made publicly available. The lecture had undoubtedly been given, but the board was not satisfied on the balance of probabilities, let alone beyond reasonable doubt, that the information provided went beyond what was already known in the art.

1.8.4 Abstracts of documents

In **T 160/92** (OJ 1995, 35) the appellant objected to the fact that the examining division had based its judgment on whether the claimed subject-matter involved an inventive step

on an **abstract of a Japanese patent document** without introducing the original document and citing specific passages from it. Concerning the citability of an abstract, the board held that the teaching of a previously published abstract of a Japanese patent document, considered per se without its corresponding original document, formed prima facie part of the prior art and might be legitimately cited as such if nothing on the file pointed to its invalidity. The party intending to contest the validity of said teaching on the basis of the original document's teaching had the burden of proof. As to whether or not citing the abstract, without the original document from which it was taken, was permissible or constituted a procedural violation, the board noted that it had to be considered whether the statement based on such an abstract alone could be regarded as reasoned within the meaning of R. 51(3) and R. 68(2) EPC 1973 (now R. 71(2) EPC and R. 111(2) EPC). In the case in question, the abstract provided certain information and, for the skilled reader, there was no indication that such information was invalid. The examining division's line of reasoning was complete and understandable.

In **T 243/96**, it was established that the abstract of a document, on the basis of which the application in suit was refused, is an independent part of the prior art in its own right. However, in view of the inadequacy of this disclosure, and the divergent views on how the abstract should be interpreted, the board decided to introduce the full document into the appeal proceedings in the form of its English translation, it being understood that the full document took precedence over the abstract.

1.8.5 Repetition of oral disclosures

Where a written disclosure was published which was based on an oral disclosure at a public conference held some years earlier, it could not as a rule be assumed that the written disclosure was identical to the oral disclosure. Additional circumstances had to be put forward and proven to justify that conclusion (**T 153/88**). In **T 86/95**, the board assumed that the disclosures were identical since it was highly unlikely that the speaker would have passed over such a salient feature at the conference.

In **T 348/94** the board confirmed that a written publication allegedly based on a paper previously read at a public meeting held some time earlier (in this case ten months) could not be assumed to be identical to what was orally disclosed, and might contain additional information. As to the extent of the oral disclosure, the burden of proof remained with the opponent.

1.8.6 Prior use

In **T 84/83** a new type of wide-angle mirror had been fitted to a motor vehicle for demonstration purposes for at least six months. The board held this to constitute prior public use as, during such a time, the vehicle could be expected to be parked on public highways and hence open to inspection by third parties.

In **T 245/88** several vaporisers had been installed in a fenced-off area of a shipyard. The public did not have unrestricted access to this area. The board was of the view that the vaporisers had not been made available to the public.

In **T 327/92** the patentee claimed an expanded film laminate characterised by the feature that it be expanded by monoaxially drawing it. The product of the process of a citation comprised a laminate which was stretched in one direction and then, within a short time, further stretched at right angles to this direction; in this process a monoaxially stretched laminate existed, at least, for 60 seconds. The board held that the intermediate product, which existed only for some 60 seconds before being further processed, destroyed the novelty of the patentee's claim, because it met all the technical characteristics required by the claim. It allowed, however, a claim directed to a not yet disclosed use of the monoaxially stretched laminate.

In **T 947/99** the board held that, contrary to the opinion of the opposition division in the decision under appeal, it was possible to establish prior public use by showing that a certain process was used over a stated period before the priority date for making a certain product and that there existed a possibility for a stated class of individuals, e.g. visitors, who were under no obligation of secrecy or confidentiality, to have direct and unambiguous access to any particular information regarding that process. If that was the case, there was no need to show that a specific named individual saw the process in operation on a specific day.

The board observed that, in accordance with the principles set out in **G 1/92** (OJ 1993, 277), it was the fact that direct, unlimited and unambiguous access to any particular information regarding the manufacturing processes known per se was possible which made these processes available to the public within the meaning of Art. 54(2) EPC 1973, whether or not there was any reason to look or ask for such information.

For the preconditions for claiming prior use, see chapters VII.D, opposition procedure, and VI.H, law of evidence.

1.8.7 Biological material

In the field of microbiology, the board, in **T 576/91**, conceded that an unwritten rule may exist within the scientific community, whereby biological material referred to in a scientific publication can be freely exchanged. However, this does not amount to an obligation, so that any biological material which is the subject of a publication can be considered as being publicly available. The board further stated that if contractual obligations between parties resulted in access to biological material being deliberately restricted to a group of persons bound either by a research contract or a licence, it could not be concluded that this material had been made "available to the public" within the meaning of Art. 54(2) EPC 1973. In **T 128/92** the board stated that, for a complex biochemical to be made available to the public, the minimum that would seem to be required for publication was a notice to those in the field that samples of the biochemical could be obtained on request, and clear evidence of exactly what the biochemical was.

1.8.8 The concept of "the public"

Over the years, the boards have arrived at a clear definition of "the public". Information is said to be "available" to the public if only a single member of the public is in a position to

gain access to it and understand it, and if there is no obligation to maintain secrecy (**T 1081/01**, **T 229/06**).

a) Sale to a single customer

In **T 482/89** (OJ 1992, 646) the board said that a single sale was sufficient to render the article sold available to the public within the meaning of Art. 54(2) EPC 1973 provided the buyer was not bound by an obligation to maintain secrecy. It was not necessary to prove that others also had knowledge of the relevant article (see also **T 327/91**, **T 301/94** and **T 462/91**).

The sale of an object to a single customer who is not obliged to maintain secrecy renders the invention public, even where the object is to be used in a prototype, which is itself to be kept confidential until it is mass-produced (**T 1022/99**).

b) Article 54(2) EPC does not necessarily refer to the skilled person

The boards usually decide that information has been made public even if the sale was made to a person not skilled in the art (see **T 953/90**, **T 969/90**).

In **T 809/95** the patentee justified its position on non-disclosure essentially on the ground that the test persons were not skilled in the art. It cited **T 877/90**. The board noted that the latter decision dealt with information made public by oral disclosure at a lecture. Public disclosure was there linked to the condition that the audience had to include skilled persons capable of understanding the lecture. Such considerations seem appropriate to an oral disclosure but are not transferable to the case of information made public by making an article available for free use, because Art. 54(2) EPC 1973 only uses the term "public" and makes no reference to "skilled persons". In the case in point, however, it was to be noted for the sake of completeness that all the essential features of the distributed Alpla bottle were identifiable by purely external observation and that no technical knowledge was needed to identify the interaction between the bottom and body fold lines when the bottle was pressed flat.

The word "public" in Art. 54(2) EPC 1973 does not necessarily refer to the man in the street, according to **T 877/90** and **T 406/92** - a disclosure before a skilled person makes it "public" in the sense that the skilled person is able to understand the disclosure and is potentially able to distribute it further to other skilled members of the public (see also **T 838/97**).

c) A limited circle of people

Another argument sometimes used is that information was given only to a limited circle of people and was therefore not publicly available.

In the opinion of the boards the information is publicly available where it was made available to a limited circle of people (**T 877/90** - congress; **T 228/91** - course; **T 292/93** -

demonstration for potential customers conducted on the premises of a company with close links to the opponent).

In **T 877/90** an oral disclosure was regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the disclosure and there was no bar of confidentiality restricting the use or dissemination of such knowledge. It was plausible that the meetings in question were not open to everybody, because only certain persons were invited to participate. Those, however, were not subject to a secrecy agreement. So the oral disclosure of the meetings was freely available to the public. Everything that was said at the meetings was therefore made available to the public.

In **T 300/86**, in the opinion of the board, a written description was to be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. This was in agreement with the Guidelines. The group of persons to be taken into account as the public within the meaning of Art. 54(2) EPC 1973 was naturally defined by the circle of persons to whom the content of the document might be of interest. All the interested parties had to have the opportunity of gaining knowledge of the content of the document, however unrestricted by contractual or other legal restrictions on use or dissemination of the information therein. Otherwise the document had not been made available to the public.

In **T 1081/01** the board observed that if, at the time of receipt of the information, the recipient was in **some special relationship to the donor** of the information, he could not be treated as a member of the public, and the information could not be regarded as published for the purpose of Art. 54 EPC 1973. Even if this special relationship were later to cease, so that the recipient was now free to pass on the information, the mere cessation of the special relationship **did not** make the information available to anyone else.

In **T 398/90** a marine engine installed in a ship was held to have been known to the engine room crew and hence to have been made available to the public.

In **T 1085/92** the board ruled that a company's own staff could not normally be equated with "the public" within the meaning of Art. 54(2) EPC 1973.

In **T 165/96** the board held that "the public" within the meaning of Art. 54(2) EPC 1973 did not presuppose a minimum number of people or specific educational qualifications; the residents of a Copenhagen suburb sufficed.

1.8.9 Obligation to maintain secrecy

If the person who was able to gain knowledge of the invention was under an obligation to maintain secrecy, the invention cannot be said to have been made available to the public, provided the person did not breach that obligation.

In **T 1081/01** the board held that information provided subject to a confidentiality agreement did not become available to the public merely by reason of the expiry of the obligation to keep it confidential. Some separate act of making it available to the public would be needed. This conclusion was in agreement with the conclusion reached in **T 842/91**, where permission to publish a text was considered merely as permission to make the text available to the public, and not as actually making the text available to the public.

If the obligation to maintain secrecy stems from an **express** agreement that has been observed, the information has not been made available to the public. Less clear cut are cases of **tacit** secrecy agreements, or where the obligation to maintain secrecy stems from the circumstances. There is considerable case law on this point.

In **T 1309/07** the board ruled that it was clear from the file that 17 520 combustion-engine pistons of a certain type had been supplied to Renault before the priority date. The question was whether, at the time of delivery, a tacit secrecy agreement had applied. In view of the large quantity involved, and the fact that pistons of this type were offered in a prepublished spare-parts catalogue, the board took the view that they had been supplied not for test purposes but for normal series production, so from that point onwards no such agreement could have existed.

a) Distribution of prospectuses, technical descriptions etc

In **T 173/83** (OJ 1987, 465) and **T 958/91** the board held that a technical description sent out to clients could not be regarded as secret information.

b) Displaying the invention

T 87/90 dealt with a case where there had been unrestricted access to a sheetfed offset printing press featuring an integrated coating unit awaiting delivery to a customer in the assembly shop of the manufacturer. The invention related to the coating unit. The press was noticed by chance by another client inspecting a press ordered for his company. Although he was not given a working demonstration of the coating unit, all the details were explained to him. In the light of experience the board took the line that a company's commercial interest in obtaining follow-up orders outweighed any considerations of secrecy and that this therefore amounted to prior public use.

In **T 1085/92** a brush holder had been manufactured by a third party on behalf of the appellants on the basis of drawings provided by the appellants and then fitted in an assembly line owned by the appellants to which visitors to the company had had access. It could not be ascertained whether in this case there had been an express secrecy agreement, although a note did exist prohibiting the release of the drawings. The board took the view that where such contractual relations and development agreements existed a secrecy agreement could be assumed to exist. Fitting the device in the assembly line did not make the invention evident to visitors, so anticipatory prior public use could not be said to exist (see also **T 365/93**).

c) Sub-contracting

In **T 830/90** (OJ 1994, 713) the actions constituting prior use were based on meetings between the shipyard commissioned to build a new ship and two rival sub-contractors, namely the patent proprietors and the opponents. The meetings involved the submission of quotations to the shipyard. The drawings shown during the meeting bore clearly visible stamps referring to Sections 18-20 of the German law prohibiting unfair competition and Section 823 of the German Civil Code (liability for damages on the grounds of actionable tort). The witnesses had stated that for them confidentiality had been a matter of course. Faced with these facts the board took the view that a confidentiality agreement had - at least implicitly - been reached. This was perfectly sufficient. Furthermore, in line with general experience, it had to be assumed that such an agreement would be observed at least as long as there was a common concern for secrecy. Such concern would last at least for the period required to safeguard the interests of the business partners. These interests might, for example, include the co-operation phase in which there was still no protection in law, or in which there was still joint further development of the new mechanism.

In **T 799/91** the opponents asserted that the subject-matter claimed had been in prior public use in that its manufacture had been "sub-contracted out" to a third company. According to the board the third company was not simply any third party because the opponents' decision to place an order was based on a relationship of trust. The board therefore saw no indication of there having been prior public use, nor could the claim have been substantiated by the testimony of any witness.

d) Demonstrating products for presentation purposes

In **T 634/91** the claimed prior public use consisted of the presentation of a circular saw at an opponent's place of business during a meeting between the patent proprietor and a potential buyer. Without elucidating further, but referring to the decision in **T 830/90** (OJ 1994, 713), the board held that such talks constituted a tacit understanding to maintain secrecy.

In **T 292/93**, the board ruled that a demonstration conducted for a small group of potential customers on the premises of a company with close links to the opponent was inconsistent with the existence of an obligation to maintain secrecy.

In case **T 478/99** a demonstration was made by two potential clients. It could not be proven that a confidentiality agreement existed. The board held that the sole absence of an explicit request for confidentiality was not sufficient to conclude that there was no confidentiality, because secrecy may result from an ethical code of conduct for the employees of big companies such as the two clients in question. Consequently, the board considered the alleged public prior use not to be proven.

In **T 823/93**, the opponent had sold a company a packaging apparatus with characteristics similar to the patented apparatus. Delivery had been made after the patent's date of priority, but the apparatus had been presented to the company's

employees prior to that date. The packaging apparatus had been developed on the basis of an order from the client. The order did not relate to a finished product but to a complex system needing to be adapted to the purchaser's requirements. The apparatus had been developed as the solution to a specific technical problem envisaged by the client himself. The question was whether the client had required the employees to whom the apparatus had been presented to treat the presentation as confidential.

According to the board, the development of a new apparatus is usually kept secret from competitors. In the case at issue, the development of the apparatus had to be regarded as the result of co-operation between the opponent and the client. The board therefore took the view that, on the basis of these facts, it could be assumed that none of the parties had an interest in disclosing any information about the apparatus and it was likely that the technical reports exchanged between the parties were tacitly required to be treated as confidential. The board also held that the general conditions of business, which had become the conditions of contract and required the plans, designs and other documents to be handled confidentially, also extended to verbal information and details given during the presentation of the apparatus. In these circumstances, the board decided that the employees to whom the apparatus had been presented could not be considered as members of the public within the meaning of Art. 54(2) EPC 1973.

e) Presenting the product in writing

In **T 887/90**, the alleged prior public use hinged on the submission of two quotations, each of which had involved a series of technical discussions with the potential customers. The quotations had not been for finished products, but for systems requiring adjustments to the clients' requirements. The drawings, without which the quotations would have been meaningless, bore clear references to Section 18 of the German law prohibiting unfair competition, which had been noted by the clients.

The board took the line that an obligation to maintain secrecy was clear from the circumstances. The recipients of the quotations had no discernible reason for passing on the contents of the quotation to third parties and hence for choosing to ignore the references on the drawings. Simply to claim that no mention had been made of any obligation to maintain secrecy was insufficient to invalidate the assumption that there had been an implicit agreement to maintain secrecy. Nor was the fact that sales representatives had also been present enough to prove the contrary.

In **T 541/92** a sub-contractor had given sketches of a device to its client. In the board's view this constituted an obligation to maintain secrecy. It was standard practice for clients and their subcontractors to keep their projects secret, and allegations to the contrary required convincing proof.

In **T 1076/93** the opponents had, without there having been an explicit agreement to maintain secrecy, had offered an apparatus which caused the subject-matter of the invention to lack novelty and had provided drawings to a weapons manufacturer. The board held that the prior use did not cause lack of novelty, because a variety of circumstances pointed to there having been an obligation to maintain secrecy. According

to the board, discretion was generally acknowledged to be the rule on the premises of such companies. The business contacts between the opponents and the weapons manufacturer were restricted to specific individuals. Furthermore, aside from the discretion commonly observed in this branch of industry, almost all the papers used by staff at the company in question bore warnings about the need for confidentiality. It had been demonstrated that this company did not as a matter of principle allow the details of quotations to be passed on to third parties.

In **T 818/93** the relevant prior art document was a declaration made by the inventor before the USPTO, plus exhibits 1 and 4 mentioned therein. Several companies had been contacted in an (unsuccessful) attempt to interest them in developing and funding research into the intraluminal graft outlined in exhibit 1. Exhibit 4 had been sent to the inventor's superior, a professor at the University of Texas Health Science Center at San Antonio, after which discussions had been held with him and a research assistant at this university with a view to obtaining the necessary equipment for carrying out the research and fabrication and for testing the graft. In the board's judgment, all these steps and approaches had been taken within the context of business relationships which were necessary to bring the project to a successful conclusion. Such negotiations were confidential by nature, in view of the comparable interests of the parties involved, and implied a secrecy agreement. In the board's view and contrary to the respondent's assertion, a written agreement was not necessary to rule out any involvement of a third party so that, in the case at issue, implicit confidentiality had not been breached by the meetings and negotiations prior to the filing date of the contested patent.

In **T 480/95** the document relied upon by the opposition division as a prepublication decisive for the evaluation of inventive step was a letter from the opponent to a customer written in connection with a contractual relationship between the two firms. In this letter the opponent gave advice as to the way in which a certain programmed memory solved specific processing problems. The board considered this letter to be a typical example of correspondence between contracting firms, which was confidential by its very nature.

f) Making available for test purposes

A product made available for test purposes is to be treated as confidential. Sale of the product in a limited quantity is regarded as sale for test purposes, if the product is normally sold in large quantities (see **T 221/91**, **T 267/91** and **T 782/92**).

In **T 602/91** the opponents had conducted an experiment using the respondent's (patent proprietor's) invention before the priority date at which at least two employees of the appellant company had been present. That there had been no express confidentiality agreement was undisputed. Nor, in the board's view, had there been any tacit agreement either, as the two parties had not concluded a development agreement or entered into any other contractual relations that would indicate either of them having had any particular interest in a secrecy agreement. Furthermore, a single case of co-operation between a manufacturer and a potential end-user of the product was not sufficient to assume that a tacit confidentiality agreement had been entered into. Good relations alone were not enough for a tacit agreement to develop, particularly as in this case the

appellants had a financial interest in disclosing the invention to the respondent's competitors.

In case **T 809/95** the granted patent was, inter alia, for a plastic bottle, the special features of which related to its foldability. One of the opponents alleged two cases of prior use. One of these had occurred in connection with a "market test" performed by a market research company on behalf of the third party to gauge the market for such bottles. The patent proprietor claimed that both prior uses had been subject to confidentiality rules.

As far as the prior use through market research was concerned, the board held that the very fact that the third party had chosen a test variant allowing the test participants to take the bottles home indicated that it attached no particular value to confidentiality in the patent sense. Nor was there any circumstantial obligation to maintain secrecy since the market research institute did not employ or have a business relationship with the test persons. Allowing the bottles to be taken home and used freely was rather evidence against any obligation to maintain confidentiality.

In **T 1054/92** the opponent had alleged and proved that the claimed invention, an absorbent structure for diapers, had been tested in public tests carried out by several hundred members of the public at several places in the USA over several weeks. The appellant (patent proprietor) had admitted not being certain that the tests were confidential but he was of the opinion that it was up to the respondent to prove "without doubt" that there was no bar of confidentiality. In the absence of such proof, the board should find on the balance of probabilities that the tests were confidential. The board was convinced in the light of common experience that it was very unlikely that these tests had been kept confidential, particularly since some of the used diapers had not been returned to the appellant. The board confirmed, contrary to the opinion of the appellant, that the burden of proof for the existence of a secrecy agreement lay with the patent proprietor. Since he could not prove the existence of secrecy agreements with the participants in these tests, the board found that they were not confidential.

In **T 1464/05** the board considered that an amount of 200 kg of the product, although clearly a bigger amount than the small sample initially delivered, would not have been sufficient for the production of optical cables on a commercial scale, but at the most for possibly carrying out tests in the production of optical cables and with the cables so obtained. It stated that the mere fact that a product has been delivered possibly for carrying out tests in what appears to be the result of an ordinary commercial transaction does not constitute by itself, in the absence of any other special circumstance or supporting evidence, a sufficient condition for concluding that the product was necessarily delivered under an implicit confidentiality agreement (see in this respect decisions **T 602/91**, **T 264/99**, **T 913/01**, **T 407/03**, and **T 1510/06**). In the particular circumstances of the present case, and with reference to the delivery involving 200 kg of the product, not only was there no indication that any express secrecy agreement existed between the two companies, but also no indication that any particular or special relationship existed between the two companies other than the ordinary relationship between a seller and a buyer company. As held in decision **T 681/01**, "there must be

something in the circumstances that suggests that a confidential relation existed before a delivery which appears to be the result of an ordinary commercial transaction can be disregarded as not making the delivered goods available to a member of the public".

g) Conferences

In **T 739/92** an oral description of the invention had been given in a conference. The question was whether the participants at this conference were bound to secrecy and could therefore not be seen as constituting "the public" within the meaning of Art. 54(2) EPC 1973. The list of participants showed that the conference was open to every specialist active in the relevant field. The participants were not prohibited from disseminating oral information from the conference, or from publishing information from it provided that they omitted any reference to the conference. Recording the lectures on tape, etc. and photographing slide material were prohibited. Guests were not permitted to attend the conference lectures and discussions. The board held that under these conditions the participants at this conference were to be regarded as normal members of the public since there was no secrecy agreement. In contrast to the situation in **T 300/86**, the participants were neither licensees of the organisers nor subject to a blanket contractual prohibition from communicating the information they obtained to third parties.

In **T 202/97** the board held that a draft standard sent together with an agenda to the members of an international standards working party as part of the preparations for a meeting on standards was not normally confidential and was thus available to the public. Even though only a particular group of persons had been invited to take part in the meeting on standards, it was the task of a standards committee to draw up, with the experts in the field, proposals for standards which had been agreed upon, on as broad a basis as possible, and which were based on the current state of developments. This task precluded any obligation to maintain confidentiality.

In **T 838/97** the invention was presented orally at a conference attended by about 100 of the most renowned experts in the respective technical field including potential rivals. The participants were explicitly instructed that information presented at the conference was not to be used without the specific authorisation of the individual who made the contribution. The board considered that the participants were bound by a confidentiality agreement and thus the invention was not to be considered to form part of the state of the art.

h) Joint venture agreement

In **T 472/92** (OJ 1998, 161) the board ruled that the existence of a joint venture agreement implied an obligation to maintain secrecy. It was found that an existing joint venture agreement would normally include an explicit or implicit confidentiality obligation between the common daughter and its parents.

In **T 633/97** the opponent had to prove that an alleged prior use had in fact been made public, i.e. there was no obligation to maintain secrecy between the respective contractors. The board stated that, depending on the nature of the business relations

and the status of the companies involved, the existence of such an obligation might be assumed on a prima facie basis without the necessity of a written agreement. In the case at issue, LLNL was acting in the national interest of the United States of America in fields which had to be considered classified. Specifically, the glass blanks delivered by CII to LLNL and referred to by the appellant were to be used in the Atomic Vapour Laser Isotope Separation (AVLIS) project depending on the highest quality fused silica available. The very nature of this project, i.e. uranium enrichment technology, led to the conclusion that all persons involved had to be bound to secrecy.

Similarly, in decision **T 1076/93**, the board considered a weapons manufacturer normally not to form part of the public but to be implicitly supposed by its contractors to behave as if an agreement of secrecy had been specified.

In **T 163/03** on appeal, the appellant (opponent) contended that the technical details of the apparatus as shown in the drawing D2 became state of the art when this drawing was given, without any confidentiality restriction, to BM. in May 1990, i.e. before the priority date of the patent in suit. In support of its requests the appellant noted that, in contrast to a joint venture, where the partners share the costs and risks of developing a new technology, the purpose of the SE project as agreed upon between the opponent and BM. was to save time by preparing for the manufacture of a new product in parallel with its development. The respondent contended that several provisions in the contract clearly indicated that the cooperation between the opponent and BM. was not actually a supplier-customer relationship, but a joint venture for which confidentiality was usually implicitly agreed.

The board examined the issue of confidentiality in order establish whether the alleged prior use met the requirements for being acknowledged as prior art within the meaning of Art. 54(2) EPC 1973. In the case at issue there was no need to decide whether the SE project qualified as a joint venture which lead to implicit secrecy obligations on the part of the opponent and/or BM. Where, as there, the terms and conditions of a technical cooperation, including related obligations of secrecy, had been explicitly specified and agreed upon by the partners of the cooperation by way of a written contract, the contractual provisions prevailed and left no room for construing implicit obligations of the parties which differed from or were incompatible with anything which the partners, on proper interpretation of the contract, had fixed therein. The board found that there was no reason whatsoever to assume, in the absence of any explicit secrecy obligation, that BM. could nevertheless have been under an implicit obligation to keep secret the manufacturing technology disclosed to it by the opponent within the framework of the SE project. This conclusion was not refuted by BM.'s possible interest in keeping details of the SE project and related know-how secret, at least until the M60 engine had been put on the market.

The board noted that, under these circumstances, even if BM. itself had imposed on its employees or third parties a confidentiality obligation in this respect, vis-à-vis the opponent it was not bound to do so. In other words, if it had passed on any information obtained from the opponent in performing the SE contract, BM. would not have acted in breach of that contract, and that was decisive for its qualification as a member of the

public. For these reasons it was established that before the priority date of the patent in suit the technical content of the drawing D2 became state of the art within the meaning of Art. 54(2) EPC 1973.

i) Paper submitted to obtain an academic degree

In **T 151/99** the board held that, in general, it appeared highly plausible that a paper submitted to obtain an academic degree (in this case a master's thesis) was not confidential, and that became a virtual certainty if the paper was referred to in published scientific work. If the reference was in a document published before the priority date of the patent in suit, it could be assumed that the paper had also been made available to the public before that date.

j) Medical field

In **T 906/01** the alleged public prior use related to surgery conducted by Dr F. and concerned the implantation of a correction device into a patient. There remained some doubt as to the I. Spinal System which was really implanted.

The board considered that a device having an investigational status, being implanted and tested within the restricted area of a hospital, under the responsibility of a surgeon operating within the framework of an investigator's agreement which included a confidentiality clause, had to be regarded as a prototype device. Usually the development and test phases of such products or devices were necessarily surrounded by secrecy as long as said products or devices had not been approved and commercialised (see **T 818/93**). Therefore, even without the production of more specific evidence on behalf of the respondent, the board was of the opinion that the clinical tests performed on the I. Spinal System by and under the responsibility of Dr F., conferred on the operation as a whole an implicit obligation of confidentiality which had to be extended to the whole team involved in that operation. Therefore, neither the fact that the I. Spinal System was received and prepared by hospital staff, nor the fact that it was visible to the hospital staff during the operation, was sufficient to prove that the I. Spinal System was accessible to the public. Furthermore, it was assumed that the operating room was not accessible to persons other than the operation team, and that the device was implanted at least partly under the patient's skin and, therefore, not immediately visible from the outside.

The board followed the reasoning of **T 152/03** that, in this field, there was a prima facie assumption that any person involved in a medical process was obliged to maintain confidentiality, given the need for patient confidentiality and the need to protect the development and testing of prototype devices, and that any evidence proving the contrary was important and had to be produced as soon as possible.

1.9. Issues of proof

1.9.1 Nature of the evidence

In **T 611/97** the appellant/opponent had listed various gun alignment systems which he alleged had been made available to the public in various ways (through being advertised, manufactured or sold, or through the distribution of catalogues).

The board stated that it was immediately obvious that a variety of actions, e.g. describing the system in a catalogue and selling it, usually meant that a different product was made available to the public. A person skilled in the art could, for example, dismantle and analyse a system which had been made unrestrictedly available to the public by being sold in order to obtain technical information not necessarily contained in the catalogue. The alleged availability of a product based on the distribution of catalogues and the alleged sale of a system described in such catalogues therefore represented different cases of availability, each of which had to be proved separately.

1.9.2 Burden of proof

Where lack of novelty is alleged, the burden of proof invariably lies with the party claiming that the information in question was made available to the public before the relevant date (see, for example **T 193/84**, **T 73/86**, **T 162/87**, **T 293/87**, **T 381/87**, OJ 1990, 213; **T 245/88** and **T 82/90**).

According to **T 766/91** and **T 919/97**, evidence of general technical knowledge need be submitted only if the latter's existence is disputed.

In **T 743/89**, however, the board applied the principle of prima facie evidence. Here, it had been proved that a leaflet disclosing the invention had been printed seven months before the date of priority, but it was uncertain when the leaflet had been distributed. The board took the view that, although the date of distribution could no longer be ascertained, it was reasonable in any event to assume that distribution had occurred within the seven-month period. The respondents contended that this was not the case, but the board considered this assertion to be so lacking in plausibility that it placed the onus of proof on the respondents.

In the decisions **T 73/86**, **T 162/87**, **T 293/87**, **T 708/89**, **T 82/90**, **T 600/90**, **T 267/91**, **T 782/92** and **T 34/94** the boards assumed that all the circumstances surrounding prior use must be proved by the party raising the objection.

In **T 326/93**, the board held that, in assessing public prior use, the burden of proof lay with the opponent, who had to show, on the balance of probabilities, firstly that the invention had been publicly demonstrated before the priority date and secondly that the skilled person would have drawn the necessary teaching from the demonstration (see also **T 472/92**, OJ 1998, 161; **T 750/94**, OJ 1998, 32; **T 848/94**).

Ruling on an objection of prior public use in **T 221/91**, the board held that it was for the patent proprietors to prove the existence of an obligation to maintain secrecy when the opponents had proved that the invention had been made available to the public and the patent proprietors had claimed the existence of a secrecy agreement (see also **T 969/90** and **T 1054/92**).

In **T 901/95** the board decided that merely claiming that generating equipment was installed into ships at three different shipyards and thus available to the public was not enough to demonstrate its obvious prior use. Shipyards were normally considered restricted areas and thus not open to the general public. This applied all the more to installations built into ships in the yards. Nor could the possibility be excluded that shipyards' business partners might secure their common interests through explicit or tacit secrecy agreements, in the absence of other protection. In the case in point, it was also questionable whether the relevant process steps and the functional arrangement of the switching means were apparent from merely looking at built-in apparatus; nor was it certain when the generating installations had become operational. Both parties dispensed with oral proceedings and no witnesses were heard; the board did not in these circumstances consider the alleged public prior use.

In **T 887/90** the obligation to maintain secrecy was derived from the circumstances. In this case the board's view was that the onus for proving the contrary lay entirely with the opponents. (similarly **T 541/92**; see also chapter VI.H, law of evidence).

In **T 826/03** the applicant had questioned the correctness of the publication date of document D3, which was a Canadian patent application based on an international application, during examination. Nevertheless, the examining division had considered document D3 to belong to the prior art within the meaning of Art. 54(2) EPC 1973, based on an e-mail response from the Canadian Intellectual Property Office (CIPO) to a corresponding enquiry by the EPO. In the appeal, the appellant contested the validity of this information provided by CIPO and argued that, due to specific circumstances in the particular case, the Canadian application according to D3 had not been made public at the date of entry into the national phase but only much later. As supporting evidence for its submission, the appellant produced several documents. In an attempt to resolve the contradictory evidence the board made another enquiry at CIPO but did not receive any response.

The board understood that it was faced with contradictory evidence with regard to the publication date of document D3. It could not refute with sufficient certainty the appellant's allegation that, in the specific case at issue, a dispute between the applicant of D3 and the various patent offices concerned with regard to the validity of the claimed priority had affected the public access to the content of the application according to D3. As a matter of principle, if an adverse decision of an organ of the EPO was to rely on a certain fact, that fact should be proven beyond any reasonable doubt. In the present case, in view of the contradictory evidence on file and in the absence of any further clarifying information on the part of CIPO, it was virtually impossible for the board to establish with certainty that the public had had access to the Canadian application according to document D3, before the priority date claimed by the application. For the

above reasons, the board considered that document D3 did not belong to the prior art within the meaning of Art. 54(2) EPC 1973.

1.9.3 Standard of proof

In **T 48/96** the board stated that, in order to prove the allegation that a particular apparatus described in a catalogue had been available to the public before the priority date, it was not sufficient to show that the catalogue had been published on time, because a mere indication in a catalogue did not constitute absolute proof that the described product had in fact been available to anybody.

In **T 77/94**, the argument that a publicity notice's date of issue was necessarily immediately after its date of printing (because such notices were only produced in order to be issued) was held to be merely a supposition which required confirmation; in reality, things were often different.

In **T 729/91**, one relevant document was an issue of a monthly periodical, intended for hoteliers and caterers and which could be bought in South Africa. In accordance with the evidence brought forward in the case, a copy of this periodical was received by a particular library on 9.8.1984, i.e. before the priority date (13.8.1984) of the patent in suit. The librarian stated that publications were "generally available to the public as of the date of receipt". There was no absolute certainty that this was the case with the publication in question. The board was of the opinion that the EPO must decide what had happened having regard to the available evidence on the balance of probabilities, i.e. it must decide what was more likely than not to have happened. In the present case, it was, in the board's view, clearly much more likely that the publication was available to the public as from the date of receipt. In the absence of evidence to the contrary, the board accepted that what had in fact happened was what the librarian stated would "generally" have happened. So the publication was considered to have been made available to the public before the priority date.

In **T 1029/96** the board held that it had to be beyond doubt - not merely probable - that claimed subject-matter was directly and unambiguously disclosed in a patent document. So if there is reasonable doubt as to the outcome of a disclosure, a novelty objection based on the document in question has to be rejected.

In **T 231/01** the examining division had relied on the probability and likelihood that the parameters of the articles known from the submitted document if measured would fall within the claimed ranges. The board could not follow this line of argument, because the criteria for assessing novelty are not based on likelihood, but on identity of technical information between the content of the prior art disclosure and the subject-matter claimed.

In **T 55/01** the respondent had argued that only a "complete chain of proof" would suffice to establish that the manual of a television formed part of the prior art. The board agreed that the evidence adduced by the appellant did not form a complete chain of evidence of a sale and noted that, in cases where only one party had access to information about an

alleged public prior use, the case law had tended towards expecting that the public prior use be proved beyond any reasonable doubt ("up to the hilt"), answering the typical questions "What?", "When?", "Where?", "How?" and "To whom?", since the other party was reduced to merely pointing out inconsistencies or gaps in the chain of evidence; see **T 472/92** (OJ 1998, 161). However, the case law had taken into account the fact that cases of mass-produced consumer goods which were widely advertised and offered for sale to customers who often remained anonymous might require different treatment; see **T 241/99**. Indeed, to demand a complete chain of evidence in such cases would make it unreasonably complicated for a party to successfully rely on a sale or an offer for sale to prove public availability.

The board observed that televisions were mass-produced consumer products which were rapidly distributed to the market without any obligation of confidentiality. It found that, according to general experience, it seemed highly implausible that such goods, whilst being mass-produced, accumulated at some hidden location. It held that, under these circumstances, no further evidence was necessary to prove that televisions were actually sold to specified customers and that the handbook accompanying them was made available to the public within a period of about four months between their established production date and the priority date of the patent in suit, thereby taking into account the fact that events on the mass market such as the appearance of new television products were readily accessible to everybody, in particular to competitors, who would normally observe the market carefully. Hence, the balance of probabilities was the applicable standard of proof in cases such as this, as distinct from **T 472/92**.

In **T 665/00**, the board held that the evidence submitted had to be assessed in accordance with the principle of "unfettered consideration of the evidence". Moreover, the same principles of taking evidence applied to all the facts and arguments relied on in support of all the grounds of opposition, including public prior use (see, to that effect, **T 270/90**, OJ 1993, 725). However, the board pointed out that the exercise of this unfettered discretion meant that varying standards of strictness could be applied in evaluating the evidence. Thus, where an issue of fact was being decided on the balance of probabilities, the more serious the issue and its consequences for the fate of the patent, the more convincing the evidence had to be (**T 750/94**, OJ 1998, 32). In particular, if the board's decision on whether to revoke the patent depended on that issue of fact, the available evidence would have to be examined very critically and strictly.

The board in **T 313/05** referred to the established case law of the boards of appeal that, when lack of novelty is alleged, the burden of proof lies with the party claiming that the information in question was made available to the public. The case law of the boards of appeal had developed certain principles on the standard of proof necessary to establish the facts on which a decision is to be based. In some decisions the boards of appeal had applied the standard of "the balance of probabilities", which means that in relation to, for example, the question of when a document was first made available to the public, the board must decide what is more likely than not to have happened (see for example decisions **T 381/87**, OJ 1990, 213, **T 296/93**, OJ 1995, 627, and **T 729/91** of 21 November 1994). In other decisions the boards took the view that a fact had to be proved "beyond reasonable doubt" or "up to the hilt" (see for example decisions **T 782/92**

of 22 June 1994, **T 97/94**, OJ 1998, 467, **T 848/94** of 3 June 1997, **T 472/92**, OJ 1998, 161 and, in particular, **T 750/94**, OJ 1998, 32). The board considered the latter approach to be the appropriate one in cases where the revocation of a granted European patent is at issue. To base a revocation decision on the mere balancing of probabilities of what might have occurred would be difficult to reconcile with the need for reliability in the decision-making procedures of the EPO, which is of utmost importance for users of the patent system as well as the general public. Thus, the public availability of document at issue before the priority date of the patent in suit could only be regarded as established if, in view of the evidence, the board does not entertain any reasonable doubt in this respect.

In **T 738/04** the board noted that it is the established practice of the boards of appeal to apply the criterion of "absolute conviction" rather than the "balance of probabilities" in cases of prior public use for which the evidence lies entirely within the sphere of the opponent (see **T 472/92**, OJ 1998, 92, later reiterated in decision **T 97/94** (OJ 1998, 467)). This implies not only that the reasoning referred to by the appellant should be complete and conclusive but also that all facts supporting that reasoning be fully substantiated by corresponding evidence. This requirement is the consequence of the principle according to which parties representing opposite interests should be given equally fair treatment and derives from the contentious character of the post-grant opposition proceedings (see **G 9/91**, OJ 1992, 408). The board observed that, usually, the only possibility for a patentee who played no part in the alleged prior use is to take issue with the conclusive nature of the adduced evidence and consequently of the reasoning to which it gives rise; the unbalanced factual situation resulting from the unilateral access of the opponent to the available evidence is then compensated by the severe legal requirement developed by the case law that such prior use should be established beyond any reasonable doubt. A more liberal approach, which would accept that facts could be established on the basis of the less demanding criterion of "balance of probabilities" would, in inequitable situations such as those referred to above, normally constitute a breach of this principle, since the patentee would be deprived of the opportunity to successfully challenge the opponent's reasoning, i.e. to question the conclusiveness of the adduced evidence.

The board found that it was essential for the opponent to decide, when filing the notice of opposition or, at the latest, when filing the statement setting out the grounds of appeal, on which prior use the objection against the granted patent would be based. In a situation like the one at issue, in which the elaboration of a norm led to a multiplicity of factual situations possibly each constituting on its own a prior use (various printed versions of the norm, multiplicity of meetings, public enquiry, etc.), the opponent should, from the outset of the opposition proceedings or ensuing appeal proceedings, have identified those situations which for it would have the highest chance of success, i.e. those situations in respect of which he would be able to produce evidence complete enough to support the desired conclusion. In the opinion of the board, it would have been unfair to allow the appellant in the course of inter partes proceedings to extend the case originally put forward in relation to one specific situation to other situations, even if these situations arose in the framework of one and the same general elaboration process.

For more details regarding proof in connection with public prior use, see also Chapter "Law of evidence".

1.9.4 Information retrieved from the internet: proof of the date of availability

There are a number of decisions of the boards of appeal that have some bearing on the use of the Internet as source of disclosure.

In **T 91/98** the board ruled that a date mentioned in the heading of an entry, which was retrieved from the Lexis-Nexis database (an Internet resource) much later than the relevant dates in question, could not be equated with the distribution date and, in particular, need not be right. Affidavits and declarations were also not found to establish the date of availability with the required degree of certainty.

In **T 373/03** neither the author date of a PBS document recovered from the Internet nor its date of creation as found embedded in the code were accepted by the board as proving a date of availability before the relevant dates in question.

In both cases the information retrieved from the Internet was not excluded per se. However, both cases demonstrate the difficulties in determining the exact date of availability of such information (see **T 1134/06**).

In **T 1134/06** the board found that a disclosure on the Internet could be comprised within the state of the art as defined by Art. 54(2) EPC 1973. If an Internet disclosure was to be used as prior art, a strict standard of proof should be adopted. Thus, the fact that an Internet disclosure formed part of the state of the art under Art. 54(2) EPC 1973 should be proved "beyond any reasonable doubt". The particular facts and evidence required would depend on each individual case, but would normally have to meet the criteria established by the jurisprudence of the boards of appeal in respect of a prior use or a prior oral disclosure, i.e. answer the questions of when the Internet disclosure was made available to the public, what was made available and under which circumstances it was made available to the public. Concerning the latter question, it would in most cases be necessary to address the main concern of reliability surrounding the Internet, in particular so as to establish whether, and to what extent, a retrieved disclosure was true to the disclosure appearing at that date.

The board went on to state that in certain cases, where a web site belonging to a reputable or trusted publisher published online electronic versions of paper publications, content and date could be taken at face value, and the need for supporting evidence could be dispensed with. It could also be envisaged that if a web site operated under recognised regulations and standards, which would allow the date and content of information retrieved therefrom to be established with a high degree of certainty, further evidence might also not or no longer be required. Of course, it should be clear for both the examiner and the public whether an Internet source was considered as "reputable" or "regulated". This again called for clearly defined guidelines. Where a disclosure had been retrieved from a resource such as the Internet Archive, further evidence concerning the history of the disclosure, whether and how it had been modified since the date it

originally appeared on a web site would be necessary. This could be in the form of an authoritative statement from the archivist. Alternatively, an appropriate statement as to the content, either from the owner or author of the archived web site which included the disclosure could suffice.

In **T 1875/06** the board fully agreed with this finding in decision **T 1134/06** and applied the strict standard of proof to document (3), retrieved from the internet by the examining division when establishing the supplementary European search report. Document (3) was a printout of a web page. At the date of the decision, the URL indicated in the supplementary European search report did not permit retrieval of document (3) or of any other document. The board stated that, on the basis of the information provided, it would have been necessary to investigate further whether a document having the content of document (3) was available to the public before the priority date of the present application. The board decided that proof of the above assumption regarding the public availability of document (3) would depend on suitable further evidence. The board was therefore inclined to exercise its discretion under Art. 111(1) EPC and to remit the case to the examining division for further examination in order that it could carry out a further investigation to obtain the necessary evidence. In so far as a reasonable effort to obtain such further evidence was unsuccessful, the examination was to be carried out without considering document (3) as included in the state of the art.

1.9.5 Obligation of the EPO to examine of its own motion

Some cases of alleged prior use have been concerned with the extent of the EPO's obligation under Art. 114 EPC to examine of its own motion. In these cases, either the opposition had been withdrawn at the appeals stage and establishing prior public use had proved difficult, or the alleged prior use had not been substantiated.

In **T 129/88** (OJ 1993, 598) the board took the view that the EPO's obligation to examine matters of its own motion did not extend as far as investigating an allegation of prior public use, where the party formerly making the allegation had withdrawn from the proceedings, and it was difficult to establish the facts without its co-operation (see also **T 830/90**, OJ 1994, 713; **T 887/90**, **T 420/91**).

In **T 582/90** the board ruled that an objection of prior public use had to be examined if it appeared to be relevant, even if it had not been sufficiently substantiated.

2. Determining the content of the relevant prior art

After establishing what information forms part of the state of the art, the next step is to determine its technical content and whether that content is apparent.

The consistent view in the case law is that for an invention to lack novelty, its subject-matter must be clearly and directly derivable from the prior art (see e.g. **T 465/92**, OJ 1996, 32; **T 511/92**) and all its features - not just the essential ones - must be known from the prior art (**T 411/98**). The disclosure is determined by what knowledge and

understanding can and may be expected of the average skilled person in the technical field in question (**T 164/92**, OJ 1995, 305, Corr. 387; **T 582/93**).

Determining the information content means interpreting what comprises the state of the art. The boards have established certain principles to be observed in this process.

2.1. General rules of interpretation

In **T 600/95**, the board held that the interpretation of the technical disclosure contained in a given document does not normally depend on the **purpose** it serves, be it as representing state of the art, priority document or the application as filed.

In **T 312/94**, the board held that it was a general legal rule for the interpretation of any document, in particular a patent application or patent, in order to determine its true meaning and thus its content and disclosure, that no part of such a document should be construed in isolation from the remainder of the document: on the contrary, each part of such a document had to be construed in the **context of the contents of the document as a whole**. Thus, even though a part of a document appeared to have a particular meaning when interpreted literally and in isolation from the remainder of the document, the true meaning of that part of the document could be different having regard to the remainder of the document (see also **T 546/07**; **T 860/06**).

In **T 969/92** the board decided that, in order to determine what had been made available to the public, not only the main claim but also the remainder of a **patent document** had to be carefully considered for guidance as to what had really been taught in the prior document, i.e. its real express and implicit information content.

In **T 158/96**, in the examining division's opinion, the use of the compound "sertraline" for the manufacture of a medicament to treat obsessive-compulsive disorder (OCD) was not novel with regard to a document disclosing that sertraline was undergoing clinical trials for OCD shortly before the priority date. The examining division stressed that, for the purposes of patent disclosure, it was common practice to accept any pharmacological test as the disclosure of a medical use, as long as this test was commonly accepted as an indicator of potential therapeutic utility.

The board did not share the examining division's conclusion in the case at issue. For a prior-art document to be recognised as prejudicial to the novelty of a claimed subject-matter, the information conveyed by this document could not be interpreted on the basis of rules, which, though normally valid, did not necessarily apply to the specific situation and therefore might lead to **speculative conclusions**.

The information in a citation that a medicament was undergoing a clinical phase evaluation for a specific therapeutic application was not prejudicial to the novelty of a claim directed to the same therapeutic application of the same medicament, if such information was plausibly contradicted by the circumstances, and if the content of said citation did not allow any conclusion to be drawn with regard to the actual existence of a

therapeutic effect or any pharmacological effect which directly and unambiguously underlay the claimed therapeutic application (see also **T 385/07**).

In **T 943/93** the board held that a **hypothetical possibility** of operating within the claimed area was not per se sufficient in law to deprive this area of novelty, particularly if the skilled person had no technical motive and thus no practical necessity to work within this region.

Decisive for novelty in **T 464/94** was a citation disclosing a preliminary test to transform plant protoplasts with selective markers. The opposition division had considered it probable that this document anticipated the patent in dispute.

In the board's view, it was not justifiable to decide whether a document was prejudicial to novelty on the **basis of probability**. When a patent was revoked for lack of novelty, the department concerned had to be sure, having taken all the facts and arguments put forward during the proceedings into consideration, that the revocation was justified. If in doubt, further evidence had to be adduced otherwise the patent could not be revoked for lack of novelty.

In **T 233/90** the board took the view that in a case where a document comprised in the state of the art under Art. 54(3) EPC 1973 referred to "**a usual manner**" of preparing a product, it was permissible to use documents of reference such as handbooks, encyclopaedias or dictionaries in order to determine what the skilled person would have understood by such a reference on the effective date of the prior document.

In **T 60/99** the subject-matter of claim 1 of the patent in suit differed from the machine referred to in the description and the drawings of the relevant prior art in that the frame of the agricultural machine for connecting the mowing unit to the hitch was at the front side of a tractor, whereas in the prior art the frame was at the rear side of a tractor.

The appellant/opponent held that the fact that the drawings and the description of the prior art document referred only to a specific embodiment concerning a rear-mounted machine did not imply that the information content of the document excluded front-mounted machines.

In the board's judgment, the independent claim of a patent document normally represents a generalisation of what is described in detail in the description by referring to the drawings. The definition of the extent of protection is given by formulating a concept covering not only the specific embodiment described in detail in the description, but also other specific embodiments, which may differ from the item described in detail in the document but which each have all the features of the concept defined by the claim.

However, the scope of the claim and its information content must be distinguished from one another. The information content of the claim relates to the totality of features which are common to a plurality of individual items and thus permit all these individual items to be conceptually embraced and the concepts to be distinguished from one another (the intension or internal content of the concept). The scope of the claim relates to the totality

of the individual items having all the features of the concept (the extension or external range of the concept).

In the case in point, the independent claim of the prior art document defines a concept which is more general than the rear-mounted mower-conditioner described in the description and the drawings (i.e. a concept embracing both a front-mounted and a rear-mounted mower-conditioner) but does not disclose any particular example of this general concept (i.e. does not disclose either a front-mounted or a rear-mounted mower-conditioner). Therefore the information content of the patent in suit must be considered novel with respect to the information content of this document.

In **T 1080/99** (OJ 2002, 568) the board held that in view of its legal nature and intended purpose, a Japanese patent abstract in English was a publication intended to reflect the technical content of the corresponding Japanese patent application for the purpose of quick prima facie information of the public, as was the purpose of any kind of abstract or summary of technical subject-matter. Hence the contents of such abstracts were to be interpreted, and possibly re-evaluated, in the light of the original document if the latter was available. Indeed, if an abstract appeared to add something to the original document, that pointed to an error in the abstract, or at least to an error in its interpretation.

Referring to established case law, the board in **T 410/99** noted that a prior art disclosure was novelty-destroying if it directly and unambiguously disclosed the subject-matter in question, as well as took account of a skilled person's common general knowledge, whether at the publication date of the cited document (in the case of prior art cited under Art. 54(2) EPC 1973); or at the priority date of the cited document (in case of a document pursuant to Art. 54(3) EPC 1973) (see e.g. **T 511/92**). Moreover, a prior art disclosure had to be read giving the information it contained the meaning that a skilled person would have given it at its publication date and disregarding information which would be understood by a skilled person to be wrong; however, any teaching which would not be recognised as wrong by a skilled person had to be accepted as prior art (see **T 412/91**).

In the case at issue, the appellant had submitted that a skilled person could have considered that additional steps were involved in the process disclosed in prior art document (9) but not described in this citation and that there were therefore other possible interpretations of its text. Therefore the claimed subject-matter was not directly and unambiguously derivable from the teaching of that document, such as was found for example in **T 464/94**. The board found, however, that in the case before it there was no evidence or reason to consider the explicit teaching of document (9) as incomplete or wrong, since it clearly described all process steps and the influence of each process step upon the quality of the product thereby obtained. Moreover, its teaching, unlike the situation in **T 464/94**, did not raise any doubt about the results obtained by the claimed process as mentioned in the text; therefore its teaching could not be considered either hypothetical or contrary to the common general knowledge in the relevant technical field. Since, therefore, the facts of the case were distinguished from those underlying **T 464/94**, the latter could not be applied to the case at issue. The board concluded that

document (9) directly and unambiguously disclosed all the features of the process of claim 1 and that the subject-matter of claim 1 thus lacked novelty.

In **T 4/00** the board found that for novelty to be destroyed for the claimed ranges of the components of the gas mixture, the skilled reader should be able to derive directly and unambiguously from a particular part of a graph at least one specific gas mixture composition relevant for the claimed ranges. However, the description of the prior art document noted that these graphs were approximate contour lines of equal weld penetration, established on the basis of measurements of the weld penetration depth obtained in tests with a number of gas mixtures. Thus the graphs themselves did not represent measured values. Further, the board observed that the means by which the graphs had been established were not mentioned in the prior art document. It therefore held that the points of a graph in a diagram in a prior art document did not represent a disclosure of the corresponding values read from the scales of the diagram, if the accuracy of the graph in the diagram could not be established.

In **T 546/07** the board found that the skilled person reading a document did not construe individual points of the disclosure in isolation, but rather in the context of the document as a whole (**T 312/94**, **T 860/06**).

2.2. Combinations within a prior art document

In **T 305/87** (OJ 1991, 429) the board considered it expedient to state that, in order to assess novelty, it was not sufficient to limit oneself to the contents of a single document taken as a whole, but rather it was necessary to consider separately each entity described therein. The subject-matter of the patent under appeal was a shear. The opponents maintained that the features, taken as a whole, of two shears which were disclosed in a catalogue, had to be regarded as a single state of the art because those shears were described in one and the same technical context and in one and the same document. They argued that, when taken as a whole, this set of known features anticipated the invention. The board, however, made it clear that it was not permissible to combine **separate items belonging to different embodiments** described in one and the same document merely because they were disclosed in that one document, unless of course such combination had been specifically suggested there. The two shears known from the catalogue were therefore definitely two separate entities forming two independent bases for comparison which ought to be considered in isolation when assessing novelty, and it was not admissible to piece together artificially a more relevant state of the art from features belonging to one or both of these entities, even if they were both disclosed in one and the same document (see **T 901/90**, **T 931/92** and **T 739/93**).

In **T 332/87** the board held that, when examining novelty, different passages of one document might be combined, provided that there were no reasons which would prevent a skilled person from making such a combination. In general, the technical **teaching of examples** might be combined with that disclosed elsewhere in the same document, e.g. in the description of a patent document, provided that the example concerned was indeed representative of, or in line with, the general technical teaching disclosed in the respective document. In the case at issue, the board concluded that a particular

composition in an example was not in agreement with the general technical teaching of the prior art document and that in view of this discrepancy the skilled person would not have combined the said disclosure with this example.

In **T 42/92** it was explained, in accordance with the boards' established case law, that a prepublished patent specification formed part of the state of the art under Art. 54(2) EPC 1973 only as regards those elements which the person skilled in the relevant art would incontestably infer from the document as a whole. The disclosure of a prior-art patent specification did not however cover combinations of individual features arising from **reference back to the claims** if those features were claimed separately for patent-law considerations and combining them was not supported by the description, or even - as here - was at odds with the embodiments described.

In view of the objection as to lack of novelty, the question to be answered in decision **T 610/95** was whether or not the proposed solution in the patent was derivable directly and unambiguously from the disclosure of citation (2), which contained **cross-references** to the entire content of **three patent specifications** without giving priority to any of these references. Each of these references offered a plurality of different options for preparing pressure-sensitive layers of medical dressings.

The board held that, under these circumstances, it could not be said that the use of the specific product acting as pressure-sensitive material in the claimed invention was directly and unambiguously derivable from the wholly general reference to the three different prior documents quoted in citation (2) and had therefore already been made available to the public.

2.3. Taking implicit features into account

In **T 6/80** (OJ 1981, 434) the board found that where a further functional attribute of an element of a **device** disclosed in a document was immediately apparent to a person skilled in the art reading the document, such attribute formed part of the state of the art with regard to that device.

Any prior-art disclosure is novelty-destroying if the subject-matter claimed can be inferred directly and unequivocally from that disclosure, including features which for the skilled person are implicit in what is explicitly disclosed (see **T 677/91**, **T 465/92**, OJ 1996, 32; **T 511/92**).

In **T 666/89** (OJ 1993, 495) the term "available" clearly went beyond literal or diagrammatical description, and implied the communication, express or implicit, of technical information by other means as well. One example of the available **information content of a document** extending beyond this literal descriptive or diagrammatical content was the case where the carrying out of a **process**, specifically or literally described in a prior art document, **inevitably resulted in a product** not so described. In such a case, the board stated, the prior art document would deprive a claim covering such a product of novelty. It was thus content, express and implied, rather than mere

form, that was decisive for the issue of novelty in general, and "selection" novelty in particular (see **T 793/93**).

In **T 518/91** the board held that the logical interpretation by a skilled person of technical facts explicitly stated in a prior document - in particular the definition beyond the explicit disclosure of the document of features of the prior art described in general terms - was not part of the technical teaching implicitly derivable from the document, which the skilled person would automatically infer, if it contradicted other explicit technical information in the otherwise consistent overall disclosure of the document.

In **T 624/91** it was held that exact **disclosures for alloy compositions** in the state of the art had to be interpreted as average or nominal values within a small range in view of known fluctuations in reproducibility and in analytical results, unless there was evidence available to the contrary. The board pointed out that, whenever a metallurgist aimed at producing an alloy in accordance with a given nominal composition, the composition of the final product would deviate somewhat from this target or even be undefined within certain narrow limits. The metallurgical production process was not ideally reproducible and the actual composition of different batches aiming at the same nominal composition would be spread over a certain area around this target. Consequently, the nominal composition of a cited alloy not only disclosed the composition as a specific point which nobody would be able to realise in practice, but also a certain range around this average or nominal composition into which the majority of the analyses of those alloys fell which had been prepared aiming at the nominal composition and using the care usual in this art when producing and analysing an alloy.

In **T 71/93** it was held that a feature not explicitly mentioned in a prior art document, even though generally known to help overcome a drawback usual in the same technical field, could not be considered implicitly disclosed if it were not directly derivable from the prior art document that the drawback was considered unacceptable and/or if other solutions were proposed for overcoming the drawback.

In **T 572/88** and **T 763/89** the boards warned against using the concept of "implicit prior description" in such a way that considerations relevant to the evaluation of inventive step were transferred to the assessment of novelty. A fair assessment of an invention's patentability called for a clear distinction between novelty and inventive step. In decision **T 763/89**, for example, the opponent could not claim "implicit prior description" for a material with exactly three layers, as claimed in the disputed patent, on the grounds that a skilled person, aware of the considerable outlay required for further sub-layers and the limited improvement in the quality of the image they bring, would have understood the wording of the claim, which set no upper limit for the number of layers, to be virtually synonymous with "two or three layers". To do so would be to adduce a typical criterion for the evaluation of inventive step.

In **T 71/93** the board held that an "implicit prior description" of a feature could not be based on the grounds that a person skilled in the art would have been aware of some disadvantages and of the lack of other forms of improvement related to a feature, since this was a criterion for the evaluation of inventive step.

2.4. Taking intrinsic features into account

In **T 59/87** (OJ 1991, 561) the respondent had contended that a particular document inherently disclosed the claimed invention and was therefore destructive of novelty. However, the board stressed that decision **G 2/88** (OJ 1990, 93, Corr. 469) emphasised that the question to be decided was what had been made available to the public, not what might have been inherent in what was made available to the public. Furthermore, when considering how far the teaching in a written description also made the inevitable result of carrying out such teaching available to the public, in each case "a line must be drawn between what is in fact made available and what remains hidden or otherwise has not been made available". Thus, the board decided that whether a previously undisclosed technical effect, which in fact inevitably occurred when a previously disclosed technical teaching in a written description was carried out, had been made available to the public by reason of the teaching in the written description was a question of fact which had to be decided in the context of each individual case.

G 1/92 (OJ 1993, 277) further stipulated that a commercially available product did not per se implicitly disclose anything beyond its composition or internal structure. Other characteristics, which were only revealed when the product was exposed to interaction with specifically chosen outside conditions in order to provide a particular effect or result, or to discover potential results or capabilities, therefore pointed beyond the product per se as they were dependent on deliberate choices being made and thus could not be considered as already having been made available to the public.

Further to this decision, the board held in **T 977/93** (OJ 2001, 84) that a product made available to the public was not reproducible within the meaning of **G 1/92**, and thus did not belong to the state of the art, if the skilled person could not establish that the reproduced product was identical to the commercially available one, because the intrinsic and extrinsic features of the product were not accessible and there was a high probability of variation upon reproduction.

2.5. Taking equivalents into account

The case law of the boards of appeal is based on a narrow concept of novelty, i.e. the disclosure of a prior document does not include equivalents of the features which are explicitly or implicitly disclosed; equivalents can only be taken into account when it comes to considering inventive step (see **T 517/90**). This narrow concept of novelty, which excludes equivalents, is of particular importance for the application of Art. 54(3) EPC 1973. In **T 167/84** (OJ 1987, 369) the board commented that conflicting applications within the meaning of Art. 54(3) EPC 1973 were included in the state of the art solely from the point of view of novelty, but were considered in the light of their "whole contents". In order to mitigate the harsh effects of the "whole contents approach", its application was confined to novelty (see Art. 56, second sentence, EPC 1973). Further, in order to reduce the risk of "self-collision", it had always been considered justified to adopt a strict approach to novelty. For this reason, Guidelines expressly stated that "when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the document; this is a

matter of obviousness". Accordingly, the board held that the "whole contents" of an earlier document did not also comprise features which were equivalents of features in the later document (see also **T 928/93**).

In **T 652/01** the appellant/opponent was of the opinion that although the relevant prior-art document did not explicitly mention a particular feature, that feature could be derived from the document by applying the document's teaching *mutatis mutandis*. The appellant had referred to **T 952/92** (OJ 1995, 755), which, in its first headnote, stated that "availability" within the meaning of Art. 54(2) EPC 1973 involved not only availability of the disclosure but also availability of information accessible and derivable from the disclosure.

The term "derivable", if used in isolation, could, *inter alia*, be interpreted as "capable of being obtained or drawn as a conclusion, deduction or inference" (Oxford English Dictionary), which would suggest that "derivable equivalents" were included.

However, the board held that, when reading the cited phrase from **T 952/92** in the context of the present decision, it was clear that the term "derivable" had been employed in the sense of "obtainable by chemical analysis of a sample" and that it was used with the same restriction as expressed in opinion **G 1/92** (OJ 1993, 277), namely that it had to be "directly and unambiguously derivable".

2.6. Taking drawings into account

In **T 896/92** the board emphasised that, in accordance with **T 169/83** (OJ 1985, 193), further conditions were required as to the disclosure of a feature shown solely in a drawing. In this respect, not only should the structure of the feature be shown sufficiently clearly in the drawing, but also the technical function achieved should be derivable (see also **T 241/88**).

In **T 204/83** (OJ 1985, 310) the board held that features shown solely in a drawing formed part of the state of the art when a person skilled in that art was able, in the absence of any other description, to derive a technical teaching from them. Dimensions obtained merely by measuring a diagrammatic representation in a document did not, however, form part of the disclosure (see **T 857/91** and **T 272/92**).

In **T 451/88** the distinction was drawn between scaled construction drawings and the schematic drawings conventionally included in patent documents, the latter being sufficient to indicate the essential elements of the invention but not to manufacture the product. It was found that schematic drawings could not be used to derive a ratio between two dimensions (**T 1664/06**).

In **T 56/87** (OJ 1990, 188) the board held that a technical feature which was derived from or based on dimensions obtained from a diagrammatic representation and which technically contradicted the teaching of the description, did not form part of the disclosure of a document.

T 748/91 was concerned with measuring relative dimensions in drawings. In that case the board found that size ratios could, under certain circumstances, be inferred even from a schematic drawing.

2.7. Taking examples into account

In **T 12/81** (OJ 1982, 296) the board held that the teaching of a cited document was not confined to the detailed information given in the examples of how the invention was carried out, but embraced any information in the claims and description enabling a person skilled in the art to carry out the invention (see also **T 562/90**). In **T 424/86** the board stated that the disclosure of a document was not to be construed only on the basis of the examples thereof; rather, the entire document had to be taken into consideration (see also **T 373/95**). In **T 68/93** the board stated that it was not allowable to take a particular example out of context. In **T 12/90**, the board decided that the disclosure in a prior document likely to affect the novelty of a claim was not necessarily limited to the specific working examples, but also comprised any reproducible technical teaching described in the document (see also **T 247/91** and **T 658/91**).

In **T 290/86** (OJ 1992, 414) the board decided that what was "made available to the public" by specific detailed examples included in a document was not necessarily limited to the exact details of such specific examples but depended in each case upon the technical teaching which was "made available" to a skilled reader. The amendment of a claim by including a disclaimer in respect of such specific detailed examples could not render the claim novel.

In **T 365/89** the board held that Art. 54(1) EPC 1973 did not require that a technical teaching had to be disclosed in detail, e.g. by working examples. Thus, the presence or absence of such more detailed information did not influence the answer to the question whether or not the relevant disclosure in a particular document belonged to the state of the art.

In **T 666/89** (OJ 1993, 495) the respondent argued that the examples of a particular prior art document lay outside the scope of a particular claim and that the generic disclosure therein could not be held to be an anticipation of this claim. As a result, only the examples of a document should be regarded as state of the art. The board stated that the respondent had ignored the established jurisprudence of the boards of appeal, according to which it was necessary to consider the whole content of a citation when deciding the question of novelty. In applying this principle, the evaluation was therefore not to be confined merely to a comparison of the claimed subject-matter with the examples of a citation, but had to extend to all the information contained in the earlier document.

In **T 1049/99** the board noted that, according to Art. 54(2) EPC 1973, the state of the art comprised "everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application". In the case of a "written description" open to public inspection, what is made available is all the information contained in that description. In some cases, the

information contained in the written description, such as teaching on ways of carrying out a process, also provides access to other information necessarily resulting from the application of that teaching (**T 12/81**, OJ 1982, 296; **T 124/87**, OJ 1989, 491; **T 303/86**).

2.8. Assessment of prior use

Several decisions have concerned the information content of cases of prior use.

In **T 245/88** two vaporisers had been installed in a fenced-off area of a shipyard. As far as the opportunity to view these vaporisers from outside the fence was concerned, the board was not convinced that a person skilled in the art, without the knowledge of the subject-matter claimed in the contested patent, would have recognised the teaching it contained and the problem it sought to solve, or that he would have detected the claimed spacing ratio among the many dimensions and dimension ratios which could be derived from a multi-tube vaporiser.

In **T 363/90** a machine fitted with a sheet feeder corresponding to the claimed invention had been exhibited and demonstrated at trade fairs. The board concluded that, under the circumstances, it was impossible for the skilled person to recognise - or to infer on the basis of further information - the technical features and the functions of the exhibited sheet feeder to an extent which would have enabled him to copy its design, let alone develop it further (see also **T 461/88**, OJ 1993, 295).

In **T 87/90** the features and functions of a press that had been open to view were ruled to have been made available to the public because full details of the press had been given and information material distributed.

In **T 208/88** (OJ 1992, 22) the board held that an effect (in this case, growth regulation) not previously described, but actually occurring during the execution of a known teaching (in this case, use as a fungicide) and intended as the basis of a use invention, had in any event not been made available to the public, if it was not revealed so clearly during such execution as to disclose the invention's essential character, at least potentially, to an unlimited number of skilled persons.

In many cases the ability to recognise a technical teaching such as the internal structure or composition of a product in prior use presupposes analysis of the product embodying this technical teaching. Whether it is technically feasible to analyse a product that is available on the open market is an issue that the boards have considered on a number of occasions.

In **T 461/88** (OJ 1993, 295) the board ruled that a control program stored on a microchip had not been made available to the public if the analysis of the program would require an expenditure of effort on a scale which could only be reckoned in man-years and if, for economic reasons, it was highly improbable that the sole purchaser of the machine controlled by the program had carried out such an analysis (see obiter dictum ruling in **T 969/90**).

In **T 390/88** the board rejected the argument that a film had not been made available to the public because its existence had only been announced at a press conference three weeks before the priority date, and hence it would have been impossible in that short time for a person skilled in the art to determine the film's composition.

In **T 406/86** (OJ 1989, 302) the composition of a product that had been commercially available before the priority date was held to have become part of the state of the art because it could be analysed without undue burden. In **T 969/90** and **T 953/90** the board had ruled that the internal structure of a product in prior use had been made available to the public because a skilled person relying on the normal means of investigation available to him would have been able to analyse the product.

In **G 1/92** (OJ 1993, 277), already mentioned above, the Enlarged Board of Appeal held: "Where it is possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then both the product and its composition or internal structure become state of the art."

In **T 952/92** (OJ 1995, 755) the board held that prior use of a product provided access to what the skilled person would be able to ascertain from that product by means of known analytical techniques. Whether such an analysis could be performed without undue burden was irrelevant to the question of whether the composition of a product had been made available to the public. In giving its reasons the board stated that the original English of **G 1/92** (OJ 1993, 277) was not entirely clear in terms of grammar, since the phrase "without undue burden" could refer to just the reproduction of the product, or both the discovery of its composition or internal structure, and its reproduction. The reference to "without undue burden" was not strictly necessary in order to provide an answer to the referred questions and could not therefore have been intended to alter or add to the existing law concerning what constitutes "the state of the art". Reproducing a product "without undue burden" was a problem associated with Art. 83 EPC 1973. Furthermore, applying the concept of "undue burden" would introduce a subjective element into the determination of novelty, something which the Enlarged Board had specifically sought to reject in **G 1/92**.

A further question considered by the board was whether, if the composition of a product in prior use was to be "made available", a complete analysis of such product had to be possible, so that, as submitted by the patent proprietor, such product could have been reproduced exactly. In the board's view, a claimed invention was anticipated by the prior use of the product, if an analysis of a product using available analytical techniques was such as to inform the skilled person of an embodiment of the product which fell within the claim of the patent.

In **T 472/92**, the problem to be solved by the subject-matter of the patent in suit was the provision of a laminate suitable for the fabrication of sleeves which could be heat-shrunk onto bottles, where the outer surface of the laminate should have a good printability. This problem was solved, according to the patent in suit, by the use of polystyrene. A further element of the solution was the manufacture of the two layer laminate by coextrusion. The appellant/opponent contended that coextruded polystyrene laminates had been

delivered to a customer and that a skilled person would have been aware of their good printability and encouraged to replace, in the laminates known in the state of the art, the ethylene polymer composition based non-cellular layer by a non-foam layer made of polystyrene. The board referred to **G 1/92** and concluded that the printability characteristic of the material was not a property that became available to the public by their mere delivery, since this was clearly an extrinsic characteristic requiring interaction with specifically chosen outside conditions. Thus, such characteristic could not be considered as already having been made available to the public (see also **T 267/92**).

In case **T 301/94**, the patent concerned green glass bottles with a high filtering power for ultraviolet light and having a defined composition. It was proved that bottles with the claimed characteristics had been sold and delivered by the respondents (opponents) to a customer before the priority date. The appellants contended that the bottles produced of glass of said composition by the respondents had not been made available to the public, *inter alia* for the following reasons:

(1) the sulphide concentration of the glass was a secret or a "hidden" feature within the meaning of decisions **G 1/92** (OJ 1993, 277) and **G 2/88** (OJ 1990, 93), since it was not common general knowledge at the priority date that a green glass having a high UV absorption might contain a very low amount of sulphides. Thus, when analysing such a glass the skilled person would not have paid attention to the sulphide concentration, high sulphide concentrations being known only in connection with amber glass;

(2) a skilled person would not have been able, on the basis of what was generally known on the priority date, to reproduce the green glass without undue burden, because a tremendous number of experiments would have been necessary to find out the temperature and the reducing conditions leading to the desired optical properties by continuous production in an industrial plant.

The board held that the optical parameters represented intrinsic characteristics of the glass composition and not characteristics depending on a particular use or application of the glass. The situation considered by the Enlarged Board in decision **G 2/88** was different from that of the case at issue, since it concerned a claim relating to a new use of a known compound reflecting a newly discovered technical effect and not a claim to the compound itself. It was the new technical effect which constituted a hidden or secret feature, not the composition itself or one component thereof. Furthermore, the board held that the appellants in fact introduced an additional requirement for the chemical composition to be available to the public, i.e. that the skilled person should be able to recognize *a priori*, on the basis of common general knowledge at the priority date, which components the commercially available product might contain and in which amounts. Such an additional requirement would not be in agreement with the essence of opinion **G 1/92**, where only analysability and reproducibility of the commercially available product were required for its chemical composition to form part of the state of the art.

Furthermore, the board held that the skilled person would have been able to reproduce the green glass without undue burden and that this was sufficient to meet the requirement of reproducibility set out in **G 1/92**. What was required in **G 1/92** was not

that continuous production on an industrial scale be possible without undue burden, but that a skilled person be able to prepare the product without undue burden on the basis of his general technical knowledge and knowing the composition or internal structure of the product, whatever the scale of production (laboratory, pilot or industrial scale).

In **T 515/98** the invention related to an epilation device. The proceedings involved, inter alia, a claim of prior use.

The board ruled that any prior use had to be considered as a whole, just as parts of a prior-art document could not be taken out of context so as to arrive at different technical information from its teaching as a whole. Here too, certain components regarded as essential to a device's basic design for normal use as intended by the manufacturer could not be omitted.

In the present case, the prior-use epilation device - as even the appellant/opponent conceded - exhibited all the features of claim 1 only if certain essential components were omitted, thus changing the kinematics of its operating elements.

In the board's view, the appellant thus implicitly acknowledged that the device as marketed was not identical with that according to the invention; what was identical with the latter was a modified version, newly constructed using only some of the original components, so that the epilation elements in the two versions differed as regards both structure and kinematics. Since, in order to move from the prior-use device to the one according to the invention, the skilled person had to perform several acts (dismantling the marketed device, omitting components, partial reconstruction) which would not arise from normal use of the device on sale, the subject-matter of claim 1 was not directly and unambiguously derivable from the prior teaching.

2.9. Broad claims

In **T 607/93** the board decided that when novelty and inventive step were being assessed, there was no reason to use the description to interpret an excessively broad claim more narrowly, if it was a question not of understanding concepts that required explanation but rather of examining an excessively broad request in relation to the state of the art.

2.10. Deficiencies and mistakes in a disclosure

Mistakes in a document do not in themselves constitute prior art such as to prevent the grant of a patent.

In **T 77/87** (OJ 1990, 280) the abstract published in the journal "Chemical Abstracts" did not correctly reproduce the original paper. The board stated that the original document was the primary source of what had been made available as a technical teaching. Where there was a substantial inconsistency between the original document and its abstract, it was clearly the disclosure of the original document that had to prevail. The disclosure in the original document provided the strongest evidence as to what had been made

available to the skilled person. When it was clear from related, contemporaneously available evidence that the literal disclosure of a document was erroneous and did not represent the intended technical reality, such an erroneous disclosure should not be considered part of the state of the art.

In **T 591/90** a prior document again contained mistakes. The board distinguished this case from **T 77/87** (OJ 1990, 280), which had concerned a special case, and took the view that a document normally formed part of the prior art even if its disclosure was deficient. In evaluating such a disclosure it was to be assumed, however, that the skilled reader was mainly "interested in technical reality". Using his general technical knowledge and consulting the reference literature, he could see at once that the information in question was not correct. It could be assumed that a skilled person would try to correct recognisable errors, but not that he would take the deficient disclosure as pointing the way towards a solution to an existing technical problem.

In **T 412/91** the board took the view, having regard to Art. 54 EPC 1973, that the incorrect teaching of document (1) was not comprised in the state of the art. It stated that, in principle, what constituted the disclosure of a prior art document was governed not merely by the words actually used in its disclosure, but also by what the publication revealed to the skilled person as a matter of technical reality. If a statement was plainly wrong, whether because of its inherent improbability or because other material showed that it was wrong, then - although published - it did not form part of the state of the art. Conversely, if the skilled person could not see the statement was wrong, then it did form part of the prior art.

In **T 89/87** the board found that "0.005 mm" (= 5 nm) was a misprint contained in the prior document and that only "0.0005 mm" (= 0.5 nm) was correct. The board stated that the correction was such that the skilled reader would be expected to make it as a matter of course.

In **T 230/01** the board noted that in Art. 54(2) EPC 1973 "the state of the art" was clearly and unambiguously defined as "everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application". A document normally forms part of the state of the art, even if its disclosure is deficient, unless it can unequivocally be proven that the disclosure of the document is not enabling, or that the literal disclosure of the document is manifestly erroneous and does not represent the intended technical reality. Such a non-enabling or erroneous disclosure should then not be considered part of the state of the art (**T 77/87**, OJ 1990, 280; **T 591/90**).

2.11. Accidental disclosure

In **T 161/82** (OJ 1984, 551) the board found that the prior art document was concerned with the solution of a problem totally different from that stated in the application at issue and concluded that in cases where an anticipation was of a chance nature, in that what was disclosed in a prior document could accidentally fall within the wording of a claim to be examined for novelty without there being a common technical problem, a particularly

careful comparison had to be made between what could fairly be considered to fall within the wording of the claim and what was effectively shown in the document (see also **T 986/91**).

In **T 601/92** a radial ventilator was claimed, characterised in that the ventilator wheels were mounted on the ventilator shaft and offset against each other in such a way that the spokes of one ventilator wheel, viewed in the direction of the axle, were arranged opposite the gaps between the spokes of the other ventilator wheel. The prior art comprised fans, during the assembly of which no attention was paid to the angle of rotation of the spokes of the two ventilator wheels in relation to each other. The probability was extremely high that such fans, which coincidentally had the spoke arrangement claimed, had been sold. The board held that this was evidence of an anticipatory prior use of the claimed product, stating that in the case of anticipation of a chance nature where there was no common technical problem, particular care had to be taken when considering what could be deemed to be part of the claim and what was derived from the prior publication. In contrast to **T 161/82** (OJ 1984, 551), in which the claimed subject-matter was also structurally the same as the prior subject-matter, but had a different function, there was no recognisable difference in function in this case. **T 208/88** (OJ 1992, 22) was not comparable since, in the present case, a product was claimed and not a new possible use for a known substance based on a previously unknown effect or function of that substance. The auxiliary request related to a process for manufacturing low-noise radial ventilators, characterised in that the ventilator wheels were systematically mounted on the ventilator shaft and offset against each other in such a way that the spokes of one ventilator wheel, viewed in the direction of the axle, were arranged opposite the gaps between the spokes of the other ventilator wheel. In the board's view, this claim was clearly delimited from the prior art by the feature "systematically". This feature clearly referred to a procedural step and could acquire significance as a substantial distinguishing feature vis-à-vis the prior art only within a process claim. The fact that the claim for a manufacturing process contained predominantly product features was a logical consequence of the close connection between product and process and did not prevent the claim from being allowed.

In **T 608/96**, the board ruled that a disclosure was "accidentally novelty-destroying" if it would not be considered by the skilled person faced with the problem underlying the application or patent, whether because it belonged to a distant technical field or because its subject-matter suggested it would not help solve the problem. This also meant that a disclosure was "accidentally novelty-destroying" only if completely irrelevant for assessing inventive step.

2.12. Reproducibility of the content of the disclosure

A disclosure destroys novelty only if the teaching it contains is reproducible.

In **T 206/83** (OJ 1987, 5), in particular, it was found that a document (in this case a co-pending European application) did not effectively disclose a chemical compound, even though it stated the structure and the steps by which it was produced, if the skilled person was unable to find out from the document or on the basis of his common general

knowledge how to obtain the required starting materials or intermediates. Information which could only be obtained after a comprehensive search was not to be regarded as part of the common general knowledge. This need for an enabling disclosure was also in conformity with the principle expressed in Art. 83 EPC 1973 for patent applications which had, accordingly, to "disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art". The requirements as to the sufficiency of the disclosure were, therefore, identical in all these instances.

For selection inventions the requirement of a reproducible disclosure also plays a significant role. In **T 26/85** (OJ 1990, 22) the board pointed out that anything comprised in the state of the art could only be regarded as having been made available to the public in so far as the information given to the person skilled in the art was sufficient to enable him to practise the technical teaching which was the subject of the disclosure, taking into account also the general knowledge in the field to be expected of him. In this particular case, the ranges of a certain parameter as defined in the claim fell within the broader ranges stated for the same parameter in a prior art document. The board considered that a realistic approach, when assessing the novelty of the invention under examination over the prior art in a case where overlapping ranges of a certain parameter existed, would be to consider whether the person skilled in the art would, in the light of the technical facts, seriously contemplate applying the technical teachings of the prior art document in the range of overlap; if it could be fairly assumed that this would be the case, it had to be concluded that no novelty existed. Such was not the case in the matter under consideration, since there existed in the prior art a reasoned statement clearly dissuading the person skilled in the art from using the range under a certain value, and the range of overlaps was under this value; the claimed range was therefore considered novel.

In **T 447/92** the board held that the cited document did not disclose when or how far a movable piece in the claimed invention (an air circuit breaker) moved, or the way in which it worked to prevent the spring-back of a lever. No relative movement was described or shown in the drawings and it was a matter of conjecture as to the manner in which the relevant parts co-operated. The board found that it might have been obvious to a skilled person that the notch could co-operate with the shaft in the manner defined in the claims of the patent in suit, but that this only meant that the disclosure took him close enough to do the rest himself. It did not mean that the document took the skilled person all the way to the present invention. Thus, the features of the air circuit breaker according to claim 1 of the application were not unambiguously derivable from the drawings of an earlier European patent application.

In **T 310/88** the board of appeal had to consider a discrepancy between what actually happened in practice when carrying out a technical teaching in a prior document according to the letter of its description, and what this prior document said would happen. According to the description in the prior document a particular component was not present, whereas the presence of this component was essential for the later invention. However, in practice, when following the teaching of the prior document literally, this component would be present. The board held that the invention was novel over the prior document because the latter did not contain a sufficiently clear teaching for

that conclusion not to be reached. The skilled person, by following the document's teaching, was led in a direction clearly pointing him away from the claimed subject-matter, because it stated that the composition obtained did not comprise a component contained in the claimed compound. The subject-matter was new even if, by reproducing the examples described in the prior document, a skilled person would inevitably obtain a composition corresponding to the composition claimed and comprising the specific component. According to the board, the teaching of the prior document had to be interpreted as meaning that further steps would be needed to eliminate the additional component.

In **T 491/99**, the board held that an earlier patent, which used terminology which at first sight was suggestive of the product invention claimed, was not in fact a prejudicial disclosure if a skilled person could actually only make the product in question later, from the process and machine described for the first time in the European patent in suit.

3. Ascertaining differences

Once the state of the art has been established, using the criteria described above, and its content has been determined, the final step is to ascertain whether the invention in question differs from the prior art.

3.1. Comparing each individual item from the prior art

When the invention is compared for novelty purposes with the state of the art as determined by applying the criteria described above, this must be done only on the basis of each element of prior art taken as a whole (see **T 153/85**, OJ 1988, 1; **T 124/87**, OJ 1989, 491; **T 233/90**, **T 904/91**).

If, however, there is a specific reference in one prior document (the "primary document") to a second prior document, when construing the primary document (i.e. determining what it means to the skilled person) the presence of such a specific reference may necessitate part or all of the disclosure of the second document being considered as part of the disclosure of the primary document (see **T 153/85**, OJ 1988, 1; **T 645/91**, **T 942/91**, **T 422/92**, **T 866/93**, **T 866/93**, **T 239/94**).

In **T 291/85** (OJ 1988, 302) the board noted that the disclosure in a prior publication always included not only what it presented as the teaching of the invention but also what it referred to as the prior art. In the board's view, however, when examining for novelty, to read into an account of the state of the art couched in very general terms specific details of the inventive teaching of the same document was permissible only where a person skilled in the art would in fact have made this combination when reading this document. This would, for instance, be the case if a source were to be cited for the prior art described and a specific, relevant disclosure could be derived from the original document, or if the description of the prior art referred directly to the appropriate passage in the description of the invention. Combining a specific feature from the description with the general description of the prior art in this way might, in certain circumstances, be obvious to a skilled person merely in the light of his general technical knowledge. In the

absence of such or similar circumstances, however, one could not, in the board's view, assume that a skilled person would necessarily have derived from the document a teaching based on a combination of this kind. Thus, the board concluded that if a citation gave detailed information about a further development of a prior art described only in very general terms without quoting a specific source, it was not permissible in examining for novelty to combine these general statements with the specific statements made solely in order to explain the said development, unless a person skilled in the art would have made the combination when reading the citation.

In **T 288/90** the appellants contended that the alleged invention lacked novelty on the basis of a document (I), read either on its own or in association with a document (12) treated as being representative of the general technical knowledge of the skilled reader of document (I). The board regarded document (12) per se as fairly representative of the general technical knowledge available at the relevant time, as it was published only fifteen months before the application date of document (I). The board observed that, although for the purposes of assessing novelty it was not normally legitimate to read two documents together, nevertheless, when interpreting a single document, it was necessary to read it having the general technical knowledge in mind, and for this purpose to look at representative technical literature as an aid to the correct interpretation of any particular term of art encountered.

In decision **T 56/87** (OJ 1990, 188) the board emphasised that the technical disclosure in a document should be considered in its entirety, as it would be by a person skilled in the art, and that there could be no justification for arbitrarily isolating parts of the document in order to derive therefrom an item of technical information which would be distinct from or even contradict the integral teaching of the document. Therefore, the board considered that a particular feature relating to the positioning of the outer electrodes of a transmission ion chamber, in such a way that they partially lay in the shadow of a collimator, for implementing a process for correcting alignment errors of a divergent beam of rays, was not disclosed in a prior art document which, however, contained a figure in which such positioning could be identified. The reason was that the figure in question was obviously a schematic illustration showing neither the proportions nor the dimensions of the actual apparatus. In order to be able to interpret it correctly, the skilled technician therefore had to refer to the other figures and to the written description of the document; he would have deduced from the latter, however, that the outer electrodes should be positioned entirely in the radiation field, and not partially in the shadow of the collimators, as set out in the claims examined (see **T 332/87**, **T 441/91** and **T 657/92**).

In **T 31/01** the board held that if the wording of an independent claim, in keeping with the description, clearly indicated that the claimed measuring device was attached in a particular way to the part being measured, the technical features of the claim which defined the attachment method had to be duly taken into account when assessing the patentability of the claimed subject-matter with regard to the latest prior art.

3.2. Distinguishing features

In **T 4/83** (OJ 1983, 498) the board held that when assessing novelty, it should be taken into consideration that any information in a patent specification which conveyed to the person skilled in the art a technical teaching, belonged to the content of the disclosure irrespective of whether or not it fell within the scope of the claims or what purpose it served.

In **T 223/05** the board held that the interpretation of the extent of the protection of a patent was not the task of the EPO, but, according to Arts. 64 and 69 EPC 1973, that of the national courts competent in procedures on infringement cases (see **T 740/96**, **T 442/91**). In particular, Art. 69 EPC 1973 did not offer any basis for reading into a claim features which could be found in the description when judging novelty (see **T 1208/97**).

3.2.1 Difference in wording

In **T 114/86** (OJ 1987, 485) the board held that a mere difference in wording was insufficient to establish novelty (see **T 12/81**, OJ 1982, 296; **T 198/84**, OJ 1985, 209; **T 248/85**, OJ 1986, 261). In **T 565/90** the appellant submitted that only preferred ranges or examples amounted to a technical disclosure destructive of novelty, and that generic ones could not anticipate the more specific teaching of the patent in dispute. The board did not agree and confirmed earlier case law that the definition of an invention which differed from the prior art only in its wording was insufficient to establish novelty. The board stated that what had to be established was whether or not the state of the art made the subject-matter of the invention available to the skilled person in the form of a technical teaching.

In **T 917/94** the board stated that incorporation of a technical feature which is redundant because it does not change the claimed subject-matter does not impart novelty to known subject-matter.

In **T 826/94** the board was of the opinion that a claimed measuring device, which showed all the constructive features of a known measuring device and differed from the latter only in name, i.e. in the dimensions to be measured, was novel within the meaning of Art. 54 EPC 1973 if it was only at the level of abstract thought, when the basic principles of the two measuring devices were compared with each other, that the conclusion could be drawn that the two measuring instruments were of the same type.

In **T 870/95** it was decided that the **general term "base"** used in the citations destroyed the novelty of the more specific one, "permanganate in aqueous solution", if it were shown that, in the light of the skilled person's general technical knowledge, the former could only be understood to mean the latter.

In **T 79/96**, an extract from a handbook (D1) disclosed all the features of claim 1 of the patent in issue apart from the use of a "countercurrent gas/gravity classifier". Thus, with respect to novelty it only had to be decided whether a vibrating fluidized bed with an upwards gas flow through the bed of particles as described in D1 should be regarded as

a countercurrent gas/gravity classifier. The definition of a countercurrent gas/gravity classifier was given in an extract from another standard handbook on chemical technology (D3). The proprietor of the patent was of the opinion that the definition given in D3 was too broad and that a person skilled in the art would not consider a fluidized bed, being a rather inefficient classifier, as a countercurrent gas/gravity classifier.

The board did not share this view. It held that, when assessing novelty of the claimed subject-matter, an expression in a claim should be given its broadest technically sensible meaning. On that basis, any gas/gravity classifier, including a fluidized bed, satisfied the classification requirements of the claim 1 of the patent at issue. The subject-matter therefore lacked novelty over D1.

3.2.2 Differences in values

In **T 686/96** claim 1 related to a composition with a feature (iv) requiring a perspex[®] abrasion value (PAV) in the range from about 12 to about 20 PAV. A prior art document disclosed in example 2 a composition having features (i) to (iii) of claim 1. With respect to novelty it had to be decided whether the known composition also had an abrasion value as required by feature (iv) of claim 1. The board established that the abrasion value of the known composition was somewhat below the lower value indicated in feature (iv) of the claim. Since the lower limit in the claim 1 was defined as "about 12", some interpretation was necessary. The board held that, when deciding on the novelty of the subject-matter of a claim, the broadest technically meaningful interpretation of a claim should be taken into account. In the board's view the scope of claim 1 was to be construed to mean that the indicated lower limit corresponded to the value disclosed in the prior art. Claim 1 was then considered to lack novelty.

In **T 262/96**, regarding the issue of novelty, the appellant/opponent contended that the ZN40 material was commercially available before the priority date and that these products had the composition, microstructure and properties indicated in claim 1 of the patent in suit. The silica content of this sample of ZN40 material was lower than the lower limit of 0.05 wt% stated in claim 1 of the patent in suit. The appellant's argument that the difference between the said numerical values was only 0.007, and thus not significant, did not convince the board. As the silica content of this ZN40 material was itself relatively low, this difference represented in fact 16%. A difference of 16% in the silica content was sufficient to distinguish two products from each other if such low silica contents could be determined with sufficient accuracy by the method of measurement used. The appellant did not provide information about the standard deviation or the degree of accuracy of the method used. Instead, he argued at the oral proceedings that the value of 0.043. wt% was in fact lower than the actual value since the analysis was effected on the sintered body and such an analysis was more problematic than an analysis performed on the starting powder because of the additional components formed during sintering. In the board's view the fact that an analysis might be more difficult on the sintered product did not mean that the result of the analysis was necessarily too low. Furthermore, the appellant's affirmation that the silica content measured in the sintered body was lower than the actual value was not supported by evidence and was contested by the respondent. If it were to be assumed for the sake of argument that the value given

for ZN40 was too low, then the appellant would still have had to prove that the actual value lay within the claimed range of 0.05 to 0.5 wt%. Evidence to this effect was not provided by the appellant, although the burden of proof rested with him. In these circumstances, the board considered that, in the absence of evidence to the contrary, the silica content disclosed lay outside the claimed range and would not destroy the novelty of the claimed ceramic bodies.

In **T 74/98** the board found no reason to round up figures obtained by converting prior art values originally expressed in a different unit of measurement. It was evident that any rounding-up following the conversion of these figures into molar amounts would affect the definition of those compositions. The board noted that it was also evident that the true meaning of a specific disclosure could not be influenced by the units chosen to express it and that the objection of lack of novelty relied on an ambiguity introduced artificially by the appellant.

In **T 1186/05** the board drew a distinction between the case before it and the case before the board in **T 74/98**. In the latter case, the board had considered that rounding up to the next integer (thus matching the lower limit of the claimed "inventive" range) of a component's molar percentage having two decimal places, calculated by conversion from its weight proportion, was not justified because (i) this would lead to a broadening of the claimed range and (ii) reconversion of the rounded molar percentage to the corresponding weight proportion would also imply a modification of the latter, i.e. would alter the true meaning of this specific disclosure.

However, in the case before it, the board in **T 1186/05** held that rounding up was required, in order to enable two density values to be compared, each one reflecting a "true" density value having three (or more) decimal places, but expressed to a different degree of accuracy, i.e. one having three and the other one having only two decimal places. Thus, the rounding exercise put the claimed and the prior art density values on the same level by using the mathematical rule existing for that purpose. This exercise had no impact on the density value as disclosed in the prior art document. For the definition of the density range the respondent had chosen to use only two decimal places. This implied that a comparison with the prior art identifying three decimal places could only be made if the prior art values were also reduced to two decimals, that was to say rounded. The board noted that the skilled person reading D1 would thus be obliged to round the disclosed value up to 0.89 for comparison (see also decision **T 708/05** of 14 February 2007). The board could not accept the argument of the respondent (patentee) that the value 0.885 could also be rounded down to 0.88 and thus outside the claimed range. The mathematical conventions for rounding values wherein the last digit is 5 (or more) required that the value be increased, or rounded up, resulting in a value of 0.89 in the case at issue.

3.2.3 Difference in composition

In **T 80/96** (OJ 2000, 50), claim 3 of the main request read as follows: "Preparation containing L-carnitine in the form of tablets, capsules, powders or granules, in particular for external application, characterised in that it contains L-carnitine-L-tartrate with an

auxiliary substance or auxiliary substances and, possibly, one or more further active agents." An aqueous solution of the claimed tartrate compound was described in the prior art. The board held that, in the case of an active agent which was known as such to be water-soluble, it was clear to a person skilled in the art that describing and claiming the active agent as a solution did not add to or change the definition of that active agent. Without further specification, the mere characterisation of a solvent or diluent as liquid or solid in a claim did not change the assessment of the novelty of the subject-matter of the claim.

Analogously, in a claim directed to a preparation of a known structurally defined active agent with at least one auxiliary substance, in which the feature "with an auxiliary substance or auxiliary substances" meant that something was added to the active agent, the admixture of an unspecified auxiliary substance could not, in view of the unlimited number of substances which might enter into consideration, be deemed a substantive and distinctive addition to the active agent, unless this feature, which was necessary if novelty was to be acknowledged, was specified in such a way that a person skilled in the art could recognise what it was that should be added to the active agent. The claim was therefore not new.

3.2.4 Inevitably obtained products

In **T 270/97** the claimed product was considered by the opposition division and the respondent/opponent as anticipated by the agent produced and inevitably obtained by repeating examples 1 and 2 of a prior-art document.

The board however found that the method disclosed in the text of example 2 implied a way of acting not envisaged in the method according to the patent in suit. The parties' attempts to show that the particles obtained according to example 2 were, or were not, identical to the products of the patent in suit, produced highly contradictory results. Therefore the board could only conclude that depending on experimental conditions not disclosed in example 2 different products might be obtained. Thus the claimed product was not inevitably obtained by following the method of example 2. As to example 1, the board found that it did not disclose an essential feature of the method of making the product of the patent in suit. Under these circumstances, it was not tenable to argue that the product according to the patent in suit was the inevitable result of repeating example 1.

3.2.5 Functional features

In **T 500/89** it could only be seen from the disclosure considered in its entirety that the prior art document did not deprive the claimed invention of novelty, because the method constituting the closest prior art differed from the claimed method in one functional characteristic. The disputed patent related to a method for the production of photographic material by the simultaneous application of several layers of fluid photographic coating materials. Although the document cited in support of the opposition listed the numerical ranges for layer thickness, viscosity, coating speed, etc. used in the method claimed, the latter was nevertheless held to be new because the cited document

described the choice of these numerical ranges as leading to intermixing between two particular layers. The contested patent was to be assessed according to a different criterion because it described the application of the layers as being "substantially free from intermixing". The "intermixing" described as an objective in the citation was not merely a stated purpose not constituting one of the technical features of the method described, but a functional feature - a criterion, in effect - forming an essential element of the teaching set out in this publication.

3.2.6 Generic disclosure

In **T 651/91** the board cited with approval the Guidelines, confirming that a generic disclosure did not normally deprive any specific example falling within that disclosure of novelty. The board further added that a disclosure could be generic even where it only left open the choice between two alternatives. In **T 508/91** the board, citing the Guidelines, held that, on the other hand, the prior disclosure of the subset "vegetables" deprived the wider set "fruits and plants" of novelty.

In **T 427/00** the appellant (opponent) argued that E1 anticipated the patented process, because it offered a selection of specific manufacturing processes from amongst all those suitable, and the skilled person would seriously have considered that selection.

The board took the view that E1 left open how the elements involved were to be made. It was a "negative" disclosure which did not give enough information to disclose a certain range explicitly. The possible processes for manufacturing the channel and surface were not a "range" in the sense of a selection invention; they were undefined and unlimited in number, and could at best be summarised under a general heading such as "manufacturing processes".

Thus, the case involved the selection not of a specific range within a broad known one but of a specific process within a broader concept; but case law of the boards of appeal held that the disclosure of a general concept did not normally deprive specific examples covered by the concept of novelty.

In **T 452/05** appellant 1 took the view that the term "water permeable membrane" could only be understood by the skilled person in the light of his common general knowledge to mean filtering paper. The board did not agree with this view.

The board stated that, according to the well established jurisprudence of the boards of appeal, any prior art disclosure was novelty destroying if the claimed subject matter could be inferred directly and unequivocally from that disclosure, including features which for the skilled person were implicit in what was explicitly disclosed (see e.g. **T 511/92**). In this respect, the board concurred with the findings of **T 823/96** that "implicit" matter had to be a clear and unambiguous consequence of what was explicitly mentioned for the skilled person.

Further, the board stated that (i) to construe the meaning of terms in patent documents, the skilled person would not consider the terms in isolation from the remainder of the

document, i.e. only in their literal meaning; on the contrary, the terms were considered in the context of the contents of the document as a whole (see also **T 312/94**), and (ii) information allegedly forming part of the common general knowledge of the skilled person had to be proven, if contested. This was normally done by referring to text books or the like. A plurality of patent documents could also be suitable if they provide a consistent picture of common general knowledge in a particular field. The board noted that, in principle, a specific term was not anticipated by a generic term. Nevertheless, in **T 870/95** an exception was made if it were proven that, in the light of common general knowledge, the generic term could only be understood in the meaning of the more specific term. Since this was not the case, the board concluded that the generic term ("water permeable membrane") did not anticipate the specific term ("filtering paper").

3.2.7 Product claim with process features

In **T 815/93** and **T 141/93**, the claims comprised both product features and features for a process for manufacturing the product. In both cases, only the process features distinguished the invention from the prior art. Following the case law on the novelty of product-by-process claims, the board found that process features not previously described could establish the novelty of the claimed product only if they caused it to have different properties from the products previously described. Neither the patent proprietor in the first case nor the applicant in the second case could demonstrate this.

3.2.8 Distinguishing features which are non-technical or involve no technical features

Whereas novelty is not necessary to establish the technical character of an invention, the converse is not true as novelty and inventive step can only be established on the basis of the technical features of the invention. This is in line with the case law of the boards of appeal (**T 154/04**, OJ 2008, 46).

The Enlarged Board of Appeal held in decision **G 2/88** (OJ 1990, 93) that the claims of a European patent should clearly define the technical features of the subject invention and thus its technical subject-matter, in order that the protection conferred by the patent can be determined and a comparison can be made with the state of the art to ensure that the claimed invention is, inter alia, novel. A claimed invention lacks novelty unless it includes at least one essential technical feature which distinguishes it from the state of the art.

When deciding upon the novelty of a claim, a basic initial consideration is therefore to construe the claim in order to determine its technical features. If on its proper construction the claim contains no technical feature which reflects such new use, and the wording of the claim which refers to such new use is merely mental in nature and does not define a technical feature, then the claim contains no novel technical feature and is invalid under Art. 54(1) and (2) EPC 1973 (because the only technical features in the claim are known) (point 7 of the Reasons).

In **T 619/98** the board stated that according to well-established jurisprudence of the boards of appeal, a mix of (known) technical features and apparently non-technical features may still be patentable as long as the latter features contribute to an overall

technical effect. It need therefore be examined whether the features under consideration bring about a technical effect or whether they merely serve to present information, as Respondent I had argued. The board concluded that these features did not produce a technical effect of any kind. It followed that they were not "technical features" in the meaning of R. 29(1) EPC 1973 and, consequently, that they could not serve to distinguish the invention from the prior art.

In **T 959/98** the board held that, even if it was accepted that Claim 1 called for a calculation, the mental act remained the only feature not mentioned in document (1), which feature however was not a technical one. In the case at issue, the said mental act would not lead to subject-matter which differed from that disclosed in document (1). Therefore, under the circumstances of this case, this non-technical feature could not render the subject-matter of Claim 1 novel.

In **T 553/02** the board stated that instructions for use contained in a claim directed to a product comprising a composition of matter and which provided no technical contribution to the claimed product were not a technical feature of that product, did not limit in any way the scope of such a claim, and could not be considered in the evaluation of novelty.

In **T 154/04** (OJ 2008, 46) the board stated that it is legitimate to have a mix of technical and "non-technical" features appearing in a claim, in which the non-technical features may even form a dominating part of the claimed subject matter. Novelty and inventive step, however, can be based only on technical features, which thus have to be clearly defined in the claim. Non-technical features, to the extent that they do not interact with the technical subject matter of the claim for solving a technical problem, i.e. non-technical features "as such", do not provide a technical contribution to the prior art and are thus ignored in assessing novelty and inventive step.

In **T 234/03** the board noted the onus was on the appellant to produce adequate evidence that there was a significant difference as regards the physical properties between, on the one hand, the rotary letterpress and gravure printing inks and, on the other hand, the jet inks suitable for use in a continuous ink jet printing process. However, the appellant failed to prove that the indication of the intended use amounted to a technical feature of the claimed composition which distinguishes it from that of document (1). It followed that the indication of use was not to be considered in the evaluation of novelty (following **T 553/02**).

4. Chemical inventions and selection inventions

The state of the art often includes documents containing technical teachings described in general terms; these teachings in turn subsume a number of more specialised technical teachings. In assessing the novelty of subject-matter that can be subsumed under a general term in the state of the art, the question arises whether the general term makes the claimed matter fully or partially accessible to the public. In other words, it has to be established whether the general term used in the citation discloses the subject-matter defined by the special term in the claim. The prior-art disclosure needs to be identified particularly carefully in such cases. General terms of this kind occur particularly

frequently in the chemical literature, which is why the relevant case law usually relates to this field. There are two types of case here:

(a) assessing the novelty of chemical substances and groups of substances in respect of general formulae (Markush formulae) under which they fall (see below, Chapter I.C.4.1), and

(b) assessing the novelty of products or processes defined by parameter ranges as against known products or processes characterised by wider or overlapping parameter ranges (see below, Chapter I.C.4.2).

These types differ mainly in technical terms, but the same principles of patent law apply to both. For this reason, the boards of appeal have always been able to adopt the same approach to questions of this nature.

4.1. Novelty of chemical compounds and groups of compounds

T 12/81 (OJ 1982, 296), a decision of fundamental importance with regard to novelty in the field of chemistry, is referred to time and again in the case law of the boards of appeal. It states that the teaching of a cited document is not confined to the detailed information given in the examples of how the invention is carried out, but embraces any information in the claims and description enabling a person skilled in the art to carry out the invention. If a product cannot be defined by a sufficiently accurate **generic formula**, it is permissible to make the definition more precise by additional product parameters such as melting point, hydrophilic properties, NMR coupling constant or the method of preparation (product-by-process claims). From this it necessarily follows that patent documents using such definitions will be prejudicial to the novelty of later applications claiming the same substance defined in a different and perhaps more precise way. Decision **T 12/81** related to such a case. Summarising, the board stated that in the case of one of a number of chemical substances described by its structural formula in a prior publication, the particular stereo-specific configuration of the substance - though not explicitly mentioned - was disclosed in a manner which was prejudicial to novelty, if it proved to be the inevitable but undetected result of one of a number of processes adequately described in the prior publication by the indication of the **starting compound** and the **process**.

The applicant argued that the novelty of the claimed product was based on a selection. The starting substance was chosen from a list of 20 compounds and combined with one of the five alternative process variants. The board did not share this view, but used the opportunity to comment on this argument and develop **criteria for selection inventions** that have frequently been adopted in later decisions:

- A substance selection can come about if an unmentioned compound or group of compounds having a formula covered by the state of the art is found, in the absence of any information as to the starting substance or substances. The subject-matter in the case in question, however, did not involve a selection of that kind in an area which, although marked out by the state of the art, was nonetheless virgin territory.

- However, the disclosure by description in a cited document of the starting substance as well as the reaction process is always prejudicial to novelty because those data unalterably establish the end product.
- If, on the other hand, two classes of starting substances are required to prepare the end products, and examples of individual entities in each class are given in two lists of some length, then a substance resulting from the reaction of a specific pair from the two lists can nevertheless be regarded for patent purposes as a selection and hence as new.

The board held that a combination of starting substances and process variants, however, was quite a different matter from a combination of two starting substances, and thus not comparable. At its simplest, if the starting substances were regarded as fragments of the end product, then every conceivable combination of a given starting substance in the first list with any starting substance in a separate second list of additionally required starting substances involved a true substantive modification of the first starting substance, since in every combination it was supplemented by a different fragment of the second starting substance to become a different end product. Each end product was thus the result of two variable parameters.

However, combining a given starting substance from a list of such substances with one of the given methods of preparation did not result in a real substance alteration of the starting substance but only an "identical" alteration. In the case in question, for example, no matter which of the processes described in detail was used, the end product was always the particular starting substance's hydrogenation product, which differed from the starting substance itself only in that it contained two additional hydrogen atoms. The process parameter was thus - seen in terms of the end product - not a variable parameter that would result in an immense widening of the range of possibilities, so that precisely in this case the end product was not the result of two variable parameters.

4.1.1 Anticipation of certain compounds

a) Definition of a substance by its structural formula or other parameters

In **T 12/81** (OJ 1982, 296, see above) the board stated that it is permissible to make the definition of a chemical substance more precise by additional product parameters such as melting point, hydrophilic properties, NMR coupling constant or product-by-process claims if it cannot be defined by a sufficiently accurate **generic formula**. From this it necessarily follows that patent documents using such definitions will be prejudicial to the novelty of later applications claiming the same substance defined in a different and perhaps more precise way.

In **T 352/93** it was decided that a claim for an ionic compound (salt) that was defined only by structural parameters, i.e. the structural formulae of the cation and anion of the compound, was not novel over prior art disclosing an aqueous solution that contained a base corresponding to the cation and an acid corresponding to the anion.

In **T 767/95** the patent related to purified interleukin-1 having a specified molecular weight, a specified pI and a specified amino acid sequence. The appellant/opponent could not show that the substance disclosed in prior art document (1) and the claimed interleukin-1 were the same protein. The board stated (a) that there were differences as to the molecular weight, (b) that a comparison between the pI's of the substance described in document (1) and the claimed substance was not possible under the given circumstances, and (c) that document (1) suggested a mixture of proteins. The semipurified nature of the preparation of document (1) was confirmed by statements in the scientific literature. There was thus a blockage preventing the skilled person from sequencing the material of document (1). Regardless of whether it arose from the semipurified nature of these preparations or from the process yielding only traces of the protein, this blockage prevented the teaching of document (1) from making available to the public a protein having the amino acid sequence specified in the patent in suit. In conclusion, since there was no evidence before the board that the material of document (1) exhibited the features of claim 1 of the patent in suit, this document did not affect the novelty of the purified interleukin-1.

b) Selection of starting substances from different lists

In **T 401/94** the board again adopted one of the criteria for selection inventions laid down in decision **T 12/81** (OJ 1982, 296), namely, that if two classes of starting substances were required to prepare the end products, and examples of individual entities in each class were given in two lists of some length, the substance resulting from the reaction of a specific pair from the two lists could be regarded for patent purposes as a selection and, hence, as new. The board applied the above criterion to the case in question and stated that, although **T 12/81** concerned the synthesis of a chemical product, and the case in question involved the preparation of a **mixture**, the claimed subject-matter was defined on the basis of two chemical entities, each of which had been selected from a list of compounds. Hence the criteria defined in **T 12/81** were applicable here too. By analogy, the board held that, in this case, the claimed composition had to be viewed as a selection, and therefore as novel, as it corresponded to a specific combination of constituents, each of which had been selected from a relatively long list. The board therefore concluded that there had been no implicit disclosure of the mixture of these constituents.

In **T 427/86**, the prior document described a process of synthesis characterised on the one hand by the starting substances and on the other by the catalytic system comprising the metal constituent and the catalytic promoter; taking into account the number of alternatives in the list of metal constituents and the list of promoters in this document, it could contain 36 different catalytic systems. The claimed invention sought to improve the operation of the catalytic system. It involved the selection of a very small number of alternatives (one and two respectively) from the list of metal constituents and list of promoters according to the prior document, the combination of which was not mentioned anywhere in the latter. The board was of the opinion that a substance resulting from the reaction of a specific pair from the two long lists was for patent purposes a selection and could be regarded as new because this specific combination chosen from the wide range of possibilities had not been disclosed by the citation. The board, furthermore, added

that, in view of the earlier decision **T 198/84**, an objective reading of the prior art document suggested constituents of the catalytic system different from the claimed ones. Therefore, the claimed components were not implicitly disclosed. The board concluded that the condition of novelty had been satisfied.

In **T 366/96** the patent related to a detergent composition comprising a peroxidase, hydrogen peroxide, and a surfactant. Prior art document (12) disclosed a detergent composition comprising surfactants, enzymes and a bleaching agent. In the list of suitable enzymes, peroxidases were mentioned. The list of suitable bleaching agents comprised, inter alia, inorganic peroxide.

The board found that document (12) taught a detergent composition comprising a peroxidase and a bleaching agent. As was generally known in the art, peroxidases acted on hydrogen peroxide as a substrate. This implied that, if the presence of peroxidases was specified, there would also be the simultaneous presence of hydrogen peroxide. In other words, even if one were to accept for the sake of argument that in document (12) the peroxidase on the one hand was enumerated in one list (i.e. that of the enzymes) and the hydrogen peroxide was mentioned in another list (i.e. that of the bleaching agents), to arrive at the compositions of the patent in suit would not require a "twofold" selection from two lists which could render the resulting combination of features novel. On the contrary, as soon as a person skilled in the art contemplated a detergent composition containing peroxidase, he or she must also contemplate the hydrogen peroxide precursors also disclosed in document (12) in order to ensure the supply of the necessary peroxidase substrate hydrogen peroxide. This was not comparable to a "twofold" selection which could render a resulting combination novel if compelling technical necessities made a particular second component mandatory as soon as the first component was chosen.

c) Selection on the basis of a general formula

Prior-art disclosure is also of key importance here. In **T 181/82** (OJ 1984, 401) the board confirmed that the products of processes which were the inevitable result of a prior description of the starting materials and the process applied thereto formed part of the state of the art. This was true even if one of the two reactants manifested itself as a chemical entity (C_1 alkyl bromide) from a group of generically defined compounds (C_1 - C_4 alkyl bromides). The board took the view that the description of the reaction of a certain starting material with C_1 to C_4 alkyl bromides disclosed only the C_1 -substituted product, and was not prepared to recognise the disclosure of a particular butyl substituent on the grounds that four isomeric butyl radicals existed.

In **T 7/86** (OJ 1988, 381) the board also based its reasoning on **T 12/81** (OJ 1982, 296), stating that the principle that a substance resulting from the reaction of a specific pair from two lists could nevertheless be regarded as new, was applicable not only to starting substances in chemical reactions but also to polysubstituted chemical substances where the individual substituents had to be selected from two or more lists of some length, such as in the case in question.

Following on from **T 181/82** (OJ 1984, 401) it was stated in **T 7/86** that if a class of chemical compounds precisely defined only in structural terms (by a chemical reaction), and with only one generically defined substituent, did not represent a prior disclosure of all the theoretical compounds encompassed by an arbitrary choice of a substituent definition, this clearly also had to be the case for a group of chemical substances, the general formula of which had two variable groups. Therefore, a class of chemical compounds defined only by a general structural formula having at least two variable groups did not specifically disclose each of the individual compounds which would result from the combination of all possible variants within such groups.

In **T 258/91** the case concerned a selection from two lists of starting compounds. The compound (formula VI) cited as taking away novelty from the patent in suit differed from the claimed compound (formula I) by the methyl residue on the amino group in the 4-position. In the board's judgment, the information in the cited document was not sufficient to disclose the compound of formula I to the skilled person in the form of a concrete, reproducible technical teaching. The board found that the cited document did not contain any teaching involving the modification of the compound, which was mentioned only by way of example. What was being taught was merely the preparation of a class of compounds and not of a specific, individual compound.

In **T 658/91** the board held that the case law did not suggest that a chemical compound was deemed to be specifically disclosed only if that compound was mentioned by name or even described in an example. On the contrary, it was sufficient if the compound could be unambiguously identified as envisaged in individualised form in the document in question, since the purpose of Art. 54(2) EPC 1973 was to exclude the state of the art from patentability.

4.1.2 Novelty of groups of substances

The case law on the novelty of generically defined compounds and particular examples of these was summarised in decision **T 12/90**. The board had to consider the novelty of a vast family of chemical compounds defined by a general structural formula, where the prior art also disclosed a vast family likewise defined by a general structural formula, the two families having a large number of products in common.

The board pointed out that a distinction had to be drawn between two situations:

(a) If the subject-matter of the invention was a particular compound, whereas the prior art disclosed a family of compounds defined by a general structural formula including this particular compound but not describing it explicitly, the invention had to be considered novel (see **T 7/86**, **T 85/87**, **T 133/92**).

(b) If, with the same prior art, the subject-matter of the invention was a second family of compounds partially covering the first, the invention was not new (see **T 124/87**).

As regards case (a) the board said: "That case is not comparable with the present one in which a distinction must be drawn between the novelty of a group of substances defined

by a general formula and a second group of substances partially covering the first and defined by another general formula, because the **concept of individualisation** naturally only applies to the structural definition of a single compound, not a collection of compounds".

Case (b) was extensively discussed in **T 124/87** (OJ 1989, 491). This decision dealt with the problem of assessing the novelty of a class of compounds defined by parameters within numerical ranges. The patent in suit claimed a class of compounds defined by parameters within numerical ranges while the prior document disclosed a process by which a class of compounds could be prepared - comprising those claimed in the patent in suit - having the combination of parameters required by the main claim of the latter.

In that particular case, the example specifically described in the prior document did not disclose the preparation of any particular compounds within the class defined in the claims of the disputed patent. However, it had been accepted by the patentee that a skilled man would have no difficulty in preparing such compounds within the class defined by the claims of the disputed patent using the process described in the said prior document, in combination with his common general knowledge, so that the disclosure of the prior document had to be regarded as not only limited to the particular compounds whose preparation was described in the examples, but also as comprising the general class of compounds made available to the skilled man in that technical teaching, even though only certain compounds within this class were described as having been prepared. Since the compounds as defined in the claims of the disputed patent formed a major part of this general class, they formed part of the state of the art and therefore lacked novelty.

In **T 133/92** the question to be answered in examining novelty was whether the selection of the alkyl group as defined in claim 1 of the disputed patent had been made available to the public within the meaning of Art. 54 EPC 1973 with regard to the disclosure of a prior document. By citing **T 666/89** (OJ 1993, 495), the respondents (patent proprietors) contended that the legally correct approach for deciding selection novelty was identical or very similar to that employed in determining obviousness. In particular, they argued that in cases of overlapping ranges of compounds, a claim to a narrower range as compared with a broader prior art range was always selectively novel if it could be demonstrated that the narrow range was inventive over the broader range. However, the board observed that in the case cited the board had repeatedly emphasised that selection novelty was not different from any other type of novelty under Articles 52 and 54 EPC 1973, so that the proper approach was to consider availability in the light of a particular document. Thus the board found that a claimed group of compounds, essentially resulting from omitting those parts of a larger group of compounds which a skilled person would have immediately considered as being less interesting than the rest, could not be selectively novel. In addition, in the board's opinion, a skilled person would, having regard to these considerations, have seriously contemplated applying the technical teaching of this prior art document in the range of overlap.

4.1.3 Novelty of enantiomers

According to decision **T 296/87** (OJ 1990, 195), the description of racemates did not anticipate the novelty of the spatial configurations contained in them; racemates were described in the state of the art by means of expert interpretation of the structural formulae and scientific terms; as a result of the asymmetric carbon atom contained in the formula the substances concerned might occur in a plurality of conceivable spatial configurations (D and L enantiomers), but the latter were not by themselves revealed thereby in an individualised form. That methods exist to separate the racemate into enantiomers was something that should only be considered with respect to inventive step.

In **T 1048/92** the board observed that the fact that the disclosure of the prior document did not embrace more than two possible steric configurations did not take away the novelty of the specific one which was claimed in the application, because there was no unambiguous technical teaching directed to that configuration. The novelty of such an individual chemical configuration could only be denied if there was an unambiguous disclosure of this very configuration in the form of a technical teaching. It was thus not sufficient that the configuration in question belonged conceptually to a disclosed class of possible configurations without any pointer to the individual member.

In **T 1046/97** the claim was directed to a specific pure enantiomer. The examining division found that prior art document (B) disclosed a compound of the same formula as the one claimed by the applicant but without giving any information on its stereochemical configuration. However, in document (B) it was also stated that "all optically active forms of the compounds described therein were enclosed in the teaching thereof." Since it belonged to the skilled person's general knowledge to identify such mixtures and to separate them, in the examining division's view the claimed enantiomer was not novel.

The board saw no reason to believe that a skilled person would not combine the disclosure of that compound with the reference to the racemic, meso and optically-active forms. However, it was established case law of the boards of appeal that the novelty of an individual chemical compound could only be denied if there was a direct and unambiguous prior disclosure of this very compound in the form of a technical teaching (see **T 181/82**, OJ 1984, 401; **T 296/87**, OJ 1990, 195). It was thus not sufficient to show lack of novelty, that the claimed enantiomer belonged conceptually to the group of possible optically-active forms mentioned in document (B), unless there was a pointer to the individual member of the group at stake. Thus, the claimed specific enantiomer being incontestably neither a racemate nor a meso form, the assessment of novelty crystallised on the question, whether it was directly and unambiguously derivable from the disclosure of the compound when combined with the reference to the optically active forms.

The board held that the term "optically-active forms" was to be interpreted as embracing any stereochemical form of the compounds disclosed in document (B), independently of whether such property was obtained by a pure stereochemical isomer or by any mixture of such isomers. Since document (B) provided no information about any specific stereochemical form this disclosure must be regarded as undifferentiated, with the effect

that the reference to "all optically active forms of the compounds described therein" could not be equated to an individualised disclosure of a specific enantiomer. The board thus held that the specific configuration of the claimed enantiomer was not directly and unambiguously derivable from the teaching of document (B) and that novelty had not been destroyed.

4.1.4 Achieving a higher degree of purity

In **T 990/96** (OJ 1998, 489), it had to be examined whether the feature in dispute, which in fact represented a **specific degree of chemical purity** (in particular diastereomeric purity), constituted a "new element" imparting novelty to the claimed subject-matter.

The board stated that it was common general knowledge that any chemical compound obtained by a chemical reaction would normally contain impurities for various reasons and that it was not possible for thermodynamical reasons to obtain a compound which was - in the strict sense - completely pure, i.e. totally free of any impurity. It was, therefore, common practice for a person skilled in the art of preparative organic chemistry to (further) purify a compound obtained in a particular chemical manufacturing process according to the prevailing needs and requirements. Conventional methods for the purification of low molecular organic reaction products, which could normally be successfully applied in purification steps, were within common general knowledge. It followed that, in general, a document disclosing a low molecular chemical compound and its manufacture made this compound available to the public within the meaning of Art. 54 EPC 1973 in **all grades of purity** as desired by a person skilled in the art.

Exceptional situations might exist which could justify a different conclusion. For example, there could be a situation where it was proved on the balance of probability that all prior attempts to achieve a particular degree of purity by conventional purification processes had failed.

In **T 728/98** (OJ 2001, 319), the applicant (appellant) argued that the situation was such an exceptional one as mentioned in **T 990/96**. The claimed pharmaceutical composition differed from the state of the art because the particularly high purity level of the compound it contained could not be achieved by conventional methods.

The board found, however, that the applicant, who bore the burden of proving this allegation, had not provided the necessary evidence. In fact, the prior-art teaching yielded significant, even if small, quantities of the substantially pure compound using conventional purification methods. The general rule therefore applied that achieving a particularly high level of purity of a known compound was not a feature to be regarded as imparting novelty to such a product over the prior art.

In **T 786/00** the arguments submitted by the respondent (opponent) with respect to **T 990/96** (OJ 1998, 489) were not convincing, since that decision could not be applied to the present case. In contrast to **T 990/96**, the present case related to a process for the manufacture of polymers having specific properties (i.e. resistance to boiling water), characterised by the use of organic compounds having a required purity as starting

components. In other words, the purity level of the starting components was an essential technical feature of the process, which could only be carried out in the required range of purity but not in all available grades of purity of the starting materials. In the board's view, there was a fundamental difference between the purity requirements presumed to exist for the isolation of a final product, and those for the starting materials used in a preparative process. By contrast, in **T 990/96**, the concern surrounding the starting materials was the precise opposite, in that it involved a mixture of stereo isomers which could be separated by fractional crystallisation so that the product resolved into two optically pure enantiomers with the aim of achieving an ultimate degree of purity. In that connection, the concern of the skilled person had to be presumed to be to use the most impure starting materials possible, consistent with the aim of obtaining a sufficient yield of product, which itself could be further purified. Consequently, the general statements in **T 990/96** concerning the purity of the final products could not be applied directly to starting materials or, hence, to the present case.

In **T 112/00** the board considered a composition including a solvent having a purity greater than 99% to be new over a prior art composition containing such a solvent whose purity was not specified. The board stated that the claimed composition could be considered as a final product and the solvent as the starting material. As in **T 786/00**, novelty would be established by the defined purity of the starting material.

The issue in **T 803/01** was the novelty of a pharmaceutical composition which differed from prior-art compositions only in the degree of purity of one of its components. In the board's view each and every purification method, provided it was "conventional" but regardless of the extent of purification sought, was presumed to be automatically available to the public, and that in a fully enabling way, so as to amount to an effective novelty-destroying disclosure. As stated in **T 100/00** in this respect, the term "conventional" could only mean "conventional in view of the concrete technical context concerned". Therefore the question of whether the degree of purity for the polylactide required in claim 1 provided a new element over the prior art had to be assessed in the concrete technical context concerned.

The board concluded in this case that the methods of purification described in document D2 - which had to be regarded as the relevant "conventional purification processes" in the concrete technical context concerned - would not succeed in providing the required degree of purity. Nor was there any ground for concluding that other "conventional" methods of purification would be capable of delivering the required degree of purity either. The board thus decided that there was a new element in the feature of a defined level of purity as set out in claim 1.

In **T 142/06** the board noted that it followed from the considerations made in decision **T 990/96**, according to which a document disclosing a low molecular compound and its manufacture normally makes this compound allowable in all desired grades of purity, that the purity level of an organic compound is as such not an essential feature for the definition of this organic compound. However, in the case at issue it was evident that the content of chlorine ion of the claimed latex was an essential feature of the claimed latex, since, according to the patent in suit, only the latexes having this low level of chlorine

ions enabled the production of films having the desired properties in terms of oxygen barrier properties and boil blushing properties. This implied that the claimed degree of purity in terms of chlorine ion content could not be considered as an arbitrary degree of purity but that it amounted to a purposive selection. Thus, for this reason the considerations made in decision **T 990/96** and, by way of implication, in decision **T 803/01**, did not apply to the case before the board. Furthermore, it also followed from the considerations made in decision **T 990/96**, that, before examining whether or not conventional purification processes described in the prior art would succeed in providing the required degree of purity, it should, in the board's view, first be checked whether the desirability of obtaining the claimed grade of purity existed in the relevant prior art (see also **T 100/00** of 7 March 2003). The board was unable to discern the desirability of reducing the amount of chlorine ion to a very low content in the prior art documents. Thus, the board could only conclude that the inventor had really provided the public with something new, or, in other words, that there was a new element (i.e. chlorine ion content not greater than 500 ppm) in claim 1 which imparted novelty over the prior art.

4.2. Selection of parameter ranges

4.2.1 Selection from a broad range

The principles applied by the boards of appeal as part of their established case law on the novelty of selection inventions were developed in particular in **T 198/84** (OJ 1985, 209). They are summarised briefly in **T 279/89**, according to which a selection of a sub-range of numerical values from a broader range is new when each of the following criteria is satisfied:

- (a) the selected sub-range should be narrow;
- (b) the selected sub-range should be sufficiently far removed from the known range illustrated by means of examples;
- (c) the selected area should not provide an arbitrary specimen from the prior art, i.e. not a mere embodiment of the prior description, but another invention (purposive selection).

The three postulates for the novelty of a selected sub-range are based on the premise that novelty is an absolute concept. It is therefore not sufficient merely for the wording of the definition of an invention to be different. What has to be established in the examination as to novelty is whether the state of the art is such as to make the **subject-matter** of the invention available to the skilled person in a technical teaching (**T 198/84**, OJ 1985, 209; see also **T 12/81**, OJ 1982, 296; **T 181/82**, OJ 1984, 401; **T 17/85**, OJ 1986, 406).

With reference to the third criterion, the board in **T 198/84** was of the opinion that this view of novelty really entailed more than just a formal delimitation vis-à-vis the state of the art. There would be delimitation only in respect of the wording of the definition of the invention, but not in respect of its content, if the selection were arbitrary, i.e. if the selected range only had the same properties and capabilities as the whole range, so that

what had been selected was only an arbitrary specimen from the prior art. This was not the case if the effect of the selection, e.g. a substantial improvement in yield, occurred in all probability only within the selected range, but not over the whole known range (purposive selection).

To prevent misunderstanding, the board emphasised, following **T 12/81** (OJ 1982, 296), that a sub-range singled out of a larger range was new not by virtue of a newly discovered effect occurring within it, but had to be new per se. An effect of this kind was not therefore a prerequisite for novelty; in view of the technical disparity, however, it permitted the inference that what was involved was not an arbitrarily chosen specimen from the prior art, i.e. not a mere embodiment of the prior description, but another invention (purposive selection).

In **T 17/85** (OJ 1986, 406) the novelty of the claimed range was denied because the preferred numerical range in a citation in part anticipated the range claimed in the application. A claimed range could not be regarded as novel, at least in cases where the values in the examples given in the citation lay just outside the claimed range and taught the skilled person that it was possible to use the whole of this range.

In deciding the question of the novelty of an invention, the board in **T 247/91** emphasised that consideration had to be given not only to the examples but also to whether the disclosure of a prior art document as a whole was such as to make available to the skilled person as a technical teaching the subject-matter for which protection was sought. The board stated that it was accepted by the appellant (patent proprietor) that a skilled reader of the cited document had no reason to exclude the range of 85 to 115°C claimed in the patent in suit when carrying out the invention disclosed in the citation. The teaching of the cited document was clearly not limited to the use of the exemplified temperatures, but extended to the whole described temperature range of 80 to 170°C which had been made available to the skilled person as a technical teaching. The subject-matter of the patent in suit lacked novelty.

In **T 406/94** the board found that the percentage range cited in the prior art, although numerically close to the claimed range, could not be adduced to anticipate the subject-matter claimed, because the percentage cited in the prior art was based on different starting materials.

In **T 209/94**, although the temperature ranges of pyrolysing steps to be carried out for preparing fibres overlapped ("greater than about 1600°C" according to the invention and "from 900 to 1800" according to the prior art document), the functional limitation of the pyrolysing step established by the statement introduced into claims 1 and 2 of the application at issue - "for a period of time sufficient to reduce oxygen and/or nitrogen content of the fibres to below about 0.5% by weight" - distinguished the claimed process from the process according to the prior art document. Indeed, the board concluded from the latter document that the presence of nitrogen (and boron) in the fibres in certain amounts was essential for their temperature stability. Since this improved thermal stability of the fibres was the very object of the invention disclosed in the prior art, fibres which would not have met this requirement could not have been considered to be within

the teaching of this document. This meant, by implication, that fibres having a nitrogen and/or oxygen content which was too low to produce the desired thermal stability were not within the scope of the invention disclosed in the prior art: the lowest value disclosed in the prior art document was 3.89%, whereas according to the application at issue the maximum amount permitted was 0.5%.

In **T 610/96** the patentee (respondent) claimed a magnetoresistive material comprising magnetic and non-magnetic metallic thin film layers. The board found that the claimed ranges defining the composition of these layers must be considered as a narrow selection of the generic disclosure of prior art document D10, which did not overlap with the sub-ranges preferred in D10 and which further selected a specific non-magnetic layer among a group of possible layers. This selection was also sufficiently far removed from the specific examples of D10. Furthermore, the claimed material showed different characteristics of the magnetoresistance change, so that the specific sub-range was not simply an arbitrary part of the generic disclosure of D10, but was of a different nature and therefore novel. The criteria for selection inventions set out in **T 279/89** were thus satisfied. Moreover, since a passage of D10 might be seen as a statement dissuading the skilled person from applying the concept of D10 in the sub-range of the contested patent, the person skilled in the art would not seriously contemplate applying the teaching of D10 in this range (see **T 26/85**, OJ 1990, 22).

4.2.2 Overlapping ranges

In decision **T 666/89** (OJ 1993, 495) the board gave a ruling on novelty assessment in cases of overlapping numerical ranges. The patent related in particular to a shampoo comprising 8-25% anionic surfactant and 0.001-0.1% cationic polymer. In an earlier patent application a shampoo composition had been disclosed containing 5-25% anionic surfactant and 0.1-5.0% cationic polymer.

The board held that the composition was not new. In the board's view, there was no fundamental difference between examining novelty in situations of so-called "overlap" or "selection", and in doing so in other situations, although it might be helpful, in order to verify a preliminary conclusion of a novelty examination in cases of overlap, to investigate whether or not a particular technical effect was associated with the narrow range in question. It needed to be stressed, however, that such a particular effect was neither a prerequisite for novelty nor could it as such confer novelty; its existence could merely serve to confirm a finding of novelty already achieved. The term "available" in Art. 54(2) EPC 1973 clearly went beyond literal or diagrammatical description, and implied the communication, express or implicit, of technical information by other means as well. Thus it was clear that matter that was hidden, not in the sense of being deliberately concealed but rather in the sense of being reconditely submerged in a document, would not have been "made available" in the above sense. In the case of overlapping ranges of physical parameters between a claim and a prior art disclosure, what would often help to determine what was "hidden" as opposed to what had been made available was whether or not a skilled person would find it difficult to carry out the prior art teaching in the range of overlap. A similar approach was to consider whether a person skilled in the art would, in the light of all the technical facts at his disposal,

"seriously contemplate" applying the technical teaching of the prior art document in the range of overlap.

Realising that the concept of "seriously contemplating" moving from a broad to a narrow (overlapping) range seemed akin to one of the concepts used by the boards for assessing inventive step, namely, whether the notional addressee "would have tried, with reasonable expectation of success", to bridge the technical gap between a particular piece of prior art and a claim whose inventiveness was in question, the board added that its novelty concept was fundamentally different from this "inventive-step concept" because, in order to establish anticipation, there could not be a gap of the above kind. Novelty was carefully analysed on the basis of comparable considerations in **T 366/90** and **T 565/90**.

Decision **T 26/85** (OJ 1990, 22) suggested, as a specific test for determining whether a technical teaching had been made available to the public, posing the question whether the person skilled in the art would in the light of the technical facts **seriously contemplate** applying the technical teaching of the prior art document in the range of overlap. If it could be fairly assumed that he would do so, it had to be concluded that no novelty existed. This formulation of the question was adopted inter alia in **T 279/89**, **T 666/89**, **T 255/91** (OJ 1993, 318), **T 369/91** of 7.10.1992, **T 631/92** and **T 660/93**.

In **T 751/94** the board regarded it as clear that the method according to the cited document was not to be carried out in the overlapping range, and consequently the overlap did not deprive the claimed invention of novelty. In addition, the combination of parameters in the claimed invention was not disclosed in, and was not clearly derivable from, the cited document.

In **T 240/95** the appellant had argued that 0.5 to 60 minutes would not include 60 minutes as such inclusion would have to be worded "0.5 up to and including 60 minutes." The board held that, in accordance with established case law, disclosure of a range was considered to be an explicit disclosure of the end values.

In **T 594/01** the main request and the first auxiliary request claimed processes for the preparation of ethylene glycols whereby the processes were to be performed with less than 0.1 wt% of carbon dioxide in the reaction mixture. The board had to decide whether there was an overlap between that carbon dioxide range and the carbon dioxide value of 0.1 wt% disclosed in example No. 4 of a document which described a method of preparation of ethylene glycol ("document 1").

The board stated that it was common general knowledge that every experimental measurement in quantitative analytical chemistry as well as any result of any physical measurement could not be dissociated from the margin of uncertainty attached to the measurement. Normally, the uncertainty of a measured experimental value was irrelevant for the assessment of novelty. However, when a specific experimental value was disclosed in an example of prior art, seeking to distinguish the claimed subject-matter therefrom only in terms of an upper limit to be required to be "lower than" the experimental value must fail, as the claimed subject matter is still not distinguishable

from the prior art within the margin of experimental error. Therefore, the carbon dioxide range defined in the main and first auxiliary requests, namely "lower than 0.1 wt%", did not distinguish it from the experimental carbon dioxide concentration of 0.1 wt% disclosed in example No. 4 of document (1) (see also **T 708/05**).

The board applied the same reasoning to the second and third auxiliary requests which claimed processes for the preparation of alkylene glycols, whereby the processes were to be performed with less than 0.01 wt% of carbon dioxide in the reaction mixture. Example No. 2 of document (1) disclosed a method of preparation of propylene glycol which involved 0.01 wt% of carbon dioxide in the reaction mixture. The claims failed for lack of novelty.

4.2.3 Multiple selection

In **T 245/91** the appellants (patent proprietors) contested the respondent's lack of novelty objection in the light of the disclosure in a prior document. They contended that the subject-matter of claim 1 amounted to the purposeful selection of a small area from the very broad disclosure in the said document. The board observed that most of the ranges in claim 1 of the patent in suit could be obtained by narrowing down the ranges according to the cited document by approximately 25 to 80% and restricting them to their central portion, and that in a situation like this, where several ranges of parameters were to be considered, a careful comparison had to be carried out in order to assess whether or not the subject-matter of the claimed invention was available to the skilled person. Any obviousness considerations were to be strictly avoided. Referring to **T 666/89** (OJ 1993, 495), the board emphasised that, under the Convention, novelty had to be decided by reference to the total information content of a cited prior art document. In the board's judgment, the combination of the relevant features would not have been seriously contemplated by the skilled reader and was not made available to him, because the said features were not prominent in the cited document and did not therefore lend themselves to an unambiguous, implicit disclosure. A further point to consider was the number of parameters used to define the claimed subject-matter, since each of the ethylene polymers was characterised by several parameters. The board held that, even if most of the ranges for these parameters corresponded to a more or less central portion of the range which limited the corresponding parameter in the composition according to the cited document, as a result of the number of parameters involved, which exceeded ten, the scope of the claimed blends was in reality quite narrow with regard to the breadth of the definition of the known composition. This was also the reason why the argument that there had been an implicit description of this narrow selection in the prior document was not accepted.

In case **T 653/93**, the appellant (applicant), whose application had been refused by the examining division, argued that the process of claim 1 was novel as it referred to a combination of three process features with selected ranges and product features with specific limits, a combination not disclosed in the prior art document.

The board of appeal emphasised that in such situations the question of novelty could not be answered by contemplating the ranges of the various parameters separately. This

would, in the board's judgment, be an artificial and unjustified approach, since it was not the specified ranges of the three parameters or their agglomeration that formed the subject-matter of claim 1, but the group of processes defined by the combination of these ranges, which was rather small when compared with the group of processes disclosed in the prior art document.

Thus the claimed group of processes, characterised by the combination of three specific process parameters, was not explicitly disclosed in the prior art document and therefore could be said to result from a "multiple (i.e. threefold) selection". The person skilled in the art, when applying the teaching of the prior art document, would not have had any reason to concentrate on the combination of the sub-ranges as defined in claim 1, e.g. because the omitted parts of the ranges disclosed in the prior art document could be recognised as of lesser interest. Since there was no indication to this effect, the "combined selection" did not emerge from the prior art document as being implicitly disclosed for the skilled person.

The novelty of the technical teaching of claim 1 was corroborated by experimental evidence showing that the products resulting from the claimed processes could not have been obtained by processes which were close to but nevertheless outside the range of the processes claimed. Moreover, the combination of properties of the products obtained by the claimed processes was not the inevitable result of the process disclosed in the prior art document but was obtained only by a particular combination of process parameters. It followed that the subject-matter of claim 1 was not considered as having been disclosed in the prior art document.

In **T 65/96**, there was no mention in prior art document D2 of a rubber-reinforced copolymer having the combined features forming the solution of the technical problem addressed in the opposed patent. The board pointed out that the argument of the appellant (opponent) that all the relevant parameters had been mentioned "within a few lines" was irrelevant, because the location within the document of a disclosure did not in itself suffice to show the true contextual relationship of the parameters, let alone establish that they were disclosed in combination, as required by the solution of the technical problem. In any case, one of the parameters was referred to in a quite separate section of the disclosure.

Furthermore, closer examination of D2 showed that the parameters relating to the amount of rubber and the particle size of rubber, were merely disclosed as independent ranges without any indication as to how, or indeed whether, they might vary in relation to one another. Whilst it was conceded by the respondent at the oral proceedings that D2 disclosed ranges partly overlapping with those defined in the solution of the technical problem, the latter required the simultaneous fulfilment of three values of the same parameters.

The board came to the conclusion that the claimed solution was not arbitrary since it solved a specific technical problem compared with the products according to D2. Hence, the claimed solution, to the extent that it overlapped at all with the general disclosure of

D2, represented a narrow selection therefrom and fulfilled all the requirements of a true selection (see **T 198/84**, OJ 1985, 209).

4.3. Subject-matter group

T 763/89 considered the issues raised by making a selection from a generically defined group of multilayer materials. The patent related to a reversal colour photographic material comprising three layers having differing colour sensitivity, each layer comprising a further three layers having the same colour sensitivity but differing photographic sensitivity. The closest prior art consisted of a reversal material with "at least two" layers. The opponent had argued that the multilayer materials disclosed by this prior art also included the three-layer material claimed, therefore causing lack of novelty. The board, however, held that it was new: although "at least two" was synonymous with a multilayer material and set the lower limit in the form of a double-layer material (the description related to any multilayer material without specifying an upper limit for the number of possible layers), the only theoretical examples given for such multilayer materials were double-layer materials. Nor did the documents cited in support of the opposition as much as hint at a three-layer material. It might appear logical for a three-layer material to form part of the group of multilayer materials in the cited documents, but this did not mean that it was thereby disclosed. On the contrary, it was a new material forming part of this group and selected from it.

The board handed down this ruling in the context of previous case law on selection inventions involving chemical substances. This had provided that a technical teaching was prejudicial to novelty if it disclosed a substance in individualised form, i.e. one clearly distinguishable from structurally similar substances. This principle for assessing the novelty of individuals as distinct from a group could be applied to things such as the photographic material in question, which was clearly distinguishable from other things forming part of the same generically described group.

5. Novelty of use

5.1. First medical use

5.1.1 Introduction

Under Art. 53(c) EPC methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body ("medical methods") are excluded from patentability; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods (see former Art. 52(4) EPC 1973).

Art. 54(4) EPC (former Art. 54(5) EPC 1973) provides that the general rules of law relating to novelty do not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Art. 53(c) EPC (former Art. 52(4) EPC 1973), provided that its use for any method referred to in that paragraph is not comprised in the state of the art. Thus in addition to the general concept of novelty,

this article introduces, in respect of substances and compounds used in surgical and therapeutic treatment and in diagnostic processes carried out on humans and animals, a **special concept of novelty** unknown in other technical fields (**T 128/82**, OJ 1984, 164). In the EPC 2000 some of these provisions have been amended but their substance remains unchanged.

Accordingly, under Art. 54(4) EPC (former Art. 54(5) EPC 1973), known substances or compositions are deemed to be new, provided they are used for the first time in such a medical method. According to the case law of the boards of appeal, the first to show a use of a substance or composition in a medical method should receive broad protection covering any use in a medical method, even if only one specific use is disclosed in the application (see **T 128/82**, OJ 1984, 164; **T 36/83** OJ 1986, 295).

For the first medical use of a known substance, Art. 54(4) EPC (former Art. 54(5) EPC 1973) provides a particular form of claim (**purpose-related product claim**). In **G 5/83** (OJ 1985, 64) the Enlarged Board observed that the inventor of a "first medical indication" could obtain purpose-limited product protection for a known substance or composition, without having to restrict himself to the substance or composition when in a form technically adapted to a specified therapeutic purpose. The appropriate protection for him was, therefore, in its broadest form, a purpose-limited product claim.

5.1.2 Scope of a purpose-related product claim

In **T 128/82** (OJ 1984, 164) the board considered the question of a first medical indication (first medical use of a known substance) with regard to the breadth of the purpose-related product claim. The examining division had refused the application on the grounds that it failed to fulfil the requirements of Art. 52(4) and 54(5) EPC 1973 (now Art. 53(c) and 54(4) EPC), as the claims were not limited to the specific therapeutic use of the known compounds as first discovered. The board had to consider whether the broad version of the claims was allowable having regard to Art. 54(5) EPC 1973 and, in particular, whether the EPC 1973 offered a basis for a limited statement of therapeutic purpose susceptible of narrow interpretation. In the opinion of the board the EPC 1973 neither prohibited nor required an unlimited statement of purpose. It held that Art. 54(5) EPC 1973 permitted a purpose-limited substance claim stating a general therapeutic purpose and found that where a known compound was for the first time proposed and claimed for use in therapy, the fact that a specific use was disclosed in the specification did not in itself call for a restriction of the purpose-limited product claim to that use (see also **T 43/82** and **T 36/83**, OJ 1986, 295). The board further observed that the practice of the EPO hitherto had shown that substance and medical preparation claims for therapeutically active compounds not limited to specific indications were allowed, even though, as a rule, only certain specific activities were stipulated. As a general rule, this practice concerned new compounds. In the board's judgment, it could not be inferred from the EPC 1973 that compounds, which - although previously known - were still patentable under Art. 54(5) EPC 1973, were in principle to be treated differently. If an inventor was granted absolute protection in respect of a new chemical compound for use in therapy, the principle of equal treatment would also require an inventor, who for the first time made a known compound available for therapy, to be correspondingly rewarded

for his service with a **purpose-limited substance claim under Art. 54(5) EPC 1973 covering the whole field of therapy**. Any other treatment would only be justified were Art. 54(5) EPC 1973 to forbid outright a broad scope of protection. The fact that Art. 54(5) EPC 1973 did not contain any requirement that protection should be broad was not in itself a reason for refusing to grant such protection. As a general rule, the usual practice as it related to new compounds should be followed. On the other hand, the mere fact that there were no instructions concerning all and any possible specific therapeutic applications did not justify limiting the scope to the therapeutic application actually mentioned. This would not be in keeping with general practice of the EPO concerning therapeutically active compounds.

The board noted that under Art. 54(5) EPC 1973 a compound which was known but not used therapeutically was to be regarded as novel. Novelty, however, was not only destroyed by the fact that the same specific therapeutic effect was already known in the art, but suffered also from the disclosure of any other specific therapeutic application. The disclosure of any specific effect, therefore, always had the same consequences as far as novelty was concerned - which in turn made it fair to regard as admissible a broad statement of purpose covering all and any specific indications.

5.1.3 Protection of a preparation in the form of a "kit-of-parts"

In **T 9/81** (OJ 1983, 372) the board held that combined preparations, the individual components of which represented known therapeutic agents, might be protected in a formulation corresponding to Art. 54(5) EPC 1973 (now Art. 54(4) EPC) even when claimed as a **kit-of-parts**, providing those components formed a functional unity (true combination through a purpose-directed application. Claim 1, which was drawn up in the form stipulated in Art. 54(5) EPC 1973, referred to a combined preparation containing an oxazaphosphorin cytostatic agent and the sodium salt of 2-mercapto-ethane-sulphonic acid as therapeutic active ingredients. The first-mentioned component of the product was known, and the second was a known mucolytic agent. According to the documentary prior art available to the board, the two active ingredients had never been used together for a **new joint effect** and were **unknown as a composition**. The active ingredients which were administered preferably at the same time according to the invention did not therefore represent a mere aggregate of known agents, but a new combination with the surprising, valuable property that the severe side-effects to be expected when administering the cytostatic agents were absent as a result of the detoxifying effect of the sodium 2-mercapto-ethane-sulphonate.

Claim 1 referred to a product which was limited to simultaneous, separate or sequential use in cytostatic therapy. In the board's judgment, it followed from this indication of purpose that the components were no longer necessarily present as a union, e.g. in composition, since the components would not otherwise be available for separate or sequential application. The board stated that as a **kit-of-parts**, however, it was not necessarily a true combination in view of the physical separation of the individual components. The mere loose association of known components did not in itself turn them into a functional unity in which a necessary and direct interaction between the components was a precondition for the purposive use (e.g. lock and key, match and

striking surface, two-component adhesive). Although the components in the claimed combination did not enter into such direct interaction with each other, the indication of purpose for the combined therapy might re-establish the unity of the product as a functional amalgamation of its two components, if it represented a genuine restriction to the specified application. In so far as the components could not attain the advantageous effect according to the invention independently of each other, the joint effect justified the unity of the combined product as a result of the limitation by the indication of purpose of the area of protection of the claim under the conditions laid down in Art. 54(5) EPC 1973, even if the components were presented side-by-side and not as a union. Since the individual components of the combined product in the present claims had themselves known therapeutic applications, these claims, by expressly including the separate presentation of those components, were indeed to be regarded as limited to the joint use of the combined products, so that the individual applications according to the state of the art were excluded.

5.1.4 Further technical information as compared with the state of the art

In **T 1031/00** claim 1 was directed to the first medical use of (-) amlodipine, namely the treatment of hypertension. However, the prior art document already showed the ability of (-) amlodipine to inhibit calcium ion influx into rat aorta tissue in vitro as indicative of its effectiveness in the treatment of hypertension. It also disclosed that amlodipine was then undergoing phase III clinical trials for the treatment of hypertension.

The board found that, in spite of the numerous examples in the description of the patent application, only one dealt with hypertension, but without going further than in vitro experiments. Thus the description **provided no further evidence or data** showing the actual antihypertensive effect of the (-) isomer of amlodipine in humans or animals than did the prior art. The board observed that, in the absence, in the patent application as originally filed, of any data providing additional technical information in relation to the actual treatment of hypertension in humans or animals compared with the disclosure in the prior art document (3), it had to be concluded that the subject-matter of the patent application was anticipated by the disclosure in that document; in other words, document (3) disclosed the same medical use as the application at issue.

5.2. Second (or further) medical use

5.2.1 Introduction

Under the EPC 1973 a patent for a further medical application could, pursuant to a line of case law first set out in decision **G 5/83** (OJ 1985, 64), be granted for a claim directed to the use of a substance or composition for the manufacture of a medicament for a specified therapeutic application ("Swiss-type claim"). The novelty of the subject-matter of such a claim could be derived not only from the novelty of the substance or of the method of manufacture, but also from the new therapeutic application (**G 5/83**). This "special approach to the derivation of novelty" as it was called in decision **G 5/83** constituted a narrow exception to the general novelty requirement and was not to be applied in other fields of technology.

Under Art. 54(4) EPC (former Art. 54(5) EPC 1973), known substances or compositions are deemed to be new, provided they are used for the first time in such a medical method ("first use in a medical method"). In the early 1980s, the Enlarged Board of Appeal was asked to decide whether any further medical use could receive patent protection under the EPC in spite of the wording of Art. 54(5) EPC 1973 (now Art. 54(4) EPC) which seemed to limit patentability to the first medical use. The Enlarged Board extended the notional novelty provided for in former Art. 54(5) EPC 1973 to apply to each further medical use in the so-called "Swiss type claim", i.e. to a claim "directed to the use of a substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application" (**G 5/83**, OJ 1985, 64; Legal Advice from the Swiss Federal Intellectual Property Office, OJ 1984, 581).

During the course of the revision of the EPC 2000, former Art. 54(5) EPC 1973 ("first use in a medical method") was renumbered to become Art. 54(4) EPC and a new Art. 54(5) EPC was introduced to provide protection for second medical uses. The new Art. 54(5) EPC eliminates any legal uncertainty on the patentability of further medical uses. It unambiguously permits purpose-related product protection for each further new medical use of a substance or composition already known as a medicine.

This protection is equivalent, as far as the further uses are concerned, to that offered by the Swiss type claim. In contrast to Art. 54(5) EPC 1973 (now Art. 54(4) EPC) which provides broad (generic) protection for the first use in a medical method, new Art. 54(5) EPC is expressly limited to a specific use in such a method. This limitation is intended to match as closely as possible the scope of protection to the scope provided by a Swiss type claim. Claims to a second medical use would be drafted as product claims relating to a specific second or further medical use (see **T 1599/06**).

The Enlarged Board of Appeal has since held in **G 2/08** (OJ 2010, ***) that, where the subject-matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so-called Swiss-type claim as instituted by decision **G 5/83** (OJ 1985, 64). As Art. 54(5) EPC now permits purpose-related product protection for any further specific use of a known medicament in a method of therapy, the loophole existing in the provisions of the EPC 1973 is now closed - when the reason for the law ceases, the law itself ceases. **G 2/08** is discussed in further detail in 5.2.4 b) below.

According to Article 1, No. 3 of the Decision of the Administrative Council of 28 June 2001 under Article 7 of the Act revising the EPC of 29 November 2000, revised Art. 54(5) EPC is applicable to European patent applications pending at the time of the EPC 2000's entry into force, insofar as a decision on the grant of the patent has not yet been taken (see decision **T 1127/05** of 15 January 2008; **T 406/06** of 16 January 2008) (see also OJ SE 4/2007).

5.2.2 Formulation of claims under the EPC 1973

a) Use of a substance or composition for the manufacture of a medicament

In **G 5/83** (OJ 1985, 64) the Enlarged Board did not accept claims directed to the use of a known substance X for the treatment of disease Y, because such a claim would relate to a medical method which was not patentable under Art. 52(4) EPC 1973. However, it allowed claims of the type **"use of substance X for the manufacture of a medicament for therapeutic application Y"** (so-called Swiss-type claim). The Enlarged Board derived the novelty of such claims from their sole new feature, that is the new pharmaceutical use of that known substance. The Enlarged Board found that no intention to exclude second (and further) medical indications generally from patent protection could be deduced from the terms of the EPC 1973. As a result, the Enlarged Board considered that it was legitimate in principle to allow claims directed to the use of a substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application, even where the process of manufacture as such did not differ from known processes using the same active ingredient. See **G 2/08** (OJ 2010, ***) for the position as it now stands under the EPC 2000 (5.2.4 b) below).

b) Process for the manufacture of a medicament

In **T 51/93** the board found that document (4) anticipated process claim 1 put forward in the set of claims for Austria (AT), Spain (ES) and Greece (GR), as the novelty of the intended use of the product could only be taken into account as a technical feature limiting the claim, where the claim took the form of a use claim as approved in decision **G 5/83**. The use claim as approved in decision **G 5/83** emphasised that the intended use was a **technical** feature to be taken into account in assessing novelty, and which limited the claim. The board stated that normally, however, in a claim to a "Process for making X for use Y comprising the steps [...]" the process claim was interpreted as covering the particular process of making X irrespective of whether that X was to be used for use Y or not. Thus, in such a process claim, the wording **"for use Y"** was intended not as a distinguishing technical feature but merely as an **illustration** of what X could be used for. Consequently the board considered that in the process claim 1 for AT, GR and ES the words "for use in the treatment by subcutaneous administration [...]" were to be treated in accordance with common practice for process claims as merely illustrative and **not as a restrictive technical feature** capable of establishing novelty. The board further stated that, for the purpose of assessing novelty in proceedings before the EPO, the interpretation to be given to a claim had to be the same irrespective of the contracting states for which the claim was put forward. The fact that the contracting states AT, ES and GR had, for a time, laws restricting claimable subject-matter, could not, where the prior art was the same for all designated states, lead to a claim being interpreted as novel and allowable for these states if it was not also novel and allowable for all other contracting states. Thus the fact that process claim 1 was put forward only for AT, ES and GR did not assist the appellant.

In **T 893/90**, however, a board of appeal had come to a different conclusion. The claims were formulated as **method claims**, namely as a method of producing a pharmaceutical

composition for controlling bleeding in non-haemophilic mammals characterised by admixing the two components in functionally defined amounts and proportions. In the board's judgment, the said claims **did not substantially differ** in their formulation from use claims, i.e. from claims directed to the use of the mixture of the two components in functionally defined amounts and proportions for the stated purpose, namely for producing a pharmaceutical composition for controlling bleeding in non-haemophilic mammals. In this respect, it was also observed that, according to claim 1, the mixture excluded other physiologically active materials; thus, the said mixture was well-defined in terms of its components. The board concluded that the claims were thus in accordance with established EPO case law that claims are allowable directed to the use of a substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application, even if the process of manufacture as such does not differ from known processes using the same active ingredient(s) (see **G 5/83**, OJ 1985, 64).

In **T 958/94** (OJ 1997, 242), the examining division had refused the claims for Greece and Spain on the grounds that, because they were directed to a process rather than an application or use, they were not in the "second medical indication" form stipulated by the Enlarged Board of Appeal in **G 5/83** (OJ 1985, 64). The examining division had taken the view that the novelty of "the use of a substance for the manufacture of a medicament" was linked to formal requirements and that given the order of decision **G 5/83** on the protection of the second medical indication, only **use claims - not process ones** - fulfilled those requirements. The appellant (applicant) had filed an appeal against that decision, requesting that the decision to refuse the application be set aside.

The board noted that Enlarged Board decisions **G 1/83**, **G 5/83** and **G 6/83** made no mention of requirements of form or category governing claims directed to a medicament's second therapeutic indication. In the board's view the French wording "revendications ayant pour objet" used in decision **G 6/83** (OJ 1985, 67) referred not to the formal aspect of the category of a claim but rather to its substance, i.e. the definition of the claimed invention in terms of its essential features. Parallel decisions **G 1/83** (OJ 1985, 60) and **G 5/83** (OJ 1985, 64) in German and English used the words "Patentansprüche gerichtet auf" and "claims directed to" rather than "Gegenstand" or "subject-matter", which also showed that the determining factor was not the wording or category chosen for the claim but its substance, namely the technical feature which formed the essence of the invention claimed (use of the substance in question). This interpretation was confirmed by the reasons for decisions in **G 1/83**, **G 5/83** and **G 6/83**.

In point 11 of the reasons for decision **G 5/83** (first paragraph) the Enlarged Board held that an invention relating to an activity could be claimed either as the application or use of a thing for a stated purpose (e.g. to achieve a technical result) or as a method or process to achieve the same result using the same thing, depending on the applicant's preference. Either type of claim also involved a sequence of steps giving rise to the final effect. In terms of use, therefore, there was no difference of substance. This general rule also applied in the field of therapy. There was **no discernible substantive difference** between a claim for the use of a substance or composition for the treatment of the

human or animal body by therapy and a claim directed to a method of treatment of the human or animal body by therapy. The sole difference was in the wording, as was emphasised by the Enlarged Board in point 13 of the reasons for decision **G 5/83**. Thus, manufacturing a medicament did indeed involve a sequence of common and obligatory steps, irrespective of the form of the claims which circumscribed its manufacture, and whether the claims were for the "application of a substance to obtain a medicament intended for a new therapeutic use" or for a "process to obtain a medicament intended for the new application, characterised in that the substance is used". Although the active substance per se, the medicament and the process for its manufacture were already known, the Enlarged Board in decisions **G 1/83**, **G 5/83** and **G 6/83** allowed a claim for preparing the medicament for the new therapeutic indication and directed to the substance's use in manufacturing the medicament intended for that new therapeutic indication. Under the same conditions - i.e. where the active substance, the medicament and the process for its manufacture all lacked novelty - it would therefore be unjustified to regard a claim of the type "method for manufacturing the medicament intended for the new therapeutic indication" as not patentable, given that a claim for the use of a substance to manufacture a medicament intended for a new therapeutic use and a claim for a method of manufacturing the medicament intended for the new use and characterised in that the same substance was used were substantively equivalent.

This decision endorses the approach already outlined in **T 893/90**. This approach was also confirmed in the decisions on this issue which followed (**T 853/94**, **T 532/96**, **T 1076/00**, indirectly also in **T 825/94**).

c) Further issues relating to claim formulation and construction

In **T 570/92** the board allowed a claim which took the form of a claim to a second medical use of a known substance and referred to a substance which had not previously been described in concrete terms. Similar to **G 5/83** (OJ 1985, 64), what was claimed was the use of that substance for the manufacture of a long-lasting medicament for the oral treatment of hypertension, to be administered once or twice daily. The latter **feature, concerning the administration of the medicament**, did not lead to exclusion from patentability under Art. 52(4) EPC 1973 (now Art. 53(c) EPC). The wording used served not to indicate to the doctor the frequency of administration actually intended when treating an individual patient, but merely to convey the teaching that the success of the treatment was assured if the medicament was administered not more than twice a day.

In **T 143/94** (OJ 1996, 430) the board found that a claim directed to the use of a substance or composition for the production of a medicament for a therapeutic application did not conflict with Art. 52(4) EPC 1973 (now Art. 53(c) EPC) or Art. 57 EPC 1973 (see above **G 5/83**); this was true irrespective of what purpose the claim served (protection of a first medical use of a substance or composition, or protection of a further medical use). Accordingly, prior **evidence of a further medical use was not required** for this form of claim to be included in a patent application.

In **T 138/95** the Swiss type claim format was admitted for the manufacture of a **medical device**.

In **T 4/98** (OJ 2002, 139) the independent claims were drawn up in the form of "Swiss type" claims. However, the feature considered by the opposition division to be a specified new therapeutic application related to the administration of an unspecified therapeutic compound in liposome-entrapped form, in an amount which was at least three (or ten) times the therapeutically effective amount of the said unspecified therapeutic compound, to treat an unspecified illness or disease in an unidentified subject. The board held that in accordance with the principles in **G 5/83** (OJ 1985, 64) and subsequent case law, the concept of second or further medical use can only be applied to claims to the use of substances or compositions for the preparation of a medicament intended for use in a method referred to in Art. 52(4) EPC 1973. It noted that the concept of "therapy" or "therapeutic application" includes treatment of a particular illness or disease with a specified chemical substance or composition in a specified human or animal subject in need of such treatment and that in the absence of the identification of at least (i) the **illness or disease to be treated** or the ailment to be cured or (ii) the **nature of the therapeutic compound** used for treating or curing the disease or (iii) the **subject to be treated**, a mere process feature could not be construed as specifying a particular method of treatment or therapeutic application within the meaning of Art. 52(4) EPC 1973 (now Art. 53(c) EPC). Thus, the board came to the conclusion that the subject-matter of the independent claims was to be understood as relating to a non-therapeutic technical activity (process). The "three times dosage" feature could then only be construed as one of the process features characterising the claimed process (see also **T 1020/03** below, where the "therapy" definition in **T 4/98** was questioned).

In **T 1286/05** Independent claim 1 was drawn up in the form of a "second (further) medical use claim" as defined in decision **G 5/83** (OJ 1985, 64). However, in spite of the chosen format, this claim did not in fact reflect a second (further) medical use, as the feature "for substantially reducing the inhibitory effect of the hydrophilic surfactant component on the in vivo lipolysis of the digestible oil" clearly defined a non-therapeutic use. It did not per se involve the treatment or alleviation of an illness or of any pathological condition and was therefore non-therapeutic.

It had to be established how a claim drawn up in the second medical use format but relating to a non-therapeutic activity was to be read for the assessment of novelty. The board stated that in **G 5/83** it was made clear that this special approach under Art. 54(5) EPC 1973 to the derivation of novelty could only be applied to claims to the use of substances or compositions intended for use in a method referred to in Art. 52(4) EPC 1973 (see **G 5/83**, point 21). As a consequence, this special approach to the derivation of novelty could not be applied to claim 1, which was to be interpreted as a claim defining a conventional process of preparation. The board noted that in claim 1 the indication of an additional non-therapeutic effect of one of the components in the finished composition had a merely illustrative character and thus no influence whatsoever on the process of preparing the composition. Therefore, it was not suitable for establishing novelty.

5.2.3 Formulation of claims under Article 54(5) EPC

Art. 54(5) EPC was introduced into the Convention as part of the revision of the EPC. Under the transitional provisions for EPC 2000, Art. 54(5) EPC shall apply to pending

applications in so far as a decision on grant has not been taken (**T 1599/06** and **T 1127/05**).

Art. 54(4) and (5) EPC read: "Paragraphs 2 and 3 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Art. 53(c) EPC, provided that its use for any such method is not comprised in the state of the art" and "Paragraphs 2 and 3 shall also not exclude the patentability of any substance or composition referred to in paragraph 4 for any specific use in a method referred to in Art. 53(c) EPC, provided that such use is not comprised in the state of the art". Hence, claims to a second medical use can be drafted as product claims relating to a specific second or further medical use (**T 1599/06**).

In **T 1599/06** the board noted that under the then applicable version of the EPC (EPC 1973) the claim at issue would be regarded as a product claim to a first medical use under Art. 54(5) EPC 1973, although the therapeutic use was indicated in a specific manner. However, a revised version of the EPC was about to enter into force (EPC 2000 on 13 December 2007). Under the legal situation as from 13 December 2007, claim 1 would be regarded as a claim relating to a second medical use under Art. 54(5) EPC since it defined the use in a specific manner.

The board observed that under the transitional provisions for EPC 2000, the new Art. 54(5) EPC would apply to pending applications in so far as a decision on grant had not been taken. Although pursuant to Art. 111(1) EPC 1973 the boards of appeal could exercise any power within the competence of the department responsible for the decision under appeal, the boards did not, in practice, take decisions to grant patents themselves, but remitted the case for that purpose to the department of first instance. This was because several further requirements of a formal nature, such as the provision of a translation of the claims, still had to be fulfilled. The board noted that, since the deciding board was following this practice, it would de facto not be possible for the patent application at issue to be granted before 13 December 2007. The board therefore considered it already necessary to take the new situation under the EPC 2000 into account when examining the claims at issue. Claim 1 was thus interpreted as a product claim for a second medical use in accordance with Art. 54(5) EPC.

In **T 385/07**, although the subject-matter of the claims complied with the requirements of the EPC as then in force, the board did not consider it appropriate to remit the case to the examining division with the order to grant the patent on the basis of these claims. The board noted that it had to be taken into account that the EPC 2000 would enter into force on 13 December 2007 and that, according to Article 1 No. 3 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Art. 7 of the Act revising the EPC of 29 November 2000, the new Art. 54(5) of the EPC had to be applied to European patent applications pending at the time of its entry into force, in so far as a decision on the grant of the patent had not yet been taken.

Since it was highly unlikely in the case at issue that a grant decision would be taken before 13 December 2007 (the description had still to be adapted); and since Art. 54(5) EPC allowed a claim format different from the so-called Swiss-type claim format

endorsed by the Enlarged Board of Appeal in its decision **G 5/83** (OJ 1985, 64), the appellant was able to consider amending its claims in the light of the forthcoming change in substantive law. The board therefore remitted the case to the department of first instance for further prosecution.

In **T 1314/05**, the board stated that decision **G 5/83** (OJ 1985, 64; point 21 of the Reasons) made it quite clear that its special approach to the derivation of novelty was applicable only to inventions or claims relating to the use of substances or compositions in a method of treatment referred to in Art. 52(4) EPC 1973, where that method did not yet form part of the state of the art. The board decided that **G 5/83** did not imply that the special approach to novelty assessment which was associated with the Swiss-type claim for substances or compositions could be applied to the use of a device to produce an appliance intended for medical purposes. Extension of that special approach to the production of such appliances ran counter to the general legal principle that exceptions are to be construed narrowly. This was confirmed by the fact that the EPC 2000 legislator in Art. 54(5) EPC expressly restricted the exception concerning the second medical use to substances or compositions. Decision **G 2/08** (OJ 2010, ***) has since considered Swiss-type claims in the light of both **G 5/83** and the revisions to the EPC - see **T 406/06** below and 5.2.4 below.

In **T 406/06** all the claims submitted to the board for consideration were drafted in the so-called Swiss-type format. The board noted that under EPC 1973 a patent for a further medical application could, pursuant to case law established by decision **G 5/83** (OJ 1985, 64), be granted for a claim relating to the use of a substance or composition for the manufacture of a medicament for a specified therapeutic application (Swiss-type claim). The novelty of the subject-matter of such a claim could be derived not only from the novelty of the substance or of the method of manufacture, but also from the new therapeutic application (**G 5/83**). This "special approach to the derivation of novelty", as it was called in decision **G 5/83**, constituted a narrow exception to the general novelty requirement and was not to be applied in other fields of technology.

The board considered the question whether the exception to the general novelty requirement, which was accepted in decision **G 5/83** under EPC 1973, was still justified under the new legal framework which enables the applicant to frame its claims in accordance with Art. 54(5) EPC in order to obtain patent protection for a new therapeutic application of a known medicament. If this question had to be answered in the negative, the novelty of Swiss-type claims would have to be assessed merely on the basis of the substance itself or the manufacturing process. The board did not decide on this point, but assumed, to the benefit of the appellant, that the novelty of the subject-matter of a Swiss-type claim could still be derived from a new therapeutic application. However, the board concluded that even if the introduction of Art. 54(5) EPC did not change the legal basis on which decision **G 5/83** was founded, the claimed subject-matter would still lack novelty. The board found that claim 1 did not relate to a new therapeutic use within the meaning of decision **G 5/83** and was not therefore novel. This issue has since been considered in **G 2/08** (OJ 2010, ***), where the Enlarged Board held that, where the subject-matter of a claim is rendered novel only by a new therapeutic use of a

medicament, such claim may no longer have the format of a so-called Swiss-type claim as instituted by decision **G 5/83** (see 5.2.4 below).

5.2.4 Novelty of the therapeutic application

a) New therapeutic application based on the group of subjects to be treated

The board of appeal applied the principles of decision **G 5/83** (OJ 1985, 64) in case **T 19/86** (OJ 1989, 25). It had to decide whether the application of a known medicament for the prophylactic treatment of the **same disease** in an **immunologically different** population of animals of the same species could be considered a new therapeutic application from which novelty for the claims could be derived. According to decision **T 19/86** the question of whether a new therapeutic use was in accordance with decision **G 5/83** should not be answered exclusively on the basis of the ailment to be cured but also on the basis of the subject (in the case in question, the new group of pigs) to be treated. A therapeutic application was incomplete if the subject to be treated was not identified; only a disclosure of both the disease **and** the subject to be treated represented a complete technical teaching. The proposal according to the application to protect animals which could not hitherto be protected from the disease in question, by intranasally administering to them a known serum, could not be considered disclosed in the prior art and therefore constituted a novel therapeutic application in accordance with **G 5/83** (see also **T 893/90**).

In **T 233/96** the board held that if the use of a compound was known in the treatment or diagnosis of a disease of a particular group of subjects, the treatment or diagnosis of the same disease with the same compound could nevertheless represent a novel therapeutic or diagnostic application, provided that it was carried out on a new group of subjects which was **distinguished** from the former **by its physiological or pathological status** (**T 19/86**, OJ 1989, 25; **T 893/90**). This did not apply, however if the group chosen overlapped with the group previously treated, or the choice of the novel group was arbitrary which meant that no functional relationship existed between the particular physiological or pathological status of this group of subjects (here humans who were unable to exercise adequately) and the therapeutic or pharmacological effect achieved.

In the case **T 836/01** claim 1 and 2 of the patent in suit were directed to the use of human interferon- β_2 for preparing a medicament for influencing tumour/cancer cell growth and differentiation. Document (D1) disclosed the use of interferon- β_2 for the purpose of activating mature lymphoid cells exerting cytolytic T cell activity on cancer cells or to stimulate the immune system of patients undergoing chemotherapy. Document (D1) and the claimed invention thus being concerned with the same composition (interferon- β_2) for treating the same disease (cancer/tumour), the board had to decide whether the medical uses claimed by the applicant represented further and different therapeutic uses. The board observed that the claimed invention relied upon a different technical effect from the one disclosed document (D1), which taught that interferon- β_2 had an **indirect effect** on cancer cells.

However, for an application to be construed as a further use or “further medical use”/“further therapeutic application” this new technical effect would have to lead to an industrial/commercial application which was truly new (**G 5/83**, OJ 1985, 64), arising from e.g. the opening of a new field of application, the healing of a different pathology/clinical situation, the creation of a distinct group or sub-group of subjects (either end-users or patients), or the new use had to involve new physical means/measures for its practice. Applying these standards, the board concluded that the technical effect relied upon in the claimed invention identified a **new clinical situation**, namely one in which it could be preferable to target the cancer cells themselves, not lymphoid cells or the immune system as in document (D1). Since a new clinical frame was not separable, as an abstract concept, from a patient suffering under it, it had to be concluded that this new clinical situation also identified a new sub-group of subjects being treated.

In **T 485/99** prior art document (1) had already disclosed the use for immunostimulation of the composition underlying claim 1 of the patent in suit. The only new feature of claim 1 was the fact that the intake of the immunostimulatory diet was pre-operative. In the opinion of the board it needed to be investigated whether the pre-operative therapy as defined in the claim could be distinguished from the therapy disclosed in document (1) by a different medical (physiological) effect due to this pre-operative administration and thus whether or not it related to a functional feature leading to the therapeutic indication within the meaning of **G 5/83** (OJ 1985, 64). If it did not, the use defined in such a way might restrict the medical practitioner's freedom when treating his patients (see **T 56/97**). Pre- or post-operative administration of the diet would then constitute methods for treatment of the human body and could thus not be regarded as patentable inventions under Art. 52(4) EPC 1973. The appellant had argued that the group of patients treated with the pre-operative diet could be distinguished from those treated with the post-operative diet. In the board's opinion, the question raised was **whether the physiological status of the patients caused by the pre-operative diet was different**. The board concluded that this could not be established at present.

For further decisions on the novelty of a therapy in the light of its application to a different group of subjects, see also **T 893/90**, **T 885/91**, **T 51/93**, **T 584/97** and **T 486/01**.

b) Difference in the prescribed administration regimen

In **T 1319/04** (OJ 2009, 36), the board noted that the application was pending on the date on which the EPC 2000 entered into force. Accordingly, the application was to be considered under the provisions of Art. 53(c) and 54(4) and (5) EPC, and no longer under Art. 52(4) and 54(5) EPC 1973. In the application in question, the feature in claim 1 - “once per day prior to sleep” - was not anticipated by the available prior art documents. The board noted that the legal question whether medicaments for use in methods of treatment by therapy, where the only novel feature is a dosage regime, are patentable under Art. 53(c) and 54(5) EPC, was an important point of law, as the situation arose quite frequently. If patenting was to be excluded in such circumstances, then applicants needed to know this for certain. Accordingly, the board referred to the Enlarged Board of Appeal three questions which were answered in **G 2/08** (OJ 2010, ***) as follows:

1. Art. 54(5) EPC does not exclude a medicament which is already used in the treatment of an illness being patented for use in a different treatment by therapy of the same illness. Art. 53(c) EPC, which lists as an exception to patentability 'methods for treatment of the human body ... by therapy' is clear and unambiguous, and draws a borderline between unallowable method claims directed to a therapeutic treatment on the one hand and allowable claims to products for use in such methods on the other. The two concepts of a method of treatment by therapy and of a product to be used in such a method are so close to each other, that there is a considerable risk of confusion between them unless each is confined to its own domain as allocated to it by the law. Art. 53(c), second sentence, EPC, is not therefore to be interpreted narrowly; on the contrary, it is appropriate to give both provisions (Art. 54(5) and Art. 53(c) EPC) the same weight and conclude that, in respect of claims directed to therapy, method claims are absolutely forbidden in order to leave the physician free to act unfettered, whereas product claims are allowable, provided their subject-matter is new and inventive. The first sentence of Art. 53(c) EPC, prohibiting patent protection of methods for treatment by therapy, is to be read and understood together with the provisions of its second sentence and with those of Art. 54(4) and (5) EPC, so that, far from being mutually exclusive, they are complementary. By virtue of a legal fiction, Art. 54(4) and (5) EPC acknowledge the notional novelty of substances or compositions even when they are already comprised in the state of the art, provided they are claimed for a new use in a method which Art. 53(c) EPC excludes from patent protection. The notional novelty, and thus, non-obviousness, if any, is not derived from the substance or composition as such, but from its intended therapeutic use. Art. 54(5) EPC refers to "any specific use" [emphasis added] and thus, in conjunction with the stated intention of the legislator to maintain the status quo of the protection evolved in the case law of the boards of appeal under **G 5/83** (OJ 1985, 64) in this respect, this use cannot be ex officio limited to a new indication *stricto sensu* (approving **T 1020/03**, OJ 2007, 204).

2. The Enlarged Board went on to hold that such patenting is also not excluded where a dosage regime is the only feature claimed which is not comprised in the state of the art. Given the answer to the first question, and, since Art. 54(5) EPC may be used in cases of the treatment of the same illness, the "specific use" in the sense of that provision may reside in something other than the treatment of a different illness, the Enlarged Board held that there is no reason to treat a feature consisting in a new dosage regime of a known medicament differently from the one given to any other specific use acknowledged in the case law. However, it stressed that the whole body of jurisprudence relating to the assessment of novelty and inventive step also applies; in particular the claimed definition of the dosage regime must therefore not only be verbally different from what was described in the state of the art but also reflect a different technical teaching. The jurisprudence on this continues to apply (see **T 290/86**; OJ 1992, 414; **T 1020/03**, OJ 2007, 204; **T 836/01**; **T 1074/06**). In respect of second and further medical indications, the EPC now allows use-related product claims directed to the substance itself, whereas under the EPC 1973, **G 5/83** allowed claims directed to the use of a substance for the manufacture of the drug for a therapeutic indication ('Swiss-type claims'). It appears that the rights conferred on the patentee by the claim category under Art. 54(5) EPC are likely to be broader and could lead to possible restrictions on the freedom of medical practitioners to prescribe or administer generics.

3. Where the subject-matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so-called Swiss-type claim, as instituted by **G 5/83**. Art. 54(5) EPC now permits purpose-related product protection for any further specific use of a known medicament in a method of therapy. The Enlarged Board set a time for the entering into effect of this provision (see chapter VI.A.4.2, principle of the protection of legitimate expectations).

In **T 317/95** the issue of novelty concerned both the question of whether the mere difference in the course of the administration of two drugs (i.e. the prescribed regimen) could indeed confer novelty on claim 10, and the objections to this claim which appeared to imply the issue of patentability under the terms of Art. 52(4) EPC 1973. The invention involved the treatment of exactly the same category of patients by separately administering to them the same two commercial drugs in the same concentration, dosage and formulation for the treatment of the same illness or disease, with the sole exception that the prescribed regimen for this treatment was slightly modified (BNS and cimetidine were administered to the patient within five minutes of each other).

The board observed that, in **G 5/83** (OJ 1985, 64), the Enlarged Board had stated that it was the purpose of the exclusion of medical treatments from patentability under Art. 52(4) EPC 1973 to free from restraint non-commercial and non-industrial medical and veterinary activities. The board did not question the appellants' submission that the pharmaceutical industry was engaged in optimising the use of drugs and medicaments by investigating the optimum regimen for their administration to achieve the maximum possible therapeutic effect. However, the board pointed out that determination of the best individual treatment schedule, in particular the prescribing and modification of drug regimens used for administering a particular medicament, so as to comply with the specific needs of a patient, appeared to be part of the **typical activities and duties of the doctor** in attendance in exercising his professional skills of curing, preventing or alleviating the symptoms of suffering and illness. These were typical non-commercial and non-industrial medical activities, which Art. 52(4) EPC 1973 intended to free from restraint. The board found that before the priority date of the contested patent, the medical practitioner was aware of the possibility of treating gastrointestinal disorders using the particular combination of drugs defined in claim 10. He was similarly in a position to prescribe an effective regimen for treating each patient according to his or her individual needs. It therefore appeared questionable to the board whether the feature at issue could indeed be considered to represent a further medical indication from which novelty could be derived on the basis of the principles set out in decision **G 5/83**. In any case, inventive step was lacking.

In **T 56/97** the alleged invention was based on the finding or discovery that, by orally administering thiazide diuretics in a certain dosage regimen or low unit dosage amount, antihypertensive activity could be achieved in patients without inducing effective diuresis. Claim 1 was in the conventional "second (further) medical use" format.

According to the board, all that had been discovered was that, if thiazide diuretics were administered in sufficiently low dosage units, their diuretic effect would be to a certain extent less or even possibly absent, while the antihypertensive activity remained. Even

assuming that this was not known in the state of the art, it could only be regarded, in the board's judgment, as an **additional item of knowledge about the known therapeutic application** of thiazide diuretics for the treatment of hypertension to alleviate and cure the symptoms and complaints of hypertension in an human or animal subject in need of it, but could not in itself confer novelty on this known therapeutic application. For the acknowledgment of novelty, such a finding or discovery would be required to lead to a specified **new therapeutic application or purpose**. That not being the case here, the board could not see how claim 1 could be construed as relating to a second or further medical use.

The above considerations led to the question whether or not claim 1 was compatible with Art. 52(4) EPC 1973. The board held that determination of the best individual treatment schedule, in particular the prescribing and modification of drug dosage regimens used for administering a particular medicament, so as to comply with the specific needs of a patient and to achieve the desired result of the treatment in an individual patient, called first and foremost for the exercise by a medical practitioner of his professional skill in curing preventing or alleviating the symptoms of suffering and illness. Such activities were **typical of the non-commercial and non-industrial medical activities** which Art. 52(4) EPC 1973 intended should remain free from restraint. The case was finally decided on the basis of the lack of novelty or non-compliance with Art. 123(2) EPC 1973 of the various requests, so that no final decision on the above issues was necessary.

In **T 584/97** and **T 485/99** a similar view was taken on the issue of whether a feature relating merely to the prescription of a specific drug regimen for known medical treatments represented a further medical indication from which novelty could be derived.

In **T 1020/03** the claims were directed to the use of insulin-like growth factor-I in the preparation of a medicament for administering to a mammal in a specific discontinuous administration pattern. Analysing decision **G 5/83** (OJ 1985, 64), the board found that any use to which Art. 52(4), first sentence, EPC 1973 applied, in circumstances where the composition had already been suggested for some therapeutic use, would allow a further medical use claim in the approved format, irrespective of the amount of detail in which the use was specified, subject to the use being novel and inventive. The phrase "manufacture of a medicament for a specified new and inventive therapeutic application" used by the Enlarged Board of Appeal merely indicated that the application was restricted in some way to make it novel and inventive over the known therapy using such composition. According to the board, if the subject-matter of the claim avoided the method of treatment by therapy prohibited in Art. 52(4), first sentence, EPC 1973 as would be the case for a claim in the approved "Swiss" form, compliance with this provision did not need to be considered further, and certainly not in order to impose restrictions on the breadth of the claim.

The board argued that there was no interference with the freedom of the physician because the patent proprietor would have a remedy only against the maker of, or dealer in the composition. The fact that the marketing of pharmaceuticals was tightly controlled within the contracting states by the relevant control authorities meant, that for most pharmaceuticals, it could be established for what therapeutic treatment(s) they were

marketed. Allowing second medical use patents served to increase the possibility that someone would undertake the necessary research.

For these reasons, the board interpreted decision **G 5/83** (OJ 1985, 64) as allowing Swiss form claims directed to the use of a composition for manufacturing a medicament for a specified new and inventive therapeutic application, where the novelty of the application might lie only in the dose to be used or the manner of application. Swiss-type claims will no longer be possible (see **G 2/08** above).

c) Novelty based on the difference in the mode of administration

In **T 51/93** a European patent application relating to the use of human HCG for the manufacture of a medicament for subcutaneous administration was refused by the examining division because prior art document D(1) implicitly disclosed the subcutaneous administration, and because the subcutaneous administration of HCG was an obvious alternative to intramuscular administration. Document D(4) (cited by the board) disclosed vials for injection containing HCG and diluent, obtained by mixing HCG with a carrier and/or diluent. The only difference between the invention as claimed and the disclosure of D(4) was that the claim was directed to an intended method of **subcutaneous administration**. The claim was drafted in the form approved in decision **G 5/83** for claims where the novelty was solely that of the intended use, so the only question to arise was whether a difference in the mode of administration of a medicament could be treated as a new therapeutic use. The board, relying on **T 290/86**, observed that the mode of administration might be a critical factor in a medical treatment and no reason could be seen for any **a priori** bar to relying on this difference when distinguishing over the prior art. Rather, patentability should be treated as depending only on whether this modification was in fact novel and inventive. Thus, it was possible to acknowledge novelty over D(4) (see **T 143/94**, OJ 1996, 430).

d) Novelty based on a different technical effect

In decision **T 290/86** (OJ 1992, 414) the board had to give a ruling on the novelty of a claim drawn up in the form of a second medical use. The claim's subject-matter was the use of a lanthanum salt for the preparation of a composition intended to remove dental plaque (according to the patent proprietor, plaque removal had the effect of preventing caries). The closest prior art disclosed compositions comprising salts containing various elements, including lanthanum, to depress the solubility of tooth enamel in organic acids, and thus to inhibit tooth decay. The board considered the claimed invention new. The grounds for its decision were as follows: "When a prior document and a claimed invention are both concerned with a similar treatment of the human body for the same therapeutic purpose, the claimed invention represents a further medical indication as compared to the prior document within the meaning of decision **G 5/83** if it is based upon a different technical effect which is both new and inventive over the disclosure of the prior document". In this case the technical effect considered new was the removal of dental plaque, whereas the prior art only disclosed the depression of enamel solubility in organic acids (see also **T 542/96** and **T 509/04**). In **T 384/03**, however, the board distinguished the case from **T 290/86** in so far as both effects at issue - increase of

ocular blood flow and lowering of intraocular pressure - would simultaneously intervene when the described treatment took place. In contrast, the two technical effects shown in decision **T 290/86** were distinct and independent of each other.

e) Statement of purpose of surgical use for a known instrument

In **T 227/91** (OJ 1994, 491) the board held that the purpose of a surgical use alone could not render novel the subject-matter of a claim relating to the use of the components of a known instrument for its manufacture, i.e. assembly. The claim under consideration related to the "use" of intercepting of a laser beam of substrate means and coating means in the manufacture of a laser surgical instrument (the use). The indication of the purpose, i.e. intercepting the laser beam, was a characteristic of the surgical use of the instrument and did not affect the structure or composition of the entity itself. This kind of functional reference could not normally impart novelty to an otherwise known article unless the function implied a necessary modification of the article itself. The only exceptions so far recognised were based on Art. 54(5) EPC 1973 and on a new therapy for a known medicament whose manufacture was also characterised by the new use of the product (i.e. second or further therapeutic indication - **G 5/83**). However, the surgical use of an instrument was not analogous to a therapeutic use in the above-mentioned cases, since the instrument was not consumed in the application and could be used repeatedly for the same or even for other purposes.

f) Discovery of a previously unknown property of a compound underlying the known effect

In **T 254/93** (OJ 1998, 285) an application relating to the use of a retinoid compound in association with the use of corticosteroids in the prevention of skin atrophy was refused by the examining division.

The board noted that it was a basic consideration in **G 2/88** (OJ 1990, 93) that the recognition or discovery of a previously unknown property of a compound, such property providing a new technical effect, could involve a valuable and inventive contribution to the art. This was apparently the reason why the Enlarged Board of Appeal accepted that the use related to such a property could be regarded as a technical feature appropriate for establishing novelty. The board stated that it had no difficulty in accepting that the prevention of skin atrophy had to be regarded as a pharmaceutical feature and, following the conclusions of the Enlarged Board of Appeal, that the effect underlying this feature was not made available to the public in written form by any of the cited literature. Nevertheless, the question arose whether, in the case at issue, this effect was a technical effect within the meaning of decisions **G 2/88** and **G 6/88** (OJ 1990, 114), which was necessary to establish novelty, under Art. 54(1) EPC 1973, of the claimed subject-matter over the prior art. Although it concerned a specific aspect of the known use, the use specified in claim 1 (prevention of skin atrophy) was not actually different from the known use (treatment of dermatoses). The board observed that when a second medical indication was claimed in relation to the use of a constituent in the preparation of a known composition and the final effect was apparent in **using the known composition for the known purpose**, a technical problem could be seen neither in the

obtaining of the final effect nor in the preparation of the composition. The only remaining question could be the explanation of the phenomenon underlying the treatment according to the known process. However, the **mere explanation of an effect** obtained when using a compound in a known composition, even if the explanation related to a pharmaceutical effect which was not known to be due to that compound in the known composition, could not confer novelty on a known process if the skilled person was already aware of the occurrence of the desired effect when applying the known process (see also **T 669/01**).

Similarly, in **T 486/01** the physiological effects highlighted by the patent proprietor were only regarded as additional items of knowledge about a further mechanism of action underlying the known therapeutic application.

In **T 1001/01** the appellant had argued that decision **T 1020/03** (OJ 2007, 204) had concluded that the specification of the "route of administration" was always a novelty-bringing feature for second medical use claims in the "Swiss-type form". (See **G 2/08**, OJ 2010, ***, above for the position on Swiss-type claims under the EPC 2000.)

The board noted that the appellant's argument that said decision was cited in the Case Law of the Boards of Appeal of the EPO, fifth edition, 2006, as taking "a new approach to the concept of "new therapy" "(page 109 of the Case law report) was not relevant, since the comments on novelty in decision **T 1020/03**, in the absence of a conclusion by Board 3.3.04 on Art. 54 EPC 1973, could only be taken as obiter dicta. The board stated that in fact, the assessment of novelty remained a decision to be taken on a case-by-case basis after making a careful and detailed technical (and not only linguistic) analysis of the features appearing in a particular claim and when the relevant piece of prior art was read by the skilled person. Indeed, the conclusions reached at by decision **T 1020/03** were irrelevant for the claims on file, since the wording of the sets of claims serving as a basis for the present decision had not been challenged under Art. 52(4) EPC 1973 because they were medical use claims in an acceptable "Swiss-type form". (See **G 2/08**, OJ 2010, ***, above for the position on Swiss-type claims under the EPC 2000.)

In **T 385/07** Claim 1 was drafted in the form of a second/further medical use of aplidine for making a medicament for the treatment of a mammal affected by pancreatic cancer. The relevant issue under the law in force was whether or not this use related to a novel medical use within the meaning of decision **G 5/83** (OJ 1985, 64). The board found that, following decision **T 158/96**, the information in a citation that a medicament was undergoing a clinical phase evaluation for a specific therapeutic application was not prejudicial to the novelty of a claim directed to the same therapeutic application of the same medicament if the content of said citation did not allow any conclusion to be drawn with regard to the actual existence of a therapeutic effect or any pharmacological effect which directly and unambiguously underlay the claimed therapeutic application.

The board stated that failure in a patent application to provide a "new element" vis-à-vis the teaching of a prior art document may indeed lead to the lack of novelty of a claimed medical use (see e.g. decision **T 919/99** of 7 April 2003, points 7 and 22 to 24 of the Reasons). However, the board did not adhere to the examining division's view that the

present application had not really developed the subject-matter further compared to the teaching of document D1. Furthermore, it was true that the present application related to in vivo results in mice, not humans. However, it was an accepted principle of the case law that, for the purpose of patent protection of a medical application of a substance, a pharmacological effect or any other effect such as an effect observed on animal models was considered to provide sufficient evidence of a therapeutic application if, for the skilled person, this observed effect directly and unambiguously reflected such a therapeutic application (see e.g. **T 241/95**, OJ 2001, 103). Applying this principle, the board accepted in the case at issue that, in the absence of any data on human patients, the in vivo experiment was sufficiently predictive of the in vivo anti-tumor activity in humans.

In **T 1127/05** it needed to be determined under Art. 54(5) EPC whether the use of known organic compounds in the inhibition of alphanybeta3-mediated angiogenesis, as claimed, was such a specific use that was not comprised in the state of the art. The decision of the examining division had been based solely on the finding that the subject-matter of claim 1 lacked novelty over the disclosure in document (2). The examining division had argued that the application disclosed that the claimed compounds, which were known to be alphanybeta5 antagonists, were also inhibitors of alphanybeta3-mediated angiogenesis. Since the use of the compounds in the treatment of angiogenesis was known in the prior art, the mechanism by which said angiogenesis was inhibited, either by alphanybeta3 or alphanybeta5 receptors, (i.e. both known from document (2)) could not confer novelty on the claimed medical application.

The board noted that document (2) did not disclose, either explicitly or implicitly, the use of the organic mimetics for the inhibition of alphanybeta3-mediated angiogenesis. The achievement of this technical effect was, however, a technical feature of claim 1. The board could not concur with the finding of the examining division and noted that, in document (2) itself, it was not disclosed whether the process for the inhibition of angiogenesis, besides being alphanybeta5-mediated, was also alphanybeta3-mediated. The fact that the claimed compounds could block both angiogenesis pathways in the same tissue could inherently be disclosed in document (2). However, the board concluded that that alphanybeta3- and alphanybeta5-mediated angiogenesis were associated with different diseases. The claimed compounds in their application of alphanybeta3-mediated angiogenesis inhibitors opened up new areas of therapeutic treatment. In view of the above considerations and following principles established in decision **G 5/83** of the Enlarged Board of Appeal (OJ 1985, 64), the board concluded that the subject-matter of claim 1 was novel.

5.3. Second (or further) non-medical use

5.3.1 Novelty criteria for use claims and process claims containing a purpose feature

a) General issues decided before the Enlarged Board of Appeal

In general, the EPC allows both method claims and use claims, but whether any activity is claimed as a method of carrying out the activity (setting out a sequence of steps) or as

the use of a thing for a stated purpose (the sequence of steps being implied) is a matter of preference. For the Enlarged Board of Appeal there is no difference of substance (**G 5/83**, OJ 1985, 64).

Two referrals to the Enlarged Board raised the general issue of novelty of a second non-medical use which was not connected with the specific problems of use claims in the medical field.

In the non-medical field use claims are admissible and not subject to special conditions. In **T 231/85** (OJ 1989, 74) the board had to judge the novelty of a second non-medical use in a special constellation. It held that the fact that a substance was known could not preclude the novelty of a hitherto unknown use of that substance, even if the new use did not require any technical realisation other than that for a previously known use of the same substance. In the case in question the known use was use as a growth regulator and the new one, now claimed by the applicant, use as a fungicide. The technical realisation was in both cases the spraying of useful plants.

Later, the same board, with a different composition, referred to the Enlarged Board the question whether a claim for the use of a compound for a particular non-medical purpose was novel under Art. 54 EPC 1973, having regard to a prior publication which disclosed the use of that compound for a different non-medical purpose, so that the only novel feature in the claims was the purpose for which the compound was used. The specific problem in these cases was that the previously disclosed use of the substance, although specifically stated to be for another purpose, would **inherently** comprise the use as claimed in the new application (**T 59/87**, OJ 1988, 347; **T 208/88** of 20.7.1988).

In decisions **G 2/88** (OJ 1990, 93) and **G 6/88** (OJ 1990, 114), the Enlarged Board stated that the patentability of a second non-medical use of a product was already recognised in principle in **G 5/83** (OJ 1985, 64) which concerned the second medical use of a substance. However, in that earlier decision the exclusion from patentability of therapeutic and diagnostic methods had caused the Enlarged Board to allow only a special type of claim. These specific difficulties did not arise in the non-medical field; there the question was of a general nature, concerned primarily with the question of the interpretation of Art. 54(1) and Art. 54(2) EPC 1973. In **G 2/88** and **G 6/88**, therefore, it was pointed out that a claimed invention lacked novelty unless it included at least one **essential** technical feature which distinguished it from the state of the art. A basic initial consideration, when deciding upon the novelty of a claim, was therefore to analyse it in order to determine its technical features. The Enlarged Board took the view that the proper interpretation of a claim whose wording clearly defined a new use of a known compound would normally be such that the attaining of a new technical effect on which the new use was based was a technical feature of the claimed invention. Thus, where the particular technical effect underlying such use was described in the patent, the proper interpretation of that claim would require a functional feature to be implicitly contained in the claim as a technical feature - e.g. the compound actually achieved the particular effect.

Referring to the facts of **T 231/85** (see above) as an example, the Enlarged Board explained that the claim directed to the use of a substance (known as a growth regulator) as a fungicide implicitly included a **functional** technical feature, namely that the said substance when used in accordance with the described means of realisation in fact achieved the effect (i.e. performed the function) of controlling fungus. The claim should not be interpreted literally as only including by way of technical features "the substance" and "the means of realisation of the claimed purpose", but should in appropriate cases be interpreted as also including as a technical feature the function of achieving that purpose, because that was the **technical result**. When determining novelty the decisive question of what had been made available to the public was one of fact in each case. A line had to be drawn between what was in fact made available and what remained hidden or had not otherwise been made available. In that connection the distinction between lack of novelty and lack of inventive step also had to be emphasised: information equivalent to a claimed invention may be "made available" (lack of novelty), or it may not have been made available but is obvious (novel, but lack of inventive step), or was not made available and is not obvious (novel and inventive). Thus, in particular, what is hidden may still be obvious. Under Art. 54(2) EPC 1973 the question was not what might have been "inherent" in what was previously made available to the public under the Convention. Under the Convention, the hidden or secret use, because it had not been made available to the public, was not a ground of objection to the validity of a European patent. In that respect, the provisions of the Convention might differ from the earlier national laws of some contracting states, and even from the current national laws of some non-contracting states. Thus, the question of "inherency" did not arise as such under Art. 54 EPC 1973. Any vested right derived from prior use of an invention was a matter of national law.

The Enlarged Board thus concluded that, with respect to a claim to a new use of a known compound, such new use might reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a **functional technical feature** of the claim (e.g. the achievement in a particular context of that technical effect). Had that technical feature not previously been made available to the public by any of the means set out in Art. 54(2) EPC 1973, then the claimed invention was novel, even though such technical effect might have inherently taken place in the course of carrying out what had previously been made available to the public. The final decisions in cases **T 59/87** (OJ 1991, 561) and **T 208/88** (OJ 1992, 22) both held that the claimed use inventions were novel and inventive.

b) Non-therapeutic treatment of animals

In decision **T 582/88** the board applied the principles set out in decision **G 2/88** in slightly different circumstances. The invention's subject-matter was a method of non-therapeutic treatment of animals for the purpose of improving their milk production and comprising oral administration of a propionate-increasing amount of glycopeptide antibiotics. In the board's view the technical effect produced by the invention - in this case an improvement in milk production - was new and had to be construed as a new technical feature sufficient to make the invention novel. The claim's subject-matter was a method of non-

therapeutic treatment of animals, not - as in decision **G 2/88** - use of a known product to achieve a new effect.

c) Non-therapeutic use distinguishable from known therapeutic use

In **T 469/94** a European patent application on the basis of a set of claims directed to the protection of the second medical indication of choline or a choline derivative was refused by the examining division, because it considered that the known treatment with choline of muscle diseases and hardness was equivalent to, or even a synonym for, the treatment for reducing muscle fatigue which was claimed in the application in suit. In response to a communication from the board, the appellant filed a new set of claims having the form of the protection of the second non-therapeutic use of a product.

Examining the case, the board concluded that the ability of choline to reduce the perception of fatigue had not been made available to the public. The first use of choline, in the therapeutic field, was known from two prior art documents. The board held that an independent invention could be based on the newly discovered effect, if such an effect led to a new technical application which was clearly distinguishable from the previous known application. The prior art documents did indeed describe the use of choline on groups of patients having manifest diseases: either epilepsy or muscle diseases and injuries. Likewise, in the case of the prophylactic use of choline envisaged in a prior art document for muscle rheumatism or muscle troubles arising from thyroidal diseases, the prophylaxis did not appear to mean the prevention of the disease itself, but simply the prevention of the acute phase of a chronic disease. The board observed that fatigue arising from major exercise was not of a pathological nature, and that the performance itself of major exercise appeared to be quite incompatible with the situations envisaged in the prior art documents, specifically that of muscle injuries. The non-therapeutic use of choline according to the invention was therefore independent of, and distinguishable from, the known therapeutic use, because it was **directed to a distinct group of persons**. The subject-matter of the claim at issue was therefore found to be novel.

d) Novelty of a Swiss-type claim

In **T 292/04**, claim 1 of the patent referred to the use of a haloperoxidase in the manufacture of an antimicrobiological agent and was drawn up in the form of a Swiss-type claim. The agent was intended for use in methods which are referred to in Art. 52 (4) EPC 1973, but also in methods not referred to in this Article. One such use was its application as a contact lens formulation. The board emphasised that, in accordance with the principles of decision **G 5/83** (OJ 1985, 64), claim 1, in so far as it referred to the use of a haloperoxidase in the manufacture of an antimicrobial agent for use in a method falling outside the provisions of Art. 52(4) EPC 1973 could not derive novelty and inventive step from the allegedly newly discovered technical effect of selectively killing pathogenic bacteria. Rather, the claim, which was not restricted to a therapeutic use of the manufactured agent, had to be understood as referring to a process for the manufacture of a liquid antimicrobial agent. The appellants had argued that the prior art documents did not disclose this newly discovered technical effect described in the patent in suit. However, the board pointed out that the reasoning of

G 2/88 (OJ 1990, 93) did not apply as claim 1 was not directed to the new use of a known compound, but to the use of a known compound in the manufacture of an agent. This kind of claim was considered by the Enlarged Board of Appeal in decision **G 5/83** to be notionally novel only in a special case; namely where the intended purpose of the manufacture of the agent was the use of this agent in the treatment of the human or animal body by surgery or therapy or in a diagnostic method. (The Swiss-type claim is no longer necessary or possible in these circumstances under the revised EPC - see **G 2/08**, OJ 2010, ***, above.)

e) New use of functional feature in a known process

In **T 848/93** the application claimed a process which differed from the prior art only in its use (remelting instead of vapour phase soldering). The examining division had understood the claim to mean that the process claimed was suitable for the use described, and had considered that it lacked novelty because the process known in the prior art was also suitable for that use, even if this was not expressly stated.

The board did not agree - if a claim concerned e.g. an apparatus which differed from a known apparatus only as regards the use indicated, then the use was not an apparatus feature. This meant that the two pieces of apparatus were identical in terms of structure. If the known apparatus was suitable for the claimed use, the application lacked novelty. If the claim was directed to an object, a substance or a composition, the same applied. If however the claim was for a process, the situation was not comparable. In such a case, the use feature was a functional process feature comparable in category with the other features (steps) of the process. The teaching of **T 69/85** was therefore not applicable to the case before the board.

In **T 1049/99** the board took the view that the criteria set out in decisions **G 2/88** and **G 6/88** (OJ 1990, 93 and 114) could not simply be transferred to process claims. The board pointed out that, according to those decisions, a new purpose related to a new technical effect could render novel the claimed use of a product already known, even though the means of realisation making it possible to achieve the new purpose was identical to the known means of realisation, given that a use claim in reality defined the use of a particular physical entity to achieve an effect. The board distinguished this situation from that of a process claim which defined the use of a particular physical entity to achieve a product and, therefore, fell within the scope of Art. 64(2) EPC 1973. An extension of the criteria set out in the decisions of the Enlarged Board referred to above would result in protection of a product obtained by a process already known on the basis of the new effect discovered in the process itself, even though that process was identical to that already known (see also **T 910/98**).

In **T 1092/01** the claimed subject-matter consisted of a process with technical features encompassing those disclosed in prior art documents D2 and D3, but which was applied for a use not disclosed in these documents (isomerization of lutein to zeaxanthin). In more general terms, claim 1 related to a known process with which a previously unknown technical effect was achieved (yet which might have inherently occurred in the course of carrying out the process). The board applied the rationale of **G 2/88** (OJ 1990,

93) where the claim related to the use of a known compound, which use was based on a previously unknown technical effect of the known compound. Thus, according to the board, the question was whether a new effect which was brought about by known means could be found novel. The board concluded from **G 2/88** that, if the newly discovered effect led the skilled person to a new activity which was not connected with the means known before, such an effect could confer novelty on a claim which was directed to the new activity, i.e. a use or a process. If this was not so, novelty could not be acknowledged.

f) Claim directed to the use of a known process for a particular purpose

In **T 210/93** the originally claimed process for the production of a rubber product was held not to be novel by the examining division because the claimed temperature range was already disclosed in D1. With reference to **G 2/88** and **G 6/88**, the applicants thereupon claimed the use of this known process for the purpose of preparing the rubber product having a certain maximum ratio of constituent X. They argued that in the absence of a disclosure of this mole ratio in D1, this constituted a "specific technical purpose of achieving the previously unknown chemical structural arrangement". The board observed that decisions **G 2/88** and **G 6/88** related to claims to the use of a known compound for a particular purpose, in contrast to the appellants' claim, which was directed to the use of a known process for a particular purpose, the purpose being the preparation of a particular product naturally resulting from such process. In the board's view, the **use of a process for the purpose of preparing its product(s)** could be said to be nothing but that very same process, and the scope of protection appeared to be the same for a claim to the process as such and a claim to such use.

In **T 684/02** in the context of the issue of novelty of the subject-matter of the claims, reference was repeatedly made by both parties to decisions **G 2/88** and **G 6/88**. The board stated that the Enlarged Board of Appeal limited its orders in **G 2/88** and in **G 6/88** explicitly to "a claim to the use of a known compound" in which a technical effect should be interpreted as a functional technical feature. In the board's view, this left no room for further expansion of this ruling to claims worded otherwise.

The claims at issue were not, however, directed to the use of a chemical compound or chemical composition for a particular purpose, as considered by the Enlarged Board of Appeal in its above decisions. Instead, they were directed to the use of a process, a wording chosen by the applicant during the examination procedure. The board stated that this fact could not be disregarded or ignored. The board could not accept the opinion of Appellant 1, that the considerations in **G 2/88** and **G 6/88** would also be valid for the present claims to the use of a process, because by this process products would be obtained which showed the improved feature.

The board noted that Claim 1 was directed to the use of the fluorination reaction process in order to remove the unstable end groups from the starting polymer. The effect of this process manifested itself in its result, i.e. in the product together with all its internal characteristics and the consequences of its particular history of origin (see **T 119/82**; OJ 1984, 217, in particular point 11 of the Reasons), but not in an effect observed in a

particular use of the product. Moreover, in the board's view, a claim to the use of a process or to the process itself addressed the producer of a product, irrespective of any conceivable later applications, methods of further processing or uses of the product, whilst a claim to the use of a product clearly addressed the customer/user of that product. In other words, the asserted advantage or purpose could not be taken into account as a functional technical feature in Claim 1 because of the jurisprudence of the boards of appeal as well as for technical reasons, because the asserted advantage or purpose was related only to the product (manufactured in some process or other) when used in certain circumstances and marginal conditions. Finally, the board stated that it shared the view expressed in point 3.2.3 of the Reasons in **T 210/93** that the use of a process for a particular purpose was "nothing but that very same process". Consistent therewith, the board held that the request did not fulfil the requirements of Art. 52(1) and 54 EPC 1973.

In **T 1179/07** the board found that the central findings in **G 2/88** und **G 6/88** (see Headnote, point III) concerned a claim to the use of a known compound for a previously unknown purpose. No findings were made in those decisions with respect to process claims for a specific use. Although the "use of a compound" could be regarded as a process including the compound use as a procedural step, a use claim could not normally be treated as equivalent to a process claim because Art. 64(2) EPC was not, as a rule, applicable to use claims. According to the Enlarged Board in **G 2/88** (point 5.1 of the Reasons), Art. 64(2) EPC was generally not directed to patents whose claimed subject-matter was the use of a process to achieve an effect (this normally being the subject of a use claim) but rather to European patents whose claimed technical subject-matter was a process of manufacture of a product.

Despite the indicated purpose, the process claimed in this case was clearly aimed at manufacturing a product: a procedural treatment of the source product resulted in an end product differing from the source product. Were the board to extend the findings made in **G 2/88** and **G 6/88** to the granted process claim, this would confer fresh protection under Art. 64(2) EPC on the product resulting from granted process claim 1 even though that product was already known from D1 and obtained by precisely the same process as that described in D1. It could not, however, be in keeping with the object and purpose of Art. 64(2) EPC to extend its protection to a product obtained by a known process. It was, in particular, this difference in the treatment of process and use claims in the context of Art. 64(2) EPC which, in the board's view, left it no scope to extend the principles laid down by the Enlarged Board in **G 2/88** and **G 6/88** with regard to the use of a known compound for a previously unknown purpose to process claims (see also **T 684/02**, **T 910/98** and **T 1049/99**).

g) Discovery of new properties/technical effects underlying the known use

In **T 958/90** the board mentioned that a known effect could not be novel for the sole reason that the patent provided the information that it was present to a hitherto unknown extent.

In **T 279/93** a claim directed to the use of a first compound in a process for preparing a second compound was revoked by the opposition division for lack of novelty. In particular, the claims were directed to the use of the alkanolamines for reducing the formation of isomelamine impurities. According to the appellant, this purpose, even if it might have been inherently attained by following the teaching of a prior art document, should have rendered the subject matter of the claims novel, since, in application of the reasoning in decision **G 2/88** (OJ 1990, 93), inherency did not destroy the novelty of the new use, which had to be regarded as a functional technical feature of the claims.

In the board's judgment, the use of a compound in a process for preparing another compound in order to reduce the formation of impurities was not necessarily a functional technical feature within the meaning of decision **G 2/88**, and did not therefore in all circumstances confer novelty on the subject matter of a claim containing it. The facts of the case at issue differed significantly from those underlying decision **G 2/88**, since the claim did not appear to contain any new technical effect or technical purpose in the sense required by that decision. In the board's view, noticing that an old product had the property of containing fewer isomelamine impurities was a mere discovery. To convert this into a patentable invention, and to show the characteristics of a new technical effect, the use referred to in the claim would have to be some **new use of the product** which exploited the discovery that the isomelamine impurities were low for some new technical purpose. However, the patent in suit disclosed no such new use; it did not teach the skilled person to do something which would not have been done without knowing the content of the patent. The patent merely gave the person skilled in the art reasons for preferring one known product over other known ones for the uses for which it had already been suggested (see also **T 1855/06** concerning new use of a known substance).

In **T 892/94** (OJ 2000, 1) the board noted that according to **G 2/88** (OJ 1990, 93), novelty within the meaning of Art. 54(1) EPC 1973 could be acknowledged for a claim directed to the use of a known substance for a hitherto unknown, i.e. new, non-medical purpose reflecting a newly discovered technical effect. However, a newly discovered technical effect did not confer novelty on a claim directed to the use of a known substance for a known non-medical purpose if the newly discovered technical effect **already underlay the known use of the known substance**.

The disclosure in citation (1) was, in the board's judgment, prejudicial to the novelty of the claim in question. It was immaterial for the purposes of prejudice to novelty that the actual technical effect exhibited by "aromatic esters" in deodorising compositions was not described in the cited document. The ex post facto discovery that the deodorising effect of "aromatic esters" when used as an active ingredient in deodorising products could result from their capability of inhibiting esterase-producing micro-organisms might possibly be regarded as a (potentially surprising) piece of knowledge about the known use or application of such esters but could not confer novelty on a claim, since the latter would require that the newly discovered effect did indeed result in either a new technical application or use of the "aromatic esters", which was not necessarily correlated with the known application or use and could be clearly distinguished therefrom.

In **T 706/95** the board held that the discovery that the **same known means** led to an additional effect when they are used for the **same known purpose** (i.e. known use) of reducing the concentration of nitrogen oxides in the same effluent could not confer novelty on this known use (see also **T 934/04**).

In **T 189/95** the board ruled that a new property of a substance, i.e. a new technical effect, did not necessarily signal or give rise to a new use for that substance. For example, the new property might **merely explain the mechanism behind the use already described in the prior art**, as in **T 892/94** (OJ 2000, 1). Here again the board ruled that discovering a new property or activity did not in itself render novel a claim for the use of a known substance for a known non-medical use, if the discovery only showed what formed the basis of the known use of the known substance.

On the issue of the discovery of a previously unknown property of a compound underlying a known use, see further **T 1073/96**, referring to **T 254/93** (OJ 1998, 285). By contrast, it was found that there was a new use, e.g. in **T 319/98**, **T 952/99**, **T 966/00**, **T 326/02** and **T 1090/02**.

h) Use of a substance to achieve a technical effect only attained in special circumstances

In **T 977/02** the claim in suit was directed not to a device per se but to use of a specific component (an electric machine carcase) to attain a technical effect (to facilitate the recycling of the electric machine). Applying **G 2/88** (OJ 1990, 93) and **G 6/88** (OJ 1990, 114), the board held that a claim to the use of a component having a specific property (material that can be crushed into fragments) for a specific purpose (to facilitate the recycling of an electric machine) stated in the said claim and based on a technical effect described in the patent (flow of the material that can be crushed into fragments through the turns of the winding during recycling) should be interpreted as comprising a functional technical feature by virtue of that technical effect. According to the board, this was still valid when, as in the case before it, the technical effect was attained only in special circumstances (when the electric machine was recycled). The board also held that the choice of the specific material for manufacture of the carcase covered by the use defined by the claim in suit constituted a novel selection.

5.3.2 Statement of purpose in non-medical use claims in view of Article 52(4) EPC 1973

In **T 36/83** (OJ 1986, 295) the board stated that having discovered for the first time the surprising properties of a chemical product already known in the state of the art and having shown those properties in various uses, the applicant had the right to have those uses protected. In the particular case the uses were presented in the description as two methods; a method of medical treatment and a method of non-medical treatment. Under Art. 52(4) EPC 1973 a method of medical treatment was not patentable but a product for use in that method certainly was. Claims 1 to 7 had been worded accordingly. The method of non-medical treatment was one falling within the general field of patentable inventions. There could be no objection to the patentability of either use or method claims in general (see **G 5/83**, OJ 1985, 64). The applicants had chosen the phrase "**use**

as a cosmetic product of thenoyl peroxide". The board considered that this form of claim was **acceptable** in the case in suit. The board noted that when considering the exclusions from patentability under Art. 52(4) EPC 1973 the wording of the claim was important. In reaching this conclusion the board held the use of the word "cosmetic" in the context of that application to be sufficiently precise to exclude therapeutic uses, without the need for a specific disclaimer of such uses.

5.3.3 Novelty criteria for product claims with purpose characteristics

In **T 215/84** the board held that the discovery that the known equipment might be used in a new manner could not render the entity itself novel.

In **T 523/89** a particular prior art document disclosed a container having all the structural features defined in claim 1 of the contested patent. Hence, the only outstanding issue was the fact that D1 nowhere indicated that the container disclosed therein was intended to be used for ice-cream. The board noted that the question of anticipation of a claim to an article for a particular use was dealt with in the Guidelines, from which it was clear that, with the exception of medical uses of known substances, the indication of intended use was only to be seen as **limiting to the extent that the article had to be suitable for that use**. In other words, disclosure of an equivalent article without an indication of the particular use claimed - although the article was nevertheless suitable for it - would cause lack of novelty of a claim to the article for that particular use. The board saw no reason to disagree with this general principle of interpretation laid down in the Guidelines.

In decisions **T 303/90** and **T 401/90** the main claims related to a contraceptive composition comprising known pharmaceutical compounds. The board was of the opinion that the composition as claimed could not be considered novel and the added word "contraceptive" did not change the product claim into a use claim. **Only in the case of first medical use** could the addition of a purpose characteristic render a product claim new, if the product as such was known in other technical fields (see also **T 1200/03**).

In **T 15/91** the board ruled that, according to the case law of the boards of appeal, the discovery that known apparatus could be used in a manner not hitherto described did not substantiate the novelty of that apparatus, if the hitherto unknown use did not require any modification to the technical design of the known apparatus (see **T 523/89**).

In **T 637/92** the board held that, according to established case law, the statement of purpose of a claimed device (or product) was to be interpreted as meaning that the device was **suitable for the stated purpose** and that a known device that served another purpose but otherwise possessed all the features listed in the patent claim was not prejudicial to the novelty of the subject-matter of the claim if the known device was unsuitable for the purpose referred to in the claim (see also **T 287/86**). In the case in question, however, these conditions had not been met since the device known from the citation did not possess one of the features of claim 1.

D. Inventive step

1. Introduction

An invention shall be considered as involving an **inventive step** if, having regard to the **state of the art**, it is not **obvious** to a **person skilled in the art** (Art. 56, first sentence EPC, unchanged). The "state of the art" for the purposes of considering inventive step is as defined in Art. 54(2) EPC. As part of the EPC 2000 revision, Art. 56, first sentence EPC remained unchanged in the three official languages. A slight editorial change was made to the wording of Art. 56, second sentence, EPC in the English and French versions. It does not include later published European applications referred to in Art. 54(3) EPC (modified). Such earlier applications are part of the state of the art only when considering novelty and not when considering inventive step (for full details see Guidelines C-IV, 7.1 and 11.2 - April 2010 version).

Technical progress is not a requirement for patentability under the EPC. Therefore, technical progress shown in comparison with marketed products as an alleged support for inventive step cannot be a substitute for the demonstration of inventive step with regard to the relevant closest state of the art (see **T 181/82**, OJ 1984, 401; **T 164/83**, OJ 1987, 149; **T 317/88**, **T 385/94**).

The extent of the monopoly conferred by a patent should correspond to and be justified by the technical contribution to the art. This general principle of law, applied in **T 409/91** (OJ 1994, 653) and **T 435/91** (OJ 1995, 188) (albeit to determine the scope of protection justified under Art. 83 and Art. 84 EPC 1973), also applies to decisions under Art. 56 EPC 1973, because everything covered by a legally valid claim has to be inventive. Otherwise the claim has to be amended, by deleting anything obvious to ensure that the monopoly is justified (**T 939/92**, OJ 1996, 309; **T 930/94**, **T 795/93**, **T 714/97**).

2. Problem and solution approach

To assess inventive step, the boards normally apply the "problem and solution approach". This consists essentially of:

- (a) identifying the "closest prior art",
- (b) assessing the technical results (or effects) achieved by the claimed invention when compared with the "closest state of the art" established,
- (c) defining the technical problem to be solved as the object of the invention to achieve these results, and
- (d) examining whether or not a skilled person, having regard to the closest state of the art, would have suggested the claimed technical features in order to obtain the results achieved by the claimed invention (see also Guidelines, C-IV, 11.5 - April 2010 version).

The boards frequently cite R. 27(1)(c) EPC 1973 as the basis for the problem and solution approach. Under the EPC 2000, R. 27(1)(c) EPC 1973 has been renumbered as R. 42(1)(c) EPC. However, apart from a small editorial change in the wording of the English version, the rule has remained unchanged in substance. R. 42(1)(c) EPC requires that the invention be disclosed in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood. Problem and solution are thus component parts of any technical invention. The problem and solution approach was primarily developed to ensure objective assessment of inventive step and avoid ex post facto analysis of the prior art.

According to board of appeal case law (see **T 1/80**, OJ 1981, 206; **T 20/81**, OJ 1982, 217; **T 24/81**, OJ 1983, 133; **T 248/85**, OJ 1986, 261), the assessment of inventive step has to be based on the objective, not subjective, achievement of the inventor. By starting out from the objectively prevailing state of the art, the technical problem is to be determined on the basis of objective criteria and consideration given to whether or not the disclosed solution is obvious to the skilled person. Although the problem and solution approach is not mandatory, its correct application facilitates the objective assessment of inventive step. The correct use of the problem and solution approach rules out an **ex post facto analysis** which inadmissibly makes use of knowledge of the invention (**T 564/89**, **T 645/92**, **T 795/93**, **T 730/96** and **T 631/00**). In principle, therefore, the problem and solution approach is to be used; however, if exceptionally some other method is adopted, the reasons for departing from this generally approved approach should be stated.

In **T 967/97** the board stated that the problem and solution approach was essentially based on actual knowledge of technical problems and ways to solve them technically that the skilled person would, at the priority date, be expected to possess objectively, i.e. without being aware of the patent application and the invention that it concerned. If the skilled person had a choice of several workable solutions that might suggest the invention, the rationale of the problem and solution approach required that the invention be assessed relative to all these possible solutions before any decision **confirming** inventive step was taken. To **deny** inventive step, no special grounds had to be given for a pre-selection of prior-art citations, even if several workable solutions were available to the skilled person; the statement of grounds merely served to show that the invention was obvious to the skilled person from the prior art in relation to (at least) one of these solutions (see also **T 558/00**, **T 970/00**, **T 172/03**, **T 323/03**).

In **T 465/92** (OJ 1996, 32) the board did not take the problem and solution approach when assessing inventive step, and said this was merely one possible approach, with advantages and drawbacks. This, however, is a one-off decision.

3. Closest prior art

3.1. Determination of closest prior art in general

In accordance with the problem and solution approach, the boards have developed certain criteria for identifying the closest prior art to be treated as a starting point. After

the relevant prior art has been identified, careful consideration must be given to the question whether, in the case concerned, the skilled person, taking into account all the available information on the technical context of the claimed invention, would have had good reason to take this prior art as the starting point for further development. The term "state of the art" in Art. 54 EPC 1973 should be understood as "state of technology", and "everything" in Art. 54(2) EPC 1973 is to be understood as concerning the information which is relevant to a field of technology (**T 172/03**).

The boards have repeatedly pointed out that the closest prior art for assessing inventive step is normally a prior art document disclosing subject-matter conceived for the same purpose or aiming at the same objective as the claimed invention and having the most relevant technical features in common, i.e. requiring the minimum of structural modifications (**T 606/89**, **T 686/91**, **T 834/91**, **T 482/92**, **T 298/93**, **T 380/93**, **T 59/96**, **T 730/96**, **T 650/01**). A further criterion for the selection of the most promising starting point is the similarity of technical problem (see **T 495/91**, **T 570/91**, **T 439/92**, **T 989/93**, **T 1203/97**, **T 263/99**). The determination of the closest prior art is therefore an objective and not a subjective exercise. It is made on the basis of the notional skilled man's objective comparison of the subject-matter, objectives and features of the various items of prior art leading to the identification of one such item as the closest (**T 1212/01**).

In **T 1464/05** the board considered the features rendered available to the public by a public prior use as the closest state of the art (see also below point 7.1.1, skilled person).

The closest prior art must be assessed from the skilled person's point of view on the day before the filing or priority date valid for the claimed invention (**T 24/81**, OJ 1983, 133; **T 772/94**, **T 971/95**, Guidelines C-IV, 11.5.1 - April 2010 version).

3.2. Same purpose or effect

In selecting the closest prior art, the first consideration is that it must be directed to the same purpose or effect as the invention. Otherwise, it cannot lead the skilled person in an obvious way to the claimed invention. According to **T 606/89** the closest prior art for the purpose of objectively assessing inventive step was generally that which corresponded to a **similar use** requiring the minimum of structural and functional modifications (see **T 574/88**, **T 834/91**, **T 897/92**, **T 380/93**, **T 1040/93** and **T 795/93**). In **T 273/92** the board of appeal confirmed the established case law of the boards, according to which a document could not qualify as the closest prior art to an invention merely because of similarity in the composition of the products; its suitability for the desired use of the invention also had to be described (see also **T 327/92**). According to **T 506/95**, the closest prior art was therefore that most suitable for the purpose claimed by the invention, not that superficially showing structural similarities with the solution as claimed. Ideally, that purpose or objective should be something already mentioned in the prior art document as a goal worth achieving (**T 298/93**, **T 859/03**). The aim was that the assessment process should start from a situation as close as possible in reality to that encountered by the inventor. The real-world circumstances had to be taken into account. If it was not clear from this criterion what the closest prior art was, the problem and

solution approach should be repeated taking possible alternative starting points (**T 710/97**, **T 903/04**).

In **T 176/89** the board concluded that the closest prior art comprised two documents in combination with each other. It found that, **exceptionally**, the two documents had to be read in conjunction; they had the same patentee, largely the same inventors, and clearly related to the same set of tests. As a rule, however, when assessing inventive step, two documents should not be combined if, in the circumstances, their teaching is clearly contradictory (see also **T 487/95**).

3.3. Similarity of the technical problem

A document serving as the starting point for evaluating the inventive merits of an invention should relate to the same or a similar technical problem or, at least, to the same or a closely related technical field as the patent in suit (**T 989/93**, **T 1203/97**, **T 263/99**).

In **T 439/92** (dividing wall for a corner or circular shower) the board pointed out that although there was freedom in the choice of the starting point on which an objection of lack of inventive step was based, there were certain criteria that should be adhered to if the prior art chosen was to be the closest. One such criterion was the problem already stated in the patent. Clearly in many cases it was reasonable for there to be a link between this problem and the prior art chosen as being closest (**T 495/91**, **T 570/91**).

In **T 325/93** the application related to an epoxy resin dispersion which provided a cured resin with improved impact resistance. The board stated that the problem addressed by the application was neither derivable nor indeed recognisable from the disclosure of D2 relating to compositions having a low coefficient of friction and which, according to the department of first instance and the appellant, represented the closest prior art. As early as **T 686/91**, another board had observed that a document not mentioning a technical problem which is at least related to that derivable from the patent specification does not normally qualify as the closest prior art for inventive step purposes, however many technical features it may have in common with the subject-matter of the patent concerned (see also **T 410/93**, **T 708/96**, **T 59/96**, **T 979/00** and **T 496/02**). In **T 644/97** the board concluded that a technical problem arising from a "closest prior art" disclosure which was irrelevant to the claimed subject-matter (in the sense that it did not mention a problem that was at least related to that derivable from the patent specification) had a form such that its solution could practically never be obvious, because any attempt by the skilled person to establish a chain of considerations leading in an obvious way to the claimed subject-matter was bound to fail. It followed that the respective claimed subject-matter was non-obvious in the light of such art (see also **T 792/97** and **T 599/03**).

In **T 835/00** D1, which the opposition division considered the closest prior art, did not mention any of the problem aspects addressed by the claimed invention. As a consequence, a technical problem was created which was unrelated to the actual disclosure of D1 but whose solution was then found to be obvious in the light of the disclosure of D2. The board referred to **T 686/91** and stated that it was a fatal defect that

a prior art disclosure from which no relevant technical problem could be formulated without inappropriate hindsight had been chosen as a starting point for the application of the problem and solution approach, because without such hindsight any attempt to establish a logical chain of considerations which might lead to the claimed invention inevitably ran into difficulties at the start, for want of a relevant identifiable goal or object. If the relevant problem was not derivable from the alleged closest prior art, the measures for its solution were a fortiori not derivable. In other words, the invention was not obvious in the light of such art (see also **T 548/03**).

3.4. Most promising springboard

T 254/86 (OJ 1989, 115) described the objectively closest prior art as the "most promising springboard" towards the invention which was available to the skilled person (see also **T 282/90**, **T 70/95**, **T 644/97**).

Where several cited documents all belonged to the same technical field as the claimed invention, the closest prior art was the one which on the filing date would most easily have enabled the skilled person to make the invention (**T 656/90**).

According to **T 870/96**, when trying to evaluate a skilled person's capabilities and behaviour in the problem and solution approach, as closest prior art a "bridgehead" position should be selected, which said skilled person would have **realistically** taken under the "circumstances" of the claimed invention insofar as these circumstances can be retrieved in one item of the prior art. Consequently, among these "circumstances", aspects such as the designation of the subject matter of the invention, the formulation of the original problem and the intended use and the effects to be obtained should generally be given more weight than the maximum number of identical technical features (see also **T 66/97**).

In **T 824/05** the board was faced with the situation of two alternative starting points equally suitable for the assessment of inventive step, whereby one starting point, i.e. D11, lead to the conclusion that the claimed subject-matter was obvious and the other starting point, i.e. D1, gave exactly the opposite result. The board held that in this situation D1 did not qualify as the closest state of the art because it did not represent the most promising springboard towards the invention.

3.5. Selection of most promising starting point

Some decisions explained how to ascertain the closest prior art which constituted the easiest route for the skilled person to arrive at the claimed solution or the most promising starting point for an obvious development leading to the claimed invention. The starting point for the assessment of inventive step should be one which is at least "promising", in the sense that there was some probability of a skilled person arriving at the claimed invention.

In **T 211/01** the board stated that, quite apart from the fact that a skilled person would normally not consider an obviously defective disclosure at all, it would in particular be

artificial to select a defective disclosure as a starting point for evaluating inventive step, when there exists other prior art which is not doubted with regard to its disclosure, but is also directed to the same purpose or effect as the patent in suit. Thus, a document which is so obviously defective as to be readily recognised as such by those skilled in the art when trying to reproduce its disclosure cannot be taken as the most promising and appropriate starting point for the assessment of inventive step.

In **T 570/91** the board emphasised that although a person skilled in the art was completely free in choosing a starting point, he would of course be bound afterwards by that choice. If, for instance, the skilled person preferred and decided to start from a specific compressor piston, he could further develop that piston but at the end of that development the normal result would still be a compressor piston and not an internal combustion engine piston. In **T 439/92** it was explained that a conscious choice of starting point, made in the knowledge of the respective benefits and drawbacks of the various types concerned, not only determined the subject-matter serving as a starting point but also defined the framework for further development, i.e. a further development within this particular type. A change of type during the further development of the consciously chosen type, to another type, which was previously known but had not been chosen, could then only be seen as the result of an ex-post-facto analysis (see also **T 1040/93**, **T 35/95**, **T 739/95**, **T 255/03**). It is unlikely, and normally not obvious, for the invention type originally chosen to be changed during development (**T 817/94**). A generically different document cannot normally be considered as a realistic starting point for the assessment of inventive step (**T 870/96**, **T 1105/92**, **T 464/98**).

In **T 487/95** the board chose a military protective helmet as the closest prior art, pointing out, however, that this did not mean that documents describing protective helmets of a different kind (such as workers' safety helmets) could not be said to form part of the knowledge of a person skilled in the art. In this case, adopting the problem and solution approach, the information contained in the patent which related to a known military protective helmet (D9) represented the **primary** source of information, i.e. the most promising point of departure, from which the skilled person would attempt to arrive at the claimed subject-matter. The other documents could, however, represent important **secondary** sources of information (in this case: workers' safety helmets) from which the skilled practitioner could obtain indications and suggestions with regard to the problem being addressed.

However, when applying these principles, care must be taken to avoid an ex-post-facto-approach. A skilled person endeavouring to arrive at a simple construction is unlikely to begin by using prior art relating to an exceptional embodiment with a complex mechanism, and then to omit this mechanism from the invention (**T 871/94**).

In **T 211/06** the original application was a PCT application. The examining division used as a starting point for the assessment of inventive step background art indicated in the application, which according to the applicant comprised confidential information. The board stated that such background art meant publicly available art at the priority date, and not some internal prior art known only within the company employing the inventors. Disclosure in the application as filed which turns out on the available evidence not to be

prior art under Art. 54(2) EPC 1973 cannot be used as a starting point for assessing inventive step, nor can subjective "laboratory practice" put forward by the examining division without any objective evidence that this was knowledge available to the public be used as a starting point for assessing inventive step.

3.6. Improvement of a production process for a known product

With a prior art not directed to the same purpose as starting point, any attempt to establish a logical chain of thought which could lead to the claimed invention, inevitably gets stuck from the outset. In particular, where the background to the invention lies in difficulties encountered in known processes for preparing known compounds. Where the invention concerned improving a process to manufacture a known chemical compound, then the closest prior art was confined to documents describing that compound and its manufacture. Comparison with these alone would show whether an improvement had been achieved which could thus be taken into account in formulating the problem the invention sought to solve (**T 641/89, T 961/96, T 713/97, T 948/01, T 833/02, T 339/03**). In the case of inventions concerning a special process for use with a particular chemical substance having necessarily specific characteristics, determining the closest prior art must involve, above all, considering only those documents which describe a generically corresponding process for using precisely this particular chemical substance with its specific characteristics (**T 1285/01, T 354/03**). This accurately and objectively reflects the actual situation in which the skilled person found himself on the priority date of the contested patent (**T 793/97**).

The above considerations regarding the closest prior art also apply to production processes for subject-matter other than a chemical compound. In **T 325/97** the patent related to a method for manufacturing a device for controlled delivery of nicotine from an adhesive reservoir. In **T 373/94** the board also applied the principles and conclusions laid down in **T 641/89** where the invention related to the improvement of a manufacturing process for prefilled plastic syringes.

3.7. Old prior art documents as closest prior art

Some decisions concerned determining the closest art by taking old prior publications as a realistic starting point for identifying the technical problem to be solved. In principle, any document that is state of the art under Art. 54(2) EPC 1973 may be a candidate for the closest prior art. The jurisprudence acknowledges, however, some cases where a document may not be a realistic starting point because it either relates to outdated technology, and/or is associated with such well known disadvantages that the skilled person would not even consider trying to improve on it. However, a document's age as such is not a ground for excluding it as closest prior art and as a starting point for the assessment of inventive step (**T 1408/04**).

In **T 1019/99** the board did not judge that a document, published only five years before the priority date of the patent, in any way represented outdated technology, even in a fast moving area such as digital image processing. With regard to the status of the document as an isolated document and the fact that it did not receive any attention after

its publication, the board agreed with the respondent that there may be various unknown technical or economic reasons preventing an otherwise promising approach from being adopted rapidly after its early publication. However, a period of five years does not appear to be excessive, in particular taking into account the time actually needed to implement and evaluate the prior art teaching.

In **T 334/92** the board held that a document that had been disregarded for more than 20 years by those skilled in the art, had never been used during that period as a basis for further development, was moreover completely silent about the extent of the indicated activity and, finally, did not even mention, let alone discuss, the relevant state of the art, so that the skilled person was not in a position to recognise any technical advantage of these compounds in respect of that state of the art, did not represent the closest state of the art and could not therefore be used to define a realistic technical problem. However, in **T 964/92**, filed as a divisional application to **T 334/92**, the board held that the same document could be considered as a realistic starting point for the determination of the relevant technical problem. The board stated that in **T 334/92** the technical problem that was solved should be seen as the provision of further chemical compounds which were more active in the treatment of angina pectoris than the known compounds and less toxic. In contrast, in **T 964/92** the skilled person set out to seek no more than alternatives to known compounds described as medicaments for treating angina pectoris. Therefore, the board held that the skilled person would consider any compound or group of compounds belonging to the state of the art, and known to have the desired activity, as a suitable starting point. In such a case the length of time for which this document had been available to the public was irrelevant.

In **T 1000/92** the board did not agree to the selection of document (1) as the closest state of the art because the disadvantages of the process described in document (1), which had been published about 30 years before the priority date of the application, were so evident and well-known that a skilled person would not have tried to improve and develop such an old process (see also **T 616/93**).

In the further decision **T 479/00** the board did not regard a 65-year-old document as a realistic starting point for the evaluation of inventive step. It was unrealistic to assume that, without hindsight, somebody of average skill in the art of colouring ceramic articles in 1994 would have had the intention to improve a technique which had not received any attention during the previous 65 years. Furthermore, the teaching of this document, published in 1929, had never been put into practice on a commercial scale.

In **T 153/97** it was stated that there was no plausible reason why the skilled person should have disregarded a document only because the publication date lay 30 years in the past.

T 69/94 also pointed out that Art. 54(2) EPC 1973 defined the state of the art as comprising everything made available to the public, clearly without any time restriction. Thus a document which related to an antiquated technology no longer used in industry comprising a teaching disapproved by those skilled in the art at the filing date of the

patent in suit could not simply be disregarded as the closest prior art only because of its publication date about 20 years before the filing date of the application documents.

In **T 113/00** the board pointed out that resurrecting very old teaching (in the present case 31 years old) with an obvious modification did not make known subject-matter inventive.

4. Technical problem

4.1. Determination of the technical problem

R. 42(1)(c) EPC (former R. 27(1)(c) EPC 1973, wording aligned) stipulates that an application's description must "disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effect of the invention with reference to the background art". As long ago as **T 26/81** (OJ 1982, 211), R. 27(1)(c) EPC 1973 was recognised as clearly binding. The boards' case law, and correct application of the problem and solution approach (see **T 1/80**, OJ 1981, 206; **T 24/81**, OJ 1983, 133), show that objective criteria must be used to determine the technical problem, i.e. the problem which can be seen to have been actually solved in the light of the closest prior art which may be different from the prior art which was at the disposal of the inventor (**T 576/95**). These objective criteria may be specifically defined by assessing the technical progress made in the subject-matter of the application against the closest prior art (**T 20/81**, OJ 1982, 217; **T 910/90**). A comparison of the problem indicated in the application with that indicated in a prior document must avoid an unduly abstract approach far removed from the practical thinking of the person skilled in the art (**T 5/81**, OJ 1982, 249).

In identifying the problem it is not permissible to draw on knowledge acquired only after the date of filing or priority. According to **T 268/89** (OJ 1994, 50) the non-effectiveness of a prior art apparatus or method recognised or alleged only after the priority or filing date could not be drawn on in **formulating the problem**, particularly where that problem was adduced in support of inventive step in a "problem invention" (see **T 2/83**, OJ 1984, 265). Inventive step had to be assessed on the basis of the skilled person's knowledge before the priority or filing date (see also **T 365/89**).

For the purpose of the problem and solution approach, the problem must be a technical one that a skilled person in the particular technical field might be asked to solve at the priority date. The technical problem may be formulated using an aim which is to be achieved in a non-technical field, and which is thus not part of the technical contribution provided by the invention to the prior art (**T 641/00**, OJ 2003, 352; **T 154/04**, OJ 2008, 46); see also below point 8.1, treatment of technical and non-technical features.

4.2. Alleged advantages

According to the case law of the boards of appeal, alleged advantages to which the patent proprietor/ applicant merely refers, without offering sufficient evidence to support the comparison with the closest prior art, cannot be taken into consideration in determining the problem underlying the invention and therefore in assessing inventive

step (see **T 20/81**, OJ 1982, 217; **T 181/82**, OJ 1984, 401; **T 124/84**, **T 152/93**, **T 912/94**, **T 284/96**, **T 325/97**, **T 1051/97**).

In **T 355/97** the patent related to an improved hydrogenation process for preparing 4-aminophenol. The technical problem as indicated in the patent in suit consisted of improving the performance index of the preparation process without loss of selectivity. The patent proprietor, however, did not demonstrate properly that the purported advantages, i.e. improvement of the performance index without loss of selectivity, of the claimed invention had successfully been achieved. The board referred to the above mentioned jurisprudence and held that, since the alleged advantages lacked the required adequate support, the technical problem needed reformulation. Therefore, the objective problem could only be seen as merely providing a further method for preparing 4-aminophenol (see also **T 1213/03**).

4.3. Formulation of the technical problem

4.3.1 No pointers to the solution

According to decisions **T 229/85** (OJ 1987, 237) and **T 99/85** (OJ 1987, 413) the technical problem addressed by an invention had to be formulated in such a way that it did not contain pointers to the solution or partially anticipate the solution, since including part of a solution offered by an invention in the statement of the problem necessarily had to result in an ex post facto view being taken of inventive step when the state of the art was assessed in terms of that problem (**T 322/86**, **T 184/89**, **T 289/91**, OJ 1994, 649; **T 957/92**, **T 422/93**, OJ 1997, 24; **T 986/96**, **T 313/97**, **T 799/02**).

In **T 1019/99** the board added that this approach constrains the specificity of the formulation. However, there is also a constraint on the extent to which the formulation can "back off" from this specificity, i.e. a constraint on the generality of the problem. The problem can be no more general than the disclosure of the prior art allows. Otherwise, a problem could be formulated so generally as to circumvent indications in a prior art document towards the claimed solution. Thus the correct procedure for formulating the problem is to choose a problem based on the technical effect of exactly those features distinguishing the claim from the prior art that is as specific as possible without containing elements or pointers to the solution.

In **T 910/90** the board stated that, when assessing the objective problem, the closest prior art and any technical advance achieved by the characterising features of the invention had to be taken into account. In so doing, it was not important whether this problem had already been mentioned in the closest prior art; what mattered was what the skilled person objectively recognised as the problem when comparing the closest prior art with the invention.

4.3.2 Problem formulated in the patent application as starting point

Furthermore it had to be considered that an objective definition of the problem to be solved by the invention should normally **start from** the problem described in the

contested patent. Only if examination showed that the problem disclosed had not been solved or if inappropriate prior art were used to define the problem, was it necessary to investigate which other problem objectively existed. The definition of **artificial and technically unrealistic problems** was to be avoided (see **T 246/91**, **T 495/91**, **T 731/91**, **T 741/91**, **T 334/92**, **T 881/92**, **T 380/93**, **T 813/93**, **T 68/95**, **T 644/97**, **T 747/97** and **T 946/00**). This legal principle is also applicable to ex parte proceedings (**T 881/92**, **T 882/92**, **T 884/92**). In **T 419/93** it was added that, when determining the problem, the statements relating thereto in the application should be examined for **correctness** with regard to the prior art and for their **de facto relevance** to the claimed features of the solution. Only if the problem described in the application did not meet prior art requirements and/or was not solved in accordance with the features of the invention, should it be adapted to the prior art and/or actual technical success. In this connection, **T 800/91** emphasised that in any event the formulated problem should be one which the skilled person knowing only the prior art would wish to solve. It should not be tendentiously formulated in a way that unfairly directed development towards the claimed solution. In **T 400/98**, the technical problem set out in the patent at issue had to be reformulated because it had not been credibly solved.

4.3.3 Formulation of partial problems - lack of unity

In **T 314/99** the three different embodiments which were covered by claim 1 did not belong to the same single general inventive concept (Art. 82 EPC 1973). According to **G 1/91** (OJ 1992, 253) lack of unity is not an issue in opposition (or opposition appeal) proceedings. In the case in point the board stated that the consequence of this conceptual lack of unity is that different aspects of the problem apply to the three embodiments and that where conceptual non-unity arises between different embodiments covered by a claim, this may necessitate the formulation of corresponding partial problems, the respective solutions of which must be assessed separately for inventive step. With respect to the requirements of Art. 56 EPC 1973 the inventiveness of the subject-matter of a claim must be denied as a whole in the event that only one of its embodiments is obvious.

4.4. Reformulation of the technical problem

It is established case law that an applicant or patentee may restate the specific problem set out in the description if, in particular, the objective assessment of inventive step draws on newly introduced prior art which is closer to the invention than that cited in the original application or granted patent. To this end, the technical effects achieved by the claimed invention when compared with the (new) closest prior art are assessed to define the new objective technical problem. As a matter of principle, any effect provided by the invention may be used as a basis for reformulating the technical problem, as long as that effect is derivable from the application as filed (see Guidelines, IV-C, 11.5.2, April 2010 version).

In **T 184/82** (OJ 1984, 261) the board said that "regarding the effect of the invention" reformulation of the problem could be allowed "provided the skilled man could recognise the same as implied or related to the problem initially suggested". The problem may thus

be restated to meet a less ambitious objective (see also **T 106/91**, **T 339/96**, **T 767/02**). It was also ruled in **T 13/84** (OJ 1986, 253) that a reformulation of the problem was not precluded by Art. 123(2) EPC 1973 if the problem could be deduced by the skilled person from the application as filed when considered in the light of the closest prior art (**T 469/90**, **T 530/90**, **T 547/90**, **T 375/93**, **T 687/94**, **T 845/02**). In **T 818/93** the board added that it sufficed if the reformulated problem could be deduced later by comparing the application with the closest art. Since features from the drawings might be incorporated into the claims, and also into the description in support of the claims (**T 169/83**, OJ 1985, 193), those features' effects and advantages might also be used as a basis for reformulating the problem, provided this problem could clearly be deduced from the above comparison. **T 162/86** (OJ 1988, 452) added that it should still be possible in appeal proceedings to define the original problem more precisely, within the limits of the original description.

According to **T 39/93** (OJ 1997, 134), the technical problem as originally presented in the application or patent in suit, which was to be regarded as the "subjective" technical problem, might require reformulation on the basis of objectively more relevant elements originally not taken into account by the applicant or patentee. This reformulation defined the "objective" technical problem. The latter represented the problem ultimately remaining, i.e. the technical effect achieved by the subject-matter (features) as defined in the claim.

In **T 564/89** the appellant submitted that any amendment of the technical problem had to be in line with Art. 123(2) EPC 1973. The board stated that this article was not concerned with the issue of whether or not an objectively reformulated technical problem could be used in the course of the so-called problem-solution approach. Art. 123(2) EPC 1973 would only come into play if an amended technical problem were incorporated into the description itself.

In **T 732/89** the respondent submitted that the "hot/wet" performance of the claimed composites, although admittedly better than that of the control composition, corresponded to a completely new effect which could not be incorporated into the technical problem without contravening Art. 123(2) EPC 1973. The board did not agree with this line of argumentation and referred to **T 184/82** (OJ 1984, 261) where a redefinition of the problem regarding the effect of an invention was allowed provided that the skilled person could recognise the same as implied or related to the problem initially suggested. In the case in point the board took the demonstrated effect into account in the formulation of the technical problem and stated that in determining which effect was crucial and which was merely accidental (the so-called "bonus effect"), a realistic approach had to be taken, considering the relative technical and practical importance of those effects in the circumstances of a given case (see also **T 227/89**).

In **T 440/91** the board pointed out that R. 27 EPC 1973 did not rule out the possibility of additional advantages - not themselves mentioned in the application as filed but relating to a mentioned field of use - being furnished subsequently in support of patentability for the purposes of Art. 52(1) EPC 1973, as such advantages did not alter the character of the invention. Thus, the character of the invention was not altered if the technical

problem specified in the application as filed was supplemented by such advantages, since the skilled person might consider them on account of their close technical relationship to the original problem (see also **T 1062/93**). The board made a distinction with regard to the situation in **T 386/89** and **T 344/89**, where there was no such technical relationship. In **T 386/89** the board had found that the solution to the technical problem derivable from the application as filed was in no way associated with a technical effect subsequently invoked. This additional effect had thus not been taken into consideration. The alleged effect of a described feature could not be taken into account when determining the problem underlying the invention for the purpose of assessing inventive step, if it could not be deduced by the skilled person from the application as filed considered in relation to the closest prior art. Similarly in **T 344/89**, the board had refused to take account of a subsequently invoked technical effect on the grounds that to do so would have altered the character of the invention (**T 532/00**, **T 845/02**).

In **T 235/04** the comparative test report did not allow any conclusion as to whether the technical benefits of the claimed composition vis à vis the closest prior art were achieved within the whole scope of claim 1. The board did not accept the formulation of the technical problem since the purported improvement had not been demonstrated to arise within the whole area that was claimed. When defining the technical problem, an effect cannot be retained if the promised result is not attainable throughout the entire range covered by the claimed subject matter. Therefore, the technical problem needed to be redefined in a less ambitious way (**T 626/90**, **T 1057/04**, **T 824/07**).

In **T 259/05** too the board held the claimed improvement to be unproven; it had not been substantiated by tests or plausibly shown in any other way. The ambitious problem formulated could therefore not be considered successfully solved. So the invention as defined in claim 1 was not a successful solution to that technical problem. As a result, the claimed improvement in the method's efficiency could not be taken into account for assessing the objective problem which the patent in suit sought to solve, or the inventiveness involved. The technical problem therefore had to be reformulated less ambitiously.

In **T 1188/00** the board found that a reformulation relating to an effect first alleged in appeal proceedings (a more ambitious problem) could not be used to substantiate inventive step unless it was plausibly demonstrated that the alleged effect could be achieved across the whole scope of the claim. The burden of proof for this lay with the proprietor.

In **T 134/00** the available experimental evidence supported the presence of an effect only for a specific combination and not for all the possible combinations of components encompassed by claim 1. The board concluded that the alleged improvement had to be disregarded in defining the technical problem underlying the claimed invention. Therefore, reformulation of the technical problem in less ambitious terms was necessary.

Also in **T 357/02** the technical problem had to be reformulated in a less ambitious manner. In the board's view it followed from the minimalist character of the technical problem objectively arising from the closest prior art, which can only be formulated as a

modification of that state of the art, regardless of a success or failure of the measures applied, that almost any modification of the latter process might be regarded as a feasible alternative by the person skilled in the relevant art, and therefore obvious, since each corresponding solution would be equally useful (or useless).

Another aspect was described in **T 155/85** (OJ 1988, 87). According to this decision, it was not acceptable to rely on an effect which had previously been described as undesirable and of no value by the applicant, to present it suddenly as possibly representing an advantage from another point of view, and thereby to imply that the technical problem and the considerations of inventive step should take this reversal into account. A redefinition of the technical problem should not contradict earlier statements in the application about the general purpose and character of the invention (see also **T 115/89**).

4.5. Alternative solution to a known problem

In **T 92/92** the board noted that Art. 56 EPC 1973 did not require that the problem to be solved should be novel in itself. The fact that the underlying problem of the patent had already been solved by the prior art did not necessarily require redefinition of the problem for the assessment of inventive step, if the subject-matter of the patent represented an alternative solution to this problem. In this context the board referred in particular to decision **T 495/91**. In this case too, the problem stated in the patent specification had already been solved. The problem to be objectively solved was the provision of an alternative process and of apparatus which made it possible to produce a floor covering with specific properties by simple and low-cost means (see also **T 780/94**, **T 1074/93**, **T 323/03**, **T 824/05**).

According to **T 588/93**, for an inventive step to be present, it was not necessary to show improvement - substantial or gradual - over the prior art. Thus an earlier solution to a given technical problem did not preclude later attempts to solve the same problem in another, non-obvious way.

4.6. Solving a technical problem - post-published documents

In accordance with the case law, there can only be an invention if the application makes it at least plausible that its teaching indeed solves the problem it purports to solve.

In **T 433/05** the board referred to decisions **T 1329/04** and **T 1336/04** when deciding whether the technical problem had indeed been solved by the subject matter of claim 1 at the relevant date (see also **T 1306/04**, **T 710/05**, **T 1396/06**).

In **T 1329/04** it was stated that the definition of an invention as being a contribution to the art, i.e. as solving a technical problem and not merely putting one forward, required that it was at least made plausible by the disclosure in the application that its teaching indeed solved the problem it purported to solve. Therefore, even if supplementary post-published evidence might, where appropriate, also be taken into consideration, it could not serve as the sole basis for establishing that the application did indeed solve the

problem it purported to solve. In the case before it, the board decided that the post-published evidence could not be regarded as supportive of evidence which would have been given in the application as filed since there was none. Since the post-published evidence was considered to be the first disclosure going beyond speculation, it was not taken into consideration.

The same Board 3.3.08, confronted with a different technical situation, namely one where the quality of evidence provided in the patent at issue was such that the claimed invention was considered to be a bona fide solution to the problem to be solved, accepted the solution of the problem by also taking into consideration the disclosure in a post-published document (**T 1336/04**).

Considering decisions **T 1329/04** and **T 1336/04**, the board was convinced that the current circumstances were appropriate to take into account a supplementary post-published document when establishing whether the application indeed solved the problem it purported to solve. In the light of the disclosure in the patent in suit, which was supported by a post published document, the board was satisfied that the problem was solved by the subject-matter of the claims.

5. "Could-would approach" and ex post facto analysis

Many decisions of the boards of appeal warn against an ex post facto approach when assessing inventive step (see also the Guidelines C-IV, 11.8 - April 2010 version). This applies especially to inventions which at first sight seem obvious, to combination inventions and where the proposed solution is supposedly "simple". Correct application of the problem and solution approach avoids this inadmissible ex post facto analysis which draws on knowledge of the invention (**T 24/81**, OJ 1983, 133; **T 564/89**, **T 645/92**, **T 795/93**).

When assessing inventive step, an interpretation of the prior art documents as influenced by the problem solved by the invention, where the problem was neither mentioned or even suggested in those documents, must be avoided, such an approach being merely the result of an a posteriori analysis (**T 5/81**, OJ 1982, 249; **T 63/97**, **T 170/97**, **T 414/98**).

In **T 970/00** the board stated that any ex post facto analysis, and in particular any conclusion going beyond what the skilled person would have objectively inferred from the prior art, without the benefit of hindsight knowledge of the invention, is of necessity at variance with a proper application of the problem-solution approach. This applies also to the determination of the technical contribution of the invention to the prior art. Accordingly, the determination of the technical contribution achieved by the invention over the closest state of the art requires an objective and technically meaningful and consistent comparison of the claimed combination of structural and functional features with the technical information conveyed to the skilled person by the closest state of the art. Any attempt to interpret the disclosure of the closest prior art so as to distort or misrepresent, based on hindsight knowledge of the invention, the proper technical teaching of the disclosure in such a way that it artificially meets specific features recited in the claim under consideration must therefore fail, especially as this would risk unfairly

and tendentiously concealing the technical contribution of the invention and prejudice the subsequent objective determination of the technical problem solved by the claimed invention.

It is the boards' established case law that the question is not whether the skilled person **could** have carried out the invention, but whether he **would have done** so in the hope of solving the underlying technical problem or in the expectation of some improvement or advantage - the so-called "could-would approach" (**T 2/83**, OJ 1984, 265; **T 90/84**, **T 7/86**, OJ 1988, 381; **T 200/94**, **T 885/97**). So the point is not whether the skilled person could have arrived at the invention by modifying the prior art, but rather whether, in expectation of the advantages actually achieved (i.e. in the light of the technical problem addressed), he would have done so because of promptings in the prior art (**T 219/87**, **T 455/94**, **T 414/98**).

It has been held that once an invention existed, it could often be shown that the skilled person could have made it by combining different elements in the prior art, but such arguments had to be disregarded as the product of ex post facto analysis (**T 564/89**).

According to **T 939/92** (OJ 1996, 309), the answer to the question what a skilled person would have done depended in large measure on the technical result he had set out to achieve. In other words, the notional "person skilled in the art" was assumed to act not out of idle curiosity but rather with a specific technical purpose in mind.

Technical feasibility and the absence of obstacles were only necessary requirements for reproducibility but were not sufficient to render obvious **what was actually achievable** for the skilled person (**T 61/90**). The fact that the inherent properties of a technical means were known to the skilled person, so that he had the intellectual possibility to apply this means in a conventional device, merely established the **possibility** of using such technical means in such a manner, i.e. that the skilled person **could** have used it. However, if it was to be established that such intellectual possibility was also a technical measure which it was obvious for the skilled person to use, it was necessary to show that there was a recognisable pointer in the state of the art to combine the known means and conventional device for achieving the intended technical aim, i.e. that the skilled person **would** have made such a combination. The existence of such a technical reason was dependent on the known properties not only of the means but also of those of the device (**T 203/93** and **T 280/95**).

6. Expectation of success, especially in the field of genetic engineering and biotechnology

In accordance with the case law of the boards of appeal, a course of action could be considered obvious within the meaning of Art. 56 EPC 1973 if the skilled person would have carried it out in expectation of some improvement or advantage (**T 2/83**, OJ 1984, 265). In other words, obviousness was not only at hand when the results were clearly predictable but also when there was a reasonable expectation of success (**T 149/93**).

In some decisions in the field of genetic engineering the board asked whether in the cases in point it was obvious for the skilled person to try a suggested approach, route or method with a **reasonable expectation of success** (T 60/89, OJ 1992, 268). For more about biotechnological inventions and the definition of the skilled person, see Chapter I.D.7.1.3.

In T 296/93 the board held that, in relation to inventive step, the fact that other persons or teams were working contemporaneously on the same project might suggest that it was "obvious to try" or that it was an interesting area to explore, but it did not necessarily imply that there was a "reasonable expectation of success". **A reasonable expectation of success should not be confused with the understandable "hope to succeed"**; it implied the ability of the skilled person to predict rationally, on the basis of the knowledge existing before a research project was started, the successful conclusion of the said project within acceptable time limits. The more unexplored a technical field of research was, the more difficult it was to make predictions about its successful conclusion and, consequently, the lower the expectation of success (T 694/92, OJ 1997, 408). According to T 207/94 (OJ 1999, 273), the "hope to succeed" was merely the expression of a wish, whereas a "reasonable expectation of success" presupposed scientific appraisal of available facts.

In T 187/93 it was stated that, even if it was obvious for the skilled person to try an experiment, it was not necessarily true that this person would have any reasonable expectation of success when embarking on it.

In T 223/92 the board said that in 1981, given the state of the art at that time, the skilled person would have opted for DNA-recombination technology only if relying, e.g., on his own good luck and inventiveness to overcome the known (and as yet unknown) problems involved, which would have caused the average skilled person to expect to fail.

In a few cases, the board stated that there have been cases where inventive step was denied by the boards of appeal because the skilled person was in a "try and see" situation. Such a situation was considered to have occurred if the skilled person, in view of the teaching in the prior art, had already clearly envisaged a group of compounds or a compound and then determined by routine tests whether such compound/s had the desired effect (T 889/02, T 542/03, T 1241/03, T 1599/06). In T 91/98 the board stated that the rationale behind the "reasonable expectation of success" approach is that one may easily conceive of inventions to be made by genetic engineering, yet realising them may cause problems in view of difficulties known or experienced when starting the project. In the case before the board, in order to find out whether derivatives of azidothymidine had an activity against human retroviruses while remaining non toxic to cells, it was enough to perform well-known, routinely carried-out in vitro tests of viral infectivity, so it was rather a "try and see" approach which applied.

In T 1396/06 the board stated that a skilled person, even when applying routine methods with the aim of solving a closely related technical problem, would not have the absolute certainty of succeeding. However, certainty of success is not required according to the jurisprudence of the boards of appeal, which makes a clear distinction between

reasonable expectation of success and certainty of success (**T 918/01**). Rather, in spite of the understandable uncertainties which always characterise biological experiments, the skilled person would have had no reason to adopt a sceptical attitude. He would have had either some expectations of success or, at worst, no particular expectations of any sort, but only a "try and see" attitude, which does not equate with an absence of a reasonable expectation of success (see also **T 759/03**).

In **T 111/00** the board noted that this approach was intended in particular to take into account the complexity inherent in some recombinant DNA techniques, which might jeopardise the final outcome of experiments making use of them. In the case at issue, the skilled person would have considered the cloning of human cDNA as a matter of routine since the necessary probe was available from document 1 and no problems were encountered.

In the light of the closest prior art the board saw the technical problem to be solved in **T 886/91** in the exact identification and characterisation of DNA sequences of HVB genome subtype adyw. The board pointed out that the situation in **T 886/91** could not be compared with the one in **T 223/92** and **T 500/91**, where production of a partially known protein in a recombinant-DNA system was achieved and considered inventive on the basis of the fact that, in the specific circumstances of those cases, there was no realistic expectation of success. In the case in point the closest prior art had already disclosed the cloning and expression of the HBV genome subtype adyw. The identification and characterisation of the claimed specific sequences of the same genome involved for the skilled person nothing more than the performance of experimental work by routine means in connection with the normal practice of filling gaps in knowledge by the application of existing knowledge.

In **T 923/92** (OJ 1996, 564) the board had to decide whether the skilled person would have attempted, with reasonable expectation of success, to produce cDNA coding for human t-PA, or whether in this instance he would have known from his technical knowledge, before even embarking on the research, that he would be able to complete his project within an acceptable time. The board bore in mind that, as stated in **T 816/90**, "even when it is possible to theoretically conceive a straightforward approach to solve a specific technical problem, the skilled person might be confronted with unexpected difficulties when trying to put the conceived strategy into practice". The board stated that, although hoping to succeed, the skilled person embarking on this project would have known that its successful conclusion depended not only on technical skill in putting into practice the sequence of precise steps of the theoretical experimental protocol, but to a large extent also on the ability to take the right decisions along the way whenever a difficult experimental situation so required. Under these circumstances, it could not be said that the skilled person had a reasonable expectation of success.

In **T 386/94** (OJ 1996, 658), again citing **T 816/90**, the board ruled that, in gene technology, inventive step could not be acknowledged if, at the priority date, a skilled person could expect to perform the cloning and expression of a gene in a fairly straightforward manner, and the cloning, although requiring much work, did not pose such problems as to prove that the expectation of success was ill-founded.

Where the expression of a cloned DNA in a chosen foreign host constituted the subject-matter of the claimed invention, the question whether a reasonable expectation of success existed or not could be evaluated only by taking into account real difficulties relating to that step. Thus, in order to be considered, any allegation that features jeopardised a reasonable expectation of success had to be based on technical facts (**T 207/94**, OJ 1999, 273).

In **T 737/96** the board was of the opinion that it was not appropriate to attempt to evaluate the expectation of success of a random technique such as mutagenesis where results depended on chance events. This was because the skilled person knew that, unless a specific selection method could be developed, which was not the case in the patent in suit, perseverance and chance played a key role in achieving success, as no form of control could be exerted over the mutation events. Under these circumstances, as in a lottery game, the expectation of success always ranged irrationally from nil to high, so it could not be evaluated in a rational manner based on technical facts. This was at variance with technical situations in which more predictable methods were relied upon to solve a particular problem, such as methods of genetic engineering like cloning or expressing a DNA sequence. In such situations, it was often possible to make rational predictions about the likelihood of success, and "reasonable expectation of success" was then a meaningful and reliable criterion for assessing inventive step (see also **T 694/92**, OJ 1997, 408).

Decisions **T 455/91**, **T 412/93**, **T 915/93**, **T 63/94**, **T 856/94** and **T 948/01** also consider this topic.

7. Skilled person

7.1. Definition of the skilled person

7.1.1 Definition

According to the case law of the boards of appeal, **the person skilled in the art** should be presumed to be an **ordinary practitioner** aware of what common general knowledge in the art comprised at the relevant date (average skilled person). He should also be presumed to have had access to everything in the **state of the art**, in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation (Guidelines C-IV, 11.3 - April 2010 version). The skilled person will be an expert in a **technical field** (**T 641/00**, OJ 2003, 352). **T 39/93** (OJ 1997, 134) explained that, whilst generally accepted definitions of the notional "person skilled in the art" did not always use identical language to define the qualities of such a person, they had one thing in common, namely that none of them suggested he was possessed of any inventive capability. It was the presence of such capability in the inventor which set him apart from the notional skilled person.

With regard to the definition of the skilled person, the board in **T 26/98** summarised the following principles which are generally applied by the boards of appeal: if the problem prompts the skilled person to seek its solution in another technical field, the specialist in

that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability" (see crucial decision **T 32/81**, OJ 1982, 225; **T 141/87**, **T 604/89**, **T 321/92**). The skilled person can be expected to look for suggestions in neighbouring fields if the same or similar problems arise in such fields. The skilled person can be expected to look for suggestions in a general technical field if he is aware of such fields. In advanced technical fields the competent "skilled person" could be taken to be a team of experts from the relevant technical branches. Solutions to general technical problems in non-specific (general) fields are considered to form part of the general technical knowledge.

In **T 1464/05** the board considered the features made available to the public by the public prior use as the closest state of the art. The board stated that, according to established doctrine, the notional person skilled in the art referred to in Art. 56 EPC 1973 was assumed to be aware of the totality of the prior art pertinent to the relevant area of technology and in particular of everything made available to the public within the meaning of Art. 54(2) EPC 1973. The different means by which the state of the art was made available to the public ranked equally with each other. The notional skilled person was supposed to be aware of all the features of the prior use in suit that had been made available to the public. Thus, although it would be unrealistic to assume that all skilled members of the interested public would have been aware of the features made available to the public by the prior use, the notion of the skilled person under Art. 56 EPC 1973 ensured that any obvious development or application of the features of the public prior use by any particular skilled member of the interested public who had gained information on the features made available to the public by the prior use was treated under Art. 56 EPC 1973 as such, i.e. as obvious with regard to the state of the art, irrespective of whether or not other members of the interested public had actually become aware of the features of the prior use.

In **T 1030/06** the application related to a system and method for securely buffering content. The board considered that the skilled person was a person of ordinary skill in the art which meant not only having access to the state of the art and common general knowledge in the field, but also the capability to perform routine work and experimentation. Thus, the skilled person could be expected to seek out solutions and make choices to try to solve design problems that crop up. In the board's view, this was particularly so where the problem was to come up with an implementation of an apparatus having certain required functions. The implementation of the first part of the solution (here the provision of several processors) often leads to further design decisions that must be made (here the choice of encryption scheme and the identification of the source of data) in order to produce a working system. The skilled person could not be expected to abandon the implementation half-way through in the form of a "black box" with undefined means for carrying out the required functions, but must attempt if possible to put such means into practice using knowledge available to him. These would literally be "further ideas" in the sense that they could be new in the given context, but they should be routine and thus not inventive.

According to **T 422/93** (OJ 1997, 25), when examining for inventive step using the "problem and solution approach", the starting point for defining the appropriate skilled person was the technical problem to be solved on the basis of what the prior art disclosed, irrespective of any other definition of the skilled person suggested in the contested patent. Since the technical problem addressed by an invention had to be so formulated as not to anticipate the solution, the skilled person to be considered could not be the appropriate expert in the technical field to which the proposed solution belonged if this technical field was different to the one considered when formulating the technical problem. Nor did the appropriate skilled person's basic knowledge include that of a specialist in the different technical field to which the proposed solution belonged, if the closest prior art gave no indication that the solution was to be sought in this other technical field.

7.1.2 Competent skilled person - group of people as "skilled person"

Sometimes the "skilled person" may be a group of people, such as a research or production team. For the purposes of Art. 56 EPC 1973, the person skilled in the art was normally not assumed to be aware of patent or technical literature in a remote technical field. In appropriate circumstances, however, the knowledge of a team consisting of persons having different areas of expertise could be taken into account (**T 141/87**, **T 99/89**). This would be the case in particular if an expert in one particular field was appropriate for solving one part of the problem, while for another part one would need to look to another expert in a different area (**T 986/96**).

Thus, the board stated, for example, in **T 424/90** that in real life the semiconductor expert would consult a plasma specialist if his problem concerned providing a technical improvement to an ion-generating plasma apparatus. In **T 99/89** too, the board took the view that "competent skilled person" could be taken to mean a team of two or possibly more experts from the relevant branches.

In **T 164/92** (OJ 1995, 305, Corr. 387) it was observed that sometimes the average skilled person in electronics, particularly if he did not have an adequate knowledge of programming languages himself, might be expected to consult a computer programmer if a publication contained sufficient indications that further details of the facts described therein were to be found in a program listing attached as an annex thereto.

Further comments on the concept of the "team of experts" are to be found in the following decisions; **T 57/86**, **T 222/86** (in advanced laser technology, the "skilled person" as a production team of three experts in physics, electronics and chemistry respectively), **T 141/87**, **T 460/87**, **T 295/88**, **T 825/93**, **T 2/94**, **T 402/95** and **T 986/96** (team consisting of a first expert in the field of mail processing and a second expert acquainted with information in the field of weighing).

7.1.3 Definition of the person skilled in the art in the field of biotechnology

The person skilled in the art in the field of biotechnology is well defined by the case law of the boards of appeal. His attitude is considered to be conservative. He would never go

against an established prejudice, nor try to enter unpredictable areas nor take incalculable risks. The notional skilled person would perform a transfer of technology from a neighbouring field to his specific field of interest, if this transfer involved routine experimental work comprising only routine trials (**T 455/91**, OJ 1995, 684; **T 500/91**, **T 387/94**, **T 441/93**, **T 1102/00**).

In **T 60/89** (OJ 1992, 268) the board took the view that the skilled person in genetic engineering in 1978 could not be defined as a Nobel prize winner, even if a number of scientists working in this field at that time actually were awarded that prize. Rather he should be assumed to be a scientist (or team of scientists) working as a teacher or researcher in the laboratories which made the transition from molecular genetics to genetic engineering at that time.

This case law was confirmed in **T 500/91** - "BIOGEN II". The board ruled that the average skilled person - who might also be a team of specialists in the relevant field - operated at a practical level, and the technical development which might normally be expected of him did not include solving technical problems through scientific research.

From the notional skilled person nothing more can be expected than the carrying out of experimental work by routine means within the framework of the normal practice of filling gaps in knowledge by the application of existing knowledge (**T 886/91**, **T 223/92**, **T 530/95**, **T 791/96**).

It had to be assumed that the average skilled person would not engage in creative thinking (**T 500/91**). Yet he or she could be expected to react in a way common to all skilled persons at any time, namely that an assumption or hypothesis about a possible obstacle to the successful realisation of a project must always be based on facts. Thus, in the board's view, an absence of evidence that a given feature might be an obstacle to carrying out an invention would not be taken as an indication that this invention could not be achieved, nor that it could (**T 207/94**, OJ 1999, 273).

In **T 223/92** the board had to consider the knowledge and capabilities of the notional skilled person in the field of genetic engineering as at October 1981, more than one year later than was the case in **T 500/91**. By this time, a considerably greater number of genes had been made the subject of cloning and expressing methods, and skills and experience in this technical field were developing rapidly. The knowledge of the notional person skilled in the art had to be considered as that of a team of appropriate specialists who knew all the difficulties still to be expected when considering the cloning of a new gene. However, the skilled person had to be assumed to lack the inventive imagination to solve problems for which routine methods of solution did not already exist.

In **T 412/93** the patent related to the production of erythropoietin. The parties agreed that in this particular case the skilled person should be treated as a team of three, composed of one PhD researcher with several years' experience in the aspect of gene technology or biochemistry under consideration, assisted by two laboratory technicians fully acquainted with the known techniques relevant to that aspect. The composition of the

team might vary depending on the knowledge and skills required by the particular aspect dealt with.

In **T 455/91** (OJ 1995, 684) the board set out considerations on the skilled person's likely attitude to possible changes, modifications or adjustments to known products (e.g. a plasmid) or procedures (e.g. an experimental protocol). Its aim was to answer, objectively and avoiding any ex post facto analysis, the question whether it would be obvious to the skilled person to make given changes in a structure or procedure. The skilled person in this field was well aware that even a small structural change in a product (e.g. a vector, protein, or DNA sequence) or procedure (e.g. a purification process) could produce dramatic functional changes. He would therefore adopt a conservative attitude. For example, he would neither go against an established prejudice, nor venture into "sacrosanct" or unpredictable areas, nor take incalculable risks. However, within the normal design procedures, he would readily seek appropriate, manifest changes, modifications or adjustments involving little trouble or work and no or only calculable risks, especially to obtain a handier or more convenient product or simplify a procedure.

If, on the other hand, he would expect to have to perform scientific research rather than routine work in order to transfer a technology previously set up in one field of research (method of transforming *Saccharomyces cerevisiae* whole cells) to a neighbouring field (method of transforming *Kluyveromyces* whole cells), then inventive step could be acknowledged (**T 441/93**).

In **T 493/01** the invention related to a protective antigen potentially useful in a vaccine against whooping cough. In **T 455/91** (OJ 1995, 684) the skilled person in the field of biotechnology had already been defined as being cautious and conservative. The board said this did not mean he would refrain from considering information because it did not concern the mainstream of research in his field of specialisation or because it applied only to some parts of the world. His skill and knowledge were not geographically limited; in fact he would have a global point of view. Thus if, as in the case in point, a pathogen constituted a known threat in some restricted parts of the world, the skilled person would not refrain from taking prior knowledge about that pathogen into consideration or from using it as a basis for his activities.

7.1.4 Identification of the skilled person in the case of computer-implemented inventions

In **T 641/00** (OJ 2003, 352) the board stated that the identification of the skilled person needs careful consideration. He will be an expert in a **technical** field. If the technical problem concerns a computer implementation of a business, actuarial or accountancy system, he will be someone skilled in data processing, and not merely a businessman, actuary or accountant (**T 172/03**).

7.2. Neighbouring field

Two landmark decisions, **T 176/84** (OJ 1986, 50) and **T 195/84** (OJ 1986, 121) addressed in detail the problem of the relevant technical field, i.e. the question of the

extent to which neighbouring areas beyond the specific field of the application might be taken into consideration when assessing inventive step. According to **T 176/84**, when examining for inventive step, a skilled person would, as well as considering the state of the art in the specific technical field of the application, look for suggestions in neighbouring fields or a broader general technical field if the same or similar problems arose, and if he could be expected to be aware of such general fields. **T 195/84** added that the state of the art also had to include prior art in a non-specific (general) field dealing with the solution of any general technical problem which the application solved in its specific field. Such solutions of general technical problems in non-specific (general) fields had to be viewed as forming part of the general technical knowledge which a priori was to be attributed to those skilled persons versed in any specific technical field. These principles were applied in a large number of decisions.

In **T 560/89** (OJ 1992, 725) the board took the view that the skilled person would also draw on prior art in other fields which were neither neighbouring nor broader general fields, if prompted to do so because the materials used were related or because of public debate about a technical problem common to both fields. Expanding on this, **T 955/90** added that, in practice, the person skilled in a broader general field would also draw on the narrower, more specialised field of the known main application of the general technology in search of a solution to a problem lying outside the special application of that technology (**T 379/96**).

According to **T 454/87** a skilled person specialising in a particular technical field (gas chro-matography equipment) would, in the course of his normal professional activity, also observe developments in equipment used in a related technical field (absorption spectral analysis).

In **T 891/91** the board stated that a skilled person in the field of lenses for ophthalmic use, confronted with the technical problem of adhesion and abrasion resistance of a coating made on a surface of the lens, would also refer to the state of the art in the more general field of coated plastic sheets in which the same problems of adhesion and abrasion resistance of the coating arose and of which he was aware.

In **T 767/89**, regarding carpets, the board ruled that wigs were neither a neighbouring technical field nor a broader general one which included the former field. So wigs were not a related technical field in which the person skilled in carpets would have been prompted to seek solutions. The two inventions addressed different problems; the user requirements were not comparable.

Because of the differing security risks, a skilled person could not be expected to search in the field of bulk-goods packaging for ideas for the design of a closure for a means of conveying money (**T 675/92**).

Further comments on the concept of relevant field are to be found in several other decisions, including the following: **T 277/90** (in dentistry, moulding technology and prosthodontics are neighbouring technical fields), **T 358/90** (discharging the content of a portable toilet did not lead the skilled person to the field of filling a tank of a chain saw by

means of a special kind of container), **T 1037/92** (a person skilled in the art of making fuse links for programmable ROMs would also have consulted the documentation in the field of ultraminiaturised integrated switches), **T 838/95** (the pharmaceutical and cosmetic fields were immediate neighbours), **T 26/98** (the board did not consider the field of electrochemical generators to be a neighbouring field of iontophoresis because, though both fields relied on electrochemical processes, such processes had substantially different purposes and applications and, consequently, had to satisfy different requirements), **T 365/87**, **T 443/90**, **T 47/91**, **T 244/91** and **T 189/92**.

On a different aspect, with regard to the applicant's reference to a remote state of the art, the board gave the following ruling in **T 28/87** (OJ 1989, 383); if reference is made in the introduction to the description of an application or a patent to a state of the art which cannot objectively be classified as a relevant field, that state of the art cannot in the course of examination for patentability be applied to the applicant's or proprietor's disadvantage as a neighbouring field merely on account of that reference.

7.3. Skilled person - level of knowledge

The same level of skill has to be applied when, for the same invention, the two questions of sufficient disclosure and inventive step have to be considered (**T 60/89**, OJ 1992, 268; **T 373/94**). **T 694/92** (OJ 1997, 408) added that, although the same level of skill is applied for both Art. 56 and Art. 83 EPC 1973, the two starting points differ; for inventive step purposes, the skilled man knows only the prior art; for sufficiency of disclosure, he knows the prior art **and** the disclosed invention.

According to **T 426/88** (OJ 1992, 427) a book providing general teaching in a general technical field covering the invention's specific technical field was part of the general knowledge of a specialist in that specific technical field. When books, representing common general knowledge, described a basic general technical theory or methodology and exemplified the same with specific applications in certain technical fields only, these did not limit the general scope and relevance of such disclosures so as to exclude possible applications in other fields. The appellant had argued that the book, written in German, was not a general reference book consulted by experts in that field in Great Britain. The board, however, adhered to the definition of the state of the art given in Art. 54 EPC 1973, according to which no account was taken of the location at which the skilled person exercised his profession.

In **T 766/91** the board summarised the normally accepted view that common general knowledge was represented by basic handbooks and textbooks on the subject in question. It was knowledge that an experienced person in this field was expected to have, or at least to be aware of, to the extent that he knew he could look it up in a handbook if he needed it. Statements in such works were used as convenient references to show what was common knowledge. The information as such did not as a rule become such knowledge through publication in a given handbook or textbook; rather by the time it appeared in such works it was already generally known. For this reason, publication in an encyclopaedia, say, could normally be taken as proof that the information was not only known but was common general knowledge. The assertion that

something was part of the common general knowledge therefore needed only to be substantiated if challenged by another party or the EPO (**T 234/93**, **T 590/94**, **T 671/94**, **T 438/97**).

In **T 378/93** the board confirmed this case law, adding that the same applied to articles in scientific periodicals addressed primarily to qualified professionals and enjoying worldwide repute.

In **T 939/92** (OJ 1996, 309) it was explained that the state of the art could also perfectly well reside solely in the relevant common general knowledge, which, in turn, need not necessarily be in writing, i.e. in textbooks or the like, but might simply be a part of the unwritten "mental furniture" of the average skilled person. In the case of any dispute, however, the extent of the relevant common general knowledge had to be proven, e.g. by documentary or oral evidence.

Numerous publications in the specialist press over a fairly short time, reporting on meetings and research in a particularly active field of technology, could reflect common general knowledge in this field at that time (**T 537/90**).

In **T 632/91** the board stated that evidence which did not comprise a comparison of the claimed subject-matter with the state of the art might nevertheless rebut a prima facie assumption that there existed some common general knowledge which would have allowed the skilled person to disregard structural differences in chemical compounds.

7.4. Everyday items from a different technical field

In **T 1043/98** the patent concerned an inflatable gas-bag for a vehicle restraint system, one part being club-shaped and the other generally butterfly-shaped. The edges of the two parts were sewn together along a continuous seam. According to the appellant, the skilled person would immediately arrive at the claimed gas-bag from his knowledge of tennis-ball or baseball construction. This raised the issue of the application of features or solutions drawn from another technical field but which could be considered "everyday items".

In **T 397/87** the board had already pointed out that there was no obvious reason why a skilled person trying to solve a non-trivial problem should have been led to the claimed process by simple examples from everyday life which were unrelated to the problem in question. In **T 349/96**, too, the board was unable to see why the fact that different transport containers were used for beer bottles in an everyday context should prompt a skilled person to invent a spinning/winding machine combination with an integrated transport system even if the many citations from the relevant technical field were unable to do this (see also **T 234/91**).

In **T 234/96**, however, the board concurred with the examining division's view that the skilled person dealing with the practicalities of motorising a dispenser drawer for washing powder had in mind as a model the disc tray of a CD player with push-button electromotor operation, which, at the time of filing the application, was familiar to anyone

and which therefore suggested the subject-matter of claim 1. In the board's view, the fact that washing machines and CD players were intrinsically different items serving different purposes did not suffice to prevent the skilled person concerned with the construction of washing machines from taking into consideration the basic principle of automatic tray operation in CD players when designing a dispenser drawer for washing powder.

From a comparison of the above-mentioned decisions, the board in **T 1043/98** concluded that the relevance of such items for inventive step depended very much on the circumstances of the individual case. It agreed that persons skilled in developing the gas-bags in question would include tennis or baseball players. It could not, however, share the appellant's view that to solve the problem addressed by the invention the skilled person would draw on what he might know about tennis-ball or baseball construction. The main reason was that the gas-bag was not intended to be spherical in shape. It was therefore unlikely that the skilled person would take as his starting point an object which was the epitome of a sphere (see **T 477/96**, where the board also concluded that everyday experience was not relevant to the technical field of the invention).

8. Assessment of inventive step

8.1. Treatment of technical and non-technical features

8.1.1 Technical character of the invention

Several decisions by the boards of appeal, especially Technical Board of Appeal 3.5.01, were concerned with the assessment of inventive step in cases where the invention consisted of a mix of technical and non-technical features. Originally, having technical character was an implicit requirement of the EPC 1973 which had to be met by an invention in order to be an invention within the meaning of Art. 52(1) EPC 1973. In the revised edition of the Convention (EPC 2000), technical character was formulated as an explicit requirement. The legal definition of Art. 56 EPC 1973 is to be put into context with the remaining patentability requirements of Art. 52 to 57 EPC 1973, these articles implying the general principles that patents shall be available for inventions in all fields of technology and that technical character is a *sine qua non* for an invention within the meaning of the EPC 1973 (**T 931/95**, OJ 2001, 441; **T 935/97**, **T 1173/97**, OJ 1999, 609; **T 641/00**, OJ 2003, 352; **T 914/02**, **T 1227/05**, OJ 2007, 574).

Adopting this approach, it is legitimate to have a mix of technical and "non-technical" features (i.e. features relating to non-inventions within the meaning of Art. 52(2) EPC 1973) appearing in a claim, even if the non-technical features should form a dominating part (**T 26/86**, OJ 1988, 19; **T 769/92**, OJ 1995, 525; **T 641/00**, OJ 2003, 352 and **T 531/03**).

In **T 1173/97** (OJ 1999, 609) it was stated that a computer program product is not excluded from patentability under Art. 52(2) and (3) EPC 1973 if, when it is run on a computer, it produces a further technical effect which goes beyond the "normal" physical interactions between program (software) and computer (hardware). In **T 424/03** the

board stated that a computer-readable medium is a technical product and, thus, has technical character.

Various questions concerning the prohibition on patenting computer programs as such (Art. 52(2)(c) and (3) EPC) have been referred to the Enlarged Board of Appeal by the President of the EPO (see also chapter I.A.2.4, computer-implemented inventions). The Enlarged Board of Appeal gave its opinion on the President's referral in **G 3/08** (see headnote on page XXXVII).

According to **T 931/95** (OJ 2001, 441) an **apparatus** constituting a physical entity or concrete product, suitable for performing or supporting an economic activity, is an invention within the meaning of Art. 52(1) EPC 1973 (confirmed in **T 258/03**). However, the board pointed out in **T 258/03** (OJ 2004, 575) that this reasoning was independent of the category of the claim. Contrary to **T 931/95** (see headnote 2), the board concluded that, in general, a **method** involving technical means is an invention within the meaning of Art. 52(1) EPC 1973. In **T 424/03** the board added that the claim category of a computer-implemented method is distinguished from that of a computer program.

In **T 258/03** (OJ 2004, 575) the board stated with regard to the concept of "invention" within the meaning of Art. 52(1) EPC 1973 that what mattered was the presence of technical character which could be implied by the physical features of an entity or the nature of an activity, or could be conferred on a non-technical activity by the use of technical means.

In **T 914/02** the board stated that the involvement of technical considerations was not sufficient for a method which might exclusively be carried out mentally to have technical character. In **T 388/04** (OJ 2007, 21), Board of Appeal 3.5.02 held that the extent to which subject-matter or activities were excluded from patentability under Art. 52(2) and (3) EPC 1973 was notionally distinct from, and might be considered independently of the question of inventive step.

In **T 336/07** Technical Board of Appeal 3.2.04 held that the mere fact that subject-matter (here rules for playing games), which was excluded per se under Art. 52(2)(c) EPC 1973, was technically implemented could not form the basis for inventive step. Inventive step could be based only on the particular manner of implementation of such subject matter. To this end it was therefore necessary to ask how the per se excluded subject matter was implemented. A consideration of the particular manner of implementation had to focus on any further technical advantages or effects associated with the specific features of implementation over and above the effects and advantages inherent in the excluded subject-matter (see also **T 1543/06**).

8.1.2 Problem and solution approach

The boards of appeal use the problem and solution approach to determine whether an inventive step is involved. This requires analysis of the invention in terms of a technical solution to a technical problem. Since both the solution and the problem solved by an invention have to be of a technical nature, the problem and solution approach might raise

questions when the invention comprises non-technical aspects or elements. Such difficulties are to be resolved by taking due care to define the technical field to which the invention belongs, the scope of technical expertise and skills expected to be applied by the technical person in that particular technical field, and the correct formulation of the technical problem actually solved (**T 1177/97**). In **T 641/00** (OJ 2003, 352), Technical Board of Appeal 3.5.01 had already held that, as a matter of principle, an invention consisting of a mixture of technical and non-technical features and having technical character as a whole was to be assessed with respect to the requirement of inventive step by taking account of all those features which contributed to that technical character. Features of the invention which did not form part of the technical solution to the technical problem had to be disregarded in the assessment of inventive step. In **T 531/03** Technical Board of Appeal 3.4.03 confirmed the principles set out in **T 641/00** and stated that, in the assessment of inventive step, features relating to a non-invention within the meaning of Art. 52(2) EPC 1973 (so-called "non-technical features") could not support the presence of inventive step. In **T 619/02** (OJ 2007, 63), the board confirmed the findings of **T 641/00** and **T 172/03** that the assessment of inventive step according to the problem and solution approach was fundamentally of a technical nature and, accordingly, the presence of an inventive step could only be established on the basis of the technical aspects of both the distinguishing features of, and the effects achieved by the claimed invention over the closest state of the art.

In **T 1121/02** Technical Board of Appeal 3.2.04 also referred to **T 931/95** (OJ 2001, 441) and **T 641/00** (OJ 2003, 352) and confirmed that features making no contribution to technical character could not support the presence of an inventive step. In **T 258/03** (OJ 2004, 575), the board held that the invention was to be assessed by taking account only of those features which contributed to a technical character. The features that made a technical contribution therefore needed to be determined. Finally, the identification of the skilled person also needed careful consideration. The skilled person will be an expert in a technical field (**T 641/00**). In **T 172/03** it was held that the term "state of the art" in Art. 54 EPC 1973 should be understood as "state of technology". The term "everything" in Art. 54(2) EPC 1973 was to be understood as concerning the kind of information which was relevant to some field of technology. It followed that anything which was not related to any technological field or field from which, because of its informational character, a skilled person would expect to derive any technically relevant information, did not belong to the state of the art to be considered in the context of Articles 54 and 56 EPC 1973.

In **T 688/05** the board discussed the principles applicable to the examination of inventions comprising non-technical features for inventive step. R. 27(1)(c) and 29(1) EPC 1973 indicated that it had to be possible to express an invention in terms of a solution having technical features to a technical problem. Although a non-technical feature might well serve to define the context in which a technical problem occurred, it could not contribute to its solution since, by definition, it had no technical consequences.

8.1.3 Identifying technical features

Unless stated otherwise, the case law referred to in the following chapters in respect of inventions consisting of a mixture of technical and non-technical features has been developed by the Technical Board of Appeal 3.5.01.

In **T 931/95** (OJ 2001, 441) the first auxiliary request sought protection for an apparatus for controlling a pension benefits program and system. The board arrived at the conclusion that the improvement envisaged by the invention according to the application was an essentially economic one, i.e. lay in the field of economy, which therefore could not contribute to inventive step. The regime of patentable subject-matter was only entered with programming of a computer system for carrying out the invention. The assessment of inventive step had thus to be carried out from the point of view of a software developer or application programmer, as the appropriate person skilled in the art, having the knowledge of the concept and structure of the improved pension benefits system and of the underlying schemes of information processing. Taking into account the fact that the technical features of the apparatus claimed were functionally defined by precisely those information-processing steps, which formed part of the knowledge of the skilled person, as well as the fact that the application of computer systems in the economic sector was already a general phenomenon at the priority date (filing date) of the application, it had to be concluded that the claimed subject-matter did not involve an inventive step.

In the crucial decision **T 641/00** (OJ 2003, 352) the patent in suit related to a method in a digital mobile telephone system of the GSM type in which a subscriber identity module (SIM card) was allocated at least two identities which were selectively activated by the user in order to distribute the costs between private and service calls. The board held that an invention consisting of a mixture of technical and non-technical features and having technical character as a whole was to be assessed with respect to the requirement of inventive step by only taking account of those features which contributed to that technical character. Features making no such contribution could not support the presence of inventive step. The board referred to **T 158/97**, where a modification of a known device not related to any technical function had been held incapable of contributing to inventive step (see also **T 72/95**, **T 157/97** and **T 176/97**).

In **T 27/97** the board, in assessing inventive step, had disregarded a feature distinguishing the claimed subject-matter from the prior art for lack of any established technical effect causally related to that feature.

In **T 1001/02** the characterising feature principally involved a design element intended to harmonise and enhance the appearance of the whole radiator. Technical Board of Appeal 3.2.03 took the view that this feature could consequently not be regarded as a technical feature and therefore left it out of account in its assessment of inventive step.

In **T 531/03**, the patent in suit related to a system for generating a printed discount certificate in a retail store. Technical Board of Appeal 3.4.03 stated that, in the assessment of inventive step, features relating to a non-invention within the meaning of

Art. 52(2) EPC 1973 ("non-technical features") could not support the presence of inventive step. The patentee submitted that the invention at issue required a combination of a technical and a non-technical inventive step, and that the skilled persons would therefore consist of a team of a "non-technical person" plus a technical person. The board rejected this approach and stated that an attempt to take into account the contribution of non-technical and technical aspects on an equal footing in the assessment of inventive step would be inconsistent with the Convention, since the presence of inventive step would, in such an approach, be attributed to features which were defined in the Convention as not being an invention.

In **T 619/02** (OJ 2007, 63) the main and the first auxiliary request did not constitute an invention within the meaning of Art. 52(1) EPC 1973. The second auxiliary request defined a method of making a perfumed product comprising perfuming with an odour, the odour being selected following a procedure in which the (unperfumed) product itself or alternatively other desired attribute was used as target. Board of Appeal 3.4.02 stated that the claim was directed to the manufacture of a perfumed product and required imparting the selected odour to the product, and hence defined a process or activity that was technical by its very nature and pertained to the general technical field of perfumery. The board confirmed that the presence of an inventive step could only be established on the basis of the technical aspects of both the distinguishing features of, and the effects achieved by the claimed invention over the closest state of the art. The board stated that the claimed method differed from the closest state of the art in that the odour had been selected following a certain selection procedure. However, neither the selection procedure nor the resulting selected odour were of a technical nature. The board concluded that if, apart from a possibly commercially promising but purely aesthetic or emotional and therefore technically arbitrary effect, the distinguishing features of an invention over the closest state of the art do not, in the context of the claimed invention, perform any technical function or achieve any technical effect, no specific objective problem of a technical nature can be considered to be solved by the invention (see also **T 1212/04**).

In **T 912/05** the application related to mail delivery systems which may deliver mail by physical and/or electronic means. It consisted essentially in providing a mail delivery service which informed the recipient of the availability of mail and delivered it according to the recipient's instructions. The independent method claims of all requests contained a step which related to the transmission of information per e-mail. The board 3.5.02 stated that the methods for mail delivery as set out in claim 1 comprised at least one step involving technical means for their implementation, as this form of communication necessarily required the use of technical means, such as computers. In accordance with the case law of the boards of appeal, these methods could thus be regarded as "inventions" within the meaning of Art. 52(1) EPC. The board, however, found that, in the case before it, it was not necessary to seek to separate features that were essentially business-related, and thus not relevant for the solution of a technical problem, from those features that, as essentially technical, should be taken into account when assessing inventive step. It concluded that the assessment of the inventive step of a business-related method might be possible without a preliminary clear-cut separation between business-related features and technical features.

8.1.4 Assessment of technical effect

In **T 258/97** the invention related to an image communication apparatus. The board referred to **T 27/97**, where it was stated that an abstract algorithm was relevant to inventive step only if a technical effect could be established which was causally linked to the algorithm, such that the technical effect provided a contribution to the solution of a technical problem and thereby conferred a "technical character" on the algorithm. Therefore, the board ruled that an assessment of inventive step could only be based on those elements and aspects of the invention in respect of which a technical effect could be established. Whether an invention caused a technical effect was essentially a question of fact.

In **T 643/00** the board stated that an arrangement of menu items (or images) on a screen might be determined by technical considerations. Such considerations might be intended to enable the user to manage a technical task, such as searching and retrieving images stored in an image processing apparatus, in a more efficient or faster manner, even if an evaluation by the user on a mental level was involved. Although such evaluation per se did not fall within the meaning of "invention" pursuant to Art. 52 EPC 1973, the mere fact that mental activities were involved did not necessarily qualify subject-matter as non-technical, since any technical solutions in the end were intended to provide tools which served, assisted or replaced human activities of different kinds, including mental ones.

The board referred to **T 1177/97** where it was stated that the use of a piece of information in a technical system, or its usability for this purpose, may confer a technical character on the information itself in that it reflects the properties of the technical system, for instance by being specifically formatted or processed. Additionally, the board referred to **T 1194/97** where Board 3.5.02 stated that functional data (line numbers, coded picture lines, addresses and synchronisations) recorded on a record carrier to be used in a picture retrieval system were to be distinguished from the cognitive content encoded. Even if the overall information could be interpreted in an infinite number of different ways in other technical or human contexts, this did not detract from its technical function in the relevant context of the claimed invention (see also **T 424/03**).

In **T 1121/02** the application related to an electric fencing element characterised in that said fencing element had along its surface contrasting markings which were deterrent to an animal. Board 3.2.04 stated that the contrasting markings were not technical features. The markings were said to be such as to resemble the warning patterning of another animal, but this was not a technical effect. Therefore the contrasting marking had no significance when assessing inventive step.

In **T 258/03** (OJ 2004, 575) the overall aim of the claimed method - to identify the successful bidder for a product offered for sale at an auction - was not regarded as having technical character by the board. The appellant had argued that the technical effect resided in overcoming the problem in the prior art of delays in the propagation of information between bidders and the server. The solution to this problem consisted in adapting the known auction method such that it could be performed automatically. The board concluded that method steps consisting in modifications to a business scheme

(the rules of the auction) aimed at circumventing a technical problem rather than solving it by technical means could not contribute to the technical character of the subject-matter claimed. The invention was regarded by the board as a mere automation of the non-technical activity of performing a Dutch auction in the absence of bidders and thus as limited to instructing the server computer to apply the given conditions and perform any necessary calculations. This was considered by the board to be routine programming well within the reach of the skilled person.

8.1.5 Formulation of the technical problem

In **T 641/00** (OJ 2003, 352) the board considered the formulation of the technical problem. Although the technical problem to be solved should not be formulated to contain pointers to the solution or partially anticipate it, merely because some feature appeared in the claim did not mean it was automatically excluded from appearing in the formulation of the problem. In particular where the claim referred to an aim to be achieved in a non-technical field, this aim might legitimately appear in the formulation of the problem as part of the framework of the technical problem which was to be solved in order to avoid taking into account a non-technical contribution when assessing inventive step. The board referred to its decision **T 1053/98**, where it had considered it necessary to formulate the technical problem in such a way that "there was no possibility of an inventive step being involved by purely non-technical features". Such a formulation of the problem could refer to the non-technical aspect of the invention as a given framework within which the technical problem was posed. In the case at issue, the object of the invention as stated in the patent specification was to eliminate inconveniences caused by distributing costs for service and private calls or among different users. That object had to be reformulated to arrive at the technical problem of implementing the GSM system **in such a way as to allow** user-selectable discrimination between calls for different purposes or by different users (see also in this respect **T 509/07**).

According to the COMVIK approach (**T 641/00**) non-technical features may be taken into consideration when formulating the technical problem. In **T 688/05** the board stated that in this way it is possible to assess whether a technical implementation requires inventive skill. The appellants submitted that this approach treats non-technical features as if they were known, although they may in fact be part of the inventor's contribution. In the board's view this is, however, the unavoidable consequence of the requirement in the EPC that the invention must relate to a technical problem. The board added that the concept of "novelty" in Art. 54(1) EPC 1973 was only defined for "inventions". It does not apply to the exceptions enumerated in Art. 52(2) EPC 1973. By analogy it could be held that claim features which do not contribute to the definition of an "invention" cannot be classified as new or not new within the meaning of Art. 54 EPC 1973. Nevertheless, they may well form the only logical link between technical features resulting from their implementation. They must therefore be taken into consideration for the examination as to inventive step, while at the same time not be permitted to contribute to it.

In **T 1284/04** the board held that the COMVIK approach does not consider the non-technical constraints as belonging to the prior art, but rather as belonging to the conception or motivation phase normally preceding an invention, since they may lead to

a technical problem without contributing to its solution. Such aspects have never been taken into account in assessing inventive step, irrespective of whether or not they were known from the prior art.

In **T 1177/97** the board held that information and methods relating to linguistics might in principle assume a technical character, if they were used in a computer system and formed part of a technical problem solution. Features or aspects of the claimed method which reflected only peculiarities of the field of linguistics, however, must be ignored in assessing inventive step. In the case in point, the technical differences which established the novelty of the claimed process were not inventive, since they originated from a non-technical constraint to the technical problem, the implementation of which was obvious.

In **T 244/00** the appeal concerned a remote-control apparatus in the field of audio-visual systems. The invention was distinguished from the prior art system only in that at least four switches (of the cursor key) were operable in single or pair wise action in at least six directions and allowed direct cursor jumps along slanting lines in diagonal directions. The board stated that the graphic design of menus was, as a rule, not a technical aspect of a menu-driven control system. Nor was the practical use of such menus genuinely a problem with which the skilled person, in his function as a technical expert, was confronted. For the purpose of the problem and solution approach, the problem had to be a technical problem which the skilled person in the particular technical field might have been asked to solve at the priority date. The board therefore concluded that, in the case at issue, the technical problem had to be formulated in a more limited way than on the basis of the alleged advantages of moving a cursor diagonally over the TV screen. The actual technical problem resided in providing an appropriate cursor key enabling the user to move the cursor in six or more such directions.

In **T 951/02** claim 1 of the application related to a combined games and gambling device. Technical Board of Appeal 3.4.03 held that, according to the statement of the problem in the application, the aim of the invention was to provide a games device offering a player particular inducements to play, thus preventing the player from starting to become bored. No objective technical problem was identifiable in this wording, however. To arrive at the objective technical problem, the aforementioned non-technical problem stated in the application had to be reformulated to indicate the aim of achieving enhanced flexibility in terms of the possible games systems of the known games device. The board held, however, that the replacement of one of the existing gambling systems in the device by a games system did not involve an inventive step, since a device for gambling possesses per se all the technical requirements for the operation of a game. The requisite modifications to the gambling device were therefore limited to the adaptation of the control program to the new games system. Such modifications to the control program of the device were within the scope of normal practice for an expert.

In **T 336/07** the application related to a method of operating an electronic video poker machine in a sequence of display, detection and determination steps. It also included non-technical aspects, in that the various steps of operation of the video poker machine were carried out in accordance with rules for playing a video poker game. The board held that a set of game rules defines a regulatory framework agreed between players

and concerning conduct, conventions and conditions that are meaningful only in a gaming context. It is perceived as such by the players involved, and as serving the explicit purpose of playing a game. As such an agreed framework it is a purely abstract mental construct, although the method and means for carrying out game play in accordance with such a set may well be technical in nature. The board found that the subject-matter of the claims did not involve an inventive step.

In **T 318/03** the invention related to a method for allocating optimum operating parameters, in particular operating frequencies. The objective problem posed in the application was to indicate a method for allocating radio frequencies in a radio network having cells of differing sizes with a view to reducing the extent to which signals were subject to interference from other transmitters' signals. Technical Board of Appeal 3.5.03 established that this was a technical problem. The claimed method influenced the resulting physical radiation field and thus solved the problem by technical means.

In **T 309/05** the board found it appropriate to adopt the approach in COMVIK (**T 641/00**, OJ 2003, 352). The board stated that the problem of automating the generation of Internet domain names, so that only names which are both available and desirable are presented to a potential buyer, must be stripped of aesthetic and semantic considerations, since these lie in a field excluded from patentability by the provisions of Art. 52(2)(b) and (c) EPC 1973. Reformulating the problem into non-technical and technical components left simply the concatenation of a text string provided by a user with a predetermined string as a technical problem.

In **T 928/03** the application related to an interactive video game in which a user controls at least one player character displayed on a screen. The board stated that making a possibly concealed indicator clearly visible on a display screen to the user of an interactive video game does not exclusively address a human mental process but contributes an objective technical function to the display. The functional quality is not cancelled by the fact that the visualised information will also enter into a decision of the user interacting with the video game displayed on the screen. In applying the COMVIK approach in a fair manner, its purpose must be borne in mind: on the one hand, the approach is to make sure that non-technical aspects do not support a finding of inventiveness; on the other hand, actual contributions to the technical character by any feature of an invention must be taken into account when assessing inventive step. In this context, a game rule constraint has to be distinguished carefully from its technical implementation.

In **T 958/03** the invention related to a method and apparatus for generating purchase incentives based on price differentials. In the board's judgment, the appellant's main contribution resided in a refined marketing scheme which based the coupon issuing process on commercial and/or psychological assumptions about consumer behaviour in the light of price differentials and brand loyalty. In the case at issue, the non-technical idea rather belonged to the non-patentable motivation phase preceding in principle any invention. It might therefore be included in the formulation of the technical problem and, thus, was disregarded in the assessment of inventive step.

8.2. Combination invention

8.2.1 Existence of a combination invention

In assessing the inventive step involved in an invention based on a combination of features, consideration must be given to whether or not the state of the art was such as to suggest to a skilled person precisely the combination of features claimed. The fact that an individual feature or a number of features were known does not conclusively show the obviousness of a combination (**T 37/85**, OJ 1988, 86; **T 656/93**, **T 666/93**, **T 1018/96**). The question is not whether the skilled person, with access to the entire prior art, **could** have made the combination according to the invention, but whether he actually **would** have done so in expectation of an improvement (see **T 2/83**, OJ 1984, 265; **T 713/93**, **T 223/94**, **T 406/98**). When assessing inventive step in a combination invention, the decisive criterion is not whether individual elements of the combination were known and obvious from prior art, but whether the state of the art would lead a skilled person to this particular overall combination of (possibly already known) features. Were this not so, it would be impossible for a combination consisting exclusively of known individual features to involve an inventive step (**T 388/89**, **T 717/90**, **T 869/96**).

A mere aggregation of features must be distinguished from a combination invention.

The existence of a combination invention requires that the relationship between the features or groups of features be one of **functional reciprocity** or that they show a combinative effect beyond the sum of their individual effects. In **T 1054/05** the board stated that two features interact synergistically if their functions are interrelated and lead to an additional effect that goes beyond the sum of the effects of each feature taken in isolation. It is not enough that the features solve the same technical problem or that their effects are of the same kind and add up to an increased but otherwise unchanged effect (see also point I.D.8.2.2 below).

In **T 406/98** the board found that as a rule, particularly when large numbers of citations were involved, it was necessary to ask **why** the skilled person would consider documents in that specific combination, and whether, **not knowing the invention**, he had reason to do so. In this case, a complete solution to the problem required deliberate selection from a large number of citations.

In **T 55/93** the appellant's argument, according to which the alleged invention should have been regarded as a mere aggregation of solutions of two independent partial problems which were not interrelated, was not accepted by the board. In the case in point, not only could the primary problem underlying the contested patent neither be found nor be derived from the prior art documents, but also the claimed features complemented each other. The board stated that the features were functionally linked together, which was the actual characteristic of a combination invention. It was wrong to select, on the basis of a plurality of partial problems to be solved, the respective constructional means used in the apparatus combination, or the steps of the method worded in terms of functional features, which by working together provided a solution to the problem taken as a whole. The non-obviousness of a combination claim turned on

the simultaneous application of all its features (**T 175/84**, OJ 1989, 71). A combination effect was also acknowledged in **T 120/88**, **T 731/94**, **T 434/95** and **T 897/95**.

8.2.2 Partial problems

In patent law terms, the existence of a combination of features, i.e. of a combination invention, is to be viewed differently from the mere existence of partial problems, i.e. of an aggregation of features. According to current case law, partial problems exist if the features or sets of features of a claim are a mere aggregation of these features or sets of features (juxtaposition or collocation) which are not **functionally interdependent**, i.e. do not mutually influence each other to achieve a technical success over and above the sum of their respective individual effects, in contrast to what is assumed in the case of a combination of features (**T 389/86**, OJ 1988, 87; **T 387/87**, **T 294/90**, **T 363/94**). It should also be borne in mind that solutions to partial problems in differing technical fields must be assessed on the basis of the knowledge and expertise of the person skilled in the art where the solution is found (**T 32/81**, OJ 1982, 225; **T 324/94**).

In **T 389/86** (OJ 1988, 87) the relationship between the two groups of features was not one of functional reciprocity. The board ruled that in such circumstances no combinative effect could be advanced in support of inventive step; rather the question was whether each group, taken singly, was obviously derivable from the prior art. For the subject-matter of the claim to be inventive, it sufficed if one of these groups was (**T 345/90**, **T 701/91**).

Similarly, in **T 130/89** (OJ 1991, 514) the technical problem intended to be solved by the claimed invention also consisted of two technically independent partial problems, each solved independently by one of the claimed subject-matter's features. The board held that the independence of the claimed subject-matter's features (each producing a different effect) meant that in assessing inventive step the two closest states of the art had to be considered to enable each of the two partial problems to be defined. It concluded that since each of the partial problems was solved by means which merely performed their known functions, each partial solution was obvious and the invention thus lacked inventiveness. In **T 597/93** the board again saw no inventive step in combining the claim's two features - both known per se - since they related to the solving of two entirely separate partial problems. It cited **T 687/94** which held that in such cases the solutions could be assessed separately against the prior art (see also **T 315/88** and **T 65/90**).

In **T 711/96** the board found that characterising features (a) and (b) functioned completely independently of each other; there was no functional interplay (combination) between them. Although the setting for one value (e.g. spread) could indirectly affect that for the other (e.g. quantity), in that spread and quantity could both be adjusted upwards to maintain constant distribution, the two features were not directly related. In other words, the characterising features did not necessarily influence each other, although they could do. The board therefore assessed the inventive step of the two features separately, and concluded that both partial problems were obvious.

In **T 410/91** the board of appeal stated that no inventive step was involved since, although all the measures in claim 1 contributed to an increase in the efficiency of the plant, that contribution was based on known, different individual effects which resulted in these measures being executed in a manner expected by the skilled person. The subject-matter of claim 1 therefore involved the stringing-together of known measures which displayed their characteristic effects; no synergistic effect based on a combination of the individual measures was discernible in the sense of a mutual influence on their respective operation (see also **T 144/85**, **T 141/87**, **T 407/91**, **T 1277/01**).

8.3. Technical disclosure in a prior art document

In line with the established case law of the boards of appeal, when investigating inventive step it should be borne in mind that the technical disclosure in a prior art document should be considered in its entirety, as it would be done by a person skilled in the art and that it is not justified arbitrarily to isolate parts of such document from their context in order to derive from them technical information which would be distinct from the integral teaching of the document (**T 56/87**, OJ 1990, 188; **T 768/90**, **T 223/94**, **T 115/96**, **T 717/96**, **T 414/98**). According to **T 95/90**, **different parts of text in a document** can be combined if there is nothing to stop the skilled person from doing so.

8.4. Features not contributing to the solution of the problem

According to the established case law of the boards of appeal, features which do not contribute to the solution of the problem set in the description are not to be considered in assessing the inventive step of a combination of features (**T 37/82**, OJ 1984, 71). According to this decision, in assessing the inventive step of a combination of features, consideration had to be given to a feature only if the applicant had provided evidence that it contributed, either independently or in conjunction with one or more of the other features, to the solution of the problem set in the description (see also **T 65/87**, **T 144/90**, **T 206/91**, **T 574/92**, **T 226/94**, **T 912/94**, **T 15/97**, **T 471/98**, **T 442/02**). Therefore, only those claimed features are to be considered which contribute causally to the solution of the problem (**T 285/91**). In **T 294/89** the board stated that the additional feature provided no surprising advantage and did not make any contribution to solving the problem indicated. Hence, the said additional feature was not relevant for assessing the inventive step of the combination of features claimed.

In **T 589/95** the terms of the solution of the technical problem extended into an area of use where it had been admitted that the relevant problem was known not to arise in practice. The board stated that, for such an area, the features of the solution did not contribute to the solution of the technical problem and could not be taken into account in the assessment of inventive step.

With reference to **T 119/82**, Board 3.3.05 held in **T 72/95**, **T 157/97**, **T 176/97** and **T 158/97** that similar considerations applied to technically non-functional modifications. An inventive step could not be claimed on the basis of a non-functional modification of a known device. If a known device was modified by adding a feature which had no technical function, this modification could not be inventive. However, the board was

obliged to assess the existence of a technical function alleged to be relevant to inventive step. The board was aware of **T 1027/93**, in which another board had observed (obiter dictum) that the Convention did not require that an invention, to be patentable, had to entail any useful effect, and that the apparent futility of a given *modus operandi* could rather be said to render it completely non-obvious. The board emphasised that the concept of "invention" implied a technical character. Technically non-functional modifications were therefore irrelevant to inventive step, even if the skilled person would never think of such a modification. A parallel could be drawn here with a new design based on a known technical concept. The new design might be a surprise and thus "not obvious" for professional designers. Nevertheless if the modifications had no technical relevance and were, from a technical point of view, arbitrary, the new design was not patentable and did not involve an inventive step.

8.5. Foreseeable disadvantageous or technically non-functional modifications

In some decisions the subject-matter was found not to involve an inventive step, when the invention was the result of a foreseeable disadvantageous modification of the closest prior art (**T 119/82**, OJ 1984, 217; **T 155/85**, OJ 1988, 87; **T 939/92**, OJ 1996, 309; **T 72/95**).

The board in **T 119/82** (OJ 1984, 217) had already found that disadvantageous modifications did not involve an inventive step if the skilled person could clearly predict these disadvantages, if his assessment was correct and if these predictable disadvantages were not compensated by any unexpected technical advantage.

8.6. Substitution of materials - analogous use

According to **T 21/81** (OJ 1983, 15), it had to be regarded as forming part of his normal activities for a skilled person to select, from the materials known to him as suitable for a certain purpose, the one which was the most appropriate. The skilled person should therefore be at liberty, within the constraints of standard technical progress, to use alternative means known by him to have the same effect (**T 324/94**). In **T 410/92** the board also held that using higher-quality materials in the design of single-phase synchronous motors with a double-pole permanent-magnet rotor was obvious. The appellants had argued that the skilled person using the superior materials available to him would be confronted with baffling starting problems. The board however concluded that the skilled person's encountering known problems when using newly developed materials would not deter him from using them in order to achieve specific, desired improvements, particularly since the means of overcoming such problems could be derived from the prior art.

The Headnote in **T 192/82** (OJ 1984, 415) read as follows: If an article is known as a combination or mixture of components fulfilling known functions, the generation and application of an improved novel component for the same purpose may be patentable as such and also as an improved article incorporating the same. If the component in question forms, on the other hand, part of the state of the art together with its relevant

properties, the incorporation thereof in the same article will be obvious in view of its predictable beneficial effect ("analogous substitution").

In this connection the board also established in **T 130/89** (OJ 1991, 514) that the use of a known material on the basis of its known properties and in a known manner to obtain a known effect in a new combination was not normally inventive ("similar use"). Exceptions to this principle might be allowed in special cases, e.g. where a selection brought unexpected advantages, a known prejudice was overcome or unforeseen difficulties were encountered, such as the need to alter another component (see also **T 1216/05**, **T 330/07**).

Following these decisions, the board summarized as follows in **T 213/87**; in the absence of any unexpected effect, the mere substitution of an element by another known for its relevant properties to provide that known effect could not be regarded as patentable.

8.7. Combination of documents

It would not be obvious to a skilled person to combine an isolated, very old document (i.e. 50 year old document), which had not given rise to a trend in the art and whose teaching ran counter to the present trend, with the document reflecting the closest state of the art (**T 261/87**, **T 366/89**, **T 404/90**).

In **T 745/92** the board pointed out that the disclosure of two prior documents - even if they were classified under the same IPC classification - could only be combined so as to result in a finding of lack of inventive step if such combination would have been obvious to a skilled person seeking to solve the problem underlying the claimed invention (**T 104/95**, **T 395/00**).

In **T 552/89** the board confirmed that, when assessing inventive step, it was not permissible to combine the teachings of different documents within the state of the art in order to establish the obviousness of a claimed invention, unless it would have been obvious for the skilled person to do so at the time of filing. When a problem defined by reference to the closest prior art as disclosed in a primary document consisted of individual problems, board of appeal case law stated that the skilled person could be expected to take account of solutions to the individual problems proposed in different secondary documents in the same or neighbouring technical fields. Thus, the teachings of secondary documents might be combined with the disclosure of the closest prior art if such secondary documents provided solutions to specific individual problems forming part of the objective problem in progressing from the closest prior art, in particular when such individual solutions were merely aggregated together in the claimed invention.

In **T 302/02** the board added that, if an invention consisted of a new combination of features taken from different technical areas, a discussion whether or not it was obvious would normally involve at least as many documents as technical areas combined in it. The board adopted the approach taken in **T 552/89**, according to which a technical problem might be formed of "individual problems". The number of individual problems obviously depended on the degree of detail of the claim under consideration and the

cited decision did not suggest that beyond a certain number the presence of an inventive step might be taken for granted. On the contrary, it was said to be obvious to try to solve the individual problems as long as the corresponding solutions were "merely aggregated together" in the claim.

8.8. Chemical inventions

8.8.1 Problem and solution approach

In a number of chemistry decisions the problem and solution approach - based on landmark decisions **T 1/80** (OJ 1981, 206), **T 24/81** (OJ 1983, 133) and **T 248/85** (OJ 1986, 261) - involves the following steps:

- a) establishing the closest prior art
- b) defining the problem in the light of that prior art
- c) identifying the solution
- d) demonstrating the success of the solution
- e) optionally reformulating the problem
- f) examining the obviousness of the solution in view of the state of the art

Demonstrating the success of the solution and reformulating the problem are particularly important steps (see **T 231/97**, **T 355/97**).

8.8.2 Structural similarity

To deny inventive step for novel chemical compounds because of their structural similarity to known chemical compounds amounted to an allegation that a skilled person would have reasonably expected the same or similar usefulness of both the known and the novel compounds as the means for solving the technical problem underlying the application in question. Such an expectation would be justified, if the skilled person knew, be it from common general knowledge or from some specific disclosure, that the existing structural differences of the chemical compounds concerned were so small that they would have no essential bearing on those properties, which were important for solving the said technical problem and could be disregarded (**T 852/91**).

In **T 643/96** the board held that the concept of bioisosterism did form part of the common general knowledge of those skilled in the art, but that it had to be applied with caution when deciding upon inventive step. In the field of drug design, any structural modification of a pharmacologically active compound was, in the absence of an established correlation between structural features and activity, expected a priori to disturb the pharmacological activity profile of the initial structure. This also held true for an alleged case of bioisosterism, which was one option of a structure-activity relationship, as long

as it was not an established case of bioisosterism (see also **T 548/91**). In **T 643/96** it was held that, when deciding upon inventive step in relation to pharmacologically active compounds, what was essential was not whether a particular substructure of a chemical compound was replaced by another known isosteric one, but whether information was available on the impact of such a replacement on the pharmacological activity profile of the specific (group of) compound(s) concerned (see also **T 467/94**, **T 156/95**).

In **T 930/94** the board held that knowledge of the fact that one specific member of a class of chemical compounds did not lead to the effect achieved by several other members of this class, did not, without additional indications, mean that such an effect could be attributed to all the compounds in this group. In such circumstances, the effect in point did not lead to a recognition of the existence of a technical concept that could be generalised (**T 641/97**, **T 209/98**, **T 853/03**).

In **T 989/93** the board stated that, in the absence of the appropriate common general knowledge, no conclusions are possible on the basis of the known properties of one group of chemical compounds (here: benzene derivatives) regarding the properties of a different group of chemical compounds (here: naphthalene derivatives).

8.8.3 Broad claims

Art. 56 EPC 1973 requires the claimed invention, i.e. the proposed technical solution for a given technical problem, not to be obvious to a skilled person from the state of the art. If the inventive step of a claimed invention is based on a given technical effect, the latter should, in principle, be achievable over the whole area claimed (**T 939/92**, OJ 1996, 309; **T 694/92**, OJ 1997, 408; **T 583/93**, OJ 1996, 496).

T 939/92 (OJ 1996, 309) contained fundamental rulings on broad claims in the field of chemistry. The board held that in view of the state of the art the technical problem which the patent in suit addressed was the provision of further chemical compounds with herbicidal activity. It was necessary for all the claimed compounds to possess this activity. Moreover, the question as to whether or not such a technical effect was achieved by all the chemical compounds covered by such a claim, might properly arise under Art. 56 EPC 1973, if this technical effect turned out to be the sole reason for the alleged inventiveness of these compounds. The appellants' submission that the test results contained in the description showed that **some** of the claimed compounds were indeed herbicidally active could not be regarded as sufficient evidence to lead to the inference that substantially **all** the claimed compounds possessed this activity. In such a case the burden of proof rested with the appellants. The requirements of Art. 56 EPC 1973 had not therefore been met (**T 268/00**, **T 1188/00**, **T 320/01**, **T 1064/01**, **T 924/02**).

Following **T 939/92** (OJ 1996, 309), the board stated in **T 668/94** that the technical problem could only be taken into account in the assessment of inventive step if it could be accepted as having been successfully solved, i.e. if it were credible that substantially all the claimed compounds possessed the plant growth regulating activity. When only some and not substantially all claimed compounds exhibited a particular technical effect, the conclusion had to be that the invention as broadly defined in the independent claim

was not a solution to the technical problem of achieving the given technical effect, with the consequence that the alleged technical effect of some of the claimed compounds was to be disregarded when determining the objective problem underlying the invention and thus when assessing inventive step.

In **T 942/98** the problem as per the application was the preparation of improved selective herbicides. The board referred to the above-mentioned case law and did not agree with the applicant that, in the present case, he merely had to show an improved effect at the direct interface between prior art and the application in order to demonstrate, without providing further details, that such an improvement applied without qualification for the entire breadth of the claim. The appellant's position, in the board's view, amounted to allowing the applicant to decide how broad a claim could be, whether or not an improvement in the effect of all the compounds claimed was actually credible.

8.8.4 Intermediate products

In key decision **T 22/82** (OJ 1982, 341) the board ruled that the preparation of new intermediates for a surprisingly advantageous complete process for the preparation of known and desired end products was inventive.

Again in **T 163/84** (OJ 1987, 301) intermediate chemical products were held to be patentable on the grounds that their further processing to the known end products involved an inventive step. The board however held that a new chemical intermediate did not become inventive merely because it was prepared in the course of an inventive multi-stage process and was further processed to a known end-product; there had to be other factors as well, such as that the process for preparing the new intermediate had enabled it to be prepared for the first time and had done so inventively and other methods of preparing it had appeared to be ruled out.

In **T 648/88** (OJ 1991, 292) the board disagreed with the view expressed in **T 163/84**, pursuing instead the line taken in **T 22/82**. An intermediate intended for the preparation of a known end-product was deemed to be inventive if its preparation took place in connection with inventive preparation or inventive further processing or in the course of an inventive complete process.

In **T 1239/01** the board confirmed that an intermediate intended for the preparation of a known end-product is deemed to be inventive if its preparation took place in the course of an inventive complete process.

In **T 65/82** (OJ 1983, 327) it was explained that new intermediates which take part in (non-inventive) analogy processes for sequent products (i.e. end products or intermediates of various kinds), must - in order to qualify as intermediates - provide a structural contribution to the subsequent products. Even where this condition is met, such intermediates are not thereby unconditionally inventive, i.e. not without taking the state of the art into consideration. As state of the art in relation to intermediates there are two different areas to be taken into account. One is the "close-to-the-intermediate" state of the art. These are all compounds identified from their chemical composition as lying

close to the intermediates. On the other hand the "close-to-the-product" state of the art must also be taken into account, i.e. those compounds identified from their chemical composition as lying close to the subsequent products.

In **T 18/88** (OJ 1992, 107) the applicants had argued that the insecticidal activity of the known end products was significantly superior to that of another known insecticide with a similar structure; this was sufficient to establish an inventive step for the intermediate products, even if the end products were not novel and/or inventive. The board, referring to **T 65/82** (OJ 1983, 327), rejected the applicants' argument on the following grounds: claimed intermediates must themselves be based on an inventive step to be patentable. Whether, under certain circumstances, new and inventive subsequent products might support an inventive step of intermediates was not the question here, because the subsequent products in this case were either not novel or not inventive. The superior effect of subsequent products which were neither novel nor inventive was not sufficient to render the intermediates inventive (**T 697/96**, **T 51/98**).

8.9. Equivalents

According to established board of appeal case law, equivalents which are not disclosed in a published document must not be considered in assessing novelty, as this properly belongs to the examination for inventive step (see **T 167/84**, OJ 1987, 369; **T 446/88**, **T 517/90**; see also Guidelines C-IV, 9.2 - April 2010 version). In **T 697/92**, the board dealt with the concept of "equivalent means", according to which two means were equivalent if, despite having different embodiments, they fulfilled the same function with regard to the same result. Both means performed the same function if they shared the same basic idea, i.e. if they applied the same principle in the same way. The result was the totality of the technical effects produced by the means. In order to be considered as equivalents, the means had to achieve the same kind and quality of result. A means was thus not equivalent if, because of its different embodiment, it led to a result of the same kind but of a different quality or degree of effectiveness. The result did not necessarily even have to be better; it was sufficient for it to be different, since it was not the result itself which was patentable but the means by which it was achieved (see **T 818/93**, **T 929/02**).

8.10. Problem inventions

The discovery of an unrecognised problem may in certain circumstances give rise to patentable subject-matter in spite of the fact that the claimed solution is retrospectively trivial and in itself obvious (see **T 2/83**, OJ 1984, 265; **T 225/84**). The posing of a new problem did not represent a contribution to the inventive merits of the solution if it could have been posed by the average person skilled in the art (**T 109/82**, OJ 1984, 473). It also had to be taken into consideration that it was the normal task of the skilled person to be constantly occupied with the elimination of deficiencies, the overcoming of drawbacks and the achievement of improvements of known devices and/or products (see **T 15/81**, OJ 1982, 2; **T 195/84**, OJ 1986, 121). In **T 532/88** the board confirmed the established principle that to address a problem simply by looking for ways of overcoming difficulties arising in the course of routine work did not constitute inventiveness. Following this case

law, the boards held in **T 630/92**, **T 798/92**, **T 578/92**, **T 610/95**, **T 805/97** and **T 1417/05** that the posing of the problem could not confer any inventive merit on the claimed subject-matter. Inventive step was however acknowledged in **T 135/94**, **T 540/93** (pet doors) and **T 1236/03** on the ground (also) that the posing of the problem was not obvious.

In **T 971/92** the board emphasised that the appreciation of conventional technical problems which formed the basis of the normal activities of the notional person skilled in the art, such as the removal of shortcomings, the optimisation of parameters or the saving of energy or time, could not involve an inventive step. The appreciation of a technical problem could thus only contribute to the inventive step in very exceptional circumstances. However, if an applicant nevertheless wished to rely on an assertion that the inventive activity resided in the recognition of a technical problem to which the solution was admittedly obvious, then the minimum requirement to be met was that this technical problem be clearly and unambiguously disclosed in the application as filed (**T 43/97**, **T 1417/05**).

In **T 566/91** the invention related to a soft nystatin pastille formulation for treatment of candidiasis in the oral cavity. In the case in point the board did not agree with the submission by the appellants that the technical problem underlying the contested patent consisted in the unrecognised problem of poor patient compliance, as the average skilled person could have posed that problem where - as in that particular case - one necessarily came to light when an object or product was used. Consequently, a problem which amounted to no more than noticing obvious non-compliance with an obvious desideratum in a given situation, namely poor patient compliance using nystatin formulation as a result of the unpleasant taste of the active substance, could not be retained as the actual problem to be solved.

8.11. New use of a known measure

When determining inventive step in the case of a new use of a known measure, the boards of appeal examine whether or not the problem which has been solved with a known measure in a known case differs from the problem posed in the case to be decided. If this examination reveals that there is no fundamental difference between the two problems, it can in principle be concluded that there is no inventive step if the known measure is adopted (see in particular **T 39/82**, OJ 1982, 419; **T 142/84**, OJ 1987, 112; **T 332/90**, **T 485/91**, **T 25/97**). In **T 39/82** (OJ 1982, 419) the board stated that it could not be considered obvious for the skilled person to use a known measure in a different context since the problems differed fundamentally from one another.

Referring to **T 39/82** (OJ 1982, 419) the board confirmed in **T 818/93** that in a **combination invention** all the features might be known per se - the invention resided in the way the features were interrelated, both structurally and functionally. In assessing the inventive step of the combination in question it was therefore of no consequence that a suitable structure was already known, provided its use and application in the conditions, and circumstances disclosed in the patent were not suggested by the cited prior art.

In **T 741/92** the invention involved the new use of a known means, namely a particular mesh structure. In the case of such inventions the board took the view that it was of little importance that the means was known per se if new properties and purposes came into play in its use. The known means was used in the invention to obtain a result not previously known or obvious.

Summing up in **T 301/90**, the board held that it was a generally accepted principle in the assessment of inventive step that, whereas the use of a known measure to achieve a known result on the basis of the expected inherent effect was not normally inventive, the indication of a new and non-obvious technical result, which could be achieved through these known effects (for application to the field of chemistry, see **T 4/83**, OJ 1983, 498 and to the field of physics, see **T 39/82**, OJ 1982, 419) might nevertheless convert the use of this known measure into a new and non-obvious tool for solving a new technical problem. It might thus represent an enrichment of the art and imply an inventive step (see **T 1096/92**, **T 238/93**).

In **T 590/90** the respondents argued that both the measures taken that distinguished the technical teaching of the contested patent from that of document 1 were already part of the prior art, and their application to the process described in document 1 was obvious. However, the board held that the application of a measure known as such, contrary to warnings given in several documents, was not obvious. Since this measure involved an inventive step, the overall process of claim 1 encompassing that measure likewise involved an inventive step: the modification of a known process by two measures, at least one of which was not obvious, rendered the entire process inventive.

8.12. Obvious new use

In **T 112/92** (OJ 1994, 192) document (1), as the closest prior art, referred to the use of glucomannan as a thickener for an ungelled processed food product, but did not mention its function as a stabiliser. The board applied the principles set out in **T 59/87** (OJ 1991, 561) to the present case and stated that even if glucomannan did act as an emulsion stabiliser in preparing the product in accordance with document (1), this use would have been a hidden use. It came to the conclusion that the use of a substance as a stabiliser for emulsions, if not inextricably linked with its use as a thickening agent, was at least very closely related. The board held that it would have been obvious for the skilled person, knowing that glucomannan was effective as a thickening agent for emulsions, at least to try to find out if it was also effective as a stabiliser. Although **T 59/87** had found that a claim to an inherent but hidden later use of a known substance could be novel, the subject-matter of such a claim would still lack inventive step if the prior art indicated a well-established link between the earlier and later uses (see also **T 544/94**).

8.13. Need to improve properties

In its Headnote to **T 57/84** (OJ 1987, 53) the board stated that if a product is required to manifest a particular property (in this case a highly fungicidal effect) under various conditions, the superiority of the invention will depend on whether or not that property is improved under all conditions liable to be encountered in practice and particularly under

the various conditions evolved in order to test it (in this case exposure to water and wind). If comparative tests are cited in support of that superiority, it is their combined results that have to be considered. The decisive factor is whether the invention outperforms the substance used for comparison in the tests as a whole (in this case, results in the need to use a significantly lower concentration of the pollutant substance), even if the substance used for comparison proves better in one of the tests.

Following **T 57/84**, it was stated in **T 254/86** (OJ 1989, 115) that an invention which relied on a substantial and surprising improvement of a particular property did not also need to show advantages over the prior art with regard to other properties relevant to its use, provided the latter were maintained at a reasonable level so that the improvement was not completely offset by disadvantages in other respects to an unacceptable degree or in a manner which contradicted the disclosure of the invention fundamentally (see also **T 155/85**, OJ 1988, 87). It was thus not necessary for there to be an improvement in every respect (**T 302/87**, **T 470/90**).

In **T 155/85** (OJ 1988, 87) it was further pointed out that subject-matter falling structurally between two particular embodiments of cited disclosure and displaying, in all relevant respects, effects substantially between those known for the same embodiments, lacked inventive step in the absence of other considerations.

8.14. Disclaimer

In **G 1/03** and **G 2/03** (OJ 2004, 413 and 448), the Enlarged Board of Appeal dealt with the allowability of "undisclosed disclaimers", i.e. "negative features" which have no basis in the application as filed. The Enlarged Board held that a disclaimer which was or became relevant for the assessment of inventive step or sufficiency of disclosure added subject-matter contrary to Art. 123(2) EPC 1973 (**T 1028/02**).

For further information on disclaimers, see also chapters II.B.1.2.1 and III.A.4.

8.15. Optimisation of parameters

In key decision **T 36/82** (OJ 1983, 269), the board stated that inventive step was not considered to be constituted by efforts directed at the concurrent optimisation of two parameters of a particular device by the simultaneous solution of two equations which were known per se and respectively expressed those parameters as functions of certain dimensions of the device. The fact that it had proved possible to find a range of values for the dimensions in question which provided an acceptable compromise between the two parameters could not be considered surprising where there were indications in the prior art suggesting that favourable results might be obtained by the method of calculation applied.

In **T 263/86** the invention related to a spectacle lens with an astigmatic effect. The board of appeal pointed out that the relationship between residual astigmatism, focussing error and frequency response could be assumed to be known by a spectacles expert. The board therefore saw the quality formula as merely the result of simultaneous optimisation

of a number of lens properties which led to a compromise lying within the skilled person's discretion. However, such compromises in the case of a parameter optimisation were not deemed to be surprising and their discovery was thus not considered to involve an inventive step.

In a number of other decisions, all of which referred to **T 36/82** (OJ 1983, 269) the subject-matter was found not to involve an inventive step, particularly when the problem addressed was to find a suitable compromise between different parameters (**T 38/87**, **T 54/87**, **T 655/93** and **T 118/94**). In **T 410/87** the board stated that it was part of the activities deemed normal for the skilled person to optimise a physical dimension in such a way as to reach an acceptable compromise, serving the intended purpose, between two effects which were contingent in opposing ways on this dimension (see also **T 409/90**, OJ 1993, 40; **T 660/91**, **T 218/96**, **T 395/96**, **T 660/00**).

In **T 73/85** the board stated that the very fact that the problem of improving the property in question was solved not - as was normal - by means of a specific change in structural parameters, but by amending process parameters, had in fact to be considered surprising. In this case it did not matter that the individual reaction conditions claimed in the disputed patent were known per se; more important was whether the skilled person, in expectation of the sought-after optimisation had suggested, or - in the absence of possible predictions - had tried as a matter of priority, the combination of measures known per se claimed.

In **T 500/89** the board established that the fact that individual parameter areas taken per se were known did not imply that it was obvious to combine them specifically to solve the problem according to the contested patent. The combination of the individual parameter areas was not the result of merely routine optimisation of the process according to document 1, as there was nothing in said document to suggest this combination.

8.16. Small improvement in commercially used process

In **T 38/84** (OJ 1984, 368) the board of appeal pointed out that the achievement of a numerically small improvement in a process commercially used on a large scale (here enhanced yield of 0.5%) represented a worthwhile technical problem which should not be disregarded in assessing the inventive step of its solution as claimed (see also **T 466/88** and **T 332/90**). In **T 155/85** (OJ 1988, 87) the board added that it was correct to say that even small improvements in yield or other industrial characteristics could mean a very relevant improvement in large-scale production, but the improvement had to be significant and therefore above margins of error and normal fluctuations in the field in consequence of other parameters. In **T 286/93** the invention related to a process for manufacturing wrapping paper and board. The results for the process had shown that the machine speed and the mechanical quality of the paper obtained had improved by some 3 % vis-à-vis a process in which the order in which aluminium polychloride and cationic starch were added had been reversed. Since a process of this kind was obviously intended for the production of paper on an industrial scale, even a small improvement had to be regarded as significant.

8.17. Evidence of inventive step in the field of medicine

In **T 619/94** the board held that features that were known or obvious in the field of sandblasting could not automatically be transferred to the medical field without considering the particular situation in the latter field, since in the case in point the consistency of the human tissue to be removed by abrasion was different from that of the material normally removed by sandblasting.

In **T 913/94** the invention related to the use of a specific agent in the preparation of a medicament against gastritis. In the board's view, though gastritis and ulcer were distinct diseases, they had common aspects in relation to their causative factors. In the case in point the board investigated, whether an anti-ulcer medicament would also have been expected to be active against gastritis. It concluded that, if the manifestations of the second more serious disease (ulcer) were known to run through the manifestations of the first disease, and this assumption reliably substantiated was not confuted, then the activity of a medicament against the more serious disease would already strongly suggest an effect against the less serious one as well. Thus, the said agent was known for the treatment of experimentally-induced ulcer; its use for the preparation of a medicament for the treatment of gastritis did not involve any inventive merit.

8.18. Analogy process - envisageable product

The effect of a process manifests itself in the result, i.e. in the product in chemical cases, together with its internal characteristics and the consequences of its history of origin, e.g. quality, yield and economic value. It is well-established that analogy processes are patentable insofar as they provide a novel and inventive product. This is because all the features of the analogy process can only be derived from an effect which is as yet unknown and unsuspected (problem invention). If, on the other hand, the effect is wholly or partially known, e.g. the product is old or is a novel modification of an old structural part, the invention, i.e. the process or the intermediate therefore, should not merely consist of features which are already necessarily and readily derivable from the known part of the effect in an obvious manner having regard to the state of the art (**T 119/82**, OJ 1984, 217; see also **T 65/82**, OJ 1983, 327).

According to **T 2/83** (OJ 1984, 265), so-called analogy processes in chemistry are only claimable if the problem, i.e. the need to produce certain patentable products as their effect, is not yet within the state of the art.

In **T 1131/05** the board deemed a process claim directed to an analogy process to be new and inventive.

T 595/90 (OJ 1994, 695) was concerned with the inventiveness of a product which could be envisaged as such but for which no known method of manufacture existed. Accordingly, a product which could be envisaged as such with all characteristics determining its identity including its properties in use, i.e. an otherwise obvious entity, might nevertheless become non-obvious and claimable as such, if there was no known way or applicable (analogous) method in the art for making it and the claimed methods

for its preparation were therefore the first to achieve this and do so in an inventive manner (**T 268/98**, **T 441/02**).

In **T 803/01** the board concluded that by analogy with **T 595/90**, the decisive question in the case in point was whether the polylactide in the claimed degree of purity was achievable at the priority date of the application in suit or whether there was an obvious way leading to it. But as this was not the case, the board concluded that the claimed subject-matter involved an inventive step.

In **T 233/93** the combination of properties defining the claimed products had been a desideratum which the skilled community had striven to achieve. These properties, however had been considered to be irreconcilable. The board stated that such a desired product, which may appear obvious per se, may be considered non-obvious and be claimable as such, if there is no known method in the art to make it and the claimed methods for its preparation are the first to produce it and do so in an inventive manner (**T 1195/00**).

8.19. Examples on the denial of inventive step

8.19.1 Reversal of procedural steps

The mere reversal of procedural steps in the production of component parts could not provide justification for inventive step (**T 1/81**, OJ 1981, 439).

8.19.2 Purposive selection

If, for a particular application of a known process, the skilled person could obviously use a material generally available on the market and suitable for the purpose, and was also highly likely to use it for reasons irrespective of its characteristics, such use should not be considered as inventive on account of those characteristics alone. It stood to reason that if carrying out such a step was itself already obvious for other reasons, the natural choice of the particular means on the market-place was devoid of mental or practical effort, or of "purposive selection", in the absence of anything to the contrary (**T 513/90**, OJ 1994, 154; see also **T 659/00**).

8.19.3 Automation

In **T 775/90** the board ruled that mere automation of functions previously performed by human operators was in line with the general trend in technology and thus could not be considered inventive (**T 1175/02**, **T 438/06**).

The mere idea of executing process steps automatically, e.g. replacing manual operation by automatic operation, was a normal aim of the skilled person (**T 234/96**).

In developing an automated process from a known manual process, apart from simply automating the individual steps of the manual process, the skilled person will also incorporate the facilities that automation typically offers for the monitoring, control and

regulation of the individual process steps, provided they fall within the definition of technical skill (**T 850/06**).

8.19.4 Routine experiments

According to the case law of the boards of appeal enhanced effects could not be adduced as evidence of inventive step if they emerged from obvious tests (**T 296/87**, OJ 1990, 195; **T 432/98**, **T 926/00**, **T 393/01**).

In **T 308/99** the claimed use was based on a thoroughly obvious property of known substances. The slightly enhanced effects associated with the claimed use in comparison with substances used in prior art emerged from obvious tests.

Work involving mere routine experiments, such as merely conventional trial-and-error experimentation without employing skills beyond common general knowledge, lacked inventive step (**T 455/91**, OJ 1995, 684; **T 104/92**).

In **T 253/92** the subject-matter of claim 1 related to a process for the manufacture of a permanent-magnet alloy. In the board's view, a skilled person would have regarded it as obvious to try out a variety of alloys known from the prior art to be of similar composition to those of the better examples and to measure their magnetic properties.

8.19.5 Simplification of complicated technology

In **T 61/88** the board indicated that, in the face of an optimal but sophisticated solution to a technical problem, the skilled person could not be denied the capacity to recognise that less complicated alternatives generally achieved less perfect results and consequently to envisage such alternatives, at least in situations in which the advantages of decreased complexity could reasonably be expected to outweigh the resulting loss of performance (**T 817/94**).

In **T 505/96** the board concluded that the simplification of complicated technology in situations in which the advantages of decreased complexity could reasonably be expected to outweigh the resulting loss of performance must be considered to be part of the normal work of the person skilled in the art.

8.19.6 Choice of one of several obvious solutions

In **T 400/98** the board stated that applying one of the possible solutions which were available to the skilled person requires no particular skills and hence does not involve an inventive step (**T 107/02**).

In **T 588/99** the board stated that in the particular situation where a document explicitly defines any compound having a certain activity as a suitable component of a detergent composition, and urges the skilled person to look for such compounds in publications of other technical fields such as biochemistry and medicine, it requires no inventive activity to solve the technical problem of providing an alternative to the compositions disclosed in

such prior art by replacing the explicitly specified compounds having the given activity with any other such compounds which may be found by exploring the other technical fields.

In **T 190/03** of 29 March 2006 the board stated that in connection with the obviousness of a solution chosen from various possibilities, it is sufficient that the one chosen is obvious and not necessarily relevant that there are several other possible solutions. The board referred to **T 939/92** (OJ 1996, 309) where it was stated that (albeit in the field of chemistry) an arbitrary selection of a solution from a number of possibilities in the absence of a hint to do so is not inventive if not justified by a hitherto unknown technical effect that distinguishes the claimed solution from the other solutions. In the case before it, the board could not see any unknown or surprising effects, but only immediately predictable ones.

8.19.7 Several obvious steps

If the technical problem that the skilled person has set himself to solve brings him to the solution step by step, with each individual step being obvious to him in terms of what he has achieved so far and what remains for him to do, the solution is obvious to the skilled person on the basis of the prior art, even if two or more such steps are required, and it does not involve an inventive step (**T 623/97**, **T 911/98**, **T 558/00**, **T 1514/05**).

8.19.8 Selection from obvious alternatives

In **T 1072/07** the application related to an oxygen-fired front end for a glass forming operation. The prior art documents proposed two possibilities for solving the problem of choosing the fuel for the burners and thus two types of burners, an air-gas fired burner or an oxygen-gas fired burner. The board concluded that to solve the problem, (how to select a suitable type of burner), the person skilled in the art had to make a choice between two well-known possibilities. Either choice, which in a particular situation would be based on balancing the advantages of the specific type of burner being selected, such as efficiency in its operation, with its disadvantages, such as technical adaptations required and costs involved, was obvious, since the types of burner to be chosen from were well-known.

9. Secondary indicia in the assessment of inventive step

9.1. General issues

According to established case law of the boards of appeal, a mere investigation for indications of the presence of inventive step is no substitute for the technically skilled assessment of the invention vis-à-vis the state of the art pursuant to Art. 56 EPC. Where such indications are present, the overall picture of the state of the art and consideration of all significant factors may show that inventive step is involved but this need not necessarily always be the case (see **T 24/81**, OJ 1983, 133 and **T 55/86**). Secondary indicia of this kind are only of importance in cases of doubt, i.e. when objective evaluation of the prior art teachings has yet to provide a clear picture (**T 645/94**,

T 284/96, T 71/98, T 323/99, T 877/99). Indicia are merely **auxiliary considerations** in the assessment of inventive step (**T 1072/92, T 351/93**).

In **T 754/89** - "EPILADY" the board detailed its reasons for ruling that an inventive step was involved. Although factors such as commercial success, the overcoming of prejudice, the age of the documents cited, the cost of advertising and the creation of a new market segment, the satisfaction of a long-standing need, the existence of imitations and forms of infringement had received considerable attention, particularly in the parties' written submissions, the technical facts of the case were such that secondary indications of inventive step had lost any relevance.

In **T 915/00** the board held that commercial implementation, licensing and the recognition of the inventor's merits by the scientific community constituted further convincing secondary indicia for the presence of inventive step.

9.2. Technical prejudice

According to the case law of the boards of appeal (see **T 119/82**, OJ 1984, 217; **T 48/86**), inventiveness can sometimes be established by demonstrating that a known prejudice, i.e. a widely held but incorrect opinion of a technical fact, needs to be overcome. In such cases, the burden is on the patentee (or patent applicant) to demonstrate, for example by reference to suitable technical literature, that the alleged prejudice really existed (**T 60/82, T 631/89, T 695/90, T 1212/01**).

A prejudice in any particular field relates to an opinion or preconceived idea widely or universally held by experts in that field. The existence of such prejudice is normally demonstrated by reference to the literature or to encyclopaedias published before the priority date. The prejudice must have existed at the priority date, any prejudice which might have developed later is of no concern in the assessment of inventive step (**T 341/94, T 531/95 and T 452/96**).

Generally speaking, prejudice **cannot** be demonstrated by a statement in a single patent specification, since the technical information in a patent specification or a scientific article might be based on special premises or on the personal view of the author. However, this principle does not apply to explanations in a standard work or textbook representing common expert knowledge in the field concerned (**T 19/81**, OJ 1982, 51; **T 104/83, T 321/87, T 392/88, T 601/88, T 519/89, T 453/92, T 900/95, T 1212/01**). In **T 515/91** the board regarded "ABC Naturwissenschaft und Technik" as a standard work (see also **T 461/92, T 152/93**). In **T 943/92** the existence of a prejudice was supported by a specialist book which reflected the technical knowledge in the special field of the contested patent. This book did not contain the opinion of just one specialist author, but that of experts in the field, as it had resulted from the collaboration of "numerous recognised scientists, technicians and practitioners as well as associations and institutes". General critical remarks in one textbook were not sufficient to substantiate an alleged prejudice, if a plurality of prior art documents pointed to the opposite (**T 134/93**).

Generally speaking, established board of appeal case law is **very strict** when it comes to recognising the existence of a prejudice. A solution put forward as overcoming a prejudice must clash with the prevailing teaching of experts in the field, i.e. their unanimous experience and notions, rather than merely cite its rejection by individual specialists or firms (**T 62/82**, **T 410/87**, **T 500/88**, **T 74/90**, **T 943/92**, **T 531/95** and **T 793/97**). The fact that a disadvantage is accepted or the prejudice simply ignored does not mean that a prejudice has been overcome (**T 69/83**, OJ 1984, 357; **T 262/87**, **T 862/91**).

In **T 1212/01** the patent related to pyrazolopyrimidinones for the treatment of impotence (Viagra). The patentee referred to some thirty scientific articles in order to demonstrate the existence of a technical prejudice that drugs lowering blood pressure were a cause of impotence rather than a form of treatment for that condition. The board, however, stated that the contents of such a selection from the prior art could not be considered per se as creating a technical prejudice against oral treatment of male erectile dysfunction. Such a prejudice could only be established by proving that, in relation to the technical solution, a relatively widespread error or misapprehension about the technical invention existed among skilled workers in the relevant field before the priority date of the patent in suit. This was not the situation in the present case.

In **T 550/97** the respondent (patent proprietor) had argued that, years after the invention, technically less advanced solutions had been filed for and marketed as a means of integrating different mobile radio networks. However, the board did not consider the fact that arguably less advanced solutions had been developed later, to be evidence of inventive step, as there was no reason to assume that later development was attributable to a technical prejudice which the present invention had needed to overcome.

In **T 347/92** the board pointed out that the finding of a relatively small operating window in an area which, according to the teaching of the most recent publications, was considered inaccessible, could not be considered obvious to a person skilled in the art.

One form of secondary indicia in the nature of a "technical prejudice" is a **development of the art in a different direction** (**T 24/81**, OJ 1983, 133; **T 650/90**, **T 330/92**).

In **T 883/03** the board found that the teaching that could have led to the characterising feature of claim 1 had long formed part of the state of the art; yet for all that time experts had been "**blind**" to that knowledge. In the case in point that was a further indication of the inventiveness of the solution proposed in claim 1.

In **T 872/98** the board pointed out that the presence of secondary indicia might also be attested by the fact that a competitor had, shortly after the priority date, filed a patent application with the German Patent Office in which the invention took an entirely different direction to the European application.

In **T 779/02** the board indicated that a prejudice could be proved by the fact that the closest prior art and the invention were separated by a long period of time (in this case

over 16 years), during which time the only solutions pursued led away from the invention, and the solution provided by the invention only becoming acceptable to experts in the field after this time.

9.3. Age of documents - time factor

The age of documents known long before the filing date might only be an indication of an inventive step if a need for the solution of an unsolved problem had existed for the entire period between the date of the documents and that of the invention (**T 79/82** and **T 295/94**). Nevertheless, the long period of time to be considered was not the period that had elapsed between the publication of a document and the filing of the European patent application disclosing the teaching of that document, but that between the time the problem became apparent and the date of filing of the European patent application providing a solution (**T 478/91**).

A period of 23 years between the publication date of the document deemed to be the closest prior art and the priority date of the contested patent in an economically significant and frequently studied field could normally be viewed as an indication of the presence of inventive step (**T 273/92**). In **T 203/93** and **T 795/93** a period of 11 years was considered to be an indication in support of inventive step, in **T 986/92** a period of 70 years, in **T 478/91** 80 years and in **T 626/96** 60 years (see also **T 774/89**, **T 540/92**, **T 957/92**, **T 697/94**, **T 322/95**, **T 255/97**, **T 970/97**, **T 6/02**).

In **T 330/92** the documents reflecting the general knowledge available to experts in the field of the application (injection mould technology for cashcard holders) had been published at least 17 years before the filing date of the contested patent. The board of appeal pointed out that the elements which could have led to the feature combination of claim 1 had thus long been known in the prior art. Nevertheless the experts had for all this time been "blind" to these findings. Nor had other applicants in the same field made use of the knowledge in question.

In **T 1077/92** the board faced the unusual situation of a problem and its ready solution having co-existed for 100 years in general, and more recently in a field of intensive research, and still the seemingly obvious step had not been taken. The board concluded that, as no other explanation could be found, this must have been because inventive insight was needed (**T 617/91**).

In **T 123/97** the failure to adopt an obvious solution to the technical problem underlying the patent in suit may have resulted from a variety of causes; for example, there may have been a commercial reason for not adopting this new technique, because the old technique was found satisfactory by the clients and could also be improved, thus avoiding considerable investment costs involved in the adoption of a new technique on an industrial scale.

9.4. Satisfaction of a long-felt need

The fact that the state of the art has been inactive over a long period prior to the invention may be an indication that an inventive step is involved if during that time an urgent need for improvement has demonstrably existed (see **T 109/82**, OJ 1984, 473; **T 555/91**, **T 699/91**). This indication is closely linked to the positive indications of the time factor and age of the cited document.

In **T 605/91** the board stated that it was not sufficient if only one individual skilled person discovered a "long-felt need". Only if various and repeated attempts to deal with the relevant disadvantages could be identified would such a long-felt need appear to have persisted.

In **T 1014/92** the board did not accept the appellant's further argument that the long period of time (about 35 years) during which documents (1) and (2) had been available to the public without having been combined, was in itself cogent evidence that there was no obvious connection between them. The board held that this conclusion might only be drawn if evidence relating to time were corroborated by other evidence, such as long-felt want (see also **T 1183/06**).

Where a process had been performed successfully on a commercial scale for more than 20 years in spite of economic disadvantages associated with it, and the claimed invention provided a solution to the technical problem of avoiding such economic disadvantages, this supported a finding of inventive step (**T 271/84**, OJ 1987, 405).

9.5. Commercial success

In principle, commercial success alone is not to be regarded as indicative of inventive step. The following requirements must first be met; a long-felt need must have been fulfilled, and the commercial success must derive from the technical features of the invention and not from other influences (e.g. selling techniques or advertising).

In **T 110/92** the board did not dispute that the heating assembly according to claim 1 might have been a commercial success. However, such a commercial success alone, with the technically relevant examination of the claimed subject-matter leading to a negative result, could not be regarded as forming the basis for an indication of inventive step even if the board were convinced that the success derived from technical features of the heating assembly and not from other causes such as those of a commercial nature (see **T 5/91**, **T 219/90**, **T 373/94**).

In **T 478/91** too, commercial success was not regarded as indicative of inventive step. The board pointed out that it was well known that the commercial success of a product could just as easily be due to factors other than its properties, in particular more streamlined manufacture, a market monopoly, advertising campaigns or efficient selling technique (see **T 270/84**, **T 257/91**, **T 712/92**).

In **T 1212/01** the patent related to pyrazolopyrimidinones for the treatment of impotence (Viagra). The board stated that in order to establish commercial success as an indicia of inventive step two evidentiary steps were required. Firstly, commercial success must be demonstrated and, secondly, it had to be shown that such success resulted from the claimed invention and not from one or more other causes. Viagra had been the subject of various awards and praise in various journals. The board stated that the prizes would have been significant if awarded by persons who understood patent law. If however the prizes were awarded for the product's life-enhancing nature, or for the appellants' high standard of research, or for a high level of sales, then, for all that any of those reasons might well be prize-worthy, the prizes can have no significance in the context of inventive step. The board arrived at the conclusion that the evidence did not establish that the "prizes and praises" resulted from the claimed inventive step.

In **T 677/91** the board took the commercial success of the claimed invention into consideration and stated that it would have been wrong to ignore the practical impact that the invention had made in its own field since the priority date. For example, in several passages of a textbook, reference was made to the fact that the various advantages of the claimed invention had brought in a new era in this special field. The board concluded that it was difficult to reconcile the contents of such passages with the idea that the claimed invention was a matter of mere routine development and thus held that the invention involved an inventive step.

In **T 626/96** the invention had likewise achieved great commercial success and gained widespread recognition in a number of countries. Furthermore, the success was achieved in a very short space of time, so that there seemed to be a pressing commercial need for this simple solution. Furthermore, the success was directly attributable to the structure of the product claimed and was not due to marketing techniques or advertising skills.

9.6. Market competitors

Market competitors' efforts to obtain **rights of joint use** constitute further secondary indicia closely related to commercial success. They may result in a positive decision on inventive step, but need not necessarily do so. In **T 351/93** the board stated that the latter applied particularly where a technical and expert assessment of the invention in the light of the prior art led, according to the problem-solution approach, to the conclusion that the existence of inventive step had to be denied.

The case was slightly different in **T 812/92** - the situation might arise where, shortly before the filing date of the contested patent, **one of the patent proprietor's competitors** offered a customer a technical apparatus without reducing to practice the advantageous technical solution according to the invention. This might be an indication that an inventive step was involved.

In **T 252/06** the board confirmed the presence of inventive step inter alia on the grounds that the proprietor's competitors had used the patent's teaching and had filed applications relating to it.

9.7. Simple solution

In a technical field of commercial importance to which considerable attention is directed the simplicity of a proposed solution may indicate inventive step. The difficulty of developing a simple solution without sacrificing quality may therefore indicate inventive step (**T 106/84**, OJ 1985, 132; **T 229/85**, OJ 1987, 237; **T 9/86**, OJ 1988, 12; **T 29/87**, **T 44/87**, **T 528/89**, **T 73/95**). This did however presuppose the absence in the prior art of anything that hinted at the proposed solution (**T 712/92**).

In **T 234/91** it was pointed out that experience in structural engineering showed that with the same or even an improved effect - in the case in point an increase in reliability - it was often much more difficult to identify and achieve a simple solution than complicated embodiments. In view of the large number of solutions suggested in the technical literature, the board came to the conclusion that the improvement achieved by the simple structural measure suggested in the contested patent had not been obvious (see also **T 330/87**).

In **T 349/95** the subject-matter at issue related to a simple form of a simple device, a device which, however, had brought about a surprising major functional improvement. In the board's view, this surprising improvement and the fact that the prior art gave no clear hint of the solution constituted evidence of the inventiveness of the claimed solution.

A different aspect was dealt with in **T 113/82** (OJ 1984, 10). In order to proceed from the known art to the invention, a series of steps needed to be taken. The board stated that this could be considered as an indicator of the presence of inventiveness, particularly in a case where the last decisive step had neither been proved to be known from the prior art nor was derivable therefrom, although this last step might at first sight seem to be a very simple one (see also **T 315/87**, **T 508/88**, **T 424/89**, **T 394/90**).

9.8. Surprising effect - bonus effect

An effect which may be said to be unexpected can be regarded as an indication of inventive step (**T 181/82**, OJ 1984, 401). However, certain preconditions have to be met. In **T 21/81** (OJ 1983, 15) the board considered that if, having regard to the state of the art, it would already have been **obvious** for a skilled person to arrive at something falling within the terms of a claim, because an advantageous effect could be expected to result from the combination of the teachings of the prior art documents, such claim **lacked** inventive step, irrespective of the circumstance that an extra effect (possibly unforeseen) was obtained (see **T 365/86**, **T 350/87**, **T 226/88**). This case law was also confirmed in **T 69/83** (OJ 1984, 357). Where, because of an essential part of the technical problem being addressed, the state of the art obliged a skilled person to adopt a certain solution, that solution was not automatically rendered inventive by the fact that it also unexpectedly solved part of the problem. Therefore, an unexpected bonus effect does not confer inventiveness on an obvious solution (**T 231/97**). If it is obvious for the skilled person to combine prior art teachings in order to solve an essential part of the problem, the presence of even an unexpected extra effect allowing another part of the problem to

be solved at the same time does not in principle imply the presence of inventive step (**T 170/06**).

Furthermore, in **T 192/82** (OJ 1984, 415) the board stated that the skilled person had to be free to employ the best means already available for his purposes, although the use of means leading to some expected improvements might well be patentable in relying on an additional effect, provided this involved a choice from a multiplicity of possibilities. The lack of alternatives in this respect might therefore create a **"one-way-street"** situation leading to predictable advantages which remained obvious in spite of the existence of some unexpected **"bonus"** effect. The board also pointed out in **T 506/92** that an additional effect achieved inevitably by the skilled person on the basis of an obvious measure without any effort on his part simply represented a bonus under EPO case law which could not substantiate inventive step, even as a surprising effect (see also **T 766/92**, **T 431/93**, **T 703/93**, **T 681/94**, **T 985/98**, **T 794/01**).

The board in **T 936/96** held that, once a realistic technical problem had been defined and once it had been established that a particular solution to such a problem **would** have been envisaged by a skilled person in the light of the relevant state of the art, that solution could not be said to involve an inventive step, and this assessment was not altered by the fact that the claimed invention inherently also solved further technical problems. In the case in point the claimed surprising effect could not be regarded as an indication of the presence of an inventive step.

In **T 227/89** the board stated that in determining which effect was crucial and which was merely accidental (the so-called **"bonus effect"**), a realistic approach had to be taken, considering the relative technical and practical importance of those effects in the circumstances of a given case (see also **T 732/89** and **T 729/90**). When assessing chemical substances for inventive step, it is often their surprising properties that are considered (see in this connection **T 20/83**, OJ 1983, 419).

In **T 848/94** the solution of the existing technical problem required a combination of measures that was not suggested by the prior art in such a manner that it would have been adopted by the person skilled in the art. Therefore, the person skilled in the art was not in a **"one-way-situation"**.

In **T 154/87** it was pointed out that the achievement of a surprising effect was no precondition for the existence of inventive step. All that was necessary was to ascertain that the respective subject-matter could not be derived by the skilled person in an obvious manner from the available prior art (**T 426/92**, **T 164/94**, **T 960/95**, **T 524/97**).

In **T 551/89** the board stated that an effect which was to be expected as the result of an obvious measure could not contribute to recognition of the required inventive step, even if the scale of this effect was surprising to the skilled person. In this case an effect whose scale surpassed the skilled person's hopes merely represented a bonus effect following inevitably from the use of an obvious measure and obtained by the skilled person without any inventive effort on his part (**T 506/92**, **T 882/94**).

In **T 240/93** the application related to an apparatus for the surgical treatment of tissues by hyperthermia, equipped with heat protection means. The application was refused by the examining division, which considered the short treatment duration of one hour and further advantages resulting from the use of cooling means to be extra (bonus) effects. The board, however, stated that in the case in point the objective problem underlying the invention was to provide an apparatus for the effective therapeutic treatment of benign prostate hyperplasia in a short period of time. In view of the many considerable practical advantages of a single one-hour hyperthermia session for a patient, such a short treatment duration could not be dismissed as a mere "bonus" effect, but was crucial to the invention and the basis of the objective problem.

9.9. Comparative tests

According to the established jurisprudence, a surprising effect (advantageous effect or feature) demonstrated in a comparative test can be taken as an indication of inventive step. If comparative tests are chosen to demonstrate an inventive step on the basis of an improved effect, the nature of the comparison with the closest state of the art must be such that the alleged advantage or effect is convincingly shown to have its origin in the distinguishing feature of the invention compared with the closest state of the art (**T 197/86**, OJ 1989, 371; **T 234/03**; **T 378/03**) and alleged but unsupported advantages cannot be taken into consideration in respect of the determination of the problem underlying the application (see also Chapter I.D.4.2, alleged advantages; **T 20/81**, OJ 1982, 217; **T 561/94**).

In **T 197/86** (OJ 1989, 371) the board supplemented the principles laid down in earlier decision **T 181/82** (OJ 1984, 401), according to which, where comparative tests were submitted as evidence of an unexpected effect, there had to be the closest possible structural approximation in a comparable type of use to the subject-matter claimed. In the case in point the respondent (proprietor of the patent) strengthened support for his claim by voluntarily providing comparisons with variants which, although not expressly belonging to the prior art, differed from the claimed subject-matter only by the distinguishing feature of the invention. The board summarised its position by stating, that in cases where comparative tests were chosen to demonstrate an inventive step with an improved effect over **a claimed area**, the nature of the comparison with the closest state of the art had to be such that the effect was convincingly shown to have its origin in the distinguishing feature of the invention. For this purpose it might be necessary to modify the elements of comparison so that they differed only by such a distinguishing feature (**T 292/92**, **T 412/94**, **T 819/96**, **T 133/01**, **T 369/02**, **T 668/02**, **T 984/03**).

As early as **T 35/85** the board had stated that an applicant or patentee may discharge his onus of proof by voluntarily submitting comparative tests with newly prepared variants of the closest state of the art identifying the features common with the invention, in order to have a variant lying closer to the invention so that the advantageous effect attributable to the distinguishing feature is thereby more clearly demonstrated (**T 40/89**, **T 191/97**, **T 496/02**).

It is for the applicant/patentee to furnish evidence of an improved effect of the subject-matter of a claim, which has been asserted, but was not mentioned in the application as filed, in the whole of the claimed area vis-à-vis the closest prior art (**T 355/97**, **T 1213/03**).

In **T 390/88** the board addressed the question of the circumstances under which the production of comparative examples was unnecessary. In the above-mentioned earlier cases the invention had been obvious *prima facie* because the products, although novel, were very close structurally to the prior art products. The case in point was different. Here, the board said that the production of comparative examples was not essential to establish inventiveness, as the invention had not been obvious from the outset (**T 656/91**).

In **T 702/99** the board stated that in cases concerning products such as cosmetics, in which applicants or patentees seek to establish that their inventions have an improved "feel" over the prior art, or opponents seek to deny such an improved "feel", it is common for one or more parties to file evidence of comparative tests conducted by a number of persons. It is essential for such tests to be made under conditions which ensure maximum objectivity on the part of those conducting the tests and who may be required at a later date to give evidence in proceedings. It is always desirable that such tests can be shown to be "blind" and that they have been conducted in the strictest conditions; that the testers have had no part in the making of the claimed invention or research leading up to the invention or the patenting procedure.

In **T 234/03** the board stated that to be of relevance in demonstrating that a technical improvement is achieved in comparison with the closest state of the art, any comparative test presented must be reproducible on the basis of the information thus provided, thereby rendering the results of such tests directly verifiable (**T 494/99**). This requirement implies, in particular, that the procedure for performing the test relies on quantitative information enabling the person skilled in the art to reproduce it reliably and validly. Vague and imprecise operating instructions render the test inappropriate and thus irrelevant.

In **T 172/90** the comparative examples produced did not constitute suitable evidence of inventive step. The board said that the products adduced as a basis of comparison were commercially available and had evidently been selected at random. Technical progress shown in comparison with products of this kind could not be a substitute for the demonstration of inventive step with regard to the closest prior art (see also **T 164/83**, OJ 1987, 149; **T 730/96**).

E. The requirement of industrial applicability under Article 57 EPC

1. Notion of "industrial application"

1.1. General issues

Art. 57 EPC (the wording has not been changed in the revised EPC) provides that "An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture". This Article defines and explains the nature of the requirement in Art. 52(1) EPC that the subject-matter has to be "susceptible of industrial application". In particular, this Article makes it quite clear that, under the Convention, agriculture is a kind of industry, and that agricultural methods are therefore, in general, methods which are susceptible of industrial application (**T 116/85**, OJ 1989, 13). Regarding the amendments to Art. 52(1) EPC in the course of the revision of the EPC, see chapter I.A.1, patent protection for technical inventions.

In **T 144/83** (OJ 1986, 301) the board stated that under Art. 57 EPC 1973 an invention was to be considered as susceptible of industrial application if it could be made or used in any kind of industry. Enterprises in the cosmetic field - such as cosmetic salons and beauty parlours - were part of industry within the meaning of Art. 57 EPC 1973, since the notion of "industry" implied that an activity was carried out continuously, independently and for financial gain. One board had already decided that the professional use of such inventions in a cosmetic salon was an industrial application within the meaning of Art. 57 EPC 1973. In **T 36/83** (OJ 1986, 295) the board also found that the professional use of the invention in a beauty parlour was an industrial application within the meaning of Art. 57 EPC 1973.

In **T 204/93** the board held that commercial use excluded from patentability under Art. 52(2)(c) and (3) EPC 1973 (in so far as it was not construed as a method for doing business) was a feature which might be understood to fall within the requirement that an invention had to be susceptible of industrial application (Art. 52(1) EPC 1973), i.e. that it could be made or used in any kind of industry (Art. 57 EPC 1973); reference was made in particular to the German word "gewerblich" in that provision of the Convention. The board noted that it was not disputed that computer programs could be exploited commercially. The exclusions from patentability defined in Art. 52(2) and (3) EPC 1973 did not in any way refer to the requirement in Art. 52(1) EPC 1973 of "industrial application" but to the requirement in that Article that the subject-matter claimed had to be an "invention". The exclusions in Art. 52(2) and (3) EPC 1973 were generally understood to share the common feature that the excluded matters lacked technicality but not that they could not be made or used, e.g. traded.

In **T 953/94** the board stated that, as the Convention showed (Art. 52(1) EPC 1973), the requirement (defined in Art. 52(2) and (3) EPC 1973) of claimed subject-matter being an "invention" was distinct from the requirement (defined in Art. 57 EPC 1973) of the claimed invention being "susceptible of industrial application". Even though the former requirement might, *cum grano salis*, be equated with a requirement for a "technical" contribution, this was not the same as a requirement for "industrial" applicability; at least

in this context, the terms "technical" and "industrial" were not synonyms. In Art. 57 EPC 1973, the meaning of "industrial" was evidently intended to cover commercial applications; this was made clear, for instance, by the German version ("gewerblich"). In the context of Art. 52(2) EPC 1973, this was clearly not the case for the meaning of "technical". This was because, in the context of "controlling a [...] process", the adjective "industrial" should, other than in the context of Art. 57 EPC 1973, be understood to relate only to technical processes usually occurring in "industry" (this latter term in its present context being understood in the narrower sense of what in German would be called "Industrie") and thus not as including "commercial", or even "financial", applications.

In **T 541/96** the board noted that according to Art. 52(1) EPC 1973 a European patent could be granted for an invention which was, inter alia, susceptible of industrial application. This concept was related to the obligation on an applicant to give a sufficient description of the invention, as required by Art. 83 EPC 1973. An invention or an application for a patent for an alleged invention which would not comply with the generally accepted laws of physics would be incompatible with the requirements of Art. 57 and 83 EPC 1973 because it could not be used and therefore lacked industrial application. The description would moreover be insufficient to the extent that the applicant would not be able to describe how it could be made to work.

The board went on to observe that the Convention did not prevent the patentability of "revolutionary" inventions. However, Art. 83 EPC 1973 made the amount of information required for a sufficient disclosure of an invention somewhat dependent on the actual "nature" of the invention. If the latter lay in a well-known technical field and was based on generally accepted theories, the description did not need to comprise many specific technical details which would anyway be implicit to a skilled person. However, if the invention seemed, at least at first, to offend against the generally accepted laws of physics and established theories, the disclosure should be detailed enough to prove to a skilled person conversant with mainstream science and technology that the invention was indeed feasible (i.e. susceptible of industrial application). This implied, inter alia, the provision of all the data which the skilled person would need to carry out the claimed invention, since such a person, not being able to derive such data from any generally accepted theory, could not be expected to implement the teaching of the invention just by trial and error.

In the case at issue, the gist of the invention consisted in inducing nuclear fusion between light nuclei and heavy unstable nuclei at low temperature by means of an electric field. The appellant had provided neither experimental evidence nor any firm theoretical basis which would enable the skilled person to assess the viability of the invention; the description was essentially based on general statements and speculations which were not apt to provide a clear and exhaustive technical teaching. Thus, it was irrelevant to consider whether the fusion reactions referred to in the description might be theoretically possible, or whether they might indeed occur under certain conditions.

In **T 718/96** the board ruled that, although disclosure objections could be raised under Art. 57 EPC 1973, on the grounds that an invention which could not be carried out was

not susceptible of industrial application, they should rather be based either on Art. 83 or on Art. 100(b) EPC 1973, which specifically related to the performability of inventions.

In **T 18/09** the board noted that the close inter-relationship between Art. 83 and 57 EPC was already addressed in previous decisions (see inter alia **T 898/05**). Both provisions related to the obligation of an applicant to give a sufficient description of the invention. In respect of Art. 83 EPC, established case law of the boards of appeal stated that a patent could only be objected to for lack of sufficiency of disclosure if there were serious doubts, substantiated by verifiable facts (see **T 19/90**, OJ 1990, 476). For the board, it would not be justified and unfair to set a different standard of proof in respect of Art. 57 EPC.

1.2. Indication of a profitable use of the invention in industry

R. 42(1)(f) EPC (former R. 27(1)(f) EPC 1973) prescribes that the description should "indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable".

In **T 870/04**, the key question for the assessment of compliance with the requirements of the Convention was whether the invention as disclosed in the application was "susceptible of industrial application". The board noted that the case law indicated that the notion of "industry" had to be interpreted broadly to include all manufacturing, extracting and processing activities of enterprises that were carried out continuously, independently and for financial (commercial) gain (see e.g. **T 144/83**, OJ 1986, 301). The requirement of Art. 57 EPC 1973 that the invention "can be made or used" in at least one field of industrial activity emphasised that a "practical" application of the invention had to be disclosed. Merely because a substance could be produced in some ways did not necessarily mean that this requirement was fulfilled, unless there was also some profitable use for which the substance could be employed.

The board noted that biotechnological inventions were quite often concerned with substances found in nature (e.g. a protein, a DNA sequence, etc.). If a function was well known to be essential for human health, then the identification of the substance having this function would immediately suggest a practical application in the case of a disease or condition caused by a deficiency, as was the case, for example, for insulin, human growth hormone or erythropoietin. In such cases, an adequate description would ensure, in accordance with the requirements of Art. 57 EPC 1973, that "the invention can be made or used in industry". In cases where a substance, naturally occurring in the human body, was identified, and possibly also structurally characterised and made available through some method, but either its function was not known or it was complex and incompletely understood; no disease or condition had yet been identified as being attributable to an excess or deficiency of the substance; and no other practical use was suggested for the substance, then industrial applicability could not be acknowledged. In the board's judgment, although the application at issue described a product (a polypeptide), means and methods for making it, and its prospective use for basic science activities, it identified no practical way of exploiting it in at least one field of industrial activity.

In **T 898/05** the board found that for the purposes of Art. 57 EPC 1973, a claimed invention had to have such a sound and concrete technical basis that the skilled person could recognise that its contribution to the art could lead to practical exploitation in industry. The board held *inter alia* that it was necessary to disclose in definite technical terms the purpose of the invention and how it could be used in industrial practice to solve a given technical problem, this being the actual benefit or advantage of exploiting the invention. The essence of the requirement was that there had to be at least a prospect of a real as opposed to a purely theoretical possibility of exploitation, if it was not already obvious from the nature of the invention or from the background art. It should not be left to the skilled reader to find out how to exploit the invention by carrying out a research programme.

Accordingly, a product whose structure was given (e.g. a nucleic acid sequence) but whose function was undetermined or obscure or only vaguely indicated might not fulfil the above criteria, in spite of the fact that the structure of the product *per se* could be reproduced (made) (see **T 870/04**). If a patent was granted, it might prevent further research in that area, and/or give the patentee unjustified control over others who are actively investigating in that area and who might eventually find actual ways to exploit it. On the other hand, a product which was definitely described and plausibly shown to be usable, e.g. to cure a rare or orphan disease, might be considered to have a **profitable use** or concrete benefit, irrespective of whether it was actually intended for the pursuit of any trade at all. Thus, although no particular economic profit might be expected in the development of such products, nevertheless there was no doubt that it might be considered to display immediate concrete benefits.

In **T 641/05** the board considered that no actual information regarding the function of the CEGPCR1a clone at any of the three particular levels of function referred to in decision **T 898/05**, i.e. molecular, cellular and biological function in a broad sense (binding of a ligand, propagation of a transmembrane signal, role in a transduction signal pathway and/or in a network of interconnected pathways of a multicellular organism) - could be directly derivable from the application itself or from the prior art on file. Although, under certain conditions, the board was well prepared - following the case-by-case approach adopted in decision **T 898/05** - to acknowledge a possible function based on computer-assisted methods, in the case before it the probative value of these (sequence homology) methods was completely lacking. In the absence of this functional information, the CEGPCR1a clone disclosed in the application at issue could only be equated or put on a par with the second group of cases identified in decision **T 870/04**, namely those cases for which no industrial application, i.e. no "immediate concrete benefit" in the sense defined in decision **T 898/05**, could be recognized.

In **T 1452/06** the board commented that the basis for all the therapeutic indications of the claimed subject-matter was the predicted role of the purported serine protease activity of the polypeptide of sequence SEQ ID NO: 24 in the degradation of the extracellular matrix. For the claimed subject-matter to fulfil the requirement of industrial application the purported serine protease activity of the polypeptide of sequence SEQ ID NO: 24 was essential. The board found that no experimental evidence whatsoever was present in the application in support of a serine protease activity for a polypeptide comprising the amino

acid sequence of SEQ ID NO: 24. There was no example disclosing this serine protease activity for a polypeptide of sequence SEQ ID NO: 24, nor any evidence showing that the screening methods and the therapeutic indications based on this serine protease activity could actually be achieved with a polypeptide of sequence SEQ ID NO: 24. Further, the board found that no probative value could be thus derived from data obtained by comparison with the prior art using computer-assisted methods, and no conclusions could be drawn from the application as regards a serine protease activity of a polypeptide of sequence SEQ ID NO: 24. The only use of a polypeptide of sequence SEQ ID NO: 24 was to find out more about the polypeptide itself and its natural function(s). No "immediate concrete benefit" within the meaning of decision **T 898/05** could be acknowledged for this use.

The board stated that a basic principle of the patent system was that exclusive rights could only be granted in exchange for a full disclosure of the invention, which included the need to indicate how to exploit the invention (Art. 57 EPC 1973). This indication must have "a sound and concrete technical basis", as a "speculative indication of possible objectives that might or might not be achievable by carrying out further research with the tool as described was not sufficient to fulfil the requirement of industrial applicability" (see **T 898/05** and **T 870/04**).

2. Indicia in determining industrial applicability

2.1. Methods applied in the private and personal sphere

In **T 74/93** (OJ 1995, 712) the application was refused by the examining division because claim 5, which was directed to the use of a contraceptive composition (e.g. a cream) for applying to the cervix of a female capable of conception, was not susceptible of industrial application as required by Art. 57 EPC 1973 in so far as the compound was to be applied to the cervix of a human female. The appellant had argued essentially that many inventions in the field of daily needs were used privately and their patentability should not be restricted.

The board noted that since "industry" in the field of industrial property was widely understood in its broadest sense (Art. 1(3) Paris Convention), such a liberal interpretation could also apply to Art. 57 EPC 1973. However, the board stated that in determining the borderline between industrial activities - in which the effects of patents had to be respected - and private and personal activities, which should not be adversely affected by the exercise of these rights, the board took into consideration the fact that Art. 57 EPC 1973 might be regarded as an expression of the general idea that any natural person had the right to have his or her privacy respected. The core of this right was not to be taken away from anybody. Therefore the fact that for some women contraception was connected with professional activities did not give an act, which was in essence private and personal, an industrial character. The board noted that this did not apply to contraception in general, but to the specific type of application of a composition as claimed in claim 5.

The board was unable to ascertain any field of industrial application for the direct use defined in claim 5, for which the requirement of Art. 57 EPC 1973 had to be met. The question as to whether it would be sufficient for an industrial application to be expected in future could be left unanswered. Even if the board were to accept the appellant's position in this respect, it would not be sufficient simply to make an unsubstantiated allegation to this effect. Without any specific indication the board was not in a position to accept that the requirement set out in Art. 57 EPC 1973 had been fulfilled.

2.2. Possibility of services offered by an enterprise

In **T 1165/97** the board held that a method of using a vaginal discharge collector and disposing of the collector after a single use could be considered susceptible of industrial application if it was conceivable that these steps were carried out as a paid service and were not exclusively dependent for their execution on the instructions of the woman in question. The board noted that, for the purposes of Art. 57 EPC 1973, what was relevant was the possibility that such a service might be offered by an enterprise. In that case, the board decided in the affirmative, pointing out that - in contrast to the case in **T 74/93** - the service was not one satisfying only the strictly personal needs of the woman in question. Collecting a sample could be caused by external reasons, e.g. on the advice of a medical practitioner to have such a sample taken for further diagnosis.

2.3. Other criteria - formulation of claims

In **G 5/83** (OJ 1985, 64), claims directed to substances or compositions for use in any methods for treatment of the human or animal body were unquestionably directed to inventions which were susceptible of industrial application within the meaning of Art. 52(1) EPC 1973. This was not only expressly made clear in Art. 52(4), last sentence, EPC 1973, but could also be inferred from the definition of "susceptible of industrial application" in Art. 57 EPC 1973, namely that the invention "can be made or used in any kind of industry, including agriculture". The last sentence of Art. 52(4) EPC 1973 appeared to be a statement of the obvious, stemming from an abundance of caution.

In **T 80/96** (OJ 2000, 50), the board found that the use of a substance to make a new pharmaceutical product without delimitation to an indication did not contravene the requirements of Art. 57 EPC 1973 in conjunction with Art. 52(1) EPC 1973. In the board's view, the requirement for clarity of the claims (Art. 84 EPC 1973) likewise did not mean that a claim for a process for preparing a particular product could not be drafted in the form of a use claim. No other meaning could be given to the individual process steps (see **T 279/93**).

II. CONDITIONS TO BE MET BY AN APPLICATION

A. Sufficiency of disclosure

Art. 83 EPC stipulates that the application shall (previously 'must') disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. In the course of the revision of the EPC, only minor editorial amendments were made to Art. 83 EPC.

1. Parts of the application relevant for assessing sufficiency of disclosure

Sufficiency of disclosure within the meaning of Art. 83 EPC must be assessed on the basis of the application as a whole - including the description and claims - (**T 14/83**, OJ 1984, 105; see also **T 169/83**, OJ 1985, 193) and not of the claims alone (see e.g. **T 202/83**, **T 179/87** of 16.1.1990, **T 435/89**, **T 82/90**, **T 126/91**). The drawings must be considered as ranking equally with the other elements of the application when considering whether the requirements of Art. 83 EPC (and Art. 84 EPC) have been satisfied (see **T 169/83**, OJ 1985, 193; **T 308/90** and **T 818/93**).

In **T 32/84** (OJ 1986, 9) it was pointed out that the fact that certain elements of an invention essential to its operation were not referred to explicitly either in the claims, or in the relevant portion of the description nor shown in the drawing of the invention as claimed did not necessarily mean that the application did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art as required by Art. 83 EPC 1973. In the case in question, a person skilled in the art could have put the invention into practice by applying a principle disclosed in the description which showed as essential to the invention an element shown not in the figure illustrating the invention as claimed, but in another figure in the application. This, however, only applied if he did not make use of additional teachings and no inventive step was involved.

In **T 1011/01** the board cited **T 226/85** (OJ 1988, 336), which states that substantially any embodiment of the invention, as defined in the broadest claim, must be capable of being realised on the basis of the disclosure. This implied in particular that an objection of insufficiency could be raised against the subject-matter of any claim, independent or dependent (R. 29(3) EPC 1973, now R. 43(3) EPC). From a legal point of view it was therefore irrelevant whether or not the feature objected to was essential or to what degree the scope of protection conferred by the patent depended on the claim in question.

2. Knowledge of skilled person relevant for assessing sufficiency of disclosure

a) The disclosure is aimed at the skilled person

The same level of skill has to be applied when, for the same invention, the two questions of sufficient disclosure and inventive step are being considered (**T 60/89**, OJ 1992, 268;

T 694/92, T 187/93, T 412/93). However, the standard of disclosure required for amendments by Art. 123(2) EPC 1973, namely that of being directly and unambiguously derivable, is inappropriate, the criterion being that it must be possible to reproduce the invention on the basis of the original application documents without any inventive effort and undue burden (**T 629/05**).

The skilled person may use his common general knowledge to supplement the information contained in the application (**T 206/83**, OJ 1987, 5; **T 32/85, T 51/87**, OJ 1991, 177; **T 212/88**, OJ 1992, 28; **T 580/88, T 772/89, T 231/92, T 818/97**). He may even recognise and rectify errors in the description on the basis of such knowledge (**T 206/83**, OJ 1987, 5; **T 171/84**, OJ 1986, 95; **T 226/85**, OJ 1988, 336). Textbooks and general technical literature form part of the common general knowledge (**T 171/84, T 51/87, T 580/88, T 772/89**). However, information which can only be obtained after a comprehensive search is not to be regarded as part of the common general knowledge (**T 206/83, T 654/90**). According to the board in **T 475/88**, in the event of a dispute a claim of common general knowledge must be backed up by evidence. As a rule, demonstrating that the knowledge in question can be obtained from a textbook or monograph will be sufficient.

Patent specifications cannot normally contribute to the sufficiency of the disclosure unless they are available to the skilled reader of the patent in question (**T 171/84**, OJ 1986, 95). By way of exception, however, patent specifications and scientific publications may be considered to form part of the common general knowledge where the invention is in a field of research so new that the relevant technical knowledge is not yet available from textbooks (**T 51/87**, OJ 1991, 177; **T 772/89, T 676/94**). In **T 676/94** the board considered that the question whether or not the contents of a technical periodical formed part of the average knowledge of a skilled person when assessing sufficiency of disclosure, should be answered on the basis of the facts and evidence in each particular case.

Considering the extent and the lack of precision in citing DVB standards, the content of which was not necessarily part of the common general knowledge, the board in **T 1191/04** considered references to such documents insufficient to meet the requirements of Art. 83 EPC 1973.

b) References may also enable the skilled person to carry out an invention

Features not mentioned in the application documents themselves but in a document to which they refer may be incorporated into a patent claim if they unequivocally form part of the invention for which protection is sought. However, all the essential structural features thus disclosed which belong together must be incorporated into the claim; it is not permissible to single out a particular one (**T 6/84**, OJ 1985, 238).

Where an invention relates to the improvement of prior art originally cited in the description of the invention, a feature described in broad terms in the cited document but not mentioned expressly in the invention is sufficiently disclosed if it is realised in the

examples of the invention in the form of an embodiment also mentioned in the reference document (**T 288/84**, OJ 1986, 128).

An invention is also sufficiently disclosed if reference is made to another document in the patent specification and the original description, and the skilled person can obtain from this cross-reference the information required to reproduce the invention but not disclosed in so many words in the description itself (**T 267/91**, **T 611/89**). This applies irrespective of the language in which it is drafted (see **T 920/92**, where the document referred to was in Japanese).

However, where the reference document was possibly short-lived advertising material, the applicant was wise to incorporate the published information explicitly rather than by mere reference (**T 211/83**).

In **T 737/90** it was explicitly stated that a reference to another document can only be taken into account if the document referred to can be unambiguously identified and the relevant addressees have ready access to it. This depends solely on the facts of the case. Following **T 737/90**, the board in **T 429/96** confirmed that a document incorporated by reference into the text of a European patent application had to become available to the public at the latest on the **publication date** and not on the **filing date** of the European patent application, in order to be taken into account for the purposes of Art. 83 EPC 1973.

In **T 341/04**, the question was whether a referenced document, which could be unambiguously identified at the date of filing of the document containing the reference by its document number, but which document itself was "missing" in the sense that it was not available at said date of filing, could be "taken into account" for the purpose of Art. 83 EPC 1973 by relying on information present in a family member of the referenced document. The board answered in the affirmative.

In **T 276/99** it was stated that the description is an essential part of the patent specification for the purpose of understanding and being able to carry out the invention and that something which is critical for the understanding of the invention should therefore appear in the patent specification and not be incorporated by reference to an A-publication. Where a reference in the description is to published prior art, a mere reference may be sufficient as such prior publication will not normally relate to the essence of the invention. However, even in such a situation it may be necessary that for ease of consultation some prior published information should appear explicitly in the patent specification (approving **T 211/83**).

3. Clarity and completeness of disclosure

a) General principles

It must be possible to reproduce a claimed step using the original application documents without any inventive effort over and above the ordinary skills of a practitioner (**T 10/86**). Where an applicant did not furnish details of the production process in the description in

order to prevent the invention from being copied easily and the missing information could not be supplied from the general knowledge of a person skilled in the art, the invention was held to be insufficiently disclosed (**T 219/85**, OJ 1986, 376).

b) Indication of at least 'one way'

An invention is in principle sufficiently disclosed if at least one way is clearly indicated enabling the person skilled in the art to carry out the invention. If this is the case, the non-availability of some particular variants of a functionally defined component feature of the invention is immaterial to sufficiency as long as there are suitable variants known to the skilled person through the disclosure or common general knowledge which provide the same effect for the invention (**T 292/85**, OJ 1989, 275). This has been confirmed by many decisions: **T 81/87** (OJ 1990, 250), **T 301/87** (OJ 1990, 335), **T 212/88** (OJ 1992, 28), **T 238/88** (OJ 1992, 709), **T 60/89** (OJ 1992, 268), **T 182/89** (OJ 1991, 391), **T 19/90** (OJ 1990, 476), **T 740/90**, **T 456/91** and **T 242/92**.

However, fulfilling the requirement of R. 42(1)(e) EPC that the description shall describe in detail at least one way of carrying out the invention claimed, does not automatically mean that the application as filed is sufficiently disclosed in accordance with Art. 83 EPC. This has to be decided by appraising the information contained in the examples as well as other parts of the description in the light of the skilled person's common general knowledge at the relevant date (see e.g. **T 322/93**). However, where the requirements of Art. 83 EPC are fulfilled, it follows that there is at least one way of carrying out the invention disclosed in accordance with R. 42(1)(e) EPC (see e.g. **T 561/96**). In this decision, the fact that the examining division, despite an objection under Art. 83 EPC 1973, nevertheless acknowledged novelty and inventive step, indicated to the board that the invention was unambiguously understandable for a skilled person and thus sufficiently disclosed.

c) Invention to be performed over whole range claimed

The disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed **in the whole range claimed** rather than **only in some** members of the claimed class to be obtained (**T 409/91**, OJ 1994, 653; **T 435/91**, OJ 1995, 188; **T 172/99** and **T 1288/01**). This was considered a question of fact. Sufficiency of disclosure thus presupposes that the skilled person is able to obtain substantially **all** embodiments falling within the ambit of the claims. This was also the view taken by the board in decisions **T 19/90** (OJ 1990, 476), **T 242/92**, **T 418/91**, **T 548/91**, **T 659/93**, **T 435/91** (OJ 1995, 188) and **T 923/92** (OJ 1996, 564). This principle applies to any invention irrespective of the way in which it is defined, be it by way of a functional feature or not. The peculiarity of the functional definition of a technical feature resides in the fact that it is defined by means of its effect. That mode of definition comprises an indefinite and abstract host of possible alternatives, which is acceptable as long as all alternatives are available and achieve the desired result (**T 1121/03** and **T 369/05**).

More technical details and more than one example may be necessary in order to support claims of a broad scope (**T 612/92**, **T 694/92**, OJ 1997, 408; **T 187/93**). This must be decided on a case-by-case basis. The board must also be satisfied firstly that the patent specification put the skilled person in possession of at least one way of putting the claimed invention into practice, and secondly that the skilled person could put the invention into practice over the whole scope of the claim. If the board was not satisfied on the first point that one way existed, the second point did not need to be considered (**T 792/00**).

d) Parameters

According to **T 517/98**, if the disclosure of a patent in suit was limited to products which, when prepared by the method according to the invention, were characterised by distinctive parameters, then a claim which did not stipulate these parameters a priori encompasses embodiments which were not obtainable by the method disclosed. Such disclosure of a single way of performing the invention would only be considered sufficient if it enabled a person skilled in the art to carry out the invention within the whole ambit of the claim. If this was not the case, the claim did not meet the requirements of Art. 83 and 100(b) EPC 1973 (Art. 100(b) EPC remains unchanged). In **T 172/99**, the board found that in the case of claimed subject-matter relying on a newly formulated and hence unfamiliar parameter to define the solution of a technical problem by which a relevant effect is achieved, the patentee, who has the duty of making a full and fair disclosure of his invention to the public under Art. 83 EPC 1973, is under a particular obligation to disclose all the information necessary reliably to define the new parameter not only (i) in a formally correct and complete manner such that its values can be obtained by a person skilled in the art without undue burden, but also (ii) in a manner which reliably retains the validity of the parameter for the solution of the technical problem for the application or patent in suit as a whole in the sense that the values routinely obtained will not be such that the claimed subject matter covers variants incapable of providing the relevant effect or, therefore, of solving the associated technical problem (followed in **T 914/01** and **T 179/05**).

In **T 815/07** the board pointed out that the purpose of a parameter contained in a claim is to define an essential technical feature of the invention. Its significance is that the presence of this technical feature contributes to the solution of the technical problem underlying the invention. The method specified for determining the parameter should therefore be such as to produce consistent values, so that the skilled person will know when he carries out the invention whether what he produces will solve the problem or not.

Where the skilled person had no reason to doubt the definition of the parameter given, but there was no indication in the patent how to measure this parameter, the patent failed to fulfil the requirements of Art. 83 EPC 1973 (**T 83/01**). However, the fact that no direct independent method of specifically determining the parameter has been described is not in itself prejudicial to the sufficiency of the description where the claims do not relate to a method of determining the parameter. In the case at issue, the possibilities of indirect empirical investigation available to the skilled person were an acceptable

solution which alone was sufficient to fulfil the requirements of Art. 83 EPC 1973 without undue burden (**T 256/87**).

Where the calibration of (undisclosed) test conditions may be achieved even where the methods of determination of the parameter are incompletely described, the invention may be sufficiently disclosed. See for example **T 1062/98**, where the exemplified materials could be reproduced and the values indicated in the patent for each of the respective examples could then be used to adapt the measuring conditions or method so that the measured values approached that in the patent. In both **T 485/00** and **T 225/93**, three methods were known in the art for the determination of the specific surface area of a CaCO₃ particle. In neither case did the description or common general knowledge indicate a preference for one of them. In **T 485/00**, the board held that reproducing an example and measuring the surface area of the resulting product by two or three well-known methods did not represent an undue burden for the skilled person. In **T 225/93**, however, the board found that, as there were three different measuring methods which did not always lead to the same result, this amounted to an undue burden.

Where it is obvious that a skilled person would select a particular analytical measuring method, (none being disclosed in the patent), balancing its simplicity and convenience against the required accuracy, the requirements of Art. 83 EPC are met (see e.g. **T 492/92**).

4. Reproducibility

4.1. General principles

In **T 281/86** (OJ 1989, 202), it was held that there is no requirement under Art. 83 EPC 1973 according to which a specifically described example of a process must be exactly repeatable. Variations in the constitution of an agent used in a process are immaterial to the sufficiency of the disclosure provided the claimed process reliably leads to the desired products. As long as the description of the process is sufficiently clear and complete, i.e. the claimed process can be put into practice without undue burden by the skilled person taking his general knowledge into consideration, there is no deficiency in this respect. See also **T 292/85** (OJ 1989, 275); **T 299/86** (OJ 1988, 88); **T 181/87**, **T 212/88** (OJ 1992, 28); **T 182/89** (OJ 1991, 391) and **T 19/90** (OJ 1990, 476).

In **T 449/90**, the board considered that the requirements of Art. 83 EPC 1973 had been satisfied where the claimed degree of inactivation ("substantially") of the Aids virus could be demonstrated with sufficient certainty. Complete inactivation of the life-threatening virus - which the opponent had argued was necessary - was indeed highly desirable, but not an issue under Art. 83 EPC 1973, given the claim as worded.

In **T 515/00** the board pointed out that an invention cannot be considered to be irreproducible merely because a claim encompasses a hypothetical embodiment which lies outside the breadth of the claim as determined by the Protocol on the Interpretation of Art. 69 EPC 1973, which embodiment cannot be reproduced.

If the only embodiment disclosed with concrete details in a patent is not disclosed in a manner sufficiently complete for the claimed invention (in this instance a railway traction unit with a liquid-nitrogen-cooled superconductive transformer) to be carried out by a person skilled in the art on the date of priority with respect to the fundamental scope of said invention, it is of no significance with regard to the question of sufficient disclosure whether on the relevant date of filing a variant (in this instance a railway vehicle with a liquid-helium-cooled transformer) could have been carried out if the variant, although it is covered by the wording of the patent claim, does not fall within the fundamental scope of the claimed invention with regard to the teaching of the patent due to a lack of comparable technical success (**T 1173/00**, OJ 2004, 16).

The board went on to state that if an invention is insufficiently disclosed, it is of no relevance whether it was objectively impossible to provide the missing information on the date of priority, i.e. whether nobody could have achieved the intended and claimed technical effect. The decisive issue is whether the invention is disclosed in a manner sufficiently complete for it to be carried out by an average person skilled in the art on the date of priority, with knowledge of the patent and on the basis of that person's common general knowledge.

Where a disadvantage of an invention (in this case the risk of injury to users) could prevent its use, this is not an obstacle to reproducibility provided that the otherwise desired result is achieved by the technical teaching disclosed in the patent in suit (**T 881/95**). An Art. 83 EPC objection concerning the absence of any detailed indication of the **use** envisaged for the products cannot succeed, as Art. 83 EPC merely requires the invention to be sufficiently disclosed (see e.g. **T 866/00**).

In **T 156/91** the board expressed doubts about the sufficiency of disclosure of an invention that could be carried out only with products whose method of manufacture was not disclosed but which were commercially available, although their availability was not guaranteed for any identifiable period. Since the process lacked inventive step, however, the board did not ultimately have to resolve the question of reproducibility.

The respondents/opponents in **T 1023/02** argued that there was no enabling disclosure of an HSV-1 vaccine since the description was devoid of any experimental data in that respect. It could be taken from a post-published document that no effective vaccines against HSV had become available. Accordingly, further inventive work was still necessary, departing from the disclosure of the patent.

The board disagreed. The fact that a post-published document reported that no proven effective vaccine against HSV was available did not prove the non-workability of the invention since there might have been other reasons, e.g. regulatory reasons, for not producing vaccines according to the invention. Furthermore, for compliance with the requirements of Art. 83 EPC 1973, it was not necessary to undertake and disclose clinical trials.

The wording of patent claims is decisive and the board must judge whether the skilled practitioner would, when reading the claims, get the technical information required to

achieve the specific targets. This is not so where the two claims encompass a treatment regimen which is broadly overlapping, with regard both to the quantity of the active ingredient to be administered and to the time intervals between the individual doses, but have different targets (**T 1074/06**).

In **T 1063/06** (OJ 2009, 516) the board held that a formulation of a claim whereby functionally defined chemical compounds were to be found by means of a new kind of research tool using a screening method set out in the description constituted a reach-through claim which was also directed to future inventions based on the one now being disclosed. As the applicant was entitled to claim patent protection only for his actual contribution to the art, it was therefore both reasonable and imperative to limit the claim's subject-matter accordingly. Patent protection under the EPC was not designed for the purpose of reserving an unexplored field of research for a particular applicant, as reach-through claims did, but to protect factual results of successful research as a reward for making concrete technical results available to the public.

4.2. Reproducibility without undue burden

The disclosure must be reproducible without undue burden.

Even though a reasonable amount of trial and error is permissible when it comes to sufficiency of disclosure, e.g. in an unexplored field or where there are many technical difficulties, the skilled person has to have at his disposal, either in the specification or on the basis of common general knowledge, adequate information leading necessarily and directly towards success through the evaluation of initial failures (**T 226/85**, OJ 1988, 336; following **T 14/83**, OJ 1984, 105; **T 48/85**, **T 307/86** and **T 326/04**). Where the skilled person can only establish by trial and error whether or not his particular choice of numerous parameters will provide a satisfactory result, this amounts to an undue burden (**T 32/85**). Nor can sufficiency of disclosure be acknowledged, if, for an invention which goes against prevailing technical opinion, the patentee fails to give even a single reproducible example (**T 792/00**).

It suffices for the disclosure of an invention that the means intended to carry out the invention are clearly disclosed in technical terms which render them implementable and that the intended result is achieved at least in some, equally realistic, cases (**T 487/91**). The occasional failure of a process as claimed does not impair its reproducibility if only a few attempts are required to transform failure into success, provided that these attempts are kept within reasonable bounds and do not require an inventive step (**T 931/91**). Nor is reproducibility impaired if the selection of the values for various parameters is a matter of routine and/or if further information is supplied by examples in the description (**T 107/91**). However, wrongly citing a method of measuring an essential product parameter may constitute insufficient disclosure (**T 1250/01**). According to **T 256/87** all that has to be ensured is that the skilled person reading the specification will be able to carry out the invention in all its essential aspects and know when he is working within the forbidden area of the claims. The possibilities of indirect empirical investigation referred to in the specification were, in the board's view, an acceptable solution which sufficed to fulfil the requirements of Art. 83 EPC 1973 without undue burden. This decision was

followed in **T 387/01**, **T 252/02**, **T 611/02** and **T 464/05**. However, according to several decisions, the concept of 'forbidden area' was rather associated with the scope of the claims, i.e. Art. 84 EPC 1973, than with sufficiency of disclosure (see 6.2 below).

In **T 1886/06**, the board emphasised that the above finding in **T 256/87** could not mean, conversely, that if the claims used a term undefined under Art. 84 EPC 1973 the invention necessarily became impossible to carry out within the meaning of Art. 83 EPC 1973 in the absence, in the description or the common general knowledge of the skilled person, of concrete indications towards a possible definition; doubts as to the claims' reproducibility over their entire scope had to be substantiated by verifiable facts. A mere conjecture that their scope might extend to undisclosed variants was not enough.

There is no requirement in the Convention that the claimed invention may be carried out with the aid of only a few additional non-disclosed steps. The only essential requirement is that each of those additional steps be so apparent to the skilled person that, in the light of his common general knowledge, a detailed description of them is superfluous (**T 721/89**).

Experiments constitute an undue burden if they have first of all to find the solution to the problem and are not carried out just to determine the numerical limits of a functionally defined range (**T 312/88**). They should quickly give a reliable picture of how the products can be produced or manufactured (**T 475/88**). However, it is not necessary for the experimental data filed with the patent in suit to be an exact repetition of the worked examples of the patent, as long as the experimental work can be regarded as being within the scope of the invention (**T 674/96**).

Where it is obvious that a skilled person would select a particular analytical measuring method, (none being disclosed in the patent), balancing its simplicity and convenience against the required accuracy, the requirements of Art. 83 EPC are met (see e.g. **T 492/92**). This is the case even if the two different analytical methods proposed by the patentee give significantly different results with the same composition. It also suffices if the person skilled in the art would assume that it was most likely that a certain method was used and this assumption could be tested in the light of the information given in the examples of the patent in suit (**T 143/02**). However, where there are different measuring methods which do not always lead to the same result, this can amount to an undue burden, as in **T 225/93**. In **T 930/99**, the board considered **T 225/93** inapplicable, as there was only one measurement method before them. The respondent's argument that there would be legal uncertainty, since third parties would not know whether they were working within or outside the range specified, was clearly an argument based on lack of clarity, which was not a ground of opposition and so could not be considered (see also 6.2 below).

If the description in a patent specification provides no more than a vague indication of a possible medical use for a chemical compound yet to be identified, more detailed evidence cannot be used later to remedy the fundamental insufficiency of disclosure of such subject-matter (**T 609/02**). Referring to **T 609/02**, the board in **T 433/05** recalled that where a therapeutic application was claimed in the Swiss type form, attaining the

claimed therapeutic effect was a functional technical feature of the claim. As a consequence, under Art. 83 EPC 1973 the application had to disclose the suitability of the product to be manufactured for the claimed therapeutic application.

Where the person skilled in the art has to find out by trial and error which, if any, compound meets the parameter set out in the claim, this constitutes an undue burden. The fact that this could be done by routine experimentation was not sufficient for the subject-matter claimed to meet the requirements of Art. 83 EPC. Nor did the question whether or not the parameter could be reliably determined play a role (**T 339/05**). In **T 123/06** the board found that the functional definition of the device was no more than an invitation to perform a research programme, the skilled person only being able to establish through trial and error whether the claimed device was achieved. This amounted to an undue burden.

According to **T 815/07**, the purpose of a parameter contained in a claim is to define an essential technical feature of the invention. Its significance is that the presence of this technical feature contributes to the solution of the technical problem underlying the invention. The method specified for determining the parameter should therefore be such as to produce consistent values, so that the skilled person will know when he carries out the invention whether what he produces will solve the problem or not.

According to **T 1063/06** (OJ 2009, 516), a functional definition of a chemical compound (in this case in a reach-through claim) covered all compounds possessing the capability according to the claim. In the absence of any selection rule in the application in suit, the skilled person, without the possibility of having recourse to his common general knowledge, had to resort to trial-and-error experimentation on arbitrarily selected chemical compounds to establish whether they possessed the capability according to the claim; this represented for the skilled person an invitation to perform a research programme and thus an undue effort (following **T 435/91**). See also **T 1140/06**.

According to **T 954/05**, the structural definition of a chemical compound may not be replaced in a claim by the mere juxtaposition of a feature purportedly representing a complete chemical structure and of a functional feature if:

- on the one hand the first feature comprises an indefinite number of compounds and there is no systematic selection rule based on the feature in question enabling the skilled person to identify the claimed compounds, and
- on the other hand the second, functional feature is not identifiable in the indefinite list of compounds potentially suitable for such a function because there is no indication of a typical standardised test for determining its presence or absence.

4.3. Post-published documents

Taking into account the intrinsic difficulties for a compound to be officially certified as a drug, it is the practice of the boards of appeal that, for the acceptance of sufficient disclosure of a therapeutic application, it is not always necessary for results of clinical

trials to be provided at the relevant date, but the patent/patent application must provide some information showing that the claimed compound has a direct effect on a metabolic mechanism specifically involved in the disease. Once this evidence is available from the patent/patent application, post-published evidence may be taken into account to support the disclosure in the patent application (**T 433/05**).

In **T 1262/04**, the board considered **T 994/95** and **T 157/03**, where it had been held that in cases where the specification of the application or patent disclosed the invention merely at a general conceptual level but lacked any concrete or tangible proof that the claimed invention could be put into practice, post published documents might constitute evidence that the invention was indeed reproducible without undue burden at the relevant date. The board considered that this principle applied at least to cases such as the one at issue, where the technical teaching as disclosed in the application was credible.

5. The requirement of sufficiency of disclosure in the biotechnology field

5.1. Clarity and completeness of disclosure

5.1.1 General

The principles elucidated under Chapter II.A.3 and 4 above are also applicable to biological inventions. In particular, reference should be made to the case law laid down by the boards in **T 281/86** (OJ 1989, 202), **T 299/86** and **T 409/91** (OJ 1994, 653). Issues related to completeness of disclosure are also discussed by the boards in context with inventive step (see e.g. **T 1329/04**, **T 604/04**, **T 898/05**, above Chapter I.D.4.1) and industrial applicability (see e.g. **T 870/04**, **T 641/05**, **T 1452/06**, above Chapter I.E). Whether the application discloses sufficient information making it plausible that the claimed polynucleotides or polypeptides have the alleged technical effect was considered a matter of inventive step (**T 743/97**; **T 1329/04**) or industrial applicability (**T 1165/06**, **T 1452/06**), whereas the relevant question under Art. 83 EPC 1973 was whether the description was sufficiently clear and complete for the skilled person to prepare the claimed products (**T 743/97**).

An invention may also be sufficiently disclosed where results are **not exactly repeatable**. In **T 301/87** (OJ 1990, 335) the invention provided a route through recombinant DNA technology to certain types of interferons but in a manner that would not provide identical results each time when repeated. The board concluded that variations in construction within a class of genetic precursors, such as recombinant DNA molecules claimed by a combination of structural limitations and functional tests, were immaterial to the sufficiency of disclosure provided the skilled person could reliably obtain some members of the class without necessarily knowing in advance which member would thereby be made available.

For an invention to be sufficiently disclosed it is necessary that the skilled person is given sufficient guidance for performing the invention in the whole range claimed without undue burden to give effect to the legal principle that the scope of the patent should be

justified by the technical contribution to the art (**T 612/92**). However, in **T 636/97** it was emphasised that it is a fundamental principle of patent law that a claim can validly cover broad subject-matter, even though the description of the relevant patent does not enable every method of arriving at that subject matter to be carried out. Otherwise no dominant patent could exist, and each developer of a new method of arriving at that subject matter would be free of earlier patents. In **T 694/92** (OJ 1997, 408) the board held that, where an invention relates to the actual realisation of a technical effect anticipated at a theoretical level in the prior art, a proper balance must be found between, on the one hand, the actual technical contribution to the state of the art by said invention, and, on the other hand, the terms in which it is claimed, so that, if patent protection is granted, its scope is fair and adequate. The board highlighted the interrelation between the requirements of Art. 84, 83 and 56 EPC 1973.

As for the amount of detail needed for a sufficient disclosure, this depends on the correlation of the facts of the case to certain general parameters, such as the character of the technical field and the average amount of effort necessary to put into practice a certain written disclosure in that technical field, the time when the disclosure was presented to the public and the corresponding common general knowledge, and the amount of reliable technical details disclosed in a document (see **T 158/91**; **T 694/92**, OJ 1997, 408; **T 639/95**; and **T 36/00** and **T 1466/05**).

When examining sufficiency of disclosure, the boards have to be satisfied, firstly, that the patent specification places the skilled person in possession of **at least one way** of putting the claimed invention into practice, and secondly, that the skilled person can put the invention into practice **over the whole scope of the claim** (see e.g. **T 792/00**, **T 811/01**, **T 1241/03**, **T 364/06**). The necessary extent of disclosure is assessed on a case-by-case basis having regard to the essence of the invention (**T 694/92**, OJ 1997, 408).

In **T 292/85** (OJ 1989, 275) the board stated that an invention is regarded as sufficiently disclosed if at least one way is clearly indicated enabling the skilled person to carry out the invention. The invention of the present case concerned a recombinant plasmid comprising a homologous regulon, heterologous DNA and one or more termination codons for expression in bacteria of a functional heterologous polypeptide in recoverable form. The application was refused by the examining division on the grounds that not all embodiments falling within the broad functional wording of the claims were available. The claims also embraced the preparation of future products, whereas they should be limited to what was available at the priority date. The board disagreed, holding that the non-availability of some particular variants was immaterial as long as there were suitable variants known which provided the same effect.

Similarly, in **T 386/94** (OJ 1996, 658) the patent specification provided a technically detailed example for the expression of preprochymosin and its maturation forms in *E. coli*. It suggested the possibility of expressing these proteins in micro-organisms in general. The board held that the invention was sufficiently disclosed because one way to carry out the invention was clearly indicated and the state of the art contained no evidence that foreign genes could not be expressed in organisms other than *E. coli*. The

principles set out in **T 292/85** (OJ 1989, 275) were also applied in **T 984/00** (where the invention lay in the use of the T-region of the Agrobacterium without the genes of the T-region of wild type Ti-plasmids to avoid the deleterious effects of these genes on the target plant) and in **T 309/06** (where the appellant had disclosed a novel group of enzymes characterised by useful properties and the board allowed the appellant to claim the enzymes independently of their origin).

In other cases, more technical details and more than one example were found necessary in order to support claims of a broad scope, for example where the essence of the invention was the achievement of a given technical effect by known techniques in different areas of application and serious doubts existed as to whether this effect could readily be obtained for the whole range of applications claimed, more technical details and more than one example may be required (see **T 612/92**; **T 694/92**, OJ 1997, 408; **T 187/93** and **T 923/92**). In **T 694/92** incomplete guidance was given. The claimed subject-matter concerned a method for genetically modifying a plant cell. In fact, the board held that the experimental evidence and technical details in the description were not sufficient for the skilled person to reliably achieve, without undue burden, the technical effect of expression in any plant cell of any plant structural gene under the control of any plant promoter. Further cases, where more than one example was required, may be found under 5.1.2.

An application may only be objected to for lack of sufficient disclosure if there are serious doubts, substantiated by verifiable facts. The mere fact that a claim is broad is not in itself a ground for considering that the application does not comply with the requirement that it be sufficiently disclosed under Art. 83 EPC (see e.g. **T 19/90**, OJ 1990, 476; established case law, serious doubts e.g. upheld in **T 612/92** but not in **T 351/01**, **T 21/05**, **T 1188/06**, **T 884/06** or **T 364/06**). In **T 19/90** the claimed invention was defined by the incorporation of an activated oncogene sequence into the genome of non-human mammalian animals in general. The examining division refused the application on the grounds that in the light of the differences among different animals, it could not be assumed that the sole example given - mice - could be extended to all other non-human mammalian animals and the claims were thus unrealistically broad. The board disagreed.

5.1.2 Factors contributing to a finding of undue burden

In **T 187/93**, for example, there were experimental uncertainties in the patent application. The invention concerned a method for producing, by expression in eukaryotic cells, a truncated membrane-free derivative of a viral polypeptide, which provided protection in an immunised subject against in vivo challenge by a viral pathogen. Examples were only given of truncation of HSV glycoprotein gD. No general technique allowing extrapolation of the results to any other glycoprotein from any other virus were disclosed. The board found that the skilled person, when trying to obtain the same technical effect with a different glycoprotein would have experienced lack of predictability, which amounted to an undue burden.

Similarly, in **T 727/95**, the board found that the invention relied too much on chance. The claimed subject-matter included a “microorganism designated *Acetobacter* and having the ability of microorganisms ATCC 53264, ATCC 53263 and ATCC 53524 to [...]”. The board observed that by including the phrase “having the ability of”, the claim covered not only *Acetobacter* microorganisms derived from the deposited strains, but also *Acetobacter* microorganisms which had the stated characteristics in common with the deposited strains. In the board's judgment, finding other stable, cellulose high-producing *Acetobacter* strains in nature was a chance event, and relying on chance for reproducibility amounted to an undue burden in the absence of evidence that such chance events occurred and could be identified frequently enough to guarantee success. The board concluded that the claim was not repeatable without undue burden over the entire breadth of the claim.

The claimed subject-matter in **T 639/95** concerned a method for producing PHB biopolymers in a host transformed with genes encoding the enzymes β -ketothiolase, acetoacetyl-CoA reductase and polyhydroxy butyrate (PHB) synthetase. The board found that the experimental plan for identifying and isolating the PHB gene was very general. Some references were missing and/or incomplete. There were no results and no details which could facilitate the repetition of the work. The board thus held that the total amount of experimental effort necessary to advance successfully step by step towards the desired final goal amounted to an undue burden for the skilled person.

However, in **T 412/93**, where errors and omissions prejudiced the reproducibility of one of the examples in toto and of another example in part, the reproducibility of the invention was not affected, as the examples were alternatives to previous ones.

In **T 612/92**, further scientific research would have been necessary in order to carry out the invention in some of the areas claimed. The claimed invention related to a method for incorporating foreign DNA into the genome of monocotyledonous plants via T-DNA. The patent suggested applying to monocotyledonous plants the same technique as known from the prior art for dicotyledonous plants. Examples of the transformation of two monocotyledonous species were given, but no new technique was suggested, nor were any indications given of any adaptations necessary to make the known method work in monocotyledonous species. Later work resulted in lack of success in other monocotyledonous species. The board held the requirements of Art. 83 EPC 1973 were not fulfilled because there were serious doubts as to whether such a method could be performed over the whole range that was claimed (see **T 694/92**, OJ 1997, 408).

However, in **T 223/92** the board rejected an objection by the appellant (opponent) that the provision of a DNA sequence coding for human interferon-gamma was in itself not sufficient and that it amounted to an undue burden for the skilled person to repeat the invention on the basis of this knowledge. The board was well aware of the fact that even with the full disclosure of the DNA sequence, reproducibility of the whole process of expressing the gene to produce the desired interferon gamma was still a difficult, complex and **time-consuming** task in 1981. Nonetheless, the board was convinced that the provision of the DNA sequence in 1981 enabled those skilled in the art to reproduce the invention, possibly in a time-consuming and cumbersome way, but, in the given

circumstances, **without undue burden** of experimentation and without needing inventive skill (see also **T 412/93**).

In **T 1466/05** the question arose whether the availability of a hybridoma producing one specific antibody (51A93) together with a general description of the epitope recognised by this antibody put the skilled person in the position to obtain further antibodies with the same specificity. The board observed that similar questions had arisen in various cases decided by the boards of appeal, and different boards had given different answers depending on the circumstances of each case (**T 510/94**, **T 513/94**, **T 349/91**, **T 716/01**).

The board pointed out that claim 1 was not restricted to chimeric monoclonal antibodies sharing the complementarity determining region (CDR) of the antibody produced by the deposited hybridoma, but encompassed also monoclonal antibodies which, even though having the same specificity, are not derived from antibody 51A93. In view of the fact that the application did not disclose any specific antigen for preparing further antibodies as claimed, the board considered that a skilled person seeking to prepare such antibodies would have to embark on a research programme with the sole guidance of a desideratum, namely that the antibodies must react specifically with the pyridinoline in peptide-linked pyridinoline, but without any teaching in the application as how to achieve the desired specificity. Due to the lack of technical details, the skilled person seeking to produce further antibodies as claimed would have to carry out additional experimentation which went beyond the average amount of effort necessary in the field of monoclonal antibodies, without any guidance from the application. This additional experimentation amounted to an undue burden.

5.2. Deposit of living material

If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in Art. 83 EPC if a sample of the biological material has been deposited with a recognised depositary institution not later than the date of filing of the application (R. 31(1)(a) EPC) and if the application fulfils the other requirements set out in R. 31 EPC (see also **G 2/93**, OJ 1995, 275).

As part of the 2000 EPC revision, for greater clarity and consistency, R. 27a, 28 and 28a EPC 1973 were restructured, trimmed and incorporated (as R. 30 to 34 EPC) into the chapter on biotechnological inventions (see OJ SE 1/2003, 164, OJ SE 5/2007, 44 and 54). New R. 31 EPC deals with the deposit of biological material, new R. 32 EPC with the expert solution and new R. 33 EPC with the availability of the deposited biological material as from the date of application of the European patent application (OJ SE 5/2007, 46).

5.2.1 Substantive law questions

In decision **T 418/89** (OJ 1993, 20) the board had to decide whether the deposited hybridoma enabled the skilled person to carry out the invention as claimed. The board found that the characteristics of the monoclonal antibodies produced by the deposited strain were different from those mentioned in the claims and that it was not possible to produce monoclonal antibodies from the deposited hybridoma using techniques recommended by the depository institution. The requirements of Art. 83 EPC 1973 were thus not met. A disclosure could not be regarded as sufficient if and when it was only possible to reproduce the invention after repeated requests to the depository institution and by applying techniques considerably more sophisticated than those the latter recommended. Nor could the scope of the patent be restricted to what had been deposited, as the characteristics of the deposit differed from the written disclosure in the patent. The true characteristics of the monoclonal antibodies produced by the deposited hybridoma were nowhere described and thus not available to the public. Thus a mere deposit of a hybridoma without any corresponding written description did not provide a sufficient disclosure. Similar conclusions were reached in decisions **T 495/89** and **T 498/94**.

R. 31(1) EPC cannot be interpreted such that there is an obligation to deposit material to facilitate the reproduction if the invention can be repeated on the basis of the written description, even if this should be a much more cumbersome way than by merely growing the deposited micro-organism (see e.g. **T 223/92**).

Similarly, in **T 412/93** the board stated that the need for a deposit cannot be introduced by reference to the concept of undue burden. This concept relates more to cases where the route that the reader is to follow is so poorly marked that success is not certain such as in **T 418/89** (see above). If the road is certain but long and laborious, the patentee is under no obligation to assist the disclosure by making actual physical samples available. The board felt that to come to the opposite conclusion would be effectively to introduce a requirement to make the best mode immediately accessible to the public, and such a requirement is not part of the European patent system (see also **T 431/96**).

With respect to the question whether the **reproducibility of specific micro-organisms** (e.g. plasmids or viral strains) was assured by the written description in the absence of a deposit, the board, after careful examination of the written disclosure, held in some cases that the information provided in the application was sufficient to lead the skilled person reliably to the same micro-organisms (**T 283/86**, **T 181/87**); in other cases it was not (**T 815/90**, **T 816/90**).

5.2.2 Procedural law questions

a) Conversion into deposit under the Budapest Treaty

T 39/88 (OJ 1989, 499) affirmed the principle that one important purpose of R. 28 EPC 1973 (R. 31 EPC) is to make the availability of the deposited organisms independent of any consent by the depositor. The board observed that the proper way of bringing a

deposit originally filed for another purpose (here a US application) into line with the requirements of the EPC system was to formally convert the deposit into a deposit under R. 28 EPC 1973 (in the case of a deposit made on the basis of a special agreement between the EPO and the depositary institution) or into a deposit under the Budapest Treaty (which automatically covers R. 28 EPC 1973), as the case might be (see also **T 239/87**, **T 90/88**, **T 106/88**).

b) Late submission of deposit number

According to R. 28(1)(c) EPC 1973, the application must state the depositary institution and the file number of the deposited biological material. In **G 2/93** (OJ 1995, 275) the Enlarged Board of Appeal held that the provisions of R. 28 EPC 1973 were subordinate to the requirements of Art. 83 EPC 1973. The indication of the file number (accession number) of a culture deposit in a patent application was substantive because, under the Convention, it was instrumental in enabling a person skilled in the art to carry out the invention. The Enlarged Board therefore held that, contrary to the ruling in **J 8/87** (OJ 1989, 9), the information concerning the file number may not be submitted after expiry of the time limit set out in R. 28(2)(a) EPC 1973 (i.e. sixteen months after the date of filing of the application or, if priority is claimed, after the priority date).

As for the term "publication" within the meaning of R. 28(2)(a), second part of sentence, EPC 1973 in the context of a European application filed as an international one, see **T 328/04**.

See **T 227/97** (OJ 1999, 495) for the board's decision that reestablishment of rights may be available for the time limit set by R. 28(2)(a) EPC 1973 and R. 13bis.4 PCT.

6. The relationship between Article 83 and Article 84 EPC

In the course of the revision of the EPC, only minor editorial amendments were made to the title of the English version and the text of the German version.

6.1. Article 83 EPC and support from the description

The patent claims must clearly define the subject-matter for which protection is sought under Art. 84 EPC. In **T 94/82** (OJ 1984, 75) it was held that this requirement was fulfilled in a claim to a product when the characteristics of the product were specified by parameters relating to the physical structure of the product, provided that those parameters could be clearly and reliably determined by objective procedures which were usual in the art. In such a product claim, it sufficed to state the physical properties of the product in terms of parameters, since it was not mandatory to give instructions in the claim itself as to how the product was to be obtained. The description, however, had to fulfil the requirements of Art. 83 EPC 1973 and thus enable the person skilled in the art to obtain the claimed product described in it (see also **T 487/89**, **T 297/90**, **T 541/97**). Nor should this be understood as also referring to those variants falling under the literal wording of the claim but which the skilled person would immediately exclude as being clearly outside the scope of practical application of the claimed subject matter, for

example, claims including an open ended range for a parameter where it was clear for a skilled person that the open-ended range was limited in practice. Values of the parameter not obtainable in practice would not be regarded by the skilled person as being covered by the claims and thus could not justify an objection of insufficiency of disclosure (**T 1018/05**).

It is of relevance whether a problem falls within Art. 83 or Art. 84 EPC when taking into consideration that examination in respect of the requirements of Art. 83 EPC is still permitted during opposition proceedings, whereas in respect of Art. 84 EPC it is limited during opposition proceedings to those cases where there has been an amendment (see **T 127/85**, OJ 1989, 271; see also **T 301/87**, OJ 1990, 335; **T 1055/98**, **T 5/99**). With regard to the examination in respect of Art. 84 EPC during opposition proceedings see also chapter VII.D.4.1.4 and 4.2 (amendments).

In **T 292/85** (OJ 1989, 275) the stated grounds for the refusal were that the disclosure was not sufficient under Art. 83 EPC 1973 and there was consequently a lack of proper support under Art. 84 EPC 1973. The board pointed out that in appropriate cases it is only possible to define the invention (the matter for which protection was sought, Art. 84 EPC 1973), in a way which gives fair protection having regard to the nature of the invention which had been described by using functional terminology in the claims. The need for fair protection governs both the considerations concerning the scope of claims and the requirements for sufficient disclosure. The board found that an invention is sufficiently disclosed if at least one way is clearly indicated enabling the skilled person to carry out the invention.

In **T 409/91** (OJ 1994, 653; ex parte proceedings) and **T 435/91** (OJ 1995, 188; inter partes proceedings) it was pointed out that the protection conferred by a patent should correspond to the technical contribution to the art made by the disclosure of the invention described therein, which excludes the patent monopoly being extended to subject-matter which, after reading the patent specification, would still not be at the disposal of the skilled person. The available information must enable the skilled person to achieve the envisaged result within the whole ambit of the claim containing the respective functional definition without undue difficulty, and the description with or without the relevant common general knowledge must provide a fully self-sufficient technical concept as to how this result is to be achieved. **T 409/91** was followed up in **T 713/98**, where the board stated that the requirement of understanding a claim characterised by a functional feature defining a result to be achieved was one of clarity and the requirement of implementing it was one of support, both within the meaning of Art. 84 EPC 1973. Implementation, viewed in relation to the disclosure as a whole, was highly relevant to the question of sufficiency under Art. 83 EPC 1973. See also **T 1225/07**.

In the inter partes case **T 435/91** (OJ 1995, 188), one of the essential technical features of claim 1, an additive which forced a detergent composition into the hexagonal liquid crystal phase, was defined only by its function. The patentee admitted that it was not possible to identify, on the basis of the information contained in the patent specification or of common general knowledge, compounds other than those specifically mentioned as bringing about the desired effect. The board was of the opinion that the compositions

must all be available to the skilled person if the definition was to meet the requirements of Art. 83 EPC 1973.

However, as long as there are no concrete grounds for believing that the invention cannot be carried out within the whole range claimed, there is no reason for not allowing more broadly based claims in an application (**T 242/92**, **T 484/92**). In opposition proceedings the opponent bears the burden of proving that the invention cannot be carried out within the whole range claimed (**T 418/91**, **T 456/91**, **T 548/91**).

In **T 1404/05** the board found that where a claim is vaguely formulated and leaves several constructions open as possibilities, and on one of these constructions part of the subject-matter claimed is not sufficiently described to be carried out, the claim is open to objection under Art. 100(b) EPC. To avoid this objection the claim needs to be explicitly restricted to a construction which is also possible on the vague formulation of the claim, but which construction is not open to an Art. 100(b) EPC objection. The mere fact that the description makes clear that this latter construction is the one intended does not mean that the claim can be treated as being confined to this latter construction. Art. 69 EPC and its protocol were intended to assist a patent proprietor in contending for a broader interpretation of a claim than perhaps its wording warranted, not for cutting down the scope of a claim.

6.2. Article 83 EPC and clarity of claims

When undefined parameters are used in the claims and no details of the measuring methods are supplied, the question arises whether there is a problem with respect to Art. 83 or Art. 84 EPC. The answer to this question is important because in opposition proceedings the patent can be examined for its compliance with Art. 83 EPC without any restriction. Compliance with Art. 84 EPC is however examined only in cases where there has been an amendment.

In some decisions (**T 123/85**, **T 124/85**, **T 172/87**, **T 358/88**, **T 449/90**, **T 148/91**, **T 267/91**, **T 697/91**, **T 225/93**, **T 378/97**, **T 387/01**, **T 252/02**, **T 611/02** and **T 464/05**) the absence of information in the application on methods for measuring undetermined parameters in the application was considered a problem with respect to Art. 83 EPC 1973. This problem has also been addressed with reference to Art. 83 EPC 1973 in ex parte proceedings, (see **T 122/89** of 5.2.1991 and **T 503/92**). Other decisions have considered this a problem with respect to Art. 84 EPC 1973, for example, in **T 860/93** (OJ 1995, 47), also ex parte proceedings, it was decided that the absence of methods for measuring a relative quality in the claim was a problem with respect to the clarity of the claim under Art. 84 EPC 1973 (see also **T 230/87**, **T 176/91**, **T 917/92**, **T 299/97**, **T 439/98**, **T 413/99**, **T 930/99**, **T 960/98**, **T 619/00**, **T 943/00**, **T 344/01**, **T 563/02**, **T 1033/02**, **T 208/03**, **T 882/03**, **T 452/04**, **T 1316/04**, **T 466/05**, **T 1586/05**, **T 859/06**). Some of these decisions are discussed further below.

In **T 464/05**, the board held that the patent in suit did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 83 EPC 1973). This finding essentially corresponded to the requirement that the

skilled person had to know "when he is working within the forbidden area of the claims" (see e.g. decisions **T 256/87** and decisions **T 387/01**, **T 611/02** and **T 252/02** of board 3.2.06). In the board's view, although this requirement in its broad reading was certainly related to Art. 84 EPC 1973 (see e.g. decision **T 943/00**), it was in fact related to Art. 83 EPC 1973 in its restricted reading, implying that the skilled person had to be able to determine whether a particular object fell within the forbidden area of the claims intended as the area including those embodiments that effectively solved the technical problem underlying the patent in suit.

In **T 1055/92** (OJ 1995, 214) the examining division had rejected the patent application under Art. 84 EPC 1973 because **in the claim** it was not clear how certain values were to be computed. The board held that the requirements of Art. 84 EPC 1973, that the claims shall define the matter for which protection is sought, should be clearly distinguished from the requirement under Art. 83 EPC 1973 that the European patent application had to disclose the invention in such a way that it enabled a person skilled in the art to carry out that same invention. Under Art. 83 EPC 1973, sufficient disclosure was required of a European patent application, i.e. of the application as a whole, comprising the claims, together with the description and the drawings, but not of an individual claim as such. A claim, on the other hand, had to comprise the essential features of the invention (**T 32/82**, OJ 1984, 354); the essential features should comprise those features which distinguished the invention from the closest prior art. The primary function of a claim was to set out the scope of protection sought for an invention, which implies that it is not always necessary for a claim to identify technical features or steps in detail (see also **T 713/98**, in 6.1 above).

According to **T 882/03**, slightly varying results obtained when using different mathematical models for the calculation of the intrinsic viscosity did not prevent a person skilled in the art from carrying out the invention but were rather related to the question of whether the matter for which protection was sought was sufficiently defined in accordance with Art. 84 EPC 1973.

In **T 256/87** (see also 4.2 above), the board had found that the skilled person reading the specification should be able to carry out the invention in all its essential aspects and know when he is working within the forbidden area of the claims. Indirect empirical investigation referred to in the specification was an acceptable solution, which sufficed to fulfil the requirements of Art. 83 EPC 1973 without undue burden. In **T 943/00**, the board disagreed with **T 256/87**, finding that the concept of 'forbidden area' was associated with the scope of the claims, i.e. Art. 84 EPC 1973, rather than with sufficiency of disclosure. The board in **T 466/05** agreed, also stating that a distinction should be made between the requirements of Art. 84 EPC 1973 and those of Art. 83 EPC 1973, and that with respect to sufficiency, the relevant question was whether the patent in suit provided sufficient information which enabled the skilled person when taking into account common general knowledge to reproduce the invention. See also **T 452/04** and **T 1586/05**. Other decisions have also interpreted the statement, 'knowing when working within the forbidden area of the claims' formulated in **T 256/87** as addressing the question of the limits of protection conferred by the claims, and thus relating to a requirement of Art. 84

EPC 1973 rather than of Art. 84 EPC 1973 (e.g. **T 960/98**, **T 943/00**, **T 619/00**, **T 452/04**, **T 466/05**).

The board in **T 608/07** found the issue before it with regard to sufficiency of disclosure was quite similar to the situation in **T 256/87**, both concerning an insufficiency which arose through ambiguity. Although the board accepted that, depending upon the circumstances, such an ambiguity might very well lead to an insufficiency objection, it should be borne in mind that this ambiguity also related to the scope of the claims, i.e. Art. 84 EPC 1973. Since, however, Art. 84 EPC 1973 was in itself not a ground of opposition, care had to be taken that an insufficiency objection arising out of an ambiguity was not merely a hidden objection under Art. 84 EPC 1973. The board was convinced that, for an insufficiency arising out of ambiguity, it was not enough to show that an ambiguity existed, e.g. at the edges of the claims. It would normally be necessary to show that the ambiguity deprived the person skilled in the art of the promise of the invention. It went without saying that this delicate balance between Art. 83 and 84 EPC 1973 had to be assessed on the merits of each individual case.

In **T 378/97**, the board noted that sufficiency of disclosure addressed the practitioner who reduced the invention to practice, but did not stick to any precise theoretical values. Varying results did not, therefore, necessarily prevent a person skilled in the art from carrying out an invention (Art. 83 EPC 1973), but could be a matter of the definition of the invention under Art. 84 EPC 1973. See also **T 960/98**, where the board stated that the relevant question with respect to sufficiency of disclosure was whether the patent in suit provided sufficient information to enable the skilled person, taking into account common general knowledge, to reproduce the invention, and **T 586/94**, **T 245/98** and **T 859/06**. Following **T 378/97**, the board in **T 439/98** found that the appellant's objections in regard to sufficiency of disclosure (the patent in suit allegedly failed to indicate a suitable method for measuring porosity), concerned the scope of the value of porosity indicated in the claim and therefore the clarity of the claim, rather than the possibility of reproducing the invention. In **T 619/00**, the board agreed that the different methods for determining the value of the gel fraction did not per se represent an undue burden. In the absence of evidence that the different methods specified would lead to determination values deviating from each other by a substantial amount having technical significance (following **T 378/97**), or by an amount that would place the skilled person in a situation where he was unable to carry out the invention (following **T 930/99**), the mere fact that the patent specification was silent as to which method should be used did not prejudice sufficiency of disclosure. The question whether the methods defined lead to a unique value or to different values also concerned the clarity of the definition of the subject-matter of the claim under Art. 84 EPC 1973. In **T 930/99** only one measuring method was involved and the board had therefore considered **T 225/93** inapplicable, (According to **T 225/93**, different measuring methods which did not always lead to the same result could amount to an undue burden.) The respondent's argument that there would be legal uncertainty, since third parties would not know whether they were working within or outside the range specified, was clearly an argument based on lack of clarity, which was not a ground of opposition and so could not be considered. See also **T 396/02**.

According to **T 805/93**, Art. 84 EPC 1973 stipulated that the claims should define the matter for which protection was sought. In the case before it, as the viscosity was the only characterizing feature of the claim at issue, it was clear that its role in defining the matter for which protection was sought, was a crucial one. The lack of information regarding the exact conditions under which the viscosity limit of the claim was to be determined, resulted in uncertainty as to the exact limits of its scope. Therefore, the viscosity could not be considered to be clearly indicated and the matter for which protection was sought could not be deemed defined, so that the claim did not comply with Art. 84 EPC 1973. For the same reason, the skilled person would be left in considerable doubt as to which compounds to select when choosing the reactive components in order to obtain the reaction product falling within the terms of the claimed adhesive. Therefore, the disclosure of the application in suit did not enable him to carry out the claimed subject-matter on a general basis, so that the requirements of Art. 83 EPC 1973 were also not met.

7. Evidence

The objection of lack of sufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts (**T 19/90**, OJ 1990, 476; **T 890/02**, OJ 2005, 497).

In order to establish insufficiency, the burden of proof is upon an opponent to establish on the balance of probabilities that a skilled reader of the patent, using his common general knowledge, would be unable to carry out the invention (**T 182/89**, OJ 1991, 391). A mere statement that one of several examples in a patent has been repeated once "exactly as described" without obtaining exactly the results claimed in the patent is in principle inadequate to discharge that burden (see also **T 406/91**, **T 418/91**, **T 548/91**, **T 588/93**, **T 465/97**, **T 998/97**, **T 499/00** and **T 751/00**). Where the parties make contradictory but unsubstantiated assertions concerning facts relevant for establishing patentability and the EPO is not in a position to establish the facts of its own motion, the benefit of the doubt is given to the patent proprietor (**T 72/04**). If the patent contains only an example with a hypothetical experimental protocol, and this example is to be relied on for showing sufficiency, then the burden of proof lies on the patentee to show that in practice this protocol works as stated. Evidence that a variation of this protocol works is unlikely to be enough (**T 792/00**). For more details see chapter VI.H. (law of evidence).

The board in **T 63/06** agreed that the burden of proof generally lies upon an opponent to establish insufficiency of disclosure. When the patent does not give any information as to how a feature of the invention can be put into practice, only a weak presumption exists that the invention is sufficiently disclosed. In such a 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.

As proof that an invention has been insufficiently disclosed, the boards require that the attempt to repeat it must fail despite following the conditions given in the examples. This requirement is not fulfilled where the opponent repeats the patented process under

conditions covered by claim 1 but differing in many respects from those applying in the contested patent's examples (**T 665/90**).

An invention should be reproduced using the examples given. Insufficiency cannot be proven on the basis of laboratory trials when the only embodiment exemplified in the patent is an industrial fermentation process (**T 740/90**). The disclosure was also considered sufficient where the opponent had only used equivalents of the surfactants given in the patent, as he had not discharged his burden of proof (**T 406/91**).

It was held in **T 541/96** that if an invention seems to offend against the generally accepted laws of physics and established theories, the disclosure should be detailed enough to prove to a skilled person conversant with mainstream science and technology that the invention is indeed feasible, the onus being on the applicant (see also **T 1023/00**). The more a new invention contradicts previously accepted technical wisdom, the greater the amount of technical information and explanation is required in the application to enable the invention to be carried out by the average skilled person to whom only that conventional knowledge is available (**T 1785/06**).

B. Claims

Art. 84 EPC lays down the relevant principles governing the content and wording of the claims, providing that claims should be clear and concise and be supported by the description. It is supplemented by R. 43 EPC.

When the EPC was revised, the German and English versions of Art. 84 EPC were only amended under Art. 3(1) of the Revision Act (alignment/minor amendment; see OJ SE 4/2007, 84). Similarly, R. 29 EPC 1973, which after renumbering became R. 43 EPC, simply underwent streamlining and alignment (see OJ SE 5/2007, 72). In substance, the two provisions remain unchanged, which means that the EPC 1973 case law continues to apply.

As explained in decision **G 2/88** (OJ 1990, 93, Corr. 469) in relation to EPC 1973, Art. 84 EPC provides that the claims of a European patent application "shall define the matter for which protection is sought". R. 43(1) EPC further requires that the claims "shall define the matter for which protection is sought in terms of the technical features of the invention". The primary aim of the wording used in a claim must therefore be to satisfy such requirements, having regard to the particular nature of the invention, and the purpose of the claims. The purpose of claims under the EPC is to enable the protection conferred by the patent or patent application to be determined (Art. 69 EPC), and thus the rights of the patent owner within the designated contracting states (Art. 64 EPC), having regard to the patentability requirements of Art. 52 to 57 EPC.

There are basically two different types of claim, namely a claim to a physical entity (e.g. product, apparatus) and a claim to a physical activity (e.g. method, process, use). These two basic types of claim are sometimes referred to as the two possible "categories" of claim. Within the above two basic types of claim various sub-classes are possible (e.g. a compound, a composition, a machine; or a manufacturing method, a process of

producing a compound, a method of testing, etc.). Furthermore, claims including both features relating to physical activities and features relating to physical entities are also possible. There are no rigid lines of demarcation between the various possible forms of claim.

The technical features of the invention are the physical features which are essential to it. The technical features of a claim to a physical entity are the physical parameters of the entity, and the technical features of a claim to an activity are the physical steps which define such activity. The Enlarged Board of Appeal also pointed out, however, that the boards of appeal had in a number of cases allowed the technical features to be defined functionally in certain instances (e.g. **T 68/85**, OJ 1987, 228; **T 139/85**).

So-called reach-through claims are to be distinguished.

In **T 1063/06** (OJ 2009, 516) the board held that a formulation of a claim whereby functionally defined chemical compounds were to be found by means of a new kind of research tool using a screening method set out in the description constituted a reach-through claim which was also directed to future inventions based on the one now being disclosed. As the applicant was entitled to claim patent protection only for his actual contribution to the art, it was therefore both reasonable and imperative to limit the claim's subject-matter accordingly. Patent protection under the EPC was not designed for the purpose of reserving an unexplored field of research for a particular applicant, as reach-through claims did, but to protect factual results of successful research as a reward for making concrete technical results available to the public.

The boards of appeal have repeatedly confirmed that claims had to be clear for the sake of legal certainty, as their purpose was to enable the protection conferred by the patent to be determined (see e.g. **T 337/95**, OJ 1996, 628; **T 338/95**, **T 586/97**, **T 437/98**, **T 728/98**, OJ 2001, 319; **T 877/99**, **T 1074/00**, **T 799/04**).

1. Clarity

1.1. Principles governing the text of claims

1.1.1 General

The protection sought should normally be indicated in the claims by technical features (see **T 4/80**, OJ 1982, 149). Furthermore the claims per se must be free of contradiction (see **T 2/80**, OJ 1981, 431).

In a case as far back as **T 165/84** it was considered that the claims lacked clarity if the exact distinctions which delimited the scope of protection could not be learnt from them.

When a claim is directed to a product characterised by parameters, those parameters must be clearly and reliably determined (see **T 94/82**, OJ 1984, 75; **T 452/91**, **T 541/97**, **T 437/98**, **T 193/01**). On the extent to which it must be clear from the claim itself how a parameter is to be determined, see section 1.1.2 below.

In **T 412/93**, however, the board observed that frequently where something had to be measured there would be a grey area where measurement error might make it difficult to determine whether a particular product fell within a claim or not. The board held that this did not justify an objection under Art. 84 EPC 1973.

In **T 555/05** the board pointed out that the feature considered in **T 412/93** was defined in relative terms in respect to a product of the prior art as reference. In the case at issue, however, the feature giving rise to the objection was defined in absolute terms. The board therefore decided that the claim at issue did not meet the requirements of Art. 84 EPC 1973.

When an essential ingredient comprised in a chemical composition is open to be labelled arbitrarily "active ingredient" or not depending exclusively on the mental label the user wished to apply, thereby rendering the meaning of that feature protean, then the public is left in doubt as to the distinction which compositions are covered by the claim and which are not, which is at variance with the principle of legal certainty. Because of that lack of legal certainty, the claim at issue in **T 586/97** fails to meet the requirement of clarity imposed by Art. 84 EPC 1973.

In **T 762/90** a lack of clarity was found in the use of a trade mark designating a whole series of products which differed from one another depending on phases in their industrial development. Moreover, the board expressed doubts about the use of such a designation, since it was uncertain whether the meaning of the trade mark would remain unaltered up to the end of the patent term (see also **T 939/92**). Similarly, in **T 480/98** the board considered that a trade mark product referred to in the characterising portion of claim 1 did not have a clear technical meaning, in that it could refer to a plurality of products having different compositions and properties. In consequence there was a lack of clarity, and the claim was not allowable. According to the board in **T 623/91** the exclusion of a composition by reference to the trade mark or trade designation would not introduce uncertainty and therefore not offend against Art. 84 EPC 1973, as changes in the range of chemical composition would not be likely without a corresponding change in the trade name or trade mark.

The preamble of claim 2 of the application in **T 363/99** contained a reference to a German patent specification. The board considered this to be a violation of Art. 84, second sentence, EPC 1973 since it was impossible to establish the scope of the matter for which protection was sought without consulting the reference document mentioned. The fact that the indication of the publication number of the reference document provided the most concise definition of the matter for which protection was sought (Art. 84 EPC 1973) was irrelevant by comparison. When formulating a patent claim, the form that was objectively more precise always had to be chosen (**T 68/85**, OJ 1987, 228).

In **T 728/98** (OJ 2001, 319) the board held that it followed from the requirement of legal certainty that a claim could not be considered clear within the meaning of Art. 84 EPC 1973 if it comprised an unclear technical feature (here "substantially pure") for which **no** unequivocal generally accepted meaning existed in the relevant art. This applied all the more if the unclear feature was essential for delimiting the subject-matter claimed from

the prior art. In this case the description did not give any indication as to how the term should be interpreted. Likewise in **T 226/98** the board held that the feature "as a pharmaceutical product" for defining a pharmaceutical standard of purity in a claim related to a product as such (here, famotidine form "B"), rendered said claim unclear in the absence of a generally accepted quantitative definition for the purported standard of purity.

In decisions **T 1129/97** (OJ 2001, 273) and **T 274/98** the board emphasised that, to satisfy the clarity requirement, the group of compounds/ingredients according to the claim had to be defined in such a way that the skilled person could clearly distinguish compounds/ingredients that belonged to the claimed group from those that did not (see also **T 425/98** regarding the expression "consisting of a major amount of"). In **T 274/98** the board stated that in the context of a claim relating to a cosmetic or pharmaceutical composition containing fatty bodies, the term "products sensitive to oxidation" referred to products which, at ambient temperature, were degraded in the presence of oxygen. In that light the disputed term was perfectly clear. The appellant failed to supply evidence that in the given context some products would be susceptible to oxidation in some conditions and not in others. Hence there was no ambiguity, and the claim was clear.

Where a quality is expressed in a claim as being within a numerical range, the method for measuring that quality must be either general knowledge or a method for measuring it needs to be identified. However, where the claim specifies that a quality must be absent, this implies that this quality cannot be detected by the methods which are common in the art for measuring it, so that the indication of a specific method is not necessary (**T 1012/98**).

Complexity as such is not equivalent to a lack of clarity - clarity under Art. 84 EPC is not at stake in a case of mere complexity of a claim provided the subject-matter for which the protection is sought and the scope thereof are clear and unambiguous for a person skilled in the art, either per se or in the light of the description (see **T 574/96** re Art. 84 EPC 1973). In **T 1020/98** (OJ 2003, 533) the board confirmed that compliance with the clarity requirement of Art. 84 EPC 1973 was not dependent on the time required to establish whether a given compound was covered by the product claim. The clarity requirement was not a basis for objecting to the complexity of a claim. Clarity within the meaning of that article merely required the claims to define the subject-matter for which protection was sought clearly and unambiguously for the skilled person, if necessary in the light of the description.

In **T 687/00** the preamble of claim 1 of the main request related inter alia to a "plastic sealing sheet with appreciably better biaxial extensibility than conventional sheet". The board held that this part-feature conveyed a mere desideratum which made no intrinsic technical contribution to the subject-matter of the claim. Furthermore, the impugned feature described an objective to be achieved over the prior art and therefore concerned the central problem addressed by the inventor of the application at issue. A subjective problem of this kind could alter in the course of the procedure. The board emphasised

that the statement of the problem belonged, as usual, in the description and not in the claim.

In **T 194/99** the board stated that it was possible in a claim for a first entity to define certain characteristics of that entity as a function of characteristics of a second entity employed when using the first entity (medical laser apparatus defined as a function of absorption characteristics of a photosensitizer). As such, there was no need for the claim to be directed to the combination of the first and the second entity (**T 455/92**). According to the board, a prerequisite was, however, that the second entity and its relevant characteristics as such, not their exact values, were unambiguously identified in the claims.

In **T 651/05** the board found that the introduction of vague terms created a lack of clarity due to different but equally valid interpretations (see also **T 621/03** and **T 127/04**). Where, on one of several possible constructions of a vaguely formulated claim, part of the subject-matter claimed is not sufficiently described to be carried out, the claim is open to objection under Art. 100(b) EPC 1973 (**T 1404/05**, also reported under II.A.6.1, Art. 83 EPC and support from the description).

1.1.2 Characterisation of a product by a parameter

In decision **T 94/82** (OJ 1984, 75) the board ruled that the requirement of clarity could be fulfilled in a claim to a product if the characteristics of the product were specified by parameters related to the physical structure of the product, provided that those parameters could be **clearly and reliably** determined by objective procedures which were **usual in the art** (see also **T 452/91**, **T 541/97**, **T 437/98**, **T 193/01**). It is not mandatory to give instructions in the claim itself as to how the product is to be obtained (**T 94/82**).

In **T 29/05** it was found that although different experimental protocols might be applied in the case in point for assessing hybridisation under stringent conditions, they were usual in the art (following **T 1084/00**).

In **T 307/06** the claims contained the added feature "and a T_g of less than 25°C". The Board noted that there were different methods for determining T_g (glass transition temperature). However, the mere fact that several methods existed did not render the claims unclear if at least one of the following conditions was met:

- (a) the different methods yield essentially the same T_g values for the same material, or
- (b) the person skilled in the art had associated the range of T_g values mentioned in claim 1 at issue with only one standard method of measurement.

Neither condition (a) nor (b) was fulfilled. The board concluded that this left doubt as to which subject-matter was covered by claim 1, and thus rendered said claim unclear (see **T 728/98**, OJ 2001, 319).

In a number of decisions the boards stress that it must be clear to the skilled reader from the claim itself how the parameters are to be determined, unless it can be demonstrated that the skilled reader would immediately know which method and conditions to apply even without any such indication in the claim.

In **T 412/02** the board held that the unambiguous characterisation in a claim of a product by parameters or by a mathematical relation between parameters necessarily required that each parameter could be clearly and reliably determined. In the board's view, it followed that the knowledge of the method and conditions of determination of the parameter was necessary for the unambiguous definition of the parameters and, as a consequence, for the unambiguous definition of a mathematical relation between them. Thus, in order to allow the matter for which protection was sought to be defined, it had to be clear from the claim itself when being read by the person skilled in the art exactly how the parameters should be determined. This would, as a rule, imply that the method of determination and the conditions of measurement which might have an influence on the value of the parameter should be indicated in the claim, either expressly or, if appropriate, by way of reference to the description according to Rule 29(6) EPC 1973. Such indication would only become superfluous provided it could be shown that the skilled person would know from the outset which method and conditions to employ (see also **T 1156/01**).

According to **T 908/04**, to comply with Art. 84 EPC 1973, claims must be clear in themselves when being read with normal skills, but not including any knowledge derived from the description of the patent application (following **T 988/02**; see also **T 1898/06**). It must be clear from the claim itself when read by the person skilled in the art exactly how a parameter characterising the claimed product (in the case in point its crystallinity) should be determined. This would imply that the method of determination and the conditions of measurement which might have an influence on the value of the crystallinity should be indicated in the claim, either expressly or, if appropriate, by way of reference to the description according to R. 29(6) EPC 1973. Such indication would only become superfluous, provided it could be shown that the skilled person would know from the outset which method and conditions to employ because, e.g., this methodology was the methodology commonly used in the technical field, or that all the methodologies known in the relevant technical field for determining this parameter would yield the same result within the appropriate limit of measurement accuracy (see also **T 555/05**).

In **T 992/02** the board took the view that whilst noting the general principle that the claims must be clear per se, the non-inclusion in the claim of the method whereby one of the parameters characterising the composition claimed (level of formation of volatiles) could be measured was justified by the requirement that the claims be concise. It considered that such a conclusion could be reached in the case in hand because the method was clearly identified in the description and did not give rise to any ambiguity.

1.1.3 Reference to the description or drawings

In **T 150/82** (OJ 1984, 309) the board ruled that claims relying on references to the description in the specification in respect of all their technical features (so called

"omnibus claims") were unallowable as contrary to R. 29(4) and R. 29(6) EPC 1973 (R. 43 EPC, unchanged), unless absolutely necessary, e.g. when a plurality of conditions would not lend themselves to verbal expression without such a reference. Examples of such exceptions included inventions containing features or limitations which could only be expressed by means of drawings or graphs defining a particular shape or a plurality of conditions. In **T 271/88** the board upheld **T 150/82** and decided that it was not possible to base claims on an appendix showing structural chemical formulae designated as "chemical formulae incorporated within claims". The board held that it was quite evident that the terms "description" and "drawing" in R. 29(6) EPC 1973 were meant to cover structural chemical formulae (see also **T 752/94**).

In **T 1156/01**, the board considered that, if the invention was characterised by parameters, the method of and means for measurement should appear completely in the claim itself, whenever this was reasonable, or by reference to the description in accordance with R. 29(6) EPC 1973, if the method was so long that it would impair the conciseness of the claim (confirmed in **T 796/01**).

In **T 237/84** (OJ 1987, 309), the board stated that the purpose of reference signs in a claim (R. 29(7) EPC 1973) was to make the claims easier for all to understand. They did not limit the scope of the claim but did affect its clarity and might enable it to be expressed more concisely than would otherwise be possible (confirmed e.g. in **T 572/90**). In **T 986/97** the board allowed a reference to the drawings.

In decision **T 816/90** plasmids were defined by use of a designation which had no technical meaning per se. Moreover, their structure was defined by reference to a figure. The board was of the opinion that such a definition of a plasmid was contrary to the requirements of Art. 84 EPC 1973 and therefore could not be accepted.

1.1.4 Indication of all essential features

According to the established case law of the boards of appeal Art. 84 EPC (substantively unchanged in EPC 2000) has to be interpreted as meaning not only that a claim must be comprehensible from a technical point of view, but also that it must define the object of the invention clearly, that is to say indicate all the essential features thereof. All features which are necessary for solving the technical problem with which the application is concerned have to be regarded as essential features; see on this issue **T 32/82** (OJ 1984, 354) and **T 115/83**, confirmed inter alia in **T 269/87**, **T 391/91**, **T 409/91** (OJ 1994, 653), **T 694/92** (OJ 1997, 408), **T 1055/92** (OJ 1995, 214), **T 630/93**, **T 61/94**, **T 488/96**, **T 1167/97**, **T 203/98**, **T 260/01**, **T 1069/01**, **T 844/02** and **T 813/03**. The indication of all essential features is seen in part as necessary to meeting the clarity requirement, in part as a prerequisite for the support function laid down in Art. 84, second sentence, EPC 1973 (see below under section 4, claims supported by the description, and in part it is inferred from Art. 84, first sentence, EPC 1973 in conjunction with R. 29(1) and (3) EPC 1973.

The essential features should in particular comprise those which distinguish the invention from the prior art (**T 1055/92**, OJ 1995, 214; **T 813/03**). Regarding the delimitation of

essential from non-essential features, see also **T 61/94**, **T 203/98**, **T 141/00** and **T 260/01**.

The board's opinion in **T 32/82** was also confirmed in **T 622/90**, where it was held that lack of clarity could be caused not only by the presence of an ambiguous feature, but also by the absence of a feature which was necessary for clarity (see also **T 630/93**).

In **T 409/91** the invention related to mineral oils containing paraffin wax. The inventors found that waxy fuels having wax crystals of sufficiently small size at low temperatures to pass through paper filters used in diesel engines could be obtained by using additives with a structure described in the application by a general formula. The claims did not mention the additives.

The board held that the claims did not define the matter for which protection was sought by reference to all its essential technical features as required by Art. 84, first sentence, EPC 1973: in the description of the application in suit the use of certain additives was presented as an essential constituent of the fuel oil composition. As this feature was missing in the claims, the board found that they defined some other invention which was not sufficiently disclosed. The board further held that the requirement that the claims be supported by the description (Art. 84, second sentence, EPC 1973) reflected the general legal principle that the extent of a patent monopoly, as defined by the claims, should correspond to the technical contribution to the art. Claims should not therefore extend to subject-matter which would still not be at the disposal of a skilled person after reading the description. Consequently, a technical feature described and highlighted in the description as being an essential feature of the invention also had to be part of the claims.

In **T 914/02** the appellant sought to derive from the alleged sheer complexity of the proposed solution an implied use of technical means, in particular a computer. According to the board, it was doubtful as a matter of principle whether complexity could be used to disqualify an activity as a mental activity (see also under I.A.1.4.2). Rather, it would appear generally that if computer means were indeed indispensable, they should be included in the claim as an essential feature of the invention.

In **T 818/03** the board considered that a method claim which did not state sufficiently clearly the steps by which a particular result was achieved might still be considered clear provided the result to be achieved was clearly defined, and a claim which defined a method of achieving some less than clearly defined result might also still be considered clear provided the steps that needed to be taken to achieve that result were sufficiently clearly defined. However, a claim must be considered to lack clarity if, as here, it set out insufficiently clearly both the necessary parameters of the method and the relevant characteristic features of the result.

In **G 1/04** (OJ 2006, 334) the Enlarged Board recalled that an independent claim within the meaning of R. 29 EPC 1973 should explicitly specify all of the essential features needed to define the invention, and the meaning of these features should be clear for the person skilled in the art from the wording of the claim alone. The same should apply

mutatis mutandis in respect of a claim relating to the subject-matter excluded from patent protection under Art. 52(4) EPC 1973 (Art. 53(c) EPC). These requirements served the overriding purpose of legal certainty.

The Enlarged Board took the view that a diagnostic method within the meaning of Art. 52(4) EPC 1973 had an inherent and inescapable multi-step nature. If diagnosis as the deductive medical or veterinary decision phase was a purely intellectual exercise, the feature pertaining to the diagnosis for curative purposes and the features relating to the preceding steps which were constitutive for making the diagnosis represented the essential features of a diagnostic method within the meaning of Art. 52(4) EPC 1973. Thus, in order to satisfy the requirements of Art. 84 EPC 1973, an independent claim relating to such a method must include these features.

The essential features necessary for clearly and completely defining a particular invention were for the most part of a technical nature. But, if a non-technical feature was to be regarded as constitutive for defining the invention, it must likewise be included as an essential feature in the independent claim. Thus, although diagnosis *stricto sensu* was a purely intellectual exercise unless it was carried out by a device, the feature pertaining to it was such an essential feature as to be included in the independent claim. The same applied to a feature relating to a method step of a non-technical nature belonging to the preceding steps which were constitutive for making the diagnosis for curative purposes. As regards, in particular, the non-technical feature pertaining to diagnosis for curative purposes, it was to be included as an essential feature in the respective independent claim if its essentialness was unambiguously inferable from the respective European patent application or European patent as a whole. This was the case if the application or patent in question disclosed a method for obtaining findings of diagnostic relevance which allowed the attribution of the detected deviation to a particular clinical picture (on the principal issues of this decision, see Chapter I.A.2.5.)

1.1.5 Clarity of broad claims

It was stated in decision **T 238/88** (OJ 1992, 709) that the clarity of a claim is not diminished by the mere breadth of a term of art (e.g. "alkyl") contained in it, if the meaning of such term - either *per se* or in the light of the description - is unambiguous for a person skilled in the art (on the problem of the interpretation of claims in general, see Chapter II.B.5).

In **T 523/91** the board held that the wording "plastics in combination with inserts" and "this insert is combined with the plastics granules in a wound or folded manner" did not cause the subject-matter of the claim to be unclear within the meaning of Art. 84 EPC 1973. Although the nature of the combination covered many possibilities, the resulting subject-matter of the claim was broad rather than unclear. The broadness of a claim could not be contested on its own but only in conjunction with other criteria such as novelty, inventive step or reproducibility.

Likewise in **T 688/91** the board stated that a broad claim was not to be equated with one lacking clarity. In this instance the claim was worded as follows: "Integrated

microprogrammed apparatus [...] with apparatus to generate the T-states T0 [...], T1 [...], [...] characterised in that [...] the generation both of the T-states T0, T1 [...] and of the further T-states [...] is in each case effected as a function of preceding T-states and of state parameters such as the instantaneous values of state and/or mode signals and [...]". The board held that, even if the words "such as" were understood to mean "for example", with the result that the subsequent information was not to be interpreted in a restrictive sense, the words "state parameters" were clear in as much as they conveyed the fact that T-state generation was to be effected as a function of any parameters representing one of the states of the apparatus. Although the claim was to be regarded as broad, since the terms used were open to general interpretation, breadth was not to be equated with an absence of clarity.

In **T 630/93** the board noted that Art. 84, first sentence, EPC 1973 implied that it was not always necessary for a claim to identify technical features or steps in full detail. The function of the essential features, although normally expressed in technical terms, was often to define the borders of an invention rather than details of the invention within those borders. Thus, essential features could often be of a very general character and in extreme cases indicate only principles or a new idea (see also Chapter II.A, sufficiency of disclosure).

In **T 29/05** it was held that the existence of unrelated subject matter in the claims at issue was merely hypothetical, and no evidence had been provided by the examining division to support its possible presence in the prior art. In the absence of such evidence, each and every nucleic acid molecule (as specified) had to be assumed to be related to the subject matter disclosed in the application. The fact that a large number of possible nucleic acid sequences might fall within the scope of the claim was not a reason for raising a lack of clarity objection.

The principle whereby a broad claim is not unclear per se was applied in several decisions (see inter alia **T 456/91**, **T 393/91**, **T 530/94**, **T 950/97**, **T 149/98**).

1.1.6 Principles in connection with categories of claim

In the aforementioned decision **T 688/91** (see point 1.1.5 above) the board found that the fact that claims of different categories were deemed to be independent claims did not preclude reference to other independent claims. In the board's view, however, any such reference had to make perfectly clear whether or not the reference was intended to replace features. In the former case, it had for reasons of clarity to replace all the features, and in the latter case none.

In case **T 410/96** concerning a data processing system the question arose whether it was permissible for a claim to a system to refer back to a claim to a method. The board held that, although R. 29(4) EPC 1973 mentioned a reference only in the context of a claim including all the features of the claim it referred to, this did not imply a contrario that a reference which did not fulfil this condition was necessarily impermissible. The board found that there was no a priori objection under Art. 84 EPC 1973 to an independent claim which partially drew its features from preceding claims of a different

category. The essential features were thus incorporated in the disputed claim by reference, the claim thus complying with R. 29(3) EPC 1973 (R. 43(3) EPC).

In decisions **T 418/92** and **T 453/90** the boards confirmed that it was possible for claims to relate to both physical activities and physical entities, in particular where the inventions concerned were fully disclosed as **processes** to the skilled person only if apparatus features were also included in the definition. In **T 1046/05** too the board confirmed the clarity of an apparatus feature in a process claim.

In **T 426/89** (OJ 1992, 172) the board decided that a claim relating to a "method for operating" a device was not "clear" (Art. 84 EPC 1973) if the claimed features only described how the device worked.

In **T 841/95** the board found that where a claim for an apparatus sought to define the invention by reference to features of the use to which the apparatus was to be put, a lack of clarity could result. However, if the subject-matter of the application was an apparatus and it was not viable to define the apparatus other than by reference to the said use, an apparatus claim directed to a combination of apparatus and use and defining the apparatus unambiguously could be clear.

Including in a device claim "for carrying out a process" a reference back to an earlier claim did not alter the fact that it was an independent (non-process) claim; rather, it limited the claimed device to being suitable to carry out the process referred to (**T 1017/98**).

The disputed claim before the board in **T 952/99** contained two different aspects of a use claim: on the one hand it defined the use of a particular physical entity to achieve an 'effect', and on the other it defined its use to produce a product. Although a use claim normally falls into either one category or the other, the board found that such a clear distinction was not possible in this case. The claim contained both application and process features and there was a technical affinity between the additional process step and the 'core' of the invention. Both the application and process features were thus technical features of the invention, so that their combination did not contravene R. 29(1) EPC 1973, the relevant criterion for assessing the extent to which the combination of a 'use' claim and technical process features was allowable from the point of view of clarity.

The board drew a distinction with **T 796/91**, in which it had been held that the heterogeneous combination of process features and application features rendered the claim fundamentally unclear. That case had concerned the combination of a process claim and a use claim with no process claim at all. In contrast to the case before the board, the process features had apparently had no affinity to the application features, which had made it impossible to subsume the two different types of technical feature under one claim.

For the particularities of product-by-process claims, see section 6 below.

1.2. Exceptions to the principles

Exceptions to these principles have been permitted for practical reasons and under certain circumstances claims granted which contained features in the form of disclaimers and functional or unspecified features.

1.2.1 Disclaimers

In its decisions **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) the Enlarged Board of Appeal used the term "disclaimer" as meaning an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding specific embodiments or areas from a general feature.

A more detailed discussion of **G 1/03** and **G 2/03** and the subsequent jurisprudence on the admissibility of undisclosed disclaimers pursuant to Art. 123(2) EPC can be found in Chapter III.A.4. For disclaimer drafting see (b) below; for novelty and inventive step in connection with disclaimers see (c).

(a) Allowability of disclaimers

To summarise, an undisclosed disclaimer may be allowable in order to:

- restore novelty by delimiting a claim against the state of the art under Articles 54(3) and (4) EPC
- restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC
- disclaim subject-matter which, under Art. 52 to 57 EPC, is excluded from patentability for non-technical reasons.

The Enlarged Board emphasised that, in defining the situations in which a disclaimer might be allowed, care had been taken to make sure that the reason justifying a disclaimer was not related to the teaching of the invention.

It disagreed with the view that, starting from the premise that a disclaimer was always a mere waiver of part of the invention, it might be used for any purpose, i.e. also for excluding non-working embodiments. The Enlarged Board held that a claim comprising non-working embodiments might have different consequences, depending on the circumstances.

According to the Enlarged Board, where there was a large number of conceivable alternatives and the specification contained sufficient information on the relevant criteria for finding appropriate alternatives over the claimed range with reasonable effort, the inclusion of non-working embodiments was of no harm. Therefore, a disclaimer was neither necessary nor appropriate.

If this was not the case and there was a lack of reproducibility of the claimed invention, this might become relevant under the requirements of inventive step or sufficiency of disclosure. The determining date for fulfilling the latter requirement had to be the date of filing or priority, and deficiencies in this respect could not be remedied during the proceedings before the EPO (differing from **T 170/87** and **T 313/86**).

This decision of the Enlarged Board of Appeal overruled the more restrictive approach in **T 323/97**, which had laid down that any amendment to a claim which was not supported by the application as originally filed and which was intended to delimit the claimed subject-matter further vis-à-vis the state of the art was in breach of Art. 123(2) EPC 1973. In addition, the limits within which disclaimers were admissible was more precisely defined, making some of the earlier jurisprudence obsolete (see **T 313/86**, **T 623/91**, **T 1050/93**). According to these decisions, a disclaimer should also be admissible when a sub-range of the invention's subject-matter defined in terms of ranges was to be excluded not in the light of the prior art but because it did not solve the technical problem.

(b) Drafting of disclaimers

Regarding the drafting of disclaimers, the Enlarged Board of Appeal stated in **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) that the disclaimer should not remove more than was necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.

In any case, the requirements of conciseness and clarity of Art. 84 EPC 1973 were also applicable to claims containing disclaimers. This meant that a disclaimer was not allowable if the necessary limitation could be expressed in simpler terms in positive, originally disclosed features in accordance with R. 29(1), first sentence, EPC 1973 (R. 43(1) EPC). In addition, a plurality of disclaimers might lead to a claim drafting which put an unreasonable burden on the public to find out what was protected and what was not protected. A balance had to be struck between the interest of the applicant in obtaining adequate protection and the interest of the public in determining the scope of protection with reasonable effort.

In the interest of transparency of the patent, it should be clear from the specification that there was an undisclosed disclaimer and why it had been introduced. The excluded prior art should be indicated in the description in accordance with R. 27(1)(b) EPC 1973 (R. 42(1)(b) EPC) and the relation between the prior art and the disclaimer should be shown.

With regard to the drafting of disclaimers the Enlarged Board likewise takes its cue from existing jurisprudence, much of which is doubtless still applicable.

The board had already decided in **T 4/80** (OJ 1982, 149) that disclaimers were admissible if the subject-matter remaining in the claim could not technically be defined directly more clearly and concisely (see also **T 433/86** and **T 173/96**).

A disclaimer introduced in order to establish novelty should exclude only that subject-matter which is disclosed in the state of the art (**T 434/92**, **T 653/92** and **T 426/94**). Of the cases which followed **G 1/03** and **G 2/03**, see inter alia **T 285/00**, **T 426/00**, **T 747/00**, **T 10/01**.

In **T 11/89** the board held that claims containing a disclaimer should clearly have shown the technical features by which the claimed subject-matter was distinguished from the excluded subject-matter. The publication number of a patent specification was obviously not a technical feature and was therefore not appropriate for determining the scope of a disclaimer. The claim in question was of the type "X-derivatives of the general formula I [...] with the exception of the X-derivatives of the general formula I disclosed in patent specification N° [...]" (see, however, **T 623/91**, in which the exclusion of a composition by reference to a trade mark or a trade designation was allowed; with regard to reference to a trade mark, albeit with another outcome, see also **T 480/98**).

The following rulings on the clarity of claims including a disclaimer were handed down after the decisions in **G 1/03** and **G 2/03** (OJ 2004, 413 and 448):

In **T 161/02** the board pointed out that the disclaimer combined features which arose from two different documents of prior art, the combination of these features resulting in a disclaimer that corresponded to neither the disclosure of the first nor that of the second document, and which - as acknowledged by the appellant - did not make any technical sense. The board held that such a disclaimer rendered the claim unclear within the meaning of Art. 84 EPC 1973, as it did not allow the public to find out what was protected and what was not protected.

To justify the exclusion expressed by the formulation "non-therapeutic use" at the beginning of the disputed claim, the appellant in **T 67/02** had cited **G 1/03** and **G 2/03** (OJ 2004, 413 and 448), which had ruled that disclaimers were admissible for subject-matter not patentable under Art. 52 to 57 EPC 1973. However, the board found that in the present case it was not possible to identify a clear distinction between cosmetic use and therapeutic treatment. The board therefore took the view that the exclusion rendered the claimed subject-matter unclear.

In the claim at issue in **T 201/99** the appellants (patent proprietors) replaced the range of treatment times "1-10 minutes" by "1-6 minutes". They argued that the range of 1 to 6 minutes should be regarded as disclaiming a sub-range of more than 6 to 10, so as to remove the area of overlap between the claimed subject-matter and the prior art. The board, however, emphasised that Enlarged Board of Appeal decisions **G 1/03** and **G 2/03** (point 3 of the Reasons) explicitly ruled out the possibility of hiding a disclaimer by using an undisclosed positive feature defining the difference between the original claim and the anticipation, since this would affect the transparency of the patent (Art. 84 EPC 1973).

In **T 286/06** claim 1 at issue required that the claimed composition comprise specified amounts of a bonding inhibitor which was a quaternary ammonium compound, and contained a disclaimer reading: "provided that said bonding inhibitor is not a

biodegradable quaternary ammonium compound". The disclaimer had been introduced during opposition proceedings in order to restore novelty over the disclosure of document (1). The original documents of the application did not contain any citation relating to the possible interpretation of which quaternary ammonium compounds had to be considered "biodegradable".

The board held that it derives from the purpose of Art. 84 EPC 1973 to ensure legal certainty, that the wording of a claim cannot be interpreted by taking into consideration the teaching of further publications not referred to explicitly in the original documents of the application as being relevant for the interpretation of terms used in the description or in the claims. This applied also in the case of a disclaimer, as the only justification for its introduction in a claim was to exclude a novelty-destroying disclosure and it did not represent an opportunity for the applicant or patent proprietor to reshape its claims arbitrarily (see **G 1/03**, OJ 2004, 413). The board evaluated the clarity of claim 1, considering what the skilled person would have understood in reading the claim only, taking into consideration common general knowledge. The board concluded that the wording of claim 1 was unclear.

(c) Novelty and inventive step

In **T 188/83** (OJ 1984, 555) the board made it clear that the range was not rendered novel by the fact that the values calculated from the examples described in a citation were excepted by means of a disclaimer if these values could not be regarded as individual.

In **T 170/87** (OJ 1989, 441) the board established that a disclaimer could render new an inventive teaching which overlapped the state of the art, but could not impart inventive step to a teaching which was obvious (see also **T 857/91** and **T 710/92**). In **T 597/92** (OJ 1996, 135) the board confirmed this, stating that there was no basis in the EPC 1973 for the substantiation of inventive step by way of a disclaimer (see also **T 653/92**).

The Enlarged Board of Appeal, too, was at pains to point out in **G 1/03** and **G 2/03** that an undisclosed disclaimer which is or becomes relevant to the assessment of inventive step or sufficient disclosure constitutes an extension which is inadmissible under Art. 123(2) EPC 1973 (see also **T 968/00** and **T 703/02**).

It was only in the case of an "undisclosed" disclaimer that the assessment of inventive step must be carried out without taking account of the said disclaimer (**T 1028/02**).

In **T 134/00** the claim at issue related to a fuel oil composition consisting of a middle distillate fuel oil and an additive composition. It required the additive composition to comprise at least the components of given types (i) and (ii), but it could also comprise other additive components. The claim also contained a disclaimer excluding a specific combination only as component (i) and not from the total fuel composition. The board therefore concluded that the disclaimer did not exclude the presence of the two specified components in the total fuel composition.

1.2.2 Functional features

In **T 68/85** (OJ 1987, 228) the board found that functional features defining a technical result were permissible in a claim (i) if, from an objective viewpoint, such features could not otherwise be defined more precisely without restricting the scope of the invention, and (ii) if these features provided instructions which were sufficiently clear for the expert to reduce them to practice without undue burden, if necessary with reasonable experiments. The board further pointed out that the effort to define a feature in functional terms had to stop short where it jeopardised the clarity of a claim as required by Art. 84 EPC 1973. The following decisions agreed with these findings: **T 139/85**, **T 292/85** (OJ 1989, 275), **T 293/85**, **T 299/86** (OJ 1988, 88), **T 322/87**, **T 418/89** (OJ 1993, 20), **T 707/89**, **T 204/90**, **T 752/90**, **T 388/91**, **T 391/91**, **T 810/91**, **T 822/91**, **T 894/91**, **T 281/92**, **T 490/94**, **T 181/96**, **T 750/96**, **T 265/97**, **T 568/97**, **T 484/98**, **T 1186/01**, **T 295/02**, **T 499/02**, **T 1173/03**, **T 404/06**. Some of these decisions (see e.g. **T 204/90**, **T 181/96**, **T 265/97**) examine a third criterion, which is not strictly speaking a requirement under Art. 84 EPC 1973 and requires that (iii) the state of the art does not stand in the way of using such functional and therefore general and broad terminology.

T 332/87 offered an interpretation of the then applicable version of Guidelines C-III, 4.8, where it was said that a claim directed to a product for a particular use has to be construed as defining a product suitable for this use. According to the board this meant only that it might be admissible in appropriate cases to introduce functional language into a claim for defining a product. However, a product defined inter alia by means of a functional feature could only be considered as novel if this functional feature differentiated the product in substance from known products.

In **T 361/88** the board distinguished between two types of functional feature: the first type of functional feature is related to process steps which are known to the man skilled in the art and may easily be performed in order to obtain the desired result; the second type of functional feature consists of process steps defined by the result which is aimed at. This is also allowable as long as the man skilled in the art knows, without exceeding his normal skills and knowledge, what he has to do in order to obtain said result. Another situation arises if said result is obtained for the first time, in which case the man skilled in the art does not know how to achieve the result.

In **T 243/91** it was stated that a functional feature was allowable if that feature provided a clear instruction to a skilled person to reduce it to practice without undue burden. In **T 893/90** the feature "being present in amounts and proportions just sufficient to arrest bleeding" was held to be a functional feature which defined a technical result which also constituted a testable criterion to be satisfied by the claimed pharmaceutical composition. Because such testing involved only routine trials, the adopted functional language was allowable. The introduction of a reference to specific amounts and/or proportions of the components would limit the claim and was not necessary. The situation in **T 893/90** was distinguished from the one before the board in **T 181/96**. Although in the former case the testing might appear prima facie bothersome, it was nothing out of the ordinary for the field of medicine, involving only routine trials. In the case in suit, however, which concerned an apparatus for hydrostatically testing a sealing

element of a threaded connection between two connected sections of pipe, there was no general type of pipe connections with generally well-defined ranges of dimensions which were thus generally available for verification of the functional features as such.

In **T 446/90** a mixing step was defined in a claim by the result to be achieved, namely obtaining a dense packing of particles B, the definition of the latter being a theoretical, idealised scientific model, such models being well known. The reference to this theoretical model could be understood by the skilled person on the basis of the further information given in the patent in suit, and at least one indirect method suitable for testing the density of the packing had been disclosed in the description. Under these circumstances the definition of the mixing conditions by the result to be achieved was held by the board to be clear. The board noted that the incorporation into the claim of the mixing conditions described in the examples would unduly limit the scope of protection and was therefore not appropriate.

In case **T 720/92** the application was refused inter alia because claim 1 was held not to be clear since it used the obscure terms "metal promoted oxidation" and "oxidizable organic polymer"; the indication of a maximum oxygen permeance was considered a definition by the result to be achieved which could not represent a technical feature. The board disagreed, holding that the term "clarity" in Art. 84 EPC 1973 referred to the practical meaning of the language of the patent claims. A claim combining functional definitions limited to features, which a skilled person would have had no difficulty in determining on the basis of common general knowledge, and a structural definition of the essential contribution to the art was not contrary to Art. 84 EPC 1973.

In **T 391/91** claim 1 set out in general terms the sequence of steps to be followed in order to put the invention into practice, i.e. in order to produce unicellular micro-organism host cells having INA (ice nucleation activity) or enhanced INA. The claim was in fact a generalisation from the particular examples. The department of first instance considered the definition in general functional terms of the DNA fragment encoding an expression product responsible for the INA+ phenotype inadmissible. The board stated that as there was no reason to doubt that it was possible to generalise the specific teaching of the examples given, it would be unfair to the appellant to require a restriction of the claim by incorporation therein of the specific features of the examples. The skilled person could use any suitable variant capable of providing the same effect of the invention. This might be tedious, but it was nothing out of the ordinary in this field and involved only routine trials.

In **T 241/95** (OJ 2001, 103) the Swiss-type second medical use claim defined the disease or disorder to be treated with substance X as "condition which is capable of being improved or prevented by selective occupation of the serotonin receptor". The board held that this functional definition was unclear because no test was at hand to determine whether the therapeutic effects were a result of the newly discovered property of X of occupying the serotonin receptor or any other known or unknown property of that substance.

In **T 1074/00** the board considered that the term "capable of hybridising under stringent conditions" was sufficiently clear for the purposes of Art. 84 EPC 1973, having regard to the particular nature of the subject-matter (see also **T 29/05**). The board found that, although different experimental protocols might be applied for assessing hybridization under stringent conditions, this did not mean that these protocols would lead to different results as far as the detected nucleotide sequence was concerned. Moreover, it had to be taken into account that the present claim defined its subject-matter also by a further functional feature relating to the biological activity.

In **T 151/01** the product claim at issue was intended to be restricted vis-à-vis the prior art embodiments by a functional feature, namely that the amount of the ingredient present in the composition must be a "therapeutic amount". The board had no doubt that the skilled person was perfectly able in most cases to decide whether a certain amount of a given non-steroidal anti-inflammatory agent had a therapeutic effect or not. However, it pointed out that, in order to establish the lower limit of the therapeutic amount for a given non-steroidal anti-inflammatory agent, in other words, in order to clearly establish the scope of protection of the claims, a standard test was required, since the result would strongly depend on the experimental method used. As there was no such test in the description or known to the skilled person, the board concluded that the claim did not fulfil the requirement of Art. 84 EPC 1973.

1.2.3 Unspecified features and relative qualities

Unspecified features are permitted as follows:

- (a) To avoid an undue limitation of the scope of the claim where the person skilled in the art can verify the result by tests involving nothing more than trial and error (**T 88/87**).
- (b) To render the meaning of the feature intelligible from the actual claim.

Thus, the objection in **T 487/89** was based on the fact that the claim had indicated both tenacity and toughness with a lower but no upper limit. The opposition division took the view that such "open-ended" parameters were always objectionable if they related to an inherently desirable characteristic. The board, however, held that whether the absence of an upper or lower limit was acceptable in a claim in any individual case depended on all the surrounding circumstances. Where, as in the case in question, the claim sought to embrace values as high as could be attained above a specified minimum level, given the other parameters of the claim, then such open-ended parameters could not normally be objected to. This decision was confirmed by **T 129/88** (OJ 1993, 598), **T 87/84**, **T 92/84**, **T 136/84**, **T 297/90** and **T 1018/05**, although in the last two cases a role was played by the question of sufficient disclosure (see also **T 989/95**, in which **T 487/89** was agreed with but not applied). In **T 586/97**, on the other hand, the board found that the absence from any independent claim of any upper limit on the amount of a particular detrimental but necessary component in the chemical composition claimed was at variance with the aim of the invention as set out in the description, namely, to decrease the percentage of the undesirable ingredient in the claimed composition. The claim was thus so broad it

went beyond the scope of the invention as disclosed in the description. Therefore the requirement of Art. 84, second sentence, EPC 1973 was not met (see section 4 below).

In **T 227/91** (OJ 1994, 491) the claims comprised a coating thickness defined by a formula with two parameters (a) and (t). Parameter (a) represented the thermal diffusivity of the coating means and was therefore a feature inherent in the instrument. Parameter (t) represented the effective pulse time of the laser and was related to the laser operating conditions, not to the structure of either the laser or the instrument. The thickness defined in the claims was still connected with the mode of operation of the laser, that is, with a human factor irrelevant to the instrument per se. The extent of the protection conferred by the subject-matter of the claims was therefore regarded by the board as ambiguous and indefinite.

In **T 455/92** independent claim 2 was worded as follows: "Covering [...] for a pressing [...], characterised by:

(a) a length which corresponds at least to the circumference of the shell face of the pressing to be covered,

(b) an overall breadth sufficient to cover the shell face and both end faces of the pressing, and

(c) a fold such that [...] the breadth [...] corresponds to the breadth of the shell face of the pressing [...]."

The board did not see this as a breach of Art. 84 EPC 1973, since reference had been made to a physical entity which was known; hence the range of sizes was definable in so far as it excluded packaging materials for other physical entities. Furthermore, it was self-evident to a skilled person in this field that the size of the packaging material (the covering) was dependent on the physical entity to be packed (for the interpretation of claims see 5 below).

In **T 860/93** the board decided as follows: Where a quality is expressed in a claim as being within a given numerical range, the method for measuring that quality must either be general technical knowledge, so that no explicit description is needed, or a method of measuring that quality needs to be identified (decision **T 124/85** followed). In contrast, where a claim specifies a relative quality, in this case that the products should be "water-soluble", it is not normally necessary to identify any method for its determination (see also **T 785/92**). In **T 860/95**, **T 649/97**, **T 939/98**, **T 1041/98**, **T 193/01**, **T 545/01** and **T 378/02** the boards confirmed that the use of a relative term in a claim may be accepted where the skilled person is able to understand the meaning of this term in a given context. However, in **T 728/98** and **T 174/02** the boards ruled that the relative terms at issue were unclear.

In **T 378/02**, claim 1 contained the terms "a smooth impermeable surface". The appellants argued that the definition of the surface was ambiguous, because "smooth" was a relative term. The board recalled that, while relative terms constituted a potentially

unclear element due to their characteristic to change their meaning according to the context, they nevertheless could be considered as clear and their use in a patent therefore allowed, if their meaning was clear in the context of the whole disclosure (see e.g. **T 860/93**, OJ 1995, 47, for "water-soluble", **T 860/95** for "a long period of time", **T 649/97** for "transparent", **T 1041/98** for "thin plate", **T 193/01** for "thin film composite"). In contrast, in decision **T 728/98** the term "substantially pure" was considered unclear per se and in the light of the description. The board considered that, in the context of the disclosure of the patent in suit as a whole, the term "smooth" represented a clear definition.

2. Conciseness

2.1. General

In **T 79/91** the board stated that lack of clarity of the claims as a whole could arise from lack of conciseness. The invention in this case had been set out in at least ten independent claims of different scope. The board was of the opinion that this presentation made it difficult, if not impossible, to determine the matter for which protection was sought, and placed an undue burden on others seeking to establish the extent of the monopoly. Citing this case, the board found in **T 596/97** that, prima facie, a total of seven independent claims could be undesirable for reasons of conciseness and clarity. However, on the facts of the specific case before it, the board found the independent claims to be acceptable.

In **T 246/91** the application comprised 191 claims, reduced in appeal proceedings to 157. The board ruled that the number of claims had to be reasonable, bearing in mind the nature of the invention claimed. Although no hard and fast definition could be accorded to the term reasonable, this did not mean that the requirement was wholly devoid of meaning and legal effect. In deciding the matter, regard had to be had to the interest of the relevant public, since patents ought not to be allowed to erect a legal maze or smoke screen in front of potential users of the inventions to which they laid claim. Patent claims taken singly as well as in totality had to be clear and concise in order to enable such potential users to ascertain, without undue burden, let alone recourse to litigation, whether their planned commercial use was likely to infringe the patent. Having to construe the remaining 157 claims and form a valid and commercially useful opinion on whether or not any one of them could prevent or hinder the commercial activities imposed, necessarily, a severe and totally undue burden on the public. It followed that the application in question contravened the clear provisions not only of R. 29 EPC 1973 (R. 43 EPC) but also of Art. 84 EPC 1973.

However, where a single main claim having to present a multiplicity of alternatives corresponding to the plurality of processes claimed would have lacked clarity, multiple claims could be concise within the meaning of Art. 84 EPC 1973 (**T 350/93**).

Overlapping method and use claims were allowed by the board in **T 433/99**, as the emphasis and thus scope of the claims was slightly different. Moreover, such a method allowed for differences in claim interpretation in the different contracting states of the

EPC, particularly during infringement and revocation proceedings in national courts, where opportunities for amendment were limited.

A Markush formula is the concisest means of defining a class of chemical compounds in a claim (**T 1020/98**). The examining division had held that "formulating claims in a style that makes routine tasks in substantive examination unnecessarily difficult" was a contravention of Art. 84 EPC 1973. However, there is no legal basis in the Convention for a request to restrict the content of an independent claim so that substantive examination can be carried out with greater ease and less effort.

Regarding lack of conciseness because of a superfluous claim, see e.g. **T 988/02**.

2.2. Rule 43(2) EPC

2.2.1 Conditions

As already mentioned, apart from a minor editorial amendment R. 29(2) EPC 1973 has been left unchanged, becoming the new R. 43(2) EPC.

In case **T 56/01** each of the appellant's requests in the appeal stage contained three independent claims of the same category: one claim to a broadband communications module and two claims to a signal transport system. Hence, the board had to discuss compliance with the amended R. 29(2) EPC 1973. The board concluded from the preparatory documents that condition (a), in spite of the distinction made between products and apparatus in the opening part of the Rule, also applied to apparatus claims. Nevertheless, the board did not consider that condition (a) was met by the two claims for the signal transport system because they were not interrelated. The board inferred from the examples in an early proposal to the Administrative Council for the amendment of R. 29(2) EPC 1973 that interrelated products were meant to be different objects that complement each other, or somehow work together. However, in the present case, the two different claims to the signal transport system were for essentially the same object. Moreover, the board defined the "alternative solutions" under R. 29(2)(c) EPC 1973 as different or even mutually exclusive possibilities. The claims at issue, however, related to one and the same solution with slightly different wording and level of detail. Moreover, even alternative solutions were only allowed under the condition that "it is not appropriate to cover these alternatives by a single claim". The board concluded from the preparatory documents that "not appropriate" meant "not possible or not practical". The intention was that, if it was possible to cover alternative solutions by a single claim, then the applicant should do so. In the case at issue, given the overlap and similarities in the features of the claims, the board held that it would have been entirely appropriate to cover the subject-matter of the signal transport system by a single independent claim with dependent claims as necessary.

In **T 659/03** the board had to decide whether the two contentious independent claims in the same category were covered by the exception in R. 29(2)(c) EPC 1973. The board held, first of all, that the appellant's wish to protect the two alternative processes by two independent process claims was justified. It then confirmed that there were alternative

solutions to a particular problem, since the independent claims each contained all the features required to solve the problem addressed. In **T 525/03**, the board found that there were alternative solutions and held that it would not appear appropriate to cover those alternative solutions in a single independent claim. Rather, attempting to redefine the subject-matter of these claims in a more generalising way in one independent claim might lead to an objection under Art. 123(2) EPC 1973. Such generalisation could furthermore be problematic for Art. 87 EPC 1973. In **T 895/05** too the board found that the requirements of R. 29(2)(c) EPC 1973 were satisfied.

In **T 671/06** the board found that a claim to a system comprising a power source specified in broad functional terms and a claim to a power source for the system specified in structural terms did not fall under the exception envisaged in R. 29(2)(a) EPC 1973. It could be deduced from the examples provided in the Guidelines that inter-related products were, on the one hand, products which, although existing independently from each other as stand alone products, only performed the distributed invention when interacting with each other (e.g. plug and socket, transmitter - receiver), and, on the other hand, chemical products which were derived from their predecessors (i.e. intermediate(s) and final chemical product, gene - gene construct - host - protein - medicament). In contrast, the system as claimed in claim 8 on the one hand and the power sources of claims 13 and 15 on the other hand (i.e. substitutes for part of this system) did not interact with each other, since the claimed system was completely self-contained in performing the invention. The clause "for a system according to claim 8" used in claims 13 and 15 meant "suitable for substitution in" rather than "suitable for interaction with". The board concluded that the term "inter-related products" in R. 29(2) EPC 1973 did not extend to a system which is self contained in performing the invention (the system of claim 8) and a product which is a constitutive substituent part for the system (the power sources of claims 13 and 15).

The board did not follow **T 133/02**, which had held that a system claim and a means claim relating to a component of the system were directed to inter-related products, similar to a plug and a connection system combining the plug with an adapted socket. The board in **T 671/06** argued that a claim directed to a connection system comprising the plug would be dependent on the claim to the plug, as it necessarily comprised all the features of the plug (R. 29(4) EPC 1973). However, R. 29(2) EPC 1973 was not intended to permit or prohibit claims which were permitted under R. 29(4) EPC 1973. The domain of application of these sub-rules should be kept separate.

Likewise in **T 1232/07** the same board, discussing the exceptions laid down in R. 29(2) EPC 1973, highlighted that exception (a) referred only to interrelated products and not to some kind of interrelationship between the subject-matter of independent claims. Such products were, on the one hand, objects which although existing independently of each other as stand alone products only performed the distributed invention when interacting with each other (e.g. lock and key) and, on the other hand, chemical compounds derived from their precursors. Moreover, the board found that the contested claims were not permissible under exception (b), as point (b) referred to different uses of a product or apparatus and not to different uses of a concept as was argued by the appellant applicant.

2.2.2 Burden of proof

In **T 56/01** the board emphasised that, when an objection under R. 29(2) EPC 1973 (Rule 43(2) EPC) arose, the burden of proof was shifted onto the applicant, i.e. it was up to the applicant to argue convincingly why additional independent claims could be maintained.

2.2.3 Applicability in opposition proceedings

In **T 263/05** (OJ 2008, 329) the board had to consider the question of whether R. 29(2) EPC 1973 applied in opposition proceedings by virtue of the reference in R. 61a EPC 1973, as had been held by the opposition division.

To answer this question, the board reviewed decision **G 1/91** (OJ 1992, 253), which had considered the effect of R. 61a EPC 1973 in the context of the requirement of unity. The Enlarged Board of Appeal had taken the view that the reference to Chapter II was only a general one and that R. 61a EPC 1973 could only be taken to refer "to those requirements which would still be reasonable to demand of the new documents relating to the amended patent". The purpose of opposition proceedings was to enable a party to oppose unjustified protective rights. The board concluded that R. 29(2) EPC 1973 did not apply in opposition proceedings to prohibit an amendment to a granted patent if it would be unreasonable to demand of the amended claims that they comply with this rule.

R. 29(2) EPC 1973 was concerned only with a perceived procedural and practical need to limit the number of independent claims, designed to help ensure that applications which contravened Art. 82 and 84 EPC 1973 could be refused with procedural economy. The rule in its amended form could not apply across the board to all amendments in opposition proceedings. Otherwise it would not be permissible to make an amendment by which non-unitary claims were introduced, something which could clearly be appropriate in opposition proceedings, given that the proprietor was no longer able to file a divisional application (**G 1/91**). Moreover, it would be unreasonable to demand of the amended claims that they comply with R. 29(2) EPC 1973 in cases where otherwise this rule would force the proprietor to abandon potentially valid subject matter already contained in the granted claims. The case at issue was an example of such circumstances.

The board concluded that it could not envisage any circumstances in which R. 29(2) EPC 1973 would be of any application in opposition proceedings. Once an amendment to the claims had been established to be necessary and appropriate having regard to the grounds of opposition, it would be unreasonable to impose the additional requirement that the amendment complied with the purely administrative provisions of R. 29(2) EPC 1973.

3. Form of the claims

R. 43(1) EPC (like R. 29(1) EPC 1973) provides that claims must contain, wherever appropriate, a statement indicating the designation of the subject-matter of the invention

and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art ("preamble"), and a characterising portion stating the technical features which, in combination with the features stated in the first part, it is desired to protect.

3.1. One-part or two-part claim

In decision **T 13/84** (OJ 1986, 253), the board ruled that a claim in two-part form had to be regarded as appropriate if a clearly defined state of the art existed from which the claimed subject-matter distinguished itself by further technical features (likewise **T 181/95**). This decision was confirmed by **T 162/82** (OJ 1987, 533), where the board added that the extent to which prior art was cited in the description could not be a determining factor in deciding whether the one-part or the two-part form of a claim was appropriate in a given case.

In **T 170/84** (OJ 1986, 400) it was pointed out that where a two-part claim would lead to a complex formulation it was no longer appropriate. In a one-part claim, the features required for the definition which belonged to the state of the art had to be sufficiently clear from the description. This principle has been upheld inter alia in **T 269/84**, **T 120/86**, **T 137/86** and **T 278/86**. The latter two decisions stipulated that a two-part claim was not justified if it gave an incorrect picture of the state of the art (likewise **T 181/95**). In **T 735/89** the board did not accept a one-part claim because it gave the impression that there was no closer state of the art.

In **T 99/85** (OJ 1987, 413) the board held that in opposition proceedings there was no reason officially to insist on a change in the wording of the claim simply because one feature in the preamble to a two-part claim did not belong to the state of the art. Furthermore, the board saw R. 29(1) EPC 1973 as an implementing regulation which did not constitute a ground for opposition (a similar view was held in **T 168/85**, **T 4/87**, **T 429/88** and **T 65/89**).

In **T 350/93** the patent application disclosed processes for the production of electro-active material and composite materials containing such material. It included main claims 1 to 4 and 6 to 8 in one-part form. The board observed that the one-part form was justified because details in certain process steps distinguished the claimed processes from those known from the prior art and the resulting distinctive features were difficult to pick out in a simple and unambiguous form.

In **T 121/06** a new document, annexed to the communication under R. 51(4) EPC 1973, was introduced as the closest prior art. As a consequence, the examining division drafted the independent claims in two-part form based on the new document. On appeal, the board found that the combination of features in claim 1 was not known from the new document. It went on to state that it would be detrimental to the logic of the claim to seek to split up its features (i) to (iii) into their basic building blocks merely to indicate which blocks happen to be known from the new document, without having regard to their inter-relationships. Thus, the two-part form of claim was found to be inappropriate (R. 29(1) EPC 1973).

For further instances in which a claim in two-part form was not regarded as appropriate, see inter alia **T 345/89**, **T 378/92**, **T 723/93** and **T 181/95**.

3.2. Particular issues in connection with two-part claims

Which features are known and hence to be included in the preamble has to be decided in the light of the objective facts (**T 6/81**, OJ 1982, 183).

In **T 13/84** (OJ 1986, 253) the board considered it could not be accepted as a general rule that the piece of prior art used for the preamble of the claim should be concerned with the same problem as the invention (likewise **T 287/02**). Generally, the apparatus or process constituting the prior art which was nearest to the invention would have to figure in the preamble of the claim, stating such features of it as were necessary for the definition of the claimed subject-matter and which were in combination already part of this prior art (see also **T 897/90**). R. 29 EPC 1973 (like R. 43 EPC) made no reference to the necessity or desirability that the characterising portion of the claim should fairly set out the inventive step. It was the subject-matter of the claim as a whole which embodied the invention and the inventive step involved (see **T 886/91** and **T 157/93**).

Likewise, in **T 850/90**, it was confirmed that examination for inventive step should also take account of the features in the preamble, since the invention was defined by the claims as a whole. Likewise, in **T 980/95** it was held that there was no explicit requirement in R. 29(1)(a) EPC 1973 that a claim in two-part form be set up on the basis of the "closest" prior art, since the rule made no reference to the necessity or desirability for the characterising portion of the claim to set out the inventive step. Thus the mere fact that a particular state of the art turned out, in later proceedings, not to be the "closest" state of the art for the assessment of inventive step did not in itself result in a two-part form based on that art contravening R. 29(1)(a) EPC 1973.

In decision **T 688/91** (discussed above under 1.1.4, indication of all essential features) the board took the view that there was a breach of R. 29 and Art. 84 EPC 1973 where an incorrect distinction was made between the preamble and the characterising portion (likewise **T 181/95**).

4. Claims supported by the description

4.1. General principles

Art. 84 EPC stipulates that the claims must be supported by the description. This requirement means that the subject-matter of the claim must be taken from the description and it is not admissible to claim something which is not described.

In decision **T 133/85** (OJ 1988, 441) the board took the view that a claim which did not include a feature described in the application (on the proper interpretation of the description) as an essential feature of the invention, and which was therefore inconsistent with the description, was not supported by the description for the purpose of Art. 84 EPC 1973. The boards apply this principle as part of their established

jurisprudence, see e.g. **T 409/91** (OJ 1994, 653), **T 939/92** (see right below), **T 322/93**, **T 556/93**, **T 583/93**, **T 659/93**, **T 482/95**, **T 616/95**, **T 687/98**, **T 1076/00** and **T 637/03**. However, the requirement for all essential features to be indicated is inferred to some extent from different provisions of Art. 84 EPC (see also above 1.1.3).

Many boards further stress that the requirement for the claims to be supported by the description was intended to ensure that the extent of protection as defined by the patent claims corresponds to the technical contribution of the disclosed invention to the art (see also **T 409/91**, OJ 1994, 653; **T 435/91**, OJ 1995, 188; **T 1055/92**, OJ 1995, 214; **T 659/93**; **T 825/94**; **T 586/97**; **T 94/05**, **T 1217/05**). Therefore the claims must reflect the actual contribution to the art in such a way that the skilled person is able to perform the invention in the entire range claimed (**T 659/93**, **T 94/05**). In the board's view, a purely formal support by the description, i.e. a verbatim repetition of the mention of a claimed feature, could not meet these requirements (**T 94/05**; see also **T 127/02** et **T 1048/05**). However, according to a different view, a review of the discussions in the various drafts to be found in the preparatory material suggests that the requirement for support of the claims was viewed rather as a formal matter to ensure that the description and claims had the same extent (**T 1020/03**, OJ 2007, 204). In the case in point the board concluded that Art. 84 EPC 1973 could not be used to force an applicant to cut down the scope of first or second medical use claims considered too broad compared to any use disclosed in the description. Other decisions in turn consider both aspects (see e.g. **T 297/05**).

According to the board in **T 317/99**, the fact that one part of a claim was not in agreement with the examples adduced in the description was not always enough to justify an objection under Art. 84 EPC 1973. If the claim was comprehensible and logical, it sufficed that there was support for all the elements of the claim in the description. (On the extent to which the technical information and examples adduced in the description may be generalised while still satisfying the requirements of Art. 84 EPC, see 4.3 below.)

4.2. Requirement for all essential features to be indicated in the claim

In **T 156/91**, too, the alleged absence of essential features in the claim was not viewed as a question of reproducibility of the invention within the meaning of Articles 83 and 100(b) EPC 1973, for which the disclosure as a whole is always the criterion; instead, what was involved was an objection under Art. 84 EPC 1973.

In decision **T 435/89** an allegedly essential process feature was missing from the apparatus claim. The board held that a claim for an apparatus per se need not contain information about the most efficient way of operating it, i.e. process features. The apparatus and the process for its use were to be kept strictly separate.

In **T 888/90** (OJ 1994, 162), the appellants had removed from their claim 1 a feature deemed to be necessary to the solution of the technical problem. The board stressed that the omission of a feature in a combination could mean that a claim related merely to a sub-combination of an invention. Such a sub-combination with no function other than that of an intermediary building block for providing an inventive full combination might also be patentable in principle, if expressly presented as such in the application as filed

and if it otherwise satisfied all conditions for patentability. Such sub-combinations were analogous to intermediate compounds in a chemical synthesis. However, in the board's view, it could not be assumed that assemblies from the outset directly and unequivocally implied their own sub-combinations. Thus, without express disclosure in this respect, including the particular use, the support for such claims would be inadequate.

In **T 1055/92** the board stated that since the primary function of a claim was to set out the scope of protection sought for an invention this implied that it was not always necessary for a claim to identify technical features or steps in detail. This primary function of the claims should be clearly distinguished from the requirement that the European patent application had to disclose the invention in such a way that it enabled a person skilled in the art to carry out that same invention. The board considered that it was sufficient if the application as a whole described the necessary characteristics of an invention in a degree of detail such that a person skilled in the art could perform the invention. This requirement, however, related to Art. 83 EPC 1973 and was not relevant to Art. 84 EPC 1973. Under Art. 83 EPC 1973 sufficient disclosure was required of a European patent application but not of an individual claim as such. A claim had to comprise the essential features of the invention; the essential features should in particular comprise those features which distinguished the invention from the closest prior art (see also **T 61/94**).

In **T 586/97**, the board found that the absence from any independent claim of any upper limit on the amount of a particular detrimental but necessary component in the chemical composition claimed was at variance with the aim of the invention as set out in the description, namely, to decrease the percentage of the undesirable ingredient in the claimed composition. The claim was thus so broad it went beyond the scope of the invention as disclosed in the description.

4.3. Restrictions on generalising the technical information and examples adduced in the description

The question of the extent to which the technical information and examples adduced in the description may be generalised in the formulation of the claims is usually examined in the context of the requirements of Art. 83 EPC (see in particular Chapter II.A.3, clarity and completeness of disclosure). Sometimes though it is also considered in the context of the requirement for support by the description. On the relationship between Art. 83 and Art. 84 EPC, see also Chapter II.A.6.

In **T 484/92**, the board concluded that, in contrast to **T 409/91**, the requirement of support by the description had been met and the appellant was entitled to claim the alleged invention in broad functional terms, i.e. in terms of the desired end effect, because, having disclosed one mechanism for achieving that goal, there were alternative ways of performing the invention at the disposal of the person skilled in the art, which would become apparent to him upon reading the description, based on his common general knowledge.

In **T 659/93** the board held that the requirement that the claims should be supported by the description meant that they had not only to contain all the features presented as essential in the description, but had also to reflect the applicants' effective contribution by enabling the skilled person to carry out their teaching throughout the field to which they applied (similarly **T 332/94** with reference to **T 409/91**, OJ 1994, 653).

In **T 939/92** (OJ 1996, 309) the examining division had raised the objection that the disputed claim was an unreasonable generalisation of the examples contained in the description. However, the board held that it did not follow from Art. 84 EPC 1973 that a claim was objectionable just because it was "unreasonably broad". The expression "supported by the description" meant that the technical features stated in the description as being essential features of the invention described must be the same as those used to define the invention in the claims, for otherwise the claims would not be true definitions but mere descriptions. If a claim concerned a group of chemical compounds per se, an objection of lack of support by the description could not properly be raised for the sole reason that the description did not contain sufficient information in order to make it credible that an alleged technical effect (which was not, however, a part of the definition of the claimed compounds) was obtained by all the compounds claimed. The facts of the case in question differed from those underlying **T 409/91**.

In **T 568/97** the claims of the patent in suit defined the physiological effect to be achieved by a sufficiently high concentration of vasoactive intestinal polypeptide and/or prostaglandins as active agents in a pharmaceutical composition for transurethral administration. Neither individual values nor ranges of the amounts of vasoactive intestinal polypeptide and/or prostaglandins were disclosed in the patent. Furthermore, it was impossible to find out without undue burden the physiologically effective amounts as claimed merely on the basis of common general knowledge. The board held that the description of the patent lacked support within the meaning of Art. 84 EPC 1973 as to the amount of vasoactive intestinal polypeptide and/or prostaglandins required to achieve a physiologically effective dose. The functional feature not only had to be such that the skilled person could understand it; he also had to be able to implement it.

In **T 627/04** the board allowed a broad claim because it corresponded to the actual contribution made by the contested patent's disclosure to the state of the art.

In **T 94/05** the board pointed out that the requirement for the claims to be supported by the description was intended to ensure that the extent of protection as defined by the patent claims corresponds to the technical contribution of the disclosed invention to the art (see also **T 409/91** and **T 435/91**). Therefore the claims must reflect the actual contribution to the art in such a way that the skilled person is able to perform the invention in the entire range claimed (**T 659/93**). In the board's view, a purely formal support by the description, i.e. a verbatim repetition of the mention of a claimed feature, could not meet these requirements. To be allowable, functional features must disclose a clear teaching which the skilled person can carry out without undue burden (see **T 68/85**, OJ 1987, 228). From this, it followed that the skilled person, at least after reading the patent specification, taking account of his common general knowledge, and possibly also after carrying out normal experiments, must actually be provided with at least a plurality

of different embodiment variants. The reproducibility from the patent specification of the above-mentioned functionally defined feature was confined to the sole embodiment described. The board concluded that the functional definition in claim 1 did not adequately reflect the technical contribution described in the patent specification.

4.4. Bringing the description into line with amended claims

In **T 977/94** the board decided that if the patentee amended his claims he had also to bring the description into line with them, because of its fundamental importance. An invention was only claimable to the extent that it was supported by the description (Art. 84, second sentence, EPC 1973), and the claims were interpreted in the light of the description (Art. 69 EPC 1973). So it was necessary to check that the essential elements of the invention claimed were also described as such in the description (see **T 300/04**).

In **T 295/02** the board found that an inconsistency between a claim and the provisional description was not a valid reason to refuse the application if the inconsistency arose from an amendment, if it was apparent that the text of the description was not intended by the applicant to form the agreed basis of any decision, especially one concerning its consistency with the amended claims, and if the appellant was prepared to adapt the description to conform to a definite allowable set of claims.

In **T 1808/06** the board recalled that, in order to meet the requirement of Art. 84 EPC that the claims have to be supported by the description, any disclosure in the description and/or drawings inconsistent with the amended subject-matter should normally be excised. Reference to embodiments no longer covered by amended claims must be deleted, unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended subject-matter. In such a case, the fact that an embodiment is not covered by the claims must be prominently stated.

The board considered that the placing of reliance on Art. 69(1) EPC, as was done in the decision under appeal, was not an appropriate justification for a less stringent adaptation of the description. Reference to Art. 69(1) EPC was misleading in so far as it could be understood to suggest a direct applicability of its contents at the examination or opposition stage. This was clearly not the case as Art. 69(1) EPC related to the scope of protection. It was only in situations where the removal of inconsistencies was not possible for procedural reasons (e.g. no amendment possible of the granted version) that - purely as an auxiliary construction - Art. 69(1) EPC could be invoked for an interpretation of the claimed subject-matter.

5. Interpretation of claims

5.1. General principles

The skilled person, when considering a claim, should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity, i.e. building up rather than tearing down, to arrive at an interpretation of the claim which is **technically sensible** and takes into account the whole disclosure of the patent. The

patent must be construed **by a mind willing to understand**, not a mind desirous of misunderstanding (**T 190/99**; confirmed inter alia in **T 437/98**, **T 1084/00**, **T 920/00**, **T 552/00**, **T 500/01**, **T 1023/02**, **T 749/03**, **T 859/03**, **T 1241/03**, **T 1418/04**, **T 906/05**, **T 405/06**, **T 1537/05**, **T 1204/06**, **T 1771/06**).

However, in **T 1408/04** the board emphasized that this is understood to mean only that technically illogical interpretations should be excluded. A mind willing to understand did not require that a broad term needed to be interpreted more narrowly (even if, as in the case at issue, the narrower interpretation would refer to a structure which is very common, but not exclusive, in the technical field concerned).

In **T 1771/06** the board held that a claim which specifically referred with closed language to the characterising part (GBSS gene fragment in the antisense direction) of the gene construct and, in a legitimate attempt to generalise, left open other structural elements necessary to operate the system ("comprising a fragment ... which codes for, said fragment consisting of a nucleotide sequence selected from ... SEQ ID No: ..."), was not an unusual claim formulation and saw no problem with it. The Board did not accept the argument of the Appellant that the scope of the claim extended to gene constructs which comprised any DNA in addition to the GBSS gene fragments. The skilled person would certainly take into account that the gene construct was made for the purpose of introducing the GBSS DNA fragment into the potato cells and integrating it into the genome. Accordingly, the gene construct would be thought to contain all necessary DNA elements for these steps to take place.

In **T 409/97** the board held that an erroneous statement in the introduction to the description was of no assistance in interpreting the claim and establishing the subject-matter for which protection was being sought, where this statement contradicted its actual content.

Two methods having no technical bearing on each other cannot form a single multi-step process (i.e. a "technical whole") even though they are linguistically linked together in a claim (**T 380/01**).

5.2. Meaning of terms

In **T 759/91** and **T 522/91** the claims contained the expression "comprising substantially". The board was of the opinion that this term lacked clear, explicit boundaries and its scope needed interpretation. While in everyday language the word "comprise" might have both the meaning "include" or "comprehend" and "consist of", in drafting patent claims legal certainty normally required it to be interpreted by the broader meaning "include" or "comprehend" (see e.g. **T 457/02**). The word "substantially" imposed a restriction on the word "comprising" in the sense that "to a large extent only that is comprised which is specified". The boundaries of the term "comprising substantially" were therefore to be drawn where the essential characteristics of the specified subject-matter ceased. The scope of the term "comprising substantially" was therefore interpreted as being identical to that of "consisting essentially of". However, in view of the

unequivocal character of the words "consisting of" as compared to "comprising", the expression "consisting essentially of" was to be given preference.

In decision **T 711/90** the board confirmed the assumption in the case law that the substitution of the term "consists of" for "contains" in a claim raised the question of clarity of the claim. When, as in the claim in question, the glass consisted of components denoted (i), (ii) and (iii), the presence of any additional component was excluded and, therefore, the proportions of the components (i), (ii) and (iii) expressed in percentages should have added up to 100 mole % for each claimed composition.

In **T 1599/06** the board likewise had to interpret the term "comprising". It emphasised that the meaning of terms in a patent claim has to be determined from the point of view of the skilled person, who reads the claim in the context of the application and against the background of his/her common general knowledge. The claim was directed to a vaccinating agent comprising at least one specific purified and isolated protein of *Mycobacterium tuberculosis*. The examining division had interpreted the term "comprising" broadly and held that the claimed subject matter lacked novelty in relation to a partially purified protein fraction which, in their view, contained inter alia the specified proteins. In the board's view, however, the skilled person would derive from the application as a whole the information that the specific characteristic of the vaccinating agents according to the invention was their generation from isolated and purified *Mycobacterium tuberculosis* proteins. Therefore, he/she would have considered that the definition in claim 1 covered vaccinating agents that, firstly, were constituted from isolated and purified proteins as mentioned in the claims and, secondly, contained those proteins as their main constituents.

In **T 1023/02** the board expressed its view that a claim using "comprising" language should generally not be construed as covering subject-matter which included further steps of a nature that would manifestly counteract the specified technical purpose of the step(s) recited in the claim.

In **T 1045/92** the claims concerned "a two-pack type curable composition comprising [...]". In the board's view "a two-pack curable composition" was an item of commerce as familiar to readers skilled in the polymer art as everyday articles were to the public at large. The claim was therefore clear.

In **T 405/00** the board considered that, according to the language conventional for patent claims in the field of chemistry, the wording "composition comprising a persalt" defined exclusively the mandatory presence of at least one of the specific chemical compounds belonging to the group of persalts.

5.3. Using description and drawings to interpret the claims

5.3.1 General principles

The subject-matter of claims is governed by Art. 84 EPC and their function by Art. 69 EPC. According to Art. 84 EPC (1973 and 2000) the claims define the invention

for which protection is sought. Under Art. 69 EPC (1973 and 2000) the claims determine the extent of the protection which will be conferred by the patent, through their definition of the invention. Under Art. 69 EPC (again in both versions) the description and drawings are used to interpret the claims. The question arises whether it is possible to interpret the claims in the light of the description and drawings as provided in Art. 69 EPC merely in order to determine the extent of protection or whether it is also possible to do so in order to establish whether the conditions governing patentability and clarity have been satisfied.

In a number of decisions, such as **T 23/86** (OJ 1987, 316), **T 16/87** (OJ 1992, 212), **T 89/89**, **T 121/89**, **T 476/89**, **T 544/89**, **T 565/89**, **T 952/90**, **T 439/92**, **T 458/96**, **T 717/98**, **T 500/01**, **T 1321/04** and **T 1433/05**, the boards of appeal have laid down and applied the principle whereby the description and drawings are used to interpret the claims and identify their subject-matter, in particular in order to judge whether it is novel and not obvious. Likewise, in a large number of decisions (e.g. **T 327/87**, **T 238/88**, OJ 1992, 709; **T 416/88**, **T 194/89**, **T 264/89**, **T 430/89**, **T 472/89**, **T 456/91**, **T 606/91**, **T 860/93**, **T 287/97**, **T 250/00**, **T 505/04**), the boards interpreted the claims in the light of the description and drawings in order to establish whether they were clear and concise within the meaning of Art. 84 EPC 1973.

Occasionally, however, the limits to interpretation in the light of the description and drawings are emphasised (for details see sections 5.3.5 and 5.3.6). A discrepancy between the claims and the description is not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently (**T 431/03**) or to give a different meaning to a claim feature which in itself imparts a clear credible technical teaching to the skilled reader (**T 1018/02**; see also **T 1395/07**). In **T 1023/02**, though, "unfortunate" claim language ("transcription" instead of "translation") in contradiction with the terms used in the description was interpreted differently.

5.3.2 Relevance of Article 69 EPC

Several decisions refer to Art. 69(1) EPC 1973 (**T 23/86**, OJ 1987, 316; **T 16/87**, OJ 1992, 212; **T 476/89**, **T 544/89**, **T 565/89**, **T 952/90**, **T 717/98**). Other case law emphasises that Art. 69 EPC 1973 (Art. 69(1) EPC) and its Protocol are primarily for use by the judicial organs which deal with infringement cases (see e.g. **T 1208/97**, **T 223/05**; also **T 1404/05**). The board in **T 556/02** made clear that it solely used the general principle of law applied throughout the EPC that a document had to be interpreted as a whole (see e.g. **T 23/86**, OJ 1987, 316; **T 860/93**, OJ 1995, 47). Art. 69 EPC 1973 was a specific application of this general principle.

In case **T 1279/04** the board did not share the appellant/proprietor's view that, for the purposes of assessing novelty in opposition proceedings, claims should be interpreted in accordance with Art. 69(1) EPC 1973 and the Protocol on its interpretation. Art. 69(1) EPC 1973 and its Protocol related to the extent of protection conferred by the patent or patent application, which was primarily of concern in infringement proceedings. They served to determine a fair protection - inter alia by reference to the description and drawings - in the context of an actual alleged infringer in circumstances where the claim

wording was set in stone. By contrast, in examination and opposition proceedings the value of future legal certainty was paramount. In this forum the function of the claims was to define the matter for which protection was sought (Art. 84 EPC 1973, first sentence - which also applied to opposition). There was no case for anything other than a strict definitional approach, given that in this procedural stage the claim could and should be amended to ensure legally certain patentability, in particular novelty and inventive step over any known prior art. Amendment rather than protracted argument should be the answer to genuine difficulties of interpretation in all aspects of the examination and opposition procedure, it being acknowledged that amendments to a patent as granted should be occasioned by grounds for opposition.

Likewise in **T 1808/06** the board emphasised that, when the description has to be amended with regard to the requirement of Art. 84 EPC, it was only in situations where the removal of inconsistencies was not possible for procedural reasons (e.g. no amendment possible of the granted version) that - purely as an auxiliary construction - Art. 69(1) EPC could be invoked for an interpretation of the claimed subject-matter.

5.3.3 Interpretation of ambiguous terms or confirmation of the text of a claim

Many decisions which use the description and drawings to interpret the claims concern the interpretation of relative, ambiguous or unclear terms or cite the description merely to confirm the most obvious interpretation of the text of a claim (e.g. **T 23/86**, OJ 1987, 316; **T 16/87**, OJ 1992, 212; **T 327/87**, **T 121/89**, **T 476/89**, **T 565/89**, **T 952/90**, **T 439/92**, **T 458/96**, **T 717/98**, **T 556/02**).

In decision **T 50/90** the board pointed out that the description and drawings were used to interpret relative terms contained in the claims when the extent of protection had to be determined.

When the technical content of the claims and the description clearly establish how an invention operates, these features cannot be disregarded for the purposes of assessing patentability by interpreting them merely as defining an intended use (**T 458/96**).

In several decisions the boards stated that terms used in patent documents should be given their normal meaning in the relevant art, unless the description gives them a special meaning. The patent document may be its own dictionary (see e.g. **T 311/93** and **T 1321/04**). Likewise in **T 500/01**, the board considered that a patent, being a legal document, may be its own dictionary. If it was intended to use a word which is known in the art to define a specific subject-matter to define a different matter, the description may give this word a special, overriding meaning by explicit definition. Consequently, a claim, the wording of which is essentially identical to a claim as originally filed, can nevertheless contravene the requirements of Art. 123(2) EPC, if it contains a feature whose definition has been amended in the description in a non-allowable way.

In **T 1023/02** the invention was based on the recognition that the genes for a specific viral protein (ICP34.5) expressed in infected cells determine the ability of herpes simplex viruses to destroy central nervous system tissue. The respondent argued that a post-

published document revealed the existence of an ORF-P gene coincident with but anti-sense to the ICP34.5 gene. Therefore, in view of the term "only", the claim had to be interpreted as requiring that the first method step did not interfere with the expression of this ORF-P gene. The board, however, pointed out that it was apparent from the description that the patentee had not envisaged the existence of this gene. The skilled reader would therefore, in the light of the description, not interpret the subject-matter of claim 1 in the way advocated by the respondent. Accordingly post-published knowledge of further technical details and/or complications could not justify this interpretation.

5.3.4 Reading additional features and limitations into the claims

In **T 416/87** (OJ 1990, 415) the board was confronted with the situation where a feature was not included in the claims which the description on its proper interpretation specified to be an overriding requirement of the invention. The board held that, following Art. 69(1) EPC 1973 and its Protocol, the claims might be interpreted as requiring this as an essential feature, even though the wording of the claims when read in isolation did not specifically require such feature (confirmed in an obiter dictum in **T 717/98**).

In **T 121/89**, on the other hand, the board does use the description to interpret an ambiguous term ("loose ignition charge"), but at the same time stresses that only features recited in or deducible from the claims could be set forth to distinguish the invention from the state of the art. The examples cited in the description did not limit the scope of the claims unless they were explicitly mentioned in them (see also **T 544/89**).

In **T 1208/97** certain known molecules were encompassed by the terms of the product claim. Appellant 1 had argued that a novelty objection could not apply because the patent specification stated the clear intention not to cover these molecules. The board did not agree with this view. For the purposes of judging novelty, Art. 69 EPC 1973 offered no basis for reading into a claim features which could be found in the description. As this article and the Protocol concerned the extent of protection, they were primarily for use by the judicial organs which dealt with infringement issues. According to the board, it had to be established whether or not the wording of claim 1, independently of any alleged intention derivable from the description, allowed a clear distinction between the claimed molecules and the known molecules.

In **T 932/99** claim 1 was directed to a product per se. The claim defined only the structure of a membrane as such, independently from its installation in an apparatus for gas separation. The board pointed out that, for this reason, the indication in the claim "capable of separating oxygen from oxygen-containing gaseous mixture" merely served the purpose of defining a capability of the claimed membrane, without imparting any limitations on any actual use of the structure claimed. The respondents had argued that, if claim 1 was interpreted in the light of the description, those limitations would be apparent. However, the board held that a distinction had to be drawn between, on the one hand, the fact that it might be necessary to take into account any explicit definition as given in the description for interpreting a claim's term and, on the other hand, the attempt to use Art. 69 EPC 1973 as a basis for reading limitations derived from the description into claims in order to avoid objections based on lack of novelty or inventive

step. The latter approach to interpretation, whereby features mentioned only in the description were read into claim 1 as necessary limitations, was incompatible with the Convention (**T 1208/97**; see also **T 945/99**, **T 2049/07**).

In **T 1018/02** the board emphasised that, although a claim must not be interpreted in a way which was illogical or did not make sense, the description could not be used to give a different meaning to a claim feature which in itself imparted a clear, credible technical teaching to the skilled reader. This also applied if the feature had not been initially disclosed in the form appearing in the claim (see also **T 373/01** and **T 396/01**).

In case **T 223/05** claim 18, which was directed to a certain compound, was silent on the value of X, when Y was not present. The opposition division had held that the skilled reader would have referred to the content of the description and would have deduced that all the claimed compounds had a Michael acceptor side-chain. Hence, the skilled reader would have corrected the lack of information in claim 18 by referring to the content of the description and would have concluded that, in the absence of Y, X had to be a Michael acceptor side chain. For this reason the subject-matter of said claim was novel over document (3).

The board, however, emphasised that Art. 69 EPC 1973 and its Protocol did not provide a basis for excluding what was literally covered by the terms of the claims. Applying this to the case at issue, the board considered it inconsistent with proper claim interpretation to read into claim 18 a particular meaning for X which only appeared in the description, and then to rely on this feature to provide a distinction over the prior art (see **T 881/01**). In **T 681/01** too it was stressed that Art. 69 EPC 1973 and its Protocol could not be relied on to read into the claim an implicit restrictive feature not suggested by the explicit wording of the claim. On this issue see also **T 1105/04**.

5.3.5 Use in the examination relating to the clarity requirement pursuant to Article 84 EPC

As already mentioned, in a large number of decisions (e.g. **T 327/87**, **T 238/88**, OJ 1992, 709; **T 416/88**, **T 194/89**, **T 264/89**, **T 430/89**, **T 472/89**, **T 456/91**, **T 606/91**, **T 860/93**, **T 287/97**, **T 250/00**, **T 505/04**), the boards interpreted the claims in the light of the description and drawings in order to establish whether they were clear and concise.

In **T 238/88** (OJ 1992, 709) the board stated that the fact that the features were not in fact usual terms of art did not rule out clarity and conciseness, since according to Art. 69 EPC 1973 the description should be used to interpret the claims.

In **T 456/91** the board was of the opinion that the clarity of a claim was not diminished by the mere breadth of a term of art contained in it, if the meaning of such term was unambiguous for a person skilled in the art, either per se or in the light of the description. In this case an extremely large number of compounds could be used for carrying out the invention. It was clear from the claims, when read in the light of the description, which peptides were suitable for the invention.

Likewise, in **T 860/93** (OJ 1995, 47) the board assumed that the description might be used to determine whether the claims were clear. In so doing it took its cue from the general legal principle whereby "*ex praecedentibus et consequentibus optima fit interpretatio*", which was recognised in the Contracting states. It accepted the reasoning in **T 454/89** (see below), namely that the description could only be used to determine the extent of the protection conferred and not to establish clarity, only in the case of claims which were self-contradictory, but not in general (see also **T 884/93** and **T 287/97**). In **T 523/00**, **T 1151/02** and **T 61/03**, the boards stated that a patent may be its own dictionary.

However, a number of decisions point out the limits to the use of the description and drawings in the examination relating to the clarity requirement.

T 2/80 (OJ 1981, 431) pointed out that a claim did not comply with the requirement of clarity laid down in Art. 84 EPC 1973 if it was not, per se, free of contradiction. It had to be possible to understand the claims without reference to the description (see also **T 412/03**).

In decision **T 454/89** the board shared this view and explained that Art. 84 EPC 1973 requires that claims must be clear in themselves when read using normal skills, including knowledge of the prior art but not any knowledge derived from the description contained in the patent application or the amended patent. While it was true that Art. 69 EPC 1973 allowed the description to be used to interpret the claims, it was only concerned with the extent of protection conferred as one of the effects of an application or patent whenever that extent had to be determined, particularly for third parties. It was not concerned with a claim's definition of the matter for which protection was sought, as was Art. 84 EPC 1973. In the course of the examination of an opposition, therefore, the applicant or patentee could not rely on Art. 69 EPC 1973 as a substitute for an amendment which would be necessary to remedy a lack of clarity. The board took the same line in decision **T 760/90**.

In **T 1129/97** (OJ 2001, 273), the board held that the mere fact that the precise meaning of an unclear term ("low alkyl") was expressly disclosed in the description but not in the claims did not mean that the latter met the clarity requirement. The clarity stipulation under Art. 84 EPC 1973 concerned only the claims, and therefore - according to the established case law of the EPO boards of appeal - required that they be clear in themselves, without there being any need for the skilled person to refer to the description. True, under Art. 69(1) EPC 1973 the description was to be used to interpret the claims. But Art. 69 EPC 1973 concerned only the extent of protection where this was at issue, e.g. with third parties, and not (as in Art. 84 EPC 1973) the definition of the matter to be protected by a claim (confirmed in **T 56/04** and **T 64/03**).

In **T 49/99** the board held that since clarity was a claim requirement, a clarity deficiency in the claim wording was not rectified by the fact that the description and the drawings would help the reader to understand the technical subject-matter that the claim was intended to define.

In **T 56/04** the board pointed out that a claim containing an unclear technical feature prevented its subject-matter from being identified beyond doubt. That was particularly the case if the unclear feature was meant to delimit the claimed subject-matter from the state of the art. The board therefore took the view that a vague or unclear term which was used in the claim and a precise definition which was to be found only in the description could be allowed only in exceptional cases to delimit the claimed subject-matter from the state of the art. Such an exception pursuant - *mutatis mutandis* - to R. 29(6) EPC 1973 exists if the precise definition - for whatever reason - cannot be incorporated into the claim, and the precise definition of the vague or unclear term is unambiguously and directly identifiable by a skilled person from the description. In **T 56/04** the board said that an exception was not involved. The specific value of "approximately 1 mm" disclosed in the description could have been incorporated into the claim itself instead of "slightly less than [...]".

On the extent to which it must be clear from the claim itself how parameters are to be determined when a product is characterised by parameters, see 1.1.2 above. In a number of decisions it is stressed that the claims must be clear in themselves when read with the normal skills but without any knowledge derived from the description (see e.g. **T 412/02** and **T 908/04**). In **T 992/02** however the board deemed it justified in the case in point for the claim not to include the procedure for measuring the parameter.

5.3.6 Scope of protection not defined with regard to infringement

In **T 442/91** the respondents wanted the board to rule on the extent of the protection conferred by what they considered to be broad claims. The board, however, felt that it should not concern itself in opposition appeal proceedings with the extent of the protection conferred by a patent (except for the purposes of Art. 123(3) EPC 1973), as this was the responsibility of the national courts dealing with infringement cases. Whilst the EPO made it clear how terms of art used in the claims should be understood, it should not proffer any further interpretation of the patent's future scope beyond that (see also **T 740/96**).

In line with this thinking, the board in **T 439/92** and **T 62/92** interpreted the claims with a view to identifying their subject-matter.

6. Product-by-process claims

6.1. Introduction

Under Art. 64(2) EPC (1973 and 2000) the protection conferred by a process patent extends to the products obtained directly by the process, even if they are not patentable *per se*. Certain applicants tried to acquire protection for known products by using process claims to define them and arguing thus - it follows from Art. 64(2) EPC 1973, which expressly states that protection will be granted for the direct product of a patentable process, that, under the EPC, a product is rendered novel by the fact that it is produced by means of a new process. This is notwithstanding the fact that such product

is not new per se, by virtue of its physical characteristics (see **T 248/85**, OJ 1986, 261; likewise **T 150/82**, OJ 1984, 309).

The boards of appeal did not accept this line of argument and made a distinction between claims to a new and inventive product defined by its method of manufacture and claims to a new and inventive process, the protective effects of which also extended to the direct products of this process.

The first decision in this regard was **T 150/82** (OJ 1984, 309). The board stated that claims for products defined in terms of processes for their preparation (known as "product-by-process" claims) were admissible only if the products themselves fulfilled the requirements for patentability and there was no other information available in the application which could have enabled the applicant to define the product satisfactorily by reference to its composition, structure or some other testable parameter (established case law, see e.g. **T 956/04**).

The boards of appeal have further clarified and developed these requirements in their case law.

6.2. Requirement that the claimed product must be patentable

In decision **T 248/85** (OJ 1986, 261) it was stated that a product could be defined by the use of various parameters, such as its structure or its process of preparation. The use of a different parameter by which to define a particular product could not by itself give the product novelty. Furthermore Art. 64(2) EPC 1973 did not confer novelty upon a claim which was formulated as a "product-by-process" when no novelty existed in such product per se, and did not entitle or enable an applicant for a European patent to include such claims in his patent which did not satisfy the requirements for patentability of Art. 52(1) EPC 1973.

In **T 219/83** (OJ 1986, 211) the board stated that "product-by-process" claims had to be interpreted in an absolute sense, i.e. independently of the process. If their subject-matter as such was new, they still did not involve an inventive step merely because the process for their preparation did so. In order to be patentable, the claimed product as such had to be a solution to a separate technical problem which was not obvious in the light of the state of the art (see also **T 223/96**).

These criteria were confirmed and applied in many decisions (see for instance **T 251/85**, **T 434/87**, **T 171/88**, **T 563/89**, **T 493/90**, **T 664/90**, **T 555/92**, **T 59/97**, **T 1164/97**, **T 238/98**, **T 748/98** and **T 620/99**).

The board clarified the conditions for novelty of product-by-process claims in decision **T 205/83** (OJ 1985, 363). It stated that the polymer product of a known chemical process was not rendered new merely by virtue of a modification to the process. If a chemical product could not be defined by structural characteristics but only by its method of manufacture, novelty could be established only if evidence was provided that modification of the process parameters resulted in other products. It was sufficient for

this purpose if it was shown that distinct differences existed in the properties of the products. This evidence might not include properties which could not be due to the product's substance parameters (see also **T 279/84**, **T 151/95**, **T 728/98**, **T 564/02** and **T 1247/03**).

In decision **T 300/89** (OJ 1991, 480) it was stated that the application lacked novelty if the claim neither defined the product structurally nor mentioned all the specific conditions needed to obtain necessarily the products whose novelty could be demonstrated, e.g. by means of comparative tests. Similarly, in **T 552/91** (OJ 1995, 100) the board ruled that the claim had to include all the process parameters required for unambiguously defining the claimed substances as inevitable process products. As chemical reactions only rarely took one particular course and therefore only rarely led to uniform substances, it was generally necessary to indicate not only the starting materials and reaction conditions, but also the method by which the reaction mixture was processed to obtain the claimed substances. This case law was confirmed in **T 956/04**, where the board considered that without clearly indicating the specific starting materials and the specific reaction conditions, the "obtainable-by" features as claimed failed to unequivocally define the claimed catalysts as inevitable process products.

In **T 728/98** the board stated that the general rule that the level of purity of a low molecular chemical compound could not entail novelty was also valid in the case of a product-by-process claim where the purity level was the inevitable result of the preparation process indicated in the claim. In the present case the appellant (applicant) had not been able to prove the existence of an exceptional situation where all attempts had failed to achieve a particular level of purity by conventional purification methods. For details of the issue of "achieving a higher degree of purity", see Chapter I.C.4.1.4.

In **T 803/01** the board noted that (contrary to the view of the examining division) there was no statement whatsoever in **T 205/83** (OJ 1985, 363) which prohibited the presence of parameters relating to impurities in a claim for reasons of clarity. The parameters relating to the purity of the polylactides were technical features in line with R. 29(1) EPC 1973. This was considered to be a relevant criterion for assessing the extent to which the use of purity parameters in a product claim was allowable from the point of view of clarity (**G 2/88**, OJ 1990, 93).

In **T 394/03** the board ruled that improved product quality achieved by means of a process did not generally constitute, in a product-by-process claim, a structural feature giving rise to novelty or inventive step. In the present case, a decorated ceramic product was claimed which differed from known products of this type only by virtue of its better quality, which had been achieved by means of the process according to the invention.

In **T 564/02**, when examining whether the product itself met the requirements for patentability, the board had to deal with the burden of proof. The respondent (opponent) had raised an objection of lack of novelty which was based on the disclosure in an example in a prior art document. The board observed that the validity of this objection rested exclusively on the validity of certain assumptions made by the respondent with respect to parameters of the product disclosed in prior art. In such a case, the concept of

the balance of probabilities could not be applied for the assessment of the validity of each assumption; it had to cede to a stricter criterion close to absolute conviction. In other words, there should be a degree of certainty which is beyond reasonable doubt.

6.3. Requirement that the claimed product cannot be described in any other way

The criterion laid down in **T 150/82** (OJ 1984, 309), whereby it must be impossible to define the claimed product other than in terms of a process of manufacture is now established case law (see e.g. **T 333/93**, **T 749/95**, **T 950/97**, **T 1074/97**, **T 933/01**). *Inter alia*, it was discussed specifically in the following decisions.

The board stated in decision **T 320/87** (OJ 1990, 71) that product-by-process claims were admissible for hybrid seeds and plants when they were not individually definable biological entities which could be characterised by their physiological or morphological features.

In decision **T 130/90** the board had to rule on recombinant monoclonal antibodies having two different specificities and produced by a process involving trioma cells or quadroma cells and thus producing antibodies in a native form. The patentability of the process was not questioned. The process known from prior art chemically recombined antibody half-molecules. At issue was the validity of the product claim. The prior art did not disclose how fully re-associated molecules, i.e. with the same structure as native antibodies, which might be contained in the mixture of hybrids, could be screened out and isolated from molecules which were chemically altered. The board allowed a claim for bispecific recombinant monoclonal antibodies comprising intact immunological chains produced by the process claimed in the independent process claims of the patent in suit. Defining the antibodies by their process was the only way of delimiting them vis-à-vis the prior art.

In **T 552/91** (OJ 1995, 100) it was held that where a European patent application relates to chemical substances originally defined by an incorrect chemical structural formula, correction of which is not allowable under R. 88 EPC 1973, replacement of the incorrect formula by the correct one infringes Art. 123(2) EPC 1973. Nevertheless, the submission of a "product-by-process" claim is compatible with Art. 123(2) EPC 1973 if it contains all the measures required to obtain this result (starting materials, reaction conditions, separation).

6.4. Combination of product and process features

In decision **T 148/87** the board stated that it was admissible to combine product parameters and process parameters in the same claim. In **T 129/88** (OJ 1993, 598) the board was of the opinion that the inclusion in a product claim of one or more process features might be permissible if their presence was desirable having regard to the impact of the national laws of one or more contracting states (see also **T 592/95** and **T 288/02**).

6.5. Extension of protection conferred by product-by-process claims

In decision **T 411/89** the board had to decide whether the amendment of a product-by-process claim from "obtained" to "obtainable" extended the protection conferred by the patent. The board took the view that the protection was not extended because the amendment did not modify the definition of the product which was claimed per se from the beginning and because the process used for its characterisation remained the same.

In decision **T 423/89**, by restricting the claim to only one of a number of manufacturing processes specified in the original claim and disclosed in the description, the patent proprietors had ceased to claim absolute product protection and had undertaken a significant limitation of their claim. There were therefore no objections under Art. 123(3) EPC 1973. The change in category from a product-by-process claim to a manufacturing process claim was also admissible in this case, as the protection afforded by the granted patent had to extend to all those methods of manufacture covered by the processes described in the claim and disclosed in the patent specification.

In **T 20/94**, however, objections under Art. 123(3) EPC 1973 led to the board's refusing a change from process claims to a product-by-process claim by way of amendment, as despite the fact that a product-by-process claim was characterized by the process for its preparation, it nevertheless belonged to the category of claim directed to a physical entity and was a claim directed to the product per se. The scope of protection conferred by a product claim exceeded the scope conferred by a process claim under Art. 64(2) EPC 1973.

7. Claims fees

Until 31 March 2008, under R. 31(1) EPC 1973 and then the new R. 45 EPC, any European patent application comprising more than ten claims incurred payment of a claims fee in respect of each claim over and above that number. With effect from 1 April 2008 the number of fee-exempt claims was increased to fifteen.

The Legal Board of Appeal ruled in case **J 9/84** (OJ 1985, 233) that R. 31(1) EPC 1973 was to be interpreted as meaning that claims numbered 1 to 10 upon filing of the European patent application - or transmittal to the EPO of the international application under the PCT - were exempt from fees, and that claims numbered 11 onwards were not. Accordingly, abandoning a fee-exempt claim after filing - or transmittal - did not have the effect that its fee exemption was transferred to another claim.

The question has arisen on a number of occasions as to whether part of, or an annex to, the description of a European patent application comprising a series of numbered paragraphs drawn up in the form of claims should be regarded as claims for the purposes of R. 31(1) EPC 1973.

In **J 5/87** (OJ 1987, 295) the application contained, under the heading "Claims", ten claims; however it contained 33 further claims which were annexed to the description as preferred, numbered embodiments presented in the form of claims. The addendum

appeared in form as well as in substance only to consist of claims within the meaning of Art. 84 and R. 29 EPC 1973. Furthermore, the appellant had admitted that the addendum had been included in the application in order to maintain the possibility of making its content a basis for substantive examination. As a result, the applicant was required to pay the claims fee - applicants were not at liberty to ignore the provisions on the form and content of the description and claims contained in R. 27 and R. 29 EPC 1973.

In decision **J 15/88** (OJ 1990, 445), the board decided in a similar case that although the 117 disputed "clauses" in question were numbered and arranged as claims and seemed to define matter in terms of technical features, they were not to be regarded as such since the fact remained that they were never referred to as claims and there were claims elsewhere which were referred to as such.

Decisions **J 16/88**, **J 29/88**, **J 25/89**, **J 26/89**, **J 27/89**, **J 28/89**, **J 34/89** and **T 490/90** all confirmed this opinion, pointing out that the case dealt with in **J 5/87** differed from the others since the applicant had indicated an intention to regard the annexes as claims. The intention of the appellant not to have this part considered as claims is more important than the form of the text.

C. Unity of invention

1. Introduction

Under Art. 82 EPC, the European patent application may relate to one invention only or to a group of inventions so linked as to form a **single general inventive concept**. R. 44 EPC (R. 30 EPC 1973) gives an interpretation of the concept of unity of invention where a group of inventions is claimed. This rule was amended by decision of the Administrative Council of the European Patent Organisation dated 7.12.1990 (OJ 1991, 4), which entered into force on 1.6.91, but the principles set out by board of appeal case law relating to R. 30 EPC 1973 as in force before 1.6.91 can still be applied. When the EPC was revised in 2000, R. 30(1) EPC 1973 was streamlined and its wording aligned with the style of the EPC 2000. Art. 82 EPC 1973 remained unchanged.

Under the EPC 1973, the boards of appeal were responsible for judging unity of invention when they decided on a protest made by an applicant against an additional fee charged by the EPO as ISA or IPEA (see Art. 154(3) and 155(3) EPC 1973). Art. 154(3) and 155(3) EPC 1973 were deleted as part of the revision of the EPC. However, they remain applicable to PCT applications which were pending at the time of the entry into force of the EPC 2000. Whilst the jurisdiction of the boards of appeal has been taken away with regard to the PCT protest procedure, the boards of appeal continue to consider unity in the context of European applications.

Harmonisation of the definitions regarding the requirement of unity of invention in the PCT (R. 13 PCT) and the EPC (Art. 82 EPC in conjunction with R. 44 EPC) means that the criteria for unity of invention in both systems are the same. Decisions of the boards of

appeal rendered in PCT cases are thus still of interest when considering unity in the context of European applications.

2. Unity in the context of different types of claims

2.1. Plurality of independent claims

Under Art. 82 EPC and R. 13.1 PCT, the international application must relate to one invention only or a group of inventions so linked as to form a single general inventive concept. The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the **same or different categories**.

In **W 5/92** the board considered it to be implicit in the definition of R. 13.1 PCT that the "invention" be considered in the broadest sense. Thus, according to PCT Search Guidelines VII-5 (PCT Gazette No. 30/1992, Sec. IV; No. 29/1993, Sec. IV, no longer in force; for similar guidance see paragraph 10.05 of the PCT International Search and Preliminary Examination Guidelines, as in force from 25.3.2004), the mere fact that an international application contained claims of different categories or several independent claims of the same category was in itself no reason for objection on the grounds of lack of unity of the invention.

R. 44(1) EPC and R. 13.2 PCT state that where a group of inventions is claimed in a European/international patent application, the requirement of unity of invention is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

The old R. 30 EPC 1973 (as in force until 31.5.91), like the previous R. 13 PCT, specified three cases in which a combination of independent claims in different categories was to be considered as having unity in the above-mentioned sense. The combinations were as follows:

- (a) in addition to a claim for a given product, a claim for a process specially adapted for the manufacture of the product, and a claim for a use of the product;
- (b) in addition to a claim for a given process, a claim for an apparatus or means specifically designed for carrying out the process;
- (c) in addition to a claim for a given product, a claim for a process specifically adapted for the manufacture of the product, and a claim for an apparatus or means specifically designed for carrying out the process.

The list was not exhaustive and other combinations were permitted if they had met the requirements of Art. 82 EPC 1973 (**T 861/92**). The same applied to the old version of R. 13.2 PCT (**W 3/88**, OJ 1990, 126; **W 29/88**, **W 3/89**). In **T 702/93** it was held that this old version of R. 30 EPC 1973 did not provide for such a fictitious unity in the case of independent claims in the same category.

The principles laid down in previous board rulings on unity of invention were based on this fiction, which no longer exists after R. 30 EPC 1973 and R. 13 PCT had been amended with effect from 1.6.91. However, the principles set out in this case law remain unchanged (**T 169/96**).

In **T 202/83** it was concluded from the old version of R. 30(c) EPC 1973 that the requirement of unity was not met by every subject-matter for carrying out a process. On the contrary, the provision presupposed that the means for carrying out the process had been specifically designed. Consequently, such a means in connection with the corresponding process did not meet the unity requirement if it was obvious that it could also serve to solve other technical problems.

In **T 200/86** the board held that it was possible to claim, in one application, not only a product for pharmaceutical use, but also the product's non-therapeutic (cosmetic and dietary) uses.

In **W 29/88** the international application related to chemical products, a process for their preparation and their use. The board was of the opinion that a particular use of a class of compounds on the one hand, and, on the other hand, a claim to that class of compounds per se or to certain members of that class of compounds could form a single general inventive concept. The board stressed that the salient point was not the identity of the respective structural scopes, but the question whether the compounds claimed per se (and the process for their manufacture) contributed to the solution of the problem underlying the use invention.

In **W 32/88** (OJ 1990, 138) the board was of the opinion that an invitation to pay an additional fee on the grounds that an international application concerning a process and an apparatus related to two different inventions, whereas the apparatus was specifically designed for carrying out the process, had no legal basis, even if the claims for the apparatus were not restricted to such use (see also **W 16/89**).

In **W 13/89** the board found unity of invention between a claim to the use of a substance or composition for the preparation of a medicine intended for a specific use (second medical use) and a claim to a pharmaceutical product containing that substance or composition (first medical use). This decision was confirmed in **W 5/91** and **W 28/91**.

In **W 23/91** the board confirmed the ISA's view that the novelty of a given product might justify claims of different categories being contained in a single application without contravening the requirements of unity of the invention (several new uses of the product in different areas and/or new processes concerning the product, e.g. preparation). In the case in point, the two independent product claims related to two "products", namely a nucleic acid sequence and the protein relating to the nucleic acid sequence. The board held that these products might constitute the common link if they were novel.

In **W 40/92** the board took the view that there can be unity of invention if one independent claim to a process and another to the means for executing that process were comprised in one application. Said means could itself also be a process.

In **T 492/91**, the board found that, for the purposes of Art. 82 EPC 1973, the whole composition covered by claim 6 (new composition) need not be the product of the process according to claim 1 (process for preparing known products). It was sufficient for one component of the composition to be such a product where the composition and the process were intended to solve the same technical problem. The board concluded that the scope of claim 6 therefore did not have to be limited to the compositions resulting from the process according to claim 1, thus excluding the compositions obtainable by subsequent mixing.

2.2. Dependent claims

R. 13.4 PCT expressly provides that dependent claims must fulfil the requirement of unity in accordance with R. 13.1 PCT. The EPC makes no comparable express provision. The question has therefore arisen as to whether dependent claims have to be treated differently under the two provisions. Board of appeal case law on PCT cases has been uniform: the boards have repeatedly confirmed the principle that the requirement of unity must also be met by dependent claims (see inter alia **W 3/87**, **W 2/88**, **W 30/89**, **W 32/89**, **W 26/90**, **W 8/91** and **W 54/91**). In EPC cases the boards likewise assume that dependent claims have to meet the requirement of unity. As distinct from the PCT procedure, under the EPC the approach is not as strict as in the case of independent claims, where the examination is always carried out in accordance with the express requirement, but only in those cases where unity could be problematical (see **T 140/83** and **T 249/89**).

In **W 8/91** it was decided that, where claims were formally dependent, the ISA had to state expressly why they lacked unity; it was not enough simply to say that this was shown directly by the subject-matter as defined by the ISA.

In **W 6/98** the board held that anticipation of the subject-matter of an independent claim might well lead to a situation of non-unity a posteriori, which however could only be established by showing that there was indeed no unifying novel inventive concept common to all dependent claims. The board noted that lack of novelty of the subject-matter of an independent claim did not automatically lead to a posteriori lack of unity for the claims directly or indirectly appended to said independent claim.

2.3. Intermediate products

In **T 57/82** (OJ 1982, 306) it was stressed that the subject-matter of an application relating to new chemical end products, processes for their preparation, and to new intermediates for those end products at all events had unity within the meaning of Art. 82 EPC 1973 if all these subject-matters were technically interconnected and integrated into a single overall concept by being oriented towards the end products. In this context, starting materials which were used in a process for preparing end products and which were themselves products of a disclosed, albeit unclaimed, production process were also considered to be intermediates. This principle was confirmed in **T 110/82** (OJ 1983, 274) for low-molecular products. According to that board, an invention relating to new low-molecular end products and to several groups of new low-

molecular intermediates invariably had unity if the groups of intermediates prepared and oriented towards the end-products were technically closely interconnected with the end products by the incorporation of an essential structural element into the end-products and if due account was taken of the regulatory function of Art. 82 EPC 1973 (prohibition of unjustified saving of fees, need for ready comprehensibility).

This was confirmed by **T 35/87** (OJ 1988, 134) and **T 470/91** (OJ 1993, 680). The intermediates in the latter case - unlike those in earlier ones - were not structurally related to each other. However, they provided both the essential structural elements present in the end products. The intermediates of the application were therefore only made available with a view to obtaining the end products and they were sufficiently closely technically interconnected with those end products. Thus, they were integrated into a single overall inventive concept by being oriented towards the end products. This was not prejudiced by the fact that the two sets of intermediates were not structurally related to each other since the orientation of the intermediates towards the end products permitted the individual technical problems addressed by the intermediates to be combined into a unitary overall problem to the solution of which both sets of purpose-made intermediates contributed.

In **W 35/91** the board ruled that the requirements of unity of invention as set out in R. 13.1 and R. 13.2 PCT were met if the novel intermediates designed to give rise to the novel end products were technically sufficiently closely related by their contribution to an essential structural element of the end products.

In **W 7/85** (OJ 1988, 211) the board stated that there was sufficient technical information to justify a prima facie finding of unity of invention between a claim to a mixture and a claim to one essential component of that mixture or a narrowly defined version thereof. If a finding of unity was justified in cases of chemical intermediates and end products even when, as was often the case, only a part of the intermediate structure was actually incorporated, there was all the more reason to view the intact components and the corresponding compositions in a mixture as technically interconnected by incorporation. The former were not even destroyed when the admixture was prepared and fully retained their properties and functions in the product, unlike typical intermediates, which lost their identity in the process. Thus, both inventions could be considered to fall within the same general inventive concept. In such cases the requirement that the means for preparing the end product should be "specially designed for carrying out the process" appeared to be fulfilled since none of the means led or was related to an end product outside the scope of its definition. In view of this the character of the invention in the component was, prima facie, also dependent on the existence of an invention in the end product.

3. Assessing lack of unity of invention

3.1. General approach - content of claims

According to Art. 3(4)(iii) PCT, an international application must comply with "the prescribed requirement of unity of invention". In the EPC, the corresponding requirements for unity are set out in Art. 82 EPC and R. 44 EPC.

In **W 6/97** it was held that the determination of unity of invention must be made on the basis of the contents of the claims as interpreted in the light of the description and of the drawings, if applicable. The board referred to Annex B, Part 1(b) of the PCT Administrative Instructions (corresponding to Annex B, paragraph (b) PCT Administrative Instructions, as in force from 1.7.2008), which states that principle and noted that the PCT Administrative Instructions are binding not only on the ISA but also on the board of appeal acting as the "three-member board" according to R. 40.2(c) and (e) PCT (see **G 1/89**, OJ 1991, 155; in the PCT Regulations, as in force from 1.4.2005, the reference to the "three-member board" has been replaced with that to the "review body").

In **W 39/90** the board observed that it was not the formal choice of words or form of reference, but the actual content of the claims which established technical relationships between the subject-matter of different claims, and which was thus decisive for the question of unity. In **W 33/92** the board emphasised that R. 13.1 PCT did not require the link between the subject-matter of the two independent claims to be expressly stated in their wording. All that was required was that there be a single inventive concept.

Neither the PCT itself nor the Rules under the PCT contain provisions indicating how to decide whether or not an international application complies with the prescribed requirement of unity of invention. However, in the PCT Search Guidelines it is stated, *inter alia*, that lack of unity of invention may be directly evident "a priori", that is before considering the claims in relation to any prior art, or may only become apparent "a posteriori", that is after taking prior art into consideration (**G 1/89**, OJ 1991, 155).

3.2. Assessment of lack of unity by the International Searching Authority (ISA)

Lack of unity may be directly evident a priori, i.e. before examination of the merits of the claims in comparison with the state of the art revealed by the search (**W 1/96** and **W 6/90**, OJ 1991, 438). If the objection of lack of unity of invention is raised a priori, the technical problem must be defined solely on the basis of the description and not of the prior art (see **W 50/91**, **W 52/91**, **W 22/92**, **W 52/92** and **T 188/04**).

For international applications the question arose as to whether the ISA had the power to assess unity of invention a posteriori, i.e. after an examination of the application. In **W 3/88** (OJ 1990, 126) the board had answered this question in the negative, interpreting the expression "a single general inventive concept" of R. 13.1 PCT as being simply the general concept of what the applicant subjectively claimed to be his invention. By contrast, in **W 44/88** (OJ 1990, 140) and **W 35/88**, the answer was in the affirmative. In the latter cases the boards had referred to the PCT Search Guidelines which permitted assessment of unity a posteriori. Both a board of appeal and the President of the EPO had then referred the question to the Enlarged Board of Appeal:

The Enlarged Board of Appeal delivered a decision in **G 1/89** (OJ 1991, 155) and **G 2/89** (OJ 1991, 166). It decided that the EPO in its capacity as an ISA might, pursuant to Art. 17(3)(a) PCT, request a further search fee where the international application was considered to lack unity of invention a posteriori. The Enlarged Board first noted that the

problems involved were mainly due to the fact that, under the PCT, as well as under the EPC 1973, search and (substantive) examination were carried out in sequentially different steps and by different examiners. This procedural separation of search and examination led inevitably to a certain overlapping because of the functional relationship between search and examination. Thus, although the objective of the search was in principle limited to discovering and reporting on relevant prior art for the purpose of assessing novelty and inventive step, which was ultimately the task of the examining authority (i.e. the IPEA and/or the designated Office under the PCT and the examining division under the EPC 1973 respectively), it was obvious that in many instances the search examiner needed to form a provisional opinion on these issues in order to carry out an effective search. Otherwise, he would simply be at a loss how to judge the relevance of the documents in the prior art and how to arrange the search report accordingly. This overlapping was inherent in the PCT and the EPC 1973 and was in contrast to the system of most national patent laws, where search and examination were carried out in one combined operation, normally by the same examiner, and where consequently there was no separation of fees for search and examination as under the PCT and the EPC 1973.

The Enlarged Board further noted that the requirement of unity of invention under the PCT applied equally to the procedure before the ISA and to the procedure before the IPEA according to Art. 17(3)(a) PCT and Art. 34(3)(a) PCT respectively, which was in conformity with the procedural separation of search and examination as referred to above and reflected the principle that the normal fees for search and examination were related to one invention (or a single general inventive concept) only. This led to the conclusion that the requirement of unity of invention under the PCT had in principle to be judged by the same objective criteria by both the ISA and the IPEA.

The Enlarged Board observed that the PCT Search Guidelines contained a direct reference to the consideration of unity of invention by the ISA on an a posteriori basis, i.e. after an assessment of the claims with regard to novelty and inventive step in relation to the prior art. A comparison with the corresponding EPO Guidelines showed that under the EPC 1973 it was also clearly foreseen that consideration of unity of invention by the search divisions might be carried out on an a posteriori basis (see also R. 46 EPC 1973). In the view of the Enlarged Board, this was a consequence of the special structure of the PCT and the EPC 1973. Therefore, the Guidelines had on this point to be considered as consistent with the PCT and the EPC 1973. As to the PCT Search Guidelines, it was noted that such guidelines were based on Art. 56 PCT dealing with the task of the Committee for Technical Cooperation (see in particular Art. 56(3)(ii) PCT and the reference to the need for uniformity of, inter alia, working methods). The PCT Search Guidelines VII-9 (PCT Gazette No. 30/1992, 14025; now contained, in amended form, in chapter 10 of the PCT International Search and Preliminary Examination Guidelines, as in force from 25.3.2004), set out how this was to be applied in practice and were the basis for a uniform practice on the part of all International Searching Authorities.

Since, under the terms of R. 33.1(a) PCT, the prior art consisted of everything that had been made available to the public before the date of filing of the international application, the ISA could use such documents as grounds for a decision of lack of unity a posteriori

even if it was not possible to cite these documents against a corresponding national patent application in one of the contracting states designated (**W 21/89**).

3.3. Assessment of lack of unity in examination proceedings

According to the wording of Art. 82 EPC, the requirement of unity of invention has to be satisfied not only by the patent application as filed but also by the patent application at later stages of the patent granting procedure, i.e. before the examining division, up until grant of the patent. R. 64(2) EPC (R. 46(2) EPC 1973; unchanged in substance) refers to the possibility that the examining division might disagree with the search division concerning lack of unity of a particular patent application and that then the examining division's opinion is decisive in that the latter may order refund of any further search fee at the applicant's request. It lies within the discretion given to the examining division to decide that a patent application lacks unity of invention within the meaning of Art. 82 EPC, even if the search division did not raise a similar objection under R. 64(1) EPC (R. 46(1) EPC 1973; unchanged in substance) (**T 178/84**, OJ 1989, 157).

3.3.1 Lack of unity raised at different stages of the procedure

In **T 87/88** (OJ 1993, 430) the board noted that the Enlarged Board of Appeal had ruled that when the EPO carries out an international search, an international application may also be considered, under Art. 17(3)(a) PCT, not to comply with the requirement of unity of invention "a posteriori", i.e. after prior art is taken into consideration and a provisional opinion on novelty and inventive step is thereby formed (**G 1/89**, OJ 1991, 155; **G 2/89**, OJ 1991, 166). This principle applied equally when carrying out a European search (Art. 92 EPC 1973) because in both cases the searches and search reports were virtually identical. The appellants' objection that a search division was not entitled to decide that the claimed invention lacked unity "a posteriori" as well was therefore unfounded.

In **T 94/91** it was added that Art. 82 EPC 1973 clearly provided that European patent applications must satisfy the criteria of unity of invention without any restriction. There was no difference in the EPC 1973 between "a priori" and "a posteriori" lack of unity. Therefore, European patent applications had to fulfil the condition of unity and it was of no importance whether the non-unity appeared immediately or only in view of a document found during the search or during the examination.

In **T 544/88** (OJ 1990, 429) the board ruled that if an applicant, in response to an objection of lack of unity under Art. 82 EPC 1973, filed new claims allegedly relating to an invention meeting the unity requirement, examination should be continued even if the other application documents had not been limited to the subject-matter of those claims. However, the examining division might request the applicant to bring the description and drawings into line with the valid claims (R. 27(1)(d) EPC 1973 as in force up to 31.5.1991; this corresponds to R. 27(1)(c) EPC 1973 and R. 42(1)(c) EPC) and to delete from the patent documents those parts of the description and drawings which did not refer to claimed inventions (R. 34(1)(c) EPC 1973). It would then be necessary to check

in each individual case whether such adjustments ought to be deferred until allowable claims were submitted.

3.3.2 Assessment of requests for refund of further search fees

In **J 24/96** (OJ 2001, 434) the appellant raised the issue of whether, in its decision concerning the refund of further search fees under R. 46(2) EPC 1973 (R. 64(2) EPC), the examining division should have dealt with the alleged incompleteness of the partial search report. The board held that within the framework of R. 46 EPC 1973 it is the task of the examining divisions (and the boards of appeal) to examine whether communications of the Search Divisions under R. 46(1) EPC 1973 asking for further search fees were justified. R. 46(2) EPC 1973 does not, however, refer to any acts of the Search Divisions other than communications issued under R. 46(1) EPC 1973. It was therefore not necessary for an examining division to deal in a decision under Rule 46(2) EPC 1973 with other objections raised by the applicants in connection with the search, such as for example the objection that the partial search report was not drawn up in accordance with the Guidelines. To avoid any misunderstanding, the board observed that the examination divisions of course have the possibility of arranging for an additional search to be performed, if they consider a search report delivered by the Search Division incomplete, but that this had nothing to do with a formal decision issued under R. 46(2) EPC 1973 concerning refund of further search fees upon request.

In **T 188/00** the appellant had requested a refund of the further search fee paid in response to a communication from the search division under R. 46(1) EPC 1973. The board noted that under R. 46(2) EPC 1973 the examining division had to review the finding of the search division that the claims as filed lacked unity of invention. In other words, a review of the finding of lack of unity of invention had to be carried out having regard only to the facts presented by the search division in its communication under R. 46(1) EPC 1973. Since in most cases objections against lack of unity of invention were raised having regard to the prior art (a posteriori unity objections), this meant that the examining division had to base its review solely on the documents cited in the partial search report and on the specification of the different inventions drawn up by the search division, while taking into account any arguments which the applicant might have submitted in support of his request for a refund.

The board observed that in the analogous procedure under the PCT, a review of the justification for the invitation to pay additional fees resulting from a finding of lack of unity was provided for in R. 40.2(c) and (e) and R. 68.3(c) and (e) PCT, the protest procedure. The boards of appeal had ruled that these reviews had to be based exclusively on the reasons given in the invitation to pay, having regard to the facts and arguments submitted by the applicants (**W 4/93**, OJ 1994, 939).

In the case at issue, however, the examining division had reasoned that the claims as filed lacked unity of invention a posteriori, as a consequence of the finding that claim 1 as filed lacked an inventive step having regard to documents D1 and D4, where the latter document was not cited in the partial search report. Thus the examining division did not review the finding of lack of unity of invention within the meaning of R. 46(2) EPC 1973,

but carried out a fresh examination on the basis of a new document D4. The board therefore held that the decision to refuse the refund of a further search fee had to be set aside for formal reasons alone and that the appellant's request for a refund of a further search fee under R. 46(2) EPC 1973 was justified.

3.4. No assessment of lack of unity in opposition proceedings

In **G 1/91** (OJ 1992, 253) the Enlarged Board held that unity of invention did not come under the requirements which a European patent and the invention to which it related had to meet under Art. 102(3) EPC 1973 (Art. 101(3)(a) EPC) when the patent was maintained in amended form. It was consequently irrelevant in opposition proceedings that the European patent as granted or amended did not meet the requirement of unity. It was clear from the "travaux préparatoires" not only that lack of unity was deliberately excluded as a ground for opposition, but also that any lack of unity arising during opposition proceedings as a result of amendment of the patent had to be accepted.

The Enlarged Board noted *inter alia* that although unity of invention under Art. 82 EPC 1973 was a material requirement, it was still merely an administrative regulation. It served a number of administrative purposes, particularly in demarcating the respective responsibilities of the departments. The administrative purposes of unity were fulfilled in the main up to the time the patent was granted. The purpose and intention of opposition proceedings was to give a competitor the opportunity of opposing unjustified protective rights. Since this served the competitor's interests, he did not also need to be given the opportunity of contesting a patent on the ground of lack of unity. Lack of unity did not in fact rule out patent protection; it could only result in an application being divided to produce two or more patents.

4. Criteria for determining lack of unity

4.1. Determination of the technical problem

According to the established case law of the boards of appeal, determining unity of invention requires as a precondition an analysis of the technical problem or problems underlying the respective group of inventions (see **W 11/89**, OJ 1993, 225; **W 6/97**, **T 188/04**). In **W 6/91** the board held that the determination of the technical problem underlying the invention was a mandatory precondition for the assessment of unity of invention, i.e. whether or not the subject-matter claimed as the solution to such a problem represented a single general inventive concept. The disregard of this principle would be in itself sufficient justification for the reimbursement of the additional search fees. In **W 8/94** the board held that a discussion of the problem underlying the claimed subject-matter was required, because only then was it possible to decide whether or not a common special technical feature within the meaning of R. 13.1 and R. 13.2 PCT existed for different embodiments (see **W 11/89**, OJ 1993, 225; **W 14/89**, **W 59/90**, **W 14/91**, **W 17/91**).

In **W 6/97** the board found that establishing the technical problem underlying a claimed invention or group of inventions in relation to the state of the art should start, as a rule,

from what was considered in the description as having been achieved by the claimed invention, since claims directed to compositions of matter at least were normally silent on the technical effects to be achieved by such compositions. As soon as the search revealed prior art which was clearly more relevant than that already acknowledged in the description of the international application, it was necessary to determine what was to be considered as the particular technical problem in view of both the disclosure of the international application as a whole and the prior art thus revealed (see **W 6/91**). Unity of invention might be assessed only after the technical problem had been determined in such a manner.

The boards have on several occasions stressed that an alleged lack of clarity in a claim cannot be used as a reason for an objection based on lack of unity (see **W 31/88**, OJ 1990, 134; **W 7/89**, **W 59/90**, **W 9/02**). In **W 21/04** the board observed that according to the established case law of the boards of appeal the features of an independent claim that the ISA held not to meet the requirements of Art. 6 PCT could not be disregarded in examining a lack of unity objection.

In **W 17/03** the board was concerned with the investigation of technical relationships for unity. The case is referred to further below.

4.2. Examination as to novelty and inventive step

In **W 12/89** (OJ 1990, 152) the board had examined the legal position and, given the difference of opinion between the boards, had referred, inter alia, the following questions to the Enlarged Board of Appeal (**G 1/89**):

"Does an International Searching Authority have the power to carry out a substantive examination of an international application in respect of novelty and inventive step when considering under Art. 17(3)(a) PCT whether the application complies with the requirement of unity of invention set forth in R. 13.1 PCT?

If an International Searching Authority does have such power, in what circumstance does it have an obligation to carry out such a substantive examination?"

The Enlarged Board of Appeal delivered its decision in **G 1/89** (OJ 1991, 155) and **G 2/89** (OJ 1991, 166). It found that in accordance with normal terminology, the term "examination" or "substantive examination" referred to the activities of the authorities responsible for deciding on patentability, such as the examining division of the EPO, or, in the case of the PCT, to the activities of the IPEA and/or the designated Office. Obviously, an ISA did not have any power to carry out such activities. The Enlarged Board held that an ISA might only form a provisional opinion on novelty and inventive step for the purpose of carrying out an effective search. This opinion was in no way binding on the authorities referred to above. The same principle applied also when an ISA considered that an international application did not comply with the requirement of unity of invention set forth in R. 13.1 PCT on an "a posteriori" basis. Such consideration had only the procedural effect of initiating the special procedure laid down in Art. 17 PCT and R. 40 PCT and was, therefore, not a "substantive examination" in the

normal sense of that term. According to the decision an assessment of whether a single general inventive concept existed was to be undertaken only in so far as this was necessary to establish whether the invention complied with the requirement of unity when implementing the procedure laid down in Art. 17 PCT and R. 40 PCT. Such an assessment was **provisional** and did not constitute a substantive examination in the sense of an examination as to patentability (see **W 6/90**, OJ 1991, 438).

The Enlarged Board further noted that consideration by an ISA of the requirement of unity of invention should, of course, always be made with a view to giving the applicant fair treatment and that the charging of additional fees under Art. 17(3)(a) PCT should be made only in clear cases. In particular, in view of the fact that such consideration under the PCT was being made without the applicant having had an opportunity to comment, the ISA should exercise restraint in the assessment of novelty and inventive step and in borderline cases preferably refrain from considering an application as not complying with the requirement of unity of invention on the ground of lack of novelty or inventive step (see **W 24/90**, **W 23/91**, **W 43/91**). In **W 1/97** the board held that there was no such clear case where the ISA, having already searched part of the subject-matter, was still not in a position to identify several separate inventions.

After the Enlarged Board of Appeal's decision in **G 1/89** and **G 2/89**, the boards repeatedly used a lack of novelty or inventive step in the general inventive concept underlying the invention to justify a finding of lack of unity of invention (see **W 17/89**, **W 27/89**, **W 18/90** and **W 19/90**). In **W 10/92** the board stressed that the problem-solution approach was to be applied to unity of invention (**W 16/91**, **W 21/91**).

In **W 17/03** the ISA had considered that the absence of common technical features and an allegedly different problem solved would be sufficient to demonstrate lack of unity between groups of inventions. The board suggested that the ISA's approach to the determination of the problem appeared to stem from the belief that what was required was the same analysis as that used to determine the problem when using the problem and solution approach to evaluate inventive step, possibly because differences and problems are involved in both situations.

The board stated that it was not convinced that the investigation of technical relationships for unity with the aid of common problems underlying the inventions is necessarily the same as the analysis that is used to determine the problem when using the problem and solution approach to evaluate inventive step. The board gave the following reasons:

(1) The evaluation of unity involves comparing problems solved (or effects achieved) by different claims, whereas the evaluation of inventive step is carried out on a single claim. As a result, when examining unity, the problems solved by different claims must be considered in the light of each other and cannot be determined in isolation in an absolute sense.

(2) In the evaluation of inventive step, the idea is to define a problem based on the distinguishing features that is essentially as narrow as possible, but not involving

elements of the solution. On the other hand, in the evaluation of unity, these restrictions do not apply, since the overall object is to find out what the claims involved have in common, i.e. if the respective inventions are so linked as to form a single general inventive concept.

Thus, the specific problems solved by the different inventions with respect to the closest prior art might need gradual refinement, in particular generalisation starting from the problem directly solved, to find out whether or not there was a common denominator that still distinguished the inventions from the said prior art.

5. The single general inventive concept

5.1. General

When deciding on unity of invention, it is mandatory under Art. 82 EPC and R. 13.1 PCT to determine whether or not a group of inventions claimed in an application forms a single general inventive concept. Thus, when seeking to establish at the search stage whether inventions comply with the requirement of unity, the first question to be considered is whether the inventions are linked by a single general concept.

In **W 19/89** the board decided that the application clearly lacked unity of invention, since the four possibilities comprised by claim 1 related to a further development of the state of the art in different directions, namely by employing different classes of dehalogenation agents having no new technical feature in common. Where at least one solution of the underlying technical problem already formed part of the state of the art, the requirement of a "single general inventive concept" implied that the further solutions to that problem proposed in the application must have at least one new element in common, this new element being normally represented by at least one new technical feature. Since the absence of such a unifying new technical feature was admitted by the applicant, the application related to more than one invention.

A useful analysis of the single general concept was made in **W 6/90** (OJ 1991, 438). The board found that this concept manifested itself in features common to different teachings expounded individually in the same application. It observed that a teaching for the purposes of patent law encompassed not only the immediate subject-matter representing the solution to the problem as defined in the relevant claim, but also its technical consequences which were expressed as effects. It was noted that any subject-matter was defined by structural features and the relationship between them. The relevant effects, i.e. the outcome or results achieved by the invention as claimed, would usually already be apparent from the problem as stated. A single general concept might therefore be said to be present only if a partial identity existed between the teachings in an application deriving from the structural features of the subject-matters claimed and/or the outcome or results associated with those subject-matters.

Where subject-matters of the same category were concerned, a partial identity, generating unity of invention, could result from the structural features of these subject-matters and/or their associated effects. The absence of such an element common to all

the different teachings in the application, and hence a lack of unity, might be established *a priori* under certain circumstances. A lack of unity might, however, also be established *a posteriori* between the subject-matters of different independent claims or in the remaining subject-matters if the subject-matter of a linking claim was clearly not novel or inventive *vis-à-vis* the state of the art. The board gave an example of what was meant by the abstract term "single general concept": a product, a process specially adapted for the manufacture of the said product, and a use of the said product, for example, embodied a single general concept because, on the one hand, the partial identity between the product and its use derived from the structural features of the product and, on the other hand, the partial identity shared by the product and the process specially adapted for its manufacture also derived from the product which was to be considered as the effect or result of this process (see **T 119/82**, OJ 1984, 217).

The board also noted that the criteria governing unity of invention for the purposes of R. 13.1 PCT elucidated above also applied in principle where the inventive step was based chiefly on the discovery of an unrecognised problem (see **T 2/83**, OJ 1984, 265). If the common problem, i.e. the effects to be achieved, was itself already known or could be recognised as generally desirable (a mere desideratum) or obvious, there would be no inventive merit in formulating the problem. If the common structural features were to be found only in the prior art portions of the claims, and if these known features did not help to solve the problem of the combined whole, this might also indicate a lack of unity.

In **W 38/90** the sole common link between the subject-matter of claims 1, 2 and 4 was that the respective features all contributed to the realisation of the same device - a viewing assembly for a door. The board observed that this common pre-characterising feature was confined to indicating the designation of the invention, as part of the prior art; it was not, however, a specific feature interacting with the remaining characterising features and thereby contributing to the various inventions and their effects. Therefore, this sole link had to be rejected as irrelevant as regards any possible contribution to inventiveness. As already concluded, in the absence of any kind of common relevant feature, no unity "*a priori*" could be recognised.

In **W 32/92** (OJ 1994, 239) the board held that there was no unity of invention where the subject-matters of independent claims, including their effects, had no common inventive feature in those parts of the claims differing from the closest prior art.

In **T 861/92** the apparatus claimed was specifically adapted for carrying out only one step of the claimed process. The board came to the conclusion that the subject-matter of the claims satisfied the requirements of Art. 82 EPC 1973 as there was a technical relationship between both inventions.

In **W 9/03** the board considered whether the common problem underlying the claims could establish unity between the different inventions. The board held that a common problem could establish the unity of different inventions only under certain conditions, for example in the case of a problem invention. That was not the situation in the case at issue, however. According to the applicant, the common problem was considered that of providing a more secure, faster and easier connection setup. The board started from the

assumption that the person skilled in the relevant art would normally consider this problem. The common problem was therefore so broadly formulated that it was "itself already known or could be recognised as generally desirable or obvious" (see **W 6/90**, OJ 1991, 438); as a result, unity could not thereby be established.

5.2. Inventive character of the single general concept

R. 13.2 PCT defines the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an international application: "Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 PCT shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

Once such a single, i.e. common, concept was established, it was necessary to consider whether or not the same could contribute to the inventiveness of the various subject-matters claimed in the case. Nothing indicated that this concept was known or belonged to the general knowledge of the man skilled in the art. Since the search examiner did not indicate that the documents cited in the case could exclude such a contribution, it could not be assumed that this could not be the case (**W 17/89**; see **W 6/90**, OJ 1991, 438). In view of this, a single inventive concept had to be attributed to all claims linking all their subject-matters (see **W 22/91**).

In **W 6/90** (OJ 1991, 438; see also Chapter II.C.5.1 above) the board further noted inter alia that for the purposes of unity of invention, R. 13.1 PCT also stipulated that the single general concept had to be inventive. Even with a given single general concept there was lack of unity if the concept had no inventive character. The boards of appeal have confirmed the above decision on several occasions (see e.g. **W 31/91**, **W 29/92**, **W 34/92**, **W 45/92**, **W 8/93** and **W 6/97**).

In **W 48/90** and **W 50/90** the board noted that as far as chemical compounds were concerned, unity of invention was no mere question of the respective structural features, but had to be decided taking into account the technical problem to be solved and whether or not the respective compounds contributed to the solution found.

In **W 45/92** the board stated that the term "inventive" could not be interpreted as a requirement for the common part to be inventive per se and therefore claimable as such. The investigation in this respect should concentrate on whether or not all or some of such features could contribute to the later detailed consideration of the inventive steps. Only if the state of the art or common general knowledge which had already been taught showed, beyond reasonable doubt, that this was not possible in the circumstances, should non-unity be declared. It further held that the term "same or corresponding special technical features" recognised that the features should define a contribution to the invention vis-à-vis the prior art. As the features in question were also part of the most relevant state of the art, where they were set out in an identical manner, they could not

provide such a contribution. Thus, the various inventions, if any, had to lie in the unshared specific characterising features in each case. Since the claims contained no other common feature between them in the characterising part, this confirmed the conclusion of lack of unity (see **W 32/92**, OJ 1994, 239).

In **W 38/92** the board confirmed **W 6/90** (above) and noted that the common features in the claim groups represented the "sole concept" linking the various subject-matters. The board stated that the remaining question was whether or not any of these specific features in the claim groups or their combination could make a contribution to the inventive steps relating to each claimed subject-matter; if so, this would render the said concept linking the various subject-matters inventive. The board observed that the new R. 13 PCT also required such a contribution by the suggested common "special technical features" over the prior art, i.e. that more than novelty be provided. In **T 94/91** the board made it clear that the general inventive concept could not be equated with the features cited in a claim or in a particular combination of claims. What should be considered was the inventive concept as defined in the claims with due regard to the description and any drawings (see **W 2/95**).

In **W 9/93** the board noted that the intermediate compounds were known, so that these products could not serve as a common inventive concept, and that a technical feature contained in the process claims was also known. The board pointed out that a technical feature which already formed part of the state of the art could not, by definition, make a contribution over the prior art and did not, therefore, qualify as a unifying element within the meaning of R. 13.1 PCT. The board observed that, according to R. 13.2 PCT, as in force from 1.7.1992, an international patent application may relate to a group of inventions if there was a "technical relationship" among those inventions involving one or more of the same or corresponding "special technical features", i.e. such technical features that defined a contribution which each of the claimed inventions made over the prior art. The board went on to say that R. 13.1 PCT did not simply require some link between a group of inventions claimed in an international patent application, but a common inventive concept. This meant that there must be either a common technical problem or at least, if there was more than one technical problem, there must be one single technical concept behind the solutions of these different problems. Neither of these conditions was, however, met in this case.

In **T 957/96** the application described a number of processes which did not have any process step in common. The board found that in this case the decisive fact for the question of unity of invention was that all the processes claimed shared a common technical feature, namely the use of the substantially pure regioisomer, which was essential for solving the technical problem addressed by the application. It was this use of the intermediate compound which formed the common "inventive" concept of all the claimed process variants. In other words, this feature constituted a special technical feature which defined the contribution that the claimed invention made over the prior art as required by R. 30(1) EPC 1973.

In **W 11/99** (OJ 2000, 186) the board held that if, in an international patent application, there are claims directed to products and to a process for the manufacture thereof, it

could not be assumed that there were no corresponding special technical features within the meaning of R. 13.2 PCT simply because the process could also be used to manufacture other products.

The board interpreted the requirement for the presence of "corresponding special technical features" under R. 13.2 PCT in cases where a manufacturing process and products were being claimed in the same application to mean that they could usually be assumed to be present where the production process is new and actually suited to making the claimed products accessible (where appropriate in addition to further products). In such cases the board regards the process as being "specially adapted" to the manufacture of the claimed products. A narrower interpretation of the terms "specially adapted" and "corresponding special technical features" would not fulfil the legislative purpose of Art. 34(3) PCT and associated R. 13.1 PCT, which, in the board's view, was the same as that of Art. 82 EPC 1973, namely to prevent subject-matters which were not interconnected being claimed in one and the same application. This interpretation accorded with Annex B to the PCT Administrative Instructions mentioned in the PCT Guideline III-7.2 (July 1998 version), where it is stated in Part 1, item (e), that a process is specially adapted for the manufacture of a product if it inherently results in the product (see Annex B, paragraph (e) of the PCT Administrative Instructions, as in force from 1.7.2008). If this condition was met, it was irrelevant whether other products could be obtained using the process.

In **T 106/06** the board referred to the established case law of the boards of appeal according to which a manufacturing process and its resulting products are considered as unitary subject matter (e.g. **W 2/95** and **W 11/99**). The board gave consideration to the question as to whether the fact that claim 1 did not relate to a manufacturing process in the usual sense which may be characterised in that the specific end products are envisaged at the outset of the process, but to a process of isolating genes which, in view of its set up, has resemblance to a screening process which, in turn, may be characterised in that the final product is not known at the outset, should have an influence on the assessment of unity. The board held that the decisive question was whether the product had actually been produced by the process and not whether or not it had been known at the start of it. Therefore, there was no difference in the assessment of unity between a manufacturing process and a screening process and their resulting products.

In **W 18/01** the board pointed out that it followed from the definitions in the Regulations under the PCT and the PCT International Preliminary Examination Guidelines (which are binding on the EPO; see **G 1/89**, OJ 1991, 155, point 6 of the Reasons) that it was normally not sufficient merely to define and examine the common core of a group of inventions, for example by indicating the features which were specified in all the claims defining the inventions of the group. R. 13.2 PCT requires an examination of the technical relationship among the inventions in a group. Such a relationship may exist even if the inventions do not involve the same technical features, provided they involve corresponding special technical features. The definition of "special technical features" given in R. 13.2 PCT requires an analysis of the contribution which each of the claimed inventions makes over the prior art. This first entails analysing which of the features

distinguish the claimed inventions from the cited prior art before their contribution can be examined in the light of the description, in particular the problems solved and the effects achieved by the claimed inventions.

5.3. Unity of single claims defining alternatives ("Markush claims")

The situation involving the so-called "Markush practice" wherein a single claim defines alternatives is also governed by R. 44(1) EPC and R. 13.2 PCT. According to R. 44(2) EPC and R. 13.3 PCT, the determination of whether a group of inventions is so closely linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims, or as alternatives within a single claim (see **W 35/91**).

In **W 3/94** (OJ 1995, 775) the board had to decide whether the ISA had substantiated its findings of non-unity. It approached the issue by referring to Annex B, Part 1(f) of the Administrative Instructions under the PCT, as in force from 1.7.1992 (now Annex B, paragraph (f) of the PCT Administrative Instructions, as in force from 1.7.2008) which is concerned with the special situation of the "Markush practice". According to that section of the PCT Administrative Instructions, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in R. 13.2 PCT shall be considered to be met when the alternatives are of a similar nature. The section then specifies when alternatives are to be regarded as "of a similar nature."

In **W 1/94**, the EPO acting as ISA had found that the compounds according to the "inventions" it had identified did not have a new structural element. Nevertheless the board concluded that the absence of such an element did not automatically destroy the unity of the invention. On the contrary, it was clear from the PCT Administrative Instructions that a technical relationship must be recognised for a group of alternative chemical compounds, such as all the compounds having a common property or activity, and such a common activity existed in the case in point. The new use could therefore form the general inventive concept linking the subject-matters of the claims in accordance with R. 13.1 PCT and had to be treated as a functional characteristic linking the compounds claimed.

In **W 6/95** the board referred to the PCT Administrative Instructions which are binding not only for the ISA but also for the board of appeal acting as the "three-member board" according to R. 40.2(c) PCT (see **G 1/89**, OJ 1991, 155; in the PCT Regulations, as in force from 1.4.2005 the reference to the "three-member board" has been replaced with that to the "review body"). The board noted that it follows from Annex B, Part 1(f)(i) of the PCT Administrative Instructions (now part of Annex B, paragraph (f) PCT Administrative Instructions, as in force from 1.7.2008), that in order to establish unity of invention "a posteriori", it was not sufficient for all alternatives of chemical compounds covered by a Markush claim to have a common property or activity, i.e. be suitable for solving a common technical problem, because according to item (B)(1) they had, in addition, to have a "significant structural element" in common in order for the alternatives to form unity. The board made it clear that it was, however, not in agreement with the explanation given in Annex B, Part 1(f)(ii) PCT Administrative Instructions to assume that

the said "significant structural element" had to be novel per se. Rather, this expression meant that in relation to the said common property or activity there had to be a common part of the chemical structure which distinguished the claimed compounds from known compounds having the same property or activity (see also **W 6/97**).

In **T 169/96** the examining division was of the opinion that in the case before it such a single general inventive concept was not present, since the structural alternatives comprised by formula A, which had a common property, did not share a common significant structural element, and, according to the EPO Guidelines C-III, 7.4a, which referred to the text of R. 30 EPC 1973 (old version as in force until 31.5.1991), a common new use of known and novel chemical compounds was not in itself sufficient to establish a common inventive concept within the meaning of Art. 82 EPC 1973. The board noted that the fact that one claim also comprised a known compound, not covered by another claim 2, was of no relevance to the question of unity, because R. 30(b) EPC 1973 (old version as in force until 31.5.91; also under the version in force thereafter) did not require that there must be a common concept unifying different "means" according to it. In other words, it was not relevant in these circumstances that the three different classes of chemical compounds identified by the examining division comprised completely different chemical structures of a residue. The board observed that the above-mentioned Chapter of the Guidelines, as well as Annex B, Part 1(f) of the PCT Administrative Instructions (this corresponds to Annex B, paragraph (f) of the PCT Administrative Instructions, as in force from 1.7.2008) concerning the examination of unity of invention of so-called Markush-type claims rightly stated that the said significant structural element might consist of a combination of individual components linked together. It was not stated there that the combination of individual structural elements had to be novel per se, nor did such a requirement follow from Art. 82 EPC 1973. Rather it followed from that guideline that this expression meant that in relation to the said common property or activity there had to be a common part of the chemical structure which distinguished the claimed compounds from known compounds having the same property or activity. In the present case no state of the art was cited which related to chemical compounds which were known to be useful for the production of polymeric compositions of enhanced oxidative stability. The combination of the peroxide group and the residue "An" which was responsible for conferring the oxidative stability, however, distinguished the compounds of claim 2 from all chemical compounds conventionally used as antioxidants in polymeric compositions, on the one hand, and from all compounds conventionally used as polymerisation initiators, on the other hand.

In **W 4/96** (OJ 1997, 552) the board of appeal noted that the requirement of a technical relationship as defined in R. 13.2, first sentence, PCT might be met when all claimed alternatives belong to a class of compounds which might be expected to behave in the same way in the context of the claimed inventions ("Markush claims"). The technical relationship involved those common special technical features that defined a contribution over the state of the art (R. 13.2, second sentence, PCT; see also **W 6/96**). However, such contribution could not be recognised on the basis of this expectation if members of the class had already been shown in the prior art to behave in the manner disclosed in the application. The board added that if at least one Markush alternative was not novel over the prior art, the question of unity had to be reconsidered by the examiner, i.e. a

posteriori (see Annex B, Part I (f)(v) PCT Administrative Instructions in conjunction with PCT Search Guidelines; Annex B, Part I PCT Administrative Instructions has become Annex B of the PCT Administrative Instructions, as in force from 1.7.2008; Part II (examples) can now be found in the PCT International Search and Preliminary Examination Guidelines, as in force from 25.3.2004).

The board also held that an objection of lack of unity could be raised a posteriori with regard to all categories of grouping of alternatives of chemical compounds. An a posteriori assessment of unity had to be made in all circumstances in the same way, since the legal requirement of R. 13 PCT was the same for all cases. Therefore, the a posteriori assessment of unity in cases of a functional relationship within a group of compounds had to be made in a manner corresponding to the assessment in cases of a structural relationship. This was appropriate for compounds related by their structure as well as for compounds related by their function. The structural relationship within the meaning of Annex B, Part I (f)(i)(B)(1) and the relationship within the meaning of Annex B, Part I (f)(i)(B)(2) and (iii) served the same purpose: both tests were intended to show whether the alternative compounds were of a similar nature, as was said in the introductory part of Annex B, Part I (f)(i). These tests were only tools in order to determine whether there was unity of invention as defined in R. 13 PCT.

6. Plurality of inventions and further search fees

6.1. Consequences of non-payment of a further search fee

If the search division raises the objection of lack of unity of invention a further search fee must be paid in accordance with R. 64(1) EPC (R. 46(1) EPC 1973; unchanged in substance) or Art. 17(3)(a) PCT for each invention involved. If the fee is paid in due time the applicants may select the single invention or group of inventions they wish to retain in the main application.

The consequences of non-payment of the further search fee for the procedure for the grant of a European patent have been the subject of conflicting interpretations on the part of the boards. While it was stated in **T 178/84** (OJ 1989, 157) that in the case of non-payment of the further search fee under R. 46(1) EPC 1973 the subject-matter not searched was regarded as abandoned and accordingly could not be pursued in the parent application, in **T 87/88** (OJ 1993, 430) it was expressly stated that non-payment could not result in abandonment. The board stated that non-payment of the further search fee in no way prejudiced the future legal fate of the unsearched parts and that R. 46(1) EPC 1973 merely provided that in the case of non-payment of further search fees the search division was to draw up a European search report only for those parts of the application that related to the invention for which the search fees had been paid.

The President of the EPO therefore referred the following point of law to the Enlarged Board of Appeal:

"Can an applicant who fails to pay further search fees for a non-unitary application when requested to do so by the search division under R. 46(1) EPC 1973 pursue that

application for the subject-matter in respect of which no search fees have been paid or must he file a divisional application for it?"

In **G 2/92** (OJ 1993, 591) the Enlarged Board of Appeal decided that the application could not be pursued for subject-matter in respect of which the applicants had not paid the further search fees. Instead the applicants had to file a divisional application for that subject-matter if they wished to continue to protect it. In the view of the Enlarged Board, it was clear from the procedural system of the EPC 1973 that the invention which was to be examined for patentability had to be an invention in respect of which a search fee had been paid prior to the drawing up of the European search report. Part IV of the EPC 1973 envisaged that an application progressed after filing from the search division to the examining division. One object of R. 46 EPC 1973 was to implement this procedure by ensuring that an appropriately extensive search was completed in respect of each individual application before it was examined by the examining division. To this end, in response to an invitation from the search division to pay one or more further search fees in respect of one or more further inventions to which the application related, applicants had to pay such further search fees if they wished to ensure that one of the further inventions could become the subject of the claims of that application. That was the proper interpretation of R. 46(1) EPC 1973 in context. This confirmed the practice according to **T 178/84**.

In **T 319/96** the initial application lacked unity, but no further search fee was paid. The applicant took the view that, because of the international-type search (Art. 15(5)a) PCT) carried out by the EPO for the subject-matter of the original claims 4 to 10, it had not forfeited its right to choose and could therefore continue pursuing this subject-matter. It had paid a search fee for each of the two inventions, and two search reports had been prepared by the Office. Since the appellant insisted on pursuing the second invention further, the application was refused under Art. 97(1) EPC 1973 in conjunction with Art. 82 and R. 46 EPC 1973.

The board stated that, under R. 46(1) EPC 1973, a search fee was to be paid for each further invention if the European search report was to cover that invention. It was true that an international-type search report had been drawn up under Art. 15(5)a) PCT for the subject-matter of the second invention in the context of another procedure, i.e. the national procedure for the purpose of establishing priority; however, this could not simply replace the European search report. R. 46 EPC 1973 did not provide that a search report from another procedure could be substituted for the European search report. Rather, the Rules relating to Fees (RFees) provided that a search report on the same subject-matter, if prepared by the Office outside the context of the European grant procedure acting in a different capacity on the basis of other treaties, should be taken into consideration in so far as the European search fee was partly or wholly refunded (Art. 10(2) RFees). The restitution was therefore made by "rolling back", not by waiving the European search fee. For this reason, R. 46 EPC 1973 did indeed apply here, and the appellant would have been obliged to pay the further search fee in order to retain the option of pursuing the second invention in the application at issue.

In **T 631/97** (OJ 2001, 13) the board held that R. 46(1) EPC 1973 on its proper interpretation does not prohibit a review by the examining division of the search division's opinion on lack of unity of invention where further search fees are not paid. A narrow interpretation of R. 46(1) EPC 1973 whereby the finding of lack of unity of invention by the search division is considered as final where the additional search fees are not paid would deprive the applicant of an opportunity to dispute the finding of the search division during the examination proceedings and would also unjustifiably restrict the power of the examining division on the question of unity of invention to the subject-matter for which search fees were paid. Thus the board did not share the view held in **T 1109/96**. The board found that the above interpretation of R. 46(1) EPC 1973 was in agreement with that of the Enlarged Board of Appeal in Opinion **G 2/92**. It also found that the Guidelines were fully consistent with **G 2/92** and R. 46 EPC 1973.

The board noted that the practice of search and examination of international applications under the PCT where the EPO was elected or designated office was also consistent with the above view: R. 112 EPC 1973 which entered into force on 1.3.2000 (OJ 1999, 660–667) required the EPO to examine the requirement of unity of invention of an international application entering the EPO as a Euro-PCT application also where the ISA considered that the application did not comply with the requirement of unity of invention (R. 13.1 and R. 13.2 PCT), and the applicant did not pay additional search fees according to Art. 17(3)(a) PCT. R. 112 EPC 1973 has been renumbered as R. 164 EPC and contains substantial amendments.

6.2. Dispensing with further search fee

In **W 36/90** and **W 19/89** the board observed that where there was lack of unity in an international application, in particular if the objection was evident a posteriori, the search examiner might decide to supplement the international search with a search on the additional inventions as well as on the first invention. This was so particularly if the concepts of the inventions were very close and none of them required a search in different classification units, so that the search could be performed for all the inventions without creating too much extra work (see PCT Search Guidelines as agreed upon by the Interim Committee for Technical Cooperation at its seventh session in Geneva in October 1977, PCT/INT/5). In such a case no objection of lack of unity should be raised because charging further fees would be incompatible with the principle of equity vis-à-vis the applicant (see **G 1/89**; for searches of additional inventions without payment of fees, see paragraphs 10.64-10.65 of the PCT International Search and Preliminary Examination Guidelines, as in force from 25.3.04 and Guidelines for Examination (April 2010), Part B, Chapter VII, paragraph 2.3).

6.3. Further invitations to pay additional search fees

A procedural change introduced with the EPC 2000 concerns the payment of supplementary search fees in case of non-unity. Under the provisions of the EPC 1973 the applicant was able to pay, on entry into the European phase, additional search fees for inventions not searched in the PCT phase (R. 112 EPC 1973). Under the new provisions, the applicant has to pay for the supplementary search which is always

performed unless the EPO was the International Searching Authority, but can no longer pay for additional searches in respect of inventions that were not searched during the international phase (R. 164 EPC). With regard to the latter ones, divisional applications can be filed after entry into the European phase.

III. AMENDMENTS

This chapter concerns Art. 123(2) and (3) EPC. Other aspects of amendments are dealt with elsewhere; see for example Chapters IV., divisional applications, V.B.1.2, priority; VII.B.1.3, 2.3, 2.4, 2.5, 2.10, 3.4, 3.7, 3.8, examination procedure; VII.D.4, opposition procedure; VII.E.16, appeal procedure.

A. Article 123(2) EPC

According to Art. 123(2) EPC the European patent application or the European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. The revision of the EPC has introduced a purely editorial change to the wording of Art. 123(2) EPC to bring it into line with Art. 123(1) EPC. However, Art. 123(2) EPC 1973 and Art. 123(2) EPC are substantively the same.

1. General issues

Regarding the concept of the content of the application, **G 11/91** (OJ 1993, 125) laid down that it related to the parts of the European patent application which determined the disclosure of the invention, namely the description, the claims and the drawings. It was reaffirmed that the description, claims and any drawings in the application documents determined the content of the application as filed (**G 2/95**, OJ 1996, 555; **T 382/94**, OJ 1998, 24).

In addition, as pointed out in **T 860/00**, the disclosure implicit in the patent application - i.e. what any person skilled in the art would consider necessarily implied by the patent application as a whole (e.g. in view of basic scientific laws) - is relevant for the requirements of Art. 123(2) EPC 1973 (see also **T 1772/06**).

In **T 246/86** (OJ 1989, 199) the board decided that as the abstract was intended solely for documentation purposes and did not form part of the disclosure of the invention, it could not be used to interpret the content of the application for the purposes of Art. 123(2) EPC 1973 (solution confirmed in **T 606/06**). For the purpose of Art. 123(2) EPC 1973, "the content of the application as filed" also did not include any priority documents, even if they were filed on the same day as the European patent application (**T 260/85**, OJ 1989, 105).

Concerning the content of the application as originally filed, the board in **T 1018/02** stated that although a claim was not to be interpreted in a way which was illogical or did not make sense, the description could not be used to give a different meaning to a claim feature which in itself imparted a clear, credible technical teaching to the skilled reader. That also applied if the feature had not initially been disclosed in the form appearing in the claim.

In **T 605/93** the board held that where the application documents of the European application as filed were a translation of the international application as it was filed, the content of the "application as filed" (for the purpose of Art. 123(2) EPC 1973) was that of

the international application as it was filed. In all normal circumstances, it ought however to be assumed that the published European application was identical in content with the published international application.

In **T 658/03** the board stated that any change of attribution of claimed subject-matter in an application or patent having different (sets of) claims for different contracting states, to a contracting state under which that subject-matter was not previously included, amounted to an amendment within the meaning of Art. 123 EPC 1973. Such an amendment was subject, in principle, to full examination as to its conformity with the requirements of the Convention.

In **T 382/94** (OJ 1998, 24) a European patent application was filed with a description and claims in German, accompanied by 25 drawings. Three of the drawings contained so-called flow sheets with text matter in English. The application was published in this form.

In the light, at the time of its decision, of Art. 80(d) EPC 1973, Art. 14(1) and (2) EPC 1973 and Art. 91 EPC 1973 together with R. 43 EPC 1973, the board ruled that the accordance of a date of filing could relate only to the whole of the application documents. It appeared to be alien to the Convention not to consider certain parts of the description, claims or drawings actually filed on the date of filing to be part of the documents as filed. The amendment of the application, based on the English-language text matter in the drawings as filed, did not represent an infringement of Art. 123(2) EPC 1973.

In **T 287/98**, the word "scrap" originally comprised in the disputed passage of the English version of the application, which means "refuse or waste in general" had been replaced in claim 1 by "scrap metal". The original application in Dutch contained the word "schroot", which means scrap metal, as substantiated by the copies of various dictionaries provided by the appellant. According to the board, this word was not correctly translated into English and nothing other than "scrap metal" was meant in the application as originally filed. The board further decided that the replacement of the word "scrap" by "scrap metal" was allowable under Art. 123(2) EPC 1973 since Art. 70(2) EPC 1973 provided that in a case referred to in Art. 14(2) EPC 1973, i.e. in which the European patent application was filed in a language of a contracting state other than English, French or German, the original text had to be taken into account in proceedings before the European Patent Office, in order to determine whether the subject-matter of the application extended beyond the content of the application as filed.

In **T 23/02**, the board said that although the claims as originally filed contained no reference to a method of measurement for the average particle diameter, that did not mean that any method could be used to determine that parameter. If anything, the claims raised doubts as to how the average particle diameter had to be determined, in particular because the skilled person would be aware of the fact that the method of measurement was of a decisive nature in particle size analysis. Therefore the skilled person would use the description and drawings when deciding how the average particle diameter was to be measured, and would come to the conclusion that when properly interpreted in the light of the original description, the claims as originally filed already contained restrictions as to the method of measurement for the average particle diameter of the various particles.

Furthermore, the method of measurement for the average particle diameter did provide a technical contribution because it affected the actual value of that parameter.

In **T 500/01** the board stated that a claim, the wording of which was essentially identical to a claim as originally filed, could nevertheless contravene the requirements of Art. 123(2) EPC 1973 if it contained a feature whose definition was amended in the description in a non-allowable way. The specific definition of a feature which according to the description was an overriding requirement of the claimed invention was applied by a skilled reader to interpret that feature whenever it was mentioned in the patent. Since in this case the definition had no basis in the application as filed, claim 1 did not meet the requirements of Art. 123(2) EPC 1973.

The appeal in **T 1228/01** lay from the examining division's decision to refuse the European patent application entitled "Method of preparation and use for zona pellucida antigens and antibodies for sterilization and contraception" because it contained subject-matter which extended beyond the content of the application as filed, contrary to Art. 123(2) EPC 1973. The appellants inferred that the reference to a deposited phage in a claim, whose correct deposit was mentioned in the application as originally filed, was an implicit disclosure of a part of a nucleotide sequence contained in the phage, although the sequence was not disclosed per se. Reference was made to **T 301/87**, whose conclusions also applied here and in which it had been decided that if an entity itself was disclosed to the skilled person, this did not necessarily mean that a component part was also disclosed for the purpose of priority if this could not be envisaged directly and unambiguously as such and required considerable investigation to reveal its identity. Thus in **T 1228/01** the board stated that the disclosure in the application as originally filed of the deposition of the recombinant bacteriophage Lgt11-P3 was not considered to be a basis within the requirements of Art. 123(2) EPC 1973 for the disclosure of a DNA sequence designated as "the P3 coding sequence" which was allegedly contained in that bacteriophage, but which as such was not disclosed in the application as originally filed.

In **T 792/94** the board ruled that since the teaching of claim 1 as amended was ambiguous (Art. 84 EPC 1973), allowing scope for an interpretation which extended beyond the overall teaching of the initial application, the amendment contravened Art. 123(2) EPC 1973.

Decisions **T 673/89** and **T 685/90** prohibited the later inclusion of **equivalents**. **T 673/89** concerned a dual circuit braking system. The board held that the mere fact that the original claim did not indicate how the signals were transmitted in the brake circuits was not a basis for deliberately supplementing its teaching with a further embodiment not referred to in the application documents as originally filed. In **T 685/90** the board stated that specific equivalents of explicitly disclosed features did not automatically belong to the content of a European patent application as filed, when this content was used as state of the art according to Art. 54(3) and (4) EPC 1973 against a more recent application. It therefore concluded that such equivalents could not belong to the content of a European patent application either, when this content was assessed to determine whether an amendment was admissible under Art. 123(2) EPC 1973. In **T 265/88** the board refused to allow originally undisclosed equivalents to be added by using a wider

technical term in place of the single technical means originally disclosed. **T 118/88** had concluded that the obviousness of a feature was no replacement for the original disclosure.

In **T 40/97** the board considered what the originally filed application taught the person skilled in the art and took the view that in a case where a number of generally similar embodiments were discussed in equivalent terms, the person skilled in the art would, in normal circumstances and when nothing pointed to the contrary, notionally associate the characteristics of an element of one embodiment described in some detail with the comparable element of another embodiment described in lesser detail.

In **T 243/89** the applicant had originally claimed a catheter only for medical use; during examination proceedings he filed a further claim for its manufacture. The board of appeal saw no reason to refuse the filing of an additional method claim for forming the apparatus, in view of the similar wording and thus of the close interrelationship between both independent claims. Since the result of the activity was in itself patentable, such methods were also patentable unless the disclosure was insufficient.

In **T 157/90** and **T 397/89** it was stressed that it was insufficient for the generalisation of a feature to have only formal support in the application as filed. If, for example, the application as filed only described specific embodiments, and the feature's general applicability was not evident to the skilled person, then generalisation could not be allowed.

In **T 906/97** the board stated that an a posteriori demonstration that the original claims, considered in isolation from the rest of the application documents, could possibly be construed in such a way as to cover a specific type of apparatus failed to provide convincing evidence that such specific apparatus was actually disclosed to the skilled person.

In **T 770/90** the board ruled that an unduly broad claim not supported by the description as originally filed was not a suitable "reservoir" for amendments. On the issue of Art. 123(2) EPC 1973, the board stated in **T 296/96** that the content of a document was not to be viewed as a reservoir from which features pertaining to separate embodiments could be combined in order to artificially create a particular embodiment. When assessing whether a feature had been disclosed in a document, the relevant question was whether a skilled person would seriously contemplate combining the different features cited in that document. That was not the case in the application as filed.

In **T 54/82** (OJ 1983, 446) the board held that an objection under Art. 123(2) EPC 1973 did not necessarily arise when an amendment was proposed which involved combining separate features of the original subject-matter of an application. When considering whether different parts of the description in an application could properly be read together, the state of the art might also be taken into account.

Expanding on **T 13/84** (OJ 1986, 253) it was stated in **T 547/90** and **T 530/90** that reformulating the technical problem was not in breach of Art. 123(2) EPC 1973 provided

the problem as clarified and the solution proposed could have been deduced from the application as a whole in the form originally filed.

Decision **T 784/89** (OJ 1992, 438) ruled on a computer-controlled method of producing NMR images disclosed explicitly in the documents as filed. By reference to another patent application an apparatus was implicitly disclosed comprising a programmable component which, when suitably programmed, was used for the claimed method. The board considered that only this specific combination had been disclosed. To claim an apparatus for carrying out a method was considered an inadmissible extension of the European patent application because the claim covered apparatus which could also be used in other methods and to achieve other effects. The only allowable claim was for an apparatus for carrying out a method comprising a programmable component which could be suitably programmed to carry out the method.

In **T 526/92** the patent related to an additive concentrate having a high TBN of at least 235 for incorporation in a lubricating oil composition. The application as filed contained no explicit reference to TBN apart from the examples where 235 was the lowest value mentioned. The feature "having a high TBN of at least 235" was introduced during the examination proceedings to distinguish the claimed subject-matter from compositions with low TBN values up to 100 disclosed in a citation. The board revoked the patent on the grounds that it breached Art. 123(2) EPC 1973, stating that the precondition of the disclaimer had not been met (see **G 1/03** concerning law now applicable to disclaimers in Chapter III.A.4 below).

In this case, TBN values had not been originally disclosed as a "broad" range but only as single, punctate values; thus a new range was defined which had not been disclosed originally. Furthermore, the generic part of the original specification did not contain any information indicating that TBN played any role in the framework of the application in suit. This meant that there was also no information whatsoever concerning a TBN range, whether open-ended or not. Nor was there any information at all in the description regarding the contribution of a TBN to the solution of a technical problem. Moreover, it could not be concluded that the individual TBN values disclosed in the examples were representative of a TBN range starting at 235 and without any upper limit. The board held that if values of a parameter are only given in the examples, without the significance of this parameter becoming evident from the original specification, no range must be arbitrarily formed, which is open ended at one side and has one limit selected from the examples.

T 201/83 (OJ 1984, 481) and **T 17/86** (OJ 1989, 297) started from the assumption that a limitation could also constitute an inadmissible extension of the subject-matter of the application. In **T 201/83**, however, the board came to the conclusion that the amendment of the concentration range for a component of a claimed alloy was admissible on the basis of a value described in a specific example since the skilled person could have readily recognised that this value was not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention to a significant degree. The new limit could therefore be deduced from the original documents. In **T 17/86** the examining division took the view that, although the

introduction into a claim of a particular technical feature constituted a limitation, it nevertheless contravened Art. 123(2) EPC 1973 since the feature concerned had been described in the application solely in association with another feature not included in the claim. The board, however, stated that the application as filed unmistakably showed that the combination of technical features in the new claim thus amended was sufficient to produce the result sought in the application.

In **T 433/01** the board's view was that the second auxiliary request would in all probability also have failed to meet the requirements of Art. 123(2) EPC 1973 because it did not satisfy the criterion derived from **T 201/83** (OJ 1984, 481) that for a generalisation based on a value described in an example to be admissible, that value had to be manifestly independent of the other features of the example in terms of the relevant technical properties.

The board in **T 876/06** suggested that according to EPO practice, as stated for instance in **T 201/83**, an amendment of a concentration range in a claim for a mixture is allowable on the basis of a particular value described in a specific example, if the skilled person could have readily recognised this value as not so closely associated with the other features of the example as to determine the effect of the invention as a whole in a unique manner and to a significant degree. Applying this principle, the board said that it had to be decided in the case at issue whether or not the weight ratio of liquid rubber to solid rubber set out in several examples was in this sense closely associated with the other features of these examples. The board came to the conclusion that the skilled person could have recognised in the application as originally filed that the weight ratio of liquid rubber to solid rubber was not so closely associated with the other features of the examples as to determine the effect of the invention as a whole in a unique manner and to a significant degree. Thus, in the board's judgment, in the case at issue it was permissible to use the particular value used in several examples to limit the range of the weight ratio of liquid rubber to solid rubber. The limitation of the claim represented merely a quantitative reduction of a range to a value already envisaged within the document and not an arbitrary restriction providing a technical contribution to the subject-matter of the claimed invention in accordance with point 10 of the Reasons in **T 201/83**. The board also found incorrect the argument of the respondent/opponent that the amendment in **T 201/83** was only considered allowable because it represented the lowest value disclosed with regard to the then claimed invention. In the board's view this fact played no role at all. Nor did the board agree with the argument that decision **T 201/83** had been overruled by later decisions of the Enlarged Board of Appeal. The requirements of Art. 123(2) EPC 1973 were fulfilled.

The board decided in case **T 184/05** relating to Art. 123(2) EPC that an impurity concentration value of a product obtained under specific process conditions could not be taken in strict isolation from the examples unless it had been demonstrated that this value was not so closely associated via the applied process with specific (undisclosed) maximum values of all other impurities comprised in the product.

In **T 570/05** the invention related to a solar-control coated substrate with high reflectance, and the proposed amendment read as follows: "*...the ... coating layer has a*

thickness of from 220 to 500 nm", for which the only literal basis in the application as originally filed for the lower value of 220 nm of the claimed coating thickness range was to be found in examples 18, 21 and 25. The formal disclosure of the value "220" already existed ; the issue to be decided was whether or not new subject-matter was added by forming a **new range** in a claim using said figure of 220 nm, it being evident that nowhere in the documents as filed did said value form the lower (or indeed any) endpoint of a range of thicknesses. Recalling the relevant case law namely, **T 201/83**, **T 1067/97** and **T 714/00**, dealing with extracting an isolated feature, the board examined whether or not there existed a functional or structural relationship between the coating layer thickness, in particular its lower limit, and the remaining features of the claim. The board concluded that the condition of absence of any clearly recognisable functional or structural relationship under which an isolated extraction of a feature of an example would be allowable under Art. 123(2) EPC according to the relevant case law was not satisfied in the present case.

In **T 727/00** the board held that the combination - unsupported in the application as filed - of one item from each of two lists of features meant that although the application might conceptually comprise the claimed subject-matter, it did not disclose it in that particular individual form. For that reason alone, claim 1 of the main request was not supported by the description.

Although the selection of explicitly disclosed borderline values defining several (sub)ranges, in order to form a new (narrower) sub range, is not contestable under Art. 123(2) EPC when the ranges belong to the same list, the combination of an individual range from this list with another individual range emerging from a second list of ranges and relating to a different feature is not considered to be disclosed in the application as filed, unless there is a clear pointer to such a combination (**T 1511/07**).

Contrary to the appellant/patent proprietor's allegation, the board in **T 1374/07**, referring to **T 811/96**, said that a selection of two components from one list is in fact equivalent to a twofold selection from two identical lists.

According to the boards' consistent case law, the guiding principle is that deleting meanings of residues must not lead to the selection, in the respective lists, of a particular combination of single, specific but originally undisclosed meanings of residues (see **T 615/95** and **T 859/94**).

In **T 942/98**, precisely this had occurred through the deletion of all other meanings, residues X1, X2 and R5 had been narrowed down to a single meaning, leading to a combination of specific meanings of residues not disclosed in the application as filed. Consequently, claim 1 as filed did not in itself provide adequate support for claim 1 as amended.

In **T 615/95** there were three independent lists of sizeable length specifying distinct meanings for three residues in a generic chemical formula in a claim. One originally disclosed meaning was deleted from each of the three independent lists. The board stated that the present deletions did not result in singling out a particular combination of

specific meanings, i.e. any hitherto not specifically mentioned individual compound or group of compounds, but maintained the remaining subject-matter as a generic group of compounds differing from the original group only by its smaller size. Such a shrinking of the generic group of chemical compounds was not objectionable under Art. 123(2) EPC 1973, since these deletions did not lead to a particular combination of specific meanings of the respective residues which was not disclosed originally or, in other words, did not generate another invention (see also **T 948/02**, which refers in detail to the case law on the deletion of one originally disclosed meaning and which did not allow the amendment of a generic chemical formula; see also **T 659/97** and **T 894/05**).

The board in **T 1146/01** had to answer the question of whether one measurement of a selected characteristic or property of a sample disclosed only in an individual example could be relevant to the generality of the claimed subject-matter, separately from and irrespectively of the other parameters inherent to the same sample. The situation in this case was different from the case in **T 201/83**. In **T 201/83** an amendment was allowed on the basis of a particular value described in a specific example, provided the skilled person could readily have recognised that value as not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention as a whole in a unique manner and to a significant degree. In **T 1146/01**, however, the board stated that formulating a new range on the basis of individual values taken from selected examples, which were not at all directly related to each other, meant that the reader was confronted with new information not directly derivable from the text of the application as originally filed.

In **T 653/03**, the original term "diesel engine" in claim 1 was replaced by the term "combustion engine". Thus the suitability of the claimed method was generalised to any type of combustion engine. The board decided that the treatment of exhaust gas in the original application was always related to a diesel engine, and it could not be inferred by the skilled person that the subject-matter of the granted patent extended to a method which was suitable for any type of combustion engine. The technical contribution was that the amended method was suitable for any type of combustion engine, whereas in the original form it was suitable only for a diesel engine. The generalisation was not admissible.

In **T 1241/03**, in view of the general disclosure of the application as filed, the reference in a claim to a combination of compounds in specific concentrations, explicitly disclosed in different passages of the application, was not considered by the board to be an amendment of the patent which extended beyond the content of the application as originally filed.

In **T 1067/02** the board came to the conclusion that the unclear nature of the amendment introduced upon grant in claim 1 as filed, i.e. the introduction of the term "complete", allowed two different interpretations and, although they were both technically sensible, neither of them was directly and unambiguously derivable from the general disclosure of the application as filed. Consequently, claim 1 of the main request extended beyond the overall teaching of the application as originally filed.

In **T 1239/03**, it was not in dispute between the parties that no part of the patent contained a definition of the ethylene content of the elastomeric copolymer in terms of weight percent. Prior to the amendment, preference was given to the interpretation "mol percent", which, with the deletion of example 3, had shifted towards "weight percent". In the board's view, Art. 123(2) EPC 1973 was to be interpreted as referring to the patent (or application) as a whole, rather than to the claims only. This was directly suggested by the clear wording of the Article. Hence it was not crucial in which part of the patent (or application) an amendment had been carried out, but only whether the overall change in the content of the patent (or application) resulted in the skilled person being presented with information which was not clearly and unambiguously set out in the originally filed application, even when account was taken of matter which was implicit to a person skilled in the art. In such a case, where it was certain that a shift in the interpretation of the claims had occurred, but doubts nevertheless existed, the board took the view that it should be incumbent upon the patent proprietor or applicant as the author of such amendment(s) to demonstrate that the requirements of Art. 123(2) EPC 1973 were complied with in making them.

In the case at issue, the patent proprietor was unable to show that the percentage value could have been consistently interpreted as "weight percent" before and after the amendments. This led to the conclusion that the author of the amendments in the patent in suit, i.e. the respondent, had not discharged the burden of proof which rested upon him. In the specific circumstances of this case, the deletion of the two examples in order to exclude the possibility of interpreting the relevant percentage as mol percent provided a lateral shift of information corresponding to the extension of subject matter beyond the content of the application as filed.

T 97/05 concerned an amendment of a claim resulting in a shift in the information provided by examples. During the opposition proceedings, claim 1 was modified by replacing the term "chemically" with "covalently" in order to specify the nature of the bond between the anionic groups and the core. The board held that in examining an amendment for compliance with the requirements of Art. 123(2) EPC 1973 it was necessary to consider not only the claims but also other parts of the application or patent, i.e. the description and examples. The information provided by the description was that the bonding between the core and the anionic group was "chemical" and that one type or species of "chemical" bonding was "covalent". The term "chemically bonded" as employed in the general description of the application as filed encompassed, but did not specifically disclose, compounds in which the anionic moieties were "covalently" bonded to the core.

The board came to the conclusion that as a consequence of the amendment of the claims the information content of the general part of the description was changed compared to the information content of the application as filed. The bonding between the core and the anionic groups in the activated catalyst compositions was no longer defined generically as "chemical" but was now more narrowly and specifically defined as being a species of "chemical", namely "covalent". The examples did not discuss or otherwise elucidate - even by implication - the nature of the bonding between the core and the anionic groups in the resulting polyionic compounds. This was not disputed by the patent

proprietor. The information provided by the examples in this respect was no more specific than that of the description, i.e. did not provide any restriction of the type of bonding to a particular species of bonding encompassed by the term "chemical". In the board's view a consequence of the amendment of the claims by replacement of the generic term "chemically bonded" by the specific term "covalently bonded" was that the examples of the patent acquired by association information, i.e. that the anionic groups were covalently bonded to the core, which was not - even implicitly - contained by the same examples in the application as filed. Thus there was a shift in the information provided by the examples in the patent as amended according to the main request compared to that provided by the same examples in the application as filed, even though the examples themselves had not been modified (by analogy with **T 1239/03**). Therefore the main request did not meet the requirements of Art. 123(2) EPC 1973.

2. Intermediate generalisation - non-disclosed combinations

The case law of the boards of appeal has to consider what happens when an amendment concerns taking features out of their initial context and combining them with others. The boards of appeal have had to decide under what conditions the resulting amendments fulfilled the requirements of Art. 123(2) EPC. In decisions **T 1408/04** and **T 461/05**, for instance, the expression "intermediate generalisation" was used in this context.

In **T 1067/97** the board confirmed that if a claim was to be restricted to a preferred embodiment, it was normally not admissible under Art. 123(2) EPC 1973 to extract isolated features from a set of features which had originally been disclosed in combination for that embodiment. An amendment of this nature would only be justified in the absence of any clearly recognisable functional or structural relationship among said features.

In **T 284/94** (OJ 1999, 464) the board stated that an amendment of a claim by the introduction of a technical feature taken in isolation from the description of a specific embodiment was not allowable under Art. 123(2) EPC 1973 if it was not clear beyond any doubt for a skilled reader from the application documents as filed that the subject-matter of the claim thus amended provided a complete solution to a technical problem unambiguously recognizable from the application. Nor was an amendment allowable under Art. 123(2) EPC 1973 which replaced a disclosed specific feature either by its function or by a more general term and thus incorporated undisclosed equivalents into the content of the application as filed.

In **T 714/00** the board stated that extracting an isolated feature from an originally disclosed combination and using it to delimit claimed subject-matter could only be allowable in connection with Art. 123(2) EPC 1973 if that feature was not inextricably linked with further features of that combination.

With regard to isolation and extraction of combined features, **T 25/03** first recalled that according to the established case law of the boards of appeal, if a claim was restricted to a preferred embodiment, it was normally not admissible under Art. 123(2) EPC 1973 to

extract isolated features from a set of features which had originally been disclosed in combination for that embodiment. That kind of amendment would only be justified in the absence of any clearly recognisable functional or structural relationship among said features (see for example **T 1067/97**). In the case at issue the board concluded that since claim 1 resulted from the extraction of isolated steps from the specific combination disclosed as essential in the embodiment of Figure 4, and since the appellant had not referred to other parts of the application as filed that could support the proposed amendment, and no such parts had been identified by the board, claim 1 as amended in accordance with the first auxiliary request did not meet the requirements of Art. 123(2) EPC 1973.

In **T 582/91**, the respondent (opponent) was of the opinion that when restricting a granted claim by introducing subject-matter from the dependent claims all the features of the dependent claims in question should be incorporated in the new independent claim. Contrary to this opinion the board considered that one feature of a dependent claim could be readily combined with a preceding independent claim as long as the skilled person recognised that there was clearly no close functional or structural relationship between the one feature of that dependent claim and its other features, or between that one feature and the teaching of other dependent claims referred to in that dependent claim. If this was the case, no objections under Art. 123(2) EPC 1973 arose (confirmed in **T 938/95**; see also **T 288/89**).

In **T 3/03** the board decided that an amendment consisting in the generalisation of an effect obtained for particular embodiments was not admissible. In the case in point, the results obtained for particular embodiments could not be generalised since the particular circumstances of use, including the type of additive used, determined whether or not filterability was improved.

In **T 1408/04** concerning an absorbent interlabial device, the respondent/opponent alleged inter alia that the terminology introduced into claim 1 was an intermediate generalisation of the original disclosure, since a topsheet defining the top surface and a backsheet defining the opposite surface was only disclosed in the embodiment of Figures 1 to 3 and was not generally applicable to the broad definition of the device according to the other features of claim 1. The board stated that the terminology introduced into claim 1 according to the main request was not disclosed expressis verbis in the filed application. From the broad range of topsheet/backsheet structures within the scope of claim 1 as granted, a specific selection had now been made. The board considered that, to avoid an **intermediate generalisation** (i.e. an undisclosed combination of selected features lying somewhere between an originally broad disclosure and a more limited specific disclosure), all the necessary features of the specific selection must be included in the claim. The selection in this case came from the drawings, which, however, also showed a particular (albeit commonly used) type of topsheet/backsheet connection. This particular connection was lacking in the claim. Thus an intermediate generalisation was present. The board disagreed not only with the appellant's understanding of what "the claims must be interpreted by a 'mind willing to understand'" meant, but also concluded that the amendment to claim 1 resulted in an

intermediate generalisation of the original disclosure and therefore that the subject matter of claim 1 did not meet the requirements of Art. 123(2) EPC 1973.

With regard to the third auxiliary request, concerning the respondent's objection under Art. 123(2) EPC 1973 on the basis of the alleged presence of an intermediate generalisation, the board in **T 1408/04** concluded that the particular definition of the topsheet/backsheet sealed connection was not a generalisation of the content of the originally filed application. Whilst it was correct that Figures 1 to 3 represented a preferred embodiment, it was clear that they represented only a "preferred" embodiment of one way of assembling the topsheet, backsheet and core. In fact this was the only way which was clearly and unambiguously disclosed. The skilled person would immediately realise that the specific topsheet/backsheet sealed configuration as shown in the Figures was generally applicable also to other aspects of the invention and was not limited only to the set of features shown in Figures 1 to 3. In this regard, the other elements present in these Figures were not inextricably linked to the topsheet/backsheet sealed configuration, as also confirmed by the description, which categorised these features as optional. Thus the skilled person understood unambiguously that these features were not part of the topsheet/backsheet structure, and could be omitted from the embodiment in Figures 1 to 3. The topsheet/backsheet structure as specifically indicated in the Figures and as defined in claim 1 of this request was consequently applicable generally to the invention as defined by the other features in claim 1. Therefore, the requirements of Art. 123(2) EPC 1973 were met.

In **T 461/05**, according to the examining division which had refused the patent application, claim 4 concerned generalisations of particular embodiments, each of which constituted an indissociable bloc, which extended the subject matter of the application beyond its original content, contrary to the requirements of Art. 123(2) EPC 1973. The board ordered that the decision be set aside. The board in this case found that claim 4 as amended defined subject matter which was less general than that defined by claim 1 in the original version but more general than the particular embodiment corresponding to case 2a as disclosed in the description and the subject matter of claim 6 as originally filed. Claim 4 thus represented a generalisation, also referred to in patent jargon as an intermediate generalisation. Here, the board emphasised that an **intermediate generalisation** was different from a simple generalisation, since in the former case a definition of the invention in general terms formed part of the original disclosure. The expression intermediate generalisation conveyed the idea that the amended subject matter was a generalisation of a particular embodiment, disclosed in the original application, which was at an intermediate point between that particular embodiment and the definition in general terms of the invention as originally disclosed. In the view of the board, the expression "intermediate limitation" would in fact be more apt, since it emphasised that the amendment was also a restriction of an original disclosure in general terms.

The case at issue in **T 461/05** involved a restriction of an originally filed main claim in general terms by adding part of the features of a combination of features originally disclosed as a particular embodiment. The amendment therefore comprised the omission of certain characteristics of the combination of features of the particular

embodiment. The board held that the provisions of Art. 123(2) EPC 1973 precluded such an amendment only where the amendment presented the skilled person with new information which did not follow directly and unambiguously from the application as originally filed. A restriction of a claim by adding a number of features from a particular embodiment originally disclosed did not in itself introduce such new information. By contrast, the omission of the remaining features of the embodiment would introduce new information if the omitted features were necessary to carry out the particular embodiment of the invention. In this case, the omission of these features would present the skilled person for the first time with the information that, contrary to what had originally been disclosed, these features were not necessary in order to carry out the particular embodiment of the invention. The board found that the contested decision contained no reasons why these omitted features would be necessary to carry out the invention. Nor were the reasons why each of the embodiments constituted an indissociable bloc apparent from the decision. Nor could the board itself see any such reasons.

On this subject, see also **T 166/04**, **T 311/04**, **T 98/05**, **T 876/05**, **T 300/06**, **T 1250/06** and **T 1001/01**; **T 1407/06** and **T 911/06**; and further **T 17/86**, **T 962/98**, **T 25/03**, **T 1004/01** and **T 404/03**, which are referred to in other sections of this chapter.

3. Technical contribution - addition or deletion of a feature

G 1/93 (OJ 1994, 541) stated that the underlying idea of Art. 123(2) EPC 1973 was clearly that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. If, however, an added feature merely excluded protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such a feature could not reasonably be considered to give any unwarranted advantage to the applicant. Nor did it adversely affect the interests of third parties. Therefore, a feature which had not been disclosed in the application as filed but which had been added to the application during examination was not to be considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973, if it merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, without providing a technical contribution to the subject-matter of the claimed invention (see also **T 112/95**).

The question of whether an added feature made a technical contribution or merely limited the scope of protection was discussed in several decisions.

In **T 384/91** of 27.9.1994 (OJ 1995, 745) it was held that the added feature did make a technical contribution. This decision was based on the following considerations: the example mentioned by the Enlarged Board illustrated a case where the feature was clearly not merely a limitation. However, the borderline beyond which a feature was no longer to be considered as making a technical contribution to the subject-matter of the claimed invention and was merely limiting the protection conferred, was not co-terminous with this example but lay between it and the limit of complete technical irrelevance.

According to the board this view was consistent with the fact that the Enlarged Board had rejected relevance as a criterion for novelty and inventive step, which would also have implied a comparison with the cited prior art documents. The board explained that the term "invention" did not necessarily imply the presence of novelty and inventive step, as was apparent from the wording of Art. 52, 54 and 56 EPC 1973.

The board concluded that there was no need to take into account the prior art documents, but that the assessment of whether the exception for mere limitations applied in a particular case should depend only on the technical relationship of the added feature to the content of the application as originally filed, as understood by a skilled reader. At the least, a feature went beyond providing a mere limitation not involving a technical contribution to the invention if it interacted with the way in which the other features of the claim solved the technical problem, as it was understood from the application as originally filed.

In case **T 64/96**, a patent relating to a cover for automobile sun visor mirrors comprising rectangular plates overlapping and connected together in chain-like succession was revoked by the opposition division. The third auxiliary request of claim 1 was amended in that it was included as an additional feature that lugs were "integrally formed in said plates".

The appellant (patent proprietor) argued first that this feature was disclosed, at least implicitly, in the original application. Indeed since the plates were described according to the appellant as being of plastics, the person skilled in the art would not seriously consider forming the plates without lugs and then attaching the lugs thereafter, for to do so would unnecessarily increase the production costs of what was after all a mass-produced article. The appellant also argued in the alternative that the requirement that the lugs be "integrally formed in said plates" was of the class of feature allowed by **G 1/93** (OJ 1994, 541) (in short, no technical contribution). In particular, the appellant argued in this respect that all he was doing was limiting the scope of protection of the patent by means of non-inventive selection since the original application covered both integrally formed lugs and separately formed lugs subsequently attached to the plates.

In the board's opinion the first line of argument confused two essentially different questions, namely what the person skilled in the art would do on the basis of his general common knowledge when seeking to put the teachings of the original application into practical effect and what the original application directly and unambiguously disclosed to him. The answer to that second question was that the skilled person was told that the plates "are provided" with lugs, nothing else. That statement certainly included the possibility of forming the lugs integrally with the plates but did not disclose it.

The board then examined the second line of argument and came to the conclusion that applying the criterion, as set out in **G 1/93** (OJ 1994, 541) and **T 384/91** (OJ 1995, 745), to the present case, it could be seen that the feature in question did indeed make a technical contribution to the subject-matter of the claim since forming the lugs integrally with the plates led to a simpler and cheaper construction of cover which, at least by implication, was the technical problem which the invention set out to solve. Thus the

addition of this feature to claim 1 of the third auxiliary request offended against Art. 123(2) EPC 1973.

The board in **T 1269/06** held that, for the assessment of whether, contrary to Art. 100(c) EPC 1973, the subject matter of the patent extends beyond the content of the application as filed, the key question is whether the amendments made in the description, or - as in the case at issue - the claims, did indeed provide the skilled person with additional, technically relevant information which was not contained in the original application documents. This cannot be inferred from the fact alone that terms not present in the application documents were subsequently introduced, or from a purely semantic analysis of the contested passages. Instead, the party or department raising the objection must be able to identify clearly the technical teaching as such which has supposedly been added.

The board in **T 931/00** stated that although figures in examples might, under specific conditions, be used to limit a range which was already present in the original application, they could not be used to define an entirely new relationship between parameters which had never been linked before. Such arbitrary new links between existing parameters introduced new matter, contrary to the requirements of Art. 123(2) and Art. 100(c) EPC 1973.

Another question which arose was whether deleting a feature could constitute a technical contribution to an invention.

On this matter, in **T 802/92** (OJ 1995, 379), an ex parte case, the application as filed contained only product claims relating to "a double heterojunction p-i-n photovoltaic cell having at least three different semiconductor compound layers composed together of at least four different elements, comprising ... first and second ohmic contacts ...". In the course of examination proceedings the applicant also claimed the method of making such a photovoltaic cell. However, the method claim did not contain a feature relating to the formation of first and second ohmic contacts.

The board allowed the deletion of this feature in the method claims. It explained that the aim of the invention was to make photovoltaic cells with certain abilities. This aim was achieved by the use of three different semiconductor layers formed of at least four different elements. In the board's view, it followed from the description that the presence of ohmic contacts did "not provide a technical contribution to the subject-matter of the claimed invention". Therefore, the presence or absence of such ohmic contacts did not affect the carrying out of the described invention since they were not an essential part of it. The board invoked the principles underlying the interpretation of Art. 123(2) EPC 1973 set out by the Enlarged Board in **G 1/93** (OJ 1994, 541). According to the board in this case these considerations were equally applicable to cases where a feature had been removed from a claim or omitted, so as to broaden its protection. Thus the removal from a claim of a feature which did not provide a technical contribution to the subject-matter of the claimed invention and whose removal merely broadened the protection conferred by the claim did not contravene Art. 123(2) EPC 1973.

In **T 10/97** not all the compounds listed in the original claim were included in amended claim 1. However, since the claimed group of compounds was obtained not by restricting an originally disclosed generic definition of a substituent in a generic formula to a specific one selected from worked examples, but by deleting some members from a list of individualised equally useful compounds in order to improve the chances of patentability over the available prior art, the board found that such deletions must be considered admissible in accordance with the case law of the boards of appeal (see **T 393/91**). For the remaining compounds, no particular technical effect was either disclosed or alleged.

In **T 592/99** the opposition division had revoked the patent under Art. 102(1) EPC 1973. On appeal, the board noted that, the feature as originally disclosed having been replaced by the feature objected to under Art. 100(c) EPC 1973, the claim as such related to different products. The board concluded that in keeping with "Order 1" of **G 1/93** (OJ 1994, 541) the patent in suit contained subject-matter which extended beyond the content of the application as filed, which was prohibited by Art. 123(2) EPC 1973. Thus, the patent could not be maintained unamended, because the ground for opposition under Art. 100(c) EPC 1973 prejudiced the maintenance of the patent. On the other hand, the board observed that it could not be amended since deleting the limiting subject-matter from the claims would extend the protection conferred, which was prohibited by Art. 123(3) EPC 1973.

The board observed that in the case of a product claim concerning a composition defined by its components and their relative amounts given in terms of ranges, it could not be accepted that such ranges, which constituted essential features, did not provide a technical contribution to the subject-matter of the claimed invention, as suggested by the appellant. Any amendment to the ranges had to have the effect of modifying the claimed subject-matter, and thus also provided a technical contribution. If the newly claimed limited range were allowed even though unsupported, any subsequent selection invention based on the new range would have to be refused as not novel, which would otherwise not necessarily be the case. To allow this would, of course, give an unwarranted advantage to the patentee, contrary to the purpose of Art. 123(2) EPC 1973. In the board's view, that was exactly what was meant in the "typical example" given in point 16 of **G 1/93**, "where the limiting feature is creating an inventive selection **not disclosed** in the application as filed or otherwise derivable therefrom". Obviously, in the quoted text, such an "inventive selection" could not mean anything other than a potential (inventive) selection. Therefore the new feature constituted added subject-matter.

The board noted that the respondents could not be requested to demonstrate the potential character of the selection without making, or preventing themselves from making, a further selection invention. Thus, the burden of proof could not reasonably be shifted to them, as demanded by the appellant.

In **T 1004/01** the opposition division had decided that the requirements of Art. 123(2) EPC 1973 were not fulfilled. In particular, the feature specifying that the peel strength be "at least 24 grams", a value only disclosed in a specific example, was associated with a multiplicity of further features of that example and could not be

detached from those further features. The question that arose before the board of appeal was whether or not there was a basis in the application as originally filed for a peel strength "of at least 24 grams" to define the claimed laminate. According to the application as filed, the peel strength of the laminate was defined by an open-ended range as an essential feature of the invention. In the general description and the claims there was no further mention of any preferred peel strength range.

According to the board, the examples in the application as filed only illustrated specific laminates which were prepared from specific polymer blends and a specific nonwoven web, using specific lamination conditions and provided specific values of the peel strength. Thus, the exemplified laminates and the peel strength thereof were disclosed only in a concrete technical context, without providing any preference for a peel strength of at least 24 grams. Nor was any such preference given in the description, which could justify the lower limit. Since, however, a peel strength of 24 grams was disclosed, the question arose as to the conditions under which such an exemplified feature could form the basis for a new range as claimed. The peel strength of 24 grams could not be detached from the exemplified laminates to form a basis for a generalised lower limit of the claimed peel strength range without taking into consideration the other particulars closely associated therewith. It followed that the claimed subject-matter in all requests could not be directly and unambiguously derived from the application as filed. As to the technical contribution, the board said that the amended feature involved an interaction with the other features, i.e. a technical contribution to the invention, and did not provide a mere limitation of scope. Furthermore, the board pointed out that the general criteria of **G 1/93** (OJ 1994, 541) had to be met, namely that the limitation did not involve a technical contribution to the subject-matter of the claimed invention and did not provide an unwarranted advantage. Since the claimed peel strength led to a technical contribution of the claimed subject-matter, the question whether or not the limiting feature created an inventive selection could be left unanswered. Consequently, the added feature could not be regarded as a mere limitation of the protection.

4. Disclaimers

4.1. Applicable law - decisions **G 1/03** and **G 2/03**

On 8 April 2004, the Enlarged Board of Appeal ruled on referrals **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) concerning disclaimers and established the criteria to be taken into account. For a full account of the law now applicable to disclaimers, see the text of the decisions. Here, the Enlarged Board's answers to the questions it was asked to consider are set out:

1. An amendment to a claim by the introduction of a disclaimer may not be refused under Art. 123(2) EPC 1973 for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed.
2. The following criteria are to be applied for assessing the allowability of a disclaimer which is not disclosed in the application as filed:

2.1 A disclaimer may be allowable in order to:

- restore novelty by delimiting a claim against state of the art under Art. 54(3) and (4) EPC 1973;
- restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC 1973; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and
- disclaim subject-matter which, under Articles 52 to 57 EPC 1973, is excluded from patentability for non-technical reasons.

2.2 A disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.

2.3 A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Art. 123(2) EPC 1973.

2.4 A claim containing a disclaimer must meet the requirements of clarity and conciseness of Art. 84 EPC 1973.

With regard to the admissibility of disclaimers reference should be made to Chapter II.B.1.2.1.

4.2. Decisions applying the criteria established by G 1/03 and G 2/03

In many decisions the boards have taken pursuant to the Enlarged Board's decision on disclaimers have related to the nature of an accidental anticipation in the specific cases at issue. Other decisions discussed at the end of this subchapter relate to other issues.

In **T 500/00** the amendment was a disclaimer introduced by the appellant into claim 1 during the examining proceedings in response to an objection of lack of novelty based on prior art document D1. The question arose as to the requirements under which such a disclaimer might be allowable.

According to **G 1/03** (OJ 2004, 413), a disclaimer may be allowable in order to restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC 1973; thus the question that arose was whether or not the disclosure of D1 was accidental.

In the case in point, the claimed solution showed an overlap with the teaching of D1. D1 and the application in suit concerned the same technical field, had, except for the disclaimed component, identical compositions and related to the same purpose of sufficient curing. Moreover, the same technical problem underlay both the patent in suit and D1. Since the skilled person would consider D1 as suitable prior art to make the invention, confirmed by the reference to D1 in the original application, the disclosure of

D1 could not be considered as being accidental within the meaning of **G 1/03**. Furthermore, since D1 related to the same technical effect as the patent in suit, and since its starting polymers to be cured were structurally identical to those used in the claimed process, D1 could be considered as a suitable starting point for assessing inventive step.

The appellant argued that the disclaimer had been made in good faith according to the Guidelines and in accordance with the practice of the boards of appeal at the time of making the disclaimer. The board pointed out that the Guidelines were not rules of law. When introducing the disclaimer into claim 1 as granted, the appellant had referred to Guidelines C-VI, 5.8b (in an earlier version). Even so, the board explained that at the time when the disclaimer was introduced, the appellant, considering the relevant case law, could not expect that a disclaimer which was relevant for the assessment of inventive step and changed the technical information in the application as filed would be allowable. The appellant's position that transitional provisions should be provided for in **G 1/03** for those applicants who had relied in good faith on the previous EPO patent practice at the time of making the disclaimer failed as well, as explained by the board. The principles laid down in **G 1/03** were to be applied to the present case. Since the disclosure in D1 could not be considered as accidental within the meaning of **G 1/03**, the disclaimer was not allowable under Art. 123(2) EPC 1973.

The decision in **T 14/01** concerned the allowability of a disclaimer aimed at removing an overlap with prior art in view of **G 1/03**. According to the board in this case, the allegation that a teaching extracted from prior art led away from the invention implied that the skilled person had taken this prior art into consideration. Yet for an anticipation to be accidental it was necessary that the skilled person would have never taken it into consideration. The board then decided that the prior art in question was not accidental in the sense of **G 1/03**, and that the disclaimer was not admissible.

In **T 1049/99** the board concluded that, contrary to what the respondent (patent proprietor) claimed, the skilled person would have taken the teaching of document D21 into consideration when working on the invention in search of a solution to the technical problem defined by the respondent, using appropriate and relevant means to resolve his problem **in the same technical field** as that of the patent in suit. Moreover, contrary to the respondent's conclusions at the hearing, the board stressed that the fact that a document was difficult to find in published prior art or was difficult for the skilled person to access was not sufficient to justify the conclusion that it constituted an accidental anticipation.

In **T 217/03**, on the issue of whether document D1 was an accidental anticipation, the board stated that D1 did not deal explicitly with the technical problem underlying the claimed invention. However, that was not decisive for accepting D1 as an accidental anticipation. The board concluded that D1 related to the same general technical field as that of the subject-matter of claim 10 and was not from a technical point of view so unrelated and remote that the person skilled in the art would never have taken it into consideration when working on the invention (see **G 1/03**, OJ 2004, 413, point 2.2.2 of the Reasons). Thus the disclosure of D1 could not be considered to constitute an

accidental anticipation. Therefore the disclaimer in claim 10 did not fulfil the conditions required to render it admissible.

In **T 788/05**, the disclaimer, which was not disclosed in the application as filed (concerning Vascular catheter), was introduced by the appellant during the examination procedure with the purpose of establishing the novelty of the claimed subject-matter with respect to D1, which was then considered as a prior art document relevant under Art. 54(3) EPC 1973. A disclaimer which was not disclosed in the application as filed is only allowable if it is introduced to overcome a novelty objection based on an accidental disclosure or to delimit a claim against the state of the art under Art. 54(3) and (4) EPC 1973 (see **G 1/03**). In the present case the relevant prior art was represented by documents D1 and D5. To be allowable the disclaimer had to fulfil the conditions in relation to both documents. As far as D1 was concerned, the disclaimer appeared to be appropriate. D5 represented the state of the art under Art. 54(2) EPC 1973. As D5 was not state of the art under Art. 54(3) and (4) EPC 1973 and was not an accidental disclosure, the disclaimer would only be allowable if it did not add subject-matter within the meaning of Art. 123(2) EPC 1973, i.e. if the disclaimer did not become relevant for the assessment of inventive step. Going into details, the board concluded that the subject-matter of claim 1 of the main and the first auxiliary requests was not acceptable under Art. 123(2) EPC 1973.

Other decisions too have had to establish whether or not an anticipation was accidental. In **T 717/99**, for example, the board did not agree with the opponent's conclusion that the anticipation was not accidental. In **T 1086/99**, **T 1050/99**, **T 1102/00**, **T 134/01**, **T 584/01**, **T 506/02**, **T 285/00** and **T 1146/01** (on comparative examples of a prior art document providing a teaching not to be followed) the boards ruled that the anticipation was not accidental and that the disclaimers were therefore inadmissible.

The following decisions deal with further aspects of the application of **G 1/03**:

In **T 1050/99** the respondent (patentee) disputed the fact that decision **G 1/03** applied to his case, arguing that as the feature in question (earlier disclaimer reformulated as an "exclusion" feature) related to subject-matter which was "disclosed" in the application as filed, the amendment derived therefrom was to be regarded as a mere "waiver" of part of the disclosed invention rather than as a disclaimer. Consequently, in his view, the criteria applying to "undisclosed" disclaimers as set out in **G 1/03** did not apply. In the board's view there was no doubt that the amendment "with the exclusion of ..." answered to the definition of a disclaimer. Moreover, there was a basis in the application for the subject-matter which was excluded in the claim. However, that subject-matter was presented as a **part of the invention**, not as an area that was to be excluded or avoided. In that sense, the disclaimer was in fact an **"undisclosed" disclaimer** because there was no disclosure in the application as filed of the disclaimer per se. Dismissing the respondent's arguments regarding the interpretation of Order 2 of **G 1/03**, the board concluded that the ruling of **G 1/03**, which dealt with the allowability of disclaimers not disclosed in the application as filed, was fully applicable to the present case.

T 1102/00 likewise considered the definition of a disclaimer. In its decision, the opposition division had held that the disclaimer correctly excluded the novelty-destroying matter disclosed in the prior art. The board observed that the opposition division had apparently not examined the question of whether the disclaimer had a basis in the application as filed, that question being decisive for the criteria to be applied in assessing its allowability. The board was not convinced that the passage in the application as filed cited by the appellant provided a basis for the disclaimer at issue. Even if it were acknowledged that the subject-matter defined by the expression "lignées cellulaires de mammifères" (as in the disclaimer) corresponded exactly to that defined by the expression "cultures de cellules de mammifères" (as in the application), it could not be inferred from the disclosure of the application as filed that the applicant intended to exclude such subject-matter from the scope of protection sought. Thus the board came to the conclusion that the disclaimer had no basis in the application as filed. It then applied the criteria established by **G 1/03** to be applied in assessing the allowability of a disclaimer which was not disclosed in an application as filed.

In **T 970/02**, the board acknowledged the fact that the "negative" feature was introduced in order to establish novelty with respect to E3, and that this document as closest prior art was also of relevance in respect of inventive step. In the board's view, however, since the amendment and the alleged "disclaimer" were clearly supported by the original disclosure the conditions set out in **G 1/03** did not apply to the case in point.

In **T 1559/05** the appellant/patentee suggested that since the basis of the amendment to claim 1 was disclosed in the application as filed, it was not an "undisclosed disclaimer" and therefore **G 1/03** did not apply in the case at issue. In the respondent/opponent's view, the original application documents did not disclose at all that the disclaimer now introduced in claim 1 would not have been included in the invention as originally disclosed; on the contrary, the material now disclaimed was originally disclosed as being suitable for use in the invention; therefore this disclaimer did not have a basis in the original application documents. The board concurred with the appellant that, in the relevant passage of the application as filed, the new feature in claim 1 ("TPX® material") was disclosed as such. However, the pertinent question was whether a skilled person, reading the original application documents in their entirety, would unequivocally have understood that the TPX® material was actually disclaimed, i.e. that this material was excluded from the protection sought in the claims. The board concluded that although the appellant was correct in stating that there was a disclosure in the original patent application for the material TPX®, the application documents did not disclaim the use of this material, since the invention could be carried out successfully using this material. The new feature in claim 1 of the appellant's main request was therefore a disclaimer not previously disclosed in the application as filed. For such a disclaimer the ruling of **G 1/03** applies. In the case at issue, the board came to the conclusion that the disclaimer in claim 1 was not allowable.

In **T 285/03** the board found that the interpretation offered by the appellant amounted to a disclaimer although it was not phrased in the usual form. However, that disclaimer was not based on a particular prior art disclosure, whether accidental or not, but tried to

delimit the claim against any potential prior art disclosure, contrary to the principles set out in **G 1/03**.

T 747/00 relates to the condition set by **G 1/03** (point 2.2 of the Reasons) that a disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. The board concluded that since, in the absence of a novelty-destroying disclosure, the disclaimer removed subject-matter without any need to do so, that disclaimer necessarily removed more than was necessary to restore novelty, which was not allowable (see also **T 201/99**). In **T 1050/99** the board concluded that the disclaimer covered more than was disclosed in the prior art and thus removed from the claim more than was necessary to restore novelty. See also **T 285/00** which concerned a disclaimer largely not based on the disclosure of a prior art document cited under Art. 54(3) EPC 1973, thereby rendering the remaining claimed subject-matter more distant from a relevant prior art document cited under Art. 54(2) EPC 1973.

In **T 382/07** it was decided that the five disclaimers did not remove more than was necessary.

In **T 8/07** the board had to decide on the allowability of a disclaimer under Art. 123(2) EPC. The board observed that **G 1/03** stated that a disclaimer may serve exclusively the purpose for which it is intended and nothing more. If a disclaimer has effects which go beyond its purpose, it is or becomes inadmissible. Further, the necessity for a disclaimer is not an opportunity for the applicant to reshape his claims arbitrarily (**G 1/03**, reasons 3). Therefore the disclaimer should not remove more than is necessary to restore novelty or to disclaim subject matter excluded from patentability for non-technical reasons. From that the board found that it could not be derived from the reasoning of **G 1/03** that a patent proprietor is permitted a degree of discretion or latitude concerning the "border" within which the disclaimer should be drafted with respect to the subject matter to be excised. On the contrary, the existence of any discretion regarding the extent of the disclaimer as compared to the subject-matter to be excluded would inevitably introduce a degree of arbitrariness in the drafting of the disclaimer. This would conflict with the express findings of **G 1/03**. It was therefore concluded that in order to comply with the requirements following from **G 1/03** with respect to the drafting of disclaimers it was necessary that these be formulated to excise only that subject-matter which could not be claimed. Further the submission of the patent proprietor that it would derive no advantage was not necessarily and inevitably correct since a broad disclaimer, in addition to restoring novelty would have the further effect of "immunising" the subject matter claimed against a potential attack of lack of novelty.

In **T 10/01** the scope of the disclaimer was broader than was necessary to restore novelty. The board nevertheless referred to point 3 of the Reasons for **G 1/03**, saying that it could also be inferred from that decision that a disclaimer that was broader than strictly necessary to restore novelty might be allowed, depending on the circumstances of the case, if that proved necessary to prevent any lack of clarity in the claim that might otherwise result. However, in the case at issue there was no apparent justification for the disclaimer being broader than the disclosure in document (1).

In case **T 440/04**, the question was whether disclaiming example 1 of C63 was sufficient to restore novelty. Whereas on the one hand a disclaimer should not remove more than was necessary to restore novelty, it cannot, on the other hand, be considered to serve its intended purpose when it excises less than what is necessary to restore novelty. The disclosure in C63 of fibres having compositions and properties as required by the present claims 1 according to all requests was not strictly limited to the fibres described in example 1 of C63. "Cutting out" the latter fibres was thus not sufficient to exclude from the said claims 1 all those fibres disclosed in C63 having a composition and the inherent properties according to said claims. In the present case, the disclaiming of example 1 was thus not sufficient to restore novelty of the claimed subject-matter over C63.

In **T 795/05** the board noted that a disclaimer which has no basis in the application as filed may not be refused under Art. 123(2) EPC provided it fulfils the criteria set out in **G 1/03** (OJ 2004, 413). The disclaimer at issue had no basis either explicitly or implicitly in the application as originally filed, although the subject-matter excluded by the disclaimer was supported by the application as filed. Further, the disclaimer was, in contrast to the case under consideration in **T 4/80**, intended to restore novelty over a document belonging to the state of the art according to Art. 54(3) EPC, and was as such not disclosed in the application as filed. Therefore the claim at issue was not allowable under Art. 123(2) EPC.

In **T 1107/06** the board observed that prior to the decisions **G 1/03** and **G 2/03** of the Enlarged Board of Appeal (OJ 2004, 413 and 448), it was widely accepted that a disclaimer could in principle be allowed when the subject-matter to be excluded was disclosed in the European patent application as filed as an embodiment of the invention. This principle emerged from the very first decision (**T 4/80**, OJ 1982, 149) allowing the introduction of a disclaimer into a claim. This decision justified the allowability of the disclaimer not by its purpose, but by the fact that the subject-matter to be excluded was originally disclosed by the applicant as a possible embodiment of the invention. The principles developed in decision **T 4/80** were applied or cited with approval in several other decisions (see e.g. **T 80/85**; **T 98/94**; **T 673/94**). However, a more restrictive approach recently emerged in the case law of the boards of appeal (see **T 1050/99**; **T 1102/00**; **T 236/01**; **T 868/04**; **T 795/05**; **T 1559/05**) according to which disclaimers which exclude subject-matter disclosed as an embodiment of the invention were regarded as non-disclosed disclaimers and held unallowable unless they fall under one of the exceptions laid down in decisions **G 1/03** and **G 2/03**.

The board held that a disclaimer does not infringe Art. 123(2) EPC if its subject-matter is disclosed as an embodiment of the invention in the application as filed. The board pointed out that the Enlarged Board restricted its analysis in its decisions **G 1/03** and **G 2/03** to so-called undisclosed disclaimers which, in the light of the questions referred, were not meant to include disclaimers excluding subject-matter originally disclosed as embodiments in positive terms. The board took the view that when there is a generic disclosure of the invention together with a specific disclosure of an illustrative or preferred embodiment falling under the generic disclosure, the skilled person will normally imply that all the other embodiments comprised in the generic disclosure without being mentioned specifically also form part of the invention. The non-exemplified

or non-preferred embodiments are thus implicitly disclosed as the logical complement of the exemplified or preferred embodiments. Thus the board made it clear that it did not embrace the restrictive approach adopted in the decisions cited above but would continue to follow the prior established case law.

Finally, with regard to another aspect recently dealt with in **G 1/07** see Chapter I.B.4.3.4, surgical methods.

4.3. Review of case law prior to **G 1/03** and **G 2/03**

For case law applying before **G 1/03** and **G 2/03**, see "Case law of the Boards of Appeal", 5th edition 2006.

5. Disclosure in drawings

The case law according to **T 169/83** (OJ 1985, 193), **T 523/88** and **T 818/93** showed that the EPC 1973 did not prohibit the amendment of claims to include **features from drawings, provided the structure and the function of such features were clearly, unmistakably and fully derivable from the drawings by the skilled person** and not at odds with the other parts of the disclosure. Nor could any element be dropped.

Indeed, in **T 169/83** (OJ 1985, 193), **T 465/88** and **T 308/90** it was pointed out that where **drawings** existed they were to be regarded as **an integral part of the documents** disclosing the invention. Drawings were to be **treated on an equal footing with the other parts of the application** (see also III.A.1. General issues). Further, the fact that features were disclosed solely in the drawings did not preclude these features from becoming essential in the course of the proceedings (**T 818/93**). The features for which a skilled person could clearly derive the structure and function from the drawings could be used to define more precisely the subject-matter for which protection was sought (**T 372/90**).

In **T 398/92**, the board made particular reference to the case law on this subject. In the case at issue the patent claims as amended contained features that had not been mentioned expressis verbis in the written part of the original application but had been derived from the figures for the application as filed. In this case the drawings in question illustrated the curves in a system of Cartesian co-ordinates with a precise, defined scale. The curves therefore could not be compared to the schematised representation of an invention given by a graph. The board recognised that the points of these curves were not purely intellectual graphic constructions but, on the contrary, corresponded to real experimental values, representing the percentages of a particular drug released in solution. Although these percentages were not mentioned expressis verbis in the original document, the board was of the opinion that for a skilled person they would have been clearly and unambiguously derivable from the scale given on the Y-axis, since the figures were sufficiently precise for the ordinate values to be read exactly and thus for the same numerical features as introduced in the claims to be derived from them. The incorporation into the text of the claims of the numerical features derived from the curves therefore did not contravene Art. 123(2) EPC 1973 (as far as **a graph representing a**

mathematical equation is concerned, see **T 145/87**). This case related to a process for regulating the print quality of printers which could only be carried out using statistical calculations. On the basis of a formula given *expressis verbis*, its representation as a graph according to the Cartesian co-ordinate system and a basic knowledge of statistics, the possible values of two parameters in the formula, though not expressly disclosed, could be deduced.

In **T 191/93** amendments were based exclusively on the original drawings and introduced only some of the features disclosed in the drawings. The board held that the subject-matter of the patent had been extended compared to the application as filed because it was not derivable from the drawings that the two newly introduced features could be isolated from the other features shown in the drawings. The subject-matter defined in the claims thus amended was ambiguous. In this case, however, the ambiguity could be removed by also introducing into the claim a third feature, disclosed in the drawings as filed, together with the other two features.

In **T 676/90** the applicant wished to delete the rolling-device features of a carrying aid for a pair of skis. The board found, however, that the original documents had disclosed only a carrying aid consisting of a rolling device and a carrying strap or only of a rolling device, but not an option without a rolling device. Nor was the board swayed in its view by the applicant's argument that the carrying strap was shown separately in a drawing. It held firstly that, according to the description, this drawing was an expanded view of the carrying strap shown in Figure 1 (which, moreover, showed a ski with the carrying strap in conjunction with the rolling device). Secondly, a drawing could never be interpreted in isolation from the overall content of the application but only in that general context. The content of an application was defined not only by features mentioned or shown therein but also by their relationship to each other.

In **T 497/97** the board noted that, since drawings were often approximate and therefore unreliable, they could only be used in interpreting amended claims if the description did not contain a more precise indication of what was meant. Moreover, in the case at issue, the drawings showed only a preferred embodiment of the invention, which did not rule out the possibility of other embodiments covered by the claimed subject-matter. The board concluded that the contested wording, inserted in the characterising portion of claim 1, had been validly based on the description according to the application, i.e. that the wording had been inferable from its context without extending its meaning.

In **T 748/91** the board reached the conclusion that size ratios could be inferred even from a **schematic drawing** as long as the delineation provided the relevant skilled person with discernible and reproducible technical teaching. In the board's view, schematic drawings depicted all the essential features.

However, a figure which served only to give a schematic explanation of the principle of the subject-matter of the patent and not to represent it in every detail did not allow the sure conclusion to be drawn that the disclosed teaching purposively excluded a feature not represented. A "negative" feature of this sort (in this case, "with no internal fittings") could not subsequently be incorporated into the claim (**T 170/87**, OJ 1989, 441).

Regarding the absence of a feature in a figure which served only to give a schematic explanation of the principle of the invention, see also **T 264/99**, in which the board found the circumstances to be different from those in **T 170/87**.

Likewise, in **T 906/97** the board held that the parent application as filed failed to disclose unambiguously the position of a door. The only indication of this position could be found in some figures, and in the board's view there was no suggestion whatsoever in the description itself that this detail of the schematic representation was actually meant to correspond to a technical feature of the apparatus shown in the figures, rather than being merely an expression of the draughtsman's artistic freedom.

The European patent in case **T 1120/05** had already been granted at the time of the entry into force of EPC 2000 on 13 December 2007. The invention concerned an "arrangement for and a method of managing a herd of freely walking animals" and the amendment introduced a **negative feature** namely "but not to the milking station (2)". This negative feature was not expressly disclosed in the description and in the claims of the patent application as filed. Features could be taken from the drawings if their structure and function were clearly, unmistakably and fully derivable from the drawings. It was not possible to derive a negative or missing feature on its own, i.e. without the context of the other, existing features of the claim. It remained to be decided if a combination of features including the negative feature could be derived or not. This approach accepted, arguendo, that the skilled person was actually capable of finding - and indeed willing to search for - negative features in a drawing, albeit in combination with some other features.

Furthermore the board accepted in case **T 1120/05** - for the sake of argument only - that the skilled person would look closely at the features relating to the animal passage. The question arose whether the skilled person would clearly, unmistakably and fully derive from the drawings that this animal passage had a further feature besides those explicitly stated in the application, i.e. whether the skilled person would positively realise that this animal passage did have some negative features as well. Were the board to accept that this were the case, then, as a matter of logic, the board would have to establish that the skilled person would, inevitably, realise the presence of further negative features, and potentially a large number thereof. Choosing arbitrarily one of these was not permitted, because the skilled person not only had to realise the possible negative features, but because they were derived from the drawings, he also had to establish which one of the features was essential to the invention and which ones were not. The board found that in the absence of a teaching from the description, the skilled person would be unable to establish the essential nature of a single negative feature, seen against a background of a multitude of potentially essential features, even if this selected single negative feature in the drawings could be recognised by the skilled person in the drawings. It was mentioned that the case law also confirms that negative features cannot be deduced from a schematic drawing only. More generally, in the context of Art. 123(2) EPC the original drawings cannot be considered as a reservoir of features on which the applicant or a patent proprietor can draw when amending the claims. Decision **T 169/83** required that "the structure and function" of the negative feature should be clearly, unmistakably and fully derivable for the skilled person from the drawings. This was not the case here.

Furthermore the drawings related to a specific embodiment. The disputed negative feature "the entrance device forms a passage leading from the receiving station to the separation device but not to the milking station" was not directly and unambiguously derivable from this specific embodiment. Therefore, this specific embodiment shown in the drawings could not serve as a basis for the desired amendment. A further passage referred to by the respondent/patent proprietor defined the result to be achieved without disclosing either explicitly or implicitly this negative feature. This negative feature therefore added subject-matter extending beyond the content of the application as filed. Moreover, the board did not consider this undisclosed negative feature as being an allowable disclaimer within the meaning of decision **G 1/03**, because the anticipation necessitating the amendment could not be considered as accidental.

6. The application as originally filed : formal aspects

6.1. Cross-references

In **T 6/84** (OJ 1985, 238) the subject-matter of the application was a chemical process solely characterised in that the catalyst was synthetic offretite having a silica/alumina mole ratio of 5 to 10. For the definition of synthetic offretite the description referred to a Canadian patent specification in which the offretite used was defined as aluminosilicate having the given mole ratios for the oxides and a characteristic X-ray powder diffraction pattern. The board took the view that structural features of a means for performing a chemical process (here the catalyst "offretite"), which were not mentioned in the application documents themselves but in a document (here a Canadian patent specification) to which they referred, could be incorporated into a patent claim if they unequivocally formed part of the invention for which protection was sought (see **T 590/94**). However, it was not permissible to single out a particular one of their number (here a silica/alumina ratio) in the absence of evidence that this feature alone was a sufficient characterisation. It was instead necessary to recite fully the other essential components of the structure and the diffraction pattern figures which belonged together, as originally disclosed and defined in that document. In **T 6/84** it was clear having regard to the facts that the further characterising parameters of synthetic offretite which were included in the main claim by way of amendment were indeed features which unequivocally formed part of the invention for which protection was already sought, because the use of synthetic offretite as a catalyst was already the only characterising feature in the claim as originally filed, and the features which were added to that claim simply defined such synthetic offretite better.

In **T 689/90** (OJ 1993, 616), however, the description of the invention as originally filed did not in any way suggest that the "further details" of a certain feature to be found in a document D1 referred to and now to be included in the main claim were intended to identify features of the invention for which protection might be sought or that such features implicitly clearly belonged to the description of the invention. The board decided that features disclosed only in a cross-referenced document which was identified in the description as filed were prima facie not within "the content of the application as filed". Only under particular conditions would adding them to a claim not be an infringement of Art. 123(2) EPC 1973, namely if the description of the invention as filed left the skilled

reader in no doubt that protection was sought for those features; that they helped achieve the invention's technical aim and thus formed part of the solution to the technical problem underlying the invention claimed; that they implicitly clearly belonged to the description of the invention contained in the application as filed and thus to the content of the application as filed, and that they were precisely defined and identifiable within the total technical information contained in the reference document. In the case at issue these requirements were not fulfilled.

6.2. Errors in the disclosure

6.2.1 Calculation errors

In **T 13/83** (OJ 1984, 428) the board held that R. 88 EPC 1973 did not apply to a non-obvious correction of an error in the description or claims which resulted from an erroneous technical calculation. A correction of such an error was allowable under Art. 123(2) EPC 1973 if the amendment would be regarded by the skilled reader as clearly implied by the disclosure of the application as filed. If more than one arithmetical possibility of correction could be envisaged, the correction chosen had to be the one which the application as a whole clearly implied.

6.2.2 Incorrect structural formula

In **T 552/91** (OJ 1995, 100) the question arose as to whether and in what form protection could be obtained for groups of chemical substances and individual compounds whose originally disclosed structural formula proved incorrect. The applicant's main request was aimed at securing such protection by a further substance claim for the group of compounds with the structural formula subsequently found to be correct. This request was refused on the grounds that it would violate Art. 123(2) EPC 1973. The board defined "content" within the meaning of Art. 123(2) EPC 1973 as "the entire technical disclosure derived by a skilled person from the application". Thus it was not enough to prove that as a result of amendments to the original patent application nothing other than the originally disclosed subject-matter was claimed; what was more important was that technically relevant information which the skilled person could not derive from the original documents was not thereby added to the application. In this case, the subsequently amended general formula gave the skilled person for the first time crucial information about the true chemical structure of the group of substances. This led to conclusions regarding properties that could be put to use. The information added to the application through the amendment of the general formula and relating to the true composition of the group of substances could not have been obtained from the application as originally filed.

6.2.3 Amendment based on errors

In **T 740/91** the board allowed a change in the upper limit of the amount of epoxy compound present on a yarn from 5.0 % by weight to 0.6 %. This amendment conferred both novelty and inventive step on the claimed subject-matter. The value of 0.6 % was

explicitly disclosed in example IV. However, the patentee conceded that this figure had been inserted in error in place of the true figure of 0.49 %.

The board concluded that the fact that the figure was wrong did not alter the fact that it was actually and credibly disclosed. It could thus be relied on as the basis for the new upper limit. This interpretation of Art. 123(2) EPC 1973 was consistent with its underlying intention, which was to protect the public from being faced at a later stage with claims which were wider in their scope than what had been disclosed in the application as filed, and published for the information of the public, including the applicant's competitors. In this case, any such competitor who had read the application as first published had formed the view that the originally claimed range of 0.1 to 5 % was too wide in the light of the prior art, and had thought that the broad claim could not validly be sustained. He would have seen at once that the highest figure for the cured epoxy resin given in any example was 0.6 %, as clearly disclosed in example IV, and therefore could not have been taken by surprise if the upper limit of 5 % were later to be reduced to 0.6 %. The fact that the figure was wrong would be unknown to competitors, and therefore could not influence their judgment.

6.2.4 Elimination of contradictions

In **T 172/82** (OJ 1983, 493) the deletion of a feature in a claim was considered admissible because the sole purpose of such deletion was to clarify and/or resolve an inconsistency. And in **T 271/84** (OJ 1987, 405) it was stated that an amendment to a claim to clarify an inconsistency did not contravene Art. 123(2) or Art. 123(3) EPC 1973 if the amended claim had the same meaning as the unamended claim, on its true construction in the context of the specification.

In **T 758/92** the board allowed the deletion of a feature because it was clearly inconsistent with the teaching disclosed in the application as filed, and there was a clear basis in the original disclosure for its deletion. A skilled reader of the original application documents would have realised that the feature to be deleted was erroneously introduced in the claim because the resulting definition was contradictory to the functioning of the described embodiment of the invention.

In case **T 60/90** the applicant had deleted the lower limit of a temperature range in order to eliminate an inconsistency between the claims and the examples. Resolving this inconsistency was found unobjectionable under Art. 123(2) EPC 1973. The board held that, (1) the feature in question was not explained as essential in the disclosure (it was originally a preferred embodiment), (2) it was not, as such, essential for the function of the invention (the examples used a lower temperature - the source of the contradiction), and (3) its removal required no real modification of other features to compensate for the change.

In **T 609/95** the board took the position that where a drafting defect or inconsistency in an application would be evident to a reader skilled in the art, the person to whom the application is addressed, it is reasonable to suppose that he would, in the light of the content of the application, attempt to formulate a notional amendment which would

enable him to make sense of what he reads, and to the extent that the amendment might be said to leap to the mind of the reader, although perhaps only after close study of the document, it can be regarded as implicit in the application and would not contravene Art. 123(2) EPC 1973, if effected in practice (see also **T 887/97** for such amendment during opposition appeal proceedings).

In **T 749/03** the respondent (patent proprietor) had made reference to **T 190/99**, which discussed the possibility of amending a granted claim to replace an inaccurate technical statement, which was evidently inconsistent with the totality of the disclosure of the patent, with an accurate statement of the technical features. According to that decision, the skilled person, when considering a claim, should rule out interpretations which were illogical or did not make technical sense. It appeared that in the present case **T 749/03** a similar situation arose - claim 5 as originally filed would, if taken alone, not make technical sense, and even the simple addition of its features to the features of claim 1 would result in an inadequately defined apparatus. However, by taking into account the whole disclosure of the patent the skilled person might arrive at a technically sensible interpretation of the claim.

In that context reference was also made to **T 371/88** (OJ 1992, 157), which concerned the admissibility of amending a granted claim to replace a restrictive term with a less restrictive term. The board in that case had ruled that such replacement was permissible under Art. 123(3) EPC 1973 if examination of the extent of protection conferred by the granted claim resulted in the following conclusions: (a) the restrictive term in the granted claim was not so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the description and the drawings of the patent; (b) it was quite clear from the description and the drawings of the patent and also from the examination procedure up to grant that the further embodiment belonged to the invention and that it had never been intended to exclude it from the protection conferred by the patent. In the present case (**T 749/03**), having regard to claim 1 alone, the features relating to the second (transmission) grating were perfectly clear in their technical meaning. However, in combination with claim 5 they would only make sense if reference were made to the description and drawings. Therefore requirement (a) was met. Further, there could be no doubt that the applicant had not waived that embodiment. Hence requirement (b) was also met.

In **T 1464/05**, assessing whether the amendment added subject matter under Art. 123(2) EPC, the Board said that the further attempt of the respondent/patent proprietor to see in the latter upper ends of range values a removable inconsistency in the application as filed could not, in the context of a wholly consistent and clear disclosure of the application, be accepted.

6.3. Subsequent addition of details

6.3.1 Amendments in the description of the prior art

In **T 2321/08** the board considered the question of whether R. 27(1)(b) EPC 1973 required that prior art known to the applicant be acknowledged in the application already

at the time of filing it. The board came to the conclusion that R. 27(1)(b) EPC 1973, or equivalent R. 42(1)(b) EPC, does not put a stringent obligation on the applicant to acknowledge prior art known to him, and to cite documents known to him reflecting this prior art, already at the time of filing the application. Furthermore, no requirement of the EPC prohibits amending an application in order to meet the provisions set out in R. 27(1)(b) EPC 1973 or R. 42(1)(b) EPC.

In **T 11/82** (OJ 1983, 479) it was pointed out that the mere addition to the description of a reference to prior art could not reasonably be interpreted as the addition of "subject-matter", contrary to Art. 123(2) EPC 1973. Whether it did so would clearly depend on the actual language used and the circumstances of the case.

In **T 211/83** the board even considered it essential that details of the way a component of the invention worked, which could only be inferred from previously published advertising literature referred to in the description, be included in the description since they were of significance for the invention.

In **T 450/97** (OJ 1999, 67) the board confirmed that the mere addition of a reference to prior art did not contravene Art. 123(2) EPC 1973. It added that after limitation of the claims, also at the opposition stage, a document which subsequently proved not only to be the closest state of the art, but also to be essential for understanding the invention within the meaning of R. 27(1)(b) EPC 1973 was to be introduced in the amended description.

In **T 889/93** the appellant (patent applicant) explained that the closest prior art was shown in two figures of the contested application. In his reply to the board's objection of obviousness he submitted that these figures did not show the state-of-the-art device correctly as they were misleadingly oversimplified. The board allowed originally filed drawings to be replaced by better ones since this only removed an inaccuracy in the representation of the state of the art and did not affect the disclosure of the invention per se. **T 1039/93** found along similar lines. In the case at issue, certain figures of the application as filed had been erroneously labelled as prior art while in fact representing in-house technical knowledge of the appellant that had not been made available to the public. The board did not object to the deletion of the labels "prior art" from the relevant figures since such deletion neither infringed Art. 123(2) EPC 1973 nor affected the disclosure of the state of the art; on the contrary such amendment was necessary to avoid giving an inaccurate representation of the state of the art. After the amendment the description correctly indicated the prior art as required by R. 27(1)(b) EPC 1973.

Equally, an amended claim did not contain subject-matter which extended beyond the content of the application as filed if the preamble to the claim had been amended by substituting an appropriate more general term, which was apt to define a feature common to both the closest prior art described in the application as filed and the invention which was the subject of the application, for a specific term which was not apt to define that feature of the prior art (**T 52/82**, OJ 1983, 416).

6.3.2 Subsequent addition of effects

In **T 11/82** (OJ 1983, 479) it was stated that it was not inevitable that the addition of a discussion of the advantages of the invention with reference to the prior art would constitute a contravention of Art. 123(2) EPC 1973. In **T 37/82** (OJ 1984, 71), for example, a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully. It could however be deduced from the original application on the basis of normal expert considerations.

In the Guidelines C-VI, 5.3.4 and 5.3.5 (April 2010 version), it is pointed out that amendment by the introduction of further examples and statements of effects or advantages of the invention not mentioned previously should always be looked at very carefully in the light of general considerations. Under certain circumstances, later filed examples or new effects, even if not allowed into the application, may nevertheless be taken into account by the examiner as evidence in support of the patentability of the claimed invention.

7. "Tests" for assessing the allowability of an amendment

In accordance with established board case law, the relevant question to be decided in assessing whether an amendment adds subject-matter extending beyond the content of the application as filed or (in the case of divisional applications) the parent application as filed is whether the proposed amendments were **directly and unambiguously** derivable from the application as filed or from the parent application as filed. The established case law is reviewed in decisions such as **T 1206/01**, **T 731/03**, **T 1407/06** and **T 1772/06**.

In this introductory section, a recent decision may be cited which draws a distinction between two cases: the removal (or replacement) of a feature and the addition of a feature. In **T 404/03** the board considered that the decisions of the boards of appeal describing and using the current palette of "tests" in connection with various types of amendments might lead to some confusion. As far as the disclosure of a group of features was concerned, as distinguished from their scope, the generalisation of a feature in a claim and the isolation of features from embodiments in the description essentially both involved a deletion of a feature, namely the specific feature and the remaining features of the embodiment respectively. The board therefore considered that these cases could be subject to the same criteria as a pure deletion, and hence, in principle, the three point test. Rather than requiring a specific statement or suggestion in the original disclosure, the three point test was more generous to the applicant because it essentially allowed the deletion of a feature if the skilled person realised from the common general knowledge in that field that the feature had nothing to do with the invention. Moreover, in the board's view, the cases of deletion of features and addition of features had to be distinguished with respect to the allowability of amendments under Art. 123(2) EPC 1973, since the former only removed elements that were originally disclosed and hence might be judged by a skilled person to be inessential to the invention, whereas the latter added new elements lacking any basis whatsoever in the original disclosure.

On amendment assessment methodology see also the recent **T 1269/06**, referred to above under point III.1.3.

7.1. Direct and unambiguous deducibility of amendments from the application as filed

Some examples illustrating the application of the test at issue here are to be found in this section below, following the introductory overview of relatively old decisions concerning the test which is actually to be applied.

Decision **T 194/84** (OJ 1990, 59) related to amendments leading to the generalisation of the subject-matter of an application or to the omission of a feature (in this instance, the use in an electrode of a storage battery cell of cellulose fibres in general instead of natural cellulose fibres). The patentee had taken the view that the amendment was admissible because the original application could properly be cited against the novelty of a more generic claim to cellulose fibres. The board took the view that this approach was based on a misapplication of the novelty test. The test for additional subject-matter corresponded to the test for novelty only in so far as both required assessment of whether or not information was directly and unambiguously derivable from that previously presented in the originally filed application or in a prior document respectively. An amendment was not allowable if the resulting change in content of the application, in other words the subject-matter generated by the amendment, was novel when compared with the content of the original application or, looked at another way, if the said change in content would be novelty-destroying for a hypothetical future claim when the original content would not be. It was important that it was the change in content which was tested, i.e. the amended content minus the original content, so that the test was applicable to amendment by generalisation or omission of a feature.

In **T 514/88** (OJ 1992, 570) the board took the view that the two tests in relation to the question of broadening of claims before grant by abandoning a feature, i.e. the test for essentiality (or inessentiality) on the one hand and the novelty test on the other, were not mutually contradictory but represented the same principle. In both cases the relevant question was whether or not the amendment was consistent with the original disclosure. This meant direct and unambiguous derivability from and no contradiction of the totality of the original disclosure (same reasoning followed in **T 527/88** and **T 685/90**).

T 118/89 took a reserved attitude to the novelty test, but at the same time emphasised the importance of the above-mentioned key question, in stating that the allowability of amendments during the grant procedure could be determined without reference to the state of the art simply by comparing the protection sought on the basis of the current claims with the disclosure in the application as filed. There was therefore no objective need to carry out new or modified novelty tests. The test for novelty was similar to that for allowability of amendments under Art. 123(2) EPC 1973 only in so far as the former also involved a direct comparison, in this case between the claims and the disclosure in a document or other evidence possibly prejudicial to novelty, i.e. the state of the art.

It is also clear from **T 288/92** and **T 187/91** (OJ 1994, 572) that the decisive question when assessing the admissibility of amendments is whether the amendment can be directly and unambiguously deduced from the application documents as filed:

In **T 288/92** the appellant (applicant) contended that the amendment resulted in a limitation of the original claim. The board rejected this argument on the grounds that the expression "subject-matter which extends beyond the content of the application as filed" in Art. 123(2) EPC 1973 prohibited the introduction of any technical information which a skilled person would not have objectively derived from the application as filed, so that the examination of the allowability of an amendment according to Art. 123(2) EPC 1973 was directed to the process of "derivation" (see also **T 383/88**), as distinct from a simple comparison of the scopes of amended and unamended subject-matters. In the view of the board this provided a **definitive method** for deciding the allowability of an amendment. Any other "test", such as the "novelty test", necessarily posed hypothetical questions. On the facts of the case the board held that it was not permissible to amend a generic formula defining a class of chemical compounds by restricting an originally disclosed generic definition of a substituent to a specific (individual) one which was arbitrarily selected from chemical entities, such as in the examples, without some support for such restriction in the general part of the description (see also **T 859/94**).

In **T 187/91** (OJ 1994, 572) the appellant had requested that a patent on a fibre optic amplifier be granted. The claims in the application as filed referred to "a plurality of pump light sources", i.e. **two** or more light sources; the amended claims referred to "a pump light source" and, thus, sought protection for a fibre optic amplifier including **one** or more light sources. The board conceded that there was clearly a close conceptual correlation between the assessment of novelty and the assessment of what was an allowable amendment under Art. 123(2) EPC 1973. It further explained, however, that two considerations which underlay Art. 123(2) EPC 1973 were different from those that underlay Art. 54 EPC 1973: firstly, a reader of an application published pursuant to Art. 93(1) EPC 1973 after 18 months would be informed of the maximum extent of its subject-matter and therefore its maximum content some time before the text of the application including the claims was finalised, having regard to the drawing up of the European search report and the subsequent examination of the application. Secondly, the relationship between the claims and content of the European patent application was determined by the idea that, after appropriate amendment if necessary, the granted claims should give a fair protection for the inventive subject-matter contained in the application as filed.

The board found that a skilled reader of the application as filed would seriously contemplate the use of only one light source when carrying out the described invention; there was nothing in the application as filed or in his common general knowledge which would cause the skilled person to exclude the possibility of using only one light source. Additionally, on a careful and analytical reading of the whole content of the application as filed, there was no reason to regard the use of a plurality of light sources as essential to the invention in order to achieve its stated aims. On the contrary, the proper interpretation of the content of the application as filed was that it included as one

possible practical variation of the preferred embodiment of the invention a fibre optic amplifier having only one light source.

In several decisions, the boards were required to give an opinion on interpreting the term "clearly and unambiguously derivable". These decisions also show how this criterion is applied in practice.

T 367/92 gives an example of an amendment rejected under Art. 123(2) EPC 1973 because it contained a specific term which, in the board's view, could not be considered to be clearly and unambiguously derivable from the originally disclosed generic term. In this case the issue of admissibility under said article boiled down to the question whether the generic term "polyester" could be equated with the specific term "polyethylene terephthalate". The sole document added by the appellant/patent proprietor in support of this interpretation proved only that polyethylene terephthalate was a polyester (which was never under discussion), but did not show that "polyester" could be interpreted as implicitly meaning "polyethylene terephthalate".

In **T 823/96**, the question whether or not a composition containing zero percent of a UV absorber was disclosed in the application as originally filed had, in the board's judgment, to take account of the whole content thereof and could not solely be based on the isolated parts of the description relied upon by the appellant. The board also observed that the term "**implicit** disclosure" should not be construed to mean matter that does not belong to the content of the technical information provided by a document but may be rendered obvious on the basis of that content. In the board's judgment, the term "implicit disclosure" relates solely to matter which is not explicitly mentioned, but is a clear and unambiguous consequence of what is explicitly mentioned. Therefore, whilst common general knowledge must be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document, the question of what may be rendered obvious by that disclosure in the light of common general knowledge is not relevant to the assessment of what is implied by the disclosure of that document. On the contrary, these two questions must be strictly separated. The board therefore did not agree with the appellant's submission that the decision under appeal was based on an underestimation of the common general knowledge. About "implicit disclosure" see also **T 1125/07** summarizing the case law and quoting among other decisions **T 860/00**.

In **T 1107/06**, quoting **T 860/00**, the board took the view that when there is a generic disclosure of the invention together with a specific disclosure of an illustrative or preferred embodiment falling under the generic disclosure, the skilled person will normally imply that all the other embodiments comprised in the generic disclosure without being mentioned specifically also form part of the invention. The non-exemplified or non-preferred embodiments are thus implicitly disclosed as the logical complement of the exemplified or preferred embodiments.

In **T 917/94** the board decided that the omission of a feature of a claim did not contravene Art. 123(2) EPC 1973, if this feature was implicitly defined by two other features and, being therefore redundant, its omission created no subject-matter extending beyond that of the application as filed.

In deciding on the admissibility of the newly submitted documents of the patent in suit, the board in **T 925/98** noted that according to the respondent, the range 30% to 50% given in claim 1 infringed Art. 123(2) EPC 1973, since such a range was not disclosed in the originally filed documents of the patent in suit, which only disclosed a general range of 30% to 60% and a preferred range of 35% to 50%. The board held, however, that, according to the established case law, in the case of such a disclosure of both a general and a preferred range, a combination of the preferred disclosed narrower range and one of the part-ranges lying within the disclosed overall range on either side of the narrower range was unequivocally derivable from the original disclosure of the patent in suit and thus supported by it (see **T 2/81**, OJ 1982, 394; **T 201/83**, OJ 1984, 481; see also **T 53/82**, **T 571/89**, **T 656/92**, **T 522/96** and **T 947/96** all referring to **T 2/81** and more recently see **T 1107/06**). Thus claiming a range from 30-50% did not contravene Art. 123(2) EPC 1973. In the case in point, moreover, graphs indicated that the claimed range was in fact the most efficient one.

T 985/06 concerned amending the upper limit of a range, supported in the description as filed, to a new (lower) value not thus supported, by changing it from 1.05:1 to 1.4:1 to 1.05:1 to less than 1.4:1. The board acknowledged that "1.05:1 to 1.4:1" included all values within the stated range. However, the application as filed disclosed only the range in general; it did not specifically, and thus directly and unambiguously, disclose all values within it. The amendment therefore contravened Art. 123(2) EPC. The respondent/patent proprietor also argued that if the upper limit of the claimed range "less than 1.4:1" lacked support in the description as filed, then it was a **disclaimer** which did have such support. But the board found that claim 1 did not contain any "negative" technical feature typically excluding from a general feature specific embodiments or areas.

In **T 329/99** the board stated that a clear distinction had to be made between the questions whether a particular embodiment was disclosed by an application, be it explicitly or implicitly, or/and whether that embodiment was merely rendered obvious by the application's disclosure (see **T 823/96**). A particular technical embodiment might be rendered obvious on the basis of the content of an application as filed without, however, belonging to its explicit or implicit disclosure and therefore without serving as a valid basis for amendments complying with the requirements of Art. 123(2) EPC 1973.

In the board's view in **T 686/99** the application as filed disclosed in an undifferentiated way different categories of base oils without any pointer regarding the selection of one particular category thereof. Priority was not given to ester oils from the original host of equivalent base oils. Therefore the board came to the conclusion that combining in claim 1 a base oil mandatorily comprising ester oils with the hydrofluorocarbons listed in claim 1 resulted from a multiple selection within two lists of alternative features, namely of ester oils from the list of base oils and of hydrofluorocarbons from the list of refrigerants, thereby generating a fresh particular combination. The content of the application as filed was not to be considered to be a reservoir from which individual features pertaining to separate sections could be combined in order to artificially create a particular combination. In the absence of any pointer to that particular combination, this combined selection of features did not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed. (See also **T 1206/01** ; and

T 1041/07 as a clear reminder about the relevant question when assessing whether a particular combination of features was disclosed in a document.)

In **T 962/98** the appellant argued that the claimed subject-matter derived from Example 1D and the content of the application as originally filed. In particular, tests carried out on the composition of Example 1D showed that the "four surfactants" could be applied in a more general context, present claim 1 being, furthermore, consistent with the description. The board did not rule out the possibility that there might be situations where some characteristics taken from a working example could be combined with other features disclosed in a more general context without necessarily creating an objectionable intermediate generalisation. However, under Art. 123(2) EPC 1973, such an intermediate generalisation was admissible only if the skilled person could recognise **without any doubt** from the application as filed that those characteristics were not closely related to the other characteristics of the working example and applied directly and unambiguously to the more general context. In other words, in order to be acceptable, this intermediate generalisation had to be the result of unambiguous information that a skilled person would draw from a review of the example and the content of the application as filed.

In the case at issue it was, in the board's view, not possible to conclude without any doubt whether or not those four surfactants either could be singled out of the composition of Example 1D and used with other carriers or were only adapted to the specific composition disclosed in Example 1D. The skilled reader was given no guidance, either in Example 1D itself or in the more general description as to which components of Example 1D should be retained unchanged, and which could be varied at will. This situation of doubt was in contradiction with the requirement that an amendment be directly and unambiguously derivable from the application as filed. Nor could this conclusion be rebutted by the tests carried out on the composition of Example 1D. Contrary to the appellant's submissions, in order to assess whether an amendment complied with the requirements of Art. 123(2) EPC 1973, the question was neither whether or not a skilled person could design other compositions in the light of the directions given by the tests nor whether or not the amended subject-matter was consistent with the description.

In case **T 619/05** the amendment concerned a feature not contributing to the solution of any technical problem by providing a technical effect. It was thus non-technical subject-matter. The term "subject-matter" in Art. 123(2) EPC, without a qualifier, seemed to indicate that this article applied to non-technical as well as technical subject-matter. Thus, any amendments concerning non-technical subject-matter should also be derivable from the patent application as filed. A difficulty in this connection was that a technically skilled person might not have the knowledge necessary in order to determine whether non-technical subject-matter had been added or not. Skills in a non-technical field might be required for deciding this issue. Since the members of a board of appeal were only required to be technically (or legally) qualified under Art. 21 EPC 1973, it would be up to the applicant (or patent proprietor) in such circumstances to provide evidence permitting a board to determine to its satisfaction how a person skilled in the relevant non-technical field would interpret the original patent application and the application (or patent) after amendment. In the present case the appellant did not

provide any proof at all that the amendments would be admissible, since it neither replied to the board's communication nor was it represented at the oral proceedings.

In **T 495/06** the appellant applicant's argument that the amendments were "not inconsistent" with the original disclosure failed to persuade the board, since the applicant thereby invoked a less stringent criterion for compliance with Art. 123(2) EPC than that developed in the jurisprudence of the boards of appeal, namely the question whether the amendment was "directly and unambiguously derivable" from the application documents as originally filed. In other words, the fact that an amendment was "not inconsistent" with the description was not a sufficient requirement for complying with Art. 123(2) EPC.

In **T 824/06** the board stated that for an amendment to be allowable under Art. 123(2) EPC required its direct and unambiguous disclosure; reasonable plausibility was insufficient.

In **T 314/07**, the question arose whether the amendment of the claim directed to the absorbent material was nevertheless directly and unambiguously derivable from a passage of the application as filed not describing the final absorbent material as such but the preparation of the intermediate film used therefor. The particular characteristics of the intermediate film described in the application as filed could be automatically transferred to the final absorbent material only if these characteristics would remain unchanged throughout the process of preparing the absorbent material, in other terms, if the location of the surfactant in the intermediate film was not altered by the process steps leading to the final absorbent material, such as aperturing and bonding the film to the other parts of the article. The board concluded that Art. 123(2) EPC was infringed.

7.2. The "is it essential" test

Another test developed by the boards of appeal for the allowability of an amendment, having regard to Art. 123(2) EPC concerns the **deletion** of a feature. In **T 66/85** (OJ 1989, 167) it was pointed out that if a technical feature was deleted from a claim in order not to exclude from protection certain embodiments of the invention, the broadening of the claim did not contravene Art. 123(2) EPC 1973 as long as there was a basis for a claim lacking this feature in the application as originally filed. It was immaterial whether or not the feature in question was relevant to the inventive concept of the claimed subject-matter (see also **T 228/98**).

T 133/85 (OJ 1988, 441) concerned a case where a feature was described as an essential feature of the invention but was not contained in the claim. The claim was therefore not supported by the description (Art. 84 EPC 1973). An **amendment to the description** to provide support for the claim was, however, not allowable under Art. 123(2) EPC 1973, because the amended description would contain subject-matter which extended beyond the content of the application as filed - namely information that such feature was not an essential feature of the invention.

On the other hand, in **T 260/85** (OJ 1989, 105) it was stated that it was not permissible to **delete** from an **independent claim** a feature which the application as originally filed

consistently presented as being an **essential feature** of the invention, since this would constitute a breach of Art. 123(2) EPC 1973. **T 496/90**, **T 189/94**, **T 628/91** and regarding deletion of the feature "substantially pure", **T 728/98** (OJ 2001, 319), confirmed this case law. In **T 628/91**, however, the disclosure was such that a structural feature could be replaced by a functional one, firstly because it was not disclosed as essential, secondly because its function was described.

In **T 415/91**, the board refused to allow the deletion of the feature "three-phase" alternating current. It argued that the low and high AC voltages were consistently referred to in the description and claims as being three-phase: the expression "three-phase" appeared about 200 times in the application as originally filed and no other number of phases was mentioned at all. The skilled person reading the application as originally filed would not necessarily have regarded the numerous references to "three-phase" as being purely by way of examples. Although it was possible that upon reflection, and using his imagination, it might occur to him that it was not essential to use three phases, this would be his own idea, resulting from his own thinking. It was not part of the content of the application as originally filed. In **T 236/95** the board examined whether, considering the problem derivable from the original description, three deleted features were represented as essential features of the invention. If the problem could not be solved without the features concerned, they could not be considered unimportant.

That the original disclosure is the determining factor is also clear from **T 331/87** (OJ 1991, 22), in which deletion of a non-essential feature was allowed: the replacement or removal of a feature from a claim may not be in breach of Art. 123(2) EPC 1973 if the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and (3) the replacement or removal required no real modification of other features to compensate for the change (see recently **T 775/07** and also **T 60/90** dealt with above in III.A.6.2.4).

Applying the above mentioned criteria in **T 396/95**, the board considered that whereas it was not expressly mentioned that the deleted feature ("carbonation") was essential for the invention this followed implicitly from the whole presentation of the invention. This feature was seen by the board to be indispensable for the function of the invention in the light of the technical problem it served to solve. Indeed the skilled person would not have regarded the carbonation feature as indispensable for the function of the invention, if the invention concerned the obtaining of chilled beverages and the problem underlying the invention consisted only of how to improve the cooling of the water in order to provide cooled beverages. But in the present case the application as originally filed related to "a water carbonator system" and the problem underlying the invention also comprised the improvement of gas/liquid mixing. In this case, the skilled person would regard the carbonation feature as indispensable for solving the problem underlying the invention.

In **T 374/93** the opponent argued before the board that the amount of polymer to be added to the suspension as defined in claim 1 of the original application was an essential feature, and that the deletion of this feature was not allowable under Art. 123(2) EPC

1973. The board did not agree, holding that the original application as a whole unambiguously taught that the amount of cationic polymer to be added to the suspension depended on various parameters and could easily be experimentally determined. In the board's judgment, a skilled person would therefore interpret the relevant passage, in the light of the original specification as a whole, as an instruction to facilitate the finding of the optimum amount of cationic polymer, or as an advantageous embodiment of the originally disclosed invention. In view of these considerations, the deleted feature of the originally filed claim 1, suggesting the need to raise in steps the amount of polymer to be added if the amount of cationic binder were reduced from a value just above 0.5% to a value just below this value, appeared to be inconsistent with the teaching of the original application. In any case, in the board's view, the skilled reader would not immediately and unambiguously recognise from the passage containing several relative terms and expressions such as "in some instances", "eg", "normally" and "usually", that the feature as deleted from the original claim 1 was a mandatory feature.

In **T 784/97** the patent proprietor alleged that a prior art document would have made the skilled person aware that the disputed feature was not essential. The board held that whether or not a feature of an independent claim had to be seen as "essential" could not be a question of the prior art disclosure. Rather, what had to be decided was what a skilled person was taught by the originally filed documents. In the present case, a skilled person having considered the originally filed documents was aware that the particle size was part of the alleged invention, so that this feature could not be omitted from an independent claim at a later stage without contravening the requirements of Art. 123(2) and Art. 100(c) EPC 1973.

Any attempt to interpret Art. 123(2) EPC 1973 such that the introduction into a claim of features previously described as non-essential would not be permissible, must fail. The board based this statement in **T 583/93** (OJ 1996, 496) on the consideration that the Convention contained no requirement that forbade the redefinition of an invention provided that Art. 123(2) and (3) EPC 1973 were complied with. Such a redefinition was often necessary in order to take into account prior art not known to the applicant at the priority date. It was therefore possible that features described as optional at the priority date later became essential in the sense that they were necessary to delimit the invention from the prior art. The introduction of such features was permissible provided that, first, the application as originally filed contained an adequate basis for such limitations and, second, the resulting combination of features was still in line with the teaching of the application as originally filed.

7.3. The "novelty test"

Recent case law no longer refers to the "novelty test". Decisions **T 60/03** and **T 1374/07**, however, as well as the Guidelines do include a passing reference. The beginning of section 7.1 also addresses the question of the validity of the novelty test.

T 133/85 (OJ 1988, 441) pointed out that care was necessary when applying the law relating to novelty to questions which arose in relation to Art. 123(2) EPC 1973. In

T 177/86 the novelty test was described as "not very useful" for examining the admissibility of broadening a claim (see also **T 150/07**).

The following decisions provide an overview mainly of the previous practice of the boards of appeal:

In **T 201/83** (OJ 1984, 481) it was stated that the test for compliance with Art. 123(2) EPC 1973 was basically a novelty test, i.e. no new subject-matter may be generated by the amendment. This was approved in **T 136/88**. **T 17/86** (OJ 1989, 297, Corr. 415) added that novelty could be found in a limitation, the addition to a claim of a further feature, or even in the absence of one of the elements of a device. The novelty test was incorporated in the Guidelines; in the April 2010 version (C-VI, 5.3.1) of the Guidelines reference is still made to this test, at least where the amendment is by way of addition (see also **T 1374/07** quoting **T 201/83**).

In **T 416/86** (OJ 1989, 309) it was held that the fact that a technical means (in this case an aperture of a special design) was known did not take away the novelty of its equivalents (in this case, apertures of a different design producing the same effect as the former) even if the equivalents were themselves well known. It followed that the equivalents of a disclosed technical means had to be considered new and therefore not disclosed if they were not mentioned in the original documents. In accordance with these principles, the board decided that the replacement of a specific feature disclosed in the invention by a broad general statement was to be considered as an inadmissible amendment under Art. 123(2) EPC 1973 when this general statement implicitly introduced for the first time specific features other than that originally disclosed. Therefore, the substitution in the claim of a structurally defined element of that claim by its known function (or disclosed function) was considered contrary to Art. 123(2) EPC 1973.

However, in **T 873/94** (OJ 1997, 456) the board pointed out that where a proposal for amending an application involved the addition of a limiting feature to a claim, applying a "novelty test" was not appropriate for determining whether or not the amendment complied with Art. 123(2) EPC 1973. Following **G 1/93** (OJ 1994, 541), the board pointed out that the underlying idea of Art. 123(2) EPC 1973 was clearly that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. In the light of these considerations the addition to a claim before grant of an undisclosed limiting feature might or might not violate Art. 123(2) EPC 1973, depending on the circumstances.

B. Article 123(3) EPC

Art. 123(3) EPC is worded as follows: "The European patent may not be amended in such a way as to extend the protection it confers." This refers to the patent as a whole; Art. 123(3) EPC thus contains a substantive clarification. This principle is applicable in all proceedings before the EPO.

1. General issues

In **T 325/95** the patent proprietor amended a granted claim by introducing limiting features disclosed only in the description. The appellant (opponent) argued that claim 1 as granted did not actually afford any scope of protection whatsoever, because the claim was invalid, its subject-matter lacking an inventive step. Since the features added to claim 1 were not set out in any of the dependent claims as granted, the subject-matter now covered by amended claim 1 was not covered by any of the claims. Therefore, by introducing features disclosed only in the description the scope of the claims had been extended within the meaning of Art. 123(3) EPC 1973.

The board pointed out that this argumentation was based on the assumption that the extent of protection referred to in Art. 123(3) EPC 1973 would depend not only on the actual wording of the claims, but also on their validity in view of the prior art. This assumption however was not supported by the explicit statement in Art. 69 EPC 1973 that "the extent of the protection conferred by a European patent ... shall be determined by the terms of the claims". Appellant's submissions in effect also implied that claims amended in opposition proceedings should always have a counterpart in the set of claims as granted. This was not in line with the consistent case law of the EPO either. Attention was drawn for instance to decision **G 2/88** (OJ 1990, 93), which ruled that replacement of a granted claim to a compound or composition by a claim directed to a new use of the compound or composition was admissible under Art. 123(3) EPC 1973.

In **T 1149/97** (OJ 2000, 259) the board decided that, without opposition, issue of a decision to grant a European patent normally constituted a cut-off point for making amendments to the application documents in the European proceedings. If an opposition has been filed, cut-off effects due to the grant of a patent might be seen in the restrictions which R. 57a, R. 87 and Art. 123(3) EPC 1973 imposed on further amendment of the patent specification. Although Art. 123(3) EPC 1973 addressed only the claims of the European patent, amendments to the description and the drawings might also extend the protection conferred in accordance with Art. 69(1) EPC 1973.

If, in view of Art. 84 and Art. 69 EPC 1973, the application documents were adapted to amended claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule subject-matter deleted for this reason could not be reinserted either into the patent specification or into the claims as granted without infringing Art. 123(3) EPC 1973. An analogous finding applied to subject-matter retained in the patent specification during such adaptation for reasons of comprehensibility, but indicated as not relating to the claimed invention.

Dealing with the allowability of amendments in **T 81/03**, the board detailed why it considered that the facts of the case dealt with in **T 1149/97** (OJ 2000, 259) differed from those of the case in point, contrary to the opponents' allegation of a substantive cut-off effect of the grant of a European patent. In reply to the opponents' second line of argument it further stressed that Art. 69 EPC 1973 and its Protocol were to be applied in proceedings before the EPO whenever it was necessary to determine the protection

conferred (see for example **G 2/88**, OJ 1990, 93). Equivalence considerations obviously often played a prominent role in national infringement proceedings, and although equivalents were not mentioned in the EPC 1973, they would be in the Protocol on Art. 69 of the revised Convention, EPC 2000 (OJ SE 1/2003, 73). Nevertheless, in spite of the indisputable importance of the concept of equivalence for the determination of the scope of protection, if the opponents had been right in their allegations, it would never be possible to amend a claim during opposition proceedings - although this was provided for in the Convention - since the addition of any new feature to some extent necessarily reduced the weight of the features in the claim as granted. This was particularly true when the subject-matter of the granted claim was not new, the situation in which amendments were most called for. For that reason the argument could not be accepted. The board thus found that the general, abstract concern that the addition of a feature to a claim after grant led to an extended scope of protection because the resulting combination of features might give rise to a different evaluation of equivalents in infringement proceedings was not in itself a sufficient reason for not allowing the addition of limiting features under Art. 123(3) EPC 1973.

The board agreed with the patent proprietor that there was no basis in the EPC 1973 for the idea that amendments after grant had to be based on subject-matter contained in the patent specification. The wording of Art. 123(2) EPC 1973 was unambiguous. It was Art. 123(3) EPC 1973 which was intended to protect the interests of third parties, as pointed out by the Enlarged Board in **G 1/93** (OJ 1994, 541). In the board's view it followed that amendments to a European patent could be based on the whole reservoir of features originally disclosed in the corresponding application, provided that Art. 123(3) EPC 1973 was not infringed by such amendments, due account being taken of the provisions of Art. 69(1) EPC 1973.

In **T 241/02** in the board's view neither the fact that the appellant (proprietor) approved the text of the patent in suit nor considerations with respect to legal certainty added to the requirements relating to amendments in R. 57a or Art. 123(2) EPC 1973. The grant of a patent therefore did not necessarily constitute a final and automatic cut-off point ruling out any reinsertion of deleted subject-matter (in the case at issue, reinsertion of portions of the description relating to the process claimed). The said reinsertion complied in this case with both R. 57a and Art. 123(2) EPC 1973. It remained therefore for the board to examine whether the requested reinsertion satisfied Art. 123(3) EPC 1973. The opposition division had concluded on the basis of **T 1149/97** (OJ 2000, 259) that reinsertion would not be possible, since it would contravene Art. 123(3) EPC 1973, but without referring to any specific parts or making any connection between parts to be reinstated and any concrete conclusion as to how the product claims would be extended in contravention of Art. 123(3) EPC 1973. The board decided that, by contrast with the situation in **T 1149/97**, in the case in point the appellant had deleted too much of the description, overlooking the relevance of parts of it to these remaining claims. According to the board, **T 1149/97** did not lay down a strict rule. It required that an examination of a request for reinsertion be carried out with a view to establishing whether or not Art. 123(3) EPC 1973, on the facts of each case, was indeed infringed. Since the requested reinsertion had to be examined in detail, in the case at issue the opposition division's decision was not sufficient to reject the reinsertion as a whole. Since at that

point it was uncertain which parts of the requested reinsertion still might violate one or more requirements of the Convention and the further patentability criteria had not yet been examined in the opposition proceedings, the board decided to remit the case for further prosecution.

In **T 975/03** the appellants/opponents referred to decisions **T 420/86** and **T 61/85** in support of their argument, regarding the reintroduction of the feature of claim 1 deleted before the grant of the patent, that the appellant/patent proprietor could not reinsert into the patent a feature it had deleted during the examination procedure, as such deletion was equivalent to abandonment. In the board's view, however, no legal grounds for the latter assertion were indicated in **T 420/86** (or in **T 61/85**). This decision had also preceded the ruling in **G 7/93** (see point 2.1). The board even held that the grant of a patent did not necessarily establish an automatic and final cut-off point which ruled out any reintroduction of deleted subject-matter. The amendment in the case at issue was therefore allowable, provided that it did not breach the requirements of R. 57a and Art. 123(2) and (3) EPC 1973. The feature in question was introduced by the appellant/patent proprietor in order to counter a novelty objection; therefore, the amendment complied with the requirements of R. 57a EPC 1973. The feature was contained in the application as filed, e.g. in claim 1, so the requirements of Art. 123(2) EPC 1973 were also met. Since the feature limited the extent of protection conferred by the claim, the requirements of Art. 123(3) EPC 1973 were met, too. The board therefore concluded that inserting the feature of claim 1 was allowable with respect to the formal requirements of the EPC. The board also decided to refuse the request for referral of a point of law to the Enlarged Board of Appeal. After analysing the case law, the board concluded *inter alia* that none of the cases involved the constellation in which a feature was allowable under Art. 123(3) EPC 1973 but was then disallowed because of a supposed cut off effect or an abandonment.

Decision **T 190/99** gives a guidance on how to interpret a claim as granted for the purpose of Art. 123(3) EPC.

In **T 666/97** the product claim of the auxiliary request no longer included a process feature which was included in the product claim as granted. In the board's view it followed from the fact that the subject-matter for which protection was claimed in the auxiliary request was a product that it could only be characterised by features manifest in/on the product itself. That meant that manipulations taking place during product manufacture but not resulting in product features were of no relevance to the definition of the claimed product and hence to the scope of protection of the claim. That was an unavoidable implication of the established case law of the boards of appeal, under which the subject-matter of a product-by-process claim derives its novelty not from new procedural steps but purely from structural features (see **T 205/83**, OJ 1985, 363).

Thus, to resolve the issue of compliance with the requirements of Art. 123(3) EPC 1973, what had to be decided was whether the omitted product-by-process feature was technically significant for the definition of the claimed product, i.e. whether it was a product feature. The board found that in the present case the omitted feature was not a

product feature. Thus the claim had not been extended within the meaning of Art. 123(3) EPC 1973.

The board in **T 1052/01** took the view that deleting examples given in claim 1 as granted (here "valve, restrictor, etc.") for a generalised feature (here "hydraulic functional unit") did not extend the protection conferred, as these examples were embraced by the generalised feature which determined the extent of the protection conferred.

In **T 579/01** the board held that in accordance with established case law the legal notion of "protection conferred" in Art. 123(3) EPC 1973 referred to the totality of protection established by the claims as granted and not necessarily to the scope of protection within the wording of each single claim as granted. Under Art. 123(3) EPC 1973, the patentee was generally allowed to redraft, amend or delete the features of some or all claims and was not bound to specific terms used in the claims as granted as long as the new wording of the claims did not extend the scope of protection conferred as a whole by the patent as granted (and did not violate the requirements under Art. 123(2) EPC 1973). Thus in the board's view in **T 579/01**, in order to assess any amendment under Art. 123(3) EPC 1973 after grant, it was necessary to decide whether or not the totality of the claims before amendment in comparison with the totality of the claims after amendment extended the protection conferred.

In the case in point, independent claim 1 and dependent claims 2 to 6 of the new main request were directed to a "vegetable plant", while the respective claims as granted were directed to a "cell in a vegetable plant". The board said that in the understanding of the skilled person the term "a cell of a plant", not being qualified as "isolated", included various physiological and morphological states of such a cell, including both differentiated and undifferentiated states. The cells in the different states in which they existed in a (developing) plant fell within the protection conferred by the claim to the "cell of a vegetable plant" as granted, and the protection conferred by such claim also extended to such cells in a plant. Furthermore, the biological notion "cells of a plant" encompassed such differentiated cells which were morphologically and functionally organised to constitute a plant. That implied that morphologically and functionally organised aggregates of plant cells, e.g. plants, likewise fell within the protection conferred by the granted claim to "a cell of a plant".

The board also decided that **any** plant as subject-matter of claim 1 of the new main request fell within the protection conferred by a claim to "a cell of a plant", and finally that the "plant" now claimed was characterised by the same genetic features as recited in the granted claim to "a cell of a plant". Also taking account of legislative developments in Europe in respect of the legal protection of biotechnological inventions (i.e. Articles 8.1 and 9 of Directive 98/44/EC), the board concluded that the amendment of the "cell of a plant" claim to a "plant" claim was not contrary to the requirements of Art. 123(3) EPC 1973.

In **T 142/05** the board found that, even where the wording of the granted claims was unamended and clear, the mere deletion from the description of an important desired property of the patented subject matter led to an extension of the scope of protection

which contravened Art. 123(3) EPC 1973. In the case at issue, the following sentence was deleted during the opposition proceedings from the description in the text as granted: "Such a fuel hose shows a heat resistance of up to ca. 160°." The wording of the claims corresponded to the text as granted. The question arose whether, although the wording of the granted claims remained unchanged, the mere fact of deleting the above sentence from the description could extend the protection conferred by the patent and lead to a violation of Art. 123(3) EPC 1973. Construed literally, this provision could be taken to mean that amendments to the description were not affected by this restriction, since only the patent claims were mentioned. The board concluded that, although the claims were the most important element in determining the extent of protection, the wording of the claims should not be seen as the sole relevant factor; instead, the description and drawings were to be used in interpreting the claims. From this, it followed that even if the wording of a claim was clear and unambiguous, i.e. where the scope of its literal meaning was clear, reference was still to be made to the description and claims. This could lead to a different interpretation of the claim, diverging from that obtained by considering only its literal meaning. Amendments to the description and drawings could modify the content of the claims and thereby extend the scope of protection according to Art. 69(1) EPC 1973, even where the wording of the claims was clear and remained unamended. In the board's view, the deletion of the sentence at issue clearly led to an extension of the scope of protection. The deletion had the effect of generalising the teaching of the patent, since without this information the extent of the heat resistance shown by the patented hose remained open. Art. 123(3) EPC 1973 had therefore been contravened.

2. Generalisation of a feature

The board of appeal held in its decision **T 371/88** (OJ 1992, 157) that Art. 123(3) EPC 1973 was not contravened if a restrictive term in a granted claim which in its strict literal sense did not embrace an embodiment set out in the description was replaced by a less restrictive term. The restrictive term should not, however, be so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the description and drawings. Moreover, it had to be quite clear from the description and drawings and also from the examination procedure up to grant that the further embodiment belonged to the invention and that it was never intended to be excluded from the protection conferred by the patent (see also **T 673/89**, **T 738/95**, **T 750/02**; **T 749/03** above).

In **T 795/95** the board did not share the appellant's view that deleting the feature "preferably polyvinyl or polyethylene" from the preamble of granted Claim 1 extended the protection conferred. The formulation "preferably polyvinyl or polyethylene" had no bearing on the scope of protection, which was determined by the more general term "plastic" and not the specific preferred substances polyvinyl or polyethylene. Deleting a "preferred" feature did not extend the scope of protection if such feature was encompassed by an earlier and general one (in this case, "plastic") which determined the protection conferred.

3. Transposition of features

In **T 16/86** the board pointed out that it was the subject-matter of the claim as a whole which embodied the invention. Therefore, in so far as a change in the position of a feature inside a claim did not alter its meaning, the extent of protection conferred remained unchanged and such an amendment contravened neither Art. 123(2) nor Art. 123(3) EPC 1973.

In **T 160/83** the board had no objection to the appellants' amendment of the characterising clause so as to include a feature which was previously in the preamble but not shown in the document representing the closest state of the art.

In **T 96/89** the board of appeal again allowed the transposition of features from the preamble of a claim to its characterising portion. This did not alter the subject-matter claimed, and thus did not extend the scope of protection. Nor was it in breach of Art. 123(3) EPC 1973 if terms were first generalised in the preamble, then trimmed back in the characterising portion to the subject-matter originally disclosed. R. 29(1) EPC 1973 required that claims be delimited against the nearest prior art; before the preamble to an independent claim could be drafted at all it was often necessary to select from two restrictive terms (the subject-matter claimed and the closest prior art) a general term covering both.

In **T 49/89** the subject-matter of granted claim 1 had been limited during opposition proceedings to a special embodiment according to granted dependent claim 2. The board of appeal held that the protection had not been extended because new claim 1 indicated all the features in granted claim 1 and the newly incorporated features were merely elaborations on those contained in granted claim 1. The extent of protection conferred by a European patent was determined by the content of **all** claims, not that of one or several only. Thus, for example, even though an independent claim lacked novelty a claim dependent on it could still be valid and the patent proprietor could restrict himself to that claim. It was, moreover, irrelevant when determining the extent of protection whether features were referred to in the prior art portion or characterising portion. The transposition of information from one to the other did not therefore contravene Art. 123(3) EPC 1973 (**T 49/89**, **T 579/01**, **T 411/02**, **T 250/02**).

4. Change of claim category

Enlarged Board decision **G 2/88** (OJ 1990, 93) related to a change of claim category in opposition proceedings, and in particular to the change from a product claim to a use claim. It stated that a change of category of granted claims in opposition proceedings was not open to objection under Art. 123(3) EPC 1973, if it did not result in extension of the protection conferred by the claims as a whole, when they were interpreted in accordance with Art. 69 EPC 1973 and its Protocol. In this context, the national laws of the contracting states relating to infringement should not be considered, for there was a clear distinction between the protection which was conferred and the rights which were conferred by a European patent. The protection conferred by a patent was determined by the terms of the claims (Art. 69(1) EPC 1973), and in particular by the categories of

such claims and their technical features. In contrast, the rights conferred on the proprietor of a European patent (Art. 64(1) EPC 1973) were the legal rights which the law of a designated contracting state might confer upon the proprietor. In other words, in general terms, determination of the "extent of the protection conferred" by a patent was a determination of what was protected, in terms of category plus technical features; whereas the "rights conferred" by a patent were related to how such subject-matter was protected.

When deciding upon the allowability of an amendment involving a change of category, the considerations were, in principle, the same as when deciding upon the allowability of any other proposed amendment under Art. 123(3) EPC 1973.

An amendment of granted claims directed to "a compound" and to "a composition including such compound", so that the amended claims were directed to "the use of that compound in a composition" for a particular purpose, was not open to objection under Art. 123(3) EPC 1973. For it was generally accepted as a principle underlying the EPC that a patent which claimed a physical entity per se, conferred absolute protection upon such physical entity, for all uses of such physical entity, whether known or unknown. It followed that if it could be shown that such physical entity (e.g. a compound) was already part of the state of the art, then a claim to the physical entity per se lacked novelty. It also followed that a claim to a particular use of a compound was in effect a claim to the physical entity (the compound) only when it was being used in the course of the particular physical activity (the use), this being an additional technical feature of the claim. Such a claim therefore conferred less protection than a claim to the physical entity per se.

In **T 912/91** the appellant/patentee claimed the use of graphite for obtaining a sintered composite ceramic body having certain characteristics. The board held that the change of claim category from the granted product claims for composite bodies to these use claims did not broaden the scope of protection of the granted claims. Even if it were considered that the use claim was notionally equivalent to a claim to a process including the step of using the graphite in the sintered body and that the effect of Art. 64(2) EPC 1973 was to confer protection on the product resulting from this process as well, this would not represent an extension of protection within the meaning of Art. 123(3) EPC 1973, since the sintered composite body was defined in the use claim in a more restricted way than the composite body of the granted claim (narrower range of the graphite content, etc.).

In **T 134/95** a patent had been granted in respect of a "container for medical use". The claimed apparatus was designed to permit the separate storage and the mixing, at the time of use, of three predefined and different compounds. The protection conferred therefore related to the apparatus and, necessarily, to its use at least for the purposes of storage and mixing. After amendment, the claim became a use claim, covering only the use of the container and no longer protecting the apparatus as such. Having pointed out that inventions of this kind were designed with a particular object in mind and could not normally be used for other purposes, the board noted that in this case, the change of

category, replacing the granted claim with a claim for the use of the container, had the effect of limiting the scope of protection. The amendment was therefore allowable.

Contrary to the opponents' allegation that a "drip solution" was obtained, the board concluded that the use of the container did not lead to the manufacture of a product; on the contrary, its purpose was to carry out two successive handling operations (the separate and sterile storage of each of the three solutions, and then the sterile compound mixing of these solutions at the time when they were administered) as explicitly stated in the granted claim (in respect of compartments for "separate storage and subsequent mixing, immediately before use" of the three solutions). The intended purpose was to conserve each of the three solutions during the storage phase and to mix them immediately before use, avoiding any premature change of the mixture. The two stages of the process therefore in no way had the effect of modifying the starting solutions with a view to obtaining or manufacturing a product. This use therefore fell into the category "use of a physical entity to obtain an effect or result", and on this basis the change of category was allowable.

In **T 279/93** the board found that a claim to the use of a compound A in a process for preparing compound B had no broader scope than a claim to a process for preparing compound B from compound A. It had already been stated in **G 2/88** (point 2.5 of the Reasons) that the technical features of a claim to an activity were the physical steps which defined such activity. In this case, the board considered that process claim 1 as filed, process claim 1 as granted and use claim 1 filed on appeal all related to the same physical steps, and that the claims were therefore of the same scope. On this view, the scope of protection conferred by this use claim was not broader than that conferred by the granted process claim (see also **T 619/88**).

A change from a product claim to a claim for the use of the product was also allowed in **T 37/90**, **T 75/90**, **T 938/90** and **T 879/91**.

In **T 420/86** a change from a claim for a process for treating soil, in which X was used, to a claim for the use of X for treating soil was allowed. In **T 98/85** on the other hand, a change from a "process for the preparation of a ... composition" to the "use of this ... composition as a ..." was seen as a breach of Art. 123(3) EPC 1973.

In **T 276/96** the board decided in view of **G 5/83** (OJ 1985, 64) that the change of claim of the type "Method of fabricating item A using item B providing effect C" to a claim of the type "Use of item B in a method of fabricating item A to provide effect C" did not extend the protection conferred, since with both formulations the same activity would be forbidden to competitors.

A change from a product claim to a claim for a process for manufacturing the product is generally seen as unproblematical (**T 54/90**, **T 191/90**, **T 762/90**, **T 153/91** and **T 601/92**). In **T 423/89** the change in category from a product-by-process claim to a manufacturing process claim was admissible. In **T 402/89**, however, the board pointed out, in passing, certain difficulties in interpreting the term "protection conferred".

In **T 5/90** the patent was granted with a claim in the form "a product having product features x and product-by-process features characteristic of process steps y". This claim, however, turned out not to be novel. The patentee finally claimed "a process of making a product having product features x by using process steps y and process steps z".

The board interpreted such a claim as covering the process steps only in so far as a product having product features x actually resulted. This was called a process-limited-by-product claim by the board. The direct product of this process would also be protected under the provisions of Art. 64(2) EPC 1973, but such product inevitably fell within the scope of the product claim originally granted. The board regarded a process-limited-by-product claim of this type as clearly complying with the requirements of Art. 123(3) EPC 1973 because it would only be infringed if the product fell within the originally granted product claim and in addition the particular form of manufacture using process steps z was used.

In **T 20/94** the patent in suit in the form as granted exclusively comprised process claims for preparing a product. In the form as amended it comprised a product claim relating to the product per se. The board stated that the protection conferred by a claim directed to a process for preparing a product covered that process. Pursuant to Art. 64(2) EPC 1973, a product directly obtained by that process was also protected, but it was not protected when obtained by any other process. However, the protection conferred by a claim directed to a product per se was absolute upon that product. The product claim thus conferred protection on that product regardless of the process by which it was prepared.

The appellant attempted to overcome this objection by formulating the product claim as amended in the form of a product-by-process claim using the term "directly obtained". The board did not agree with this line of argument, stating that a product-by-process claim was interpreted as a claim directed to the product per se, since the only purpose of referring to a process for its preparation was to define the subject-matter for which protection was sought, which was a product. Whether or not the term "directly obtained" or any other term, such as "obtained" or "obtainable", was used in a product-by-process claim, the category of that claim did not change. Thus amended claim 1 in the case in question contravened Art. 123(3) EPC 1973.

In **T 426/89** (OJ 1992, 172) the claim related to a process for operating a pacemaker. An actual operating method for a pacemaker for arresting a tachycardia would necessarily be a method for treating the human (or animal) body by therapy using a pacemaker, and would not be patentable. However, the patentee maintained that the claim referred to the steps in a technical method which did not define a method of treatment but rather, in functional terms, the structural features of a pacemaker. The board agreed. If correctly interpreted in accordance with Art. 69(1), second sentence, EPC 1973 claim 1 did not define a method but rather an apparatus (pacemaker) in terms of the functions of its components. Since the reference to a method in the designation of the subject-matter of claim 1 did not make this explicit, the board regarded claim 1 as not "clear" within the meaning of Art. 84 EPC 1973. The differences between the patent according to the auxiliary request and the granted version were that in claim 1 the title of the invention,

"Method for the operation of a pacemaker", had been replaced by "Pacemaker". The board pointed out that the amendment of claim 1, including its change of category, did not contravene Art. 123(3) EPC 1973. Claim 1 as granted was already a product claim containing a functional definition of a pacemaker. So the seeming change of category did not alter the content of the claim but simply served to clarify it (see also **T 378/86**, OJ 1988, 386).

In **T 82/93** (OJ 1996, 274) the granted patent contained a claim 1 relating to a method of operating a pacer. The board found that this claim defined a method for treatment of the human body by therapy and therefore was not allowable under Art. 52(4) EPC 1973. It held that the device claim of the auxiliary request was not allowable under Art. 123(3) EPC 1973. The subject-matter protected by the granted claim was a pacer, **when in use**; in contrast, the claim of the auxiliary request only included technical features which defined physical characteristics of the pacer device itself. The board explained that in general terms, if a patent as granted only included claims defining the operation of a device and therefore containing both "device features" and "method features", and the proposals to amend the patent during opposition proceedings included claims which only contained "device features", the proposed amendment was not allowable having regard to Art. 123(3) EPC 1973, because the patent as granted conferred protection upon the device only when it was in use so as to carry out the method, whereas the proposed amended patent would confer protection upon the device whether or not it was in use, and would therefore confer additional protection compared to the patent as granted.

In contrast to the findings in **T 426/89** mentioned above, in this case the board held that claim 1 as granted was clear, defined the use of a device to carry out a method of treatment of the human body by therapy and was not a pure "device claim" since it also included method steps. Thus, under such circumstances, Art. 52(4) and Art. 123(3) EPC 1973 might operate in combination as an "inescapable trap".

In **T 1206/01** the board clearly pointed out that according to the established case law of the boards of appeal a product claim conferred protection on the claimed product, regardless of the process or method by which it was prepared. Therefore a change of category from a granted product claim to a process claim restricted to one or more methods of preparing the product did not extend the protection thereby conferred.

In **T 352/04** the patent related to a hair-setting agent. The question arose whether the scope of protection had been extended by an amendment, and in particular by the addition of "with a mechanical spray device" in claim 1. The board drew attention to the jurisprudence, which says that the scope of the protection conferred by a patent is defined not only by its technical features but also by the category of the claims. It found that the inclusion of the mechanical spray device as a separate element in claim 1 also changed the claim category, which could now embrace a spray device containing the cosmetic agent. The amended claim 1, therefore, enabled not only a means patent (for hair treatment) but also an apparatus patent (mechanical spray device containing the cosmetic agent) to be given protection. The board further found that a mechanically driven spray device containing a cosmetic hair-treatment agent could not be regarded as

either a process for manufacturing the hair-treatment agent or a (further) use of the agent, nor did it involve a category change which could be considered admissible under Art. 123(3) EPC 1973. On the contrary, the amendment of the claim shifted the patent proprietor's protection, at the cost of legal certainty for third parties, towards the inclusion of further, previously unprotected subject-matter, which however was precisely what Art. 123(3) EPC 1973 sought to prevent.

The board concluded that incorporating the feature "with a mechanically driven spray device" had brought within the scope of protection subject-matter which now also comprised, in addition to the cosmetic hair-treatment agents, a mechanical spray device in the most widely varied embodiments, since the scope of protection could not be limited to the wording of the claim. As the claim's amended wording now also protected a mechanical device not covered by the claim as granted, the scope of the protection conferred by the patent at issue had been extended vis-à-vis the hair-treatment agent as granted. The contested patent's text as maintained therefore contravened Art. 123(3) EPC 1973.

C. Relationship between Article 123(2) and Article 123(3) EPC

1. Cases of conflict

In **T 384/91** (OJ 1994, 169) the question was referred to the Enlarged Board whether, given the requirements of Art. 123(2) and (3) EPC 1973, a patent could be maintained in opposition proceedings if its subject-matter extended beyond the content of the application as filed, whilst at the same time the added feature limited its scope of protection. The conflict here was that the "limiting extension" had to be deleted as a breach of Art. 123(2) EPC 1973, but to do so would broaden the scope of the patent and thus contravene Art. 123(3) EPC 1973 (see **G 1/93**, OJ 1994, 541).

This problem was extensively discussed for the first time in **T 231/89** (OJ 1993, 13). In this decision, an additional, limiting feature was added to the claim during grant proceedings. The opposition division revoked the patent on the grounds that the feature had not been disclosed in the application as originally filed but its deletion would contravene Art. 123(3) EPC 1973. The board of appeal held it to be inappropriate to take paragraphs 2 and 3 of Art. 123 EPC 1973 as independent of each other while applying them in conjunction to revoke the patent. This "paradoxical result" could be avoided by interpreting the two paragraphs in terms of their mutual relationship, where one was predominant, i.e. independent, and the other subordinate, i.e. dependent:

- (a) If Art. 123(2) EPC 1973 was predominant, the added feature would have to be deleted in spite of Art. 123(3) EPC 1973;
- (b) If Art. 123(3) EPC 1973 was to be taken as independent, the added feature could remain.

If the limiting feature was irrelevant for novelty and inventive step, it seemed reasonable to opt for alternative (b); protection of third parties was then crucial. If, on the other hand

- as was the case here - the added feature had no technical significance, then alternative (a) seemed appropriate and, thus, the deletion of the feature justified.

In **T 10/91** a neutral feature of no particular value for the skilled person was added during the examination proceedings. The feature had no technical significance. It could therefore stay in the claim, but could not be taken as delimiting when examining for novelty and inventive step.

In **T 938/90**, however, the addition was technically significant and it had to be taken into account in the examination for novelty and inventive step. The board therefore declined to apply the principles developed in **T 231/89** and dismissed the patent proprietor's appeal against the revocation of the patent (see **T 493/93**).

2. Decision G 1/93 of the Enlarged Board of Appeal

In **G 1/93** (OJ 1994, 541) the Enlarged Board of Appeal ruled on the question of "limiting extensions" as follows:

If a European patent as granted contained subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973 and which also limited the scope of protection conferred by the patent, such patent could not be maintained in opposition proceedings unamended, because the ground for opposition under Art. 100(c) EPC 1973 prejudiced the maintenance of the patent. Nor could it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which was prohibited by Art. 123(3) EPC 1973. Therefore, in principle, if the European patent as granted contained a "limiting extension", it had to be revoked. Paragraphs 2 and 3 of Art. 123 EPC 1973 were mutually independent of each other. In this sense, it had to be admitted that Art. 123(2) EPC 1973 in combination with Art. 123(3) EPC 1973 could operate rather harshly against an applicant, who ran the risk of being caught in an inescapable trap and losing everything by amending his application, even if the amendment was limiting the scope of protection. However, as submitted by the opponent, this hardship was not per se a sufficient justification for not applying Art. 123(2) EPC 1973 as it stood in order to duly protect the interests of the public. Nor did it, in principle, matter, that such amendment had been approved by the examining division. The ultimate responsibility for any amendment of a patent application (or a patent) always remained that of the applicant (or the patentee).

The Enlarged Board, however, also mentioned three other instances:

- If the added feature could be replaced by another feature disclosed in the application as filed without breaching Art. 123(3) EPC 1973, the patent could be maintained (in amended form). This might turn out to be a rare case in practice (see below **T 166/90**).
- An added undisclosed feature without any technical meaning could be deleted from a claim without violating Art. 123(3) EPC 1973.

- An added feature, which did not provide a technical contribution to the subject-matter of the claimed invention but merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, was not considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973. In this case also the patent could be maintained.

Board of Appeal 3.4.02 noted in **T 335/03** that, according to **G 1/93**, there was no basis in the Convention for providing a claim with a footnote to the following effect; "This feature is the subject of an inadmissible extension. No rights may be derived from this feature"; in other words, in cases of conflict between Art. 123(2) and Art. 123(3) EPC 1973 the footnote solution is inadmissible.

On the basis of decisions **G 1/93** and **G 1/03** dealing with Art. 123(2) and (3) EPC 1973 and with disclaimers, the board in **T 1180/05** came to the conclusion that the deletion of a feature in a granted claim, which feature extended beyond the content of the application as filed, and its reintroduction in the form of a disclaimer, so that the subject matter of the claim remained the same, was not suitable to overcome the potential conflict between paragraphs 2 and 3 of Art. 123 EPC 1973. The board decided not to refer the question to the Enlarged Board of Appeal as requested by the patent proprietor. The decision of the opposition division maintaining the patent in amended form was set aside and the patent revoked.

3. Resolving the conflict in exceptional cases

In some cases the conflict between Art. 123(2) and Art. 123(3) EPC 1973 can be resolved. In **T 166/90** the board allowed an inadmissible feature in a granted claim to be replaced by other disclosed features, since this did not extend the scope of protection. The invention concerned an opaque plastic film. The product claim as granted contained a feature stating that the density of the film was less than the arithmetical density from the type and proportion of the individual components. In opposition proceedings the patent proprietor claimed a process for manufacturing the film, but without including in his process claim the density-related feature. The board examined whether this would broaden the scope of the patent, asking if the process claim features which replaced the deleted feature necessarily limited the claim to films - like that in the granted product claim - with a density less than the arithmetical one. The board concluded that, with a probability bordering on certainty, the process now claimed would produce an opaque film of a density less than that arithmetically derivable from the type and proportion of its individual components. Thus, deleting the density-related feature had not in fact extended the scope of protection.

In **T 108/91** (OJ 1994, 228) the board concluded that Art. 123(3) EPC 1973 was not contravened when an incorrect technical statement which was evidently inconsistent with the totality of the disclosure was replaced by an accurate statement of the technical features involved. This case concerned a container-closure arrangement, which, according to information later included in the claim, was unstressed, whereas it was clear from the description that this part was in fact under tension. Decisions **T 673/89** and

T 214/91 followed **T 271/84** (OJ 1987, 405), **T 371/88** (OJ 1992, 157) and **T 438/98**, in ruling that amending a claim to remove an inconsistency did not contravene Art. 123(2) or Art. 123(3) EPC 1973 if the claim as corrected had the same meaning as the correct interpretation of the uncorrected claim in the light of the description.

In **T 553/99** the board stated that if a claim as granted contained an undisclosed, limiting feature in contravention of Art. 123(2) EPC 1973 it could be maintained in the claim without violating Art. 123(2) EPC 1973 provided that a further limiting feature was added to the claim which further feature was properly disclosed in the application as filed, and deprived the undisclosed feature of all technical contribution to the subject-matter of the claimed invention.

T 657/01 provided an example of the inescapable Art. 123(2) and (3) EPC 1973 trap.

With regard to the approach applicable in a case concerning the relationship between Art. 123(2) and Art. 123(3) EPC 1973, **T 942/01** held it to be a principle in patent law (see for example **G 1/93**, OJ 1994, 541) that a patent could not be maintained unamended in opposition procedure if a violation of Art. 123(2) EPC 1973 had occurred during the examination procedure. In the case in point the respondents, during the opposition procedure, had correctly objected under Art. 123(2) EPC 1973 to the deletion of the feature in question, and the appellant had consequently reacted by cancelling the deletion, i.e. by reintroducing the deleted feature into claim 1. Such a cancellation of unallowable amendments during the opposition proceedings was normally possible under the provisions of the Convention, except where the unallowable amendment was a "limiting extension", so that its cancellation would extend the protection conferred by the patent and therefore contravene the requirements of Art. 123(3) EPC 1973 (**G 1/93**). According to the board, such a situation was the basis for **T 1149/97** which had been cited by the respondents. However, that decision did not apply to the case at issue (**T 942/01**), which dealt with an unallowable extension only.

For an example of a "limiting extension" adding subject-matter contrary to Art. 123(2) EPC but at the same time limiting the scope of protection vis-à-vis what could have been claimed, so that its removal infringed Art. 123(3) EPC, see **T 567/08**.

Following the principles set out in **G 1/93**, the board came to the conclusion that in **T 250/05** the patent could not be maintained unamended **and** that the patent could only be maintained if there was a basis in the application as filed **for replacing** such subject-matter without violating Art. 123(3) EPC. The sixth auxiliary request (which contained only one claim) met both prerequisites.

D. Rule 139 EPC

R. 88, second sentence, EPC 1973 provided that if a request for correction concerned the description, claims or drawings, the correction had to be obvious in the sense that it was immediately evident that nothing else could have been intended than what was offered as correction. In EPC 2000, this provision has become **Rule 139, second**

sentence, EPC and its wording is unchanged; there have been no substantive amendments; only some editorial changes have been made in the three languages.

In **G 3/89** (OJ 1993, 117; see also **G 11/91**, OJ 1993, 125) the Enlarged Board of Appeal specified that, for a correction under R. 88, second sentence, EPC 1973 to be allowed, the respective part of the European patent had to contain such an obvious error that a skilled person was in no doubt that the feature concerned could not be meant to read as such. If, on the other hand, it was doubtful whether that feature was incorrectly defined, then a correction was ruled out (see **T 664/03**, **T 580/05**; see also **T 382/07** where **G 11/91** did not apply).

In **J 42/92** the board had to decide whether a request under R. 88, second sentence, EPC 1973 could be made after grant. It came to the conclusion that a request under R. 88 EPC 1973 for amendments to the description or claims could only be filed during the pendency of application or opposition proceedings. Under Art. 97(4) EPC 1973, the decision to grant a European patent took effect on the date on which the European Patent Bulletin mentioned the grant. After this date, R. 88 EPC 1973 could only be applied while opposition proceedings were pending. In the case at issue, the decision to grant the patent had already taken effect, and no opposition had been filed. The appeal had therefore been dismissed, since the EPO had ceased to have jurisdiction to consider a request under R. 88 EPC 1973 at the time when the request was filed. The board also pointed out that there is no reason why, once no application or opposition proceedings are pending before the EPO, decisions on the question of corrections (bearing in mind the requirement of obviousness to a skilled person) should not fall within the sole jurisdiction of the national courts or other authorities responsible for proceedings in which this question may arise (quoting **J 42/92**, see also **J 23/03** and **T 493/08**).

1. Relation to Article 123(2) EPC

The boards have been called upon several times to discuss the question whether a correction under R. 88, second sentence, EPC 1973 could be allowed even if the requested amendment would constitute an extension of protection within the meaning of Art. 123(2) EPC 1973 over the disclosure made on the date of filing. In decisions **T 401/88** (OJ 1990, 297) and **T 514/88** (OJ 1992, 570) the answer was negative. In **T 200/89** (OJ 1992, 46) the board took a similar view with regard to Art. 123(3) EPC 1973 and concluded that requests for correction under R. 88 EPC 1973 and requests for amendment under Art. 123 EPC 1973 had to be considered separately.

A further question was whether, for the purposes of correction under R. 88, second sentence, EPC 1973, the evidence that nothing else would have been intended than what was offered as the correction could take the form of documents filed only after the application. On this point a different conclusion was reached in **T 401/88** (OJ 1990, 297) than in **J 4/85** (OJ 1986, 205).

As a result of referrals by the President of the EPO (**G 3/89**, OJ 1993, 117) and by a board of appeal (**G 11/91**, OJ 1993, 125) both questions came to be decided by the

Enlarged Board. The Enlarged Board's conclusion was that the parts of a European application or patent relating to the disclosure (description, claims and drawings) could be corrected only within the limits of what the skilled person would derive directly and unambiguously, using common knowledge and seen objectively and relative to the date of filing, from the whole of these documents as originally filed. Such a correction was of a strictly declaratory nature and thus did not infringe the prohibition of extension under Art. 123(2) EPC 1973. Other documents - notably priority documents and the abstract - could not be used for correction purposes even if filed together with the application, but could, however, be adduced as evidence of common general knowledge on the date of filing. Evidence of what constituted such knowledge on that date could be furnished in any suitable form. And documents not relating to the disclosure could, under certain circumstances, be included partially or wholly in the disclosure by means of reference.

No correction was possible if there was any doubt as to whether a mistake existed, or whether nothing else could have been intended other than what was offered as the correction.

In **T 1008/99**, the request for correction of errors concerned a European divisional application which had been filed with a wrong description not related to the earlier (parent) application. The wrongly filed description should therefore be replaced by the description of the parent application. The board held that for the purposes of R. 88 EPC 1973, the error had to be **apparent from the divisional application itself**, and the parent application could not be used to demonstrate that the error was obvious (see IV.7.4, divisional applications).

Moreover, according to decision **G 2/95** (OJ 1996, 555, point 2 of the Reasons), the interpretation of R. 88, second sentence, EPC 1973 had to be in accord with Art. 123(2) EPC 1973, which meant that a correction under R. 88 EPC 1973 was bound by Art. 123(2) EPC 1973, in so far as it related to the content of the European patent application as filed. A correction could therefore be made only within the limits of the content of the parts of the application which determined the disclosure of the invention, namely the description, claims and drawings. Other documents could only be used for proving what was common general knowledge on the date of filing. As far as a divisional application pursuant to Art. 76 EPC 1973 was concerned, the content of the application which determined the disclosure was that of the divisional application as filed, rather than that of the earlier (parent) application.

2. Obviousness of the error and the correction

In the past, the boards have allowed corrections under R. 88, second sentence, EPC 1973 provided it was immediately evident to the skilled person that an error had occurred and how it should be corrected. In **T 640/88** and **T 493/90** the required correction to an error in the claim was evident from the description. In **T 488/89** the reference to a parallel application enabled the skilled person to establish without difficulty the correct limit values. In **T 365/88** it was ruled that an abbreviation in the claim could be corrected because it appeared correctly in the description; an additional Roman numeral I in the abbreviation of an enzyme was implicitly disclosed because at the time of filing only one

enzyme of this type was known, and clarification prevented confusion with enzymes of the same type discovered at a later date.

In **T 990/91** the board allowed the correction of a chemical name on the grounds that an obvious error had been made in naming a salt which was the subject-matter of the application - the molecular formula of this salt was clear from the application. However, the molecular formula corresponding to the name was different. Guided by the content of the application and taking into account cited documents which were published before the priority date of the application in question, the correction required would be immediately evident to the skilled person.

In **T 417/87** the board of appeal allowed the number of a publication cited in the original description to be corrected under R. 88, second sentence, EPC 1973. In **T 158/89**, however, correction of a percentage range of a component was not allowed. In the board's view, the skilled person could have deduced from inconsistencies in the claims and description that an error had occurred. However, there were two plausible ways of correcting it. Since the skilled person would have regarded both alternatives as equally plausible, it was not immediately obvious that nothing else had been intended other than the proposed correction.

In **T 606/90** the board allowed a correction pursuant to R. 88, second sentence, EPC 1973, in the opposition proceedings although the correction was not so obvious from the published text of the patent that it was immediately evident that nothing other than the proposed correction could have been intended. The applicant had filed typed amendments to the claims and the description and had also submitted the "working document" with the handwritten corrections for the dossier. The typed version of claim 1 omitted the detail which was now the subject of a request for correction pursuant to R. 88 EPC 1973; the same detail was present in the corresponding passage in the description. When the text was being prepared for publication of the patent, the detail in question was also omitted from the description owing to an error by the EPO. The board concluded that the omission in the description should not be taken into account when considering the admissibility of the correction. It stated that it was therefore clear that the phrase in question had been omitted from the typed version of claim 1 as a result of an error by the applicant and that the reader of the patent would immediately have noticed the need for correction of this error if a transcription error had not likewise been committed by the EPO. The correction requested was therefore admissible within the terms of R. 88 EPC 1973.

In **T 955/92** the appellant had requested that under R. 88 EPC 1973 the words "silica" and "alumina" in the claims and description be replaced by "silicon" and "aluminium" respectively. It argued that the ambiguous expression "silica to alumina atomic ratio" could only have two meanings, either "silicon to aluminium atomic ratio" or "silica to alumina molar ratio" and that it was evident to a skilled person that the correction could only be as requested.

The board did not share this view. It accepted that there was obviously a mistake and that the interpretation according to the correction sought was more likely than the

alternative. However, referring to **G 3/89** (OJ 1993, 117), it emphasised that the correction should be unambiguously derivable by a skilled person, using common general knowledge, from the description, claims and drawings of the patent application on the date of filing. The board held that in the case in point the reasons given by the appellant to show that only the requested correction could have been intended were not based on the level of general knowledge on the date of filing. In order to arrive at the conclusion that the requested correction was the only physically meaningful one, experiments had had to be performed which needed more than common general knowledge, and the results thereof would not have been available on the date of filing.

In **T 438/99** the board held that the fact that a term or phrase could not be interpreted or construed because it was unresolvably ambiguous did not necessarily mean that its deletion was a permissible amendment under Art. 123(2) EPC 1973. There remained a residual clear meaning in the ambiguous term, e.g., as in this case, that a specific direction was taught, and suppressing that fact resulted in a different technical teaching.

E. Standard of proof for allowing amendments and corrections

In **T 383/88** the board held that the normal standard of proof in proceedings before the boards of appeal, namely "the balance of probability", was inappropriate for determining the allowability of an amendment under Art. 123(2) EPC 1973. Instead, a rigorous standard, i.e. one equivalent to "beyond reasonable doubt" was considered by the board to be the right one to apply in such a case, since applying a lower standard could easily lead to undetected abuse by allowing amendments on the basis of ostensibly proven common general knowledge.

It had frequently been argued that certain technical features could be directly and unambiguously derived from a specification as filed by reading it in the light of common general knowledge. However, the board recommended viewing this approach with considerable caution. Firstly, the issue of the allowability of an amendment under Art. 123(2) EPC 1973 had to be decided by reference to what could be derived from the patent application as filed in the light of common general knowledge and not vice versa. Secondly, it was notoriously difficult to prove common general knowledge. For example, information might be generally disseminated, and therefore known within the community of skilled addressees, but it might well, at the same time, not be commonly accepted. Furthermore, too much reliance could not be placed on affidavit evidence from over-qualified persons, for the relevant knowledge was that of a notional, i.e. average, skilled addressee, and not that commanded by leaders in the relevant scientific discipline or field. The board added that it could not normally be the case that an affidavit by a single person was sufficient to discharge the burden of proof to the strict standard that was required (quoting **T 383/88** in this respect see also **T 1046/96**, **T 1239/03**, **T 1006/03**).

In **T 581/91** the board held that the balance of probabilities was not an appropriate criterion to be applied in a case where a correction under R. 88 EPC 1973 was at stake. Following decision **T 383/88**, the board stated that a more rigorous standard, that is one equivalent to "beyond reasonable doubt", ought to be applied.

In **T 795/92** the board stated that Art. 123(2) EPC 1973 clearly precluded allowing an amendment if there was any doubt as to whether or not it was derivable from the original application. In the case at issue an upper limit of 89% indicated in claim 1 of the main request for the degree of nickel reduction was not expressly mentioned in the application as filed. The board decided that, in spite of a certain probability in favour of the appellant/patentee's position, the amendment was not allowable because there were various known methods for calculating this value, not all leading to identical results, and the application did not directly and unambiguously disclose which method had to be used.

IV. DIVISIONAL APPLICATIONS

1. Subject-matter of a divisional application

1.1. Introduction

The procedure defined in the EPC for the filing of divisional applications is self-contained and complete (see e.g. **T 587/98**, OJ 2000, 497). The most important rules on European divisional applications are laid down in Art. 76 EPC and R. 36 EPC (R. 25 EPC 1973). The divisional application is accorded the same filing date as the parent application and benefits from any right of priority of the parent application in respect of the subject-matter contained in the divisional application. Divisional applications are to be treated in the same manner as ordinary applications and are subject to the same requirements, unless specific provisions of the EPC require something different (**G 1/05**, OJ 2008, 271, point 3.1 of the reasons).

The provisions relating to divisional applications were also amended in the context of the EPC revision. The changes to Art. 76 EPC are primarily of an editorial or clarificatory nature or are changes resulting from changes made to other EPC provisions. For details on the amended version of R. 25 EPC, see point 6.2.1 below.

As soon as it has been validly filed, a divisional application is examined entirely separately from the parent application and must satisfy the substantive requirements of the EPC on its own merits. In particular, a European divisional application may only be filed in respect of subject-matter which does not extend beyond the content of the earlier application (parent application) as filed. If it fulfils this condition and the formal requirements for the accordence of a filing date, then the same filing and priority dates apply to it as to the parent application (Art. 76(1), second sentence, EPC). Art. 76(1), second sentence, EPC therefore has a double purpose: first as a formal requirement preventing applicants from putting into a divisional application new matter which could be objectionable under national security considerations and second, at the same time, establishing the substantive requirement for the patentability of divisional applications that they may not contain added matter in relation to their parent application (see **G 1/05**, OJ 2008, 271, point 2.7 of the reasons).

The question whether the subject-matter of a divisional application extends beyond the content of the parent application will be decided by the examining division in the substantive examination (**J 13/85**, OJ 1987, 523; see also Guidelines C-VI, 9.1- April 2010 version). All the features disclosed in the divisional application must be reflected in either the description or the claims or in drawings of the parent application in the version as filed (see **G 1/05**, OJ 2008, 271, point 9.2 of the reasons; **T 211/95**, **T 1026/03**). In order to determine whether or not the divisional application offends against the provisions of Art. 76(1) EPC 1973, it has to be established whether technical information has been introduced into that divisional application which a **skilled person** would not have objectively and unambiguously derived from the earlier application as filed (**T 402/00**, **T 423/03**). According to the EPO practice, an unamended description identical to that contained in the parent application is normally accepted. The Guidelines C-VI,

9.1.5 (April 2010 version) also state that an amendment of the description should be required only where absolutely necessary. Thus the **repetition** in a divisional application **of matter** in the parent application need not be objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application. In **T 441/92**, therefore, the board took the view that there was nothing in the EPC to prevent an applicant from repeating the earlier description in a divisional application and that Art. 76(1) EPC 1973 had not been contravened in this respect in the case in point.

At any rate an opposition can be filed against a patent granted in respect of a divisional application. In this instance the opposition is justified under Art. 100(c) EPC on the basis that its subject-matter extends "beyond the content of the earlier application as filed".

A European application can give rise to more than one divisional application, while a divisional application in turn can give rise to one or more divisional applications. In several decisions the boards affirmed the admissibility, in principle, of divisionals from divisionals (sequences of divisional applications), which had also been expressly advocated by the contracting states during the preparatory work on the EPC 2000 (see **T 555/00**, **G 1/05** and **G 1/06**, OJ 2008, 271 and 307).

2. Validity of divisional applications

2.1. Questions referred to the Enlarged Board of Appeal

Several questions on the validity of divisional applications were referred to the Enlarged Board of Appeal with decisions **T 39/03** (OJ 2006, 362), **T 1409/05** (OJ 2007, 113) and **T 1040/04** (OJ 2006, 597).

T 39/03 looked into whether a divisional application whose content at the time of filing extended beyond that of the earlier application as filed could still be amended during examination to meet the requirement of Art. 76(1), second sentence, EPC 1973 (answered in **G 1/05**, OJ 2008, 271). Where a divisional application offends against the provisions of Art. 76(1) EPC 1973, the board referred to the established practice of the EPO which allows the applicant at any later stage of the examining procedure to make amendments which bring it into line with Art. 76(1) EPC 1973, and to consider the corrected application, provided it also satisfies Art. 123(2) EPC 1973 with regard to its version as filed, as a valid divisional application filed on the date of filing of the earlier application and having the benefit of any right of priority. The board, however, had strong reservations as to the correctness of this practice in the light of the previous case law (see in particular **T 1158/01**, OJ 2005, 110; **T 720/02** and **T 797/02**) regarding the treatment of divisional applications filed as divisional applications of earlier divisional applications, and concerning the provisions of R. 25(1) EPC 1973.

T 1409/05 looked into how the requirements of Art. 76(1) EPC 1973 are to be interpreted in the case of a sequence of divisional applications, each divided from its predecessor (answered in **G 1/06**, OJ 2008, 307). The Enlarged Board of Appeal decided to deal with the referred legal questions in consolidated proceedings. When appeal proceedings **T 1040/04** (OJ 2006, 597) – the subject-matter of the referral – ended following the

withdrawal of the remaining appeals, the **G 3/06** proceedings pending before the Enlarged Board of Appeal were terminated. The question at issue – whether a patent granted for a divisional application can be amended in opposition proceedings – was subsequently addressed in **T 687/05** (see point 2.3 below, sequence of divisional applications).

2.2. Right to amend - G 1/05

In **G 1/05** (OJ 2008, 271) the Enlarged Board of Appeal held that in decision **T 39/03** the starting point of the referring board was its doubts as to whether a divisional application containing subject-matter extending beyond the earlier application as filed could be amended later to comply with Art. 76(1), second sentence, first half sentence, EPC 1973, based mainly on the concept that initial non-compliance of a divisional application with the said provision made the divisional application "invalid". The Enlarged Board of Appeal pointed out that Art. 76(1), second sentence, EPC 1973 has a double purpose, first as a formal requirement preventing applicants from putting into a divisional application new matter which could be objectionable under national security considerations and second, at the same time, setting up the substantive requirement for the patentability of divisional applications that they may not contain added matter in relation to their parent application. In the opinion of the Enlarged Board of Appeal all the matters set out above point in favour of an interpretation of Art. 76(1) EPC 1973 permitting an applicant to amend a divisional application after the application has been filed so as to comply with the provisions of that article, provided always that the amendment complies with the other requirements of the EPC.

The second question raised in the referral in **G 1/05** is whether it is still possible to amend a divisional application in order for it to meet the requirements of Art. 76(1) EPC 1973 when the earlier application is no longer pending. The Enlarged Board of Appeal held that an amendment to remove added matter not disclosed in the parent application as filed from the divisional application as filed is allowable irrespective of whether the earlier application is still pending or not.

In answering the third point of law referred in **G 1/05** – whether there are any further limitations of substance to the right to amend divisional applications – the Enlarged Board again cited the principle that the divisional application is a separate and independent application and is, if not specifically provided otherwise, to be treated in the same manner and subject to the same requirements as an ordinary application. Amendments to divisional applications are allowed under Art. 123(2) EPC 1973 to the same extent as amendments of any other non-divisional applications.

Its headnote reads as follows:

As far as Art. 76(1) EPC 1973 is concerned, a divisional application which at its actual date of filing contains subject-matter extending beyond the content of the earlier application as filed, can be amended later in order that its subject-matter no longer so extends, even at a time when the earlier application is no longer pending. Furthermore,

the same limitations apply to these amendments as to amendments to any other (non-divisional) applications.

2.3. Sequence of divisional applications - G 1/06

In **T 1409/05** (OJ 2007, 113), the board referred the following points of law to the Enlarged Board of Appeal:

(1) In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, is it a **necessary and sufficient** condition for a divisional application of that sequence to comply with Art. 76(1) EPC 1973, second sentence, that anything disclosed in that divisional application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed?

In **G 1/06** (OJ 2008, 307) the Enlarged Board ruled that Art. 76 EPC 1973 also applies to divisionals from divisionals, because – if not specifically provided otherwise – divisionals must be treated just like any other application. Therefore a divisional (of whatever generation) can be the "earlier application" within the meaning of Art. 76(1) EPC 1973 for a further divisional.

The characterising feature of a sequence of divisional applications each divided out from its predecessor is that each member of the sequence claims as filing date the date of the originating or root application in which the subject-matter divided out in sequences of divisional applications was first disclosed.

The filing date of the root application is the only filing date which can be attributed to a divisional application, by way of the legal fiction contained in Art. 76(1), second sentence, second half sentence, EPC 1973, irrespective of whether the divisional application is a first divisional or a divisional further down in a sequence of divisionals.

In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it is a necessary and sufficient condition for a divisional application of that sequence to comply with Art. 76(1) EPC 1973, second sentence, that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed. Content which has been omitted on filing a member higher up the sequence cannot be re-introduced into that member or in divisional applications lower down the sequence from it.

In **T 687/05** the opposition division revoked the patent which was a divisional application of a parent application, which was itself a divisional application of a grandparent application. The reason was that the subject matter of claim 11 of the parent application was considered to extend beyond the content of the grandparent as filed. In the appeal proceedings the appellant filed a replacement main request containing an amended claim 1 and whereby claim 11 was deleted and replaced by granted dependent claim 12. The board held that the findings of the Enlarged Board of Appeal in **G 1/05** (OJ 2008,

271) and **G 1/06** (OJ 2008, 307), although made in regard to patent applications, were also valid for granted patents. Thus, in order to meet the requirements of Art. 100(c) EPC 1973, it was a necessary and sufficient condition that anything disclosed in the granted patent had to be directly and unambiguously derivable not only from the application on which the patent had been granted, but also from what was disclosed in each of the preceding applications as filed (see also **T 265/05** with reference to this decision).

T 904/97, **T 1158/01** (OJ 2005, 110), **T 643/02**, **T 720/02**, **T 797/02** and **T 90/03** no longer apply if inconsistent with **G 1/05** and **G 1/06**. For those T decisions, see "Case Law of the Boards of Appeal of the European Patent Office", 5th edition 2006, p. 285.

3. Individual cases

The board in **T 176/90** applied the principle that the parent application should disclose the invention claimed in the divisional application in a manner sufficiently clear and complete for it to be carried out by the skilled person. For an invention relating to a **generic class of chemical compounds**, this required the disclosure of the structure of the class, usually by means of a general formula, and an indication of a method of preparation.

In **T 118/91** the board considered the argument that the filing of a divisional application led to the abandonment of its subject-matter in the parent application, which accordingly could no longer be considered as having originally disclosed that subject-matter. The board found that there was nothing in Art. 76 EPC 1973 or any other provision of the EPC to support that contention, stating clearly that the content of the application as filed cannot as a matter of logic be reduced by the subsequent filing of a divisional application.

In **T 211/95** the examining division had refused a divisional application on the grounds that a set of features from the original claim 1 of the parent application was entirely missing from claim 1 of the divisional application. This omission was said to violate the provisions of Art. 76(1) EPC 1973. The board was unable to accept this. There were two technically unconnected teachings which could be claimed separately. The skilled person would clearly see that the set of features according to the subject-matter claimed in the parent application was not essential to the subject-matter claimed in the divisional application. The subject-matter of the divisional application was directly and unambiguously disclosed in the parent application.

In **T 1088/06** an appeal was filed against the decision of the Examining Division refusing the European patent application, which had been filed as a divisional application on the ground that the application extended beyond the content of the earlier application as filed. The expression " 10^{-4} to 10^{-9} " occurred six times in the earlier application. The expression " 10^4 to 10^9 ", which differed from the above expression by a reversal of the sign of the exponents, also occurred six times in the divisional application as filed. The question raised was whether the range of the electrostatic dissipation capacity and the range of the ability to dissipate electrostatic energy indicated as being "between about 10^4 to 10^9 Ohm/cm²" extended beyond the content of the earlier application as filed. The

Examining Division had held that the correct range could not be "directly and unambiguously derived from the parent application as originally disclosed." In the board's view, if information in the earlier application is objectively recognisable by the person skilled in the art as information that is incorrect, and if the person skilled in the art would derive the correct information directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents of the earlier application as filed, then the correct information belongs to the content of the earlier application and may be used to decide whether a divisional application extends beyond the content of the earlier application as filed (Art. 76(1) EPC). In the case before it, the board concluded that the range of 10^4 to 10^9 Ohm/cm² did not introduce subject-matter extending beyond the earlier application as filed.

The thrust of the appellant's (opponent's) submission in **T 341/06** was that the subject-matter of claim 1 as per the opposition division's contested interlocutory decision extended beyond the content of the parent application as filed and therefore did not meet the criteria set out in decision **G 1/06** (OJ 2008, 307). This claim related to a roof component with an integrated sunroof; it had therefore to be compared with claim 3 of the parent application, which also related to a roof component of that type, to ensure compliance with the requirements of Art. 76(1) EPC 1973. The respondent (patent proprietor) argued that a second teaching concerning the attachment of the sunroof to the roof component was disclosed directly and clearly in the parent application. However, the board held that there was nothing in the parent application to suggest to the person skilled in the art that it contained an invention – in addition to the one already claimed – corresponding to claim 1 of the main request. The passages cited by the patent proprietor did not refer to the attachment of the sunroof frame to the reinforcement frame, nor did they contain any reference to the purpose of the same or any formulation of the problem posed by such attachment. The board saw these passages as being merely the description of the third embodiment of the invention disclosed in the parent application in connection with a sunroof unit. The respondent possibly recognised subsequently that it could be in its interest to patent certain features of the means of attaching the sunroof frame, irrespective of the form of the roof liner. However, the independence of these features was not apparent in the parent application. The subject-matter of claim 1 was not therefore directly and clearly apparent as a combination of features in its own right on the basis of the disclosure in the parent application.

In **T 1387/05** the parent application disclosed two different branches of video signal transmission. The first branch related to broadcasting from an encoder on a transmitter side to a decoder on a receiver side and was the invention for which protection was sought by the application before the board. The alternative branch disclosed a recording means, for instance a video cassette recorder, on the encoder side and a playback means, for instance a video cassette player, on the decoder side and had been pursued in the parent and root applications. The appellant's (applicant's) argument was based on the underlying understanding that the parent application disclosed two distinct branches as alternatives, and that the claims of the divisional application at issue concerned only the first branch. The board stated, however, that the parent application did not directly and unambiguously present alternative apparatuses corresponding to these two alternative branches. Instead it disclosed a recording/reproducing processing apparatus

with the functionality that a broadcast wave might be transmitted and/or received. The board accepted the appellant's argument that decision **G 1/06** (OJ 2008, 307) did not state that subject-matter had to be separately derivable from what was disclosed in each of the preceding applications as filed. However, this did not mean that features which were disclosed in a given context might be claimed in a different context or specific features might be generalised without a proper basis in the parent application as filed. As the same principles were to be applied for both Art. 76(1) EPC and Art. 123(2) EPC 1973, it followed that it was normally not allowable under Art. 76(1) EPC 1973 to extract features from a set of features which were originally disclosed only in combination in a parent application and to claim such extracted features in a divisional application isolated from their context, namely the combination disclosed in the parent application.

Following the established case law of the boards of appeal, the board stressed in the consolidated cases **T 1500/07**, **T 1501/07** and **T 1502/07** that, where newly claimed subject-matter is based on the extraction of features in isolation from a set of features originally disclosed in combination (e.g. in a specific embodiment in the description) the criterion for compliance with Art. 76(1) EPC 1973 is met, if there is no clearly recognisable functional or structural relationship between the features, i.e. if they are not inextricably linked. What is decisive is determining which specific combinations of features were originally taught by the parent, and whether the skilled person recognizes **immediately and unequivocally** from the totality of the disclosure when read contextually and using his common general knowledge that, and which, certain features are incidental to the proper functioning of these specific embodiments, and that these can be dispensed with without consequence for the remaining features. In the case before the board, the fact that the claimed features were not given any special prominence, and that they were functionally and structurally bound to the other, remaining features indicated that these criteria were not met.

4. Amendments to divisional applications

4.1. Link between Article 76(1) and Article 123(2) EPC

Under Art. 123 (2) EPC, amendments to a divisional application are admissible to the same extent as amendments to all other non-divisional applications. This was discussed in **G 1/05** (OJ 2008, 271, point 9.2 of the reasons). The Enlarged Board of Appeal did not consider that from the mere fact of division it was possible to derive limitations, such as by waiver or abandonment of any subject-matter of the earlier application not encompassed by the claims of the divisional application under consideration, on what further amendments could be made or to what subject-matter further divisional applications of the said divisional application could be directed. Art. 76(1) EPC 1973 referred to the content, interpreted as the whole technical content, of the earlier application, and there is no legal basis for limiting this on division. Third parties needed to be aware that while a divisional application was still pending, any of its content as filed might yet be the subject of patent claims, either in the divisional application itself, or in further divisional applications. Therefore, a divisional application could be directed by amendment to aspects of the earlier application also disclosed in the divisional application as filed, but not encompassed by the claims of the divisional application as

filed. In arriving at this finding, the Enlarged Board of Appeal in particular relied on a direct correspondence between Art. 76(1) and Art. 123(2) EPC 1973, both Articles enshrining the same principles (see points 5.1 to 5.4 of the reasons).

This is in keeping with the established case law of the boards of appeal in which the principles developed in connection with Art. 123(2) EPC are also applied to the relationship between the divisional and parent application: the subject-matter of the amended application or patent (in this case the divisional application) had to be directly and unambiguously derivable from, and consistent with, the original disclosure (in this case the parent application) (**T 514/88**, OJ 1992, 570; **T 527/88**). It is the total information content of the original application as filed that matters (**T 873/94**, OJ 1997, 456; **T 463/08**). In view of these decisions, the board held in **T 289/95** that the question of whether or not a claim in a patent deriving from a divisional application "covers" or "embraces" something which was not specifically disclosed in the parent application was not the proper standard of comparison for determining whether there had been an inadmissible extension of subject-matter.

While Art. 76(1) EPC requires that a divisional application does not extend beyond the content of the earlier application, Art. 123(2) EPC stipulates that, once the provisions of Art. 76(1) EPC have been met, the divisional application may not be amended after filing in such a way that it contains subject-matter extending beyond the content of the divisional application as filed. A divisional application must therefore meet the requirements of Art. 76(1) EPC and those of Art. 123(2) EPC, which should preclude the introduction of new subject-matter into the examination proceedings (see **T 441/92**, **T 873/94**, OJ 1997, 456; **T 1221/97**, **T 1008/99**, **T 561/00**, **T 402/00**, **T 423/03**).

Art. 76(1) and Art. 123(2) EPC have the **same purpose**, i.e. to create a fair balance between the interests of applicants and patentees, on the one hand, and competitors and other third parties on the other. The idea underlying these provisions is that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application (**G 1/93**, OJ 1994, 541; **T 873/94**, OJ 1997, 456; **T 276/97**, **T 701/97**).

The arguments used by the appellant in **T 276/97** may be summarised as follows: given that the **wording** of the French version of Art. 76(1), second sentence, EPC 1973 differed from that of Art. 123(2) EPC 1973, it was wrong to follow the EPO case law, according to which the interpretation of Art. 123(2) EPC 1973 was applicable to Art. 76(1) EPC 1973 as well. Referring to the case law, the board stated that Art. 76(1) EPC 1973 was to be equated with Art. 123(2) EPC 1973. The term "éléments" in the French version of Art. 76(1) EPC 1973 did not justify a different interpretation of the terms "Gegenstand" and "subject matter" respectively in the German and English versions of Art. 76(1) and Art. 123(2) EPC 1973. The board also confirmed that the French wording of Art. 76(1) EPC 1973 encapsulates in translation the same intention as the German and English versions of the Article, i.e. to disallow an extension of the parent application's content through the introduction of new subject-matter in the divisional

filing, or through any amendment subsequent to the date of filing of the parent application.

4.2. Individual cases

In **T 701/97** the board stated that an amendment had to be regarded as introducing subject-matter extending beyond the content of the original application, if the overall change in the content of the application resulted in the skilled person being presented with information which was not clearly and unambiguously presented in the original application, even when account was taken of matter which was implicit to a person skilled in the art (see also **T 383/88** and **T 688/99**). The criteria to be used for comparing a claimed invention with the subject-matter disclosed in an earlier document allegedly disclosing the same invention had recently been defined again in **G 2/98** (OJ 2001, 413). Where, as in the case in suit, an independent claim present in the parent application as originally filed had been amended by the addition of features restricting the scope of the claim and taken from a number of parts of the original application which were not clearly related, it was not sufficient that all the individual added features were disclosed in the original application. Rather, the combination of features in question had to be clearly and unambiguously derivable from the document by a skilled person using common general knowledge. Hence multiple limitations generating specific subject-matter not derivable from the original application could not be allowed.

In **T 441/92** a divisional application was filed with a description essentially identical to that in the parent application. After an amendment to the claims the divisional application comprised the same subject-matter as the parent application, which in the meantime had lapsed irrevocably (so that the question of double patenting did not arise). The board found that the claims now featuring in the divisional application did not introduce subject-matter beyond the content of the parent application and thus did not contravene Art. 76(1) EPC 1973. Nor was Art. 123(2) EPC 1973 contravened, since all the claims were directly and unambiguously derivable from the description in the divisional application as filed. Equally no objection could be made to the fact that the divisional application as originally filed claimed a different invention from that specified in the amended claims. While the content of an application must not be extended after filing, the protection sought by the claims might be extended beyond that sought in the claims as originally filed as long as the application was pending; in this respect, there was no distinction between a normal and a divisional application. Furthermore, the subject-matter of the claims in the parent application could not be considered to have been abandoned because that application had lapsed. The board found that the lapse of the parent application could not have the effect of reducing the content of a previously filed divisional application.

In **T 542/94** the examining division refused a divisional application on the basis of Art. 123(2) EPC 1973 because its subject-matter extended beyond the parent application, when it should have done so on the basis of Art. 76(1) EPC 1973. The board noted that the admissibility requirement for the claims in a divisional application was the same in Art. 76(1) and Art. 123(2) EPC 1973. Since the examining division's arguments were essentially based on a comparison between the subject-matter of the parent application

and that of claim 1 of the divisional application, its finding was in fact based on Art. 76(1) EPC 1973. Hence, the imprecise ground for refusal given in the decision under appeal did not put the appellant in a disadvantageous position and there was therefore no case for reimbursement of the appeal fee under R. 67 EPC 1973 (now R. 103 EPC).

In **T 475/02** a European patent was granted on a divisional application which had been filed in respect of subject-matter of an earlier application. An appeal was lodged against the decision of the Opposition Division to reject the opposition against the patent in suit, one of the grounds for opposition being the extension of subject-matter beyond the content of the earlier application as filed. The appellants (opponents) argued that although the description in the divisional application as filed was identical to that of the earlier application, its claims were different, so that the two applications were materially different. Hence, the amendments to the claims carried out during the examination proceedings should have been based on both the divisional and the earlier applications. The board stated that, since the opposed patent was granted on a divisional application, for the subject-matter of any claim as granted to be allowable, it had thus to pass both of the two tests: (i) it must not extend beyond the content of the divisional application as filed; and, (ii) it must not extend beyond the content of the earlier application as filed. Whether the first test was passed depended only on the particular claim and on the content of the divisional application as filed. That the subject-matter of a claim passed the second test did not necessarily mean that it passed the first, and vice-versa. The two tests need separate consideration, in particular where the divisional application as filed did not include the complete text (both description and claims) of the parent application. In the case before the board, the divisional application included the text of the description of the earlier application as filed but not all of its claims as filed.

In this respect, the board observed in **T 806/03** that first test is governed by Art. 123(2) EPC and the second by Art. 76(1) EPC. In the case before the board, Art. 123(2) EPC provided the basis for examining the allowability of amendments of the subject-matter of the divisional application carried out **during its examination** in comparison with the initial text of this divisional application as filed, whereas the comparison of the text of the granted patent with the text of the parent application should have been based on Art. 76(1) EPC.

5. Double patenting

The parent and divisional applications may not claim the same subject-matter. The principle of the ban on double patenting is based on the idea that the applicant has no legitimate interest in proceedings that give rise to the grant of a second patent in respect of the same subject-matter for which he already holds a patent. There is therefore nothing in the established EPO practice to oppose and dismiss amendments to divisional applications, when the same subject-matter is claimed in the amended divisional application as in a pending parent application or a granted parent patent. However, this principle cannot be applied with a view to preventing the filing of identical applications, because that would infringe the precedent principle, whereby an assessment is made of whether the EPC requirements are met on the basis of the final version of the application (**G 1/05** and **G 1/06**, OJ 2008, 271 and 307, point 13.4 of the reasons).

In **T 118/91** and **T 80/98**, care was taken to avoid any risk of double patenting by ensuring that the subject-matter of the divisional application differed from that of the parent application. In **T 118/91**, in particular, the board stated that it could find nothing to support the contention that features forming part of the subject-matter of the divisional application could not be the subject of a dependent claim in the parent application. The Guidelines state that, as a general rule, one application may claim its own subject-matter in combination with that of the other application. The board found no fault with this approach and did not see that it imposed an unfair burden on competitors or led to "double patenting" in its normal sense. In this particular case, the board was satisfied that any danger of "double patenting" had been eliminated by **extensive restriction of the claims** in the divisional application.

In **T 58/86** it was decided that the independent claims in a divisional application impermissibly exceeded the disclosed content of the original application, an essential feature of the relevant subject-matter of the original application being omitted in each of them. Reinstating this feature would have resulted in subject-matter that was already protected in the original application - and therefore double patenting.

In **T 587/98** (OJ 2000, 497) the examining division had refused a European patent application, filed as a divisional application, on the grounds that its subject-matter overlapped with that of the parent application. The board found that the claims were not **"conflicting" claims** within the meaning of the Guidelines. Furthermore, there was no express or implicit provision in the EPC which prohibited the presence in a divisional application of an independent claim - explicitly or as a notional claim arrived at by partitioning of an actual claim into notional claims reciting explicit alternatives - which was related to an independent claim in the parent application in such a way that the "parent" claim included all the features of the "divisional" claim combined with an additional feature.

In **T 307/03** (OJ 2009, 418) the board could not follow **T 587/98**. According to **T 587/98**, neither Art. 125 EPC 1973, which requires the EPO to take into account the principles of procedural law recognised in the contracting states, in the absence of procedural provisions in the EPC, nor the provisions relating to divisionals prevented "conflicting claims" of the type considered in that case. The board in **T 307/03** relied on Art. 60 EPC 1973, concerning the fundamental right to a patent, to deduce the principle of the prohibition of double patenting, and did not seek to import a principle of procedural law solely under Art. 125 EPC 1973. This board highlighted that the principle of the prohibition of double patenting, namely that the inventor (or his successor in title) has a right to the grant of one or and only patent from the EPO for a particular invention as defined in a particular claim, can be deduced from Art. 60 EPC 1973. Furthermore, a double patenting objection can also be raised where the subject-matter of the granted claim is encompassed by the subject-matter of the claim later put forward, that is where the applicant is seeking to re-patent the subject-matter of the already granted patent claim, and in addition to obtain patent protection for the other subject-matter not claimed in the already granted patent. In particular, where the subject-matter which would be double patented is the preferred way of carrying out the invention both of the granted patent and of the pending application under consideration, the extent of double patenting

cannot be ignored as *de minimis*. To avoid the objection of double patenting the claims of the pending application should be confined to other subject-matter that is not already patented, to allow the examination procedure to focus on whether a claim to this other subject-matter meets the requirements of the EPC.

After taking into consideration that the practice of prohibition of "double patenting" is confined to patents and applications relating to the same invention as defined by the subject-matter of the corresponding claims and therefore confined to claims conferring notionally the same scope of protection, the board saw no basis in case **T 1391/07** for extending this practice to cover claims not defining the same subject-matter but conferring - as in the case before it - a scope of protection overlapping with each other only partially in the sense that some, but not all of the embodiments notionally encompassed by one of the claims would also be encompassed by the other one of the claims. In particular, the lack of legitimate interest of an applicant in obtaining two patents for the same subject-matter - as invoked by the Enlarged Board of Appeal in decisions **G 1/05** and **G 1/06** (see above) - cannot be invoked when the scopes of protection conferred by the respective subject-matters **overlap only partially** with each other as there is no manifest objective reason to deny the legitimate interest of the applicant in obtaining a protection different from - although partially overlapping with - that of the parent patent already granted. Accordingly, the board concluded that the mere fact that the scope of protection notionally conferred by the claim in suit would partially overlap with that of the granted parent patent did not prejudice the grant of a patent.

Double patenting is not a ground of opposition - according to the board in **T 936/04**. It is within the discretion of the departments of the EPO to raise the objection in opposition or opposition appeal proceedings against proposed amended claims, but this should be done only in clear cases. The purpose behind the principle of the prohibition of double patenting is to avoid unnecessary duplication of effort, and not to impose on the departments of the EPO an obligation to make a complex comparison between the case before them and the claims that may have been granted in some other proceedings. In the case at issue, at the time of the decision by the opposition division, a patent had not yet been granted on the divisional application. For this reason alone the opposition division was correct to disregard the objections of double patenting raised before it. At that stage it would only be a matter for the Examining Division, in the proceedings on the divisional application before it, to avoid double patenting by again allowing claims already granted in the parent patent.

6. Filing a divisional application

6.1. Right to file

In **J 2/01** (OJ 2005, 88) the board held that joint applicants only acquired the procedural status of one applicant in common, i.e. they constitute a single party in the legal sense. Therefore, where an application (the "earlier application") had been filed jointly by two or more applicants and the requirements of Art. 61 or R. 20(3) EPC 1973 (now R. 22 (3) EPC) had not been met, the right to file a divisional application in respect of the earlier

applications under Art. 76 EPC 1973 was only available to the registered applicants for the earlier application jointly and not to one of them alone or to fewer than all of them.

The case underlying decision **J 34/86** concerned a very particular set of circumstances where the Legal Board of Appeal allowed an application to be filed as a divisional application by a party other than the registered applicant for the parent application. The applicant for the parent application had been ordered by a US court to assign all property rights in the invention defined by certain claims of the parent application to the applicant for the divisional application, and the applicant for the parent application had already signed an assignment to that effect.

In **J 20/05** the board held that, fundamentally, it is the entitlement acquired by virtue of the parent application that gives the right to file a divisional application. This means that the rights in respect of the divisional application derivable from the parent application extend to, but are also limited to, the rights existing in the parent application at the filing date of the divisional application. In the same way, it was decided in case **G 1/05** (OJ 2008, 271), that under the EPC the filing date of the root application is the only filing date which can be attributed to a divisional application, by way of the legal fiction contained in Art. 76(1), second sentence, second half sentence, EPC 1973. The entitlement to file a divisional application under Art. 76 and R. 25 EPC 1973 (now R. 36 EPC) is a procedural right that derives from the applicant's status as applicant in the earlier application (with reference to **J 2/01**).

In the case before the Legal Board of Appeal, the national entitlement proceedings were still pending and the parent application proceedings were still suspended at the time the impugned application was filed as a divisional application. That meant that, when the application in suit was filed, the doubt about who was lawfully entitled to file the parent application subsisted. The board held that it would be inconsistent with and contrary to the fundamental objective of the provisions on suspension on the one hand to suspend the parent application proceedings because of the national entitlement proceedings but on the other to allow the filing of a divisional application by the applicant whose entitlement is challenged. In summary, an applicant whose application proceedings had been suspended under R. 13 EPC 1973 (now R. 14 EPC) was not entitled to file a divisional application relating to that application while the proceedings remained suspended. Therefore such an application could not be dealt with as a divisional application and the Receiving Section had to decide accordingly.

6.2. Filing date

6.2.1 Amended versions of Rule 25(1) EPC 1973 and new legal basis under Rule 36(1) and (2) EPC

R. 25(1) EPC 1973 has been substantially amended twice.

In the original version of 1.10.1988, a divisional application could be filed only up to the date on which the applicant approved the text in which the patent was to be granted under R. 51(4) EPC 1973 (in the version which entered into force on 1.09.1987).

Under R. 25(1) EPC 1973 in the amended version of 2.01.2002, the applicant can file a divisional application in respect of **any pending earlier European patent application**. This just means that the existence of a pending application is a special condition to be complied with when an applicant files a European divisional application. It does not mean that the existence of a pending earlier application (by the unlawful applicant) is a precondition for the filing of a new application pursuant to Art. 61(1)(b) EPC 1973 (**G 3/92**, OJ 1994, 607, point 5.6 of the reasons). An application is pending up to (but not including) the date on which the European Patent Bulletin mentions the grant of the European patent or up to the date on which the application is refused, withdrawn or deemed withdrawn (see Notice of 9.01.2002, OJ 2002, 112).

The Legal Board of Appeal is of the view that the amended version cannot be applied **retrospectively** (**J 4/99**). Moreover, **J 24/03** points out that R. 25(1) EPC 1973 **does not set a deadline** for the filing of a divisional application but **rather stipulates** that the earlier European application must be pending. The provision on the re-establishment of rights therefore does not apply to the filing of a divisional application because R. 25(1) EPC 1973 does not establish a time limit within the meaning of Art. 122 EPC 1973 (see also **J 21/96** and **J 10/01**).

In **J 18/04** (OJ 2006, 560) the board added that the term "pending ... patent application" in R. 25(1) EPC 1973 did not set a time limit, but rather established a **substantive requirement** which had to be fulfilled at the point when a divisional application was filed. A board had no power to exempt an applicant from compliance with this substantive requirement. No substantive rights were established in a divisional application before the actual filing date of the divisional application. Substantive rights which were lost in the parent application could not be re-established in the divisional application by applying Art. 122 EPC 1973.

Regarding the term "pending" in R. 25(1) EPC 1973, the Legal Board of Appeal in **J 2/08** (OJ 2010, 100) the Legal Board of Appeal has referred the following point of law to the Enlarged Board of Appeal: Is an application which has been refused by a decision of the Examining Division thereafter still pending within the meaning of R. 25 EPC 1973 (R. 36(1) EPC) until the expiry of the time limit for filing a notice of appeal, when no appeal has been filed? The case is pending as **G 1/09**.

The principle underlying R. 25(1) EPC 1973 was adopted without amendment into the new R. 36(1) EPC in the context of the revision of the EPC. Moreover, the decision of the Administrative Council of the European Patent Organisation of 25 March 2009 (OJ 2009, 296) made a further amendment to the provision in question. Under the **new legal arrangements**, the applicant can file a divisional application in respect of each pending earlier European patent application if:

(a) the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued, or

(b) the divisional application is filed before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Art. 82 EPC, provided it was raising that specific objection for the first time.

The rationale for introducing the above-mentioned time limit is to prevent the filing of abusive divisional applications. Once the time limit has elapsed, only divisions required on the grounds of lack of unity will be admissible.

R. 36(2) EPC has also been amended and supplemented as follows:

A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall be then filed within two months of the filing the divisional application. The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin.

Whereas the legal question referred to the Enlarged Board in case **J 2/08** concerns the status of a parent application after its refusal and until the expiry of the period of appeal, if no appeal is filed, the Legal Board was confronted with a different situation in **J 5/08**. It had to decide whether the parent application was pending at the date of filing of the divisional application which took place *after* the appeal in the parent application had been filed but *before* the interlocutory decision by the Examining Division revised the appealed decision. This "reformatory" revision decision was restricted to the correction of the decision to grant without any exhaustive statement in respect of the patentability of the subject matter. According to the Legal Board, a revision decision pursuant to Art. 109 EPC 1973 as such opens up the possibility that the patentability of the claimed subject matter will be completely re-assessed, independently whether or not the cancellation of the appealed decision is expressly ordered or the written reasons are restricted to a specific legal question. In the present case, it seemed obvious and self-evident that the grant proceedings having been terminated by the revision decision were still pending up to that date of the revision decision. Hence, the appeal was regarded as allowable and the divisional application as having fulfilled the requirement pursuant to R. 25 (1) EPC 1973, i.e. that the parent application was pending at the filing date of the divisional.

6.2.2 Case law in respect of the version of 1 October 1988

A brief overview of the extensive case law in respect of the old version of 1.10.1988 appears below (for more detailed information, see "Case Law of the Boards of Appeal of the EPO", 4th edition 2001, p. 463 ff). Subsequently, the latest case law in respect of the version of 2.01.2002 is discussed.

In its opinion **G 10/92** (OJ 1994, 633) the Enlarged Board of Appeal concluded that an applicant could only file a divisional application relating to the pending earlier European patent application up to the date of approval in accordance with R. 51(4) EPC 1973. Art. 76(3) EPC 1973 contained a general authorisation to specify the procedure for filing

European divisional applications. This general authorisation also allowed the Administrative Council to determine the point in time up to which a European divisional application could be submitted. R. 25 EPC 1973 was therefore consistent with Art. 76(3) EPC 1973 and hence was also reasonable and appropriate.

In **J 36/92** the appellant approved the text of the patent application according to R. 51(4) EPC 1973, stating in the same letter, "We have today filed a divisional application including" However, the divisional application reached the EPO one day after the applicant's letter. The board stated that where an applicant approved the text of a European patent application pursuant to R. 51(4) EPC 1973 and in the same letter stated that he had that day filed a divisional application, the filing of the divisional application should be allowed, whether or not it was actually received by the EPO together with the letter (see also **J 27/94**, OJ 1995, 831).

In **J 29/96** (OJ 1998, 582) the board held that where consent has been given to the text of an earlier application pursuant to R. 51(4) EPC 1973, then withdrawal of this consent for the sole purpose of filing a divisional cannot re-open the period in which a divisional application can be filed (see **G 10/92**, OJ 1994, 633).

6.2.3 Case law in respect of the version of 2 January 2002

In **J 7/04** the Legal Board did not share the applicant's view that a divisional application may be filed at the latest **on** the date of the publication of the mention of the grant of the parent application. The board referred to **J 7/96** (OJ 1999, 443) and **J 10/01** and stated that the examining division's decision to grant a patent does not take effect on the date on which the decision-making process is completed, but on the date on which the European Patent Bulletin mentions the grant. In the interim period, i.e. between the decisions to grant the patent and the publication of the mention of the grant, the application is deemed to be still pending before the EPO. Once the grant of the patent has been mentioned, the earlier procedure is terminated and the application is no longer pending. Thus, the date after which the applicant is no longer allowed to file a divisional application is that on which the European Patent Bulletin mentions the grant of the earlier patent because on that date the patent is deemed to be outside the EPO's jurisdiction, and a divisional application could not be filed on the same date because the application is definitively removed from the EPO's sphere.

In **J 28/03** (OJ 2005, 597) the Legal Board of Appeal confirmed that an application was pending up to (but not including) the date on which the European Patent Bulletin mentioned the grant of the European patent, or until the date on which the application was refused, withdrawn or deemed withdrawn; if notice of appeal was filed against the **decision to refuse**, a divisional application could still be filed while appeal proceedings were under way (see Notice dated 9.01.2002, OJ 2002, 112). The logical idea behind the Notice of the EPO concerning the amendments of R. 25(1) EPC 1973, which stated that only an appeal against a refusal of the patent application would allow the filing of a divisional application, was to enable a party to file a divisional application independently of the outcome of the appeal, in other words even if the refusal of the "parent application" were to be confirmed by the board of appeal the divisional application would have its

own and independent examining procedure. On the other hand, an appeal against a decision granting a patent and resulting in publication of the grant of the patent would be expected to be inadmissible under Art. 107, first sentence, EPC 1973 and should therefore not enable the applicant to file a divisional application even during the appeal procedure. This could also be understood as a means of preventing abusive appeals based on artificial construction of pending "parent applications". Thus, the status of a divisional application filed while an appeal was pending against the decision to grant a patent pursuant to the parent application depended on the outcome of that appeal. Therefore, the department of first instance could not decide on the question whether the divisional application had been validly filed until the decision of the board of appeal on the appeal was taken.

7. Procedural questions

7.1. Basic considerations

The procedure concerning the divisional application is in principle independent from the procedure concerning the parent application. Although there are some connections between the two procedures (e.g. concerning time limits), actions (or omissions) occurring in the procedure concerning the parent application after the filing of the divisional application should not influence the procedure concerning the latter (**G 4/98**, OJ 2001, 131, point 5 of the reasons). This does not give the parent application any procedural priority over the divisional application, which is like any other application and in particular does not have subordinate procedural status (**T 1177/00**, **T 1176/00**).

This view was affirmed by the board in **T 1254/06**, which inter alia asked whether the legal force of a **decision to remit** in respect of a divisional application went beyond the divisional application procedure itself and affected the parent application procedure to the extent that it could prevent different parts of the EPO (including the boards of appeal) from dealing with the substance of identical requests. With regard to the case in question, the board stated that the principle that both proceedings were independent meant that a decision to remit in one procedure did not have a **preclusive effect** with respect to identical requests in the other procedure. This applied in particular when – as in this case – the decision to remit was made not by the board of appeal but by the examining division, because the first-instance administrative decision – unlike the final decision of a judicial body – did not have true res judicata effect.

In **T 51/08** the appellant had submitted with the statement of grounds of appeal amended claims corresponding to the second auxiliary request of the parent application which had been refused. The board held that this subject matter had become res judicata and therefore could not form a suitable attempt to remove the factual basis for the rejection. Subject matter on which a final decision has been taken by a board of appeal in the parent application becomes res judicata and cannot be pursued in the divisional application.

In case **J 5/07** the appellant had been invited in a communication of the Examining Division dated 16 March 2005 to file observations according to Art. 96(2) EPC 1973 (now

Art. 94(3) EPC) within a period of four months. No observations were received by the EPO within this period and the appellant's request for further processing with regard to its application was rejected on the ground that the omitted act was not completed in due time (Art. 121(2) EPC 1973; now R. 135(1) EPC). The appellant filed an appeal against this decision, arguing that the omitted act was in fact completed because in response to the communication a divisional application was filed by the appellant. The Legal Board saw no reason to doubt that the filing of a divisional application was a reaction of the appellant to the Examining Division's objections to the claims of the present application made in its communication dated 16 March 2005. However, the filing of a divisional application did not constitute a response to the invitation by the Examining Division in the parent application within the meaning of Art. 96(3) EPC 1973 (now Art. 94(4) EPC). The board highlighted that a divisional application was legally and administratively separate and independent from the grant proceedings concerning the parent application. The filing of a divisional application left the text of the patent application objected to unamended. Therefore, no logical or legal basis could be found for treating an act during the grant procedure for one application (the divisional) as the procedural step required to make up for a failure to comply with a time limit to be observed in entirely separate grant proceedings (the parent).

7.2. Intention to file a divisional application, or right reserved to do so

In **T 1184/03** the appellant requested, in the oral proceedings, that delivery of the decision be postponed with a view to filing a divisional application. The board stated that the case was ready to be decided at the oral proceedings. **Postponing the decision** of the board to allow the filing of a divisional application would run counter to the public interest in having the matter decided as expeditiously as possible, because the matter ready to be finally decided by this board would be pending again.

In **T 591/05** the board noted that the declaration made by the appellant (applicant) during the examination procedure that he reserved the right to file divisional applications expressed at the most an intention at that time and did not create any obligation on the part of the examining division in charge of the examination of the application to check the status of any possible divisional application based on the application, still less possibly to **postpone the grant of the patent** in order to elucidate the outcome of the appellant's intentions regarding possible divisional applications. Thus, once the appellant had given his approval to the text for grant during the grant procedure, the general principles of due process and good faith were fully complied with by the examining division. The formulation of the requests during the grant procedure and the approval of the application documents proposed for grant were the sole responsibility of the appellant and it was incumbent upon the appellant, and not upon the examining division or upon the EPO, to undertake the appropriate measures to ensure that any possible divisional application was being filed in due time before the grant procedure was closed (with reference to **T 824/00**, OJ 2004, 5 and **T 953/96**).

The board could not see in what respect the divisional application might have had any bearing on the admissibility of the present appeal. In particular, any allegation relating to the circumstances under which the divisional application was filed might well have been

pertinent to the legal status of the divisional application, but was irrelevant to the issue of the admissibility of the present appeal. Neither the fact that the appellant announced his intention to file a divisional application nor the filing and the status of the divisional application constituted a sufficient reason to conclude that the appellant was adversely affected by the decision to grant within the meaning of Art. 107 EPC (with reference to **T 549/93**).

7.3. Designation of contracting states in a divisional application

According to Art. 76(2) EPC 1973, the European divisional application shall not designate contracting states which were not designated in the earlier application. Pursuant to Art. 76(2) EPC all the Contracting States designated in the earlier application at the time of filing of a European divisional application are deemed to be designated in the divisional application.

Following revision, the new R. 36(3) and (4) EPC under Art. 51(3) EPC not only stipulate the fees payable and the respective time limit, but also the legal consequences of the failure to make payment on time.

In **G 4/98** (OJ 2001, 131), the Enlarged Board of Appeal found that there was no support under the European patent system for the view that a failure to pay designation fees in due time had the effect that the designations disappeared retroactively as if they had never existed. On the contrary, the board pointed out that the wording of Art. 78(2) and Art. 79(2) EPC 1973 and the system clearly indicated that up to the due date for payment of the designation fees, the designations had full effect. Only if the designation fees were not paid in due time would the designations not have any effect with respect to acts to be performed after that date, such as the filing of a divisional application. Retroactivity of the effects of non-payment of designation fees would occur only where the EPC explicitly provided for it, i.e. in the case of provisional protection (Art. 67(4) EPC 1973).

The applicant might designate all contracting states designated in the parent application in the divisional application, and he might proceed with all of them even if in respect of the parent application he later paid only some or no designation fees. This was in line with the fact that the procedure concerning the divisional application was in principle independent from the procedure concerning the parent application and that the divisional application was treated as a new application. Although there were some connections between the two procedures (e.g. concerning time limits), actions (or omissions) occurring in the procedure concerning the parent application after the filing of the divisional application should not influence the procedure concerning the latter. Moreover, the applicant was not forced into the senseless act of paying designation fees for a parent application in which he had lost all interest. This supersedes the decision in **J 22/95** (OJ 1998, 569), according to which failure to pay a designation fee rendered the designation void ab initio.

In **J 40/03** the appellant asked to designate Sweden in a divisional application filed **after** the time limit for payment of designation fees on the parent application had expired. Sweden was designated in the parent application as filed but no designation fee for that

state had been paid. The board confirmed the established case law (**G 4/98**, OJ 2001, 131; **J 25/88**, OJ 1989, 486; **J 19/96**) that the designations in a parent application, all or some of which may be designated in a divisional application, were those in the parent at the time of filing of the divisional application. If the time limit for paying the designation fees for the parent had not expired, there would be complete identity of potential designations since all the deemed precautionary designations of the parent would be available to the divisional. However, if that time limit had expired and designation fees had been paid for fewer states than those originally designated in the parent, then the divisional could only designate some or all of those states which remained designated in the parent; other states formerly designated in the parent were deemed withdrawn by virtue of Art. 91(4) EPC 1973 (now R. 39 (2) EPC), and thus deemed never to have benefitted from any provisional protection by virtue of Art. 67(4) EPC 1973. Art. 76(2) EPC 1973 should be interpreted as "all states **validly** designated in the parent may also be designated in the divisional".

In **J 1/05** the applicant had paid the designation fee only in respect of Italy and did not file the divisional application designating all the EPC contracting states until after the normal time limit for payment of designation fees for the parent application. The board confirmed **G 4/98** (OJ 2001, 131), in which it was held that only such states as were already designated in the parent application could be designated in a divisional application, or, in the event that the designation fee for the parent application had not been paid, those for which the normal period for payment of the designation fee had not yet expired. After expiry of that period, the provisional designation of any other contracting states was deemed to be withdrawn and the right to designate further states was lost. Moreover, no right to the valid designation of new states in the divisional application could be derived from the fact that an appeal was pending against a notification of a loss of rights under R. 69 (2) EPC 1973 (now R. 112 (2) EPC) in relation to the parent application. The divisional application could therefore claim territorial validity only for Italy.

7.4. Correction of errors

In **J 17/97** and **J 18/97** the representative had filed the parent application in the name of I, but the divisional application in the name of S. Due to the different identities of the applicants, the Receiving Section had refused to treat the application as a divisional application. In its decisions, the Legal Board did not allow the request for correction to replace the name of the applicant of the divisional application with the name of the applicant of the parent application pursuant to R. 88 EPC 1973 (now R. 139 EPC) because the appellant had not proved that the divisional application had been filed in error by S and should have been filed by I. R. 88 EPC 1973 may not be used to enable a person to give effect to a change of mind or to a subsequent development of plans.

In **T 1008/99**, the request for correction of errors concerned a European divisional application which had been filed with a wrong description unrelated to the earlier (parent) application. The wrongly filed description was therefore to be replaced by the description of the parent application. The board held that, for the purposes of R. 88 EPC 1973, the error had to be **apparent from the divisional application itself**, and the parent

application could not be used to demonstrate that the error was obvious. Even if it was apparent from the filed description, claims and drawings that they did not belong together, it was not immediately clear from the divisional application itself which of these parts was incorrect. For that reason alone, the correction requested under R. 88, second sentence, EPC 1973 was not allowable.

V. PRIORITY

The right of priority is generally regarded as one of the cornerstones of the Paris Convention. Its basic purpose is to safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention, thereby alleviating the negative consequences of the principle of territoriality (**T 15/01**, OJ 2006, 153).

Art. 87 to 89 EPC provide a complete, self-contained code of rules on claiming priority for the purpose of filing a European patent application (see **J 15/80**, OJ 1981, 213, most recently confirmed in **J 9/07**). However, since the EPC - according to its preamble - constitutes a special agreement within the meaning of Art. 19 of the Paris Convention, it is clearly intended not to contravene the basic principles concerning priority laid down in the latter (see **T 301/87**, OJ 1990, 335; **G 3/93**, OJ 1995, 18 and **G 2/98**, OJ 2001, 413). Furthermore, in view of Art. 87(1) and (2) EPC, the priority system adopted by the European legislator also recognises "internal priorities" (**T 15/01**, OJ 2006, 153).

The EPO does not normally check the validity of a priority right during examination. A check must be made, however, if relevant prior art has been made available to the public within the meaning of Art. 54(2) EPC on or after the priority date claimed and before the date of filing or if the content of the European patent application is totally or partially identical with the content of another European application within the meaning of Art. 54(3) EPC, such other application claiming a priority date within the above-mentioned period (Guidelines C-V, 2.1 - version of April 2010). In opposition proceedings this applies where prior art is invoked in connection with a ground for opposition under Art. 100(a) EPC in relation to which the priority date is of decisive importance (Guidelines D-III, 5 - version of April 2010). Failure by the division to check the validity of the priority right in the circumstances described has been held to be a substantial procedural violation (see **T 16/89**, **T 737/95**, **T 2170/08**).

For issues of evidence concerning the validity of the priority claim, see also VI.H.4.3.4 and 5.1.2. For decisions on the correction of the priority declaration see VII.A.6.2.

A. Applications giving rise to a right of priority - General issues

1. Application filed in or for a state which is party to the Paris Convention or a member of the WTO

Under the EPC 2000 Art. 87(1) EPC has been amended to align it with Art. 2 of the TRIPS Agreement, which requires that priority rights also be extended to first filings made in or for any member of the World Trade Organization (WTO) (OJ SE 4/2007, 88). The revised provision governs applications filed on or after 13 December 2007.

Previously, in **G 2/02** and **G 3/02** (OJ 2004, 483) the Enlarged Board decided that the obligations deriving from the TRIPS Agreement did not bind the EPO directly and did not therefore entitle the applicant for a European patent to claim priority from a first filing in a

state which at the relevant dates was not a member of the Paris Convention but was a member of the WTO/TRIPS Agreement.

2. Priority right of the applicant or his successor in title

In **T 1008/96** the European patent application resulting in the patent in suit and the two Italian utility model applications from which priority was claimed had been filed by different persons. The board held that the succession in title had to be proven to its satisfaction. It was a general principle of procedural law that any party claiming a right had to be able to show that it was entitled to that right (see **J 19/87**). This question had to be answered in accordance with national law. The board concluded that the respondent had **failed to prove that it was the successor in title** in respect of the two Italian utility model applications. Consequently, no priority rights existed for the patent in suit.

In **T 62/05** the board pointed out that the EPC did not contain any regulations on the formal requirements that an **assignment of priority rights** for the filing of a European patent application should fulfil in order to be considered valid for Art. 87(1) EPC 1973. However, having regard to the crucial effect that a valid priority date has on patentability (cf. Art. 89 EPC 1973), and to the fact that, in the case at issue, the validity of the priority claim depended on the validity of the transfer of the ownership of the right of claiming priority from the Japanese first filing for the European patent application, such transfer of priority rights, in the board's view, had to be proven in a formal way (cf. **T 1056/01**). It hence appeared reasonable to the board to apply an equally high **standard of proof** as that required for the assignment of a European patent application by Art. 72 EPC 1973, which, however, the board concluded was not met here. In particular, the appellant could not convince the board that an assignment had taken place implicitly and tacitly before the end of the twelve month period or that it would have been illogical for the applicant of the priority application to assign the application to the applicant for the patent in suit without assigning the corresponding priority rights.

In **T 493/06** it was held that the respondents had provided sufficient proof of the assignment of priority rights. In the board's view even a copy of an assignment agreement could be sufficient provided that evidence was supplied that the content of the copy was identical to that of the original document. Such evidence might, according to board of appeal case law, take the form of an affidavit - even though affidavits were not expressly mentioned in Art. 117(1) EPC 1973 - and the principle of unfettered consideration of the evidence applied to them (see e.g. **T 970/93**, **T 804/94**, **T 558/95** and **T 43/00**).

The question of succession in title has also arisen where the validity of the priority claim has been put in doubt in view of a still earlier previous application (see below under section C. First application).

3. National deposit of industrial design

In **J 15/80** (OJ 1981, 213) it was held that a priority right based on the deposit of an industrial design was not recognised for a European patent application. As the EPC was

a special agreement within the meaning of Art. 19 of the Paris Convention, a general understanding by the EPC contracting states that the deposit of an industrial design clearly gave a priority right for a national patent application could, by application of Art. 4 Paris Convention, lead to an interpretation of Art. 87(1) EPC 1973 going beyond its terms. However, in the absence of such a general understanding there was no reason to read Art. 87(1) EPC 1973 more broadly than its express terms and scope required.

In the board's opinion it was the law under the Paris Convention that, in relation to patent applications, a right of priority under that Convention existed if the prior application was for the protection of an invention as such and contained a disclosure of it. The deposit of an industrial design in essence protected aesthetic appearance. Although the deposited design might incorporate an invention, according to national design laws the deposit would not protect the invention as such.

4. Exhibition priority

In **T 382/07** it was held that an exhibition priority could not be validly claimed for a European application or patent. The board stated that the possibility of recognising exhibition priorities internationally followed from Article 11 Paris Convention. Its provisions allowed Paris Union member countries to recognise exhibition priorities in their domestic law under certain conditions but did not oblige them to do so. Entitlement to claim an exhibition priority was to be decided on the basis of the national law of the country where protection and priority were claimed, i.e. for a European application or patent the EPC, and not the law of the country where the exhibition took place or a first application claiming the exhibition priority was filed. Since the EPC did not recognise exhibition priorities, any priority claim based on an invention disclosure at an exhibition must fail in the case in hand.

5. Postdating of the previous application

Swiss patent law allows a patent application to be postdated if it is subsequently amended. In **T 132/90** the patent proprietor had claimed 11.3.1983, the original filing date of the earlier Swiss application, as the priority date for his European application dated 9.3.1984. In 1985 the Swiss Patent Office ordered that the filing date of the Swiss patent application be set at 1.7.1983 following subsequent completion of the technical documentation.

The board of appeal concluded that the original application should serve as the basis for claiming a priority right and that the priority date was the filing date of the original application. The postdating order did not take effect ab initio, and the subsequent fate of the original application was immaterial as far as the priority date was concerned.

6. Multiple exercise of the right of priority for one contracting state

In **T 998/99** (OJ 2005, 229) the board held that Art. 87(1) EPC 1973 made no provision for multiple filings in the same country within the priority period for the same subject-matter and hence the same invention in conjunction with the same priority document. As

derogations had to be interpreted strictly, only the first filing could validly claim priority. Neither Art. 4.G(1) of the Paris Convention nor its equivalent in the EPC 1973 (Art. 76(1), second sentence, EPC 1973) allowed a divisional application to give rise to a right of priority with effects going back to the date of filing of the initial application.

This interpretation was not echoed in the jurisprudence which followed. In **T 15/01** (OJ 2006, 153) the board pointed out that, with respect to the issue of exhaustion of priority, the wording of Art. 87(1) EPC 1973 appeared to be open to different interpretations. Since the EPC constituted a special agreement within the meaning of Art. 19 of the Paris Convention, this provision was not intended to contravene the basic priority principles of this Convention. The right of priority was generally regarded as one of the cornerstones of the Paris Convention. Its basic purpose was to safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention, thereby alleviating the negative consequences of the principle of territoriality. The Paris Convention in its present version explicitly recognised the possibility of claiming multiple and partial priorities and guaranteed the right to divide patent applications while preserving the benefit of the right of priority for the divisional application as well (principles also recognised in Art. 76(1), second sentence, EPC 1973 and Art. 88(2) and (3) EPC 1973). In the light of the above, the board considered that the priority provisions of the Paris Convention had to be construed in a manner which ensured that the general purpose they served, namely to assist the applicant in obtaining international protection for his invention, was fulfilled as far as possible. Furthermore, the board examined more closely the circumstances under which the issue of exhaustion might arise (splitting up of the subject-matter of the priority application to avoid non-unity objections; filing of a deficient subsequent application and remedying it by means of a second filing; combination of the originally disclosed subject-matter with further improvements and additional embodiments developed during the priority period) and analysed the interests involved. It concluded that the same priority right might be validly claimed in more than one European patent application; there was no exhaustion of priority rights. In **T 5/05** the board again confirmed that neither the Convention nor the Paris Convention contained any indication that the right of priority constituted an exception which therefore had to be interpreted narrowly and thus allowed the right of priority to be exercised only once for one contracting state. These decisions were followed in **T 1562/06**.

B. Identity of invention

In accordance with Art. 87 EPC (unamended in this respect) a European patent application is only entitled to priority in respect of "the same invention" as was disclosed in the previous application. The Enlarged Board of Appeal stated in **G 2/98** (OJ 2001, 413) that the concept of "the same invention" was to be interpreted narrowly and equated with "the same subject-matter" in Art. 87(4) EPC 1973. This interpretation means that the priority of a previous application in respect of a claim in a European patent application in accordance with Art. 88 EPC 1973 is to be acknowledged only if the person skilled in the art can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole. The subject-matter of the claim defining the invention in the European application

has to be understood as "the specific combination of features present in the claim" (see also **T 948/97**).

1. Disclosure in the earlier application of the invention claimed in the subsequent application

1.1. Basic considerations in the interpretation of "the same invention"

In opinion **G 2/98** (OJ 2001, 413) the Enlarged Board of Appeal addressed the whole concept of "the same invention" in Art. 87(1) EPC 1973. (The relevant provisions were not amended in the EPC 2000 and the principles set out below continue to apply.) In the years preceding the opinion of the Enlarged Board in this case, the boards applied different yardsticks to assess identity of invention between a previous and subsequent application. One was to check whether all the features of the invention claimed in the European patent application were disclosed in the priority document ("novelty test"). In **T 311/93** and **T 77/97** in particular, boards looking at the validity of priority claims continued to apply the criterion of at least implicit disclosure used for the disclosure test under Art. 123(2) EPC 1973. Other decisions however followed the principle, developed in "Snackfood" (**T 73/88**, OJ 1992, 557), that adding non-essential features which merely limited the scope of protection did not invalidate the priority claim. This latter decision allowed a claim to enjoy priority despite containing an additional feature not disclosed in the earlier application.

In **G 2/98** the Enlarged Board of Appeal, ruling on points of law referred by the President regarding the interpretation of Art. 87(1) EPC 1973, first considered whether interpreting "the same invention" narrowly was consistent with the relevant Paris Convention and EPC 1973 provisions. A narrow interpretation meant that the subject-matter of a claim which defined the invention in a European patent application - i.e. the specific combination of features in that claim - had to be at least implicitly disclosed in the application whose priority was claimed. The Enlarged Board held that a broad interpretation, distinguishing between those technical features which related to the function and effect of the invention and those which did not - with the result that an invention could still be considered "the same" even if a feature were amended, deleted or added - was inappropriate and prejudicial to a proper exercise of priority rights. To ensure a practice fully consistent, inter alia, with equal treatment for applicants and third parties, legal certainty and the principles for assessing novelty and inventive step, "the same invention" had to be interpreted narrowly and in a manner equating it to "the same subject-matter" in Art. 87(4) EPC 1973. This interpretation was underpinned by the Paris Convention and the EPC 1973, and was entirely consistent with opinion **G 3/93** (OJ 1995, 18). The Enlarged Board therefore ruled on the points of law referred to it as follows:

The requirement for claiming priority of "the same invention", referred to in Art. 87(1) EPC 1973, means that priority of a previous application in respect of a claim in a European patent application in accordance with Art. 88 EPC 1973 is to be acknowledged only if the skilled person can derive the subject-matter of the claim

directly and unambiguously, using common general knowledge, from the previous application as a whole.

The principles laid down by the Enlarged Board in **G 2/98** mean that many statements made in decisions based in particular on **T 73/88** (holding that adding non-essential and merely scope-limiting features did not invalidate a priority claim) are no longer relevant (e.g. **T 16/87**, OJ 1992, 212; **T 582/91**, **T 255/91**, OJ 1993, 318; **T 669/93**, **T 1056/93** and **T 364/95**; see also "Case Law of the Boards of Appeal of the EPO", 3rd ed. 1998, p. 263 et seq. and 269 et seq.).

The older case law which devised the **"novelty"** and **"disclosure"** tests still applies following **G 2/98** (and **G 1/03** and **G 2/03**, see 1.2 below). This case law provides that two applications relate to "the same invention" within the meaning of Art. 87 EPC 1973 when they both contain "the same subject-matter". The invention or subject-matter of a previous application is to be considered identical to that of a subsequent one if the disclosure of both applications is the same (**T 184/84**). Disclosure in the previous application means that the subject-matter of the claims of the European application must be clearly identifiable in the documents of the previous application taken as a whole (**T 81/87**, OJ 1990, 250; **T 359/92**, **T 469/92**, **T 597/92**, **T 296/93** and **T 620/94**). Identical wording is not required (**T 81/87**, OJ 1990, 250; **T 184/84**).

1.2. Amendments and disclaimers

As has been stated in **G 2/98** (OJ 2001, 413), the extent of the right to priority is determined by, and at the same time limited to, what is disclosed in the priority application.

In **T 923/00** the application as filed and the priority document were in essence identical. The board emphasised that any conclusion in favour of or against the amendments' allowability under Art. 123(2) EPC 1973 would also apply in favour of or against entitlement to the claimed priority, and dealt with both issues jointly.

In **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) the Enlarged Board held that in order to avoid any inconsistencies, the disclosure as the basis for the right to priority under Art. 87(1) EPC 1973 and as the basis for amendments in an application under Art. 123(2) EPC 1973 had to be interpreted in the same way. That meant that a disclaimer, not providing a technical contribution as outlined, which was allowable during the prosecution of a European patent application did not change the identity of the invention within the meaning of Art. 87(1) EPC 1973. Therefore its introduction was allowable also when drafting and filing the European patent application without affecting the right to priority from the first application, which did not contain the disclaimer (see also **T 175/03** and **T 910/03**).

1.3. Disclosure in the previous application as a whole

Under Art. 88(4) EPC 1973 it suffices if the features claimed in the later application are disclosed by the earlier application taken as a whole (**T 497/91**, **T 184/84** and **T 359/92**).

Art. 88(4) EPC 1973 cannot be construed as meaning that a priority document must comprise claims in order to form a regular national filing within the meaning of Art. 87(3) EPC 1973 which can give rise to a right of priority. If the priority document does not include any claims, this does not mean that the conditions of Art. 88(4) EPC 1973 are not fulfilled (**T 469/92**). Features of the invention may also be disclosed in the drawings (**T 169/83**, OJ 1985, 193).

On the other hand, **T 409/90** (OJ 1993, 40), showed that a broad claim in the previous application was not necessarily a suitable basis for a priority right. This decision was based on the principle that what was disclosed by a priority document was what could be deduced from the priority document as a whole by a person skilled in the art. However, when considering what was disclosed in a priority document's claim it was necessary to bear in mind the purpose of the claim, i.e. to define the protection sought. The fact that a claim in a priority document was broad enough to cover specific subject-matter filed for the first time in a later application was not by itself sufficient evidence that such subsequently filed subject-matter had already been disclosed in the priority document, or that subsequent claims based on the later-filed subject-matter still defined the same invention as that which was the subject of the priority document.

At issue in **T 289/00** was whether the feature in Claim 1, namely that a channel was enclosed on all sides, was directly and unambiguously disclosed in the priority application. The board accepted that the latter's reference to the channel as "filled with air" did not in itself mean that it was enclosed. However, under Art. 88(4) EPC 1973 the previous application's documents had to be considered as a whole, and the reference therefore had to be seen together with the other information on this matter which the skilled person would derive from the application. A skilled person considering the priority application documents as a whole would conclude, without further information, that the channel would be enclosed on all sides.

In **T 515/00** the board noted that a claim passed the priority test if its subject-matter could be derived from the previous application **as a whole**. It followed that comparing the claim with the corresponding claim of the previous application was not a valid approach to performing the "priority test".

1.4. Reference to common general knowledge

In **T 136/95** (OJ 1998, 198), the board stated that identity of invention has to be assessed by reference to the skilled person. A patent application is a technical document, addressed to the skilled person, not a work intended for the general reader. However, the skilled person is not familiar, unlike in the assessment of inventive step, with all the prior art, but only with those elements of it which form part of his **general knowledge**, and it is on the basis of this knowledge, or by carrying out simple operations derived from it, that he may infer whether or not there is identity of invention.

The board came to the conclusion that it was necessary to give some flexibility to the requirement for identity of invention between the two applications. Some features claimed in the European application need not be expressly mentioned in the previous

application whose priority is claimed, provided that the skilled person is able, purely on the basis of his knowledge or by performing simple operations to carry out the invention, to infer these features from the prior application. In the case in question a **structural feature** claimed in the European patent application was supported by a **general functional feature** described in the prior application.

In **T 744/99** the appellant had argued that claim 8 was not entitled to priority because the British patent application from which priority was claimed did not disclose a receiver. The board noted that the requirement for the subject-matter of a claim to be derivable "directly and unambiguously, using common general knowledge from the previous application as a whole" in accordance with opinion **G 2/98** (OJ 2001, 413), such subject-matter could not be novel with respect to the disclosure of the priority document. The application of common general knowledge could only serve to interpret the meaning of a technical disclosure and place it in context; it could **not** be used to **complete** an otherwise incomplete technical disclosure.

Thus the board concluded that, since the priority document only disclosed a new signal protocol without any disclosure of a suitable receiver, claim 8, which was directed to such a receiver, was not entitled to the claimed priority date, but only to the filing date.

1.5. Explicit or implicit disclosure of the "essential" features in the priority document

1.5.1 General

In order to give rise to priority all the essential elements, i.e. features of the invention in the priority document must be either expressly disclosed or directly and unambiguously implied by the text as filed. The question therefore arises as to what constitutes the essential elements, i.e. features of the invention, claimed in the European patent application, and whether or not these features are disclosed in the respective priority documents (cf. Art. 88(4) EPC 1973; see also **T 81/87**, OJ 1990, 250; **T 65/92**, **T 127/92**, **T 296/93**, **T 479/97**, **T 342/98** and **T 188/97**). Essential elements missing in the priority document and recognised as essential only later on, are not part of the disclosure of the previous application and there is then no right to priority (**T 81/87**, OJ 1990, 250; **T 301/87**, OJ 1990, 335; **T 269/87**, **T 296/93**, **T 1228/01**). The "essential features" within the meaning of this jurisprudence are not the counterpart to the "non-essential features" within the meaning of **T 73/88** ("Snackfood", OJ EPO 1992, 557) decision. Accordingly, the jurisprudence based on **T 81/87** has been upheld even after the opinion given in **G 2/98** (see, for instance, **T 479/97**).

1.5.2 Cases of non-disclosure of an essential feature

In **T 923/92** (OJ 1996, 564) the board maintained a patent on a process comprising the preparation of a protein with (further specified) human tissue plasminogen activator function. The subject-matter of the claim was defined by means of reference to an **amino acid sequence**. The sequence contained in the European application was disclosed for

the first time in the third priority document (P3). It differed from the sequence reported in the first and second priority documents (P1 and P2) in respect of three amino acids.

The board held that only the priority of P3 could be claimed. In the board's judgment, the skilled person would consider the primary amino acid structure of a protein to be an essential feature thereof because it represented its chemical formula. He would therefore consider the reference to the amino acid sequence of a protein as having not merely an informational character but as being a **primary technical feature** linked to the character and nature of the product. When comparing the sequences reported in P1/P2 and in P3, the skilled reader could not know whether, in spite of the differences, the sequences were identical in their physical and biological characteristics; at least on paper the quoted replacements of amino acids could imply important structural and functional differences. The evidence submitted by the patentee was understandably restricted to the testing of a limited number of parameters and left open the possibility that the two polypeptides could differ in many other properties (see also 1.10 below, "Inventions relating to nucleotide and amino acid sequences").

In **T 1052/93** it was an essential feature of the wash adjunct products claimed in the European patent that they contained sodium perborate monohydrate in conjunction with a **functionally defined activator**. The priority document only mentioned certain activators complying with the functional definition in the European patent; these specific compounds could not be considered to disclose the broad group of activators functionally defined in claim 1 of the European patent.

In **T 1054/92** of 20.6.96 claim 1 contained the feature that the absorbent structure had a **moisture content** of less than 10%. This feature could not be derived from the disclosures in the first and second priority documents. The said upper limit was only introduced by the third priority document. The board could accord to the subject-matter of claim 1 only the third priority date. The feature concerning the moisture content of less than 10% was an essential element. The relevant feature appeared in claim 1 as originally filed and was relied upon by the appellant in the examination proceedings when seeking to distinguish the subject-matter of this claim from cited prior art.

In **T 277/95** the board found that a claim to a method of producing in CHO cells hEPO characterised by the presence of a specific **glycosilation pattern** did not enjoy priority from a priority application which made available the cell line but gave no information on the specific glycosilation pattern.

In **T 479/97** a first priority document characterised the *pelC* gene claimed in the subsequent application as being on a **5kb DNA fragment** which was carried by a deposited plasmid. The board found that even if the sequence of the DNA fragment was known this did not necessarily imply that the provision of this fragment made available in a direct and unambiguous manner a specific gene which it contained, if only because the 5kb fragment which was bigger than the gene of interest might carry more than one gene.

1.5.3 Example of disclosure of essential features of an invention

In **T 172/95** the board did not follow the appellant/opponent's argument that for the copolymer the subsequent European application contained information not to be found in the priority document. As to the objections concerning the fractionation method the appellant could provide no evidence for his allegation that the differences which were present would result in different ethylene polymers being claimed in the priority document and in the patent in suit. In contrast, the respondent provided evidence of the contrary.

Regarding the calculation methods for two parameters defining the claimed copolymer, the board pointed out that the passage not present in the priority document did not change anything in the actual method of determination of these parameters, but merely specified how a person skilled in the art would normally operate. Therefore, the introduction of the above passage into the application as filed did not change anything in the definition of the copolymer, hence did not in substance modify the teaching of the priority document. Whereas in the priority document the copolymer could have one or more melting points, in the subsequent European application the possibility of two melting points was excluded.

1.6. Solution of the same problem

In **T 647/97** the board stated that the invention or subject-matter of a previous application was to be considered the same as that of a subsequent application if the disclosure of both applications was the same. This not only required that the solution to a given problem (i.e. the features of the main claim) was the same, but also that the problem itself was the same in both applications. The **proper definition of the problem to be solved in the priority document** as understood by the skilled person reading the document with his common general knowledge in the art at its filing date was decisive to that end.

The board noted that the priority document only mentioned solid and gel copolymer compositions for providing a sustained-release composition for treating periodontal disease (first problem), but was silent about any fluid or liquid compositions. The skilled person would moreover not consider fluid and liquid compositions as a suitable solution for the problem addressed in the priority document. It was only disclosed in the contested patent that the fluid and liquid compositions surprisingly transformed into a near solid phase and would therefore be suitable for treating difficult to reach areas of periodontal cavities (second problem). It therefore constituted a second invention involving a different problem and a different solution.

1.7. Same teaching in the priority document

In **T 250/06** the board emphasised that, for priority to be acknowledged, it was not sufficient that a formal support for the claimed subject-matter be found in the priority document; on the contrary, it pre-supposed that the priority document also provided an

adequate technical teaching in respect of said subject-matter and that this was the "same" teaching as that of the European patent.

Claim 1 related to a group of recombinant DNA molecules comprising a nucleotide sequence encoding a vertebrate delta opioid receptor (DOR) characterised as hybridising under conditions of low stringency to the mouse DOR DNA sequence shown in Figure 5. The priority document taught the cloning of the mouse DOR DNA and its sequence. The proprietor/respondent emphasised that this was the key to cloning further vertebrate DOR DNAs. The board agreed that the provision of the mouse DOR DNA sequence was one essential element in the cloning of further DOR DNAs of different origins. However, as was readily apparent from the priority document per se, this teaching on its own was not sufficient. In Example 6, a human DOR DNA was allegedly identified by probing a human DNA library with mouse DOR DNA. Yet, the clone so isolated turned out to be μ OR DNA. The European patent application disclosed the isolation of μ , κ and DOR clones and their unambiguous characterisation, in particular by comparison with sequences then available in the art. Thus, it contained a technical teaching which was different from (more complete than) that of the priority document.

In **T 1443/05**, too, the board concluded that the teaching of the contested patent, which included a disclaimer not present in the previous European patent application from which priority had been claimed, was different from the teaching of the latter, such that the requirement of the "same invention" according to Art. 87(1) EPC and **G 2/98** (OJ 2001, 413) was not met. The board also found in this case that examples included in the previous application (now an Art. 54(3) EPC 1973 document) anticipated the subject-matter of Claim 1 of the patent in suit.

1.8. Error margins and definitions of limits

Prior to the opinion given in **G 2/98** (OJ 2001, 413), it was sometimes possible to claim error margins or definitions of limits which differed in the subsequent application from the original one. In the jurisprudence which came after **G 2/98**, however, reference is no longer made to the decisions handed down in **T 212/88** (OJ 1992, 28), **T 957/91**, **T 65/92** and **T 131/92** (see "Case Law of the Boards of Appeal of the EPO", 3rd ed. 1998, p. 263 et seq.). But since the facts are only comparable up to a certain point, it is not possible to say unequivocally to what extent the principles laid down earlier still apply.

In **T 201/99** the cited priority applications disclosed, in respect of the **mean residence time** of the material in the granulator/densifier, either the range "from about 1-6 minutes" (claim 1 of both priorities) or, for all the examples, a specific residence time of "about 3 minutes". In contrast, claim 1 of the granted patent claimed a mean residence time of "1-10 minutes". The appellant had argued that the upper limit of "6 minutes" was not disclosed in the cited priorities as a cut-off value (i.e. as possibly related to the function of the invention and its effect) and thus constituted a feature which might be modified without changing the nature of the invention.

This argument was not accepted by the board, which held that, even if for the sake of argument the range of "about 1 to 6 minutes" given in the priority applications was

interpreted as an open range extending far beyond "6 minutes", the value of "10 minutes" as well as, for instance, the range from above 6 minutes up to 10 minutes still constituted selections not disclosed in the priority applications. It followed that for a skilled person applying his common general knowledge the value of "10 minutes", at least, was not derivable directly and unambiguously from the prior applications.

The invention in **T 423/01** concerned a method for analysing length polymorphisms in simple or cryptically simple DNA regions. The priority document contained a definition of the simple DNA sequences analysed according to the invention. According to this definition, these sequences incorporate short **DNA motifs** repeated in tandem repeats and containing at least one nucleotide and a maximum of approximately 6 to 10 nucleotides. Example 2, which was identical to Example 2 in the application, described the detection of length polymorphisms of a DNA sequence containing a trinucleotide sequence as repeating unit. According to claim 1 of the patent in suit, the DNA sequences in the invention incorporated repeating units of between three and six nucleotides. The respondents objected that the claimed upper limit, in particular, could not be found in the original documents.

The board considered the decision **T 201/83** (OJ 1984, 481) to be relevant to the question of rightful priority claims, although it is concerned with the original disclosure of quantitative ranges of values within the meaning of Art. 123(2) EPC 1973. According to this case law, an amendment to a range in a claim is allowable on the basis of a particular value described in a specific example, provided the skilled man could have readily recognised this value as not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention as a whole in a unique manner and to a significant degree. Applying the above case law, the board held that the claimed priority was validly claimed. The board had already established, in the context of Art. 123(2) EPC 1973, that the phrase "approximately 6 to 10" explicitly disclosed the number six. A range between the value 3 disclosed as preferred in Example 2 and the lowest value of the "range" already mentioned in the priority document for the upper limit value (at least one nucleotide and a maximum of 6 to 10 nucleotides) was to be considered disclosed by the original application.

In **T 250/02** the board found that the subject-matter of a claim for a herbal essential oil in which the total amount of carvacrol and thymol was at least 55%, and preferably 70%, by weight of the said essential oil could not be derived directly and unambiguously from a priority document disclosing a herbal oil containing "thymol and carvacrol in levels of 55% to 65%".

Further decisions concerned with differing ranges indicated in a priority document and disputed sets of claims include **T 903/97**, **T 909/97**, **T 13/00**, **T 136/01**, **T 788/01**, **T 494/03** and **T 537/03**.

1.9. Selection from generic disclosure

A generic disclosure implicitly encompassing two or more alternative embodiments cannot generally give rise to a right of priority in respect of one specific embodiment that is **neither explicitly nor implicitly** disclosed (**T 61/85** and **T 30/01**).

T 77/97 related to a case in which two dependent claims 4 and 5 of a European application related to individual compounds which were part of the group defined by the generic formula of claim 1. Claim 3 of the priority document defined by means of a generic formula a **group of four chemical compounds**, including the compounds according to the two claims 4 and 5 of the subsequent European application.

The board acknowledged that the priority document contained sufficient information for a skilled person to obtain without difficulty the four chemical compounds according to the generic formula of claim 3. However, this affirmative conclusion could not automatically lead to the recognition of the priority in relation to claims 4 and 5 concerned. With reference to decision **T 409/90** (OJ 1993, 40; see under 1.3 above), the board pointed out that it was not sufficient to establish that the compounds concerned fell within the scope of the claims of the previous application, and that they could be prepared without difficulty in accordance with the information contained in this application.

The expression "the same invention" as used in Art. 87(1) EPC 1973 had to be interpreted in conformity with the requirements of Art. 88(2) to (4) EPC 1973. Before a decision on the claimed priority could be taken, it was first necessary to establish the elements for which this priority was being claimed and whether these elements of the invention were revealed in a precise manner in the priority document. The applicant claimed the right of priority not only in respect of the element which distinguished all the compounds claimed in all the claims of the European application from the prior art, but also in respect of the specific combination of individual substituents which precisely defined the actual chemical compounds. It was therefore necessary to examine whether these elements, this **set of features**, had been revealed precisely by the documents of the prior application, as required by Art. 88(4) EPC 1973.

Although there was no doubt that the priority document described a very narrow group as being preferred, it did not, however, distinguish between the four compounds of this group, and neither did it specify that the formula of claim 3 had to be considered as an "abridged" formulation of a list or table indicating four individual chemical compounds. As a consequence, claims 4 and 5 could not be granted the claimed priority right (see also **T 295/87**).

The invention at issue in **T 30/01** concerned an apparatus for optical imaging and measurement. The board rejected the appellant's argument relating to an implicit disclosure in the priority document of two possible implementations of the teaching of the document, noting that its description unmistakably indicated the provision of the light steering means "in the sample arm". This precise disclosure deprived of support the appellant's construction of the disclosure as implicitly disclosing the provision of the light steering means in and outside the probe as two complementary alternative

implementations - let alone as disclosing any specific one of these two alternatives by way of "implicit disclosure" by reference to common general knowledge (**T 823/96**, **T 744/99** and **T 818/00**). The board also pointed out that the appellant's contention was at variance with the criterion consistently applied by the boards of appeal that a generic disclosure **implicitly encompassing two or more alternative embodiments** can generally not give rise to a right of priority in respect of a **specific one of the embodiments** that is neither explicitly nor implicitly disclosed (**T 61/85**) the latter criterion being a particular form of the "disclosure test" laid down in **G 2/98** (OJ 2001, 413) and constituting the logical corollary of the established principle - confirmed in opinion **G 2/98** (see also **T 744/99**) - that no right to priority can be acknowledged for an invention that is regarded as novel over the disclosure of the corresponding priority document.

T 788/01, **T 899/04** and **T 70/05** also saw the boards apply the principle that a generic disclosure cannot provide priority for a specific embodiment not disclosed in the priority document.

In **T 903/05** the claims of the patent related to the use of a telomerase peptide consisting of the sequence of SEQ ID NOs: 2, 3, 4, 9 or 10 for the manufacture of a medicament for the treatment or prophylaxis of cancer, the treatment or prophylaxis comprising generating a T cell response. The priority document disclosed more generally the use of telomerase peptides for use in a method of treatment or prophylaxis of cancer, in which a T cell response is generated. Among the preferred peptides were those of SEQ ID NOs: 2, 3, 4, 9 and 10, which were also part of the list of peptides disclosed in Tables 1 and 2.

The board recalled that, according to **G 2/98** (OJ 2001, 413), if the invention claimed in a later European patent application constituted a selection invention in respect of the subject-matter disclosed in a first application whose priority was claimed, the criteria applied by the EPO with a view to assessing the novelty of selection inventions over the prior art had also to be considered carefully when assessing whether the claim in the European patent application was in respect of the same invention as the priority application within the meaning of Art. 87(1) EPC 1973. Such priority claims should not be acknowledged if the selection inventions in question were considered "novel" according to these criteria. The board considered that in the case before it the selection of specific peptides from the disclosure of the priority document did not result in novel subject-matter since the selection was made from only one list of entities, i.e. the preferred peptides specified in the claims and Tables 1 and 2, such that the claimed subject-matter was directly and unambiguously derivable from the priority document.

1.10. Inventions relating to nucleotide and amino acid sequences

In **T 923/92** (OJ 1996, 564 - see also 1.5.2 above), claim 1, the subject-matter of which was defined by means of a reference to the amino acid sequence of Figure 5, was held not to be entitled to priority from earlier applications P1 and P2, in which that amino acid sequence was not disclosed. The sequence reported in Figure 5 was observed to differ from that of Figure 5 of P1 and P2 in respect of three amino acids. In the board's judgment, the skilled person would consider the reference to the amino acid sequence of

a protein as a primary technical feature linked to the character and nature of the product. Evidence from the patentee was restricted to the testing of a limited number of parameters and constituted at most proof of similarity, not of identity of the two polypeptides. These differed in one essential characteristic, i.e. the primary amino acid sequence.

In **T 351/01** a polynucleotide which was the subject-matter of claim 1 was characterised both in structural terms and by its function. Priority documents I and II disclosed a polynucleotide having the same function as that of the polynucleotide of claim 1. However, its structure differed from that of the polynucleotide of claim 1 by five bases, all found in the part of the sequence which does not relate to the function i.e. outside of the coding region. The board, referring to the Enlarged Board's opinion which had rejected an extensive or broad interpretation making a distinction between technical features which are related to the function and effect of the invention and technical features which are not, concluded that the subject-matter of claim 1 could not be seen as the same subject-matter as that disclosed in the priority documents.

In **T 30/02** the board had to decide whether an application cited under Art. 54(3) EPC 1973 had validly claimed priority. The board held that the presence of two additional guanine residues in the nucleotide sequence disclosed in this document resulted in a different molecule that was not directly and unambiguously derivable from the earlier application from which priority was claimed. It was generally acknowledged in the case law of the boards of appeal that the nucleotide sequence of a nucleic acid represents an essential feature linked to the character and nature of the nucleic acid as such, and, where the nucleotide sequence is a coding sequence, also of the encoded protein (see **T 923/92**, OJ 1996, 564). The skilled person was aware of the fact that even a minimal modification of the nucleotide sequence may result in a different nucleic acid not only from the structural but also from the functional point of view, and that a modification affecting a single nucleotide may result in the substitution of an amino acid in the encoded protein or in a shift of the reading frame (if one nucleotide is deleted or inserted), the outcome of which may be a truncated form of the protein or even a protein with a partial amino acid sequence which differs from the original sequence. Furthermore, since the primary sequence of the protein was, in most cases, determinant for its function, even small structural modifications of the nucleotide sequence could result in dramatic functional changes in the encoded protein. See also **T 70/05**.

In **T 1213/05** the invention related to the human BRCA1 gene isolated from the genome and its use in the diagnosis of predisposition to breast and ovarian cancer. The board inter alia had to deal with the question of whether the applicant could claim the priority of document (P2) despite the fact that the BRCA1 coding sequence disclosed in (P2) deviated from the BRCA1 coding sequence disclosed in the application as filed by 15 nucleotide residues.

The board recalled that the Enlarged Board of Appeal in opinion **G 2/98** had rejected an extensive interpretation of the concept of "the same invention", which makes a distinction between technical features which are related to the function and effect of the invention and technical features which are not, with the possible consequence that a claimed

invention is considered to remain the same even though a feature is modified or deleted, or a further feature is added. The case law of the boards dealing with the concept of "the same invention" in the field of biotechnology and especially in connection with inventions involving nucleotide sequences and amino acid sequences (**T 351/01**, **T 30/02**, **T 70/05**, **T 923/92**) had also taken a strict approach.

The proprietor/appellant took the view that, if parameters (here: the nucleic acid sequence) which are used to define a substance (here: a nucleic acid) in a claim were known to vary within margins of commonly encountered experimental errors, the occurrence of variation in such a parameter between a disclosure in a priority document and the corresponding later application did not necessarily abrogate entitlement to the claimed priority. The need for legal certainty for third parties could not be higher than experimental certainty. The proprietor further argued that the technical problem underlying the patent in suit was the provision of the isolated BRCA1 gene as a tool to diagnose a predisposition to breast or ovarian cancer. The sequence deviations were irrelevant for solving this problem. However, the board rejected both approaches as not being compatible with the EBA's conclusion in opinion **G 2/98**.

On the other hand, in two further decisions of Board 3.3.04, **T 80/05** and **T 666/05**, it was held that certain sequence deviations between the patent in suit and the contested priority documents (P2 and P4, respectively) did not affect the invention claimed. Consequently, in both cases the corresponding priority date was found to be valid.

In **T 250/06**, the claimed subject matter of the second auxiliary request was defined with reference to a hybridising sequence. Claim 1 of this request related to recombinant DNA molecules comprising a nucleotide sequence encoding a murine delta opioid receptor (DOR), characterised as hybridising under conditions of low stringency to the DNA sequence shown in Figure 5. Appellant II pointed out that Figure 5 of the priority document differed from Figure 5 in the patent application by the addition of seven interspersed bases in the 3' untranslated region. It concluded from this that the groups of claimed molecules to be retrieved by hybridisation to these reference molecules had to be different and that the priority document was thus not enabling. The board, however, pointed out that conditions of low stringency were developed for screening molecules which differ somewhat from the probe. It was fully expected that the group of molecules obtained by hybridisation to the DNA of Figure 5 of the priority document and of the patent in suit respectively would not be different.

2. Claiming the invention disclosed in the earlier application in the subsequent application

The features of the invention disclosed in the priority application must also characterise the invention claimed in the subsequent application.

2.1. Implicit features of the technical teaching of the subsequent application

In **T 809/95**, the opponents submitted that the "thin-walled" feature, which was **disclosed** in the first priority application **as essential**, was not contained in granted

claim 1. The board of appeal was of the opinion that granted claim 1 was based on a "collapsible" plastic bottle "produced by the blow-moulding method" which had folds "to facilitate a reduction of volume upon the exertion of a pressure applied to the walls by hand". This description in itself implied that the bottle would have to be made from thin-walled plastic flexible enough to be collapsible by hand when empty, as required by independent claim 3 in the first priority application.

2.2. Features missing with respect to the earlier application

2.2.1 Omission of non-essential features

In **T 809/95**, the opponents maintained that the claim at issue did not contain all the features which a skilled person would recognise as essential from the second priority document, with the result that the claim was directed to another invention. The board established, however, that the features which the opponents thought were missing were not connected in **any recognisably close way with the problem put forward in this priority document**. This problem was not solved by the missing features, but by other features, all of which could be found in the claim. Thus the subject-matter of this claim was entitled to claim the second priority.

In **T 576/02** the board pointed out that the omitted feature was even less essential in that it did not even appear in the independent claims of the priority document, which by definition specified all the essential features of the invention.

In **T 515/00** the appellant had argued that features pertaining to hardware components relating to the printing process were no longer present in the claim and that there was no basis in the priority document for the deletion of these features. The board referred to **G 2/98** (OJ 2001, 413, point 8.3 of the Reasons), in which the Enlarged Board had warned against an approach whereby a distinction was made between technical features which were related to the function and the effect of the invention and technical features which were not. Priority could not be acknowledged if a feature was modified or deleted, or a further feature was added.

The board further noted that a claim passed the priority test if its subject-matter could be derived from the previous application **as a whole**. It followed that comparing the claim with the corresponding claim of the previous application was not a valid approach to performing the "priority test". The priority test was basically a disclosure test in which the skilled reader could use common general knowledge. If, in the description of the previous application, a distinction was made between features that were essential for the performance of the invention and features which were not, the latter could be deleted from the subject-matter of a claim without losing the right to priority. The omitted hardware components were nowhere presented as essential features in the priority document's description. The skilled reader would not have any reason to assume that they were essential merely because they were present in claim 1 of the priority document. This decision was followed in **T 321/06**.

2.2.2 Omission of indispensable features

In **T 134/94** the priority document disclosed a **process** which worked under specific conditions indicated as features (a) to (d). Requirements (a) and (c) did not appear in the granted claim of the patent in suit. The board held that this claim was not entitled to priority. As requirements (a) and (c) did not appear in the granted claim the scope of the invention as defined thereby comprised areas which, according to the priority document, did not belong to the invention. Thus the invention defined by granted claim 1 was not the same as the invention defined in the priority document. On the priority date the technical problem underlying the invention was considered to be solved only if each of the conditions (a) to (d) was satisfied; according to granted claim 1 features (a) and (c) were no longer necessary for solving the problem underlying the invention.

On this point, the board argued that the respondent's position, which was that the priority claim should be acknowledged whenever the disclosure of the priority document would destroy the novelty of the claims of the later application or patent ("novelty test"), had no basis either in the EPC or in the EPO case law. Such a position would imply that essential features of an invention disclosed in a priority document could be omitted in a later application based thereon without loss of priority right. However, if an essential feature of an invention was so omitted, the invention was no longer the same, i.e. the requirement of Art. 87(1) EPC 1973 was not fulfilled.

In **T 552/94** the patent's claim 1 lacked four features which according to the priority document were indispensable for carrying out the invention. In other words, they were no longer essential to the invention as now defined. Citing **T 134/94** and **T 1082/93**, the board found that without those features the invention according to claim 1 could not be the same as that described in the priority document, and the requirements of Art. 87(1) EPC 1973 were therefore not met.

In **T 1050/92**, on the other hand, the disclosure of the invention in the earlier application provided an adequate basis for replacing the term used in said application with a more general one in the European application.

3. Enabling disclosure in the priority document

As already stated, Art. 87 EPC requires that the European patent application and the application whose priority is claimed relate to the same invention. The main criterion in this respect is whether the claimed invention is disclosed in the priority document as a matter of substance, i.e. with all its essential features. The disclosure of the essential elements must be either express, or be directly and unambiguously implied by the text. Missing elements which are to be recognised as essential only later on are thus not part of the disclosure (**T 81/87**, OJ 1990, 250; **T 301/87**, OJ 1990, 335; **T 296/93**, OJ 1995, 627; **T 188/97**). **T 81/87** and **T 296/93** also emphasise that the priority document must disclose the invention claimed in the subsequent application in such a way that it can be carried out by a person skilled in the art (**T 193/95**). In addition to **T 441/93** (see D.3 below) and **T 20/04**, see on this issue the decisions set out below.

In **T 81/87** (OJ 1990, 250), concerning living cells capable of expressing bovine preprorennin, only the priority claim of the second previous application was valid because in the first one the steps leading to the desired bovine preprorennin gene were **not sufficiently disclosed**. The board took the view that in order to give rise to priority rights the essential elements, i.e. the features of the invention, in the priority document had to be either expressly disclosed or directly and unambiguously implied in the text as filed; missing elements recognised as essential only later on were not part of the disclosure, and gaps with regard to basic constituents could not be retrospectively filled by relying on knowledge acquired in this manner. It could become a misuse of the priority system if some parties in a competitive situation were allowed to jump ahead of others on the basis of mere expectations and by omitting the critical features of the invention altogether.

In **T 296/93** (OJ 1995, 627) the board examined whether the priority document was deficient in respect of relevant technical information necessary for reducing the claimed invention to practice by the person skilled in the art without undue burden. Equally, in **T 207/94** (OJ 1999, 273) the board examined the question of whether the requirement in Art. 87 EPC 1973 that the same invention must be claimed in the priority application and the European patent application was fulfilled in the sense that the priority application disclosed the invention claimed in the subsequent European application in an enabling manner.

In **T 767/93** claim 1 of the European patent related to a process which comprised expressing from a recombinant DNA vector in a suitable host organism a polypeptide capable of raising HCMV-neutralising antibodies in humans. The board found this invention to be the same as that disclosed in the first priority document: the reported DNA and amino acid sequences were identical and the teaching of the priority document, as it would be read by a skilled person, was not limited to a specific example but was of more general scope, since it referred to the expression of a protein from the isolated genome fragment by using conventional genetic engineering techniques in suitable vectors and also mentioned the possibility of expressing discrete portions of the protein. The lack of actual human clinical data with respect to "the capability of raising HCMV-neutralising antibodies in humans" did not necessarily lead to the conclusion that essential elements were missing in the disclosure of the first priority document.

In **T 919/93**, claim 1 of the European patent comprised a reference to the inactivation of a virus related to Acquired Immune Deficiency Syndrome (AIDS) which was neither cited expressis verbis in the priority document nor implicitly derivable therefrom.

The board referred to **T 449/90** where it was stated that the feature of inactivation of the NANB- hepatitis or AIDS virus upon dry heating had to be testable by the skilled person in order for the European application to fulfil the requirement of sufficiency of disclosure. In the application as filed, there were passages relating to a method for testing virus inactivation in dry heated blood clotting factor preparations based on the use of thermally highly stable viruses as virus inactivation indicators. This technical information was considered by the board in that case to be sufficient for the skilled person to evaluate

whether NANB-hepatitis or AIDS virus had been substantially inactivated by the heat treatment and thus the requirements of Art. 83 EPC 1973 were found to be fulfilled.

In **T 919/93** however, these passages in the European application as filed, essential for the patent application to meet the requirements of Art. 83 EPC 1973 had no counterpart in the priority document, which was thus not enabling for the claimed subject-matter. Thus in the case in point the priority could not validly be claimed.

In **T 843/03** the board pointed out that the priority document had to provide an enabling disclosure (**T 81/87**, OJ 1990, 250; **T 193/95**). The board recalled that it has been established in a number of board of appeal decisions that sufficiency of disclosure presupposes that the skilled person is able to obtain substantially all embodiments falling within the ambit of the claims and that he/she, in order to reach this goal, may not be confronted with an undue burden.

The examining division had rejected the application for lack of novelty, as in its view the first priority document was not enabling for the production of the claimed VLP (virus-like particle) comprising human papilloma virus-16 (HPV-16) L1 capsid protein. However, based on previous case law on the requirement of Art. 83 EPC 1973 (**T 19/90**, OJ 1990, 476) and on the novelty requirement (**T 464/94**) the board concluded that, when an applicant provided a technical disclosure and **prima facie evidence** as to certain technical elements in an application, **it was the EPO which had the burden of proof** when judging that something was not shown. According to the appellant, four particles shown in an electron micrograph forming part of the priority document represented HPV type 16 VLPs which were the result of a procedure disclosed in the priority document with respect to HPV-11 VLPs. The board held that the examining division had not taken the legally appropriate approach when deciding to the disadvantage of the applicant with the reason that "[...] no absolute fact can be deduced from figure 7 as to whether it shows correctly formed HPV 16 particles or not". The board did not see full proof of such facts as a requirement within the framework of the EPC and could not see any serious doubts of the examining division substantiated by verifiable facts.

In **T 903/05** the board rejected the argument of appellant II that the claims did not relate to the same invention since the priority document **lacked any experimental data** which made it plausible that the invention now claimed worked. The enablement of the disclosure of the priority document had explicitly not been challenged by appellant II. The board saw no legal basis for imposing additional criteria such as the presence of experimental data in the priority document which made it plausible that the invention would work. The board was furthermore convinced that the experimental data which were present in the patent and not in the priority document did not change the nature of the invention disclosed.

C. First application

In principle, only the first application filed in a state party to the Paris Convention or a member of the WTO can form the basis of a priority right. In the EPC, this is made clear in Art. 87(1) and (4) EPC.

Therefore, if apart from the application whose priority is being claimed in the subsequent European application, an earlier previous application was also filed, in order to check the validity of the priority claim it must be established whether the invention claimed in the subsequent application was disclosed in the earlier previous application (see 1 below). Two more recent decisions concerning the question whether the priority application or a still earlier application was the first application also focused on the identity of the applicants (see 2 below).

In **T 477/06** the board held first that since Euro-PCT application D8 had been deemed withdrawn due to non-payment of the designation fees (R. 23a EPC 1973), it was not prior art under Art. 54(3), (4) EPC 1973 for the application in suit. However, it had been filed by the same applicant and earlier than the priority application. In view of the fact that claimed subject-matter was anticipated by this earlier application, the priority application was not the first application within the terms of Art. 87(1) and (4) EPC 1973 (cf. Art. 8(2)(b) PCT), so that the priority claim was not valid. Hence, the application in suit enjoyed priority only from the date of filing and D8 was prior art under Art. 54(2) EPC 1973.

For the case of a priority held invalid because it was **not** shown, for the purpose of Art. 87(4) EPC 1973, that at the date of filing of the application from which priority was claimed, a previous first application filed by the applicant in respect of the same invention had been **withdrawn**, see **T 1056/01** (reported in Chapter VI.H.4.3.4, law of evidence).

1. Identity of invention

To establish whether the invention claimed in the subsequent European application was already disclosed in the earlier previous application, the same principles have to be applied as when establishing identity of invention between the application forming the basis of priority and the application claiming priority. The question is whether the person skilled in the art can derive the subject-matter of the claim of the subsequent application directly and unambiguously, using common general knowledge, from the earlier previous application or only from the later one.

In **T 323/90** the board concluded that the alleged first application disclosed a different invention from that in the European application and the application from which priority had been claimed: the claimed process (for increasing the filling power of tobacco lamina filler) differed as regards both the moisture content of the tobacco for processing and the first step in the process.

In **T 400/90** priority had been claimed from a US application in respect of a European application concerning an electromagnetic flowmeter. The opponents submitted that the

same invention was already the subject of an earlier US application filed by the same applicant outside the priority period. The earlier US application disclosed all the features contained in the European application with the exception of the use of saddle-shaped coils; however, the latter were already known and used frequently. In the board's opinion, the question to be answered was **whether the use of saddle-shaped coils had been disclosed** in the earlier US application, and **not whether it was obvious** to use such coils in place of the magnets disclosed in the earlier application. The board came to the conclusion that the inventions claimed in the US applications were different and priority had rightly been claimed from the later application because, according to the teaching of the earlier application, coils of any shape could be used, whereas according to the teaching of the priority document saddle-shaped coils had to be used.

In **T 184/84** a method of producing a single crystal of ferrite was claimed in a Japanese application, the priority of which was claimed in respect of a European application, and in a previous Japanese application. The starting materials were defined differently in the two Japanese applications. The method disclosed in the later application and the European application was clearly more advantageous than that forming the subject-matter of the earlier Japanese application. The board held that the **significant differences in properties** were indicative of the presence of different materials and therefore found that the earlier Japanese application was not the first filing of the invention claimed in the European patent application. It based its finding on **T 205/83** (OJ 1985, 363), which stated that the novelty of products prepared using a modified process could be established by the fact that according to an empirical principle in chemistry, a product's properties were determined by its structure, so that differences in the properties of products indicated a structural modification.

The subject-matter in **T 107/96** of the patent in suit contained the feature "angle of contact greater than 120°", which feature was disclosed in the later previous US application P2. In P2 a particular advantageous effect was also attributed to the large extent of the said "angle of contact". The earlier previous US application P1 was totally silent about the aforementioned feature "angle of contact" and its advantageous effect. However, the figures of P1 represented **diagrammatic** and schematic drawings. The board concluded that therefore, and in line with the established jurisprudence of the boards of appeal, they could not serve as a basis for determining the extent of a minimum "angle of contact" because dimensions obtained merely by measuring a diagrammatic representation of a document did not form part of the disclosure. Hence, the said feature "angle of contact greater than 120 °", was not disclosed in the earlier previous US application P1 but only in the later previous US-application P2.

In **T 449/04**, in order to establish whether the application (PR) whose priority was claimed was the "first application" within the meaning of Art. 87(1) EPC 1973, the board had to compare the "subject-matter" (Art. 87(4) EPC 1973) of this application with that of an earlier application D1 filed by the same applicant. The board followed opinion **G 2/98** (OJ 2001, 413) of the Enlarged Board of Appeal, according to which, firstly, the concept of the "same invention" in Art. 87(1) EPC 1973 has to be narrowly or strictly interpreted, that is, in a way equating it with the concept of "the same subject-matter" under Art.

87(4) EPC 1973, and, secondly, that the description of the invention of the earlier publication has to be considered **as a whole**.

Application (PR) had a lower cobalt-content of the steel as compared to D1 without adversely affecting the mechanical properties. Given that D1 dissuaded from providing a maraging steel with this lowered cobalt-content, the invention disclosed in D1 was not the "same invention" as the one disclosed in application (PR). Yet, at the same time, the earlier application D1 included a **comparative example**, the composition of which fell within the elemental ranges of the maraging steel claimed in the present application as well as in application (PR), which led the Examining Division to conclude that the subject-matter at issue was already contained in D1. However, the board emphasised that the "same invention" considered in Art. 87(1) EPC 1973 did not encompass the comparative example(s) which were clearly and definitely **excluded from the scope of the invention** in D1. Having regard to the strict and narrow interpretation of the term "the same invention" pursuant to Art. 87(1) EPC 1973, this term was focused on what constituted the elements of the invention. The teaching in both documents was different, and consequently D1 could not prevent application (PR) from being a "first application" in the sense of Art. 87(1) EPC 1973.

2. Identity of applicant

In **T 5/05** the opposition division had concluded that neither of the two claimed priority applications qualified as the first application within the meaning of Art. 87(1) and (4) EPC 1973 on the grounds that two inventors and part of the subject-matter were the same as in an earlier previous application. As the filing date of that application was more than twelve months prior to the filing date of the contested patent and the application had been "made public", the same invention of the same inventors could no longer serve as a basis for claiming priority.

The board, however, stressed that priority could be based only on earlier applications filed by the applicant of the European application or by his predecessor-in-title. Moreover, only such applications could meet the further requirement, derivable from Art. 87(4) EPC 1973, that an application giving rise to the priority right had to be the first application by the applicant or by his predecessor-in-title in respect of the invention. The inventor was not relevant. Applications filed by various applicants figured alongside one another as state of the art within the meaning of Art. 54(2) or Art. 54(3) EPC 1973. The board also rejected the respondent's argument that the **economic aspect** was relevant to the requirements relating to priority and that the two wholly owned subsidiaries of the same parent company were not independent of each other in view of their association through the parent. Legal acts were in principle attributable to the (legal) person who had performed them. Exceptions to this needed a legal basis, which did not exist in the law relating to priority.

In **T 788/05** the proprietor had been co-applicant in a previous European application D1 with an earlier priority date than that of the patent in suit. The appellant/opponent argued that since the proprietor was also designated as applicant in D1, it had to be regarded as the "person" referred to in Art. 87(1) EPC 1973 regardless of the designation in D1 of a

second applicant. Since, moreover, the invention was the same in both documents, D1 had to be considered as the first application. Therefore the priority claimed for the application in issue was not valid and D1 was prior art under Art. 54(2) EPC 1973.

The board held that the term "a person" in Art. 87(1) EPC 1973 (or "an applicant" in Art. 88(1) EPC 1973) implied that the applicant was the same for "the first application" (or "previous application" in Art. 88(1) EPC 1973) and for the later application for which a priority right was claimed. In the case of D1, the priority right belonged to the two applicants simultaneously, unless one decided to transfer his right to the other, who then became his successor in title and this before the filing of the later application. No evidence of such a transfer had been submitted. Since the application in issue was only filed by one applicant, D1 could not represent the "first application" within the meaning of Art. 87(1) EPC 1973. The priority date was valid and D1 represented state of the art under Art. 54(3) EPC 1973. The disclaimer introduced during the examination proceedings to restore the novelty of claim 1 vis-à-vis D1 was also accepted by the board.

D. Partial and multiple priorities

In cases where partial or multiple priorities can be validly claimed the subject-matters of the subsequent application have two or more operative priority dates. In the case of a **partial priority** that part of the subsequent application's subject-matters disclosed in the previous application has the priority date of the previous application; for the remaining part the date of filing of the subsequent application applies. With multiple priorities, the priority of two or more previous applications is claimed. In this case, claims in the subsequent application have the priority date of the previous application in which the subject-matter subsequently claimed was disclosed. **Multiple priorities** may be claimed for any one claim (Art. 88(2), second sentence, EPC 1973), as long as several subject-matters are included.

In such situations, when the content of an application forming the basis of a priority claim is published during the priority interval, the question arises whether such content belongs to the state of the art which can be cited against the partial subject-matters of the subsequent application which have a priority date after the date of publication.

1. Publications during the priority interval

In **G 3/93** (OJ 1995, 18), the Enlarged Board decided that a document published during the priority interval, the technical contents of which corresponded to that of the priority document, constituted prior art citable under Art. 54(2) EPC 1973 against a European patent application claiming that priority, if such priority was not validly claimed. This also applied if a claim to priority was invalid due to the fact that the priority document and the subsequent European application did not concern the same invention because the European application claimed subject-matter not disclosed in the priority document.

The Enlarged Board emphasised that the existence of a right of priority depended, *inter alia*, on the fulfilment of the requirement of identity of invention, that is, whether the

previous application disclosed the same invention as that claimed in the subsequent European application. Where priority was claimed but could not be allowed because the inventions were not the same, there was no right to priority. Consequently, any publication of the contents of a priority document during the priority interval constituted prior art citable against elements of the European application which were not entitled to priority (see **T 441/91**, **T 594/90**, **T 961/90** and **T 643/96**; for another view see **T 301/87**, OJ 1990, 335). **T 131/99** stresses that to that extent there is no difference between dependent and independent claims.

2. Different priorities for different parts of a European patent application

In **T 828/93** the board stated that it followed from Art. 88(3) EPC 1973 that different priorities (including no priority, i.e. only the date of the European application) could be conferred on different parts of a European application. All that had to be checked was whether the subject-matter to be compared with the prior art, i.e. the **subject-matter of the independent patent claims**, corresponded to the disclosure of the documents of the priority application as a whole (see Art. 88(4) EPC 1973). Only one (or, as the case may be, no) priority could be conferred on each claimed **subject-matter as a whole**, in so far as the subject-matter was defined by the given elements as a whole. This subject-matter as a whole represented the invention, which either corresponded to the disclosure of a priority application or not.

T 132/90 concerned a case in which claim 1 of the contested patent contained a feature B not disclosed in the Swiss priority document. The board held that a priority right therefore subsisted only with regard to part of the subject-matter of the claim, i.e. claim 1 without feature B, but not with regard to the subject-matter of that claim as a whole. The part of the subject-matter entitled to priority did not involve an inventive step. The subject-matter as a whole of claim 1 of the European application, which only had the priority status of the filing with the EPO, was no longer new because the patent proprietors had published all its features after filing the Swiss application.

In **T 127/92** a European patent application claimed the priority of two German utility models, which had been published during the priority interval (documents D1 and D2). The board of appeal took the view that priority had been validly claimed from D1 for claim 1 and several dependent claims. It was necessary to establish whether those **sub-claims** that also contained **elements not disclosed in D1** were entitled to claim partial priority from D1 for the subject-matter of claim 1 contained within them. On the basis of the principles developed in **G 3/93** (OJ 1995, 18), the board came to the conclusion that D1 and D2 formed part of the state of the art in respect of these claims and that, consequently, the subject-matter of these claims no longer involved an inventive step. The patent proprietor therefore deleted them.

3. Multiple priorities for one claim

In **T 828/93** (see above) the board confirmed that, because of the legal situation explained above, the possibility mentioned in Art. 88(2) EPC 1973 of multiple priorities

for any one patent claim related only to instances where, unlike in the case at issue, the claim contained **alternatives** and could therefore be split into **several subject-matters**.

In the opinion given in **G 2/98** (OJ 2001, 413) the Enlarged Board of Appeal analysed the legislative intention behind Art. 88(2), second sentence, EPC 1973 and likewise concluded that a distinction has to be drawn between the two following cases. The legislator did not want several priorities to be claimable for the **"AND" claim** (e.g. a claim to features A and B, with the first priority document disclosing claim feature A alone and only the second priority document disclosing claim feature B). With regard to the **"OR" claim** the Enlarged Board drew the following conclusion from the historical documentation relating to the EPC 1973: where a first priority document disclosed a feature A, and a second priority document disclosed a feature B for use as an alternative to feature A, then a claim to A or B could enjoy the first priority for part A of the claim and the second priority for part B of the claim. It was further suggested that these two priorities might also be claimed for a claim directed to C, if the **feature C**, either in the form of a generic term or formula, or otherwise, **encompassed feature A as well as feature B**. The use of a generic term or formula in a claim for which multiple priorities were claimed in accordance with Art. 88(2), second sentence, EPC 1973 was perfectly acceptable under Articles 87(1) and 88(3) EPC 1973, provided that it gave rise to the claiming of a **limited number of clearly defined alternative subject-matters**.

In **T 620/94** it became apparent that the granted claim 1 covered two alternatives A and B of the invention. Only alternative B was disclosed in the priority document; alternative A was contained only in the subsequent European application. Prior art published during the priority interval rendered obvious alternative A. The patent could thus only be maintained in amended form, i.e. limited to alternative B.

In **T 441/93** the European patent related to a process for preparing a strain of the yeast *Kluyveromyces*, which comprised transforming *Kluyveromyces* yeast cells with a vector comprising, inter alia, a DNA sequence encoding a polypeptide. The invention disclosed in the priority document was a process for the preparation of new strains of the yeast *Kluyveromyces*, characterised in that **protoplasts** of such yeast were mixed with and transformed by vector molecules. The appellant (opponent) argued that the generic claim 1 of the European patent did not enjoy the priority of the previous application because the priority document did not mention the transformation of whole cells, which alternative was covered by claim 1 (and other claims) of the subsequent application.

On the evidence put before it, the board concluded that the references to protoplasts in the priority document were of crucial importance and that no mention had been made in the priority document of the possibility of **transforming whole cells**. The board held that it was decisive what process had been disclosed in the previous application since claim 1 of the subsequent application was directed to a process. In so far as claim 1 covered whole cell transformation, it could only be entitled to the filing date of the European application. It might be the case that all transformed cells which could be made using a whole cell transformation process could also be made using the protoplast transformation process of the priority document. But even this would not mean that claim 1 was entitled to the priority date for process aspects neither disclosed nor enabled by

the priority document. Accordingly, claim 1 was entitled to the filing date of the priority application only in so far as it related to the transformation of protoplasts. The claims could thus be divided into two groups with regard to priority: Group A, enjoying priority rights from the previous application and comprising claim 1 in so far as directed to a process for the transformation of *Kluyveromyces* protoplasts, and the related further claims; and Group B, only enjoying the priority of the subsequent European application, and comprising claim 1 in so far as not directed to a process for the transformation of protoplasts, and the related further claims.

In **T 665/00**, there was a quite unusual relationship between the prior use claimed by the applicant, the invention disclosed in the priority document and the subject-matter of the disputed claims which can be summarised as follows:

- (a) the alleged prior use took place between the priority date and the filing date of the disputed patent,
- (b) the subject matter of that prior use was described in the priority document,
- (c) the subject-matter of the prior use fell within the scope of the claims of the disputed patent, but
- (d) the priority document did not necessarily describe all the subject-matters claimed.

In those specific circumstances, the question arose whether the alleged prior use might be prejudicial to the novelty of the claims, even though it was described in the priority document.

The board observed that, under Art. 88(3) EPC 1973, the right of priority covered only those elements of the patent application included in the application whose priority was claimed. Different elements of a patent application could have different priority dates. In **G 2/98** (OJ 2001, 413), the Enlarged Board of Appeal had stated that the approach of recognising different priority dates also applied to a claim using a generic term or formula, provided that the use of such a term or formula gave rise to the claiming of a limited number of clearly defined alternative subject-matters. Applying that case law to the case in hand, the board concluded that, of the different alternatives contained in claim 10 of the disputed patent (relating to a powder containing hollow microspheres the specific mass of which was described by the generic term "less than 0.1 g/cm³"), the non-compacted powders containing "Expancel DE" microspheres were covered by the claimed date of priority. According to the board, the prior use claimed, which took place after the date of priority and involved a product containing the same "Expancel DE" microspheres, could not therefore destroy the novelty of powders containing those microspheres according to claim 10 of the disputed patent, since they were covered by the date of priority.

See also **T 1443/05** (also referred to in B.1.7 above), in which the board concluded that the generic wording of claim 1 did not reveal any clearly defined alternative subject-matters which could have justified the priority right.

VI. RULES COMMON TO ALL PROCEEDINGS BEFORE THE EPO

A. The principle of the protection of legitimate expectations

1. General issues

A general principle well established in European Community law, and one generally recognised in the EPC contracting states and board of appeal case law, is that of the protection of legitimate expectations. Its application to procedure before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings (**G 5/88**, **G 7/88**, **G 8/88**, OJ 1991, 137). Some decisions also use the term "good faith" to describe this concept (**J 10/84**, OJ 1985, 71; **J 38/97**). A key decision on this issue is **G 2/97** (OJ 1999, 123), which is broadly based on the previous case law (see also below VI.A.1.3 and VI.A.2).

According to the case law of the boards of appeal, the principle of the protection of legitimate expectations governing procedure between the EPO and applicants requires that communications addressed to applicants must be clear and unambiguous, i.e. drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee. A communication from the EPO containing erroneous information which misleads the applicant into taking action causing the refusal of his patent application is null and void in its entirety (**J 2/87**, OJ 1988, 330). An applicant must not suffer a disadvantage as a result of having relied on a misleading communication (**J 3/87**, OJ 1989, 3). On the contrary, if his actions were based on a misleading communication he is to be treated as if he has satisfied the legal requirements (**J 1/89**, OJ 1992, 17).

The principle of the protection of legitimate expectations applies to all procedural actions -whether formal or informal - taken by EPO employees vis-à-vis parties to proceedings (**T 160/92**, OJ 1995, 35; see also **T 343/95**; **T 460/95** of 16.7.1996; **T 428/98**, OJ 2001, 494). Decision **T 923/95** ruled that the principle of protection of legitimate expectations applied to both ex parte and inter partes proceedings and in **T 161/96** (OJ 1999, 331) the board explicitly stated that the requirements in connection with the principle of good faith to be observed by the EPO were the same vis-à-vis all parties involved in proceedings before the EPO, be they applicants, patent proprietors or opponents.

The Legal Board of Appeal decided in **J 13/03** that under Art. 48(2) PCT and Art. 150(3) EPC 1973 the principle of the protection of legitimate expectations also applies to acts performed by other authorities concerned in Euro-PCT proceedings during the international phase such as the US Patent Office acting as receiving Office or as International Preliminary Examining Authority.

1.1. Sources of legitimate expectations

Several decisions have specified the **sources** of legitimate expectations. In **T 905/90** (OJ 1994, 306, Corr. 556) the board held that specific communications or other actions within the framework of particular proceedings and official statements such as guidelines were not the only sources of legitimate expectations; these could also properly arise from the actual general conduct or established practice of organs of the EPO. All changes in these practices should be officially announced at the earliest possible moment in order to avoid misleading the parties.

In **J 25/95** (and in decisions given on the same day, namely **J 14/95**, **J 15/95**, **J 16/95**, **J 17/95** and **J 24/95**) the board drew up a list of these sources in the light of the case law. It was pointed out that the source of legitimate expectations must be confined to certain categories of information; information provided by the EPO in individual cases, information contained in official statements of general applicability and published by the EPO, e.g. in the OJ, established practice of departments of the EPO, and decisions taken by the Enlarged Board because of its special role. The users' confidence in the continuity of a practice based on a decision of the Enlarged Board might be considered particularly legitimate since all boards of appeal were expected to follow the Enlarged Board's interpretation of the EPC 1973.

In **J 27/94** (OJ 1995, 831) the board stated that there might be cases in which the public had a legitimate expectation that the department of first instance would not deviate from the established case law. This might apply if the relevant case law had become enshrined in the consistent practice of the department of first instance, and in particular if this had been made known to the public in published Guidelines, Legal Advice or Notices from the EPO. On the other hand, several cases have drawn attention to the fact that a **single decision** of a board of appeal cannot create a legitimate expectation that it will be followed in future (**J 25/95**, **T 500/00**). More information concerning the effect of case law on the principle of legitimate expectations can be found below under the heading "Departure from previous case law and the principle of legitimate expectations."

1.2. Examples of the legitimate expectations principle

In **T 124/93** the opposition division had wrongly changed the date of its decision, giving it a later one which had misled the parties about the time limit for filing the notice of appeal and statement of grounds. Applying the principle of the protection of legitimate expectations, the board ruled that the appeal was to be considered as filed in due time (for an example of re-dating the decision see **T 972/05**). In **J 18/96** (OJ 1998, 403) the board accorded a filing date to protect an applicant's legitimate expectations, although he had not fulfilled a requirement under Art. 80 EPC 1973. By issuing a communication under R. 85a EPC 1973 (deleted in EPC 2000), the Receiving Section had given him the impression that his application was validly filed (see also **J 5/89**).

In **J 15/92** the Legal Board of Appeal held that "in the case of a request whose true nature is uncertain (i.e. it is unclear whether this is a request for re-establishment or a request for a decision), the EPO should clarify the matter by asking the requester". It

would have been sufficient in the case in point for the EPO to invite the applicant to define his request more precisely. For the EPO to interpret the request arbitrarily constituted an error rendering the impugned decision null and void (see also **J 25/92** and **J 17/04**).

In **J 6/08** the board added that a request (for a decision or re-establishment) filed with a view to obtaining the redressal of a loss of rights within the meaning of R. 69(1) EPC 1973 (resulting in this case from failure to comply with the one-month period for filing the request for re-dating of the application in accordance with R. 43(1) EPC 1973; R. 56(1) EPC, amended) has to be interpreted by the EPO in the light of the requester's objectively discernible will and taking account of the particular circumstances of the case. In case of doubt the Office is obliged to establish what the requester really wanted and may also be obliged to point out any still outstanding procedural steps in connection with this request (in this case, observance of the period of one year under Art. 122(2) EPC 1973). If procedural statements are interpreted correctly, it is not consistent with the relation of trust between applicants and the EPO to hold the applicant to the letter of his statements as chosen by him if the interpretation of the whole submission, taking account of the procedural situation, gives rise, at the least, to justified doubts as to whether the literal content of statements actually corresponds to the objectively discernible will of the applicant.

The Legal Board of Appeal suggested in **J 17/04** that it was the EPO's responsibility to provide forms which catered for all procedural possibilities in a clear and unambiguous manner. In the case in point the applicant was allowed to rely on a possible interpretation of the text of the EPO form in accordance with the principle of the protection of legitimate expectations even if another interpretation was more current.

In **J 27/94** (OJ 1995, 831) the board decided that if a declaration which was subject to a condition and therefore invalid was treated as a valid procedural act by the EPO, the EPO was not allowed later to go back on its own earlier conduct which served as a basis for the applicant's decision on how to proceed, because this would have represented "venire contra factum proprium" and thus offended against a generally recognised legal maxim.

Both **T 160/92** (OJ 1995, 35) and **T 428/98** (OJ 2001, 494) concerned information provided by EPO employees by telephone. In **T 160/92** the board did not deny that the principle of legitimate expectations should govern all the actions of EPO employees towards parties to the proceedings, including telephone conversations which were not provided for in the Convention and did not, as such, form part of the formal procedure before the EPO. However, since telephone conversations did not form part of the said formal procedure, the board did not consider it necessary to conduct a detailed investigation seeking to clear up what had been said in the relevant telephone conversations, the sequence of procedurally relevant facts having been clearly established in the file. In **T 428/98** (OJ 2001, 494) the board held that an appellant might rely on information which the board's registrar could be proved to have provided by telephone concerning the method for calculating a time limit the appellant had to observe

before the board if the point of law on which that information was based had at that time not yet been clarified in the case law of the boards of appeal.

Some cases deal with the attempt by the EPO to correct a decision that had already been issued and sent to the parties. In **T 1081/02**, the board held that the communication issued by the opposition division's formalities officer during the period for appeal, stating that the decision already issued had been sent by mistake and should therefore be disregarded, could not constitute a legally sound basis for regarding the decision's validity as so doubtful that it could be considered void. According to the applicable principle of the protection of legitimate expectations, however, the parties could not be deemed to have failed to comply with the time limit for filing a notice of appeal (Art. 108 EPC 1973) (see also **T 466/03**).

The facts in **T 830/03** were similar. A written decision was notified to the parties after the oral proceedings before an opposition division ("the first decision"). A second written decision ("the second decision") was issued together with a communication which suggested that the first decision was superseded. The opponent filed a notice of appeal outside the period of four months after the date of the notification of the first decision, but within the time limit after the notification of the second decision. The board held that the only legally valid written decision was the first decision but that, in application of the principle of protection of legitimate expectations, the appeal was deemed to have been filed in time.

Further examples of the principle of the protection of legitimate expectations can also be found below under Chapter VI.A.2.

1.3. Limits of the legitimate expectations principle

The Enlarged Board observed in **G 2/97** (OJ 1999, 123) that the notice sent by the registry of the boards of appeal was a standard form, nothing more than an administrative notice to inform the parties of the reference number of the appeal proceedings. It had no legal consequences; it was not a "communication" within the meaning, for example, of Art. 110(2) EPC 1973 (now R. 100(2) EPC). Such a notice could not be considered to give rise to any misunderstanding.

The board decided in **J 17/98** (OJ 2000, 399) that the principle of protection of legitimate expectations according to which communications of the EPO, including official forms, must be clear and unambiguous, did not extend so far as to require comprehensive legal advice to be contained in such forms. While forms must be clear and unambiguous, they need not contain detailed explanations of the law. This was especially true for legal issues which directly follow from the provisions of the EPC 1973 (see also **T 778/00**, OJ 2001, 554). Consequently, the board did not share the view of the appellants that EPO form 1004 (General Authorisation) should have informed the users of the difference between filing a general authorisation and the appointment of a representative. This difference resulted directly from the EPC 1973 itself. Thus, the fact that EPO form 1004 did not contain such information did not render it ambiguous or misleading.

In the same vein, the board in **T 1029/00** decided that the appellant could hardly cite the lack of bank account information on EPO correspondence as the reason for making an incorrect cash payment. Neither the Convention nor its Implementing Regulations required "automatic" provision of this information, whether on all correspondence generally or in certain specific cases. If necessary, applicants had to ascertain such bank account information for themselves.

The board in **J 29/97** emphasised that an examiner could not be treated as a legal adviser of the appellant who had to consider what possible action the appellant might wish to take. The principle of the protection of legitimate expectations did not extend that far.

The board decided in **J 5/02** that if the EPO provided a professional representative with incorrect information on the basis of which he concluded that the relevant legal provisions - in this case Art. 122 EPC 1973 - were no longer applicable, this was not a violation of the principle of the protection of legitimate expectations. If he did not realise the information was incorrect, he was guilty of fundamentally inexcusable ignorance of the law; if he did realise it was incorrect, he was not misled.

In **T 765/06** the board decided that the mere fact that the Examining Division had consented to the late filing of fresh claims did not establish a legitimate expectation that the claims would be admitted into the proceedings and accorded substantive consideration.

1.4. The requirement of proof

A number of decisions have confirmed that proof is required where the EPO is allegedly in breach of the principle of the protection of legitimate expectations.

In **T 321/95** the board of appeal stated that the alleged oral agreement was not mentioned anywhere in the communications between the primary examiner and the appellant and was not derivable from the content of the file either. Thus, arguments supporting the allegation of a violation of good faith could only be considered as the appellant's personal opinion, which did not convince the board because there was no evidence that there had been any agreement in the sense mentioned by the appellant instead of simply a "miscommunication" between the primary examiner and the applicant.

In case **T 343/95**, dealing with the content of a telephone call on which the appellant based its allegation in respect of principle of good faith, the board was of the opinion that even if it was not possible to establish the call's content beyond any reasonable doubt a posteriori, in a case like the present one it was sufficient that the board was satisfied on the basis of a balance of probabilities (i.e. that one set of facts was more likely to be true than the other). There were indeed many circumstances in favour of the appellant's submission, among them the fact that the appellant had had a similar problem in a parallel case where he reacted immediately. The board could find no logical reason, especially taking into account the fact that his interest in the file had made him contact

the EPO, why he would not have made the payment had he known it was not to be processed automatically. The board held that the conditions for the application of the principle of legitimate expectations were fulfilled.

In **T 460/95** (interlocutory decision of 16.7.96) the board stated that for applicants to be able to claim that they had relied on incorrect information in accordance with the principle of good faith, it had to be established that the erroneous information from the EPO had been the direct cause of the action taken by the applicants and objectively justified their conduct (see also **G 2/97**, OJ 1999, 123). Whether or not this was the case would therefore depend on the individual circumstances of each case.

2. Obligation to draw attention to easily remediable deficiencies

In **J 13/90** (OJ 1994, 456) the Legal Board of Appeal held that, in accordance with the principle of good faith, the EPO is obliged to warn users of the European patent system of omissions or errors which could lead to a final loss of rights. A warning would always be necessary when one could be expected in all good faith. This would presuppose that the deficiency could be easily identified by the EPO and the applicant was in a position to correct the deficiency and thereby avoid the impending loss of rights. The limits to the scope of this principle were outlined in decision **G 2/97** (OJ 1999, 123).

The Enlarged Board, on the basis of the established case law of the boards of appeal, saw in **G 2/97** no justification for the suggestion that the principle of good faith imposes on a board an obligation to warn a party of deficiencies **within the area of the party's own responsibility** (see also **J 41/92**, OJ 1995, 93; **J 4/96**, **T 690/93**, **T 861/94**, **T 161/96**, OJ 1999, 331). The appellant's responsibility for fulfilling the conditions of an admissible appeal cannot be devolved to the board of appeal. There can be no legitimate expectation on the part of users of the European patent system that a board of appeal will issue warnings with respect to deficiencies in meeting such responsibilities. To take the principle of good faith that far would imply, in practice, that the boards of appeal would have to systematically assume the responsibilities of the parties to proceedings before them, a proposition for which there was no legal justification in the Convention or in general principles of law. The Enlarged Board explained that the decision in **T 14/89** (OJ 1990, 432) concerned the particular circumstances of that case - involving a request for re-establishment of rights - and that there was no generally applicable principle to be derived from it.

The Enlarged Board of Appeal, considering the question of law raised by **T 742/96** (OJ 1997, 533), thus concluded that the principle of good faith does not impose any obligation on the boards of appeal to notify an appellant of a missing appeal fee when the notice of appeal is filed so early that the appellant could react and pay the fee in time, if there was no indication - either in the notice of appeal or in any other document filed in relation to the appeal - from which it could be inferred that the appellant would, without such notification, inadvertently miss the time limit for payment of the appeal fee.

In **T 1152/05** the notice of appeal filed by the patent proprietor was not in one of the official language of the EPO; this document was, in accordance with Art. 14(4) EPC,

deemed not to have been filed. This conclusion could not be altered by the argument of the patent proprietor that the EPO should have warned it before the end of the appeal period that it was not entitled to file its Notice of Appeal in the Dutch language and that it would hence have had sufficient time to file a notice of appeal in one of the official languages of the EPO. In the board's view, even on the basis of the *ratio decidendi* of **J 13/90**, the EPO was not obliged to warn the patent proprietor of the fact that it could not benefit of the provisions of Art. 14(4) EPC.

In **J 2/08** (OJ 2010, 100), the appellant/applicant also contended that the EPO had violated the principle of good faith on several occasions (omission to inform in respect of filing a divisional application ; publication of the divisional application ; late Noting of Loss of Right). As a result, in the appellant's view, by taking no action (instead of proactively warning the appellant) the EPO induced the appellant into believing that everything was in good order with the divisional application, until it became too late to file an appeal against the decision refusing the parent application. In the Board's view it was exclusively the responsibility of the applicant and his representative to decide on the factually and legally most appropriate filing actions to be taken. Furthermore no legitimate expectations concerning the validity of an application may be based on the fact that an application has been published. Finally, the communication under R. 69 EPC 1973, which is not just a warning but a procedural act, had to be sent after the end of the appeal period.

2.1. Examples of the obligation to draw attention to easily remediable deficiencies

The principle of legitimate expectations was applied in **J 11/89** where the Receiving Section failed to take any particular action upon the receipt of Japanese patent documents intended to be considered as priority documents, but whose priority was not claimed in the request for grant.

In **J 13/90** (OJ 1994, 456) the Legal Board of Appeal decided that if, having regard to the principle of good faith, the applicant could expect to receive a communication warning him of an impending loss of rights, but that communication was not issued in due time, the EPO must set a new period allowing the applicant to remedy the deficiency and perform the omitted procedural act in due time.

Decision **T 460/95** (interlocutory decision of 16.7.96) found that in the case in point the irregularity was obvious and easy to identify, and the appellant could easily have put it right during the time remaining. The registrar, when he received the request for an extension, could and indeed should have seen that it was based on a misunderstanding during a telephone conversation.

In **J 3/00** the appellant filed an international patent application at the EPO as receiving Office under the PCT (RO/EPO). The description and claims were filed, by mistake, in Swedish, a language which the RO/EPO did not accept for filing international applications. The board held that this deficiency in the application was immediately and readily identifiable by the receiving Office on the face of the application in the course of the Art. 11(1) PCT check. The appellant could in good faith have expected a warning.

Several examples concern missing or insufficient fee payments. In **J 15/90** of 28.11.1994 the Legal Board of Appeal held that an insufficient payment of a fee did not result in a loss of rights if the error occurred 18 days before the period expired and the EPO failed to inform the applicant (see **J 13/90**, OJ 1994, 456). In **T 923/95** a sum of DEM 1 200 instead of DEM 2 000 was mentioned in the fee payment voucher annexed to the notice of appeal filed by the appellants (opponents). In the board's view, the EPO, which had acknowledged receipt of the notice of appeal before the final date for payment of the appeal fee, could at the same time easily have notified the appellants by fax that the amount of DEM 800 was still outstanding. The board said it was clearly contrary to the principle of good faith if in circumstances of this kind the EPO remained passive and allowed a time limit to expire (in this case, one week later), where the consequence of failure to observe the time limit was that the appeal was considered not to have been filed.

In **T 296/96**, only 50% of the appeal fee was paid before the expiry of the time limit under Art. 108, first sentence, EPC 1973. However, since the formalities officer invited the appellant to pay the remainder of the appeal fee and accepted its subsequent payment without comment, the appellant could assume in all good faith that the appeal was deemed to have been filed (Art. 108, second sentence, EPC 1973) and that, as a consequence, it was not necessary to file an application for restitutio in integrum. The appellant should thus have been invited by the EPO to file an application for restitutio in integrum before the expiry of the one-year time limit under Art. 122(2), third sentence, EPC 1973. Since there was no such invitation, the appellant, who was misled by the action of the formalities officer, must, in accordance with the principle of the protection of legitimate expectations, be treated as having paid the appeal fee in time. The appeal was thus deemed to have been filed.

2.2. Electronic filing of documents

The Notice from the EPO dated 3.12.2003 concerning the electronic filing of documents within the meaning of R. 36 EPC 1973 (OJ 2003, 609) stated that the electronic filing of documents was not admissible in opposition and appeal proceedings. This is no longer applicable as under Decision of the President of the EPO dated 12 July 2007 (OJ SE 3/2007, 12 ff) the notice 2003 ceased to have effect. An even more recent Decision of the President of the EPO dated 26 February 2009 (OJ 2009, 182 ff) concerning the electronic filing of documents, which entered into force on 5 March 2009 replaced the Decision 2007. This Decision dated 26 February 2009 stated in its Article 1 on the admissibility of electronic filing that (1) **Documents** in proceedings under the EPC **may be filed** with the European Patent Office **in electronic form**. This Decision of the President dated 2009 is **now the law applicable**.

Strictly speaking, the following decisions of the Boards of appeal taken at the time of the Notice 2003 no longer apply. They are nevertheless reported to illustrate the reasonings of the Boards when faced with questions of this kind concerning the applicability of the principle of legitimate expectation.

In the ex-parte case **T 991/04** the appellant had filed the notice of appeal together with the grounds of appeal not by regular mail or faxed letter but by using the technical means of the *epoline*® -system provided for by the EPO for filing documents relating to a European patent application. The board held that the appeal did not comply with the formal requirement "filed in writing" in Art. 108 EPC 1973, but that it was deemed admissible on the basis of the principle of good faith. The board stated that applicants could expect that they be informed by the EPO about the use of the correct administrative channels for filing documents with the EPO and, if they made a readily identifiable mistake, to be warned accordingly.

In the ex-parte case **T 781/04** the board also stated that an appeal filed via electronic means did not comply with the requirement of Art. 108 EPC 1973 that an appeal must be filed in writing. However, the appellant, who had filed the appeal via electronic means (*epoline*®), had been misled into believing that the appeal had been duly filed. Therefore the principle of good faith demanded that the appellant's error be rectifiable and the appropriate remedy would be to allow the appellant's request for *restitutio in integrum*.

2.3. Limits of the obligation to draw attention to easily remediable deficiencies

Cases concerning missing fees and insufficient fee payments have also been among the cases highlighting the limits of the obligation to draw attention to easily remediable deficiencies. In **T 161/96** (OJ 1999, 331) the board came to the conclusion that there was no basis for assuming an obligation on the part of the EPO to warn the party of an impending loss of rights relating to an underpayment of 40% of the opposition fee. **J 2/94** involved a letter comprising a request without the necessary payment. According to the board the appellant could not have expected to be informed of the missing fee. There had been no evident indication in the appellant's submission which made a clarification or reminder necessary. Indeed, as emphasised by the board, the EPO could, in practice, often establish whether a specific fee had been paid only after the relevant time limit had expired, once the complete data on all payments made during that period was available.

In **T 445/98**, the board considered that, because the department which cashed the fee was not the same as the one which received the notice of appeal, the deficiency was not easy to identify and the time between payment of the appeal fee and expiry of the non-observed two-month time limit for filing the notice of appeal was too short, so that the opponent could not expect a warning. Moreover, the board pointed out that the principle of the protection of legitimate expectations did not extend so far as to relieve parties of their responsibilities, as already stated in many decisions of the boards of appeal (confirmed by **T 778/00**, OJ 2001, 554, following **G 2/97**).

As pointed out by the board in **J 12/94**, it is incumbent on both parties to act in good faith.

J 7/97 concerned a European patent application filed with the EPO by fax. One page of the description was missing, however, whilst another was transmitted twice. The board took the view that a single page missing from a lengthy description was not an "obvious error" under the case law, at least in the circumstances of this particular case. The

applicant could not in good faith expect the EPO to check application documents for completeness on the very day it received them. Nor could any such obligation be inferred from the President's decision on fax transmissions (OJ 1992, 299); Art. 3 (now Art. 6, Decision of the President of the EPO of 12 July 2007, OJ SE 3/2007, 7) of that decision required the filing office to notify the sender as soon as possible "where a document transmitted ... is illegible or incomplete"; as the latter adjective clearly referred to the transmission rather than the actual document.

3. Courtesy services performed by the EPO

The principle of the protection of legitimate expectations also applies to courtesy services provided by the EPO where these are not worded so as to rule out any misunderstanding on the part of a reasonable addressee. However, an applicant cannot rely on the EPO systematically providing certain courtesy services and therefore is not entitled to base a claim on their omission (**J 12/84**, OJ 1985, 108; **J 1/89**, OJ 1992, 17; **J 27/92**, OJ 1995, 288).

In **J 1/89** the board held that the applicant was entitled to rely on the accuracy and completeness of information provided as a courtesy service. He could not, however, rely on courtesy services not required by the Convention being systematically provided. An example cited was the due date for a renewal fee. If an applicant paid a renewal fee late as a result of a misleading reminder, he had to be treated as if he had paid in time.

In **J 34/92** the fifth-year renewal fee had not been paid in full. The professional representative did not however receive the communication the EPO usually issues drawing attention to the fact that late payment of the renewal fee was possible upon payment of an additional fee. Furthermore, the communication under R. 69(1) EPC 1973 was sent out so late that a request for re-establishment of rights could no longer be submitted within the one-year absolute time limit under Art. 122(2) EPC 1973. The Legal Board of Appeal referred to its consistent case law according to which the EPO might subsequently grant applicants a time limit sufficient to allow them to perform acts they had been unable to perform previously because of the EPO's failure to exercise due care, but this was only applied to non-absolute time limits, as an **absolute time limit**, by definition, was non-extendable.

In **J 14/94** (OJ 1995, 825) the facts were quite different. The applicant had failed to pay the third renewal fee. Nevertheless, the EPO continued the examination procedure for several years without informing the applicant of any loss of rights. The board held that if, during a long period of time, the EPO by its conduct led the parties and the public to the legitimate belief that no loss of rights had taken place, the EPO could not later refer to a loss of rights which occurred several years previously as this would constitute "venire contra factum proprium" and therefore contravene the principle of legitimate expectations. In such circumstances, the late payment of a renewal fee might - by way of exception - be considered as having been made in time if the EPO had not informed the applicant of the outstanding payment, had accepted later renewal fees without objection and had continued the examination proceedings for several years.

In **J 27/92** (OJ 1995, 288) the appellant had raised the question of whether European representatives were entitled to rely on the advice given by the Information Office. A representative maintained that he had been misled by information voluntarily given to him on the **telephone** by an officer of the EPO with regard to the amount of the examination fee payable. The board pointed out that parties to proceedings before the EPO - and their representatives - were expected to know the relevant provisions of the Convention, even when such provisions were intricate. Where such a service had been rendered, however, an applicant was entitled to rely upon its content if the communication from the EPO was the direct cause of the action taken and, on an objective basis, it was reasonable for the appellant to have been misled by the information. These principles applied not only to written communications but also to **oral communications** from the EPO.

4. Principle of legitimate expectations where the previous case law is departed from

4.1. General

In **J 27/94** (OJ 1995, 831) the board stated that there might be cases in which the public had a legitimate expectation that the department of first instance would not deviate from the established case law. This might apply if the relevant case law had become enshrined in the consistent practice of the department of first instance, and in particular if this had been made known to the public in published Guidelines, Legal Advice or Notices from the EPO. In such a situation, an applicant might legitimately expect that a practice allowing or even recommending a particular way of proceeding would not be changed without appropriate advance information.

In the case at issue, the applicant argued that **J 11/91** (OJ 1994, 28) was binding on the department of first instance on the basis of the principle of legitimate expectations. However, the headnote of **J 11/91** was published in the same issue of the OJ as the referral of this point of law to the Enlarged Board of Appeal. Taking this information into account, there was no reason to believe that the department of first instance would follow **J 11/91** in future cases. On the contrary, the Guidelines remained unchanged, which in fact lead to the reasonable expectation that the practice based on them would likewise not be changed. The department of first instance was therefore not obliged by the principle of the protection of legitimate expectations, on the basis of decision **J 11/91**, to allow the filing of a divisional application after the approval of the text intended for grant until opinion **G 10/92** (OJ 1994, 633) was made available to the public.

In **J 25/95** the board stressed that the publication of **J 11/91** in the Official Journal of the EPO (OJ 1994, 28) as well as in the publication "Case Law of the Boards of Appeal of the EPO" did not create a legitimate and reasonable expectation that a divisional application could be filed up until the decision to grant. There was no case in which legitimate expectations had been accepted only on the basis of the publication of a single decision of a board of appeal. The board observed, furthermore, that decisions of the boards were not published because the EPO wished to announce that its users could rely on them in future cases, but because the **boards** themselves considered them to be

of general interest in respect of the development of case law. If there was any doubt whether the established practice in this respect existed, it was up to the appellants to seek clarification by means of an enquiry to the EPO which would have revealed quickly that the department of first instance did not apply **J 11/91**.

In **T 740/98** the appellant submitted that the disclaimer had been allowed by the examining division in conformity with the Guidelines for Examination (1994 version) and the then established case law of the boards of appeal. Consequently the standards set out in the subsequent decision **G 1/03** (OJ 2004, 413) could not be applied, since this would offend against the principle of good faith and the protection of the legitimate expectations of the users of the EPO. The board noted that the legal system established under the Convention did not treat either the Guidelines or established case law as binding. Thus, any principle of protection of legitimate expectations could not be based on earlier Guidelines or case law. The board held that the standards set out in **G 1/03** were applicable to the case.

A similar issue arose in **T 500/00** where the appellant argued that the disclaimer had been made in good faith according to the Guidelines and in accordance with the practice of the boards of appeal at the time when the disclaimer was made. The board noted that what counted was not whether the opposition division had acted in accordance with the Guidelines, but whether it had acted in accordance with the Convention. The board held that at the time when the disclaimer was introduced the appellant could not expect that it would be considered allowable. The board added that a single decision of the board of appeal could not create a legitimate expectation that it would be followed in future. The principle of good faith could thus not be invoked against the application of principles concerning the allowability of disclaimers laid down in **G 1/03** to pending cases.

4.2. Point in time from which a new decision which deviates from existing practice becomes generally applicable

Several decisions were concerned with the question of **when** a new decision which deviates from existing practice to the detriment of an applicant becomes generally applicable and how the legitimate expectations of users of the EPO are protected. In three decisions (**G 5/88**, OJ 1991, 137, concerning an administrative agreement; **G 5/93** OJ 1994, 447; **G 9/93**, OJ 1994, 891) the Enlarged Board of Appeal reached the conclusion that decisions overturning earlier rulings would not be applied up to the date on which they were made available to the public.

According to **G 5/93** (OJ 1994, 447) the EPO was bound, by its own interpretation and practice, to admit the possibility of Euro-PCT applicants having their rights re-established with regard to the time limit for paying the national fee provided for in R. 104b EPC 1973 (which became R. 107 EPC 1973; see now R. 159 EPC) in all cases where re-establishment of rights was applied for before decision **G 3/91** (OJ 1993, 8) was made available to the public (see also **J 9/93**).

In **G 9/93** (OJ 1994, 891) the Enlarged Board of Appeal overturned its earlier ruling in decision **G 1/84** (OJ 1985, 299) and held that a European patent cannot be opposed by

its own proprietor (see also Chapter VII.D.2.1.3). The Enlarged Board held that where purely procedural matters are concerned there may be reasons of equity for not applying the new interpretation of the law to pending cases. As to the referred question of the admissibility of self-opposition, obviously patent proprietors in cases then pending before the EPO had had every reason to expect that such an opposition would be considered as admissible, relying on the decision in **G 1/84**, which had been followed for many years. In the view of the board, it would be inequitable to prevent them from continuing the proceedings, which they had embarked on in good faith and which could not adversely affect the rights of any third party.

In **T 716/91** the board came to the conclusion that **G 4/93** (corresponding to **G 9/92**, OJ 1994, 875) had also to be applied to pending cases. In the case in point an appeal against the interlocutory decision of the opposition division maintaining the patent in an amended form was only filed by the opponent. The respondent (patent proprietor) requested that the patent be maintained as originally granted. In **G 4/93** the Enlarged Board of Appeal stated that under such circumstances the patent proprietor is primarily limited to defending the amended version as accepted by the opposition division. Therefore, in view of **G 4/93**, the board rejected the main request of the respondent in spite of his argumentation that it was uncertain until the publication of **G 4/93** whether it was allowable for the patentee to maintain a request based upon the originally granted claims and that contrary case law existed on this issue. The board pointed out that **G 4/93** did not contain any indication limiting the applicability of the law as interpreted therein to pending cases. Therefore this case was not analogous to the situation in **G 9/93**. On the contrary, following the arguments of the respondent itself that "contrary case law" existed, the respondent should have taken the appropriate procedural steps (in this case by filing an appeal) to ensure he could still request the maintenance of the patent as granted, instead of taking the risk of the other possible interpretation being followed by the present board.

See **J 8/00**, about the appellant's contention, not followed by the legal board, that these three Enlarged Board decisions form the basis of a general rule that new case law must never be applied "retrospectively" (in the sense used by the appellant).

In **T 739/05**, the board saw no reason to suspend the further prosecution and the final decision of the case until a decision of the Enlarged Board of Appeal was issued on an important point of law which might have been of importance for the case under consideration. The board held that the decision of the Enlarged Board of Appeal could not affect the outcome of the case because of the principle of the protection of legitimate expectations relating to pending cases. Where existing long-standing practice laid down in publications of the EPO is overruled by a new decision, consistent case law allows the applicants of pending cases a transitional period during which they may rely on the previous practice until the modifying decision is made available to the public.

The recent decision **G 2/08** (OJ 2010, ***), concerning dosage regime, stated that in order to ensure legal certainty and to protect legitimate interests of applicants, the interpretation of the new law given by the Enlarged Board in this decision (see chapter I.C.5.2.4 b), novelty) should therefore have no retroactive effect, and an appropriate time

limit of three months after publication of the present decision in the Official Journal of the EPO was set in order for future applications to comply with this new situation. In this respect the relevant date for future applications was their date of filing or, if priority has been claimed, their priority date.

B. Right to be heard

Only the title of Art. 113 EPC was amended in the EPC 2000; its substantive provisions remain the same. Therefore, although the case-law developments set out below result from decisions given while the EPC 1973 was still in force, they remain valid even after the entry into force of the revised EPC.

1. The general principle

Under Art. 113(1) EPC the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

This important procedural right is intended to ensure that no party is caught unawares by reasons given in a decision turning down his request on which he has not had the opportunity to comment. A decision which fails to take into account the arguments submitted by a party and which is based on a ground on which the party had had no opportunity to present its comments, contravenes Art. 113(1) EPC and constitutes a substantial procedural violation (see **J 7/82**, OJ 1982, 391; **T 1039/00**, **T 778/98**).

In **J 20/85** (OJ 1987, 102) the board pointed out that Art. 113(1) EPC 1973 was of fundamental importance for ensuring a fair procedure between the EPO and a party to proceedings before it, especially when issues of fact arose. A decision against a party to proceedings on such an issue of fact could only properly be made by the EPO after all the evidence on which such decision was to be based had been identified and communicated to the party concerned. Furthermore, in **J 3/90** (OJ 1991, 550) the Legal Board of Appeal held that where the EPO had examined the facts, Art. 113(1) EPC 1973 was not complied with unless the parties concerned had been fully informed about the enquiries made and the results and then given sufficient opportunity to present their comments before any decision was issued (see also **J 16/04**).

1.1. The definition of "grounds or evidence"

The "grounds or evidence" under Art. 113(1) EPC are to be understood as meaning the essential legal and factual reasoning on which the EPO has based its decision (**T 532/91**, **T 105/93**, **T 187/95**, **T 1154/04**). In **T 951/92** (OJ 1996, 53) the board ruled that the term "grounds or evidence" should not be narrowly interpreted. In the case in point, which related to examination proceedings, the board held that the term was to be understood as referring to the legal and factual reasons leading to refusal of the application, and not in the narrow sense of a requirement of the EPC.

In **T 375/00** the appellant/opponent considered his right to be heard to have been violated on the basis that the problem mentioned by the opposition division in its decision was different to that discussed in the preceding proceedings. The board held that the appellant's right to be heard had not been violated, because the definition of the objective problem was part of the arguments, not part of the grounds as specified in Art. 113(1) EPC 1973. In **T 33/93** the board stated that the citation of a decision for the first time in the decision under appeal was not a fresh ground or piece of evidence within the meaning of Art. 113(1) EPC 1973, but a mere repetition of arguments, since it only confirmed the position duly brought to the appellant's attention.

In **T 587/02** the board saw no fundamental objection to citing in the decision of an examining division an IPER from an International Preliminary Examining Authority other than the EPO, provided that it constituted a reasoned statement (as required by R. 51(3) EPC 1973) using language corresponding to that of the EPC. In the case of an inventive step objection, that would require a logical chain of reasoning which could be understood and, if appropriate, answered by the applicant. Since the IPER in this case did not fulfil these requirements, the board held that the applicant's right to be heard had been violated.

1.2. Some examples of the principle

The right to be heard has not been observed if a decision to refuse an application is based essentially on documents which, though supplied by the applicant in support of his case, are used against him to produce an effect on which he has not had an opportunity to make observations (see **T 18/81**, OJ 1985, 166 and **T 188/95**). This principle also guarantees that grounds put forward are taken into consideration, and it is contravened if a translation, subsequently filed in an official language, of a Japanese document cited in due time is disallowed (**T 94/84**, OJ 1986, 337).

In **T 921/94** the board held that the appellant's bona fide submissions and the technical information provided by its test report substantially changed the points at issue, and that the examining division had a legal obligation under Art. 96(2) and 113(1) EPC 1973 to inform the appellant of the objections under the EPC arising in the new situation and to invite it to file further observations before issuing a decision to refuse the application (see also **T 1154/04**).

In **T 385/97** the board held that if first instance departments and/or parties had failed to take account of highly relevant matter which was clearly available in the EPO file and which related to a ground of opposition, the board's competence extended to rectifying the position by consideration of that matter, provided that the parties' procedural rights to fair and equal treatment were respected.

In **T 474/04** (OJ 2006, 129), the board held that if assertions made in an unsworn witness declaration remained contested, as a rule a request from a party to hear the witness had to be granted before these assertions were made the basis of a decision against the contesting party. In the case at issue, the board of appeal decided that the opposition division's decision not to summon Mr S. as a witness, although he was

available, handicapped the appellant in its defence against what turned out to be the decisive piece of evidence (see also chapter "law of evidence").

In **T 763/04** the board held that Art. 113(1) EPC 1973 is contravened if facts and arguments which according to the appellant are clearly central to his case and could present a challenge to the decision in question were completely disregarded in that decision. The right to be heard is contravened if the decision of the department of first instance fails to mention or take into consideration important facts and arguments which could present a challenge to that decision.

Following this decision, the board in **T 1997/08** pointed out that the right to be heard also guarantees the EPO's readiness to note and take account of the applicant's submissions in his reply to a communication. It may be assumed that the right to be heard has been contravened if the reasons given for the examining division's decision merely repeat the reasons given for the communication issued before the said reply.

In **T 515/05** the appellant had based its opposition only on the grounds of Art. 100(a) EPC 1973 in its notice of opposition. The opposition division itself introduced as a further ground for opposition the issue of whether the patent met the requirements of Art. 83 EPC 1973. According to the minutes of the oral proceedings the chairman of the opposition division stated at the beginning of the proceedings that no discussion of the ground of opposition according to Art. 100(b) EPC 1973 would take place during those proceedings, because this opposition ground had not been sufficiently substantiated by the opponent. The board considered that this course of action of the opposition division constituted a substantial procedural violation. The fact that the appellant did not avail itself of the opportunity to file written arguments in response to the summons to attend the oral proceedings did not deprive it of its right to be heard. The appellant was entitled to expect that it would still have an opportunity to comment on this new ground during the oral proceedings.

In accordance with established case law, not only must an opportunity to present comments be given, but these comments must actually be taken into account. As the decision "on the state of the file" expressly stated that the applicant had filed no submissions after the final communication, which was factually incorrect, the board concluded, in the circumstances of case **T 1709/06**, that, because the examining division had ignored potentially significant arguments presented in a reply following a communication containing a new objection, the applicant had been denied its right to comment on all the grounds for refusing the application. The applicant's right to be heard enshrined in Art. 113(1) EPC had therefore been infringed.

1.3. Limits of the principle

In **T 643/96** an examining division relied in its decision on a document for which it gave only incomplete bibliographic data. The board held that the examining division's failure to provide the applicant with a copy of the said document did not amount to a substantial procedural violation, having regard to the right to be heard, because the document

added nothing to the case, since it listed something already listed in another document and thus contained only information already known to the appellant/applicant.

In **T 405/94** the board held that a party which, although made aware by at least one letter from another party that an objection had been raised about the availability to the public of the content of a thesis, did not react before the oral proceedings at which a decision could be taken, or which provided for the first time at the oral proceedings information which was found to need confirmation, had had sufficient opportunity to comment on the objection and did not need to be given a further opportunity.

In **T 296/96** the applicant did not submit convincing arguments in his reply to the first communication. The examining division refused the application on the basis of the objections mentioned in the only communication, instead of repeating the objections in a second one. Since, however, the main arguments for refusing the application were a mere repetition of those mentioned in the only communication, the contested decision was based on grounds on which the applicant had had an opportunity to present his comments and, consequently, Art. 113(1) EPC 1973 was not contravened. In **T 821/96**, the board added that, according to the established case law, it was left to the examining division's discretion to decide whether to issue a further invitation to present comments under Art. 96(2) EPC 1973. A further invitation would only be appropriate if it would appear likely that, in the light of the applicant's reply, the examination proceedings would terminate in the granting of a patent (see also **T 201/98**).

In **T 1237/07**, the board stated that Art. 96 EPC 1973 and R. 51 EPC 1973 left the examining division discretion to assess whether a communication was necessary or it was more appropriate to put an end to the written phase and hold oral proceedings. The right to present comments enshrined in Art. 113(1) EPC did not need to be exercised in writing but might be satisfied by way of oral proceedings.

In **T 166/04** the examining division had refused the patent application at the end of oral proceedings which the applicant had not attended. In the appellant's opinion, a gross procedural violation had occurred in that the examining division had used a short-term invitation to oral proceedings to introduce five additional prior art documents (D4...D8) in a complex technical field. Instead, the examining division should have issued another communication pursuant to Art. 96(2) and R. 51(3) EPC 1973 to safeguard the applicant's right to be heard according to Art. 113(1) EPC 1973. The board noted that the decision under appeal mentioned the prior art documents D4 to D8 only obiter. Those documents, while cited in the summons, had not therefore played a decisive role. However, even if they had formed part of a critical argumentation, the board would not necessarily consider their late introduction through summons as improper. Apart from the non-extendable time limit, the appellant had had an opportunity to respond to the summons in writing as if he had responded to a communication under Art. 96(2) EPC 1973. He had actually done so by submitting amendments and arguments with his letter dated 27 March 2003, which dealt with all the prior art documents D1 to D8. In addition, the board pointed out that the applicant had decided not to participate in the first-instance oral proceedings in the course of which he could have made further submissions.

As to the issue of a second communication prior to the refusal of the application, the board in **T 1557/07** stated, giving detailed reasons, that the circumstances of the case before it were not comparable to those underlying **T 734/91**. Concerning a further issue, i.e. the allegation that the examining division had not fully and accurately dealt with all the relevant arguments submitted by the applicants, the examining division was under no obligation to address each and every argument presented by the party concerned. In the case in point, the examining division had commented on the crucial points of dispute, thus giving the applicants a fair idea of why their submissions were not considered convincing. This allegation was therefore also not conclusive. In conclusion, the examining division had not committed a substantial procedural violation.

1.4. Right to be heard and the timing of decisions

In **T 663/99** the board decided that the patent proprietor's right to be heard was violated if the time limit fixed under R. 57(1) EPC 1973 for presenting comments on the opposition had not expired by the date of handing over a revocation decision to the EPO's internal postal service (see also **T 804/94**).

In **T 1081/02** the board of appeal decided that the principle of the right to be heard had been violated, since the opposition division, after inviting the patent proprietor to file within two months the documents considered necessary to maintain the patent, did not wait until this time limit had expired but issued an interlocutory decision prior to its expiry. The board held that, in accordance with its spirit, Art. 113(1) EPC 1973 also applied if a party was denied the opportunity to speak, as it were, because a decision was issued before expiry of a period granted to the party for the presentation of its comments.

In **T 922/02** (ex parte) the board stated that the provisions of Art. 113(1) EPC 1973 were only complied with, in a case where the decision was taken after remittal for further prosecution, if the notification and invitation was made after the remittal, typically by announcing the resumption of the proceedings, setting out the objections, if any, and asking the appellant whether or not he wished, within a fixed period of time, to present his comments or modify his request(s). Otherwise any final decision would come as a surprise to the appellant, which was contrary to the principle of good faith and fair hearing established by Art. 113(1) EPC 1973. The board followed in this respect the case law developed in **T 892/92** (OJ 1994, 664) and **T 120/96** for opposition proceedings, which was equally applicable to examination proceedings, because the right to be heard was an essential procedural principle governing both procedures.

In **T 849/03** the board held that a decision should not catch the parties unawares. In the examination procedure the right to be heard is therefore violated not only in the event of failure to inform the applicant beforehand of the reasons forming the basis of a rejection but also if, at the time the decision is issued, the applicant had no reason to expect such a decision (see also **T 1022/98**).

In **T 685/98** (OJ 1999, 346), the board adjudged that, the phrase "fails to reply in due time to any invitation under ... paragraph 2" in Art. 96(3) EPC 1973 had to be construed in the light of the purpose of the invitation pursuant to Art. 96(2) EPC 1973 and

R. 51(2) EPC 1973, which was to afford the applicant an opportunity to exercise his right to present comments in accordance with Art. 113(1) EPC 1973. Hence a letter from the applicant which neither exercised nor waived that right was not a reply for the purposes of Art. 96(3) EPC 1973. In the case in point, the examining division believed that the applicant, by making a simple procedural request by return of post, had somehow forfeited his right to present comments during the remainder of the four month term set for reply. However, on a proper interpretation of the applicant's letter, he had neither exercised nor waived his right under Art. 113(1) EPC 1973 to present comments on the substantive issues nor, as the time set for reply had not expired, could he have forfeited this right. Thus the precipitate refusal, while there were still some two months of the term for reply unexpired, did indeed contravene Art. 113(1) EPC 1973 by depriving the applicant of an opportunity to present such comments (see also the Chapter VII.B.2.8, examination procedure).

In **T 966/02**, the opponent had filed two notices of opposition in due form and time. The opposition division held that the second set of pleadings did not constitute a notice of opposition but was merely a supplement to the first opposition and that the subject-matter of claim 1 was not new as compared with document D1, which was only submitted with the second set of pleadings (notice of opposition). The board held that this finding infringed Art. 113(1) EPC 1973 because the opposition division had given its decision without first asking the appellant (patent proprietor) to comment on the issue of novelty and inventive step and without informing it that the material submitted with the second notice of opposition, in particular D1, was to be taken into account in assessing novelty. In the case in hand, it was clear that the patent proprietor regarded both notices of opposition as inadmissible and thus felt that there was no sense in commenting on the facts until the situation had been clarified. The appellant (patent proprietor) could not have foreseen that the opposition division would give a final decision without first clarifying the procedural situation and giving it an opportunity to comment on the facts in the clarified situation, and it came as a complete surprise to it that it did so.

In **T 281/03** dated 17 May 2006 the opponent/appellant had wanted to comment before the opposition division on inventive step if novelty was established. However, the issue of inventive step was not discussed at the oral proceedings and the opposition division, after deliberating and announcing its decision on novelty, immediately announced the decision to reject the oppositions. The board held that, in order to guarantee the right to be heard, there should have been an explicit step, recorded in the minutes, giving the opponent/appellant the opportunity to comment on inventive step before the final deliberation, or alternatively an opportunity after the deliberation to comment on the opposition division's conclusion. The fact that before the final deliberation the floor had been given to the opponent/appellant again or that the opponent/appellant made a last submission was not enough to meet this requirement, regardless of whether an experienced representative might have perceived a certain risk of an imminent final decision.

The case law concerning the specific aspects of the right to be heard which arise in examination proceedings where a patent application is refused following a single communication without a further invitation to submit comments is discussed in detail in

Chapter VII.B. The problem, relating to the right to be heard in opposition proceedings, of when an invitation to file observations under Art. 101(1) EPC (Art. 101(2) EPC 1973) must be issued is also discussed in the Chapter VII.D.5.

2. Right to be heard in oral proceedings

2.1. Right to oral proceedings

Art. 113(1) EPC was also important in connection with the right to oral proceedings provided for in Art. 116(1) EPC. In **T 209/88** the board stated that non-compliance with a request for oral proceedings deprived the party of an important opportunity for presenting his case in the manner he wished and using the possibilities open to him under the EPC. By virtue of his request for oral proceedings, the party could rely on such proceedings being appointed before the issue of an adverse decision and therefore had no reason to submit further arguments in writing. In this respect, Art. 116 EPC 1973 was considered an essential part of the requirement under Art. 113(1) EPC 1973 that the party must be given sufficient opportunity to present his comments on the grounds for the decision (see also VI.C.1, oral proceedings).

2.2. Introduction of a new claim, relevant document or new argument

A number of decisions have been issued on the subject of enabling the parties to exercise their right to be heard in oral proceedings when a new claim or relevant document is introduced.

In a case where an opposition division or a board of appeal feels bound by Art. 114(1) EPC to examine new facts or evidence submitted for the first time during oral proceedings, it must, in accordance with Art. 113(1) EPC, give the other parties the opportunity to comment before issuing a reasoned decision based on such facts or evidence (**G 4/92**, OJ 1994, 149; see also **T 484/90**, OJ 1993, 448; with regard to late submission see **T 330/88**, **T 356/94** and above all Chapter VII.C.1). The same principle has also been applied to decisions of examining divisions.

2.2.1 Cases where new claims or relevant documents were introduced

In **T 951/97** (OJ 1998, 440) the examining division introduced document D4 for the first time during oral proceedings. D4 had been mentioned in the European search report but had not been cited at any stage in the examination procedure prior to the oral proceedings; in particular, no reference had been made to it in the communication under R. 71a EPC 1973. After a half-hour adjournment, the appellants filed a second auxiliary request which, in the examining division's view, was *prima facie* not admissible and not allowable. In response to this, the appellants submitted that a further opportunity for amendment should be granted, since a newly cited document had been introduced by the examining division, changing the subject of the proceedings. In addition, the appellants should be given sufficient time to comment on D4. At the end of the oral proceedings, the application was refused under Art. 97(1) EPC 1973.

The board found that half an hour was too short a period for an adequate analysis of the complex text of D4. It was clear that D4 was essential to the finding of the examining division in relation to inventive step; consequently, the decision was based on evidence on which the applicants had not had a sufficient opportunity to present their comments as required by Art. 113(1) EPC 1973 (see also **T 492/03**). The examining division had also decided under R. 71a EPC 1973 not to consider this second auxiliary request, on the ground that the subject of the proceedings had not changed. The board, however, held that the subject of the proceedings had been changed within the meaning of R. 71a(1) and (2) EPC 1973, inter alia where the examining division itself introduced a new document, which was **pertinent new material**, into the proceedings for the first time during oral proceedings convened following a R. 71a EPC 1973 notification.

In **T 783/89** the opposition division had presented the parties at the start of the oral proceedings with a new version of the main claim, giving them ten minutes to consider it. The board ruled that this had taken the appellants by surprise. Nor had the time given been enough to establish whether the amendments were allowable.

In a number of cases, the boards held that Art. 113(1) EPC had not been violated when new claims or relevant documents were introduced.

In **T 484/89** the board held that the opposition division was empowered under Art. 114(1) EPC 1973 to take account of and refer to all relevant documents cited. If it intended to do so it would normally issue a communication to that effect when appointing oral proceedings. In the case in question, however, the opposition division had considered it necessary to refer to the document during the oral proceedings. In such cases the parties should, at their request, be granted an adjournment or else new oral proceedings should be appointed to give them the opportunity to comment. Since no such request was made, according to the decision or the record of the oral proceedings, no breach of Art. 113(1) EPC 1973 had taken place.

In **T 376/98** it was evident from the file that the examining division had referred to document D4 for the first time during the oral proceedings. The examining division had stayed the oral proceedings to give the applicant time for consideration. When the oral proceedings were resumed, the appellant requested a decision based on the documents on file. Regarding the introduction of D4 at the oral proceedings, the board noted that no procedural limitations were placed upon the examining division to cite relevant documents during any stage of the examination procedure, as long as the applicant was given a fair chance to comment on the objections raised before a final decision was taken (see **T 1198/97**). In the board's opinion, the appellant's request for a decision could only be taken to mean that the appellant was not interested in a further debate about the relevance of D4 or its importance for the decision. In fact, the appellant's request left the examining division no other choice than to decide the case straight away and no procedural violation could be inferred in the circumstances.

In **T 566/91** the opposition division, albeit inadvertently, based its decision to revoke the patent on a version of a citation which was more complete than the version which both parties present at the oral proceedings before the board had had in their possession. In

order to comply with Art. 113 EPC 1973 in the proceedings before the board, the board offered the parties a half-hour suspension of the oral proceedings to enable them to study the fuller version of the document with the help of the interpreters.

In **T 248/92**, the examining division had based its decision on **arguments** submitted for the first time during oral proceedings. The board held that the examining division's decision had not been taken contrary to Art. 113(1) EPC 1973. Although one of the purposes of oral proceedings was to settle as far as possible all outstanding questions relevant to a decision, they did not have a constraining effect in the sense of requiring an **immediate** decision to be taken at the end of those proceedings. If the appellant had felt the need for further reflection, he could have asked for the oral proceedings to be adjourned or for the proceedings to be continued in writing so that he could study carefully the newly introduced arguments, which were obviously crucial to the decision.

2.2.2 Cases where no new claims, relevant documents or new arguments were introduced

In **T 195/84** (OJ 1986, 121) the representative objected at the oral proceedings that new grounds were being presented, challenging the existence of an inventive step, to which he had not previously had an opportunity to reply. The board could not share this opinion as the representative had been aware that such prior art existed, and he had thus had sufficient time to consider it in full. Furthermore, he had not requested any additional time to examine this art in greater detail and had not asked for an adjournment.

In **T 327/92** the board held that reliance by the opposition division at oral proceedings on a document originally cited in the opposition against a dependent claim only, as closest prior art against an amended main claim, did not amount to a substantial procedural violation where the patentee had the opportunity to comment at oral proceedings.

2.3. Changes after oral proceedings

In **T 862/98** the decision of the department of first instance was signed by an opposition division different from that before which the oral proceedings had taken place, the second member having been replaced **after** the oral proceedings. The board decided that changes in the composition of an opposition division after oral proceedings should generally be avoided. This also applied to cases where no final substantive decision had been given orally. Where changes were unavoidable, new oral proceedings must in general be offered to the parties (see the analogous rule in Art. 7(1) RPBA 2003 (Art. 8(1) RPBA 2007)). Such offers might be forgone in exceptional cases.

In the appellants' view, the opposition division had violated Art. 113 EPC 1973 by changing its provisional opinion after the oral proceedings without giving the appellants an opportunity to comment on the grounds, which had not been stated before, on which the contested decision was based. In **T 68/94** the board pointed out that provisional opinions were never binding. The purpose of oral proceedings was to summarise and discuss the parties' arguments. This meant that either party could present its comments on the other's counter-arguments, in accordance with the requirements of Art. 113 EPC

1973. The respondents had already filed a letter setting out the arguments which the opposition division had then endorsed in the contested decision. All the arguments in the case had been known to both parties.

3. Non-appearance at oral proceedings and the right to be heard

Until RPBA 2003 entered into force (the version currently in force is RPBA 2007), opinion **G 4/92** was the authoritative source on this question for the departments of first instance and the boards of appeal. The entry into force of RPBA 2003 rendered opinion **G 4/92** obsolete in this respect (see point 3.2 RPBA and the comments on Art. 11 RPBA 2003 in CA/133/02). The Guidelines for Examination in the EPO still refer to it for the departments of first instance (see Guidelines E-III, 8.3 - April 2010 version). With regard to proceedings before the examining divisions, see the communication published in OJ 10/2008, p. 471. The basic EPC provision on non-attendance is R. 115(2) EPC (formerly R. 71(2) EPC 1973).

3.1. Non-appearance at oral proceedings - case law concerning **G 4/92**

In **G 4/92** (OJ 1994, 149) the Enlarged Board of Appeal held that, in view of the right to present comments, a decision against a party who had been duly summoned but who failed to appear at oral proceedings could not be based on facts put forward for the first time during those oral proceedings. Evidence put forward for the first time during oral proceedings could not be considered unless it had been previously notified and it merely supported the assertions of the party which had submitted it. However, new arguments could - in principle - be used in the reasons for the decision as they did not constitute new grounds or evidence, but were reasons based on the facts and evidence already put forward. This opinion related only to inter partes proceedings.

The way in which **G 4/92** is interpreted and applied in practice is illustrated in a number of decisions.

In **T 341/92** (OJ 1995, 373) the board held that it was possible to base a decision on a ground discussed for the first time during oral proceedings which would prevent the patent being maintained as amended, at least if the stage reached in the case was such that the absent - albeit duly summoned - patent proprietors could have expected the question to be discussed and were aware from the proceedings to date of the actual basis on which it would be judged. The appellants (patent proprietors) had filed, together with a statement setting out the grounds of appeal, a main request and an auxiliary request with new claims. However, the appellants - having notified the board to that effect in advance - were not represented at the oral proceedings. During oral proceedings the question of whether the subject-matter of claim 1 in accordance with the main request infringed Art. 123(3) EPC 1973 was brought up by the board **for the first time**. The board concluded that the main request constituted an inadmissible extension of the protection conferred. At the end of oral proceedings it was announced that the patent would be maintained with the claims according to the auxiliary request. The board did not consider itself prevented by reasons of procedural law from rendering a decision on the basis of Art. 123(3) EPC 1973. It argued that the situation differed from **G 4/92** in

that the extension to which objection had been made arose solely from a comparison of the wordings of the respective claims according to the granted patent and the main request before the board, and therefore not from facts that had only been introduced into the case during oral proceedings.

In **T 133/92** the board concluded that considering and deciding in substance on the maintenance of the patent on the basis of claims as amended during oral proceedings in the absence of the appellants (opponents) did not conflict with the opinion of the Enlarged Board of Appeal in **G 4/92**. The board stated that the respondent's (patentee's) restrictions to the claims removed objections already raised by the appellants. In such a situation the appellants could not have been taken by surprise, because they had reasonably to expect that the respondent would try to overcome all objections. The submission of auxiliary requests was clearly not a "fact" within the meaning of **G 4/92**. Were it otherwise, no decision could ever be issued at the end of a hearing where, as is usually the case, auxiliary requests are filed and, as is also frequently the case, the opponent does not attend the hearing, thereby rendering such hearings pointless and a waste of time, as well as offending against the general principle of legal certainty, i.e. the general interest of the public in the termination of legal disputes. Likewise, the board held in **T 771/92** that the decision to maintain the patent on the basis of a set of claims amended during oral proceedings in the absence of the appellant did not conflict with the principles described in **G 4/92**. The submission of restricted claims was neither a fact nor could it be evidence. The appellant could not be taken by surprise by the amendment made, because he had reasonably to expect that the respondent would try to overcome the objections made. The amendments resulted from the novelty objection made by the appellant during the written procedure.

In cases **T 912/91**, **T 202/92**, **T 856/92**, **T 890/92**, (see also **T 673/06** and **T 235/08**), which were based on similar facts, the board also concluded that Art. 113(1) EPC 1973 had been satisfied. In **T 1049/93** the board decided that, where a duly summoned opponent chose not to attend oral proceedings, a board of appeal could still consider prior art which might be an obstacle to the maintenance of the patent in suit. **G 4/92** should not be construed as extending or prolonging the rights of a voluntarily absent party. In case **T 414/94** the board stated that there was no general prohibition on amending requests during a party's absence from oral proceedings as requested by the respondent/opponent. An absent party must expect reactions of the opposing party within the legal and factual framework of the case established prior to oral proceedings, and the possibility of decisions taking account of, and being based on, such reactions.

In **T 501/92** (OJ 1996, 261), the board ruled that if a new ground for allowing the appeal based upon the facts set out in the file record was raised by an appellant for the first time as a new argument during oral proceedings from which the respondent was voluntarily absent, it would be contrary to Art. 113(1) EPC 1973 and contrary to the principles underlying **G 4/92** to decide to allow the appeal on the basis of this new ground without first giving the respondent an opportunity to comment. In the case in point the appellant (opponent) submitted at the oral proceedings that the failure by the proprietor to file a formal request for maintenance of the European patent should lead automatically to revocation of the patent.

In **T 892/94** (OJ 2000, 1) the respondents (proprietors), albeit duly summoned, not only failed to appear at the oral proceedings but had also notified the board in advance, before the oral proceedings were held, of their decision to take no further part in the proceedings. According to the board, the respondents' declaration that they would take no further part in the proceedings could only be construed as an unequivocal decision to surrender, voluntarily, their rights according to Art. 113(1) EPC 1973 and no longer to avail themselves of the opportunity to present their comments on any objections, facts, grounds or evidence which could potentially be introduced into the proceedings by the appellants or the board and which could later turn out to be decisive for the revocation of the patent. The board was therefore of the opinion that considering and deciding in substance on the revocation of the patent did not contravene the respondents' procedural rights as laid down in Art. 113(1) EPC 1973, although the respondents did not attend the oral proceedings.

In **T 191/98** the board dealt with the question of whether the respondent (proprietor), who had not attended the oral proceedings, had been given sufficient opportunity to present comments on the introduction of the late-filed document D10, the interpretation of the disclosure of D10 and the reasons leading to the decision for revocation. The respondent had had more than two years' prior knowledge of the possible admission of D10 into the appeal proceedings and had been informed by the board that D10 was to be discussed at the oral proceedings. The appellant considered D10 to be novelty-destroying. The board did not agree with the appellant's line of argument, but it decided that the subject-matter of claim 1 as granted lacked inventive step when starting from the prior art disclosed in D10, and it revoked the patent.

The board referred to **G 4/92** (OJ 1994, 149) and considered that the respondent, when informing it of its non-appearance, should have expected that the board would decide in substance on the patent in its granted form, taking into account any piece of evidence filed by the appellant and arguments based on that evidence, including the possibility that the line of argument based on a particular piece of evidence would be further developed during the oral proceedings.

T 55/91 raised the principle of the right to be heard in ex parte proceedings when the applicants/appellants, who were duly summoned to attend oral proceedings, failed to take advantage of the opportunity presented. The board considered that, pursuant to Art. 113(1) EPC 1973, the appellants had had an opportunity to present their comments on the novelty objection raised by the board, but had not availed themselves of this opportunity. On considering the case at the oral proceedings, duly held pursuant to R. 71(2) EPC 1973 despite the absence of the appellants, the board came to the conclusion that the subject-matter of claims 1 and 2 lacked novelty for reasons already set out by the board.

3.2. Non-appearance at oral hearings before the boards of appeal

According to Art. 15(3) RPBA 2007 (Art. 11(3) RPBA 2003), "the Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated

as relying on its written case." In **T 706/00** the board observed that this new RPBA provision superseded the findings of **G 4/92** (OJ 1994, 149). More recently, see **T 1704/06** quoting CA/133/02 and the relevant passages concerning Art. 11(3) RPBA 2003.

In **T 979/02** (ex parte), two days before the oral proceedings, the appellants had informed the board that they would not attend. On the afternoon of the same day they filed a single amended set of claims for the appeal board to consider in their absence. The board referred to the ex parte case **T 70/98** and to Art. 11(3) RPBA 2003. In **T 70/98** the appellants had announced on the day before the oral proceedings that they would not attend and had then filed a new auxiliary request. The board in that case had concluded that the appellants had waived the opportunity of discussing their case and, if necessary, of filing further amendments to overcome any objections during the oral proceedings. In the case at issue the board stated that for reasons of procedural economy, it had no reasonable alternative other than to decide on the admissibility of the request by using the criterion of whether the documents of the request would be prima facie clearly allowable under the EPC. The board concluded that both the description and the claims taken alone prima facie revealed a number of formal deficiencies and decided not to admit the late-filed request. The appeal was dismissed.

In **T 986/00** (OJ 2003, 554), in a communication accompanying the summons to oral proceedings, the respondent (patent proprietor) had been warned that he should be prepared to amend the description and the dependent claims at the oral proceedings, should the board decide to maintain the patent in amended form on the basis of one of the auxiliary requests. Furthermore, it had been indicated that any written submission should be filed at the latest one month before the oral proceedings. However, the proprietor chose not to be represented at the oral proceedings and, despite the warning, did not file any further amendments to the patent in suit.

According to Art. 113(2) EPC 1973, the board had to decide upon the patent only in the text submitted, or agreed, by the proprietor. Furthermore, according to Art. 11(1) and (3) RPBA 1980 (now Art. 15(1) and (3) RPBA 2007), a case should normally be ready for decision at the conclusion of oral proceedings and the parties should provide all relevant information and documents before the hearing. In **T 986/00**, the board held that a proprietor who chose not to be represented at oral proceedings should ensure that he has filed all the amendments he wishes to be considered before the oral proceedings. According to the board, this was all the more so in the case at issue, since the proprietor had been expressly warned about the possible necessity of amending the claims and the description. The board concluded that it could therefore take the decision without further ado, and it revoked the patent.

In **T 1903/06** the board was aware that the objections against the main and auxiliary requests on file could have been met by suitable amendments, if the appellant's representative had been present at the oral proceedings. However, the board had to decide upon the application only in the text submitted to it by the appellant (Art. 113(2) EPC 1973). In this respect, it agreed with the following conclusions in **T 1000/03**: "The appellant had been duly summoned, and at the oral proceedings could easily have

corrected the above and further minor deficiencies in the description. To delay the decision pending their correction was uncalled for (see Art. 11(3) RPBA 2003). Under Art. 113(2) EPC, the board had to keep to the text submitted by the appellant/applicant, who by not appearing at the oral proceedings had taken the risk of the application being refused even for easily remediable deficiencies." Thus, the appellant had to bear the consequences of the failure to appear.

4. Article 113(2) EPC

Under Art. 113(2) EPC (unchanged under the EPC 2000) the EPO may consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent. Concerning Art. 113(2) EPC see chapters VII.B.3, examination procedure, and VII.E.17, reimbursement of appeal fees.

In **T 32/82** (OJ 1984, 354) the board stated that when taking its decision a board of appeal (or department of first instance) had no authority to order the grant of a European patent containing claims which were different in their content or interdependency from those submitted by the applicant. In **T 647/93** (OJ 1995, 132) the board pointed out that Art. 113(2) EPC 1973 was a fundamental procedural principle, being part of the right to be heard, and was of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, had, in principle, to be considered to be a substantial procedural violation (see also **T 32/82** and **J 19/84**). In any case, such violation occurred when, as in the case in point, the examining division did not make use of the possibility of granting interlocutory revision under Art. 109 EPC 1973 after the mistake had been pointed out in the grounds of appeal.

4.1. The requirement of a text agreed by the applicant

In **T 73/84** (OJ 1985, 241) the board held that the European patent was to be revoked if the proprietor stated in opposition or appeal proceedings that he no longer approved the text in which the patent was granted and would not be submitting an amended text (see also **T 655/01**, **T 1526/06** and the cited case law). The board in **T 706/00** pointed out that the EPO cannot depart from a request once made. It can only grant or deny the request; it cannot grant more, less or even something different. Unless a grantable text is submitted, at least auxiliarily, the request is rejected in full. In **T 549/96**, the board noted that an applicant had to unambiguously indicate, at the end of the proceedings, which text he proposed. Otherwise, the examining division would be unable to decide on the basis of which version it should proceed and the application would eventually have to be refused, since there would be no clear request at all. Thus, if an applicant failed to indicate his approval of the text of an allowable subsidiary request, e.g. by express disapproval or by maintaining one or more unallowable higher-preference requests, the examining division could refuse the application under Art. 97(1) EPC 1973 (see also **T 976/97**).

In **T 237/96** the board explained that Art. 113(2) EPC 1973 could not be interpreted in the sense that the examining division was bound to accept any amendment which the

applicant might propose, only to ensure that there was a version approved by him. In circumstances in which, as in the case in question, amendments proposed by the applicant after the R. 51(4) EPC 1973 communication were with good reason not allowed by the examining division by virtue of R. 86(3) EPC 1973 and the applicant did not give its agreement to any other version of the application documents, the established practice of the EPO, sanctioned by consistent case law, was to refuse the application on the ground that there was no version approved by the applicant within the meaning of Art. 113(2) EPC 1973, on which a patent could be granted.

In **T 917/95**, a patent proprietor who was a party to the inter partes proceedings had submitted a new claim prior to the oral proceedings before the board of appeal, but no amended description or drawing. The descriptions and drawings relating to the previous claims were incompatible with the new claim. Because the proprietor failed to appear at the oral proceedings, no documents were available at the end of the oral proceedings on the basis of which the patent could have been maintained (see also **T 725/00** and **T 1174/01**).

In **T 255/05**, as "auxiliary request" the appellant requested that "the application proceed to grant on the basis of all or at least one of the four alternative claim sets". In brackets the appellant added that it appreciated "that if more than 1 set of such claims is allowed then it may be necessary to file divisional applications accordingly". The appellant's "auxiliary request" was thus not one single request but encompassed numerous requests. These were not only the four alternative claim sets filed, but also any possible combination of more than one of these claim sets up to all of them taken together. It was, however, totally undefined in which order these four requests and any such combination requests should be considered by the board. According to Art. 113(2) EPC 1973, it was the applicant's responsibility to define the text on the basis of which it requested a patent to be granted. In the case of auxiliary requests this also meant that the applicant had to indicate also the order in which the requests were to be examined. This was so because filing an auxiliary request meant that such a request was only filed in the event that the preceding request was not allowed by the board. As a consequence, when the appellant, even after having been invited to do so by the board, did not clearly indicate the order in which its several requests were submitted and what the exact content of each of these requests was, there was no text submitted or agreed by the applicant within the meaning of Art. 113(2) EPC 1973 and no request which could be considered by the board. Therefore, the appellant's "auxiliary request" was disregarded.

4.2. Cases where the EPO is uncertain or mistaken about the approval of the text

In **T 666/90** the status of the requests on file was not clarified during oral proceedings before the opposition division. This resulted in a disagreement in the period between oral proceedings and the drafting of the written decision. The board pointed out that in a case such as this the appropriate action to take was to request a written copy of the final version of the requests and clarification of the order in which they were to be ranked prior to the decision being issued. Failure to clarify the position was in breach of Art. 113(2) EPC 1973 and hence constituted a substantial procedural violation. In **T 552/97** the opposition division had taken no decision on the main request, being under

the incorrect impression that it was no longer in the proceedings. The board pointed out that EPO departments should clarify the position before issuing decisions, especially if requests had been amended in oral proceedings. In **T 355/03** it was unclear which text the applicant wished to have as the basis for grant. The board held that the examining division ought to have established what the applicant really wanted. The examining division's failure to do so constituted a substantial procedural violation.

In **T 1439/05**, it was held that, under Art. 113(2) EPC 1973, the EPO had to consider and decide on the application in the text submitted or agreed by the applicant. If there were several requests in the form of a main request and successive auxiliary requests submitted in order of relevance, the examining division was bound in its decision by the order in which the requests had been submitted.

In **T 425/97**, the text of the single claim attached to the written decision of the opposition division was different from the text apparently held patentable at the oral proceedings, in relation to many essential features of the claim. From the original minutes of the oral proceedings, the history of the case and further circumstances, the board therefore concluded that the opposition division took a decision on the patent in suit on the basis of a text which had neither been submitted nor agreed by the proprietor of the patent. This involved an infringement of Art. 113(2) EPC 1973 and had to be considered as a substantial procedural violation.

In **T 543/92** and **T 89/94** the opposition division unintentionally failed to take account of a document introducing amended claims. In both cases the patent was revoked. The board ruled that once an item of mail had been received at the EPO it had to be considered to have been received by the organ deciding the case. Responsibility for correct processing of mail thereafter lay with the relevant departments within the EPO. The decision under appeal was thus in breach of Art. 113(2) EPC 1973.

In **T 1351/06**, the main request had not been withdrawn and had therefore remained pending. As a result, the decision to grant the patent on the basis of the text approved by the applicant as an auxiliary request was contrary to Art. 113(2) EPC 1973.

C. Oral proceedings

1. Right to oral proceedings

1.1. The general principle

The right of parties to oral proceedings in examination, opposition and appeal proceedings is enshrined in Art. 116(1) EPC, according to which oral proceedings take place either at the instance of the EPO if it considers this to be expedient or at the request of any party to the proceedings. In other words, oral proceedings are not held automatically in each case. The right to an oral hearing is an extremely important procedural right which the EPO should take all reasonable steps to safeguard (**T 19/87**, OJ 1988, 268, **T 663/90**, **T 808/94**, **T 911/04**). If a request for oral proceedings has been made, such proceedings have to be appointed. This provision is mandatory and leaves

no room for discretion (**T 283/88**, **T 795/91**, **T 556/95**, **T 1048/00**). Considerations such as the speedy conduct of the proceedings, equity or procedural economy cannot take precedence over the principle of the right to oral proceedings. The right to be heard in oral proceedings subsists so long as proceedings are pending before the EPO (**T 598/88**, **T 556/95**, **T 114/09**).

The EPC 2000 made no substantive changes to Art. 116 EPC, merely a minor editorial correction.

The refusal of a request for oral proceedings normally constitutes a violation of the right to present comments and justifies reimbursement of the appeal fee (see under chapter VII.E.17, reimbursement of appeal fees). Thus, if the request for oral proceedings is ignored, even due to an oversight, the decision must be set aside as null and void (**T 19/87**, OJ 1988, 268; **T 93/88**, **T 560/88**, **T 663/90** and **T 766/90**).

More specifically, the Rules of Procedure of the Boards of Appeal of the EPO (RPBA) as amended on 25 October 2007 (see OJ 2007, 536) contain rules relevant to oral proceedings. According to Article 24 of these Rules they entered into force upon entry into force of the revised text of the European Patent Convention, i.e. on 13 December 2007 in accordance with Article 8 of the Revision Act.

1.2. Special cases of oral proceedings before the Receiving Section

Under Art. 116(2) EPC oral proceedings must take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application. Thus, in **J 20/87** (OJ 1989, 67) the Legal Board stated that a board, exercising powers within the competence of the Receiving Section under Art. 116(2) EPC 1973 in conjunction with Art. 111(1) EPC 1973, could refuse a request for oral proceedings made by an applicant in the course of an appeal against a decision of the Receiving Section where the board did not consider such proceedings to be expedient and where it did not envisage refusing the European patent application.

A case in which the Receiving Section had to decide whether the loss of a right had resulted from the EPC 1973 in accordance with R. 69(2) EPC 1973 was not a case in which the Receiving Section "envisages refusing the European patent application" within the meaning of Art. 116(2) EPC 1973. The Receiving Section could therefore refuse an applicant's request for oral proceedings where it did not consider such proceedings expedient (**J xx/xx**, OJ 1985, 159).

In **J 17/03** the board of appeal decided that the refusal of oral proceedings before the Receiving Section did not amount to a procedural violation. Since a decision confirming a loss of right or refusing a requested re-establishment of rights was not to be equated with the refusal of an application, the Receiving Section had discretion in dealing with the appellant's request for oral proceedings. While the discretion provided for in Art. 116(2) EPC 1973 was not without limits and had to be exercised in light of recognised procedural principles such as the right to be heard set out in Art. 113(1) EPC

1973, the Receiving Section had given the appellant ample opportunity to present its case as several letters and communications had been exchanged and a consultation by telephone had taken place.

1.3. Examples of the general principle

The board in **T 556/95** (OJ 1997, 205) held that the discretion of an examining division to allow amendments up to the decision to grant the patent did not mean that that department had discretion to refuse a request for oral proceedings dealing with such amendments. The examining division had to have regard to Art. 116(1) EPC 1973 when exercising its discretion under R. 86(3) EPC 1973 in case of amendments requested after the issue of a communication under R. 51(6) EPC 1973 (old version). The board went on to state that the right to be heard in oral proceedings (Art. 116 EPC 1973) subsisted so long as proceedings were pending before the EPO. Lastly, the board added that the Enlarged Board of Appeal - which in **G 7/93** (OJ 1994, 775) had given some guidance as to how an examining division should exercise such discretion under R. 86 EPC 1973 (after the R. 51(6) EPC 1973 communication had been sent) - could not limit the application of Art. 116(1) EPC 1973 by means of such guidance.

In **T 383/87** the board pointed out that Art. 116(1) EPC 1973 guaranteed the right of any party to request oral proceedings, i.e. to argue its case orally before the relevant department of the EPO. A party might feel that it could present its case better orally than in writing, even if it had no new arguments. It was then its genuine right to request oral proceedings without being inhibited by the fear of having to pay additional costs, unless the request for oral proceedings was a clear abuse of the law. In **T 125/89** the board also emphasised that Art. 113(1) and 116(1) EPC 1973 were clearly not restricted to "new and substantial arguments". Parties also had the right to repeat known arguments or to stress arguments which had already been brought forward or to link such arguments in a specific combination or series.

In **T 693/95**, the board emphasised that where several parties are involved, e.g. in opposition proceedings, the EPC provides only for oral proceedings to which all the parties are invited, so as to respect the principles of judicial impartiality and the equal rights of parties. No provision exists for a discussion of substantive issues between a single party and a member of either the opposition division or the board of appeal. In the case in question, oral proceedings had taken place before the opposition division, and the appellants had had an opportunity to present their comments, through one of their number who had been present. Thus there was no basis for their allegation that they had been denied the right to be heard.

2. Request for oral proceedings

A party's right to oral proceedings is subject to a clear and unconditional request for such proceedings (**T 299/86**, OJ 1988, 88; **T 433/87**, **T 663/90**). The question whether a request for oral proceedings has been made must be decided on the individual facts of each case. If there is the slightest doubt, clarification should be sought from the party concerned (**T 19/87**, OJ 1988, 268; **T 283/88**). Nevertheless, in **T 528/96**, the board

explained that, although the opposition division might reasonably have been expected to query whether such a request was in fact intended, the fact that it failed to do so did not constitute a procedural violation, since the onus to make a clear request was on the party itself.

In **T 870/93** the board found that the appellant had merely stated his intention of awaiting a new communication from the opposition division before - possibly - requesting oral proceedings. It added that to be sure of oral proceedings, the opponent should have asked for them at an early stage. Alternatively, if his intention was to request oral proceedings only under certain conditions, he should have filed an auxiliary request clearly setting out those conditions.

2.1. Wording of request

2.1.1 Wording constituting a request

In the ex parte case **T 95/04** the appellant's request for a telephone call from the examiner was followed by a further request "in any event" for an opportunity to be heard before an adverse decision was taken. In the board's view, the expression "in any event" in the given context clearly implied that in the event that the examiner was to exercise his discretion and not to communicate further with the applicant, then the applicant wished to have a further opportunity to be heard which under the circumstances could only be provided by appointing oral proceedings. The applicant's request thus included a request for appointment of oral proceedings.

In **T 19/87** (OJ 1988, 268) the board considered that the request in the applicant's letter for "an interview as a preliminary to oral proceedings" could only be construed as both a request for an interview (which might or might not be granted) and a request for oral proceedings. In the case in question it was mandatory that oral proceedings should take place before the examining division (see also **T 283/88**).

In **T 668/89** the phrase "... applicant's representative claims his right to appear and argue the case orally" was deemed to be a valid request for oral proceedings.

2.1.2 Wording not constituting a request

In **T 528/96**, the final paragraph of the patentee's response to the opposition - the last document on the file before the opposition division took its decision - read as follows: "Should the opposition division feel that further information is required, the patentee will be pleased to respond in due course, either in writing or during the oral hearing". The opposition division argued that this statement did not constitute a request for oral proceedings. The board endorsed this view. The statement did not constitute a formal request for oral proceedings.

In interlocutory decision **T 299/86** (OJ 1988, 88) a party made the following statement: "In the event, however, that the examining division is minded to refuse the application, I reserve my right to request oral proceedings under Art. 116 EPC 1973". This was

interpreted as meaning that the party had not yet decided whether to request oral proceedings (see also **T 263/91**).

In **T 433/87** the board interpreted the patent proprietor's request "to conclude the opposition proceedings and if necessary arrange oral proceedings as soon as possible" to mean that oral proceedings were requested only in the event of their being considered necessary by the opposition division. The statement "if there are any outstanding problems, the writer would welcome an opportunity to discuss the case with the examiner" could not be understood as a valid request for oral proceedings either (see **T 88/87**).

2.2. Withdrawal of request

A party's request for oral proceedings can be withdrawn only by virtue of a clearly expressed intention not to proceed with the request, for example in the form of an unambiguous written statement to that effect on the file. If there is no unequivocal proof of the withdrawal of the request, it has to be assumed that the request, once submitted, is still valid and was therefore also valid at the time of the contested decision (see **T 283/88**, **T 663/90**, **T 879/92**).

In **T 3/90** (OJ 1992, 737) oral proceedings were appointed as a result of a party's request for such proceedings on an auxiliary basis. The party subsequently stated that it would not be represented at the oral proceedings. In its decision, the board stated that such a statement should normally be treated as equivalent to a withdrawal of the request for oral proceedings (see also **T 696/02** and **T 1027/03**). In **T 910/02** the board of appeal remitted the case to the department of first instance for further prosecution without oral proceedings, since all the parties who had presented their comments in the appeal proceedings had either withdrawn their request for oral proceedings or had stated that they would not attend oral proceedings. In such a case the board has discretion either to abide by the date for the oral proceedings in order to announce a decision, or to cancel the oral proceedings and issue a decision based on written proceedings.

Citing **T 3/90**, the board in **T 1482/05** decided that the statement not to attend oral proceedings and requesting a decision on the record amounted to a withdrawal of the request for oral proceedings. The appellant/applicant thereby unequivocally expressed that he was interested in an immediate decision on the file as stood and that he did not wish to present his arguments orally in the requested oral proceedings.

However, a party's silence in response to a communication inviting it to state whether it wishes to maintain its request for oral proceedings may not, in principle, be interpreted as a withdrawal of the request.

In **T 35/92** the board stated that while it was reasonable for the opposition division to expect a response to its communication, which was justified in the interests of keeping the proceedings as brief as possible, there were nevertheless no legal grounds whatsoever for interpreting silence on the part of the appellants as withdrawal of the

subsidiary request for oral proceedings. A request within the meaning of Art. 116(1) EPC 1973 could only be withdrawn by a declaration to that effect.

In **T 686/92** the appellant's (patent proprietor) silence following a communication from the opposition division, asking whether they were maintaining the request for oral proceedings, had also been interpreted by the opposition division as a withdrawal of that request. The board stated that in the case of an auxiliary request for oral proceedings by a party there was no room for discretion on the part of the opposition division. The board held that the opposition division had no power to issue a decision adversely affecting the party without first appointing oral proceedings. In a similar case (**T 795/91**) the board added that a withdrawal required an unambiguous expression of the party's wish to withdraw (see also **T 766/90**, **T 879/92**).

In **T 1042/07** the board stated that in the absence of anything that can be regarded as a statement of grounds of appeal, the lack of any substantive response to a notification of the inadmissibility of the appeal is considered as equivalent to an abandonment of a request for oral proceedings initially made in the notice of appeal.

2.3. Further oral proceedings before the same department

According to Art. 116(1), second sentence, EPC the EPO may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same. In **T 298/97** (OJ 2002, 83) the board observed that as a matter of law, the right to oral proceedings was not to two oral proceedings on the same subject. Any further oral proceedings on the issue of admissibility would therefore be a matter for the board's discretion.

In **T 194/96** the board stated that the discretionary power to reject a request for further oral proceedings before the same department is limited to the case "where the parties and the subject of the proceedings are the same". In the case in question, after the first oral proceedings new citations were submitted which were more pertinent than the documents on file and which could and in fact did radically change the nature of the decision. The board held that in such a case the subject of the proceedings within the meaning of Art. 116 EPC 1973 could no longer be the same (see also **T 441/90**).

In **T 731/93** the board stated that where fresh evidence had been admitted into the proceedings, the "subject" of such proceedings, as construed by reference to the text of Art. 116(1) EPC 1973 in all three official languages, could no longer be the same. In this case the refusal of a request for further oral proceedings constituted a substantial procedural violation.

In the following cases a request for further oral proceedings was rejected:

In **T 298/97** the appellant had had ample time and opportunity for over three years to prepare and present its arguments and indeed was, at its own request, given the further opportunity following the oral proceedings to submit evidence on the very issues raised at the oral proceedings. However, since the appellant was not able to overcome its own

inadmissibility difficulty, no further proceedings, whether written or oral, were required. An opportunity for clarification having been given and no issue requiring further proceedings having resulted, the request for further oral proceedings was refused.

In **T 748/91** the board considered that in the case in point no substantially new situation had arisen with regard to Art. 116(1), second sentence, EPC 1973 to justify further oral proceedings (see also **T 692/90**, **T 755/90**, **T 25/91** and **T 327/91**). In **T 547/88** too the board rejected the request for further oral proceedings since the parties and the subject were the same. The purpose of continuing the proceedings in writing after the first oral hearing was merely to provide further clarification of the same facts.

In **T 614/90** the board did not consider further oral proceedings expedient. The opportunity to comment in writing on the board's reasons for refusing further oral proceedings was also rejected because the reasons for the refusal had been given to the respondent in a communication.

In **T 529/94** the board ruled that refusal had not constituted a procedural violation. Indeed, in the board's opinion as expressed in this case, the examining division, in exercising its discretionary power under R. 86(3) EPC 1973, had considered newly filed claims 3 and 4 as inadmissible. The legal consequence of this was that claims 3 and 4 were never integrated into the text of the application and never became part of it. For this reason, refusing to hold oral proceedings a second time, during which proceedings it was intended to discuss the allowability of proposed amendments already judged as inadmissible, could not constitute a procedural violation.

2.4. Auxiliary request for oral proceedings

According to the established practice of the boards of appeal, a request for oral proceedings on an auxiliary basis is interpreted as a request for oral proceedings unless the board intends to decide the case in favour of this party (see **T 3/90**, OJ 1992, 737).

In **T 344/88** the appellants requested that oral proceedings be held if the opposition division intended to maintain the patent in whole or in part. The opposition division rejected the opposition as inadmissible without appointing oral proceedings. The board found that while it was true that, in rejecting the opposition as inadmissible, no formal decision had been taken to maintain the patent, this was nevertheless the consequence of the decision. A party's auxiliary request for oral proceedings therefore should not be viewed solely in terms of its wording. In view of the particular importance of the right to present comments in the form of oral proceedings, if it could reasonably be assumed from the wording of the request that oral proceedings were desired, such proceedings should be appointed or, where there were genuine doubts, the extent of the auxiliary request should be clarified by consulting the requesting party.

Although boards repeatedly emphasise the absolute right to oral proceedings a request for oral proceedings has sometimes been interpreted as conditional when the board intends to remit the case to the department of first instance.

In **T 924/91** the appellants requested oral proceedings if the patent were not to be granted on the basis of the written submissions. The board remitted the case to the department of first instance and stated that there was no need to appoint oral proceedings because remittal meant that the decision under appeal was being set aside, not that the application was being refused. The board emphasised that the appellants' conditional request for oral proceedings was a request in the current appeal proceedings and would have no effect in the further proceedings before the examining division. Likewise, in **T 166/91** the board stated that the decision to remit the case to the department of first instance was not to be considered as adversely affecting the appellants, so that no oral proceedings needed to be appointed (see also **T 808/94**).

In their statement of grounds of appeal the appellants in **T 494/92** made an unconditional request for oral proceedings. The board stated that in view of the positive conclusion it had reached regarding the question of inventive step, and in the absence of any other substantive and/or procedural issues, such oral proceedings would serve no purpose. The board thus treated the request as merely conditional.

2.5. Request for oral proceedings in further prosecution proceedings

In **T 892/92** (OJ 1994, 664) the board held that "further prosecution" proceedings on remittal by the board of appeal were to be regarded as a continuation of the original proceedings, particularly where the original interlocutory decision had been set aside by the board and was therefore no longer legally effective. Consequently, the patent proprietors' original request, which had never been withdrawn or amended, became effective again after remittal, so that the opposition division should not have taken a decision adversely affecting the proprietors without giving them an opportunity to present their case orally (Art. 116(1) EPC 1973).

2.6. Request for oral proceedings as a reply to a communication of a board of appeal

In **T 1382/04** the appellant had been invited to file observations on the Board's communication under R. 100(2) EPC. Failure to reply to such an invitation in due time would result in the application being deemed withdrawn (R. 100(3) EPC). Hence, the Board had to ascertain that a reply meeting the requirements of R. 100(2) EPC had been received in due time. If no response qualifying as a reply had been received, the case was no longer pending. The question arose because the appellant had not made any substantive observations on the Board's communication. The Board pointed out that historically, the legal instrument of a deemed withdrawal was introduced for administrative reasons as a means to save resources of patent offices and courts in cases where the applicant or appellant had clearly lost its interest in prosecuting an application. In the present case, the Board considered the request for oral proceedings which was received within the time limit for filing observations as a reply avoiding a deemed withdrawal under R. 100(3) EPC since it could not be assumed that the appellant had lost its interest in the application while requesting oral proceedings at the same time, apparently with a view to present its comments on the Board's arguments orally.

3. Non-appearance at oral proceedings

For the law governing the absence of parties from oral proceedings, see R. 115(2) EPC and - for the boards of appeal - Art. 15(3) RPBA 2007 (OJ 2007, 536, applicable as from 13 December 2007). Art. 15(3) RPBA 2007 is the same as old Art. 11(3) RPBA 2003 (OJ 2003, 61). Concerning non-attendance at oral proceedings before the examining division, see also the notice from the EPO published in OJ 10/2008, p. 471.

3.1. Right to present comments and non-attendance of a party by choice

On the question of whether a decision pronounced against a party who has chosen not to attend oral proceedings may be based on new facts, evidence and/or arguments introduced during those oral proceedings, see Chapter VI.B.3, non-appearance at oral proceedings and the right to be heard.

In **T 917/95** the board held that a patentee who, in inter partes proceedings, filed a new claim but no amended description prior to the oral proceedings before the board of appeal and who failed to attend the oral proceedings could not rely on the board's postponing its ruling simply to permit amendment of the description, even if the new claim was grantable (see also **T 109/02** and **T 181/02**). Concerning those cases where the appellant (applicant) submits new claims after oral proceedings have been arranged and then does not attend those proceedings, see the more recent case **T 1704/06** (ex parte) in which the board arrived at its decision in the light of RPBA 2007.

3.2. Obligation to give notice if not attending oral proceedings

In **T 653/91** the board made the following statement, "If, having been summoned to oral proceedings, a party does not wish to attend such proceedings, both the board (through its Registrar) and any other parties to the proceedings should be notified in writing of this fact as early as possible before the appointed day. Except in special circumstances, telephone communications concerning such matters are inappropriate, especially in inter partes proceedings".

In **T 930/92** (OJ 1996, 191) the board also pointed out that there was an equitable obligation on every party summoned to oral proceedings to inform the EPO as soon as it knew that it would not attend as summoned. This was the case whether or not that party had itself requested oral proceedings, and whether or not a communication had accompanied the summons to oral proceedings. If a party which had been summoned to oral proceedings failed to attend as summoned without notifying the EPO in advance that it would not attend, an apportionment of costs in favour of another party which had attended as summoned could be justified for reasons of equity in accordance with Art. 104(1) EPC 1973.

In **T 692/00** the board held that for the appellant (proprietor) to announce shortly before the appointed date for oral proceedings that it might or might not attend while maintaining its request for oral proceedings could only be an abuse of procedure.

In **T 69/07** the respondent had requested oral proceedings, but did not appear at the oral proceedings at the appointed time. The board noted that, in accordance with Art. 6 of the Code of Conduct of Members of the EPO, of which the representative is obligatorily a member, the members are required to act courteously in their dealings with the EPO. The representative of the respondent had had sufficient time to inform the board of its intended non-appearance at the oral proceedings. This would have avoided keeping the other party and the board first of all courteously waiting for the representative in case he had unintentionally been delayed, and then obliging the registrar of the board to carry out enquiries to establish if the representative intended to attend the oral proceedings. The board referred to **T 954/93**, where the facts were similar to those of the case at issue. The board confirmed the views of that board that the actions of the representative were "reprehensible".

See also chapter VII.C.7.2.2 concerning apportionment of costs.

4. Preparation and conduct of oral proceedings

4.1. Fixing or postponing the date for oral proceedings

The current practice for fixing the date of oral proceedings before the departments of first instance was published in OJ 2000, 456. It has been applicable since 1 November 2000. More recently, the EPO's notice of 18 December 2008 (OJ 2009, 68) adjusted the procedure for changing the date. For the current practice before the boards of appeal, see OJ SE 3/2007, p. 115 (this notice from the Vice-President DG 3 of 16 July 2007 largely supersedes the 2000 notice). These notices use much the same wording.

According to point 2.1 of the notice of 18 December 2008, departments of first instance fix a single date for oral proceedings and do not pre-announce it (for details by department, see the notice). Under point 1 of the 2007 notice, "The boards of appeal fix one single date for oral proceedings. A pre-announcement of the date is not made."

As regards changing the date, point 2 of the 2007 notice (boards of appeal) and point 2.1 of the 2008 one (departments of first instance), drawn from the 2000 notice, state in similar terms that oral proceedings appointed by the EPO will be cancelled and another date fixed at the request of a party only if the party concerned can advance serious reasons which justify the fixing of a new date. The request for another date must be filed as soon as possible after the grounds preventing the party concerned from attending the oral proceedings have arisen, and must be accompanied by a sufficiently substantiated written statement indicating these reasons. As far as the boards of appeal are concerned, a change of date for oral proceedings may exceptionally be allowed at the board's discretion under Art. 15(2) RPBA 2007.

The 2007 and 2008 notices (in point 2.1 and 2.3 respectively) give examples of serious reasons for requesting a postponement, including "a previously notified summons [...]"; "holidays which have already been firmly booked"; "serious illness" Conversely (under points 2.2 and 2.4 respectively), grounds which are not acceptable are, for

instance; a summons to oral proceedings before the EPO or a national court notified after the summons in the relevant proceedings; excessive work pressure.

The 2000 and 2007 notices state that any request to set another date for oral proceedings should indicate why another representative cannot stand in for the one unable to attend.

In **T 1080/99** (OJ 2002, 568) the board had made it clear in a letter sent almost three months before appointed oral proceedings that a request by a party for postponement of the oral proceedings, did not meet all the requirements of the Notice of 2000. The party, instead of attempting to supplement its original request as soon as possible, chose to react to the board's letter only one week before the appointed oral proceedings. The board held that it must be considered that the additional reasons and evidence for the request for postponement and the fixing of a new date for oral proceedings were received too late and that these reasons could therefore not be accepted.

Nevertheless the board made some remarks having regard to the substance of the party's late-filed reasons. Among them the board took the view that a "series of business engagements" was not a reason falling within point 2.3 of the Notice, since business engagements were directly governed and planned by the office of the patent agent or the representative and were not normally affected by "external forces" within the meaning of point 2.3 of the Notice. Moreover according to point 2.4 of the Notice, "excessive work pressure" was normally not acceptable as a ground for postponement of oral proceedings. The board concluded that the late-filed additional reasons were also insufficient within the terms of the Notice.

In **T 1053/06** the reasons given by the appellant/applicant for requesting postponement of the oral proceedings clearly indicated that the appellant had chosen not to pursue this case further and would prefer its patent application to be lost for non-payment of the next renewal fee at a later date rather than by an adverse decision of the board now. Those reasons had to do solely with the convenience of the appellant, which, until it received the board's negative preliminary opinion, had preferred to pursue the appeal proceedings and had indeed itself requested oral proceedings. Against those reasons the board had to consider the interests of the public and of justice. A postponement would unfairly prejudice by delay other appeals pending before the board. Most importantly, it would be unfair on the public for the board, without receiving any reasons from an appellant/applicant, to extend the life of a patent application which it considered likely to fail beyond the date on which the public, until now, had expected a final decision. Accordingly, the board considered the request for postponement had to be refused. The appellant's further request to exclude its request for postponement from the public part of the file was also not allowable.

Art. 10b(3) RPBA 2003 was renumbered Art. 13(3) RPBA 2007 in the revised RPBA which entered into force on 13 December 2007. The text remained unchanged. In **T 427/05**, in a letter dated 3 April 2007 and received on 27 April 2007, the appellant asked for the contested decision to be set aside and for the patent to be maintained in amended form as per its main request or one of 71 new auxiliary requests. The

respondent (opponent) submitted that none of these requests should be admitted into the proceedings; they were late-filed and too voluminous. Failing that, the oral proceedings should be postponed. The oral proceedings took place on 12 June 2007, the board pointing out that, under Art. 10b(3) RPBA 2003, amendments – whatever their possible relevance – requested after oral proceedings had been arranged were not admitted if they raised issues which the board or parties could not reasonably be expected to deal with without postponing the oral proceedings. The admission of 72 late-filed requests was thus at the board's discretion. As regards the request that it postpone the oral proceedings, the board decided there was no reason for that, in view of its decision to admit only those late-filed requests which related (albeit narrowed down in some cases) to the subject-matter which had been central to the discussions from the outset.

4.1.1 Unavailability of a party, representative or expert

In **T 275/89** (OJ 1992, 126) the board considered that the illness of a duly represented party was not a sufficient reason for postponing appointed oral proceedings unless the party who was ill needed to be present. A request to change an appointment could only be allowed if unforeseen, exceptional circumstances had arisen, which either made oral proceedings impossible (such as a representative's or unrepresented party's sudden illness) or could have a decisive impact on the course of the proceedings (such as unforeseen unavailability of an important witness or expert), followed in **T 1923/06**.

In **T 1212/04** the board held that the generally accepted principle that serious illness was a sufficient reason for postponing the date for oral proceedings could not be applied in the present case to the illness of the inventor designated in the application, since the appellant had failed to give any reasons why the inventor's presence at the oral proceedings was necessary or even indispensable, and since, in contrast to the case of a party's representative or an important witness or expert, the inventor's participation was unlikely, in the board's view, to have any impact on the decision.

In **T 37/97**, the board decided that the facts cited in support of the request were neither unforeseeable nor exceptional and therefore did not justify postponement. In cases such as this, where a new representative had been appointed after the summons to oral proceedings had been duly issued, the said representative, before taking on the mandate, could be expected to have made sure he was available on the appointed date or to arrange for alternative representation. Furthermore, a professional representative could be expected to be able to prepare for oral proceedings with all due care within a month unless the case was exceptionally difficult, which it was not.

In **T 693/95** the board decided that it had waited patiently for two years to give the appellants time to find a legal representative of their choice. This they had failed to do. After such a long delay there was no valid reason for postponing oral proceedings; for reasons of equity, the board was obliged to take into account not only the appellants' interests but also those of the respondent and the public, which had an interest in knowing as soon as possible the exact extent of protection of the contested patent.

In **T 664/00** the appellant (patent proprietor) had requested an adjournment of oral proceedings in order to allow them to be attended by an expert from the United States, which would not have been possible on the date appointed by the board since this was a public holiday in the USA. The board rejected the request for the following reason. National holidays in individual contracting states are not recognised by the EPO for practical reasons. To allow for national holidays in non-contracting states throughout the world would be even less practical. To allow for such holidays in just one country would discriminate against parties from other states.

In **J 4/03** the board decided that the desire of the appellant to be present himself at oral proceedings did not in itself amount to a serious ground for postponing the oral proceedings to a date on which the appellant could be present, in the absence of other special circumstances. The present appeal against the decision of the department of first instance turned essentially on how the law was to be applied to facts which were not in dispute, and so the presence or absence of a party who was duly represented in the proceedings should have no impact on the course of the proceedings or the final decision.

In **T 1067/03** the respondent's representative requested that the oral proceedings be postponed because of a prior appointment for a medical operation. The representative said that his client was opposed to a change of representative on the grounds that, in addition to the appeal in question, a further opposition and a patent infringement case were pending which together formed an intricate ensemble. In the board's opinion, these circumstances justified postponing the oral proceedings.

The board in **T 1102/03** applied Art. 15(2) RPBA 2007 and articles of the Notice of 2000 (confirmed by that of 2007) in a case where the appellant/patent proprietor's initial request for postponement of the oral proceedings was occasioned by holidays booked by its representative. He was of the opinion that this fact on its own justified a postponement. In the board's view, however, while a holiday was a possible valid basis for a request, it was not necessarily a sufficient reason for postponement. All circumstances of the case and all the criteria referred to in the Notice had to be taken into account by the board when exercising its discretion. This case presented circumstances which entailed a special organisational burden: - eleven parties were involved at the beginning of the appeal procedure; - an extended board of appeal was involved; - one of the largest rooms usable for oral proceedings was booked for two days and it would have been difficult to make substitute arrangements within a reasonable period (see point 1.1 of the Notice). The board judged that the effort of postponing fixed oral proceedings until a date might be found which would suit numerous parties, the members of an extended board, and the facility management of the EPO, outweighed the effort of postponing or interrupting one representative's holiday booked to a destination within Europe. A strict standard was to be applied under these circumstances because a liberal approach might give rise to a series of postponements. The requirement of procedural economy could have been met if an alternative pair of dates had been found on which all parties had agreed explicitly and members and rooms had been available. As such an agreement was not reached, the board, for the sake of

procedural economy, maintained the original pair of dates (the second day to be used only if necessary).

In **T 601/06** the board considered the request to postpone the oral proceedings to be late filed. The representative should have been aware when receiving the summons that he would be prevented from attending the oral proceedings and should have filed his request immediately. Filing the request more than one month later was not considered to fulfil the requirement of "as far in advance of the appointed date as possible" as required under Art. 15(2) RPBA or "as soon as possible" as required in the Notice of the Vice-President of DG3. The board noted that, in accordance with established case law (see e.g. **T 1102/03** and **T 1053/06**), the provisions of Art. 15(2) RPBA and the above-mentioned Notice balance the interests of the parties and the public taking into account, among other factors, an efficient use of resources and capacities of the office. Thus, a request for postponing the date of oral proceedings may be refused if it is late filed.

In **T 601/06** and **T 869/06** the boards offered an alternative date within a period of about two months from the date of the request in view of the balance of interests of the parties and the public. It was stated that the period of about two months arose from the fact that, except for when the parties consent, new summons had to be issued at least two months in advance of a hearing, so that dates within the two-month period from the date of the request could not be used for other cases.

In **T 1505/06**, three days before oral proceedings before an opposition division, the appointed representative of the proprietor fell ill and postponement of the oral proceedings was requested. On the day before the oral proceedings, the division informed the parties that the hearing would not be postponed. At the start of the oral proceedings, the proprietor's replacement attorney again requested that they be postponed due to the illness of the appointed representative. The opposition division refused the request. The board noted that the request for postponement contained all the elements necessary to allow the opposition division to decide whether or not to postpone the oral proceedings (see Notice of VP 2 and VP 3, OJ 2000, 456). When deciding whether or not to postpone oral proceedings the opposition division might have to take into account a number of factors. These factors might include the proximity of the filing of the request to the oral proceedings, the complexity of the case, the availability of an alternative representative capable of preparing the case in the remaining time available and the effects of a postponement on any other party. The opposition division would have to weigh up these factors when exercising its discretion in coming to a decision. The board noted that if a party was placed in such a position that its representative did not have sufficient time to prepare its case then the right to be heard had not been respected. This would have been a substantial procedural violation. However, the lack of reasoning in the decision under appeal meant that the board was not able to decide whether the proprietor's right to be heard had been respected and hence whether or not a substantial procedural violation had been committed. The board remitted the case to the opposition division for further prosecution. It held that the failure of the opposition division to include in its decision its reasons for refusing the request for postponement was a substantial procedural violation, and that reimbursement of the appeal fees of both the proprietor and the opponent was therefore justified.

4.1.2 New evidence

In **J 4/03** the board held that the desire of an applicant to file unspecified new evidence at an unspecified future date could not amount to a serious reason for postponing oral proceedings. Even in ex parte proceedings the appellant had to attempt to file any facts or evidence he wished to rely on before the set date of oral proceedings so that the board could exercise its discretion under Art. 114(2) EPC 1973 whether to admit the further evidence or not, on the basis of the relevant material.

In **T 881/95** the request for postponement was refused because the evidence, which could only have been provided later, was not such as to affect the decision.

4.1.3 Proceedings before a national court

In **T 392/97** the board ruled that the **subsequent** appointment of oral proceedings by a national patent court to take place on the same date as the previously appointed oral proceedings before the board was not in itself a sufficient reason for adjournment. A request to postpone an appointed and agreed date could only be allowed in the case of "unforeseen and exceptional" circumstances. "Exceptional" could be construed as meaning those circumstances which either made it impossible for the oral proceedings to take place or might have a material bearing on the course and outcome of the proceedings. (See also OJ SE 3/2007, point 2.2, p. 116.)

4.2. Curtailment of notice in the summons

Under R. 71(1), second sentence, EPC 1973 the notice given in the summons to oral proceedings must be at least two months, unless the parties agree to a shorter period. This rule is now R. 115(1), second sentence, EPC but otherwise unchanged.

In **J 14/91** (OJ 1993, 479) the board ruled that a dispute about a third party's right to inspect the application dossier before publication had to be decided promptly (i.e. before publication), otherwise Art. 128(2) EPC 1973 became null and void. If oral proceedings would facilitate a prompt decision, the summons under R. 71(1) EPC 1973 could give shorter notice - even without the other party's agreement - provided the parties were given enough time to prepare. The board referred to Art. 125 EPC 1973 and stated that in the case of a request for inspection of files to which the applicant objected, oral proceedings were the best way to give the parties a comprehensive and swift hearing. Although the Convention did not itself make any provision for urgent cases, it was a generally recognised principle of procedural law in the contracting states that notice could be curtailed in urgent cases. The degree of curtailment should be decided on a case-by-case basis.

In **T 111/95** the board stated that the examining division had no right simply to set a date for oral proceedings about two weeks after despatch of the summons. The board found that there was nothing on file to establish that the applicants' representative, at any time and unconditionally, accepted the date set. The board thus held that the summons was null and void, as were the actions following and resulting from it. The case was therefore

remitted to a department of first instance in a different composition for resumption of the proceedings at the stage preceding the invalid act.

In **T 772/03** the summons to oral proceedings did not comply with the requirement to give at least two months' notice. The board observed that the onus of proving that an agreement for a shorter notice period was reached lies with the examining division as the party making the claim (following **T 111/95**). The board noted that the minutes of the oral proceedings did not prove that the representative had agreed to a shorter period of notice, and that the file contained no evidence that the representative and the examining division had ever discussed a shorter notice period. The examining division had thus failed to prove that an agreement on a shorter notice period had been reached.

4.3. Communication under Article 15(1) RPBA

New Art. 15(1) RPBA 2007 reads as follows: "If oral proceedings are to take place, the Board may send a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other observations that may help concentration on essentials during the oral proceedings."

Under the EPC 2000, the provision applicable since 13 December 2007 is Art. 15(1) RPBA 2007, formerly numbered Art. 11(1) RPBA 2003 but otherwise unchanged. Under Art. 11(1) RPBA 2003 the board may, if oral proceedings are to take place, send a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other observations that may help concentration on essentials during the oral proceedings. Art. 11(1) RPBA entered into force on 1 May 2003 and replaces the previous Art. 11(2) RPBA (cited hereafter as "Art. 11(2) RPBA (previous version)"). The only difference between the two articles is that according to Art. 11(1) RPBA 2003 a communication no longer needs to be sent **with** the summons to oral proceedings. The change aims to give the board the possibility to decide not only whether but also when to send a communication before the oral proceedings. The case law on Art. 11(2) RPBA 1980 thus remains applicable in all other respects.

In **T 614/89** it was pointed out that a communication in accordance with Art. 11(2) RPBA 1980 preparatory to the oral proceedings, in which the board presented its provisional assessment of the facts, was by no means binding and ought not to be interpreted by any party as meaning that the proceedings were pointless. Rather, that party had an absolute right to have the case discussed at the oral proceedings. The communication in accordance with Art. 11(2) RPBA 1980 was a snapshot, intended to clear up certain points of controversy in advance and accelerate the proceedings, as well as to encourage the parties to come up with further and sounder arguments in order to provide a reliable basis for the decision.

By a decision dated 13.12.1994 the Administrative Council introduced R. 71a EPC 1973 concerning the preparation of oral proceedings. R. 71a EPC 1973 provided as follows: "When issuing the summons, the EPO shall draw attention to the points which in its

opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed..." (OJ 1995, 9).

In **G 6/95** (OJ 1996, 649), on a referral in **T 276/93** (OJ 1996, 330), the Enlarged Board ruled that R. 71a(1) EPC 1973 did not apply to the boards of appeal, which thus continued to have discretion as to whether or not to send a communication when issuing a summons to oral proceedings, as provided for in Art. 11(2) RPBA 1980. The mandatory procedural requirements of R. 71a(1) EPC 1973 applied to the EPO's departments of first instance but not to the boards, because the Administrative Council could not amend the Implementing Regulations in such a way that the effect of an amended rule was in conflict with the RPBA - adopted under Art. 23(4) EPC 1973 by the Presidium of the boards of appeal and approved by the Council as reflecting the boards' independence.

4.4. Interpretation and application of Rule 116 EPC (former Rule 71a EPC 1973)

Old R. 71a EPC 1973 is now R. 116 EPC, unchanged apart from a renumbered reference (to R. 132 EPC instead of R. 84 EPC 1973) and some editorial amendments in the French version. The case law cited below relates mainly to R. 71a EPC 1973. For recent case law citing R. 116 EPC, see e.g. **T 133/06**. See also chapter VII.C.1, late submissions.

R. 71a EPC 1973 stipulated, inter alia, that, when the EPO issues the summons to oral proceedings, a final date for making written submissions in preparation for the oral proceedings must be fixed. New facts and evidence submitted after this date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed. The same is true for applicants or patentees invited under R. 71a(2) EPC 1973 to submit documents which meet the requirements of the EPC.

In **G 6/95** (OJ 1996, 649) the Enlarged Board of Appeal held that R. 71a(1) EPC 1973 did **not** apply to the boards of appeal. However, in **T 97/94** (OJ 1998, 467) the board ruled that if a board decided to send the parties a communication under R. 71a(1) EPC 1973, the parties were obliged to comply with it, particularly as regards the deadline for reply. R. 71a(1) EPC 1973 was thus binding on the parties.

In **T 452/96** the board emphasised that fixing a time limit under R. 71a EPC 1973 was not to be taken as an invitation to submit further evidence (see also **T 39/93**, OJ 1997, 134, and **T 885/93**) and therefore had no impact on the EPO's power to disregard late-filed documents (see also **T 476/96**). With respect to "new arguments", see **T 131/01**, **T 624/04** and **T 926/07**.

4.4.1 Examination and opposition proceedings

The recent decision **T 343/08**, which cites **T 755/96** extensively, includes very detailed findings on R. 71a EPC 1973. See also Chapter VII.C.1., in particular **T 214/01**, **T 131/01** and **T 926/07**.

In **T 755/96** (OJ 2000, 174) the board observed that R. 71a EPC 1973 gave the EPO a discretionary power. The EPO's power to accept or refuse late-filed new facts or evidence was in fact governed by Art. 114(2) EPC 1973, and the discretionary power to refuse new requests for amendments was governed by Art. 123 EPC 1973 and the corresponding Implementing Regulations.

As to the exercise of discretion under R. 71a EPC 1973 regarding amendments, the board held that the discretion was to be exercised by considering all relevant factors which arose in a particular case and by balancing the applicant's interest in obtaining proper patent protection for his claimed invention and the EPO's interest in bringing the examination procedure to a speedy close by the issue of a decision (following **G 7/93**, OJ 1994, 775).

In **T 755/96**, in the board's view it was important to draw a **distinction** between the **application stage** and the **opposition stage**. The reasons given for introducing R. 71a EPC 1973 made it clear that a particular concern was that in opposition proceedings other parties were not taken by surprise. Parties to opposition proceedings were often represented by professional representatives, who would need to consult their clients and technical experts for further instructions to deal with new requests or evidence. Thus there could be good reasons to refuse material filed after the final date set under R. 71a EPC 1973, or to postpone oral proceedings.

However, the same considerations did not apply to an examining division entrusted with substantive examination, since it had its own technical expertise and did not have to obtain instructions from third parties. If prepared for oral proceedings, it should normally, even in relation to requests filed at the oral proceedings, be in a position to assess whether a new request was clearly not allowable under the Convention and to decide on the basis of this finding not to admit such a new request into the proceedings. An examining division which in exercising such discretion does not admit amended claims must give the reasons therefor. The assessment that they were filed too late under R. 71a EPC 1973 did not represent adequate reasoning in accordance with R. 68(2) EPC 1973.

In **T 712/97** the respondent (opponent) filed a report on comparative experiments on the last day of the period set for filing comments pursuant to R. 71a(1) EPC 1973. The opposition division allowed this experimental report into the proceedings, but not the appellant's experimental report in response thereto. The board held that allowing the respondent's report into the proceedings did not amount to a procedural violation. However, it considered that admitting the respondent's experimental report into the proceedings meant that the subject of the proceedings had changed within the meaning of R. 71a(1) EPC 1973 and that the appellant's experimental report should therefore also have been admitted into the proceedings as a response to the respondent's experimental report. That the appellant's report would not affect the outcome of the proceedings was in these circumstances not a consideration that should have been taken into account when deciding on its admission into the proceedings. A party was entitled to know that its response was part of the documents admitted into the proceedings, even if it proved not to be decisive for the outcome before that instance.

In **T 484/99** the appellant (patentee) alleged that the refusal, under R. 71a EPC 1973, by the opposition division to consider or even look at amendments to the requests presented on the day of the oral proceedings before them amounted to a procedural violation. The board disagreed because it was clear from the wording of R. 71a(2) EPC 1973, that submissions by the proprietor presented after the final date did not need to be considered. In **T 64/02** the board referred to the case law of the boards of appeal holding that the opposition division's discretion to disregard submissions filed too late also covered amended claims presented after the final date fixed under R. 71a EPC 1973. R. 71a(2) EPC 1973 thus also applied to the belated submission of amended patent claims in an auxiliary request, even if those claims had not been requested in the summons (see also **T 1105/98** referred to further below).

In **T 951/97** (OJ 1998, 440), the board considered the application of the rule to the examining division. It held that the subject of the proceedings was changed within the meaning of R. 71a(1) and (2) EPC 1973, *inter alia*, where the examining division itself introduced a new document, which was pertinent new material, into the proceedings for the first time during oral proceedings convened following a R. 71a EPC 1973 notification.

In **T 765/06** the examining division had pointed out in the summons to oral proceedings that preparatory submissions and new claims should not be filed later than one month before the date of oral proceedings. Six days before the oral proceedings, the applicant filed new requests which the rapporteur, in a telephone conversation with the applicant, regarded as non-protectable and which were not admitted in the oral proceedings pursuant to R. 71a EPC 1973. The board found that conceding permission to file new claims did not comprise an assurance that such claims would be considered in the proceedings, with a considerable restriction of the time available for examination. The board explained that, to safeguard the legal form of the patent grant procedure and ensure that decisions were taken with due care, the examining division could not readily dispense, in advance and without knowledge of the matter to be considered, with the time required to prepare for oral proceedings.

In **T 798/05** the board did not accept the respondent's argument that R. 71a EPC 1973 constituted an absolute bar on late submissions in opposition proceedings, thus ruling *prima facie* examination. It found that R. 71a EPC 1973 did not override or restrict the principle of *ex officio* examination enshrined in Art. 114(1) EPC 1973, since an implementing regulation ranked lower than an EPC Article. The board also pointed out that even the actual wording of R. 71a EPC 1973 did not support any such interpretation in any of the three official languages, as the expressions "brauchen, need not, peuvent" all left room for discretion over the admission of late submissions. The purpose of R. 71a EPC 1973 was simply to provide the European Patent Office with a case management framework for the preparation of oral proceedings. In an *ex parte* case the board stated that the requirement of R. 116 EPC does not mean that already in the communication all lines of arguments or a detailed reasoning for the decision should be set out (**T 462/06**).

4.4.2 Appeal proceedings

The relevant case law on R. 71a EPC 1973 (now R. 116 EPC) in appeal proceedings concerned R. 71a(2) EPC 1973 only, as R. 71a(1) EPC 1973 did not apply to the boards of appeal (see **G 6/95**, but also **T 97/94**, cited above). See also Art. 13 RPBA 2007.

The board in **T 1105/98** explained that R. 71a(2) EPC 1973 was applicable to proceedings before the boards of appeal. In the case in question, the patent proprietor's auxiliary request with amended claims was presented at the start of the oral proceedings, i.e. after expiry of the time limit set in the summons to oral proceedings. The respondent (opponent) argued that the auxiliary request should be refused as being out of time.

The board examined whether the auxiliary request could be refused as being out of time on the basis of R. 71a(2) EPC 1973, and decided that this provision also applied to the late submission of amended claims by way of an auxiliary request, even if the summons to oral proceedings had not contained an invitation to submit them. If the patent proprietor only submitted amended claims at the oral proceedings, the board could use its discretion to disregard them, particularly if the facts of the case had remained the same and further investigation was necessary to assess the lack of patentability alleged as grounds for opposition (see also **T 681/02**; **T 494/04**).

In **T 401/02** the board of appeal did not admit into the proceedings the appellant's amended claims, which were presented for the first time at the oral proceedings, even though the factual position had not changed. The admission of new requests on the basis of amended patent claims which are submitted by the patent proprietor only at the oral proceedings despite a final date having been set in the summons for the submission of such requests is distinctly limited in opposition appeal proceedings by R. 71a(2) EPC 1973 and the case law that has evolved on this provision. The board held that the admission of the request would normally have to be refused if the board or one of the parties to the appeal proceedings could not be expected to study the amended claims without postponement of the oral proceedings.

4.5. Location of oral proceedings

In **T 1012/03** the applicant, having been summoned to oral proceedings before the examining division in The Hague, had requested that oral proceedings take place in Munich instead. The examining division held oral proceedings in The Hague in the absence of the applicant and refused the European patent application. The applicant appealed against this decision. The board noted that Art. 116 EPC 1973 did not expressly stipulate the location where oral proceedings had to take place. The various expressions used in paragraphs 1 to 4 of Art. 116 EPC 1973, such as "before the same department", "before the Receiving Section, the examining divisions and the Legal Division", could be read as a reference to the function of the department or division as a deciding body. If the relevant department had to exercise its function in oral proceedings, it followed that a department had to be located at a specific place in order to conduct oral proceedings. Thus the word "before" in the above expressions also implied a location

"where" the proceedings had to be carried out. The board went on to examine whether the President had the power to establish examining divisions in The Hague and concluded that such a power was provided for by Art. 10(1), (2)(a) and (b) EPC 1973. The board concluded that in the case in point the justification for conducting oral proceedings in The Hague could be deduced from Art. 116 EPC 1973 in conjunction with Art. 10(1), (2) (a) and (b) EPC 1973.

In **T 1266/07** the appellant/applicant requested that the oral proceedings be conducted by video conference. The board refused the request as being filed late and stated that in future such a request might be allowed. For this to happen, however, it would be necessary for a general framework to exist. Firstly, video conferencing before an Examining Division is explicitly regulated (see Updated information concerning interviews and oral proceedings to be held as a video-conference, OJ 2006, 585ff.). There is, however, at present no corresponding provision for the boards of appeal; in particular, it is not mentioned in the RPBA. Secondly, oral proceedings held before the Examining division are, in accordance with Art. 116(3) EPC, not public, whereas those before the boards of appeal are public, Art. 116(4) EPC. It would be necessary to ensure that the use of video conferencing is reconciled with the requirement that oral proceedings before the boards be public.

4.6. Computer-generated presentations

In **T 1122/01** the board of appeal had to decide on the admissibility, during oral proceedings, of a PowerPoint presentation which did not communicate any new facts. The board explained that a PowerPoint presentation was essentially a written presentation of information, thus enabling a party to present written arguments in addition to its oral statements. It could also be a way of introducing new means of evidence, or it could lead to a completely new and unexpected presentation of the case by a party. There was therefore a risk of the other parties being caught unawares by this, of new procedural issues being raised, and of the oral proceedings becoming protracted.

The board explained that the principles relating to the use of visual aids such as flip charts should also be applied to PowerPoint presentations. A party wishing to use such a presentation should announce this intention early enough before the oral proceedings and should send both the board and the other parties a copy. Any objections could then be raised and considered at the oral proceedings before the presentation was given, and a decision could be made if need be.

In **T 1110/03** (OJ 2005, 302) the board of appeal considered the objection of the appellant (patent proprietor) to the manner in which one of the opponents was permitted to argue his case at oral proceedings before the opposition division by means of an hour-long computer-generated slideshow presentation containing many complex slides. The board concurred with the view expressed in decision **T 1122/01** that there was a danger of a degree of unfairness creeping in in the unrestricted use of computer-generated slideshow presentations in oral proceedings. This potential unfairness could be mitigated by providing the other parties and the division or board with copies of the material to be presented in good time before the oral proceedings.

A computer-generated slideshow presentation is, in principle, not distinguishable from other presentations using more conventional technology such as flip-charts or overhead projectors. The board in **T 555/06** stated that the practice mentioned in **T 1110/03** placed certain restrictions on the timing of a party's preparation for oral proceedings but had no influence on the content. In the present case the opponent's representative informed the opposition division prior to the oral proceedings that the computer-generated slideshow presentations would contain only information which was already in the file and therefore would act only as a visual aid. Nevertheless, the opponent failed to respect the opposition division's instruction to file a copy of the content in advance. In the light of the concerns raised in **T 1110/03**, the division's action in refusing the presentation was both entirely understandable and reasonable. This could not have influenced the content of the information to be presented if the refused presentation had indeed been limited to the existing content of the file. Moreover in view of the failure to comply with the opposition division's instruction to file a copy of the content in advance the opponent's representative was not taken by surprise by the division's action during the oral proceedings. There was thus no infringement of the opponent's right to be heard.

In **T 373/05**, a few days prior to oral proceedings before the board the appellant/proprietor asked for a screen for showing PowerPoint® slides at the hearing, without however saying what the slides were about. At the start of the oral proceedings, it distributed paper versions of the slides, setting out arguments about the admissibility of Respondent I's opposition and regarding sufficiency of disclosure. The board took the view that since they contained no new facts, their late submission was no reason to disregard them under Art. 114(2) EPC 1973. On the contrary, it felt that presenting the appellant's arguments visually on paper had also helped the respondents to prepare their responses. It therefore allowed the appellant to show the slides.

In the board's view in **T 1556/06**, the Opposition Division has discretion as to the way oral proceedings were conducted. It was not a wrongful exercise of this discretion, and thus not a procedural violation, to refuse to allow a party to use a PowerPoint presentation during oral proceedings if the party was not thereby prevented from presenting its arguments orally.

4.7. Minutes of oral proceedings (Rule 124 EPC)

For the amendments made to old R. 76 EPC 1973, see the section in OJ SE 5/2007 on R. 124 EPC.

In **T 642/97**, the board considered basic principles concerning the minutes. According to R. 76 EPC 1973 these should contain "the essentials of the oral proceedings ... and the relevant statements by the parties...". It stressed that this provision did not require that the minutes reflect the full arguments of the parties. It was within the discretion of the minute-writer to decide what he considered "essential" or "relevant" (see **T 212/97**). Whereas minutes were required to contain the requests or similarly important procedural statements, most of the arguments concerning patentability were normally apparent from the previous written submissions or from the facts and submissions in the written decision and did not need to be contained in the minutes. Nevertheless, if a party was of

the opinion that the minutes were incomplete or wrong, since essential submissions were not reflected at all in the file, it might request the opposition division to correct the minutes to preserve its rights (**T 642/97**; **T 231/99**; **T 898/99**; **T 838/92**; **T 68/02**; **T 937/07**; see also especially cases **R 8/08** and **R 14/09** (point 4 of the Reasons) for the importance of the minutes in the review procedure).

In **T 231/99** it was held that the board's responsibility for the decision on the validity of the patent did not extend to deciding on the accuracy of the minutes of first instance proceedings (see also **T 1198/97**). In **T 508/08** the board stated that if the department of first instance (opposition division) saw fit to ignore its obligations (to respond to a request for correction of the minutes) there was nothing the board could do; it had no power to compel the division to fulfil them. In **T 212/97** the board explained that only decisions could be contested. Since the minutes of oral proceedings were neither a decision nor part of the decision, they could not be "annulled" by the board of appeal (as already established in **T 838/92**). A procedural violation could only be said to have occurred if the limits of the minute-writer's discretion as to what he considered "essential" or "relevant" were overstepped, e.g. if a party's unambiguous statement of surrender were omitted from the minutes. **T 928/98** specified that what was particularly relevant were the specific requests and statements with an impact on the definition of the subject-matter, such as statements of surrender or abandonment of subject-matter.

In **T 1063/02** the board held that it could not order the amendment of the opposition division's minutes of oral proceedings unless they manifestly and definitely differed from the actual course of the proceedings.

In **T 396/89** there was disagreement between the parties as to whether the appellant had or had not made a concession on a particular point before the opposition division. There was no record of this in the minutes of the proceedings. The board stated that if a clear concession was made during oral proceedings, the opposition division was entitled to base its decision on that concession, unless it was convinced that the facts conceded were not true. However, if an important matter of fact was conceded, that concession ought to be carefully recorded in the minutes of the hearing.

In **T 740/00**, the appellant informed the opposition division of its opinion that the minutes did not reflect the actual conduct of the proceedings. Instead of examining whether the minutes actually fulfilled the requirements of R. 76(1) EPC 1973 and then deciding whether or not to correct them, the opposition division argued in essence that the minutes were correct because the minutes said so. The board considered such a reasoning circular and thus as not fulfilling the requirements of R. 68(2) EPC 1973, which required decisions of the EPO to be reasoned. This constituted a procedural violation (see also **T 819/96**).

In **T 263/05** (OJ 2008, 329), the board held that the minutes of oral proceedings before the boards of appeal should record the requests of the parties on which a decision of the board is required, such as the allowability or otherwise of the appeal, the form in which the proprietor seeks maintenance of the patent, requests for remittal of the case or relating to appeal fees or costs. The minutes should also record specific statements

which have an impact on the definition of the subject-matter, such as statements of surrender or abandonment of subject-matter, where these are relevant to the decision to be taken. The arguments of the parties should not be recorded in the minutes, nor should statements or admissions made in oral proceedings which a party considers will be of use to it in any subsequent proceedings in national courts but which have no bearing on the decision which the board is required to make, such statements or admissions neither constituting "essentials of the proceedings" nor "relevant statements" within the meaning of R. 76(1) EPC 1973.

According to **T 928/98**, **T 263/05** (OJ 6/2008, p. 329; including very detailed findings on R. 76 EPC 1973, p. 372 ff) and **T 61/07** it is not the function of the minutes to record statements which a party considers will be of use to it in any subsequent proceedings in national courts, for example in infringement proceedings as to the extent of protection conferred by the patent in suit. This is because such statements are not "relevant" to the decision which the board has to take, within the meaning of R. 124(1) EPC. Such matters are within the exclusive jurisdiction of the national courts. On this basis the board in **T 550/04** concerning the opponent's request to record in the minutes that the expression "oxygen-free atmosphere" in claim 1 had the meaning of "completely oxygen-free atmosphere" stated that this statement would not have an impact on the definition of the subject-matter of the patent for the questions the board had to decide and was thus not proper subject-matter for the minutes. The board therefore refused the request. Concerning requests for incorporation of statements of parties in the minutes, see also **T 966/99**, **T 468/99**, **T 957/99**, **T 459/01** and **T 550/04** citing R. 124 EPC.

4.8. Costs

4.8.1 Apportionment of costs

The failure of a party to submit new and substantial arguments at oral proceedings does not as a rule lead to a different apportionment of costs pursuant to Art. 104 EPC. In certain cases, however, e.g. if a party withdraws a request for oral proceedings, asks for their postponement, fails to turn up or makes abusive use of them, a different apportionment of costs may be ordered in accordance with Art. 104 EPC (see Chapter VII.C.7.2). The costs issue is addressed more specifically by Art. 16 RPBA 2007 (OJ 2007, 536), formerly Art. 11a RPBA 2003 (OJ 2003, 61) which refers specifically to Art. 104(1) EPC. Under Art. 16 RPBA 2007, the board "may on request order a party to pay some or all of another party's costs which shall, without limiting the board's discretion, include those incurred by any ... acts or omissions prejudicing the timely and efficient conduct of oral proceedings" (see e.g. **T 53/06**).

4.8.2 Interpreting costs during oral proceedings

Under R. 4(1) EPC, formerly R. 2(1) EPC 1973, "any party to oral proceedings before the European Patent Office may use an official language of the European Patent Office other than the language of the proceedings, if such party gives notice to the European Patent Office at least one month before the date of such oral proceedings or provides for

interpretation into the language of the proceedings" (see also Communication dated 16 July 2007, OJ SE 3/2007, p. 118).

In **T 473/92** the respondents asked the EPO, three days before the oral proceedings, to arrange for and bear the cost of interpreting services. According to the respondents, the period of one month stipulated in R. 2(1) EPC 1973 had not been observed because the EPO had failed to issue a corresponding invitation - they submitted that the EPO ought to have drawn their attention to the period of notice mentioned in R. 2(1) EPC 1973. The board, however, decided that the respondents had to bear the costs of interpreting at the oral proceedings. If the parties were being offered a free interpreting service, the EPO should at least be enabled to minimise its costs by having sufficient time to organise the interpreting efficiently. Obviously, only the EPO could assess how much preparation time was needed. Nor was the EPO under any obligation to draw the respondents' attention to the notice period of one month. A professional representative before the EPO was supposed to be familiar with both the Convention and its Implementing Regulations.

In **T 44/92** the board came to the conclusion that if a patent proprietor with several appointed representatives chose to use another official language for the oral proceedings in addition to the language of proceedings, the EPO would not bear the costs of interpreting (R. 2(1) and (5) EPC 1973) (see also **T 774/05**, **T 131/07**).

5. Non-public oral proceedings

In **T 1401/05** the board excluded the public from that part of the oral proceedings which concerned the exclusion of certain documents from file inspection. Under Art. 116(4) EPC, oral proceedings shall in principle be public in so far as the board does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings. The board held that as the debate dealt with the request for exclusion of certain documents from file inspection, which had been excluded provisionally, the public could not be admitted to the hearing on this point. Otherwise the purpose of the provisional exclusion would have been frustrated. In such a situation, the danger of serious and unjustified disadvantages had to be deemed to exist.

6. Presence of assistants during deliberations of the board

According to Art. 19(1), second sentence, RPBA 2007 only members of the board may participate in the deliberations; the chairman may, however, authorise other officers to attend. In **T 857/06** the board stated that in several EPC contracting states the judicial work of courts, in particular supreme courts and constitutional courts, is supported by assistants. Also the active involvement of assistants in preparing the ground for judicial decisions appeared to be widely accepted. In accordance with this practice, a limited number of assistants supports the EPO's boards of appeal. They are selected in a formal internal recruitment procedure for which only experienced examiners, i.e. permanent employees of the EPO, may apply. The board concluded that the discretion under Art. 19(1), second sentence, RPBA 2007 may be exercised to allow the board's assistant to attend and to take part in the deliberations.

D. Time limits, further processing and interruption of proceedings

1. Calculation, determination and extension of time limits

1.1. Calculation of time limits under Rule 131 EPC

R. 131 EPC differs from the previous version (R. 83 EPC 1973) only to the extent that there are slight drafting changes (see OJ SE 5/2007).

In **J 14/86** (OJ 1988, 85) the Legal Board of Appeal made the following ruling on the calculation of time limits under R. 83 EPC 1973 - the fact that R. 83(2) EPC 1973 fixed the point in time from which all the time limits ran and defined this point as the day following that on which the event giving rise to the time limit occurred, could not be interpreted as requiring the addition of a day to time limits expressed in years, months and weeks, hence the grant of an additional day for reasons of equity. The expiry date of time limits expressed in years, months or weeks was derived from R. 83(3) to (5) EPC 1973. These paragraphs, in conjunction with paragraph 2 of the same rule, established unequivocally that the time limits were fixed in full years, months and weeks, without any possibility of their being reduced or extended (see also **J 9/82**, OJ 1983, 57).

The calculation of time limits under R. 80 PCT was identical, but its wording largely avoided the lack of clarity found in R. 83 EPC 1973.

In **J 13/88** the Legal Board of Appeal gave an example of how to calculate time limits with reference to the above-cited case law. In the case in question the 12-month priority period had to be calculated. The event representing the point in time from which a time limit started to run was the filing date of the application in respect of which priority was claimed, which was 5.5.1986. The period referred to in Art. 87 EPC 1973 was expressed in months; it expired in the relevant subsequent month (i.e. in this case May 1987) on the day which had the same number as the day on which the said event occurred, which was 5.5.1987 (R. 83(2) EPC 1973 in combination with R. 83(4) EPC 1973).

T 2056/08 concerns the calculation of the period for filing an appeal when combined with a ten day period for postal delivery. The board noted that the two month period stipulated in Art. 108 EPC started from the day of the presumed or actual notification. If any rule of thumb could be suggested to calculate the appeal period, it should be "ten days plus two months" rather than "two months plus ten days."

For events which trigger the start of a time limit in connection with re-establishment of rights, see Chapter VI.E.3.2.1 below; for "notification" as an event which triggers the start of a time limit, see Chapter VI.K.5; for the relevant event for calculating the time limit under Art. 78(2) EPC 1973 (new R. 38 EPC), see **J 13/04**.

1.2. Determination and extension of periods under Rule 132 EPC

R. 132 EPC now defines the term "a period to be specified". The other amendments to the former R. 84 EPC 1973 were purely editorial (see OJ SE 5/2007).

1.2.1 Relevant criteria when time limits are extended (R. 132(2), second sentence, EPC)

In **T 79/99** the board noted that when asked for either extensions of time limits or postponement of oral proceedings, the board has to consider not only the interests of each of the parties but also the overall interest in the expeditious prosecution of appeals and the delays to other cases in the event of postponements. It decided that all interests would be best served in the case at issue by maintaining the date appointed.

The board took this opportunity to remind parties that, while some delay arising from the volume of pending appeals was inevitable, additional delays caused by parties themselves were often avoidable and were in principle undesirable. Such additional delays could affect not only the particular cases in which they occur but also other pending appeals the parties to which have complied with the usual time limits. It was also the case that most initial time limits under the EPC and the procedure of the boards were generous by comparison with corresponding provisions of the laws of many contracting states. Parties should not consider extensions of time as being available for the asking. Requests for extensions of time should only be made sparingly. Such requests should be made as soon as the possibility of the need for extra time becomes apparent and not at the last moment. Only the period of time actually and reasonably required should be sought. The more extensions a party seeks, or the longer the time sought for any one extension, the more important it is to provide reasons. It is also prudent to consult other parties to the appeal in advance - if they agree to an extension, the board is more likely to agree also; if they disagree, the board could then be made aware of their views. The board went on and pointed out that when considering requests for additional time, it would take into account not only any reasons put forward but also the number of previous extensions (if any), the views of the other party or parties (if known), the effect of delays on other appeals pending before it and the general principle that all delays are to be avoided where possible. Similar considerations apply to requests to adjourn oral proceedings.

See also **T 954/98** on the use of discretion under R. 84, second sentence, EPC 1973 (R. 132(2), second sentence, EPC). The application of Art. 120 EPC 1973 and R. 84 EPC 1973 to cases where the time limits had expired before the entry into force of EPC 2000 is considered in **J 12/07**.

1.2.2 Applicability of Rule 132 EPC to the Rules relating to Fees

In case **J 7/07** the Receiving Section had given the appellant a period of one month to submit evidence and pay the surcharge under Art. 8(4) RFees (now Art. 7(4) RFees). The appellant had not reacted. When appealing the decision refusing his request that the finding of a loss of rights pursuant to R. 69(1) EPC 1973 be set aside, the appellant argued that this one month time limit was too short and amounted to a substantial procedural violation as it was not in compliance with R. 84 EPC 1973.

The board noted that R. 84 EPC 1973 referred only to the Convention and the Implementing Regulations. However, according to Art. 120(b) EPC 1973, the Implementing Regulations should specify minima and maxima for time limits to be

specified under the Rules relating to Fees. That R. 84 EPC 1973 did not explicitly provide such maxima and minima indicated a possible conflict between Art. 120 EPC 1973 and R. 84 EPC 1973. Art. 164(2) EPC 1973 provided that in case of conflict the provisions of the Convention should prevail. Thus there was a basis for applying the provisions of R. 84 EPC 1973 to the Rules relating to Fees, unless the provisions of these Rules took precedence over the provisions of the EPC and/or the Implementing Regulations. The EPC was clearly the higher legal norm, and in case of conflict, by analogy with Art. 164(2) EPC 1973, the provisions of the EPC should take precedence over the provisions of the Rules relating to Fees. On general legal principles, the Implementing Regulations should take precedence over the Rules relating to Fees. Thus, the fact that R. 84 EPC 1973, which implemented Art. 120 EPC 1973, did not explicitly refer to the Rules relating to Fees, should not, in itself, be a bar to applying R. 84 EPC 1973 to these Rules. Further these rules contained no autonomous provision for specifying minima and maxima for time limits.

In the light of the above, the board considered that R. 84 EPC 1973 applied to the time limit in the then Art. 8(4) RFees.

1.3. Extension of time limits ipso jure on account of public holidays or dislocations

In the context of the EPC revision exercise (EPC 2000), the scope of application of R. 134 EPC (R. 85 EPC 1973) was extended beyond the postal service to include "technical means of communication permitted by the President of the European Patent Office under R. 2(1) EPC". As evidenced by the preparatory documents, the term "transmission of mail" in paragraphs 2 and 5 also refers to the submission of documents by technical means of communication permitted by the President of the European Patent Office (CA/PL 17/06, p. 356).

The various alternatives provided for in R. 85 EPC 1973 (new R. 134 EPC) are explained in **J 13/05**. The case law focuses on R. 134(2) and (5) EPC.

1.3.1 Interruption in the delivery of mail in a Contracting State (Rule 134(2) EPC)

R. 134 (2) EPC (R. 85(2) EPC 1973) provides for a time limit to be extended if it expires on a day on which there is a general dislocation in the delivery or transmission of mail in a contracting state or between a contracting state and the EPO. The duration of the period of dislocation shall be as stated by the European Patent Office. The term "general interruption" was deleted in the process of revising R. 85(2) EPC 1973. However, as evidenced by the preparatory documents, the retained term "dislocation" also refers to interruptions (CA/PL 17/06, p. 356). Decisions which interpret the term "general interruption" are still cited in the following as an aid to interpreting the "general dislocation" referred to in R. 134(2) EPC.

In **J 4/87** (OJ 1988, 172) the board reaffirmed that in the event of an unforeseeable postal delay causing non-compliance with a time limit, the EPO had no discretion to extend the time limit other than in the cases referred to in R. 85(2) EPC 1973.

In **J 11/88** (OJ 1989, 433) the board interpreted R. 85(2) EPC 1973 as being so drafted that if a general interruption or subsequent dislocation in the delivery of mail within the meaning of the rule occurred, any time limit under the EPC 1973 which expired within the period of interruption or dislocation was extended **by operation of law**. Accordingly, if the President of the EPO did not issue a statement as to the duration of that period, because he did not have the relevant information at the right time, this could not affect the rights of a person adversely affected by the interruption or dislocation. The board furthermore stated that whether or not an interruption in the delivery of mail or subsequent dislocation qualified as a "general interruption" was a question of fact, which had to be decided in the light of any credible information available; in case of doubt, the EPO should make official enquiries of its own motion in application of Art. 114(1) EPC 1973.

In **J 3/90** (OJ 1991, 550) the Legal Board of Appeal interpreted the concept of a **general** interruption, explaining that R. 85(2) EPC 1973 was not restricted to nationwide interruptions. In this case the board had to consider whether or not a disruption of mail had affected those residing in an area in such a way as to render it of "general character" and decided that the limited geographical extent of the disruption did not disqualify the interruption from being general. Whether or not a representative had undertaken all possible measures to avoid the effects of a postal strike was not a relevant test under R. 85(2) EPC 1973.

In **J 1/93** the Legal Board of Appeal again stated that for an interruption in the delivery of mail under R. 85(2) EPC 1973 to be considered general in character **the public in general** residing in an area of some magnitude, even if of limited geographical extent, had to be affected. The loss of a single mailbag might affect a number of individual addressees but not the public in general.

In **J 14/03** the board confirmed that evidence of a disruption within the meaning of R. 85(2) EPC 1973 provided by the appellant can lead to a retrospective extension of time in a particular case, as occurred in **J 11/88**, if this evidence, had it been known at the time, would have been such as to warrant a Presidential statement under R. 85(2) EPC 1973. However, the board found that in that case the quality of evidence was quite different from the case at issue, in which the only evidence of interruption was that of newspaper articles. The board considered this evidence inconclusive as the articles reported not only a number of problems caused by adverse weather and unofficial strikes, but also measures to deal with such conditions.

1.3.2 Dislocation of a mail service outside the contracting states (Rule 134(5) EPC)

In **J 13/05** the board highlighted that R. 85(5) EPC 1973 (which entered into force retrospectively on 11 September 2001) was inserted into the EPO following the events of 11 September 2001 because the legal remedies available at that time were inadequate. It was decided not to extend R. 85(2) EPC 1973 to postal interruptions outside the contracting states, as only for those states could the European Patent Office be sure of obtaining the information necessary to enable the President to announce a general interruption or dislocation. Therefore, unlike the preceding paragraphs, R. 85(5) EPC

1973 was drafted so as to place the **burden of proof** on the party asserting a general interruption or dislocation of the mail service.

The board found that the appellant had not put forward any facts which would support his submission that the requirements of R. 85(5) EPC 1973 were fulfilled. According to its wording and objectives, this rule required that the general interruption or dislocation arose at the place of dispatch, not of receipt. Moreover the requirement of another "like reason" had to be interpreted in the light of the purpose of the provision and of Art. 120(a) EPC 1973. As suggested by the wording and confirmed by its legislative history, that rule supplemented R. 85(2) EPC 1973 and likewise related to cases in which there was a general interruption or subsequent dislocation of the mail service on account of the events it specified, and therefore, like R. 85(2) EPC 1973, R. 85(5) EPC 1973 required that more than one person using the mail service be affected or theoretically capable of being affected by the interruption or dislocation, even if a merely minor or geographically limited interruption might be sufficient.

1.4. Statutory periods of grace and the fiction of observance of a time limit for fee payments

1.4.1 Additional period for renewal fees under Rule 51(2) EPC

The substance of Art. 86(2) EPC 1973 has been moved to new Rule 51(2) EPC.

In decision **J 4/91** (OJ 1992, 402) the Legal Board of Appeal laid down a new method for calculating the additional period for renewal fees. The board held that when calculating the six-month period for the payment of a renewal fee with additional fee under Art. 86(2) EPC 1973, R. 83(4) EPC 1973 should be applied *mutatis mutandis* in the light of R. 37(1), first sentence, EPC 1973. This meant that the six-month period did not end on the day of the subsequent sixth month corresponding "in number" to the due date according to R. 37(1), first sentence, EPC 1973 but on the day which was equivalent to this due date by virtue of its being the "last day of the month". For the purposes of calculating the additional period under Art. 86(2) EPC 1973, therefore, R. 83(4) EPC 1973, in the context of R. 37(1), first sentence, EPC 1973 resulted in a period running "from the last day of the month to the last day of the month".

The additional period started on the last day of the month specified in R. 37(1), first sentence, EPC 1973 even in the circumstances mentioned in R. 85(1), (2) and (4) EPC 1973. It followed that the occurrence of such circumstances at the beginning of the period did not result in the end of the period being postponed beyond the end of the sixth month and into the seventh month.

1.4.2 Period of grace for payment of fees under Rule 85a EPC 1973

In the context of the EPC revision exercise (EPC 2000), R. 85a and b EPC 1973 were deleted to take account of the extended application of further processing under Art. 121 EPC (OJ SE 1/2003, 190). Since the entry into force of EPC 2000, the new Art. 121 EPC also applies to European patent applications pending at the time of the revised

Convention's entry into force, provided the time limit for requesting further processing has not yet expired (Art. 1(5) AC decision, OJ SE 1/2007, 198). Since R. 85a EPC 1973 no longer applies in most cases, see the fifth edition for a detailed overview of the case law on this provision.

In **J 5/91** (OJ 1993, 657) the Legal Board of Appeal concluded that in cases where the time limits for subsequent payment of designation fees under paragraphs 1 and 2 of R. 85a EPC 1973 expire at different times, all designation fees can still validly be paid up to the later date.

In **J 5/98** the board held that the occurrence of a **national holiday** on the last day of the period of grace for payment of designation fees pursuant to R. 85a(2) EPC 1973 did not have the effect of extending that period.

The board in **J 15/02** stated that the time limits under R. 25(2), second sentence, and R. 85a EPC 1973 respectively did not form one integrated period, even if, according to **G 3/91** (OJ 1993, 8), the two time limits were closely linked, because the benefit of an extension under R. 85a EPC 1973 was available only if the prescribed surcharge was paid together with the due designation fees.

1.4.3 Fiction of fee payment in due time pursuant to Article 7(3) and (4) RFees

In the context of bringing the Rules relating to Fees into line with EPC 2000, the Rules' articles were renumbered. Art. 8 has become Art. 7 RFees (OJ SE 1/2007, 201).

In **J 20/00** neither the sixth renewal fee nor the additional fee according to Art. 86(2) EPC 1973 had been entered in a bank account held by the EPO in due time. The question then arose whether Art. 8(3) RFees (in conjunction with Art. 8(4) RFees) was applicable since it referred to the observance of a "period" for payment.

The board noted that it is true that the expression "period" in Art. 8 RFees could at first sight be understood as meaning a time limit in the sense of a period of a certain duration which begins on a first and ends on a later ("last") day, whereas renewal fees are due on a specific single day, namely on the last day of the month containing the anniversary of the date of filing of the European patent application (R. 37(1), first sentence, EPC 1973, R. 51(1), first sentence, EPC). However, this was not convincing in view of the definition of periods given in R. 83(1) EPC 1973 (R. 131(1) EPC). More relevant, in fact decisive, was the fact that in effect the due date marks the last day of a long period (one year and one day - R. 37(1), first sentence, EPC 1973 in conjunction with second sentence, EPC 1973) during which a renewal fee can be validly paid (without additional fee). The board concluded that Art. 8(3) and (4) RFees apply equally to the payment of renewal fees in respect of which one of the conditions set out in Art. 8(3)(a) RFees has been fulfilled on or before the due date. This provision also covers situations where the payment order was given later than ten days before the relevant point in time.

The board also found that the non-observance of the time limit and an ensuing loss of rights connected to it cannot be established, as long as the request mentioned in

Art. 8(4) RFees has not been issued by the EPO and the time limit specified therein has not expired. As the examining division failed to do so, the board was empowered pursuant to Art. 111(1) EPC 1973 (see **T 842/90**) to set a time limit of two months according to Art. 8(4) RFees. As the appellant paid the requested surcharge in due time and had previously filed evidence that payment of the sixth renewal fee had been effected, all the requirements of Art. 8(3) RFees had been fulfilled.

2. Further processing under Article 121 EPC

An extension can no longer be requested once a period has expired (**J 7/81**, OJ 1983, 89). However, even Art. 121(1) EPC 1973 provided that applicants could request further processing of a European patent application if their application was to be refused, had been refused or was deemed to be withdrawn following failure to reply within a time limit set by the EPO. The new version of Art. 121 EPC now broadens the scope of application of further processing and makes it the **standard legal remedy in cases of failure to observe time limits in the European patent grant procedure** and related ex-parte appeal proceedings, irrespective of whether the time limits are set by the EPO or are specified in the Convention or Implementing Regulations, and irrespective of whether the legal consequence is the loss of the application or merely a partial loss of rights. In some cases it therefore replaces the re-establishment of rights, which had proved to be too complex and unwieldy (MR/2/00, p. 157). In other cases it replaces the implementing and fee-related rules established to provide a remedy where the scope of application of further processing and re-establishment of rights had proved to be too restrictive (especially R. 85a and b EPC 1973).

Under the new Art. 121(1) EPC, the applicant can apply for the further processing of his application if he fails to observe a time limit vis-à-vis the Office. However, Art. 121(4) and R. 135(2) EPC lay down exceptions to this general rule, especially with regard to the time limits for priority, remedies and the request for further processing and re-establishment of rights, and with regard to the non-observance of certain time limits for which a special remedy provision exists in the Implementing Regulations (e.g. R. 58 and 59 EPC).

Hence, in contrast to the provisions under the EPC 1973, further processing can be applied to the time limits for the payment of filing, search and designation fees, the national basic fees and the examination fees, and to the time limit for filing the request for examination (OJ SE 4/2007; MR/2/00, 157). Since further processing now also applies to time limits for fee payment, requests for further processing no longer have to be in writing. Under the new system, the request is made simply by payment of the prescribed fee (OJ SE 5/2007).

The new provision applies to applications pending when the EPC 2000 entered into force, provided that the time limit for requesting further processing had not expired, and also to applications filed since the entry into force of the EPC 2000 (Art. 1, No. 5, AC decision, OJ SE 1/2007, p. 198).

In **J 37/89** (OJ 1993, 201) the Legal Board of Appeal pointed out that the applicants could overcome a loss of rights under Art. 96(3) EPC 1973 (which corresponds to Art. 94(4) EPC) resulting from the **refusal of a request for a time-limit extension** by requesting further processing in accordance with Art. 121 EPC 1973. At the same time, they could request reimbursement of the fee for further processing. This secondary request had to be decided on in connection with the final decision. Under Art. 106(3) EPC 1973, the decision on the secondary request could be appealed together with the final decision. The appeal could also be confined to contesting the decision on the secondary request.

In **J 47/92** (OJ 1995, 180) the Legal Board of Appeal stated that further processing under Art. 121 EPC 1973 was available only in respect of those time limits **the duration of which was to be determined or set by the EPO**. This question has been overtaken by the new version of Art. 121 EPC.

In **J 16/92** the examining division had issued a communication pursuant to R. 69(1) EPC 1973 after its first communication inviting observations had failed to elicit a response. The representative had thereupon applied for further processing of the application, requesting an extension of the time limit for filing observations concerning the first communication. The omitted act had, however, not been completed within the two-month time limit pursuant to Art. 121(2) EPC 1973. The Legal Board of Appeal concluded that where the omitted act consisted in filing a reply in substance to a first communication, it was not completed by filing a request for a time limit for submitting that reply, since a request for a time limit was not equivalent to the act the party in question had proposed performing within the time limit requested.

3. Interruption of proceedings under Rule 142 EPC

The amendments to R. 90 EPC 1973 (new R. 142 EPC) were purely editorial (OJ SE 5/2007).

3.1. Application of Rule 142 EPC by the EPO of its own motion

The EPO must apply the provisions of R. 90 EPC 1973 (R. 142 EPC) of its own motion (**J ..87**, OJ 1988, 323; **J 23/88**, **T 315/87**). The consequence of an interruption in the proceedings is that the time limits in force as regards the applicant or patentee at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings were resumed (see R. 142(4) EPC). However, the time limit for making the request for examination and the time limit for paying renewal fees are only suspended (see below Chapter VI.D.3.7, "Consequences of interruption of proceedings").

3.2. Concept of legal incapacity (Rule 142(1)(a) and (c) EPC)

The EPC does not define the concept of "legal incapacity", which is assessed differently according to whether the person concerned is the applicant or patentee or a professional representative: In **J xx/xx** (OJ 1985, 159) and **J ..87** (OJ 1988, 177) the Legal Board held that the capacity of the **applicant or patent proprietor** to carry out legal

transactions relating to his application or patent must be determined in accordance with the relevant **national law** because the interest in the patent application or the patent is an interest in property (see Art. 74 and Art. 2(2) EPC 1973; see also **J 49/92**). On the other hand, **J xx/xx** (OJ 1985, 159) states that a **uniform standard** of judging legal incapacity of **representatives** shall apply in order to avoid differences in the application of R. 90(1)(c) EPC 1973 depending on the nationality of domicile of the representative.

3.3. Determining legal incapacity of the applicant or patent proprietor for the purpose of Rule 142(1)(a) EPC

In **J ../87** (OJ 1988, 177) the board ruled that a brief medical certificate attesting that the applicant had been in a state of physical and mental exhaustion and depression, was not sufficient to establish incapacity within the meaning of R. 90(1)(a) EPC 1973 since the certificate said nothing about the seriousness and duration of this condition.

In **J 49/92** the Legal Board of Appeal was again unable to conclude from the applicant's submission that he had been legally incapacitated in accordance with German law, which was relevant in that case. The board had no evidence - such as a medical certificate - to suggest that the applicant's condition had been such, according to German legal practice, as to exclude his exercising his will rationally, since he had still managed to transfer the fees for the application, even if they had been sent by mistake to the German Patent Office instead of the EPO.

3.4. Determining legal incapacity of the representative for the purpose of Rule 142(1)(c) EPC

In **J xx/xx** (OJ 1985, 159) the board noted that, although there were differences in the national laws of contracting states as to the concept of "legal incapacity" and as to its consequences, there seemed to be a broad agreement that a person of full age was legally incapacitated when he was suffering from such a disturbance of his mind that he was unable to form the necessary voluntary intention to carry out legal transactions which would be binding upon him, e.g. to make valid contracts. Such a disturbance of his mind could be recognised by national law even if it was temporary only (e.g. a disturbance caused by physical injury or by the influence of alcohol or other drugs) or occurred from time to time, as was the case with some mental illnesses in which the patient had lucid intervals. Disturbance of the mind causing legal incapacity was always recognised by law if it was of long duration, a fortiori if it was permanent and irreversible.

The board noted that although no definition of legal incapacity was given in the Rule or in the Convention, the most that could possibly be deduced from R. 90 EPC 1973 itself was that the incapacity should be such that the appointment of a new representative was necessary or at least expedient (see R. 90(3) EPC 1973). The relevant aspect of his legal incapacity for the purpose of R. 90(1)(c) EPC 1973 was that of his incapacity to carry out professional work on behalf of a client. Since there was a unified European profession of representatives before the EPO, it was justified to consider that there should be a uniform standard of judging legal incapacity, in order to avoid differences in the application of R. 90(1)(c) EPC 1973 depending on the nationality or domicile of the

representative. The matter was, of course, completely separate from any question of a representative's legal incapacity to manage his own personal affairs, which, in accordance with the relevant national law would be governed by his nationality or domicile. In these circumstances, the question of determining the legal incapacity of a representative for the purposes of R. 90(1)(c) EPC 1973 was one for the EPO, applying its own standards, developed in the light of experience and taking into consideration principles applied in the national laws of the contracting states.

In **J 7/99** the board noted that this uniform standard of legal incapacity had been determined by the board for the purpose of R. 90(1)(c) EPC 1973 taking into consideration the principles recognised in the national laws of the contracting states. The basic consideration was whether the representative concerned was either in a fit mental state to do the work required of him at the material time or whether he lacked the capacity to make rational decisions.

In **J 5/99** the board stated that that meant carefully weighing up all reliable relevant information. Also indispensable was a reliable medical opinion taking account of all material facts.

The legal incapacity had to be of a persistent nature (**J ../86**, OJ 1987, 528). For the purposes of R. 90(1)(c) EPC 1973, the EPO must establish whether and if so when the representative was legally incapacitated, and in the light of its findings specify the time limits which might have been interrupted (**J ../87**, OJ 1988, 323).

In **J 7/99** the appellant's former representative explained during the oral proceedings that his mental block was restricted to just this single case in which his secretary had failed to observe the time limit pursuant to Art. 91(5) EPC 1973 and, as a consequence, he himself had failed to file the grounds of the request for restitutio in integrum within due time (Art. 122(2) EPC 1973). In other cases he worked, as he pointed out, "automatically" so that no other failure to meet time limits or other mistakes occurred. The board found, however, that that was not "legal incapacity" as it was understood for the purpose of R. 90(1)(c) EPC 1973. Legal incapacity pursuant to this rule meant a mental state in which the representative was so totally or nearly totally unable to take rational decisions that all his professional duties, and not just one isolated case, were affected by his mental state. It would be highly unreliable to assess a representative's legal capacity or incapacity by reference to only one case. Furthermore that approach would beg the question whether legal incapacity as regards one single case could or did affect other cases dealt with by the representative in question. Thus the board did not find that the appellant's former representative was legally incapable of dealing with the application at the material time and held that the main request must be refused (legal incapacity was also rejected in **J 2/98**.)

In **T 315/87** of 14.2.1989 the board lent credence to the assertion that during the time in question the previous representative had found himself in the unusual situation described, particularly as the circumstances (proceedings concerning professional conduct, the need to organise his office's work) had also been made known officially to the EPO. It further accepted that he had been suffering from physical and mental

disorders during that time. Indeed, the medical documents submitted by the previous representative himself pointed to a psychosomatic condition.

3.5. Legal incapacity of a representative from outside the contracting states

In **J 23/88** the Receiving Section had disallowed the applicant's claim under R. 90(1)(a) EPC 1973, holding that an American patent attorney was not covered by R. 90(1)(a) EPC 1973, being neither the applicant nor the proprietor of a European patent, nor a person authorised by national law to act on his behalf. The decision was based on a strict construction of R. 90(1)(a) EPC 1973, and in particular upon the premise that the relevant category in that Rule (persons authorised by national law) covered legal representatives of the applicant (patent proprietor) but did not extend to a patent attorney authorised under the laws of a non-Contracting State, whose legal incapacity was, therefore, irrelevant to the operation of the above Rule. The board disallowed the applicant's claim under R. 90(1)(a) EPC 1973.

The board however, of its own motion, considered whether or not such interruption had taken place under R. 90(1)(c) EPC 1973 (legal incapacity of the representative of an applicant for a European patent), a ground not specifically relied upon by the appellant. The board came to the conclusion that the US patent attorney in the case at issue was, at the relevant time, a legally incapacitated representative of the applicant within the meaning of R. 90(1)(c) EPC 1973. This interpretation was fully consonant with the preparatory documents regarding the desirability of equal treatment of applicants from contracting and non-contracting states. The board found that the difference in the wording of R. 90(1)(c) EPC 1973 from that of R. 90(1)(a) EPC 1973 was deliberately chosen so as to create equal treatment between applicants in the contracting and in non-contracting states (see Minutes of the 10th meeting of Working Party I of the inter-governmental conference for the setting up of a European system for the grant of patents, held in Luxembourg, on 22 to 26 November 1971, BR/144/71, point 71). The board observed that Art. 133(2) EPC 1973 provided a limited exception to the normal requirement for professional representation within the meaning of Art. 134 EPC 1973 in the case, and only in the case, of the filing of the European patent application. Such a filing could validly be made by the applicant himself or by any representative duly authorised by him. Thus, in effect, once the processing of the international application had properly started in the EPO, an American patent attorney would lose his entitlement to act under Art. 49 PCT by virtue of the combined effect of Art. 27(7) PCT, Art. 133(2) EPC 1973 and Art. 134 EPC 1973. Once he lost his representative capacity, any interruption in proceedings occasioned by his death or legal incapacity would no longer be covered by R. 90(1)(c) EPC 1973.

3.6. Interruption of proceedings because of insolvency (Rule 142(1)(b) EPC)

According to R. 142(1)(b) EPC (R. 90(1)(b) EPC 1973) proceedings before the EPO shall be interrupted in the event of the applicant for a European patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the EPO.

In **J 9/90** the Legal Board held that for R. 90(1)(b) EPC 1973 to be applied in the light of Art. 60(3) EPC 1973 and R. 20(3) EPC 1973, the applicant entered in the Register of European Patents and the insolvent person (here a limited company) had to be legally identical (for circumstances under which rights may be re-established see Chapter VI.E.9.).

In **J 26/95** (OJ 1999, 668) the board noted that, as could be derived from the legislative history of R. 90 EPC 1973, it was not the name or formal qualification of an action against property that was decisive for the question of whether it interrupted proceedings under R. 90(1)(b) EPC 1973. It was also not decisive whether the action served the purpose of satisfying all of the debtor's creditors. The decisive criterion for interruption was whether the action against the property was such as to make it legally impossible for the applicant to continue with proceedings. Being placed under Chapter 11 of the US Bankruptcy Code was an action taken against the property of the debtor. It did not, however, constitute a case where, as a result of such action, it was impossible for the debtor to continue the proceedings before the EPO. On the contrary, it was the very nature of proceedings under Chapter 11 that it was the debtor who continued to act for his business, even if he was subject to certain restrictions due to his obligation to preserve the interests of his creditors and due to his supervision by a trustee, if any. The board concluded that Chapter 11 bankruptcy proceedings were therefore not comparable to the cases which had been recognised in the case law of the boards of appeal as leading to interruption of proceedings, i.e. where parties had been placed under receivership under French law (**J 7/83**, OJ 1984, 211) or been declared bankrupt under German law (**J 9/90**). The board therefore concluded that, in the absence of specific circumstances having been shown in the case under consideration, proceedings against the applicant under Chapter 11, "Reorganization", of Title 11 - Bankruptcy - of the United States Code did not interrupt proceedings before the EPO within the meaning of R. 90(1)(b) EPC 1973. A situation which could be compared to the exceptional case underlying decisions **J 9/94** and **J 10/94** had also not been substantiated. The case law enshrined in **J 26/95** was also confirmed in **J 11/98**.

3.7. Consequences of interruption of proceedings (Rule 142(4) EPC)

R. 142(4), first sentence, EPC (R. 90(4), first sentence, EPC 1973) states that the time limits in force as regards the applicant for or proprietor of the patent at the time of interruption of the proceedings shall begin again as from the day on which the proceedings are resumed. R. 142(4) EPC includes two exceptions in this respect, namely the time limits for making a request for examination and for paying renewal fees. R. 142(4) EPC does not, however, constitute an exception to the general principle that all time limits are interrupted. Its sole purpose is to specify how time limits are to be calculated when proceedings resume (**J 7/83**, OJ 1984, 211).

In **J 7/83** (OJ 1984, 211) the board held that in the event of proceedings for grant of a European patent being interrupted because the applicant company has gone into receivership (R. 90(1)(b) EPC 1973), the period prescribed by Art. 94(2) EPC 1973 for payment of the **examination fee** is suspended as from the date on which payments were discontinued by court order up to the date on which proceedings for grant are

resumed (R. 90(2) EPC 1973). The period then resumes for the part remaining to elapse, or for at least the two months prescribed by R. 90(4), second sentence, EPC 1973. In **J ..187** (OJ 1988, 323) the board stated that such an interpretation could not be applied to **renewal fees** for which the EPC did not prescribe a time limit for payment but simply dates on which they fell due. The only time limit affecting renewal fees that might be suspended was the six-month period for paying the renewal fee together with an additional fee referred to in Art. 86 EPC 1973. R. 90(4) EPC 1973 had to be interpreted as deferring, until the date proceedings are resumed, the payment date for renewal fees which had fallen due during the period of the representative's or applicant's incapacity.

E. Re-establishment of rights

1. EPC 2000 - synopsis of changes

In the revised EPC, the relationship between further processing and re-establishment of rights has been redefined. Further processing is now the standard legal remedy for missed time limits in the European patent grant procedure (see also chapter VI.D.2, further processing) and thus in some cases replaces re-establishment. Under Art. 122(4) EPC in conjunction with R. 136(3) EPC, re-establishment is ruled out in respect of time limits for which further processing is available under Art. 121 EPC, in particular the fee payment time limits under R. 38, 39(1), 45(2), 70(1) and (3) and 159(1)(c)-(f) EPC (see OJ SE 4/2007). Re-establishment continues to be ruled out in respect of the time limit for requesting re-establishment (Art. 122(4), R. 136(3) EPC), but is still possible for the time limit for requesting further processing (OJ SE 4/2007).

In one respect though the scope of re-establishment has also been extended. Under the new law, re-establishment of the priority period under Art. 87(1) EPC is now possible. However, in view of the central importance of the date of filing and/or priority for the valid claiming of priority, R. 136(1), second sentence, EPC lays down a time period specifically for such cases where there is an urgent need for clarity. Any request for re-establishment of the priority period must be filed within two months of the expiry of that period (OJ SE 5/2007). The same two-month period applies to the filing of the request for re-establishment in respect of the time limits under Art. 112a(4) EPC.

The requirements (Art. 122(1) EPC) and procedure (R. 136 EPC) for re-establishment and the provisions governing the right of continued use (Art. 122(5) EPC) remain unchanged (OJ SE 4/2007); but details - such as time limits, requirements to be met by the request or the competent department - have been transferred to the Implementing Regulations (R. 136 EPC). The legal effect of re-establishment is now expressly regulated by Art. 122(3) EPC. The legal consequences of failure to observe a time limit are deemed not to have ensued.

2. Applicability of re-establishment of rights (Article 122(1) EPC)

2.1. The meaning of "time limit"

For re-establishment of rights to be possible, there must be a failure to meet a time limit vis-à-vis the EPO (Art. 122(1) EPC), i.e. a time limit given specifically to the applicant pursuant to the Convention or by an official of the EPO within which he must accomplish a certain act (i.e. according to R. 59 EPC).

In **J 3/83** the board explained that the concept of a time limit within Art. 122 EPC 1973 involved a **period of time of a certain duration**. In the case of designation of states, there was no such period. States had to be designated at a particular time, see Art. 79(1) EPC 1973. With the EPC 2000 this is no longer an issue, as under the new Art. 79(1) EPC all contracting states party to the EPC at the time when the application is filed are deemed to be designated in the request for grant of a European patent.

In **J 7/90** (OJ 1993, 133) the board found that the "time limitation" condition imposed under board of appeal case law, which required that, in general, a request for correction of the designation of a state or priority data had to be refused in the public interest if it was not made early enough to enable publication of a warning together with the European patent application, was not a "time limit" within the meaning of Art. 122(1) EPC 1973.

In **J 21/96** the board held that the **time restriction for filing a divisional application** (R. 25(1) EPC 1973) was not a time limit within the meaning of Art. 122(1) EPC 1973. It merely identified a point in the grant procedure after which a divisional application could no longer be filed. This point was decided upon by the applicant when he gave his approval pursuant to R. 51(4) EPC 1973. Therefore, in the absence of a time limit to be observed, re-establishment of rights was not possible (see also **J 4/02**).

The Legal Board of Appeal adhered to this conclusion even after R. 25(1) EPC 1973 had been amended in 2001. In **J 10/01** the board emphasised that not every "time limit", "time limitation" or "time restriction" under the EPC 1973 was also a time limit pursuant to Art. 122 EPC 1973. According to **J 21/96**, R. 25(1) EPC 1973 did not lay down a time limit within the meaning of Art. 122 EPC 1973 but merely identified a point in the grant procedure after which a divisional application could no longer be filed. This decision could be applied to the case in suit as well, as only the defined point in time had been changed, from the time of approval of the text according to R. 51(4) EPC 1973 to the moment when the earlier application was no longer pending.

On the same subject the board emphasised in **J 24/03** (OJ 2004, 544) with reference to **J 3/83** and the principles of procedural law generally recognised in the contracting states, that a **time limit** involves a **period of fixed length** for accomplishing a procedural act. It held that, in procedural law, the fact that a conditional act can only be accomplished before a particular set of circumstances foreseen by legal provisions occurs (**condition**), was conceptually different from a set period of time imposed for doing an act (**time limit**). The board concluded that R. 25(1) EPC 1973 did not impose

any time limit but rather sets a condition, namely that the earlier European patent application was pending. The communication of the day of publication to the applicant could not be regarded as an implicit imposition of a time limit (see also **J 3/04**).

Time limits in the EPC have **two conceptual elements**: (1) a period of time determined in years, months or days, and (2) a relevant date, which serves as the starting date of the time limit, and from which the period of time is counted. Time restrictions imposed on applicants by the EPC, but not having these conceptual elements cannot be regarded as time limits for the purposes of Art. 122 EPC 1973 (**J 18/04**, OJ 2006, 560).

2.2. Loss of rights as a direct consequence by virtue of the EPC

Under Art. 122(1) EPC rights could not be re-established unless they had previously been lost as a direct consequence of the non-observance of a time limit vis-à-vis the EPO.

In **J 1/80** (OJ 1980, 289) certified copies of priority documents had not been filed within the 16-month period provided for in R. 38(3) EPC 1973. The Legal Board of Appeal found that, according to the Convention, there was a deficiency only if the priority documents had not been filed by the end of the period. It could only be said that there was a deficiency thereafter and the applicant should have been given an opportunity to remedy that deficiency within a further period (Art. 91(2), R. 41(1), 84 EPC 1973). The board recognised that there could only be a loss of rights if the applicant did not then take advantage of this opportunity.

2.3. Omission of acts by applicant

Under Art. 122(1) EPC re-establishment of rights may be granted to both the applicant and the proprietor of a European patent. In principle it is a legal remedy that is not available to opponents, even after the EPC revision.

In **G 1/86** (OJ 1987, 447) the Enlarged Board of Appeal admitted an exception to this principle in the following case: an **opponent as appellant** may have his rights re-established under Art. 122 EPC if he has failed to observe the time limit for filing the **statement of grounds of appeal** (established case law, see i.e. **T 335/06**). The board first of all observed that in drafting Art. 122 EPC 1973, the authors of the Convention intended only to exclude certain cases and time limits from *restitutio in integrum*, and not to restrict that facility solely to applicants and patent proprietors. The wording of Art. 122(1) EPC 1973 (Art. 122 EPC remaining unchanged in that respect), the historical documentation relating to the EPC 1973 and a comparison of the national laws of member states suggested that opponents may not have their rights re-established in respect of the time limit for appeal. However, this did not answer the question raised with regard to the time limit within which the opponent has to file the statement of grounds for appeal because, when its authors decided to exclude opponents from *restitutio in integrum*, the draft EPC 1973 made no provision for a separate time limit for filing the statement of grounds of appeal, and consequently they did not rule on the matter.

The Enlarged Board considered that the reasons justifying the exclusion of opponents from re-establishment of rights in respect of the time limit for appeal - in particular the patent proprietor's interest in no longer being left uncertain as to whether an appeal had been lodged once this time limit had expired - could not be extended to the time limit for filing the statement of grounds of appeal, because this uncertainty no longer existed. Once the appeal had been filed, the legal process had begun and the patent proprietor had to comply with the procedural requirements like all the other parties and wait until the board of appeal arrived at a final decision on the appeal's admissibility.

On this basis the Enlarged Board applied the general legal principle recognised in the contracting states of the EPC that all parties to proceedings before a court must be accorded the same procedural rights, as a principle deriving from the general principle of equality before the law. Under this principle an opponent must not be treated differently from the patent proprietor as that would result in unjustifiable discrimination against him.

In **T 210/89** (OJ 1991, 433) the board ruled that an opponent (appellant) was not entitled to have his rights re-established when he missed the two-month time limit for **filing an appeal** (Art. 108, first sentence, EPC 1973). An opponent (appellant) seeking to have his rights re-established could not rely on the principle of "equality before the law" (applying Art. 125 EPC 1973) where the appeal did not exist for procedural reasons (distinguishing **G 1/86**, see above). The applicant or proprietor, having failed to set in motion his appeal, would find himself at the end of the legal road; by contrast, an opponent could, if he wished, seek revocation in the national courts into whose jurisdiction the European patent would have passed (see also **T 323/87**, OJ 1989, 343; **T 128/87**, OJ 1989, 406 and **T 314/01**).

Referring to **G 1/86** the board stated in **T 702/89** (OJ 1994, 472) that a request for re-establishment of rights by an opponent who had failed to observe the nine-month time limit under Art. 99(1) EPC 1973 for filing the **notice of opposition** and paying the appropriate fee had to be rejected as inadmissible. In **G 1/86** the Enlarged Board of Appeal held that in appeal proceedings the legal process started when the appeal had been filed and the appropriate fee had been paid. For the same reasons, the board in **T 748/93** maintained that, in accordance with Art. 99(1) EPC 1973, the legal process in opposition proceedings began when the notice of opposition was filed and the appropriate fee was paid.

In **J 3/80** (OJ 1980, 92) the board made it clear that if the **national industrial property office** concerned **failed to forward** a European patent application filed with that national office **to the EPO in time**, with the result that the application was deemed to be withdrawn (Art. 77(5) EPC 1973), the applicant could not claim restitution of rights, since the EPC provided only for restitution of rights where there had been a failure to observe a time limit which it was for the applicant to observe.

3. Admissibility of applications for re-establishment of rights

3.1. Department competent to decide upon the application

The department competent to decide on the omitted act shall decide upon the application (R. 136(4) EPC, Art. 122(4) EPC 1973).

In **J 22/86** (OJ 1987, 280) the board stated in relation to the failure to pay grant and printing fees and to file translations that the examining division was in the first instance competent to decide upon such omitted act. However, in view of the special circumstances of this case, the board decided, pursuant to Art. 111(1) EPC 1973, to exercise the power of the examining division to decide upon the application for restitutio (see also **J 9/86**).

In **T 26/88** (OJ 1991, 30) the appellant failed to comply with the request (pursuant to R. 58(5) EPC 1973) to pay the printing fee and to file translations of the claims within three months of notification of the request. The patentee submitted the request that the board of appeal should examine and decide upon the application under Art. 122 EPC 1973. The board found that the circumstances of decision **J 22/86** were **quite different** from the case at issue and justified the exceptional exercise of the power of the examining division to decide on the application for re-establishment. In the case before the board the **opposition division's formalities officer** was responsible (see also **T 522/88**).

In **J 10/93** (OJ 1997, 91) the board noted that, according to Art. 20(1) EPC 1973, the Legal Division was competent to decide on the appellants' request for recording the transfer of a patent application. However, the Legal Division not only decided on this request but also dealt with the appellants' application for re-establishment of rights which it rejected as inadmissible. In the case at issue, the omitted act was the applicants' failure to reply to a communication of the examining division issued pursuant to **Art. 96(2) EPC 1973**. Consequently, the department competent to decide on the application for restitutio was the **examining division** (Art. 122(4) EPC 1973). The board found that the Legal Division had exceeded its powers. It stated that this could not be justified by any need to decide on the request for restitutio as a preliminary issue to be answered before examining the request for registering the transfer. The board set aside the decision of the Legal Division on this ground alone and ordered that the request for restitutio be remitted to the examining division for examination.

In **J 23/96** the applicant applied for a **decision under R. 69(2) EPC 1973** and, as an **auxiliary request**, asked for **re-establishment of rights**. The examining division issued a brief communication saying that the request for re-establishment would be decided once the decision under R. 69(2) EPC 1973 was final, or during any ensuing appeal. The board noted that auxiliary requests were filed in case the main request was refused; they then took its place and had to be dealt with in the same decision. The course taken by the examining division was at odds with procedural economy, and might also oblige the applicant to appeal twice. This amounted to a substantial procedural violation which meant setting the contested decision aside and referring the matter back, without

considering the merits, for the division to decide on the two requests together. The board could not decide on the request for re-establishment because it was not the "competent department" within the meaning of Art. 122(4) EPC 1973. In this case, the competent department was the **examining division**.

T 473/91 (OJ 1993, 630) was concerned with jurisdiction over the request for re-establishment of rights in respect of the **time limit for filing a notice of appeal**. The board noted that the admissibility of an appeal under Art. 109 EPC 1973 (interlocutory revision) only fell under the jurisdiction of the department of first instance when this question could be decided immediately on the basis of the appeal submissions themselves (notice of appeal and statement of grounds, date of payment of the appeal fee). Consequently, the **boards of appeal** had exclusive jurisdiction over a request for restitutio in respect of a time limit relating to the appeal itself (Art. 108 EPC 1973) (see also **T 949/94**). The board stated that in the system for appellate review by a separate higher instance, as foreseen by the Convention in accordance with the principle of devolutive legal remedy, a final decision (as distinct from a decision that was no longer appealable as a result of the time for appeal having lapsed) by a lower instance effectively severed the case from that instance, in so far as the decision had settled all pending issues on their merits. As an exception to the principle of devolutive legal remedy, Art. 109 EPC 1973 provided for rectification by the department of first instance. Being an exception to the system of devolutive appeals, this provision had, however, to be construed narrowly. The board held that since the outcome of the admissibility issue was dependent on the outcome of the issue of restitutio in integrum, the request for restitutio had to be decided by the board of appeal.

In **T 808/03**, the board pointed out that the department competent to decide whether a notice of appeal meets the requirements of the Convention was the board of appeal. While this competence in relation to admissibility of an appeal was subject to the exception of Art. 109(1) EPC 1973, this provision conferred only the limited power to set aside *uno actu* the department's own decision if the appeal was considered admissible **and** well founded. There is no power to decide that an appeal is not admissible.

In **T 624/96** the board ruled that because no written statement setting out the grounds of appeal had been filed within the time limit under Art. 108 EPC 1973 in conjunction with R. 78(3) EPC 1973, the appeal should be rejected as inadmissible under R. 65(1) EPC 1973 unless the appellant's request for re-establishment of rights was granted. The appellant had filed such a request. Under Art. 122(4) EPC 1973 the board of appeal was competent to decide on this request, because the omitted act concerned an appeal.

In **W 3/93** (OJ 1994, 931) the board stated that as the board had to decide on the protest, it was also competent to examine the request for re-establishment of rights (Art. 122(4) EPC 1973).

3.2. Time limits for filing an application for re-establishment (Rule 136(1) EPC)

The provisions of Art. 122(2) EPC 1973 have been transferred to the Implementing Regulations (see R. 136 EPC). In principle the time limits of two months from removal of

the cause of non-compliance and one year after expiry of the unobserved time limit still apply, but R. 136(1) EPC provides for two exceptions: a request for re-establishment in respect of the periods specified in Art. 87(1) EPC (priority) and Art. 112a(4) EPC (petition for review through the Enlarged Board of appeal) must be filed within two months of expiry of the unobserved time limit. Hence the case law summarised in point 3.2.1 is not applicable to such cases, but the principles laid down in point 3.2.2 are likely to be transferrable to the two-month period under R. 136(1), second sentence, EPC.

3.2.1 Two-month time limit from the removal of the cause of non-compliance

(a) General issues

The application for re-establishment of rights must be filed within two months of the date of the removal of the cause of non-compliance with the missed time limit (Art. 122(2) first sentence EPC 1973, R. 136(1) first sentence EPC). This also applies if the time limits under Art. 102(4) and (5) EPC 1973 have been missed, even if no decision has yet been handed down concerning revocation (**G 1/90**, OJ 1991, 275). The omitted act must be completed within the same period. The fee for re-establishment of rights is also payable within the same time limit as that stipulated by Art. 122(2) EPC 1973 for the filing of an application for re-establishment (**J 18/03**).

In most cases the "cause of non-compliance with the time limit" involved some error in the carrying-out of the party's intention to comply with the time limit (**J 29/86**, OJ 1988, 84; regarding other possible causes of non-compliance, see also point 7.2 below) According to the case law of the boards of appeal, the removal of the cause of non-compliance occurs in such cases on the date on which the person responsible for the application (the patent applicant or his professional representative) is **made** aware of the fact that a time limit has not been observed (**T 191/82**, OJ 1985, 189; **T 287/84**, OJ 1985, 333; **J 29/86**, OJ 1988, 84; **J 27/88**, **J 27/90**, OJ 1993, 422). The decisive factor in this is the time when the person concerned **ought to have noticed the error** if he had taken all due care (established case law, see e.g. **J 27/88**, **J 5/94**, **J 27/01**, **T 315/90**, **T 840/94**, **T 170/04** and **T 1026/06**, **T 493/08**). In **T 261/07**, relying on **T 949/94**, the patentee had argued that it had only become aware of an oversight when it could be established that the decision of the opposition division had indeed been received. The board however took the view that the cause of non-compliance was removed as soon as the patentee noticed via a file inspection "that something was amiss" (**J 9/86**, **J 17/89**, **T 191/82**).

In **T 493/08** the Board considered that, where a time limit was not observed due to an error of law, the removal of the cause of non-compliance with that time limit occurs on the date on which the applicant actually became aware of the error of law. The board stated that in an apparent contrast to this view, in **T 1026/06** the date when the applicant should have made investigations was considered to be critical, even though the applicant apparently failed to undertake such investigations as a consequence of what was considered to be an error of law.

As stated in **J 27/90** (OJ 1993, 422), the removal of the cause of non-compliance is a matter of fact which has to be determined in the individual circumstances of each case (**J 7/82**, OJ 1982, 391; see also **J 16/93**, **T 900/90**, **T 832/99**). In the case of an error of facts the removal occurs on the date on which any person responsible for a patent application should have discovered the error made. This is not necessarily the date of receipt of the communication under R. 69(1) EPC 1973 (see **T 315/90**). If, however, such a communication has duly been served, it may, in the absence of circumstances to the contrary, be assumed that the removal was effected by this communication (see also **J 7/82**, OJ 1982, 391, **J 29/86**, OJ 1988, 84; **T 900/90**, **T 428/98**, OJ 2001, 494; **T 832/99** and **J 11/03**).

In **J 29/86** (OJ 1988, 84) the board assumed a later date in view of the special circumstances of the case. In **T 900/90** the board emphasised that in all cases in which the receipt of the notification under R. 69(1) EPC 1973 could be regarded as the removal of the cause of non-compliance it had to be clearly established that neither the representative nor the applicant was aware that the application had been deemed to be withdrawn before the receipt of that notification. Other cases in which the boards agreed to a date different from that of the receipt of the communication under R. 69(1) EPC 1973 include **J 16/93**, **J 22/97**, **J 7/99**, **J 19/04**, **T 24/04** and **T 170/04**.

In **J 27/01** the board decided that persons absent from their residence for a lengthy period are obliged to ensure that legally important documents are forwarded to them so that they can note their contents within a time limit appropriate to the technology available in the particular case. The obstacle to completion of the omitted act was therefore overcome on the date on which the individual applicant could have noted the content of the EPO communication under R. 69(1) EPC 1973 if he had had it duly forwarded to him.

(b) Responsible person

In several decisions the boards considered the question of the identity of the responsible person who ought to have detected the omission.

In **T 191/82** (OJ 1985, 189) the board held that in a case in which non-compliance with a time limit leading to a loss of rights under the EPC 1973 was discovered by an employee of a representative, the cause of non-compliance, i.e. failure to appreciate that the time limit had not been complied with, could not be considered to have been removed until the **representative concerned** had **himself** been made aware of the facts, since it had to be his responsibility to decide whether an application for re-establishment of rights should be made and, if it was to be made, to determine the grounds and supporting facts to be presented to the EPO (see also **J 7/82**, OJ 1982, 391; **J 9/86** and **T 381/93**).

In **J 27/88** the board held that the responsible person in the case at issue was neither the appellant nor the European representative but the **US patent attorney** who was the authorised agent of the appellant and was duly empowered to take all necessary measures. The date of removal of the cause of non-compliance was the date on which the US patent attorney became aware of the omission. In this decision the board stated

that the effective date of removal of the cause of non-compliance was not necessarily the date on which the omission had been discovered but the date on which it ought to have been discovered if all due care had been observed (see also **T 315/90**).

In **J 27/90** (OJ 1993, 422) the applicant, a US company, properly appointed a European professional representative as its agent by referring to a general authorisation (R. 101(2) EPC 1973). For the payment of renewal fees the appellant used a computerised service firm, a so-called "renewal fee payment agency". In a communication under R. 69(1) EPC 1973 received by the professional representative, the appellant was informed that the application was deemed to be withdrawn because the renewal fee and additional fee had not been paid in due time. The board held that in the absence of circumstances to the contrary a communication under R. 69(1) EPC 1973 to the professional representative removed the cause of non-compliance. This also applied when parties instructed the (European) professional representatives via their (national) patent attorney. The appointment of an independent service firm for the payment of renewal fees did not constitute such circumstances to the contrary.

In **J 16/93** the board stated that by virtue of the contractual relationship between the applicant for a European patent and the professional representative, to which the express authorisation on file with the patent application bore witness, the professional representative was responsible for complying with all the obligations incumbent on his client under the EPC 1973. In principle, therefore, a communication under R. 69(1) EPC 1973 to the representative removed the cause of non-compliance with a time limit. However, in the event of exceptional circumstances the cause of non-compliance with a time limit may persist even though the applicant's representatives were duly informed of the loss of rights resulting therefrom. This is the case when a combination of circumstances, which cannot be blamed on either the applicant or its representatives, and which arose in particular from the fact that they had both moved to new addresses and from the illness of a director of the company applying for a European patent, made it impossible for the professional representatives to contact the applicant in due time. This combination of circumstances prevented the representatives from performing the omitted act - i.e. paying the renewal fee for the third year - since they had not received any advance. A representative whose authorisation is silent in this respect and who has not received any funds for this purpose is not expected to advance moneys on behalf of his client out of his own pocket.

In **T 840/94** (OJ 1996, 680) the board noted that, according to the established case law of the boards of appeal, the removal of the cause of non-compliance occurred on the date on which the applicant or his representative should have discovered the error. The board also observed that the EPO had notified the European representative as prescribed in R. 81(1) EPC 1973. If a party instructed the authorised representative not to pass on any further communication from the EPO, it could not then rely on the fact that information notified to the European representative and necessary for continuing the proceedings was lacking. Similarly, in **T 812/04** the board held that the person to be taken into account for the purposes of establishing the point in time when the appellant was no longer prevented from carrying out an unperformed act is the duly appointed representative.

In **T 32/04** the board considered that in the absence of a duly registered transfer of the application, the person responsible for the purpose of the EPO remained the applicant or his representative. Hence an alleged assignment of the application to a third party in the absence of such a registration was "res inter alios acta", i.e. outside the ambit of the legal relationship between the applicant and the EPO.

(c) Legal fiction of deemed notification

The boards explained in several decisions that the decisive factor is the date of actual receipt of a communication under R. 69(1) EPC 1973 (R. 112(1) EPC).

In **J 7/82** (OJ 1982, 391) the board held that in a case in which the receipt of a notification was relevant to the question of when the cause of non-compliance with a time limit had been removed, the significant date was the **date of actual receipt** by the applicant. In **J 22/92** the board emphasised that the removal of the cause of non-compliance was a matter of fact and therefore had to be established beyond any reasonable doubt. This was not the case where under R. 78(2) EPC 1973 (in the version in force until 31 December 1998) the notification was only deemed to have been made when despatch had taken place and when the receipt of the letter could not be proved. Thus, the board considered the date on which the responsible representative of the appellant first became aware of the missed time limit to be the date on which the removal of the cause of non-compliance with the time limit had occurred (see **T 191/82**, OJ 1985, 189).

In **T 428/98** (OJ 2001, 485) it was stated that where a communication from the EPO notified an applicant that he had missed a time limit, the cause of failure to complete the omitted act within the meaning of Art. 122(2), first sentence, EPC 1973 was as a rule removed on the date when the applicant actually received the communication, provided that failure to complete the act was purely due to previous unawareness that the act had not been completed. The legal fiction of deemed notification under R. 78(3) EPC 1973 (in the version in force until 31 December 1998, now R. 126(2) EPC) had no effect on the date of removal of the cause of non-compliance, even if this worked against the applicant because the actual date of receipt of the communication preceded the date calculated according to R. 78(3) EPC 1973 (see also **T 1063/03**).

In **J 11/03**, however, the board agreed with the appellant that the removal of the cause of non-compliance had not taken place before deemed notification in accordance with R. 78(2) EPC 1973, since there was no indication that the communication concerning loss of rights had already been received before that date (see also **J 10/99**).

3.2.2 One-year time limit following the expiry of the unobserved time limit

A request for re-establishment of rights is only admissible within the year immediately following the expiry of the unobserved time limit (Art. 122(2), third sentence, EPC 1973; R. 136(1), first sentence, EPC). Under R. 136(1), third sentence, EPC, the request for re-establishment of rights is not deemed to have been filed until the prescribed fee has been paid.

In **J 16/86** the board ruled that a request for re-establishment filed over a year after expiry of the non-observed time limit was inadmissible whatever the reasons for its late submission (see also **J 2/87**, OJ 1988, 330; **J 34/92**).

In **J 6/90** (OJ 1993, 714) the statement of grounds was not submitted until shortly after the end of the period of one year stipulated in Art. 122(2), first sentence, EPC 1973 but within the period of two months specified in Art. 122(2) EPC 1973, which in the case at issue expired later. The Legal Board of Appeal pointed out that the one-year period served to provide legal certainty. If this period had elapsed, any party could confidently assume that a patent application or patent which had been rendered invalid by the non-observance of a time limit would not be revived. However, if on inspecting the file a third party noted that an application for re-establishment had been made within the one-year time limit, he would have adequate notice. The board concluded as follows: To make a valid request for re-establishment of rights within the year immediately following the expiry of the unobserved time limit, it is sufficient if the files contain a clearly documented statement of intent from which any third party may infer that the applicant is endeavouring to maintain the patent application. (see also **T 270/91**, **T 493/95**, **J 6/98**).

In **J 6/08** the fee for re-establishment of rights was not paid until after the one-year period had expired. The board referred to the case law (**J 16/86**, **J 34/92**, **J 26/95**, OJ 1999, 668; **J 6/98**, **J 35/03**), under which the one-year period fulfils the function of a deadline whose purpose is to ensure legal certainty for the public and the completion of proceedings before the EPO within a sensible and appropriate period of time. In view of the particular circumstances of the case, however, the board considered that re-establishment was not ruled out since the fact that the conditions for re-establishment had not been met in due time - i.e. payment of the fee for re-establishment within the one-year period - was largely to be laid at the door of the Office itself. Where the Office has failed to meet its obligation to provide clarifications or advice, a request for re-establishment filed within the period of one year can, when the principle of the protection of legitimate expectations is taken into account, be treated as valid even though the fee for re-establishment was not paid until after the period of one year had expired. In the present case, the requester's right to be treated as though the non-observance had not occurred can take precedence over third parties' interest in legal certainty, which the one-year period in Art. 122(2), third sentence, EPC 1973 is intended to ensure.

In **J 12/98** the appellant's chief argument on appeal appeared to be that the words "within the year immediately following the expiry of the unobserved time limit" in Art. 122(2), third sentence, EPC 1973 should be construed to mean "within one year of the applicant having knowledge of the unobserved time limit". As the board pointed out, this interpretation would appear to make the starting point for calculating the two-month period referred to in Art. 122(2), first and second sentence, EPC 1973 the same as that for calculating the one-year time limit referred to in Art. 122(2), third sentence, EPC 1973. This interpretation would thus, according to the board, deprive Art. 122(2), third sentence, EPC 1973 of any function, as of necessity something done within two months of a particular date would have been done within one year of that date. Such a reading, in the board's view, was contrary to the normal rules of interpretation.

3.3. Making good the omitted act

The omitted act must be performed within two months from removal of the cause of non-compliance (Art. 122(2), second sentence, EPC 1973; R. 136(2) EPC).

According to **T 167/97** (OJ 1999, 488), the requirement of Art. 122(2), second sentence, EPC 1973 implies that the completed act likewise must meet the requirements of the EPC - i.e. in the case at issue that the statement of grounds of appeal is admissible for the purpose of Art. 108, last sentence, EPC 1973. Where the statement of grounds filed with the request for re-establishment is insufficient for the appeal to be declared admissible, the request for re-establishment must itself be declared inadmissible.

3.4. Filing and substantiation of the application

Under R. 136(1), first sentence, EPC (Art. 122(2) EPC 1973) an application for re-establishment of rights has to be filed in writing within two months of the removal of the cause of non-compliance with the time limit (except in the special case referred to in R. 136(1), second sentence, EPC). Under R. 136(2) EPC (Art. 122(3) EPC 1973) the application has to state the grounds on which it is based, and set out the facts on which it relies. The boards consider this requirement in relation both to admissibility and to the submissions that must be taken into account (see also 7.1 below). In **T 1465/08** the board stated that the simple fact of paying a fee did not as a rule amount to the filing of a request. In the case of a request for re-establishment of rights, the mere payment of the fee does not suffice and does not meet the requirements of R. 136 EPC. According to the established case law of the boards of appeal, these provisions (of EPC 1973, but unchanged in that respect) have consistently been interpreted as meaning that a statement of grounds, containing at least the core facts on which the application relied, had to be filed within the stated time limit (**J 18/98**). An application relying solely on general statements and containing no specific facts is inadmissible for lack of substantiation (**J 19/05**).

In **T 13/82** (OJ 1983, 411) the board held that the application would be duly supported only if it was clear from the facts set out and substantiated that the applicant had taken all due care required by the circumstances to observe the time limit. The board held that a conclusive case must be made, **setting out and substantiating the facts**, for the probability - at least - that a wrongful act or omission on the part of an assistant was the cause of the failure to meet the time limit: the mere possibility was not sufficient to exculpate the applicant (**T 715/89**).

In **T 287/84** (OJ 1985, 333) the board decided that an application for re-establishment of rights could be considered as complying with the requirement that it had to set out the facts on which it relied (Art. 122(3) EPC 1973) if the initially filed application in writing, which did not contain such facts, could be read together with a further document, which contained them and was filed before the expiry of the period within which the application had to be filed.

In **T 324/90** (OJ 1993, 33) the board held that **evidence** proving the facts set out in the application could be filed after expiry of the two-month time limit laid down in Art. 122(2) EPC 1973. Only the grounds and a statement of the facts had to be filed within the two-month period. It was not necessary to indicate in an application for re-establishment the means (e.g. medical certificates, sworn statements and the like) by which the facts relied on would be proved. Such evidence could be submitted after the time limit, if so required (see also **T 667/92** and **T 261/07**).

In **J 19/05** the board held that an application for re-establishment of rights must be sufficiently substantiated, in accordance with Art. 122(3), first sentence, EPC 1973, to ensure that any subsequent introduction of fresh grounds can be ruled out. An application for re-establishment relying on general statements and containing **no specific facts** is not considered to satisfy the requirement for substantiation and is therefore to be refused as inadmissible. In the case at issue, an appellant's application for re-establishment of rights was couched in purely general terms and contained no concrete facts identifying a reason for non-observance, the chronological sequence of events or the causes underlying the action or inaction of the persons involved concerning non-payment of a renewal fee. Nor was the inadequate substantiation augmented by the account of the facts in a subsequent letter from the representative. The reason for non-observance given in the letter, i.e. a "misunderstanding", was unsubstantiated, as was the claim that a "transmission error" had occurred, since there was no explanation as to who had misunderstood what and when this had happened.

In **J 8/95** the appellants argued that the German-language version of Art. 122(3) EPC 1973 did not stipulate that the statement of grounds for an application for re-establishment of rights had to be filed within the time limit laid down in Art. 122(2) EPC 1973. In the current case, the language of the proceedings was German; clearly, therefore, the decision had to be based on the German version. The board however decided that Art. 177(1) EPC 1973 assumed a uniform legislative intent, which could only be identified on the basis of all three texts of the EPC 1973 (see also **T 324/90**, OJ 1993, 33).

In **J 26/95** (OJ 1999, 668) the applicant had missed two time limits which expired independently of one another and each resulted in the application being deemed withdrawn. The board held that in such an event a request for re-establishment had to be filed in respect of each unobserved time limit. Where two different time limits had been missed the loss of rights could only be overcome if the applicant showed, **in respect of both time limits**, that all requirements of Art. 122 EPC 1973 for the requests to be admissible and well-founded were met - including the payment of two fees under Art. 122(3), second sentence, EPC 1973.

3.5. Correction of deficiencies in the application for re-establishment

In **T 14/89** (OJ 1990, 432) the board pointed out that the principle of good faith governing proceedings between the EPO and the parties involved required that the applicant have his attention drawn to **deficiencies** in his application for re-establishment of rights **which were obviously easy to correct** (in the case in point: fee not paid and substantiation

not supplied) if correction of the deficiencies could be expected within the two-month time limit for restitutio under Art. 122(2) EPC 1973. If this communication was not sent by the EPO within the two-month time limit, it had to be sent subsequently and a new time limit set. Acts, the deficiencies of which were corrected within this set time limit, were deemed to have been performed in due time within the meaning of Art. 122(2) EPC 1973. This case law was confirmed by the Legal Board of Appeal in a similar case, **J 13/90** (OJ 1994, 456). In **J 34/92** the board pointed out, however, that this only applied to time limits which were not absolute.

In **J 41/92** (OJ 1995, 93) the board held that the users of the EPC could not, by merely asking the EPO to warn them of any deficiency that might arise in the course of the proceedings, shift their own responsibility for complying with the provisions of the EPC 1973. If, however, a deficiency was readily identifiable by the EPO and could easily be corrected within the time limit, the principle of good faith required the EPO to issue a warning (following **T 14/89**, OJ 1990, 432, and **J 13/90**, OJ 1994, 456). Whereas the EPO might be obliged, on the basis of the principle of good faith, to give information on a specific query, a party could not expect a warning in respect of any deficiency occurring in the course of the proceedings (see **J 12/94**; see also Chapter VI.A.2.3 concerning the limits to the EPO's obligations with regard to the protection of legitimate expectations).

4. Time limits excluded from re-establishment under Article 122(4) and Rule 136(3) EPC

Under Art. 122(4) and R. 136(3) EPC, as under the old Art. 122(5) EPC 1973, certain time limits are excluded from re-establishment. Although the provisions of the new law are differently worded (referring to the periods for which further processing is available), most of the exclusions continue to apply. One major exception is the **priority period** (Art. 87(1) EPC). Under the new law, re-establishment in respect of this period is possible (subject to the conditions of R. 136(1), second sentence, EPC). This change to the EPC has no implications for the interpretation of Art. 122(5) EPC 1973, which clearly rules out the time limit under Art. 87(1) EPC 1973 and leaves no room for interpretation in that respect (see **J 9/07**).

Re-establishment does however continue to be ruled out for the time limits for paying the **filing fee, search fee, designation fees** and **examination fee**, and for the time limit for filing the request for examination (see also OJ SE 4/2007).

Hence the decision in **J 11/86** continues to apply. There the board held that a European patent application for which no filing, search and designation fees had been paid in due time was deemed to be withdrawn (Art. 90(3) and Art. 91(4) EPC 1973). The non-payment of these fees was not a correctable deficiency under Art. 91(2) EPC 1973, which the EPO had to give the applicant an opportunity to correct. Thus, the appellants could not derive any right from the non-issuance of a reminder by the EPO and restitutio in integrum was excluded by Art. 122(5) EPC 1973 whether or not such reminder had been sent.

The provisions of Art. 122 EPC 1973 are not applicable to the time limits referred to in paragraph 2 of this Article (**T 900/90**). This exclusion of re-establishment in respect of the time limit for requesting re-establishment (Art. 122(4), R. 136(3) EPC) has likewise remained unchanged.

In **J 12/92** the Legal Board of Appeal ruled that a request for re-establishment in respect of the time limit under Art. 121(2), second sentence, EPC 1973 was possible (see **J ../87**, OJ 1988, 323; **J 29/94**, OJ 1998, 147). As the time limit for requesting further processing is excluded by Art. 121(4) EPC from further processing, under the EPC 2000 this continues to be a case for re-establishment.

However, due to the new relationship between further processing and re-establishment, the broader scope of further processing and the associated deletion of R. 85a and b EPC 1973, case law on the **grace periods under R. 85a and b EPC 1973** is now obsolete. This ruled that the express exclusion formulated with regard to the non-payment of certain fees within the normal time limit also applied in the event of their not being paid within the periods of grace provided for in R. 85a and b EPC 1973, for the obvious reason that to concede that restitutio in integrum applied to the non-observance of those grace periods would allow the unequivocal prohibition contained in Art. 122(5) EPC 1973 to be evaded (see **J 12/82**, OJ 1983, 221; **J 18/82**, OJ 1983, 441; **J 11/86** and **G 3/91**, OJ 1993, 8).

In **J 8/94** (OJ 1997, 17) and **J 25/94** the board confirmed this case law in relation to the new version of R. 85b EPC 1973, which had been in force since 1 April 1989 (see OJ 1989, 1).

The case law on the **exclusion of PCT time limits** under Art. 122(5) EPC 1973 that is summarised below is likewise rendered obsolete by the new law. Due to the deletion of R. 85a EPC 1973, the broader scope of further processing and the clearly defined relationship between further processing and re-establishment (Art. 122(4), second sentence, and R. 136(3) EPC), the issues to which it relates will no longer arise (for details of this case law refer to the 5th edition).

In **G 3/91** (OJ 1993, 8) the Enlarged Board of Appeal held that, contrary to earlier rulings, Euro-PCT applicants were no longer entitled to re-establishment of their rights, if they failed to observe the time limits for the **payment of the national fee, designation fee or search fee**, than were European applicants.

In **G 5/92** and **G 6/92** (OJ 1994, 22 and 25) the Enlarged Board of Appeal decided that the time limits under Art. 94(2) EPC 1973 were thus excluded from re-establishment of rights, no matter whether the applicant had chosen the "direct" European or the Euro-PCT route (see also **J 5/04**).

In **G 5/93** (OJ 1994, 447) the Enlarged Board added that a Euro-PCT applicant could be re-established in the time limit for paying the **claims fees** provided for in R. 104b(1)(b)(iii) EPC 1973 (in the version in force until 1 March 2000) because the direct European applicant was not excluded by Art. 122(5) EPC 1973 from re-

establishment into the time limit to pay the corresponding fees provided for in R. 31 EPC 1973.

In **J 13/03** the board refused the appellant's request for the question of whether Art. 122(5) EPC 1973 applied to PCT applications on entry into the regional phase to be referred again to the Enlarged Board of Appeal for review.

In **T 227/97** (OJ 1999, 495) the board noted that a time limit might only be specifically excluded by Art. 122(5) EPC 1973. The board noted that there could be no presumption of any intention to exclude the time limit of R. 28(2) EPC 1973 from restitutio in integrum under Art. 122 EPC 1973. The protection of the public was safeguarded by the provisions of Art. 122(6) EPC 1973. The board also held that under Art. 48(2)(a) PCT a Euro-PCT applicant who had not carried out a certain procedural act within the time limit prescribed in the PCT might take advantage of the relevant provisions of the EPC 1973 concerning re-establishment of rights (Art. 122 EPC 1973) in all cases where the direct European applicant too might invoke them if he failed to observe the relevant time limit. The board came to the conclusion that the provisions of Art. 122 EPC 1973 were applicable to the time limit set by R. 28(2)(a) EPC 1973 and the equivalent time limit set by R. 13bis.4 PCT.

In **J 1/03** the appellant had requested that restitutio be granted into the time limit under R. 4.9(b)(ii) PCT. The board, however, pointed out that actually there was no time limit in the EPC 1973 which corresponded to the time limit under R. 4.9(b)(ii) PCT. Thus, there was no identical time limit under the PCT within the meaning of **G 3/91** but only a comparable one. The board refrained from a final decision on the application of Art. 122(5) EPC 1973 to the case at issue, as re-establishment could not be granted on the merits of the case.

5. Re-establishment in respect of time limits in PCT protest proceedings

Art. 48(2)(a) PCT states that any contracting state shall, as far as that state is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit. The application of provisions concerning restitutio in integrum is covered by Art. 48(2)(a) PCT, when the necessary conditions are fulfilled. Consequently, a Euro-PCT applicant who has not carried out a certain procedural act within the time limit prescribed in the PCT can take advantage of the relevant provisions of the EPC 1973 concerning re-establishment of rights in all cases where the direct European applicant too may invoke them if he fails to observe the relevant time limit (see **G 3/91**, OJ 1993, 8).

In **W 4/87** (OJ 1988, 425) the board decided that an application for restitutio in integrum could be submitted in cases where the statement of grounds supporting the protest under R. 40.2(c) PCT was submitted late, since Art. 122 EPC 1973 applied in conjunction with Art. 48(2) PCT.

In **W 3/93** (OJ 1994, 931) the request for re-establishment of rights was to enable the protest to be deemed to have been filed within the time limit fixed by the ISA under

Art. 17(3)(a) PCT and R. 40.1 PCT, and, in substance, for examination of the protest. The board held that by analogy with the principles developed by the Enlarged Board of Appeal in **G 5/83** (OJ 1985, 60, points 5 and 6 of the Reasons) for interpreting the EPC 1973, Art. 48(2) PCT should be construed to mean that in the event of a delay in meeting the time limit laid down in R. 40.3 PCT the same legal remedies were available as in the case of failure to observe other comparable time limits under the PCT or EPC 1973 (see also **W 4/87**). The board stated that when re-establishment of rights was granted, the legal situation was restored to that existing prior to the noting of the loss of rights which ensued from failure to observe the time limit. The board of appeal's decision based on failure to observe the time limit was thus rendered invalid, even though it was a final decision. In other words, the granting of re-establishment of rights destroyed the legal validity of the decision, which accordingly did not need to be set aside or amended. As a result, the protest was admissible and had to be examined on its merits.

6. Parties to proceedings

In **T 552/02** the appellants (proprietors) asserted that the respondents should not be a party to the proceedings with respect to the application for re-establishment. They essentially based this assertion on a passage in the Guidelines E-VIII, 2.2.7 (old version), which reads as follows: "The grounds for the decision [on the re-establishment of rights] need only be stated if the application is disallowed. This also applies in opposition proceedings since the opponents are not involved in the procedure for re-establishment of rights". They further held that Art. 15(2) RPBA 2003 obliged the board to state its grounds if it gave a different interpretation of the EPC 1973 to that provided for in the Guidelines.

On the latter point the board said (a) that the members of the board were not bound by any instructions and had only to comply with the provisions of the EPC 1973, which meant the board was not bound by the Guidelines, and (b) that Art. 15(2) RPBA 2003 did not oblige the board to state grounds for deviating from the Guidelines but simply stipulated that it should "state the grounds for its action if it consider[ed] that [its] decision [would] be more readily understood in the light of such grounds".

According to the board, the response to be given to the application for re-establishment was of the utmost importance for the respondents, as it affected the actual admissibility of the appeal and hence the reviewability of the opposition division's decision to revoke the patent in suit. From this the board deduced that it would be a breach of Art. 113(1) EPC 1973 to take a decision concerning the interests not only of the appellants but also of the respondents without giving the latter an opportunity to present comments.

In **T 1561/05** the board came to the same conclusion: Art. 122 EPC 1973, only lays down rules concerning the requester. However, this does not mean that, in re-establishment proceedings taking place in connection with inter partes opposition or opposition appeal proceedings, the requester is the sole party, with party status denied to others. Re-establishment, within the relevant examination or opposition procedure, is a separate, formally established intermediate procedure involving an assessment of whether non

observance of a time limit relevant to a decision has led to the legally prescribed consequences of such non observance or whether, given that the requester exercised all due care required by the circumstances, the act subject to a time limit can be deemed to have been completed in due time. If, therefore, a request for re-establishment of rights is filed in the context of inter partes proceedings, the patent proprietor and the opponent will also be parties to the re establishment proceedings. In the latter proceedings, the party contesting the request has an unlimited right to be heard under Art. 113 EPC 1973.

7. Merit of applications for re-establishment of rights

Under Art. 122(1) EPC, for re-establishment to be allowed the requester must show that he missed the time limit despite taking all the due care required by the circumstances.

7.1. Submissions to be taken into account

In **J 5/94** it was decided that the grounds on which a request for re-establishment of rights was based could be amplified, provided this **completed the submission** that had been filed **in due time** and thus did not alter the basis on which the original request for re-establishment had been filed.

In **T 324/90** (OJ 1993, 33) the board held that **evidence** proving the facts set out in the application could be filed after expiry of the two-month time limit laid down in Art. 122(2) EPC 1973. Only the grounds and a statement of the facts had to be filed within the two-month period. Likewise in **T 261/07** the board allowed the patentee, who had given an account of all the relevant facts to the best of its knowledge on 2 April 2007, to adduce further clarifying **evidence** supporting the case on 31 May and 24 August 2007.

In **J 18/98** the examining division had refused the applicant's application for restitutio in integrum. An appeal was filed against that decision. From the established case law on Art. 122(3) EPC 1973 the board concluded that **facts submitted only with the statement of grounds of appeal** could not be taken into account, since the function of appeal proceedings was only to give a judicial decision upon the correctness of an earlier decision of the department of first instance (**T 34/90**, OJ 1992, 454). On the basis of the submission to be taken into account, the board decided that the applicant had not complied with his burden of allegation and proof. The vague statement that the assistant had been carefully trained and, during random checks, had proved to be knowledgeable and careful was not adequate, since no further details had been given of the selection conditions, of the training and checking, or of the office's mode of operation.

In **T 257/07** the board refused re-establishment of rights into the time limit for filing the notice of appeal because the request for restitutio in integrum as filed within the two months stipulated in Art. 122 (2) EPC failed to show that all due care had been taken. It was only one year after the removal of the cause for non-compliance that the appellant qualified certain statements previously made and added new facts that previously went unmentioned, in particular regarding the system for managing files and deadlines. It transpired from these subsequent submissions that the original request for re-establishment of rights gave only an incomplete picture of reasons for non-compliance,

of how appeals were filed, and of safeguards against errors made. The Board considered that this omission could not be subsequently remedied by the addition of further facts, as case law would only allow the appellant to "submit further evidence which clarifies the facts which were set out in the application for re-establishment" (**J 2/86**, OJ 1987, 362; **T 261/07**).

7.2. Inability to observe a time limit

In the established case law, unawareness of the expiry of a time limit is recognised as an obstacle to its observance, as are persistent financial difficulties incurred by the person concerned through no fault of his own. The former is to be distinguished from a deliberate act on the part of the applicant/representative which is attributable to tactical considerations or a legal error.

7.2.1 Financial difficulties

In **J 22/88** (OJ 1990, 244) the Legal Board of Appeal had to resolve the question as to whether Art. 122 EPC 1973 applied in cases of financial difficulties lasting a fairly long time. The board referred to the "travaux préparatoires" and came to the conclusion that financial difficulties experienced through no fault of one's own and leading to failure to observe time limits for the payment of fees could constitute grounds for granting re-establishment of rights. A prerequisite for granting the request was that the applicant should have tried with all due care to obtain financial support. The board also made it clear that for "all due care" to be proven, it had, of course, to be clear that the financial difficulties were genuine and were due to circumstances beyond the reasonable control of the applicant (see also **J 31/89**, **T 822/93**). In **J 9/89** the board noted that there was no evidence before the board of any effort having been made by or on behalf of the appellant to find financial support during the critical period.

In **J 11/98** the fifth renewal fee for a PCT application was not paid in time and the examining division issued a communication under R. 69(1) EPC 1973 noting that the application was deemed to be withdrawn under Art. 86(3) EPC 1973. The representative requested the EPO to recognise that proceedings were interrupted under R. 90(1)(a) or (b) EPC 1973 (see also chapter VI.D.3, interruption of proceedings) and requested re-establishment in respect of the time limit, on the grounds that at the relevant times in 1996 the appellant (patent applicant) had been seeking protection under Chapter 11 of US bankruptcy law.

The board confirmed the examining division's decision refusing the application for re-establishment. The applicant had not shown that at the relevant time it had been so lacking in funds as to be absolutely unable to make the payment. Only the latter situation had been accepted by the board, in an exceptional case, as a ground for re-establishment. The applicant's submissions showed that non-payment of the fifth renewal fee was due not to an absolute inability to pay but to its business priorities at the time. That could not justify re-establishment.

7.2.2 Tactical considerations

In **T 413/91** the board stated that the word "unable" implied an objective fact or obstacle preventing the required action, e.g. a wrong date inadvertently being entered into a monitoring system. The appellants' reasons for not filing any statement of grounds were that they had expected an agreement with the proprietor, which, however, did not come about. The board stated that such a reason did not justify re-establishment of rights, pointing out that it was an extraordinary means of judicial remedy. It offered no choice to a party as a substitute for the proper action to be taken, nor did it imply any right to have the fatal effect of an **intentional step** cancelled, even if this step later on proved to have been a mistake. A party who had deliberately chosen not to file a statement of grounds for the appeal could not achieve an appellate review through the back door of a request for re-establishment.

In **T 250/89** (OJ 1992, 355) the opponent had claimed that he could not have filed the statement of grounds in due time because he would have needed to refer to documents withheld by a third party. The board confirmed the line taken in earlier decisions (see **G 1/86**, OJ 1987, 447; **T 287/84**, OJ 1985, 333). When determining whether all due care required by the circumstances had been taken, the word "all" was important and failure to observe a time limit had to be the result of an oversight, not a culpable error. The board rejected the application for re-establishment of rights on the ground that the opponent had had sufficient material at his disposal to be able to draw up the statement of grounds in due time in accordance with Art. 108, third sentence, EPC 1973 and R. 64 EPC 1973.

In **T 1026/06** the appellant's patent was granted (according to the communication under R. 51(4) EPC 1973) without the designation DE. The appellant did not appeal against this within the relevant time limit, on the assumption that the designation DE nevertheless remained valid and that the Office would correct this error. Thus the appellant was aware of the time limit, but was unable to comply with it because of a mistake regarding the legal necessity of filing an appeal.

The board drew a distinction between this and the situation in **T 413/91** and **J 2/02**, in which the boards had not recognised the act of intentionally allowing a time limit to expire as an obstacle. However, these two cases differed from the current case, in so far as the parties concerned had deliberately refrained, for motives extraneous to the proceedings, from performing the required actions, whereas the appellant in the current case had been unable to file an appeal because of a mistake of law. The board nevertheless refused the application for re establishment, since the appellant had failed to file it within two months from removal of the cause of non compliance.

7.3. General comments on due care

7.3.1 Introduction

In numerous decisions the boards have ruled on the "all due care required by the circumstances" issue. In considering it, the circumstances of each case must be looked

at as a whole (**T 287/84**, OJ 1985, 333). The obligation to exercise due care must be considered in the light of the situation as it stood before the time limit expired. In other words, the steps the party took to comply with the time limit are to be assessed solely on the basis of the circumstances applying at that time (see i.e. **T 667/92**, **T 381/93**, **T 743/05**, **J 1/07**, **T 1465/07**).

In **T 30/90** the board held that the allowability of applications for re-establishment hinged on whether the conduct of the appellant and/or his representative, during the entire period after the relevant decision, was indicative of "all due care required by the circumstances". In this connection, "all due care" meant all appropriate care, i.e. as much as would be taken under the circumstances by the **average reasonably competent patentee/representative**.

In **J 23/87** the board ruled that exercising due care under Art. 122 EPC 1973 meant that an applicant, when deciding whether to pursue his application, could not rely entirely on **information** provided voluntarily by PCT authorities and the EPO at various stages of the procedure, and instead had to ensure that he was normally able to comply with the basic PCT and EPC 1973 time limits even if he received this information late or not at all.

In accordance with the established case law of the boards, re-establishment cannot be justified by ignorance or **misinterpretation** of an EPC provision. This also applies to individual applicants without a representative (**J 2/02**). With regard to re-establishment in respect of disciplinary proceedings and the European Qualifying Examination, the board ruled in **D 6/82** (OJ 1983, 337) that a mistake of law, particularly one regarding the provisions on notification and calculation of time limits, did not, as a general rule, constitute grounds for re-establishment of rights. The obligation to take "all due care required by the circumstances" meant that persons engaged in proceedings before or involving the EPO had to acquaint themselves with the relevant procedural rules.

For cases where the cause of non-compliance with a time limit involves some error in the carrying out of the party's intention to comply with the time limit, the case law has established the criterion that due care is considered to have been taken if non-compliance with the time limit results either from **exceptional circumstances** or from an **isolated mistake within a normally satisfactory monitoring system** (**J 2/86**, **J 3/86**, OJ 1987, 362; **T 428/98**, OJ 2001, 494 and **T 785/01**; for the requirements to be met by an individual applicant without a representative, see also below point 7.4.1b)). In the latter case, the relevant party must show that the system normally works well (see e.g. **J 9/86**, **J 27/88**, **J 28/92**, **T 27/86**, **T 166/87**, **T 715/91**, **T 612/90**, **T 731/91**, **T 179/92**, **T 371/92**, OJ 1995, 324; **T 377/93**, **T 956/93**, **T 681/95**, **T 1062/96**, **T 186/97**, **T 428/98**, OJ 2001, 494 and **T 785/01**).

7.3.2 Exceptional circumstances

a) Organisational upheaval

In **T 14/89** (OJ 1990, 432), due to **internal reorganisation and removals**, the R. 58(5) EPC 1973 communication was put into the wrong removal carton and

consequently did not reach the responsible department of the patent proprietor. The board found that this fact, which led to non-observance of the time limit, constituted an isolated mistake such as could not be ruled out despite careful company organisation. The conditions for re-establishment of rights were therefore met.

In **T 469/93** the board found that even if all due care required by the circumstances were to be exercised, the occasional error during **complex transfers of company ownership** could not entirely be avoided. The error in this case being an exceptional one, the causes of which had since been removed, the appellant's request for re-establishment of rights was to be allowed.

In **J 13/90** (OJ 1994, 456) the applicant, a small firm employing about 15 people, was in **takeover** negotiations with another company. In the course of the negotiations a change of attorney took place. As a result of the unforeseeable breakdown in negotiations plus the fact that action had already been taken to replace the previous attorney, payment of the fourth-year renewal fee had been overlooked. This isolated mistake in a special situation was, in the board's opinion, excusable and the requested re-establishment of rights was therefore granted.

In **J 21/92** and **J 24/92** the applicant and his representative (both Americans) had each changed their **fee-monitoring system**, independently of each other. The situation was further complicated by the fact that the representative was no longer responsible for paying the appellant's renewal fees.

In **T 369/91** (OJ 1993, 561) the relevant circumstances involved **moving from a manual to a computerised time-limit monitoring system**. Here "due care" meant ensuring that during the changeover period the representatives handling the various kinds of cases were told which system - manual or computerised - had generated the reminder in question. Only then could they reliably know if and when a further reminder was likely.

In **T 489/04** the board did not recognise the **installation of a new computer system** as an extraordinary circumstance. On the contrary, it considered the resulting burden on employees as foreseeable and containable, had appropriate measures been taken in good time.

In **J 11/06** the appellant submitted that, due to the removal and later change of the US representative, there was some confusion caused by this reorganisation. However, the board noted that no details at all had been given as to why this affected the payment of the renewal fee. Likewise in **J 4/07** the board did not recognise the presence of exceptional circumstances because the representative's submissions were inadequate.

b) Sudden serious illness

In **T 525/91** the board found it credible that the sudden and unforeseen diagnosis of illness and the announcement of the urgent need for a major operation caused the appellant's representative not only great physical weakness but also severe psychological stress. In those circumstances, and in view of the short period between

diagnosis and hospital admission (two working days) and the proven absence of the secretary on one of those working days, it had to be acknowledged that even on the days between diagnosis and admission the representative had been in an exceptional situation which impeded him from devoting the necessary attention to the imminent time limit and taking the precautions needed to ensure that it was observed. In the circumstances the board deemed the conditions for re-establishment to have been met (see also the reference in **T 1401/05** to **T 558/02**).

One thing that must be borne in mind in this context however is the case law on requirements governing a satisfactory system for monitoring time limits, which has to include an **effective system of staff substitution in case of absence**. Re the duty of care in a large firm see **T 324/90** below; re the applicant's duties see **T 1401/05** below; re the duties of a representative running a one-person office see **J 41/92** below; and re the duty of care of an individual applicant see **J 5/94**.

7.3.3 Isolated mistake within a satisfactory system for monitoring time limits

a) General principles

An isolated mistake in a normally satisfactory system is excusable (see for example **T 1024/02**, **T 165/04** and **T 221/04**); the appellant or his representative must plausibly show that a normally effective system for monitoring time limits prescribed by the EPC was established at the relevant time in the office in question (**J 2/86**, **J 3/86**, OJ 1987, 362; and **J 23/92**).

The fact that this system operated efficiently for many years was **evidence** in many decisions that it was normally satisfactory (see **J 31/90**, **J 32/90**, **T 309/88** and **T 30/90**). In **T 130/83** the board stated that if a proper reminder system had been instituted by a representative, in order to guard against the consequences of oversight in a busy office, this was itself strong prima facie evidence of the taking of care by the representative (see also **T 869/90**, **T 715/91**, **T 111/92**).

However, in **T 1465/07**, the board disagreed with the view that a monitoring system of time limits can be held to have been normally satisfactory because it worked without previous problems and consequently accept that all due care had been taken even though doubts exist. Evidence that such a monitoring system operated efficiently for many years will weigh in favour of a finding of a normally satisfactory character but will be counterbalanced by evidence that main features of such a character, such as an independent cross check, go missing. In that case a satisfactory character will be excluded.

In **T 580/06** the board had to rule on an **isolated failure to meet a time limit** in a well-organised system, even though the **cause** of the failure ultimately **remained unclear**. The appeal fee had not been paid in due time because the appellant's representative's deposit account had not contained sufficient funds. The Office was able to prove that the fax requesting the representative to replenish his account and issue a debit order for the administrative fee in accordance with point 6.5 ADA had entered the representative's

domain. The representative maintained that he had known nothing about the fax, but was unable to explain why the time limit had been missed or to provide relevant evidence in his favour, although he was able to show satisfactorily that time limits had previously never been missed in his well-organised office. One reason why it was not possible to clarify what had happened to the fax within the representative's domain was that he had not activated his fax machine's received-data recording function. The board took the view that the difficulty of finding out what had happened to the fax could not be attributed to lack of due care on the representative's part and was not inconsistent with the assumption that it was an isolated mistake within an otherwise well-organised system. That applied in particular to the fact that the representative had at that time not activated his fax machine's received-data recording function, as that function had no significance in relation to the organisation of the monitoring system. The board therefore saw no reason to overrule the case law which ruled that an isolated failure did not imply generally deficient organisation.

In **T 283/01** of 3.9.2002 the board pointed out that the applicant's system was not properly designed to handle the appeal in question, involving partial responsibility of an external representative. The **deviation from the normal way of filing** and prosecuting an appeal had been the applicant's deliberate decision in the particular circumstances of the case. The failure to take note of the time limit for filing the statement of grounds of appeal had been a consequence of that deviation. On the contrary, the board held that taking all due care required by the circumstances of the case should have implied installing an individual control mechanism, offering a realistic possibility of detecting and correcting the failure to note and calculate the time limit for filing the statement of grounds. However, it was clear from the facts submitted by the appellant that no such measures had been taken.

In **T 808/03** the board held that the condition of "an isolated mistake by a usually reliable person" was not met in the present case, as the responsible person had made a **second** mistake when processing the reminder of a system for monitoring time limits.

In **T 261/07** the letter containing the appealed decision never reached the Central Intellectual Property Department of the patentee. Rather the letter only reached an **intermediary delivery service** that received and distributed mail within the patentee's premises. Concerning the issue of all due care taken in setting up a system for properly monitoring incoming mail, the board observed that the patentee was not even able to name the person who had signed for the receipt of the letter, let alone demonstrate that such a person was properly qualified for the tasks he or she was entrusted with. Due to the routine deletion of data, it could not be demonstrated that the person who signed for the receipt duly entered the letter into the mail room's database. Nor was it demonstrated that the other persons who worked in the mail room and who might have taken the letter from the mail room to the Central Intellectual Property Department were properly chosen and trained. Further, there was no effective cross check. Such a failsafe system would have required a regular comparison between the mail room database and the database of the Central Intellectual Property Department in order to discover discrepancies.

In **T 473/07** the board held that the representative's practice of checking only the dates entered by his records clerks while relying on the resulting time limits calculated by the computerised system did not rule out errors. Modern real-world offices comprised computerised systems but **program deficiencies** were also a well-known part of that reality and could not be absolutely ruled out. Therefore, relying exclusively on a time limit generated by a computer program and refraining even from a plausibility check did not meet the all-due-care requirement.

b) Small firms/companies

In **T 166/87** of 16.5.1988 the board held that the question whether a particular arrangement used in a particular office to ensure that procedural acts such as the payment of fees were completed in due time satisfied the requirement of "all due care" in Art. 122 EPC 1973 had to depend on the individual circumstances of each case (**J 9/86**). In the board's view, what had to be considered was whether the system during normal operation was reasonable and normally satisfactory, and therefore such as to establish that the applicant had used "all due care required by the circumstances" in his efforts to observe the time limit in question. The board held that in a relatively small office, normally working in an efficient and personal manner, employing normally reliable personnel, a cross-check mechanism, especially in relation to one-off payments such as an appeal fee, could fairly be regarded as superfluous.

In **J 31/90** the board took the view that this system, while far from perfect, could be considered in the special circumstances of the case to be normally satisfactory. The board emphasised, however, that the system could only be so considered because of the particular conditions in which the representative and her secretary worked. Over a period of ten years, working together alone in a small office they had built up an excellent working relationship and mutual trust. The board was satisfied that the system had worked well over a considerable period of time. The fact that this system operated efficiently for many years was evidence that it was normally satisfactory (see also **J 33/90**).

In **T 73/89** the board rejected the application for re-establishment of rights because, in order to work properly, the normally satisfactory diary system required a qualified attorney to check whether, in any particular case, an extension was necessary or possible; in this case no such check was made.

In **T 428/98** (OJ 2001, 494) the board stressed the exceptional nature of the ruling in **J 31/90** and **T 166/87** and said that according to the appellant's submission his representatives' office was staffed by two patent agents, two lawyers, a partly qualified patent lawyer (*Patentassessor*) and a law graduate, i.e. six people dealing in their main professional capacity with cases relating to intellectual property rights. Such cases being commonly subject to time limits, with immediate negative legal consequences for the client if they were missed, time-limit monitoring in such an office was a major undertaking in terms of both significance and scale. The board therefore deemed a cross-checking mechanism to be essential.

In **J 11/03** the board confirmed that the organisational requirements for a generally efficient time-limit monitoring system were subject to variation on account of the firm's size and nature and the number of time limits that had to be monitored. A cross-checking mechanism may in certain circumstances be regarded as superfluous in a small firm employing normally reliable personnel and normally working in an efficient and personal manner, but not in a large company with its own patent department (**T 166/87**). The appellant was a very small firm with a commercial division essentially comprising only the commercial manager and the book-keeper. For the application in suit, the commercial division was handed a list of the payments to be made, with a schedule for their payment. The book-keeper was normally extremely correct and conscientious in her work. The board found that in the circumstances additional checking that payments had actually been made might be deemed superfluous without impairing the functioning of the system.

In **T 1260/04** the statement setting out the grounds of appeal was deemed not to have been received, as it was only filed electronically. However, the appellant had his rights re-established, as the board was satisfied that the failure to comply with the time limit represented an isolated mistake within a satisfactory system for monitoring time limits. The following practice was normally applied in the representative's office: in order to ensure a consistent internal electronic record of documents, all communications were sent to the EPO in electronic form, but a confirmation copy was sent by fax or courier where a paper copy was still required by the EPO. A docketing system existed which ignored the "ten day rule". The statement setting out the grounds of appeal was filed electronically on 7 October 2004. The filing of the written grounds of appeal was docketed for action by the representative in the docketing system before an internal deadline of 8 October 2004. Since the representative was working late, he decided to send the follow-up paper copy at a later date, conscious that the time limit would not expire until 18 October 2004. Due to an oversight in the week that followed, the paper copy was not sent by fax as intended. The board considered this an isolated mistake due to exceptional circumstances in the case.

In **J 41/92** (OJ 1995, 93) the Legal Board of Appeal found that a careful and diligent professional representative had, in any case, to be expected to take into account that he or she might fall ill and be prevented for some time from taking care of time limits. Therefore, if a professional representative ran a one-person office, appropriate provisions needed to be made so that, in the case of an absence through illness, the observance of time limits could be ensured with the **help of other persons**. If there was no substitute or assistant at the representative's office, co-operation with colleagues or with a professional association could, for example, be sought for this purpose.

In **T 1401/05** the Board followed decisions **T 324/90**, **J 41/92** and **J 5/94** and deemed it necessary that **reasonable provisions for absence** due to the illness of a person who is in charge of monitoring time limits are made, unless in the particular circumstances of a case imposing such provisions would have to be considered as an undue burden. Only where any necessary provisions have been taken will it be possible to deem the monitoring system of time limits to be "normally satisfactory" (see **T 324/90**), which is a condition for a finding of due care and, thus, for considering illness to be an excuse for

not meeting a deadline. Regarding the need for a back-up in the specific case, the Board considered it of relevance that the number of time-limits to be complied with was small (the appellant filed only a few patent applications per year). Under these circumstances, the Board accepts that it was not necessary for meeting the standard of due care to make specific provisions for the unforeseeable two-day illness of the sole employee in charge of monitoring of time limits; more specifically, no substitute for him had to be appointed. The Board further found that the employee in charge, who came to suffer from an unexpected illness on the last two days of the appeal term, fulfilled his obligation to exercise due care when he waited with giving instructions until the last two days of the time limit.

c) Large firms/companies

In **J 9/86** the board was of the opinion that in a large firm where a large number of dates had to be monitored at any given time, it was normally to be expected that at least one effective cross-check was built into the system (**T 223/88**, **J 26/92**, **T 828/94** and **T 808/03**).

In **T 828/94** the board noted that a monitoring system should contain an **independent cross-check** to prevent the misunderstanding between a representative and a technical assistant from assuming that a notice of appeal would be prepared and filed on time by the other person, for example, someone would be responsible for checking independently of the representative and the assistant. The board noted that where a misunderstanding was likely to arise as a result of the two being responsible for the same file, the assistant should have clear instructions on how to proceed.

Concerning the need for an independent cross-checking mechanism and the form it should take, see also **T 428/98** (OJ 2001, 494), **T 1172/00**, **T 785/01**, **T 36/97**, **T 622/01**, **J 1/07** and **J 13/07**. In **T 257/07** the board emphasized that an independent cross-check must necessarily include either **another person** or an automated system alerting another person.

In **T 686/97** of 12.5.1998 the board observed that reminder systems normally satisfactory to ensure compliance with other rules of procedure under the EPC could not be satisfactory in the context of appeals to the boards, whose function is to provide a final judicial review under the EPC. The board recognised that the specific remit of the administrative section, in particular the limitation of its function to a strictly non-interpretative application of relevant rules and time-limits, was and remains the only practicable one, and therefore found it to be normally satisfactory. It pointed out, however, that the reminder system used by the applicant for restoration, a corporate patent department, relied solely upon the ascertainment of and compliance with relevant time limits as contained in various EPO forms and/or notices published in the Official Journal. Thus, the reminder system contained a significant, if not overwhelming reactive component and correspondingly lacked reliance on internal legal analysis and resultant administrative measures. The provision of a "redundant" or "failsafe system" is an essential component of a normally satisfactory reminder system in corporate departments. The failure to provide administrative reminders to the responsible patent

attorneys of the time limits applying to the filing of statements of grounds of appeal was incompatible with the operation of a normally satisfactory system and therefore the exercise of all due care within the meaning of Art. 122(1) EPC 1973.

In **T 324/90** (OJ 1993, 33) the board held that in a large firm, where a considerable number of deadlines had to be monitored at any given time, it had normally to be expected that at least **an effective system of staff substitution** in the case of illness and for absences in general was in operation in order to ensure that official documents such as decisions by the EPO, which started periods within which procedural steps had to be carried out, were properly complied with. From the facts submitted in this case it had to be concluded that no appropriate precautions had been taken in the event of unexpected absences on the part of staff responsible for monitoring time limits.

In **T 677/02** the board decided that a large enterprise had not exercised all the due care required by the circumstances if, when the representative actually responsible was on **short time working**, no **deputy** had been designated to crosscheck the input of time limits into the system for monitoring time limits.

7.4. Persons required to exercise due care; requirements regarding due care

Primarily it is up to the applicant (patent proprietor) to show due care. If third parties act for him he has to accept their actions on his behalf (see **J 5/80**, OJ 1981, 343). The "due-care" obligation is assessed differently, depending on whether an applicant, his representative or an assistant is involved.

7.4.1 Due care on the part of the applicant

a) General principles

In **J 3/93** the board ruled that the duty to exercise all due care stipulated by Art. 122 EPC 1973 applied first and foremost to the applicant and then, by virtue of the delegation implicit in his appointment, to the professional representative authorised to represent the applicant before the EPO. The fact that the representative had acted correctly did not exempt his client from suffering the consequences of his own mistakes, or even negligence (see also **J 16/93**, **J 17/03**).

In **T 381/93** the board of appeal observed that the applicant was entitled to rely on his duly authorised professional representative to deal with the EPO. However, the board held that to the extent that he was on notice that a time limit had not been met and/or that instructions were required in order to meet it, an applicant had a duty to take all due care in the circumstances to meet the time limit.

In **J 22/92** the board held that the applicant, who had appointed US attorneys for the purpose of the PCT application, was entitled to believe that a copy of a communication had been sent to the US attorneys as well. The board referred to the principle of proportionality and stated that the loss of the patent application as a result of what may be considered at most a minor procedural irregularity would otherwise appear an

extremely severe result. The board held that, in the case in point, the due care to be considered was in fact not that which was expected from a professional representative but that which was expected from an applicant unaware of the proceedings.

b) Unrepresented individual applicant

In **J 5/94** the board made allowance for the fact that the appellant was an individual applicant who had not appointed a representative and who was neither familiar with the requirements of the Convention nor in possession of an established office organisation attuned to ensuring that procedural deadlines were met. The board pointed out that in such a case the **same standards** of care as those required of a professional representative or the patent department of a large firm could **not** be applied.

At the same time, an individual applicant was also obliged to exercise due care in the course of the procedure. Accordingly, when not using the services of a professional representative, he must himself take all possible steps to ensure that he can do, properly and punctually, whatever is required during the grant procedure to prevent any loss of rights. He is not entitled either to invoke general ignorance of the law or to leave undone anything which may reasonably be expected of him with a view to observing time limits (**J 5/94**, **J 27/01**, **T 671/02**, **J 2/02**, **J 6/07**, **T 493/08**).

In **T 601/93** the appellant was not aware of the need to file a statement of grounds within the time limit. The board held that any legal error which might have led the appellant to believe that the requirement was not to be observed would exclude the application of due care, considering the unequivocal provision in Art. 108 EPC 1973 (concerning a **mistake of law** by an individual applicant without a representative, see also **J 2/02**).

In **T 122/91** the board held that due care had not been exercised if the head of an office went off on a journey without informing his deputy of matters requiring immediate attention because a time limit was involved.

c) Using an non-authorised representative

In **J 23/87** the applicant failed to furnish a translation of an international application within the time limit prescribed by Art. 22(1) PCT in conjunction with Art. 158(2) EPC 1973. The appellant, a small Japanese firm with limited financial resources, submitted that a Japanese patent attorney without special knowledge of PCT matters had been consulted, and that this attorney incorrectly informed the appellant that "filing in designated countries could be made within twenty months from the PCT filing date" (instead of, correctly, the priority date) and that, due to this mistake in combination with the lack of official information, the appellant was unaware of the need to take action before the EPO at the relevant time. The board held that for an applicant who lacked the necessary knowledge of the PCT and the Convention procedures, it was obviously necessary to consult a competent professional representative in order to cope with the procedures involved in such a patent application. Thus, the board was not satisfied that the appellant, being completely ignorant about the special procedure to be observed in this case, had chosen a sufficiently competent professional representative and let him

properly advise the appellant on the matters involved having had an opportunity to study the details concerning the present application. The board added that a mistake of this kind on the part of a professional representative, even properly consulted, could hardly be accepted as a ground for granting *restitutio in integrum*.

7.4.2 Due care on the part of the professional representative

a) General issues

The extensive case law on a professional representative's duty of care in **dealing with assistants** is dealt with in point 7.4.4.

In **T 112/89** the board stated that, regarding the due care required by Art. 122(1) EPC 1973, the obligations of the applicant and those of his representative were clearly distinct and that the due care to be exercised by the representative might depend on the **relationship which existed between him and his client**. The board noted that it was clear that both the representative and the applicant had to exercise all due care in order to observe all the time limits during patent granting procedures. In the case at issue, the board was not convinced that the duty of the representative was fully discharged when he had notified his client that a time limit was to be observed and was satisfied that the client had received the notification. On the contrary, the board was of the opinion that when a representative had been instructed to lodge an appeal and did not receive in due time from his client the necessary additional instructions he needed to discharge his duty, he should take all necessary measures to try to obtain from his client these instructions.

In **T 1095/06** the board stated that a professional representative must be presumed to be supervising his own work continuously. The case law on "an isolated mistake in an otherwise satisfactory system" could not be relied on to ignore a failure to act by the professional representative himself, unless there were special circumstances which made the failure to act compatible with taking all due care. A belief that an action had been performed for which there was no objective basis could not be given any weight as a circumstance to be taken into account under Art. 122(1) EPC 1973. Furthermore, the board held that neither the importance of an application to an applicant, nor the technical merit of the invention concerned, were circumstances that could be taken into account in favour of allowing re-establishment.

In **J 16/93** the board stated that a representative who had not received **any funds** for the **purpose of paying the renewal fee** and whose authorisation was silent in this respect was not expected to advance moneys on behalf of his client out of his own pocket. As the client was, in this situation, free to abandon its application by ceasing to pay the fees demanded by the Convention, the representative risked effecting a payment which he would not be able to recover either from the EPO (even though his client had not wished the payment to be made), or from the client, if the authorisation was silent in this respect.

In **J 19/04** the board confirmed that a professional representative is not obliged to pay renewal fees on his client's behalf if he has received no instructions to do so. However,

the representative's conduct has to be assessed according to the extent to which he has done all that is necessary to ascertain the **client's true wishes** (see also **J 1/07**). It is not the number of (unanswered) reminders that is decisive, but when those reminders were sent in relation to the date on which the time limit expired, how the reminders were formulated and what the representative's duties were in relation to the client.

In **T 1401/05** the board referred to the previous case law concerning a representative's duty to remind his client of due dates. In the present case, the communication between the representative and his client (patent applicant) worked efficiently, the last contact having taken place roughly two weeks before the expiry of the time limit. The board was of the opinion that the representative was entitled to rely on his client's awareness of the expiry of the time limit. The representative was therefore not required to issue a further reminder to meet his obligations of due care. Since the only cause for the missed term was the physical inability of the patent applicant to act during his illness and not any overlooking of the deadline as a result of a deficient monitoring system, the application for re establishment of rights was allowed.

In **J 11/06** the board held that according to the established jurisprudence of the Legal Board of Appeal following decision **J 27/90**, even if renewal fees were paid by someone else, the appointed professional representative remained responsible in the procedure before the EPO, and had to take the necessary steps to ensure payment if intended (likewise **J 1/07** and **J 4/07**). No reasons had been submitted as to which concrete steps had been taken. The board distinguished the case at issue from **T 14/89** and **J 13/90**. In both these cases, specific reasons were given as to why the mistakes happened, and corroborating evidence was filed. In **J 4/07** the European representative had every reason to believe that it was the appellant's intention to continue prosecution of the application in suit. Under these circumstances the Board did not consider that it was sufficient for the European representative only to send a single reminder more than four months prior to the expiry of the critical term.

In **T 338/98** the appellant was first represented by professional representative A, but later asked him to transfer all files to a new representative B. One European patent application failed to be transmitted. Although the representatives were aware that the renewal fee was due for this application, they did not reach clear agreement about paying it, with the result that the fee was not paid and the application was deemed to be withdrawn. The board held that in these circumstances it did not appear appropriate formally to delimit the individual responsibilities of each of the representatives during a **transfer of cases** requiring, by its very nature, close co-operation between the persons involved and naturally leading to overlapping responsibilities. The fact that in these circumstances the representatives had been unable to reach agreement about the way to proceed and that the appellant had not been informed of the outstanding renewal fee and of the disappearance of the file in question was not an indication that all due care required by the circumstances had been taken at that moment. The board did not allow re-establishment of rights.

In **J 16/92** the board made it clear that anyone getting himself into a situation where he could not be sure of being able to complete the omitted act ran the risk of his request for

further processing being ruled inadmissible for failure to complete the omitted act in good time. In this case the representative had not started working on the file until four days before expiry of the time limit for further processing and hence had discovered too late that he was unable to find the first communication to which he was to respond.

In **J 1/03** the board emphasised the paramount importance of the **designation of receiving Offices** and the difficulty or even impossibility, in many cases, of correcting wrong or missing designations. Consequently, the benchmark for what "all due care" meant in those cases, was very high. Likewise the check of the content of the international application on the basis of the "Notification of Receipt of Record Copy" issued by the International Bureau had to be made very carefully.

b) Ignorance of or erroneous interpretation of a provision of the EPC

In **J 3/88** the board noted that account should be taken of the fact that under Art. 134(1) EPC 1973 the contracting states had in principle confined representation of applicants before the EPO to "professional representatives" who, by virtue of their qualification should guarantee the best possible representation. The board stated that it followed that a representative could not relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fell upon him personally, such as, for example, the interpretation of laws and treaties. If he delegated such tasks to an employee and if the latter made an error in the course of that work which resulted in the failure to observe a time limit, the representative could not claim that he had taken all due care required by the circumstances (see also **J 33/90**).

In **J 31/89** the Legal Board of Appeal confirmed that erroneous interpretation of the EPC **owing to a mistake of law** on the part of the duly authorised representative with regard to the rules for calculating time limits (in the case in point, regarding the late payment of a renewal fee together with the additional fee) could not be excused. The appellant and the representative failed to determine correctly the last date for valid payment of the renewal fee (see **J 42/89**, **T 853/90** and **T 493/95**).

In **T 624/96** the board expressed doubts about the nature of the original mistake, which concerned calculation of the time limit for filing the statement of grounds of appeal. This was possibly a "mistake of law" caused by ignorance or misinterpretation of the provisions of the EPC, as in e.g. **J 31/89** or **T 853/90**. The board found that in the circumstances of the case at issue, however, the agent had not made a "mistake of law" of this kind. The agent cited an earlier appeal in which he had represented the same applicant, and after verifying this the board concluded that he therefore did indeed have some familiarity with the appeals procedure. He also submitted programmes of training courses, organised by IRPI (French institute for research into intellectual property) and the Paris chamber of commerce, at which he had given talks on European patents and EPO proceedings. This too indicated that the agent in question was regarded by users as reasonably familiar with such proceedings. The board therefore allowed the applicant's request for re-establishment.

In **J 28/92** the board held that the misinterpretation of a provision of the EPC by a representative was not without basis or unreasonable and considered that there was no basis for penalising the representative for having arrived at a **not unreasonable interpretation** of a rule of the EPC, which subsequently turned out to be wrong. The missed time limit was actually the result of the failure of the representative's secretary to carry out his instructions correctly. The representative of the applicant could show that he had a normally effective system for monitoring time limits and that he had duly instructed the reliable secretary. The board observed that the representative's interpretation of a legal provision of the EPC was not the result of, and did not lead to, a failure to exercise all due care required by the circumstances.

In **T 493/08** the board shared the view expressed in **J 28/92** and stated that there might be exceptions to the rule, that an error of law could not be excused, which, however, could be acknowledged only under rigorous criteria.

In **T 516/91** the mistake made by the representative was that he requested **an extension of two months for submitting the grounds of appeal**. The board emphasised that the time limits set by Art. 108 EPC 1973 could not be extended. In mistakenly believing that an extension of these time limits was possible, the representative failed to exercise due care (see also **T 248/91** and **T 853/90**).

Likewise, in **T 460/95** the representative requested an extension of the time limit, although, in his professional capacity, he should have known that time limits under Art. 108 EPC 1973 could not be extended. The board noted that representatives were expected to be acquainted with the provisions of the EPC regarding time limits, and that the representatives in question had not been as vigilant as the situation demanded. In this specific case, however, the board found that the representative had taken the precaution of contacting the Registry of the Boards of Appeal beforehand, prior to his failure to observe the time limit, and had received information from that body which had led him to take action prejudicial to his interests. The board took the view that the appellants should not suffer injury merely because they had relied on **information** received from the EPO which later proved to be mistaken or likely to have been misunderstood. The board considered that the principle of trust constituted a further reason for acceding to the patent proprietor's request, and therefore, for acceding to the request for re-establishment of rights.

In **T 881/98**, the appellant's professional representative had written to the Registry of the boards of appeal requesting a two-month extension to a time limit, without giving reasons or indicating that the time limit in question was for submitting the statement of grounds of appeal. He added that if not notified to the contrary he would assume his request was allowed. Only after the time limit had expired did the appellant learn, following a telephone call between the representative and the Registry, that the time limit was not extendable and the appeal was therefore being dismissed as inadmissible. The communication to that effect was issued two days later. The appellant requested re-establishment of rights. He cited the **principle of the protection of legitimate expectations** - the Registry should have noticed the mistake and drawn attention to it in time.

The board refused the request for re-establishment. First, it confirmed the boards' case law whereby ignorance or misinterpretation of EPC provisions was no excuse for non-compliance with the time limit in question. Nor did it consider the Registry to have fallen short of legitimate expectations, as in this case (in contrast to **T 460/95**) the appellant had not been misled to his detriment by wrong information from the Registry but had himself made the mistake of thinking that the time limit could be extended. Nor, in the circumstances, was it easy for the Registry to realise the appellant's mistake, because the extension request was easily confusable with a routine one, especially since it was in a standard form.

In **T 733/98** the board informed the appellants that the statement setting out the grounds of appeal did not comply with Art. 108, third sentence, EPC 1973. The appellants requested re-establishment in respect of the time limit for filing the statement of grounds, arguing that they had relied on Legal Advice No. 15/84 of the EPO, which had still been in force when they had received the communication under R. 51(4) EPC 1973. The board held that the appellants had misinterpreted the Legal Advice in question, having failed to realise that the procedure for handling main and auxiliary requests which it described no longer applied once amended R. 51 EPC 1973 entered into force. The board decided that the requirement of all due care required by the circumstances within the meaning of Art. 122(1) EPC 1973 was not met in this case. The request for re-establishment was refused and the appeal rejected as inadmissible.

7.4.3 Due care on the part of a non-authorised representative

In **J 3/88** the US patent attorney of a "non-resident" applicant acted in collaboration with the duly appointed professional representative. The board held that as regards the requirement of "all due care" within the meaning of Art. 122(1) EPC 1973, the **US patent attorney** had to be regarded as the agent of the appellant. Thus, in order to comply with this requirement, it had to be established that the US patent attorney had taken the due care required of an applicant for or proprietor of a European patent by Art. 122(1) EPC 1973.

In **J 25/96** the board held that where a US applicant availed himself of the services of a US patent attorney for matters which in relation to the EPO fell within the applicant's responsibility, the US patent attorney had to be regarded as the agent of the applicant. Thus, to meet the "all due care" requirement, the **US patent attorney** had to show he had taken the due care required of an applicant.

In **J 4/07** the Board pointed out that a non-European representative can be held responsible for meeting the obligations of any representative whose duty it is to care for his client's interests, irrespective of whether such representative is entitled to represent before the EPO or any other patent office (see **J 25/96**). The monitoring of specific time limits that were set expressly does not depend on knowledge of EPC law. Thus a non-European representative must also establish a **reliable monitoring system** for such time limits. Furthermore, any representative, whether European or non-European, moving from one law firm to another must take provisions upon entry in that firm that those filed that he carries over are integrated into a time limit monitoring system.

According to the established jurisprudence, if an agent is appointed, the agent has also to observe all due care and if he does not act accordingly this is imputed to the applicant. In **J 3/08** it was clear that the agent, by not acting as instructed, had not properly handled the case. The board questioned whether, in the exceptional situation of a fraud committed by an agent, it would be justified that such a behaviour, which an applicant cannot normally anticipate and against which he can take no precautions, is also to be imputed to him. According to the board, if fraud by an agent were to be accepted as a reason for re-establishment of rights, by derogation from the general principle that an agent's behaviour was imputed to the applicant, the evidence presented must be so conclusive as to convince the board that a fraud took place as opposed to just unprofessional behaviour.

7.4.4 Due care in dealing with assistants

a) Introduction

Numerous decisions of the boards of appeal deal with the legal question: under what circumstances a mistake by an assistant may be imputed to the representative of a party, and hence to that party.

The case law concerning due care on the part of professional representatives' assistants was established in **J 5/80** (OJ 1981, 343). This key ruling by the Legal Board of Appeal lays down that a request for re-establishment of rights can be acceded to in the event of a culpable error on the part of the assistant, if the professional representative is able to show that he has **chosen** for the work a suitable person **properly instructed in the tasks to be performed**, and that he has himself exercised reasonable **supervision** over the work (see also **T 191/82**, OJ 1985, 189; **T 105/85**, **T 110/85**, OJ 1987, 157; **T 11/87**, **T 176/91** and **T 221/04**). Where an assistant has been entrusted with carrying out **routine tasks** such as typing, posting letters and noting time limits, the same strict standard of care is not expected as is demanded of the representative himself (**J 16/82**, OJ 1983, 262; **J 33/90**, **J 26/92**, **T 221/04** and **T 43/96**). Decision **J 5/80** also pointed out that, if other than **routine tasks** are delegated which normally would fall to the representative by virtue of his professional qualification, the representative would not be able to establish that he exercised all due care (see also **J 33/90** and **T 715/91**). More recent decisions stress that responsibility in every respect passes to the representative as soon as he is presented with the file for processing, and that to that extent he is not justified in relying on an assistant's calculation of a time limit (see point (c) below).

Regarding the **burden of proof** in the form of an adequately detailed statement in connection with the duty of care in the selection, instruction and supervision of assistants, see **J 18/98**.

b) Selection, instruction and supervision

It is incumbent upon the representative to choose for the work a **suitable person**, properly instructed in the tasks to be performed, and to exercise reasonable supervision over the work (**J 5/80**, **J 16/82**). These duties are incumbent upon him also with regard to

substitutes for holidays, special leave and other emergency situations. New assistants must be supervised on a regular basis for a period of at least some months (see **J 3/88, T 715/91**).

The case law cited above applies equally to a patent attorney residing in the USA (or his assistants) if he acts in collaboration with the duly appointed professional representative. In **J 3/88** the US patent attorney of a "non-resident" applicant acted in collaboration with the duly appointed professional representative. The "**docket clerks**" (assistants of the US patent attorney) were entrusted with the performance of routine tasks such as noting time limits and checking due dates. The board stated that in order to be able to carry out these admittedly rather simple tasks properly, they needed nevertheless some **basic knowledge**. In particular, the docket clerks should be familiar with the meaning of the various existing time limits for the payment of renewal fees they had to handle as well as the legal consequences in case a particular prescribed time limit was not met. In addition, they had to be able to identify the critical dates of a patent application and to record them on an "index card". Finally, the docket clerks ought to be acquainted with the conditions and modalities of informing the US patent attorney in charge about the due dates to be observed. Above all, they should know how to proceed when a fees reminder sent by a professional representative was received by the office of the US patent attorney. The board concluded that, although no special qualifications were required, it was fairly impossible for a docket clerk to perform these routine tasks satisfactorily without having previously been given appropriate instruction and being supervised closely until he was familiar with the job.

A reasonable **supervision** of the activity of a newly engaged docket clerk implied that his work be periodically checked. In order to be effective and avoid culpable errors, these periodic checks should not be initiated mainly by the docket clerk on the occasion of his alerting the patent attorney in charge to a coming due date, but should rather be performed systematically irrespective of such alerts, at least during an initial training period of several months. These checks should be aimed at making sure that, especially in consideration of subsequently received fees reminders, the index cards were accurately updated.

In **T 191/82** (OJ 1985, 189) the non-payment in due time of an additional fee was found to be clearly attributable to an unfortunate concatenation of errors by nevertheless properly selected and experienced employees.

In **J 12/84** (OJ 1985, 108) the due care required in the circumstances was not observed when the **employees of another company** were instructed to sign for registered mail addressed to the representative, as he was not able to supervise the work of such persons not employed by his firm.

In **T 309/88** the board stated that even employees **without formal training** as patent attorney's assistants could perform the task of recording and monitoring time limits. This was routine work which did not require specialised knowledge and professional qualifications. However, the assistant had to be properly instructed in the tasks to be performed and a trained employee had to be on hand to give advice.

In **J 26/92** the board noted that according to the case law of the boards of appeal, routine tasks could be entrusted to an assistant provided that the necessary due care on the part of the representative had been exercised in dealing with the assistant. In this respect, it was incumbent upon the representative to choose for the performance of routine tasks a suitable person, properly instructed in the tasks to be performed, and to exercise reasonable supervision over their work.

In **T 949/94** the board stated that a representative was expected to exercise a reasonable supervision over the work delegated. This did not mean that he had to supervise the posting of every letter. Once he had signed a letter and ordered his secretary to post it, he was entitled to assume that it had been posted. In the light of that, the board was satisfied that the representative had exercised due care in dealing with his secretary (**J 31/90**).

In **T 1062/96** the board found that the **posting** of a letter prepared and signed by the representative was a **typical routine task** which the representative could entrust to an assistant (see also **T 335/06**). In the case in question the assistant was expressly instructed to send the letter by fax on the same day. In a properly organised office the representative could rely on the correct execution of such an instruction. The sending of the fax did not require any specialised knowledge or qualification. Therefore, the assistant, here a secretary, who had proven to be reliable in the daily work of the representative's office, could have been expected to do this job within her own responsibility. Since the order was to be carried out more or less immediately, a later check whether the fax had actually been despatched was not necessary.

In **T 1465/07** the board considered the obligations of the representative in dealing with assistants developed by the case law of the Boards to be fully compatible with the **principle of proportionality**. In the case at issue the secretary of the representative had previously worked for another partner and after her taking up her new job the **instructions** given in relation to the backup check consisted in little more than the order to continue to perform that check in the same way as she had done in her former position. The board considered that this was insufficient and that she required **supervision** at shorter intervals during the period immediately following her taking up the new job. Requiring such supervision was not only appropriate and necessary but also not disproportionate, as supervision does not require a substantial amount of time.

c) Technically qualified assistant

In **T 715/91** the board held that the consequences of an error by a technically qualified assistant (an engineer training for the European qualifying examination) imputed to the representative would also have to be borne by the appellants. The task of writing, or at least supervising, the despatch of important submissions, such as grounds of appeal, would normally fall to the representative himself. Furthermore, given that the assistant had only recently been taken on, the representative could not be expected to have been able to ascertain in such a short time to what degree the assistant did know the rules and regulations of the EPC.

In **T 828/94** the board found inter alia that the technical assistant in charge was not supervised well enough and had not been properly instructed.

Referring to the required **standard in exercising due care**, the board decided in **T 832/99** that a technical employee working in a firm of patent attorneys was not an assistant but was carrying out de facto the work of a patent attorney. This meant that the **same strict requirements** for due care would have to be applied to the technical employee as were applied to the appellant and the appellant's representative.

d) Substitutes replacing assistants

In **J 16/82** (OJ 1983, 262) the board stated that the conditions relating to assistants also applied in the case of a substitute replacing an assistant who was on holiday, ill or otherwise absent. It was a commonly experienced fact of life that assistants did have to be temporarily replaced from time to time. Where a qualified assistant was absent, therefore, the applicant or representative had either to be able to call on a similarly qualified substitute or else himself to take over the work assigned to the assistant. The **same standard of care** had to be exercised as regards the choice, instruction and supervision of the substitute as of the assistant himself (**T 105/85**).

e) Ultimate responsibility of the representative

In **J 25/96** the statement of grounds for the request for re-establishment of rights explained inter alia that non-observance of the time limit had been caused by the assistant entrusted with monitoring time limits. The board held that the case law according to which a representative could entrust suitably qualified and supervised personnel with monitoring time limits had been developed for routine tasks and normal cases. It did not mean that a representative could also entirely leave such staff to monitor cases which

(i) were **particularly urgent**

(ii) needed **particular attention** and further steps by the representative himself to ensure that the necessary acts were still performed in time

(iii) could result in an **irrevocable loss of rights** if any error or delay occurred.

In **T 719/03** the board did not accept the appellant's argument that the failure to comply with the time limit had been an isolated mistake by the qualified secretary who had noted on the cover page of the revocation decision only the time limit for appeal but not also the time limit for filing the statement of grounds of appeal. The board held that the appellant's representative had himself failed to exercise due care, since the contested decision had been shown to him twice without his noticing the incompleteness of the note concerning the mandatory time limit that had to be monitored. The board took the view that, with **careful handling** of a dossier involving statutory time limits, the representative was so often faced with the time limits to be observed that **compliance with the time limit was ensured**.

In **T 439/06** (OJ 2007, 491), it was the assistant who monitored the time limits who made the decisive mistake in calculating the time limit when applying R. 78(2) EPC 1973. Taking into consideration the assistant's statement that in his 25 year career he had never missed a time limit due to an incorrect "ten day rule" calculation, this might be qualified as an isolated mistake. However, concerning the necessary "due care" required from the representative, the board emphasised that fulfilling the requirements of proper selection, instruction and supervision only meant that the assistant's error in dealing with the delegated task cannot be imputed to the representative. It does not mean that with the proper selection, instruction and supervision of the assistant the representative's responsibility ends there once and for all, and that he need not take further care with respect to the delegated task.

What all due care calls for depends on the specific circumstances of the case. It is not necessary to perform a triple check from the outset, once such a decision is received in the representative's office and when the time limit is noted. This still belongs to the administrative treatment of the file where the representative does not yet need to be involved if he has installed a satisfactory system. However, once the representative gets the file on his desk for his own action, in order to comply with the relevant time limit, responsibility passes over to him in all respects. All due care under these circumstances requires the representative to verify the time limit calculated by his records department when he receives the file for dealing with it. He cannot simply rely on having delegated this task once and for all to his records department (see also **J 1/07**; **T 719/03**; **T 473/07**).

Likewise in **T 1561/05** the board held that the representative was personally at fault in failing, when signing the statement of grounds for appeal, to check the calculation of the time limits by his support staff and therefore to notice that the calculation was wrong. A task forming part of the representative's **core duties**, such as performing a **final check** when signing a submission which is subject to a time limit, cannot be delegated in a way that absolves the representative of responsibility.

7.4.5 Due care in using mail delivery services

In decision **T 667/92** the board considered whether the appellant could be said to have taken all the due care required by the circumstances when allowing only two days for delivery from the UK to Germany and whether, in these circumstances, the choice of using a special carrier for the delivery was in keeping with the due care requirement. The board pointed out that a party who missed a time limit had also to show due care in its **choice of method of delivery** and that the use of outside agents might be held against the applicant under Art. 122 EPC 1973 owing to a lack of proper safeguards. The board added that in parallel situations telefaxing should preferably be used. The board took into account the very extraordinary circumstances regarding the withholding of the item by the customs in Munich for 36 hours, an incident which could not reasonably be foreseen, and allowed the request.

In **T 381/93** the problem arose from the failure of the private courier service to deliver the package containing the corresponding documents to the EPO as instructed. In deciding

on due care, the board referred to decision **T 667/92**, in which it was stated that a party who had missed a time limit had also to show due care in its choice of method of delivery. The board held that once a reliable carrier had been chosen and commissioned for the delivery, a party was entitled to rely on them, provided that the party had given all the necessary and proper instructions to the carrier.

If a party to proceedings requests re-establishment of rights on the basis that a document missed an EPO time limit because it did not arrive within the **standard delivery time**, that party will have to prove that the form of postage used would normally have ensured that the document would reach the EPO on time. The board left out of account the question of whether a party who relies on the usual delivery time has exercised all due care with regard to the time limit (**T 777/98**, OJ 2001, 509).

8. Rights of use under Article 122(5) EPC

Art. 122(5) EPC corresponds to Art. 122(6) EPC 1973 and is substantively unchanged (see OJ SE 4/2007).

In **J 5/79** (OJ 1980, 71) the board stated that according to Art. 122(6) EPC 1973, third party rights of user arose only where the restoration related to an already **published European patent application** or a European patent; those whose commercial interests were at stake should be entitled to be sure that protection, the existence of which was public knowledge, and which had fallen into the public domain, no longer had effect. The board stated that the basis of this rule had never been questioned. In the case at issue, the restoration related to an application that was unpublished at the material time, so on that ground alone there could be no third party rights of user.

There was another requirement of Art. 122(6) EPC 1973, before third party rights could arise, which was also lacking in the case at issue, namely that the restoration of rights **should be made public**. Publication concerning European patent applications and patents took place in the "European Patent Bulletin". According to Art. 129(a) EPC 1973, this Bulletin was to contain entries made in the Register of European Patents as well as other particulars the publication of which was prescribed by the EPC 1973. Particulars of the restoration of rights within the period in default in the case at issue constituted no such "other particulars". In accordance with Art. 127, second sentence, EPC 1973, no entries could be made in the Register of Patents prior to publication of the European patent application. Even in the case of published applications, R. 92(1)(u) EPC 1973 (R. 143(1)(u) EPC), provided that the date of re-establishment of rights was to be entered only if loss of the application (R. 92(1)(n) EPC 1973; R. 143(1)(n) EPC) or the revocation of the patent (R. 92(1)(r) EPC 1973; R. 143(1)(r) EPC) had been entered in the Register. That was not so in the case at issue. The board held therefore that no rights of user could be claimed by a third party on the facts in this case that the appellant was not adversely affected by the decision under appeal.

9. Restitutio in integrum - Interruption of proceedings

In **J ../87** (OJ 1988, 323) the board decided that, in accordance with R. 90 EPC 1973 (equivalent to R. 142 EPC save for a few editorial amendments), which the EPO must apply of its own motion, the legal incapacity of an applicant or his representative has the effect of interrupting proceedings and, where appropriate, the one-year time limit referred to in Art. 122(2) EPC 1973 (now R. 136(1) EPC).

In **T 315/87** the board of appeal was faced with the question whether the EPO should not of its own motion first check whether the conditions for an interruption of proceedings under R. 90 EPC 1973 existed, before considering a request for re-establishment. The board stated that preference should be given to the application of Art. 122 EPC 1973, under which less severe impairment could also be grounds for re-establishment of rights. The question of any interruption of proceedings under R. 90 EPC 1973 could be left open provided that all the losses of rights which had occurred could be overcome by restitutio in integrum under Art. 122 EPC 1973.

In **J 9/90** the Legal Board of Appeal held that for R. 90(1)(b) EPC 1973 (interruption of proceedings because of insolvency) to be applied in the light of Art. 60(3) EPC 1973 (unchanged) and R. 20(3) EPC 1973 (R. 22(3) EPC), the applicant entered in the Register of European Patents and the insolvent person (here, a limited company) had to be **legally identical**. However, the fact that the persons involved were not identical did not necessarily rule out re-establishment of rights under Art. 122 EPC 1973. Someone who was only indirectly affected by an event, such as insolvency, could be "unable" within the meaning of Art. 122(1) EPC 1973. In such a case however the persons so affected had to prove that they had exercised all the due care that could have been expected of them in the circumstances of such an insolvency.

10. Re-establishment in the context of the President's extension of time limits during general disruption

In **T 192/84** (OJ 1985, 39) it was held that if the President of the EPO extended time limits expiring during a period of general interruption in the delivery of mail in a contracting state (R. 85(2) EPC 1973), a pending application for re-establishment of rights considered to have been lost during that period, which had been filed by a representative having his place of business within that state, had to be deemed to have been made without purpose *ab initio*, even though the non-observance of the time limit was due to causes other than the interruption in the delivery of mail. Accordingly, it could be declared that no rights were lost and the fee for re-establishment of rights could be refunded. The reformulation of this rule (now R. 134 EPC, see also chapter VI.D.1.3.1, interruption in the delivery of mail) does not call this case law into question.

11. Principle of proportionality

In **T 111/92** the statement of grounds of appeal had been filed two days late due to an error of calculation of the due date on the part of the representative. The board held that the mistake in calculating the ten-day period due to human error at a time when the

person in question was under pressure was an isolated mistake in an otherwise satisfactory system. The board referred to the principle of proportionality and stated that, in accordance with general principles of law, as applied in the context of administrative law, a procedural means used to achieve a given end (e.g. a sanction following a procedural non-compliance) should be no more than that which is appropriate and necessary to achieve that end. Bearing the principle of proportionality in mind, the loss of the patent application because of the procedural irregularity which has occurred in the case at issue would be a severe result. Moreover, the interests of any third party misled within the meaning of Art. 122(6) EPC 1973 by the fact that the statement of grounds of appeal was filed two days late would be protected by Art. 122(6) EPC 1973. The board allowed thus the application for re-establishment (see also **T 869/90**, **T 635/94**, **T 804/95**, **T 27/98** and **J 22/92**).

In **J 44/92** and **J 48/92** the boards noted that the principle of proportionality **only** applied **in borderline cases, in support of other grounds** already substantiating to a certain extent the allowance of the appeal. Usually it had been applied where a time limit had been missed by one or two days due to some miscalculation (see below). The board considered that the principle of proportionality did not assist the appellant as there had been a major system fault, which could not be excused by reliance on the principle of proportionality.

In decision **T 971/99** and **T 1070/97** the boards stated that Art. 122(1) EPC 1973 **did not leave any room for the application of the principle of proportionality**, so that the number of days by which a time limit had been missed was irrelevant for deciding whether all due care was applied or not. Only the character of the conduct before the time limit expires was decisive for the consideration of the issue of due care, not the length of the ensuing delay (see also **T 439/06** (OJ 2007, 491) and **T 1561/05**).

In **T 1465/07** the board interpreted Art. 122 EPC 1973 in the context of the right of access to a court taking into account the case law of the European Court of Human Rights and the European Court of Justice and came to the following conclusions:

The principle of proportionality applies to limitations of the right of access to the boards of appeal, such as rules on time limits, by legislative measures or their application. This means that those measures or their application must not exceed the limits of what is appropriate and necessary in order to attain the objectives legitimately pursued by the legislation in question; when there is a choice among several appropriate measures or ways of applying them recourse must be had to the least onerous, and the disadvantages caused must not be disproportionate to the aims pursued.

As for the application of Art. 108 EPC 1973 in conjunction with Art. 122 EPC 1973, the principle of proportionality has the consequence that the interpretation of those provisions must not impose means that are inappropriate, unnecessary or disproportionate in relation to the aim to be achieved, namely legal certainty and the proper administration of justice by avoiding any discrimination or arbitrary treatment. Correspondingly, the **conditions for granting re-establishment**, in particular the requirement of due care, **must not be interpreted in an excessive manner** that

unreasonably restricts access to the board and thus prevents the board from deciding on the merits of the case. This is the balance between legal certainty and proper administration of justice on one hand and substantive justice on the other, which has been struck under the EPC in this context. It follows that the principle of proportionality must always be applied in connection with the interpretation of those conditions, which determine whether or not an application for re-establishment can be allowed. The number of days by which a time limit has been missed is irrelevant for deciding whether all due care within the meaning of Article 122(1) EPC 1973 was applied or not as that provision does not leave any room for the application of the principle of proportionality in this respect.

Considering whether the requirement of an independent cross check is proportionate in general, the board held that the additional burden was not disproportionate for a large firm, where the cross check can be organised more economically than in a smaller one. Independence of the monitoring systems is both appropriate and necessary. The board then applied the principle of proportionality to the facts of the case and came to the conclusion that the monitoring system in place could be improved by charging the representative himself with the cross check.

12. Refund of the fee for re-establishment

In **J 7/93** (see also chapter IX.B.2, competence of the EPO) the EPO did not tell the appellant to ignore its previous communications issued in connection with a time limit supposed to be missed; this would have enabled the appellant to recognise that its request for re-establishment was unnecessary. Instead, the EPO continued the proceedings for re-establishment of rights and finally refused restitutio without taking into account the fact that these proceedings had been unnecessary from the very beginning. The board found that this amounted to a substantial procedural violation within the meaning of R. 67 EPC 1973. The board held that it was equitable to order reimbursement of the appeal fee, even though the appellant had not applied for this (**J 7/82**, OJ 1982, 391). The board held that since there was no longer any legal ground to request re-establishment of rights, the fee for re-establishment was wrongly accepted by the EPO and, therefore, had to be refunded to the appellant (confirming **J 1/80** and **T 522/88**).

In **T 1198/03** the respondent (opponent) sent his reply to the appellant's statement of grounds of appeal one day late and requested that, if the board did not otherwise consider the reply, he be re-established into **the time limit for filing the reply**. The board decided to consider the respondent's reply. The restitutio request was therefore redundant. Distinguishing the present case from other cases, where an application for re-establishment of rights was equally redundant but the boards did reimburse the corresponding fee, the board stated that, in the case before it, restitutio was not available as a matter of principle, and that in such a situation a party should not be able to reap cost benefits from the redundancy of a restitutio request filed on an auxiliary basis. Otherwise parties might be encouraged to file such inapplicable requests.

In contrast, in **T 971/06** the **Office had committed mistakes** which caused the request for re-establishment. As the appealed decision of the examining division did not comply with Art. 97(2) EPC 1973, it was considered invalid by the board. The examination should therefore have been re-opened without an appeal. Furthermore, the appellant was misled by the examining division for several months as to the procedure for remedying the mistake. When the examining division finally issued a communication refusing its request to correct the decision, the appellant filed an appeal, a statement of grounds of appeal and requests for re-establishment. The board considered these requests unnecessary, but an understandable reaction. It found that the fees paid in respect of these requests had to be refunded.

In **T 46/07**, the board found that, if the fee for re-establishment of rights is paid after expiry of the two-month period laid down in Art. 122(2) EPC 1973, the application for re-establishment of rights does not come into existence and therefore the fee must be refunded even without a respective request.

F. Rules relating to Fees

1. General

No provision of the EPC states explicitly that the EPC takes precedence over the Rules relating to Fees (RFees) in cases of conflict between them. However, the EPC is clearly the higher legal norm, and in case of conflict, by analogy with Art. 164(2) EPC 1973 (unamended in substance), the provisions of the EPC should take precedence over the provisions of the Rules relating to Fees. Also on general legal principles, the Implementing Regulations should take precedence over the Rules relating to Fees (**J 7/07**). See also VI.D.1.2.2, applicability of Rule 132 EPC to the Rules relating to Fees.

The EPC 2000 required a revised version of the Rules relating to Fees, which also entered into force on 13.12.2007 (see Administrative Council decision of 7.12.2006, OJ 2007, 10; also Administrative Council decision of 25.10.2007, OJ 2007, 533). Since then, further amendments have come into effect.

R. 85a and 85b EPC 1973 have been deleted in view of the extended scope of application of further processing under Art. 121 EPC. The new Art. 121 EPC broadens the scope of application of further processing and makes it the standard legal remedy in cases of failure to observe time limits in the European patent grant procedure, including for the payment of fees.

2. Payment of fees

2.1. Methods of payment

Since 1.4.2008 the EPO has not accepted cheques in payment of fees, and it has no longer been possible either to pay fees by payment or transfer to a Giro account of the Office (Art. 5 and 7 RFees, as amended by Administrative Council decision of 25.10.2007, OJ 2007, 533).

According to **T 415/88**, the remittance of German Patent Office fees vouchers did not comply with the then applicable version of Art. 5 RFees and thus could not be regarded as payment of a fee. Nor could payment in cash of the appeal fee at the German Patent and Trade Mark Office (DPMA), instead of the EPO, be accepted (**T 1029/00**). The Administrative Agreement of 29 June 1981 between the two offices concerning procedure on receipt of documents and payments (OJ 1981, 381) as amended on 13 October 1989 (OJ 1991, 187), covered only those forms of postal delivery actually specified in the agreement and could not be interpreted more broadly. Pure cash payments were not the same as payment enclosures because they were not delivered as mail. They were more like documents brought by hand, which under Art. 1(4) of the 1989 agreement could not be accepted by the DPMA for the EPO.

2.2. Debit orders

Under Art. 5(2) and Art. 7(2) RFees the EPO makes deposit accounts available for the settlement of fees and costs of other services provided by the EPO. These are governed by the Arrangements for deposit accounts (ADA) and their annexes (last published as a Supplement to OJ 3/2009).

Already in **T 152/82** (OJ 1984, 301) it was held that the EPO must execute a debit order in accordance with the substance of that order where the intention was clear, even though the amount specified was clearly incorrect. This also applied where a national form was used in error, as in **T 170/83** (OJ 1984, 605). A timely filed statement that a debit order for payment of a fee had been issued was itself considered such a debit order in the absence of any record of the original (**T 17/83**, OJ 1984, 306).

In case **T 773/07**, which concerned the Arrangements for deposit accounts in force until 12.12.2007 (Supplement to OJ 1/2005), the appellant's deposit account held insufficient funds to cover the appeal fee. The board rejected the argument that this fee could or should have been booked before six other fees on the relevant date. It was not for the EPO cashier to choose priorities between fees to be paid, all the more so since it was the responsibility of the account holder to ensure that the account contained sufficient funds at all times (point 5.2 ADA).

In **T 871/08** the opponent had indicated that the appeal fee would be paid by online debit order, but also requested that, if this was not done by one day before expiry of the Art. 108 EPC 1973 time limit, the Office should debit the fee. The board held that the payment of the appeal fee was exclusively the responsibility of the appellant or its representative, who could not discharge themselves by shifting the responsibility to the Office, let alone with a conditional order (see now point 6.3 ADA).

As confirmed in **T 270/00**, if an automatic debit order is revoked after the decisive payment date for the appeal fee, this is too late to affect the payment. Valid payment of the appeal fee is a matter of fact, which cannot be undone and is not at the disposal of the appellant.

2.3. Indication of purpose of payment

In **J 19/96** the board noted that **J 23/82** (OJ 1983, 127) held that the indication of the purpose of a payment within the time limit for payment was not a mandatory requirement for payment to have been made in due time and, according to Art. 7(2) RFees (now Art. 6(2) RFees), could thus still be given later. However, the current board doubted whether this meant that it was generally possible to change the purpose of a payment after expiry of the relevant time limit with retroactive effect to the date on which the payment was made.

2.4. Designation fees

Art. 79(2) EPC has been amended by providing that the designation of a contracting state **may** be subject to the payment of a designation fee, turning the clause from a mandatory to an enabling one and thereby increasing the flexibility of the EPC on this point. The time limit for payment of designation fees has been moved to R. 39 EPC.

Under Art. 2 RFees, applicable as from 1.4.2009, a flat designation fee for all contracting states applies to European patent applications filed on or after 1.4.2009 and to international applications entering the regional phase on or after that date.

Applying the earlier law regarding the payment of designation fees, the legal board in **J 23/82** (OJ 1983, 127) held that, if the amount paid in respect of designation fees under Art. 79(2), second sentence, EPC 1973 or R. 85a EPC 1973 was not sufficient for all the contracting states designated at the time of payment, the payer had to be requested pursuant to the then Art. 7(2), first sentence, RFees (now Art. 6(2), first sentence, RFees) to select the states he wished to designate. Application of this provision therefore took precedence over the then Art. 9(2), second sentence, RFees (later Art. 8(2), second sentence, RFees). Only if the payer did not comply in due time with this request had Art. 9(2) RFees to be applied instead of the then Art. 7(2), second sentence, RFees. (R. 85a EPC 1973 has been deleted in view of the extended scope of application of further processing under Art. 121 EPC; see 1. above. Art. 8(2) RFees has also been deleted with effect from 1.4.2009 in respect of European patent applications filed and international applications entering the regional phase on or after that date.)

However, the legal board in **J 19/96** held that it was not justified for the EPO to proceed according to the then Art. 9(2), second sentence, RFees in a case where the applicant had individually indicated the states he had designated, for which he had paid the corresponding amount in designation fees, and where, on invitation under the then Art. 7 RFees, he did not indicate other states for which the payment should be used but confirmed his wish to maintain the original individual designations. According to the legal board, the fact that the designation of the states expressly indicated by the applicant was not possible for legal reasons was not equivalent to the situation where the applicant had not specified how to apply an insufficient overall amount, as referred to in the then Art. 9(2), first sentence, RFees (as in **J 23/82** above). The designation was still a clear and unequivocal declaration of the procedural will of the applicant, which was binding on the EPO.

3. Date of payment

Where an amount is paid into or transferred to a bank account held by the Office, under Art. 7(1) RFees (formerly Art. 8(1) RFees) the date on which the amount of the payment or transfer is **actually entered** in its account is considered to be the date on which the payment has been made to the Office. Thus, where an appeal fee was mistakenly transferred to a bank account held by the German Patent Office (GPO), neither the date on which the transfer was entered in the GPO's account nor the date on which the order to transfer the amount to the GPO was issued could be taken into account to establish whether a fee due to the EPO had been paid in due time (see **T 45/94** and **T 1130/98**). The boards pointed out that, in the Administrative Agreement between the German Patent Office and the EPO concerning procedure on receipt of documents and payments dated 29.6.1981, as amended on 13 October 1989 (OJ 1991, 187), there were no provisions regarding the passing on of the payment or notification of the EPO for erroneous bank transfers. Sums of money payable to the EPO and paid into one of the accounts held by the German Patent Office were, under the terms of the Administrative Agreement, repaid to the payer (**J 49/92**). On the other hand, according to Art. 1(5) of the Administrative Agreement, payments sent by **post** to the GPO were accepted on behalf of the EPO and set aside for daily collection by an EPO employee.

Similarly, the use of a private courier to deliver a cheque (which did not arrive until after expiry of the relevant time limit), could not be considered as equivalent to the use of the postal services. The courier in question was not recognised as a delivery service equivalent to the postal service until later, by a decision of the President of the EPO dated 11 December 1998 (OJ 1999, 45) and this provision could not have retroactive effect (**J 13/98**). (Payment by cheque has not been accepted since 1.4.2008 - see also 2.1.)

Under Art. 7(3) RFees, the period for payment of a fee is considered to have been observed even if payment is not received until after expiry of the period in which it should have been made, on condition that certain requirements are met (see **T 842/90** for an application of this under the then applicable Art. 8(3) RFees).

4. Small amount lacking

Under Art. 8, first sentence, RFees (formerly Art. 9, first sentence, RFees), a time limit for payment is in principle deemed to have been observed only if the full amount of the fee has been paid in due time. However, the EPO is given the discretion, where this is considered justified, to overlook any small amounts lacking without prejudice to the rights of the person making the payment (Art. 8, fourth sentence, RFees, formerly Art. 9, fourth sentence, RFees).

The justification for overlooking a small fee underpayment has been considered by the boards of appeal in several cases. In **T 130/82** (OJ 1984, 172) the board decided that it was justified to overlook an underpayment of just over 10%. In **J 11/85** (OJ 1986, 1) the board stated that an underpayment of about 10% may as a rule be considered as a small

amount (see also **T 109/86** of 20.7.1987). See also **T 343/02**, where the underpayment of less than 2% due to the unexpected deduction of bank charges was overlooked.

In **T 290/90** (OJ 1992, 368) the board found that this question must be decided on an objective basis, having regard to all the relevant circumstances of the case, and not on a subjective basis. It held that in the circumstances of that case 20% of the opposition fee could properly be regarded as a small amount, because it was inappropriate to punish the appellant for contending he was entitled to a reduction in the opposition fee (under R. 6(3) EPC 1973) and the missing 20% was paid soon after expiry of the period.

However, in **T 905/90** (OJ 1994, 306, Corr. 556) the board found that the meaning of 'smallness' could best be determined by comparing the amount of shortfall with the amount of the full fee. A difference of 20% clearly could thus not, on purely arithmetical grounds, be regarded as small. It was with very small or trifling amounts that the former Art. 9 RFees (see now Art. 8 RFees) was designed to deal so as to prevent a loss of rights where an inadvertent error of some kind had led to a slight underpayment of an amount due in respect of the relevant proceedings.

In **J 27/92** (OJ 1995, 288) the examination fee was underpaid by about 20%, amounting to DEM 560. Distinguishing **T 905/90**, the board defined the concept of a "small amount lacking" in the then Art. 9 RFees (see now Art. 8 RFees) as a fixed proportion of the amount of the particular fees to be paid. At most, 20% of the fee to be paid might be regarded as small within the meaning of the said provision. Moreover, the choice of 20% as the percentage to be considered a "small amount" would achieve the desirable end of making it possible to apply the former Art. 9 RFees (see now Art. 8 RFees) to cases where a party paying fees mistakenly sought to take advantage of the 20% reduction in fees available in relation to Art. 14(2) and (4) EPC 1973 under R. 6(3) EPC 1973 and the former Art. 12(1) RFees (see now Art. 14(1) RFees). In the case in point the board decided that it was justified to overlook the deficit as the applicant not only paid it without delay, but also appeared to have been misled into paying only 80% of the fees as a result of information provided by the EPO.

5. Reduction of the examination fee

In **J 1/09**, the Legal Board held that R. 107(2) EPC 1973 governed the reduction of the examination fee after the entry of an international application into the European phase. It did not apply to divisional applications. Art. 12(2) RFees 2003 only laid down the level of the reduction. For the conditions for the reduction it referred to R. 107(2) EPC 1973 (see also **J 14/07**).

G. Procedural steps

1. General principles

A procedural step is an act, performed by a party to the proceedings, which falls under procedural law as regards the conditions governing it and its effect, and which influences

the course of the proceedings. The decisions of the boards of appeal have developed a number of principles regarding procedural steps:

In proceedings before the EPO a distinction can be made between two kinds of procedural step: those affecting the scope, subject-matter and effect of the requested decision, and those affecting the form of the proceedings. This chapter looks at general principles applying to both types of procedural step. The special features relevant to opposition and appeal statements, to requests for a different apportionment of costs, reimbursement of the appeal fee and appointment of oral proceedings, and to the filing of amended claims are dealt with in the appropriate chapters.

To be effective, declarations regarding procedure need, in the interests of legal certainty, to be clear, particularly - because of their consequences - declarations terminating the proceedings; ambiguous declarations are ineffective (**J 11/94**, OJ 1995, 596). This was confirmed in **J 27/94** (OJ 1995, 831), where it was also stated that this implies that a procedural declaration must not be subject to any condition, leaving it open whether the EPO can proceed further on the basis thereof. The applicant had approved the text of the patent under R. 51(4) EPC 1973 (R. 71(3) EPC) yet also stated his intention to file a divisional application in due course, although, according to **G 10/92**, a divisional application could only be filed up to this approval. Thus the approval should not have been treated as valid. See also **T 355/03**. Following **J 11/94** and **J 27/94**, the legal board in **J 16/94** (OJ 1997, 331) found that the test for whether a procedural declaration was unambiguous was whether the declaration was clear enough for the EPO to proceed on the basis thereof. See also **J 6/00** and **J 4/03**.

There is also a general interest in the reliability of procedural declarations of the parties, particularly declarations which open a new procedure. Thus someone who performs the required acts acquires the status and the procedural rights of a party, e.g. as applicant, opponent or appellant, on the date of completion of the necessary requirements. Procedural declarations cannot be negated on the basis of instructions not yet known to the representative when acting vis-à-vis the EPO (**T 309/03**, OJ 2004, 91; in this case a representative filing an appeal unaware that the applicant did not wish to appeal). Nor are procedural statements valid if they are filed by a person who is not entitled to do so (**J 28/86**, OJ 1988, 85). On this basis the approval of the text of a patent application was held invalid in **J 12/95**. Both the approval and a divisional application were sent to the EPO together by courier, as ordered by the representative, but before they had arrived an employee faxed only the approval to the EPO. The Receiving Section therefore held the filing of the divisional application to be invalid. However, the board found that there was convincing evidence that this transmission took place against the express order of the authorised representative and could not therefore be treated as a valid approval. The divisional application had to be considered to have been filed within the time limit laid down in R. 25(1) EPC 1973 (R. 36(1) EPC).

The legal personality of a named entity under the Convention is decided on the same basis as before national courts, namely the capacity to sue or to be sued in its own name and on its own account (**G 3/99**, OJ 2002, 347).

According to **T 212/88** (OJ 1992, 28) all requests by parties, including any request for apportionment of costs, should be made before announcement of the decision at the conclusion of oral proceedings. In **T 552/97** the board ruled that, before issuing its decision, the department responsible should clarify the position, ascertaining exactly what was requested and verifying the correctness of its assumption that a request had been withdrawn. An objective lack of clarity at the end of the oral proceedings constituted a substantial procedural violation. Requests relating to ancillary proceedings (e.g. apportionment of costs) remain pending, even if the appeal is withdrawn (**T 265/93** and, similarly, **T 789/89**, OJ 1994, 482). See also **T 884/91**, **T 82/92**, **T 92/92** and **T 329/92**. According to **T 961/00**, whether or not a declaration concerning the maintenance of the patent made by a patentee in the course of the proceedings has the legal meaning of a request does not depend on the wording used by the patentee. There is a request in the legal sense whenever it is to be derived from a patentee's declaration that he formally expresses therewith his will or agreement that the opposition division should decide in a certain way.

Procedural statements are open to interpretation (**G 9/91**, OJ 1993, 408). Statements filed during proceedings before the department of first instance are not valid in the subsequent appeal proceedings (see **T 34/90**, OJ 1992, 454; **T 45/92**, **T 501/92**, OJ 1996, 261).

In **T 446/00** the board pointed out that it was inherent in the system of communications that they might contain, *inter alia*, a direction to the party or parties to take a certain procedural step or steps. It was incumbent on parties to comply with directions in communications and the board could not sanction disregard for its directions.

2. Signatures

In **J 25/86** (OJ 1987, 475), the board held that the signing of the authorisation is to be considered to be the legal act from which an application ultimately originated.

In **T 960/95**, the board ruled that under R. 61a EPC 1973 (R. 86 EPC) in conjunction with R. 36(3), first sentence, EPC 1973, (R. 50(3), first sentence, EPC) an opposition had to be signed. A missing signature was a deficiency which could be remedied under R. 36(3), second sentence, EPC 1973. According to **T 850/96**, the same had to apply to signatures which were not legible. An opposition signed by a non-authorised third party should be treated like an unsigned one (**T 665/89**).

In **T 848/00** the board stated that, according to R. 76(3) EPC 1973, the minutes were to be authenticated (now 'signed', see R. 124 EPC) by the employee who drew them up and by the employee who conducted the oral proceedings. A countersignature of the parties was not prescribed by this rule. As the signatures of the employees were not contested, the legal validity of the requests recorded in the minutes was established.

According to Art. 7 of the Decision of the President of the European Patent Office dated 26 February 2009 concerning the electronic filing of documents, and which entered into force on 5.03.2009, where filed documents require signature, subject to Art. 8 this may

take the form of a facsimile signature, a text string signature or an enhanced electronic signature.

In **T 1427/09** the board held that the principle that the signature of an unauthorised person should be treated like a missing signature, as set out in **T 665/89**, should apply not only to handwritten signatures, but also to electronic signatures. See also Chapter VII.E.7.5.1 (electronic filing of appeal).

3. Main and auxiliary requests

3.1. Admissibility

In **T 382/96** the board stressed that one of the fundamental principles of European patent law was that responsibility for defining the subject-matter of a patent rested with the applicant (in opposition proceedings the proprietor). That was clear for example from the provisions of R. 51(4) to (6) EPC 1973 and R. 58(4) and (5) EPC 1973 (see now R. 71(3) to (5) and R. 82(1) and (2) EPC). The applicant (patent proprietor) could not offload this responsibility de facto on to the EPO or any other parties to the proceedings by filing a multitude of requests, let alone incompletely formulated request variants. Doing so constituted an abuse of procedure, as it overburdened the EPO and any other parties to the proceedings with work not originally theirs to perform and thereby hampered the orderly conduct of proceedings.

In **T 745/03** the board also pointed out that it was up to a party to decide on the presentation of its case. When filing several sets of claims, a party usually listed them in order of preference, the least limited claims being a main request, the more limited versions auxiliary requests, so that if a higher order request should fail, then a lower, more limited request would still have a chance of success. In the case before the board this had changed to an approach which could more aptly be designated as "pick and mix", as independent claims present in higher order requests were also to be found in lower order requests in differing permutations of independent claims. This approach could give rise to a situation where the final decision given did not refer to some independent claims because if even just one of the independent claims in a particular request repeated from a higher order request did not meet the requirements of the EPC, the particular request concerned failed without a decision being necessary on the other independent claims. See also **T 221/06**.

In **T 148/06** the board held several requests inadmissible which were submitted not as principle and auxiliary requests, but as requests of equal ranking. It was not the board's duty to give a legal opinion on the admissibility of several requests as guidance for appellants in defining the order in which they would like their requests to be examined.

In **T 792/92** the board considered as inadmissible the appellant's request at the end of the oral proceedings that, should the outcome of the discussions be negative for him, he be given the opportunity to formulate new requests.

3.2. Order of requests

An auxiliary request is a request for amendment which is contingent upon the main request (or preceding auxiliary requests) being held to be unallowable **T 153/85** (OJ 1988, 1). It is also a request for amendment covered by R. 86(3) EPC 1973 (now R. 137(3) EPC); Art. 96(2) EPC 1973 and R. 51(2) EPC 1973 (see now Art. 94(3) EPC and R. 71(2) EPC); and, during appeal proceedings, Art. 110(2) EPC 1973 and R. 66(1) EPC 1973 (see R. 100(1) EPC) (**T 79/89**, OJ 1992, 283). Before a decision can be taken on the basis of an auxiliary request, the main request has to be examined and decided upon (**T 484/88**). Referring to these decisions, the board in **T 169/96** pointed out that, under Art. 113(2) EPC 1973, the EPO was bound to the requests of the applicant or proprietor, and, in the case of main and auxiliary requests, this meant that the EPO was also bound to the order of the requests. If a decision relates to several requests, it must give reasons for the rejection of each one. It must be clear from the decision which considerations led the division to its conclusions (**T 234/86**, but see **T 745/03** in 3.1 above). For further examples of cases where the examining division was found not to have given sufficient reasons in its decision, see **T 951/97**.

3.3. Examination procedure

In **T 488/94**, the board stated that before refusing an application in the case of main and auxiliary requests, the Examining Division in accordance with Art. 113(1) EPC 1973 would not only have to communicate its arguments regarding non-allowability of the main request to the applicant, but also regarding non-allowability of the auxiliary request, if the result of the subsequent examination of the auxiliary request was also negative. A "direct" rejection of an auxiliary request without preceding communication of the grounds on which the rejection was based would only comply with the requirements of Art. 113(1) EPC 1973 under rather exceptional circumstances.

Art. 113(2) EPC requires the EPO to examine an application only in the text which the applicant has submitted or approved. Where there are multiple requests in the form of a main request and lower-ranking auxiliary requests, the examining division in its decision is bound by the order of the requests. To avoid misunderstanding, the examining division should clarify the status of the requests before pronouncing its decision at the conclusion of oral proceedings (**T 1439/05**).

According to **T 1105/96** (OJ 1998, 249), an applicant had a right both to file one or more auxiliary requests in addition to a main request, and to maintain all such requests even if the examining division communicated its view that all except the last auxiliary request were inadmissible or unallowable, and he was then entitled to a reasoned appealable decision in respect of rejection of each such request. Where an examining division had communicated its view that a further request in the form of an amended text of a claim would be allowable, the rejection in advance of such a further request unless all preceding requests were abandoned was an unlawful exercise of discretion under R. 86(3) EPC 1973 (R. 137(3) EPC) and a substantial procedural violation under R. 67 EPC 1973 (R. 103 EPC). In **T 320/99** the examining division considered the auxiliary request allowable, but nonetheless issued a decision refusing the main request

and thus the application. The correct course of action would have been to issue a communication under R. 51(4) EPC 1973 based on the auxiliary request. The issue of the decision was a substantial procedural violation which justified the reimbursement of the appeal fee (referring to **T 1105/96**).

In **T 1157/01** the applicant had maintained all its requests (main and three auxiliary requests. When it declared its non-approval of the text proposed for grant based on the third auxiliary request, however, the appellant did not explicitly repeat that it maintained all its previous and higher ranking requests. However, according to the general principle "A jure nemo recedere praesumitur" mentioned in **G 1/88** (OJ 1989, 189), in the absence of an explicit withdrawal, surrender of a right could not be simply presumed and silence could not be deemed to be equivalent to surrender in the logic of how the Convention operated. The decision under appeal had omitted to give reasons for the refusal of the higher ranking requests still pending before the Examining Division, which amounted to a substantial procedural violation.

The board in **T 1351/06** referred to the decisions **T 79/89** (OJ 1992, 283), **T 169/96**, **T 1105/96**, (OJ 1998, 249) and to Legal Advice No. 15/05 (Rev. 2, OJ 2005, 357), where it was held that it was standard practice at the EPO that the applicant was able to propose one main and one or more auxiliary requests at the examination stage, to amend the text of the application. The board saw no reason why the applicant should not also be able to do so in response to a communication under R. 51(4) EPC 1973, especially in cases where that communication had not been preceded by a communication under Art. 96(2) EPC 1973 and thus constituted a "first communication" within the meaning of R. 86(3) EPC 1973.

In **T 549/96** it was noted that Art. 113(2) EPC 1973 required the examining division to decide upon an application only in the text agreed by the applicant. Thus an applicant had to indicate clearly at the end of the proceedings which text he wished to be used. If an applicant failed to indicate his approval of the text of an allowable subsidiary request, e.g. by express disapproval or by maintaining one or more unallowable higher-preference requests over one considered allowable by the examining division, the examining division could refuse the application under Art. 97(1) EPC 1973. Art. 113(2) EPC and Art. 97(1) EPC remain substantially unchanged under the EPC 2000.

The board contrasted opposition and grant proceedings. In the case of an allowable auxiliary request in opposition proceedings an interlocutory decision was taken under Art. 106(3) EPC 1973 to the effect that the European patent met the requirements of the EPC 1973, account being taken of the amendments made by the patent proprietor. This interlocutory decision then also had to include the reasons why the preceding requests did not meet the requirements of the EPC 1973. This saved the proprietor the further costs of fulfilling the formal requirements under R. 58(5) EPC 1973 before there was a final decision on the version in which the patent could be maintained. No comparable situation existed in grant proceedings. On the contrary, in ex parte appeal proceedings the principle of examination ex officio applied. Up to the grant stage it had to be ensured that the conditions for patentability were met. An interlocutory decision, stating that the

application in a certain version met the requirements of the EPC 1973, would be in conflict with this purpose. The board drew attention to Legal Advice No. 15/98 (OJ 1998, 113). The substance of Art. 106(3) EPC 1973 can now be found in Art. 106(2) EPC and that of R. 58(5) EPC 1973 in R. 82(2) EPC. This Advice has now been replaced by Legal Advice No. 15/05 (OJ 2005, 357). In **T 482/06**, the board found that decision **T 549/96** was compatible with the updated Legal Advice, as it stated that "an applicant must unambiguously indicate at the end of the proceedings, which text he proposes" Legal Advice No. 15/05 set out the mechanism to provide this indication. See also **T 976/97**, also before the entry into force of Legal Advice 15/05, where the situation was similar to that in **T 549/96**. In **T 1220/05** the board (referring to **T 839/95** and **T 549/96**) held that interlocutory decisions finding an auxiliary request allowable were not in keeping with standard first-instance practice in examination proceedings, as opposed to opposition proceedings (see Legal Advice No. 15/05 (Rev. 2), point 1.1), and in appeal jurisprudence were deemed undesirable owing to possible repercussions (binding effect, no reformatio in peius).

3.4. Opposition procedure

According to **T 234/86** (OJ 1989, 79), the opposition division can - and in certain circumstances must - maintain the patent as per the patentee's subordinate auxiliary request if he pursues main and auxiliary requests which are not allowable although taking precedence over the allowable one. Rejection of the requests which take precedence must be substantiated (see **T 488/94** for procedure before the Examining Division).

In **T 5/89** (OJ 1992, 348) the board confirmed that a decision may confine itself to rejecting the main request only if all subordinate requests have been withdrawn. This principle was also confirmed in **T 785/91** and **T 81/93**. Following **T 5/89**, the board in **T 861/97** stated that deciding to revoke a patent solely on the basis of the main request when there was an expressly maintained auxiliary request constituted an infringement of Art. 113(2) EPC 1973.

In **T 155/88** the board made it clear that the patentee could not be required to withdraw any request. If he filed one or more auxiliary requests in addition to a main request and did not withdraw any of them, an Opposition Division was obliged in its decision to give reasons why each successive request was either not admissible (in the exercise of its discretion under R. 57(1) EPC 1973 and R. 58(2) EPC 1973, see **T 406/86**, OJ 1989, 302), or not allowable on substantive grounds - see **T 234/86**, OJ 1989, 79. If an Opposition Division allowed an auxiliary request without giving reasons in its decision as to why the main request or preceding auxiliary requests were not allowable, such decision would be set aside as void and of no legal effect, and the appeal fee refunded on the basis of a substantial procedural violation, as was the case in **T 234/86** and **T 484/88**. The board in **T 848/00** agreed with the reasoning of decision **T 155/88** that if a patentee proposed amendments to its claims which arose out of the opposition and which were intended to meet the grounds of objection raised in the opposition by limiting the scope of protection sought, this should not normally be interpreted as an abandonment of the subject-matter protected by the claims of the patent as granted. But

this statement did not influence how the amended set of claims was to be read because a restriction of claims was possible without abandoning the subject-matter of the patent specification as originally filed.

According to **T 961/00**, it is a party's procedural right to file and maintain such requests as are regarded by the competent organ as unallowable or even inadmissible. If a party does so, then the competent organ has to give a decision on it, i.e. to refuse it if it is unallowable or inadmissible (see **T 1105/96**, OJ 1998, 249), but it cannot simply disregard it and deal with the case as if the request did not exist. On the contrary, this would constitute a substantial procedural violation.

3.5. Appeal procedure

In **T 911/06** the board stated that applying the general principles of court procedure to the order of the requests of the appellant proprietor might be inconsistent with the purpose of the appeal procedure inter partes as expressed in the decision **G 9/91** (OJ 1993, 408). In the board's opinion, examining new requests in the appeal, when the appellant proprietor had also requested examination of the correctness of the first instance decision as a lower ranking request, would effectively reduce the appeal procedure to a simple continuation of the first instance proceedings, although it was apparent from the general logic of the EPC, that the appeal proceedings were wholly separate and independent from the proceedings at first instance. The board noted that it had been established in Legal Advice from the EPO No. 15/05 (rev 2), OJ 2005, 357 as well as in several decisions of the boards that in the case of main and auxiliary requests from the applicant or proprietor in first instance examination and opposition proceedings, the EPO was bound to the order of these requests. However, this principle did not necessarily apply to second instance proceedings before the boards of appeal. In view of the foregoing, the board considered that it was in line with the purpose of the appeal to examine first whether the department of first instance had correctly assessed the substance of the requests presented to it. Thus, in the case at issue, the correctness of the decision refusing the maintenance of the patent as granted had to be examined first, before examining the new amended claims.

H. Law of evidence

1. Introduction

Before an administrative authority or a court takes a decision, it is required to establish the existence of the material facts, i.e. the facts from which, under the relevant legal provision, the legal effect ensues. The facts are established by taking evidence.

Where the onus is on the parties to present their case, they are required to furnish proof of the facts they allege, in so far as such facts are disputed. Where the investigative principle applies, the evidence relating to the facts to be proved must be obtained by the body which has to take the decision, although the lengths to which it must go are left to it in the proper exercise of its discretion. The body in question is not bound by mutually corroborating statements made by parties on opposing sides; it has wide discretion to

decide what evidence to accept and the weight it attaches to it (the principle of unfettered consideration of the evidence).

The EPC contains provisions governing means of giving or obtaining evidence, the procedure for taking evidence as well as the conservation of evidence. The boards of appeal have also considered other questions arising in connection with the law of evidence.

Art. 117(1) EPC gives a non-exhaustive list of admissible means of evidence. When the EPC was revised, Art. 117 EPC was shortened (with Art. 117(2) to (6) EPC 1973 being replaced by new Art. 117(2) EPC), and the procedural details for taking evidence were transferred to the Implementing Regulations (see R. 118 - 120 EPC). Art. 117(1) EPC as revised no longer lists the EPO departments which may take evidence (Receiving Section, examining and opposition divisions, boards of appeal and Enlarged Board of Appeal); it now merely refers in general terms to "proceedings before the European Patent Office". It applies to European patents already granted when the EPC 2000 entered into force and to European patent applications pending at or filed since that date.

In **T 543/95** the board drew a distinction between the terms "evidence" and "substantiation". The time at which something could be said to have been made available to the public was substantiated by indication of a date or of a restricted period and by indication of the means by which the time claimed was established. The purpose of the evidence was to verify whether the assertion made was in fact correct. Substantiation did not extend to evidence, even if it was possible for both to coincide when using written documentation as a means of proof.

2. Admissible evidence

2.1. No definitive itemisation of admissible evidence

Art. 117 EPC makes no provision for a definitive itemisation of admissible evidence. Nor does the Convention contain any provisions which say that certain questions of fact may only be proved by certain forms of evidence. In their case law, the boards of appeal have considered the question of whether the evidence submitted by a party can be admitted into the proceedings. The assumption here has been that any type of evidence is admissible for proving any facts.

In **G 11/91** (OJ 1993, 125) the Enlarged Board of Appeal stated that evidence of what was common general knowledge on the date of filing of a patent application may be furnished in connection with an admissible request for correction under R. 88, second sentence, EPC 1973 (now R. 139, first sentence, EPC) in any suitable form allowed by the Convention (and Art. 117(1) EPC 1973 in particular) as a means of giving or obtaining evidence. It may thus be based upon means of evidence in other than document form (see also **G 3/89**, OJ 1993, 117). The Legal Board of Appeal decided along the same lines in **J 11/88** (OJ 1989, 433), according to which questions of fact must be settled on the basis of any credible information available.

That the EPC 1973 contained no restrictions with regard to evidence which could be admitted in proceedings before the EPO has been confirmed on several occasions by the case law, with the boards of appeal interpreting the term "taking of evidence" broadly, applying it not only to the hearing of the oral evidence of parties, witnesses or experts in accordance with R. 72 EPC 1973 (now R. 117 EPC) but also to the production of documents of any kind, affidavits and the giving and obtaining of evidence, whatever its form (see **T 117/86**, OJ 1989, 401; **T 416/87**, OJ 1990, 415; **T 323/89**, OJ 1992, 169; **T 314/90**). A "déclaration sur l'honneur" certified by a "notaire" also constitutes admissible evidence, although its probative value depends on the particular circumstances of the case (**T 301/94**).

2.2. Hearing witnesses and experts

In **T 374/02** the board clarified that the Convention required clear requests with regard to testimonies a party wished witnesses to give, since the responsible department of the EPO had to issue a decision regarding the taking of oral evidence (Art. 117(1)(d) EPC 1973 and R. 72(1) EPC 1973; now R. 117 EPC). The party had to indicate the factual details that it wanted to be proven by the oral evidence requested. In this case, the appellant had solely asked in his letter for the board's opinion about the presence of three persons during the oral proceedings and mentioned that one of them "can make a further statement" without explicitly offering the mentioned persons as witnesses. Even if the mention of the above persons could have been considered an implicit offer of witnesses, the board was of the opinion that it did not need to hear them, because this "implicit offer of witnesses" did not specify what might persuade the board to evaluate the evidence already existing in the file differently, and because witnesses were meant to corroborate the facts for which they were expected to be heard, not to fill in gaps in the facts and arguments brought forward by the party in support of its case.

In **T 543/95** the opposition division had refused to hear the witness, commenting that he would serve only to confirm the facts presented. It regretted that the opponent had not produced further documents showing when the brochure was made public. The board pointed out that the purpose of all evidence, whatever its nature, was to confirm a party's assertions. Parties were free in their choice of evidence. The kinds listed in Art. 117(1) EPC 1973 were merely examples. It was not for the opposition division to criticise the absence of other types of evidence.

Both an employee of one of the parties (see **T 482/89**, OJ 1992, 646; **T 124/88**, **T 830/90**, OJ 1994, 713; **T 443/93**, **T 937/93**) and also his clients (**T 575/94**) may be heard as witnesses. The fact that a witness might be **biased** did not make his oral evidence inadmissible but was a matter to be taken into account when the EPO considered the evidence (**T 838/92**). As regards this aspect, see point 4.2 below (probative value of evidence).

In **T 395/91** it was not considered appropriate for an **expert** to be heard since the questions to be answered by the expert had already been answered by the inventor as a person skilled in the art. The board was further of the opinion that assessment of the

patent law aspects, on the basis of comprehensible technical facts, was a matter for the members of the board and not a technical expert.

In **T 375/00**, in the board's opinion, an expert was only necessary when a board did not consider itself in a position to decide upon a matter without technical assistance. As boards included two technically qualified members, such cases would be rare and would occur only in special circumstances. Such circumstances did not obtain in the case at issue, which was a relatively simple mechanical case. Moreover, it was open to the appellant himself to actively seek the necessary evidence, and he had not done so. If a board were to be active in seeking experts to help the case of a party, it might be open to accusations of partiality. It was therefore neither necessary nor desirable for the board to obtain the evidence of an expert in this case.

In **T 311/01** the appellant (opponent) had offered witness testimony on the skilled person's knowledge and understanding of D1. The board considered this an admissible form of evidence under Art. 117(1) EPC 1973, where there was a need to clarify matters potentially material to the decision and of which the witness had personal knowledge. But the testimony had been offered as evidence not of specific facts but of the knowledge and ideas of skilled persons in the technical field concerned. So the appellant was offering experts, not witnesses. That, however, was not necessary; the board itself was expert enough, at least on the features and advantages described *inter alia* in documents D1 to D3 and D5.

2.3. Sworn statements in writing and statutory declarations

Art. 117(1)(g) EPC allows sworn statements in writing as a means of giving or obtaining evidence. Their purpose is to ensure that the person who has signed and handed one in need not be heard as a witness; it is not necessary to confirm the context of the declaration by hearing the person in question. In **T 674/91** the board noted that such declarations were generally produced from answers to questions put by legal experts and it was therefore not surprising if a number of declarations contained the same stereotyped formulations. With regard to evidence submitted in such statements, the board was not obliged to check the signatures as long as no counter-opinion had been presented concerning those signatures.

Sworn statements within the meaning of Art. 117(1)(g) EPC are the so-called "affidavits". The act of signing the affidavit and of swearing under oath that the statements it contains are true and correct to the best of the knowledge of the declarant, is done in the presence of a solicitor or a commissioner of oaths. Affidavits are to be distinguished from "statutory declarations", which are not given on oath. However, statutory declarations are solemn statements of evidence with the same effect as an oath and must equally be attested by a person authorised to administer oaths. They are admissible means of evidence under Art. 117(1) EPC. The statutory declaration takes the place of the sworn statement in writing referred to in Art. 117 EPC 1973 which does not exist as evidence under German law (see **T 558/95**).

In **T 770/91** the board pointed out that although statutory declarations were not explicitly covered by Art. 117(1)(g) EPC 1973, they were taken into account in accordance with the principle of the unfettered consideration of evidence. Similarly, the EPO accepts unsworn solemn declarations in the same way as it accepts other unsworn statements (**T 970/93**, **T 313/04**). Under German law, statutory declarations are not one of the usual forms of evidence. They are admissible only in particular cases and have a lesser probative value than the usual ones such as witness testimony. In proceedings before the EPO, however, even a simple declaration can be a means of evidence within the meaning of Art. 117(1) EPC 1973 (see **T 474/04**, OJ 2006, 129).

Any kind of document, regardless of its nature, is admissible during proceedings before the European Patent Office. The probative value of any such document, however, depends on the particular circumstances of the particular case in application of the principle of free evaluation of evidence. In this context, the EPC does not rule out the hearing of an employee of one of the parties to the proceedings as a witness. Analogously, the board in **T 327/91** could not see any reason to disregard an affidavit, even, if it were signed by a general manager of the appellant. However, what was not admissible was evidence supplied in the form of testimony by witnesses or statutory declarations if such means of evidence were offered in place of delivery notes which could no longer be produced because such a long time had been allowed to elapse that they had been destroyed during routine shredding (**T 231/90**).

In **T 804/92** (OJ 1994, 862) the opposition division had, in a communication to the parties, suggested in detail the content of a statement under oath. Such a practice was firmly rejected by the board because it involved the risk of leading witnesses and could seriously undermine the probative value of such statements. This applied to departments at any instance in proceedings before the EPO.

In **T 798/93** the board emphasised that sworn statements in writing, which were one of the means of giving or obtaining evidence listed in Art. 117(1) EPC 1973, were not automatically ordered simply at the request of one of the parties. All means of giving or obtaining evidence listed in Art. 117 EPC 1973 were subject to the discretion of the department concerned, which ordered them only when it considered this necessary.

In **T 558/95** the board was unable to exclude the opponent's statutory declarations from the proceedings on the grounds that their wording was to some extent identical and that they had been drawn up by employees of the opponent. It was rather a question of evaluation to see whether the evidence provided was sufficient (see point 4.2 below, probative value of evidence).

2.4. Other evidence

The term "**documents**" in Art. 117(1)(c) EPC 1973, which is not elucidated in the EPC, was defined in **T 314/90** as meaning essentially all written documents in which thoughts are expressed by means of characters or drawings, including published documents.

In **T 795/93** the board was of the opinion that a **document** as a means of disclosing the state of the art was a means of proof with a variety of functions. It was intended first to prove what had been made available to the public in the written description it contained, i.e. what contribution in the form of information, knowledge, teaching, etc. it made to the state of the art, and also served to prove when such information had been made available.

In **T 71/99**, the patent had been revoked at the end of the oral proceedings before the opposition division. The appellant's (patentee) objections to the contested decision were based exclusively on allegations relating to the conduct of the oral proceedings before the opposition division. However, the minutes of the proceedings by the division did not provide a full account of the conduct of oral proceedings. To show the board what had actually happened, the respondent submitted **part of a copy of a report** of the proceedings dictated by his representative on the day they were held. The appellant argued that this document should not be admitted, without however disputing the facts set out in it. Since the extract submitted was significantly more precise and not difficult to understand, the board saw no reason not to admit the document and informed the parties accordingly at an early stage in the proceedings.

3. Taking of evidence

3.1. Competent departments

Art. 117 EPC 1973 provided for the admission of evidence in proceedings before examining divisions, opposition divisions, the Legal Division and the boards of appeal. It was made clear in **J 20/85** (OJ 1987, 102) that the Receiving Section also had the power to take evidence, although this EPO body was not listed in Art. 117 EPC 1973. Art. 117 EPC now indicates the types of evidence permitted "in proceedings before the European Patent Office".

3.2. Time frame

Evidence must be taken as soon as a dispute arises (**J 20/85**, OJ 1987, 102). Evidence may also be taken from parties without the presence of their patent attorneys if the latter have been informed of the hearing (see **T 451/89** and **T 883/90**).

In **T 953/90** the board held that when a party sought to prove potentially relevant facts by means of the statement of a witness, it was particularly important that this statement be furnished early in the opposition phase so as to enable the witness to give oral evidence in accordance with Art. 117 EPC 1973, if the statement was disputed by a party on the other side or if the EPO considered it necessary.

3.3. Taking of evidence - scope and right to be heard

In **T 39/93** the board held that it had to decide an appeal on the basis of the evidence and arguments adduced only in the current proceedings. It would be wholly wrong for it to take cognisance of any matter that was not actually in this particular case. If an

original photomicrograph was a piece of evidence that had been introduced in another case and only a photocopy of this had been introduced in the case in question, the board was limited to a consideration of the photocopy filed in the current appeal.

An opposition division's refusal to consider evidence filed in due time infringes a party's fundamental right to free choice of evidence and right to be heard (Art. 117(1) and Art. 113(1) EPC). More specifically:

EPO departments must ascertain the relevance of evidence submitted to them before deciding whether to admit or reject it. Only in exceptional circumstances need they not do so, according to the board in **T 142/97** (OJ 2000, 358). In the case in point, however, the opposition division based its refusal of the offers to present evidence on mere conjecture as to its content, and failed even to take cognisance of the evidence tendered and its connection with the circumstances of the prior use, although there were no circumstances which would have made examination as to relevance dispensable.

The opposition division revoked the patent in suit in **T 474/04** (OJ 2006, 129) because the invention did not involve an inventive step over the prior use evidenced in a declaration submitted in lieu of evidence on oath. Since fundamental assertions made in the declaration had been contested, the author was offered as a witness. Although the appellant (patentee) had consistently demanded that the author be heard, the opposition division decided not to summon him as a witness, even though he was available. The board held that this had handicapped the appellant in its defence against what turned out to be the decisive piece of evidence. The appellant had effectively been prevented from having its evidence that the prior use had not taken place in the way alleged by the respondent considered. This was all the more inappropriate since the prior use was the respondent's own and the evidence therefore largely lay "within the power and knowledge of the opponent". Thus, the opposition division had infringed the appellant's right to be heard, which constituted a substantial procedural violation justifying the remittal of the case to the department of first instance. The board thus made it clear that, as a rule, if assertions made in an unsworn witness declaration remain contested, a request from a party to hear the witness must be granted before these assertions are made the basis of a decision against the contesting party.

In **T 225/03** the opposition division did not take evidence by hearing the witness before revoking the patent because it considered the allegation of public prior use to be adequately proven by the documentary evidence. The board found that level of proof to be insufficient, and held that the respondent's request – that the documentary evidence be complemented by hearing the witness – had to be granted, as only the witness could confirm the links between the individual pieces of evidence and the circumstances of use as explained in his statutory declaration. It therefore sent the case back to the department of first instance for further prosecution.

In **T 267/06** an affidavit with an attached, undated drawing (item D12) and a witness hearing were offered as evidence of the public prior use claimed in the notice of opposition. The opposition division rejected the opposition to the European patent. The only reference it made in its decision to the offer of a witness hearing as evidence was in

the "Summary of facts and submissions", while the reasons dealt exclusively with the item D12 affidavit and drawing. In the board's view, the arguments advanced in the contested decision suggested that the opposition division had held certain assertions concerning public prior use as per D12 to be unverifiable and had made presumptions about the technical form of the "Umhausungen" (housings) referred to in the affidavit. Thus essential details referred to in the affidavit and deemed to be illustrated in the drawing seemed not to have been taken into account. In those circumstances, the witness hearing offered as further evidence should not have been disregarded for the purposes of assessing the claimed public prior use as per D12. According to the opposition, evidence from the witness hearing had been offered among other things specifically in case the described details of the system for which prior public use was claimed were contested and hence not taken into account. The board therefore found that disregarding the offer of evidence constituted a fundamental procedural violation in that there had been no opportunity to exercise the right to be heard under Art. 113(1) EPC 1973.

According to **T 716/06**, it is true that where oral evidence of a witness is requested by a party the competent EPO department should grant this request only if it considers this oral evidence necessary, i.e. when it is required to clarify matters that are decisive for the decision to be taken. There is normally no need for the competent department to hear a witness on an alleged prior use, if it does not evaluate the facts and arguments brought forward by the opponent in support of the claimed prior use differently. There is also normally no need to hear a witness to testify that an alleged prior use was made available to the public, if this alleged prior use is cited only in support of lack of novelty and the EPO department is of the opinion that the alleged prior use is in fact not a novelty-destroying part of the state of the art, since establishing availability to the public in that case would have no influence on the decision to be taken. By contrast, in the case at issue, the opposition division was of the opinion that not only was the claimed public prior use not established but also that this public prior use, even if established, would not be a novelty-destroying part of the state of the art, because the feature that the stator disc is optically opaque was not disclosed therein. However, the opposition division did not consider the opponent's offer to hear the same witness on these two issues.

The board stated that if a request is made by an opponent to hear a witness on an alleged public prior use and on the disclosure of a certain feature by this prior use, the competent department of the EPO must as a rule grant this request before deciding that the alleged public prior use is neither established nor a novelty-destroying part of the state of the art because the feature in question is not found to be disclosed therein.

While it is well-established by case-law that third party observations can be considered, both at first instance and on appeal, there is no obligation on the board beyond such consideration and no right of a third party to be heard on the admissibility of its observations and of any evidence in support of observations. While, of course, the actual parties to proceedings have the right to be heard in relation to such observations if they might (in whole or in part) form the basis of a decision, that right arises quite independently under Art. 113(1) EPC. Thus, the admissibility of third party observations (and accompanying evidence) is entirely a matter for the board (**T 390/07**).

In **T 1100/07** the opposition division had concluded that since the submitted documents were insufficient to prove that all technical features of the claim were present, no reason had been seen to hear the two witnesses offered by the appellant. As to the first witness, the board concluded that the decision of the opposition division not to hear him was justified because the witness was only offered to confirm what was stated in a previous letter, which itself only consisted of assertions about various documents. Those documents spoke for themselves and the witness's confirmation of their content could add nothing relevant to the case. With regard to the second witness, however, the decision of the opposition division was wrong, as it appeared to have overlooked that the witness was not being offered merely to confirm the statement about the content of the statutory declaration, but also to give evidence about the technical details of the public prior use. Although the board expressed considerable sympathy with the predicament in which the opposition division found itself when considering the request to hear witnesses - given that the evidence was confusing and not directed to the crucial issue of the case - the case was remitted to the department of first instance in order for the evidence of the second witness to be heard.

3.4. Keeping of evidence

T 760/89 (OJ 1994, 797) dealt with the possibility of returning documents which had been filed as evidence and were subject to an obligation to maintain secrecy. The ruling was that documents filed as evidence during opposition proceedings and submissions referring to them in principle remained in the file until the end of the proceedings and for at least five more years (see R. 95a EPC 1973, now R. 147 EPC). Documents filed as evidence could only exceptionally and on a substantiated request remain unconsidered and be returned. Such an exception existed if the interests of the filing party in having them returned unconsidered clearly prevailed over the interests of any other party and the public interest. This might be the case if the documents were filed in breach of a confidentiality agreement and if they did not belong to the state of the art but were third party statements filed as part of the response to the opposition, and if the other parties involved agreed with the request. The same applied to submissions referring to such documents.

4. Evaluation of evidence

4.1. Principle of unfettered consideration of evidence

The EPC says nothing about how the outcome of taking evidence should be assessed. The principle of unfettered consideration of evidence applies. The body required to take the decision therefore decides - on the basis of the whole of the evidence taken and the proceedings, and in the light of its conviction arrived at freely without reference to any legislative provisions on the evaluation of evidence - whether an alleged fact has occurred or not (see **T 482/89**, OJ 1992, 646; **T 327/91**, **T 838/92** and **T 575/94**). Nor have any general rules been laid down in the case law for the consideration of evidence; instead, it has been decided from case to case when a particular piece of evidence is sufficient. If a party fails to submit available evidence when asked by the board to do so, this may be taken as an indication that it is possible that the evidence does not support

his arguments (see **T 428/98**). On the other hand, an allegation (namely that evidence had been falsified) based solely on suspicion could not reasonably be expected to form a valid ground for casting doubt on the credibility of the evidence (see **T 970/93**).

However, the principle of free evaluation of evidence applying in the proceedings before the EPO could not be a justification for refusing a **relevant and appropriate** offer of evidence. Free evaluation of evidence means that there are no firm rules according to which certain types of evidence are, or are not, convincing. It does not mean that the deciding body can choose the evidence which it considers sufficient for establishing the truth, but that there are no firm rules according to which certain types of evidence are, or are not, convincing (**T 474/04**).

In **T 324/03** the appellant (opponent) had nominated three witnesses to give evidence in support of his allegation that prior use of the patent at issue (cutting tool inserts) had taken place but the board rejected the request for hearing these witnesses. In this case, the board considered it appropriate to start from the hypothesis that inserts of type 229 as shown in the drawing D8 as alleged by the appellant were effectively made available to the public before the priority date of the patent in suit, and only if the alleged prior use was found pertinent as to its subject-matter to investigate whether it could be established as fact, for example by hearing the witnesses offered by the appellant. However, in the absence of any precise information or data in the submitted documents, the allegations of the appellant had to be regarded as unsubstantiated. As a consequence, the appellant's offer to hear witnesses for proving the allegations made became **irrelevant** for the board's decision.

When evaluating evidence, it is necessary to distinguish between a document which is alleged to be part of the state of the art within the meaning of Art. 54(2) EPC 1973, in the sense that the document itself is alleged to represent an instance of what has been made available to the public before the priority date of the opposed patent, and a document which is not itself part of the state of the art, but which is submitted as evidence of the state of the art or in substantiation of any other allegation of fact relevant to issues of novelty and inventive step (**T 1110/03**, OJ 2005, 302). In the first situation, a document is **direct evidence** of the state of the art; its status as state of the art cannot normally be challenged except on authenticity. In the second situation, a document is also **evidence** albeit **indirect**; it provides a basis for an inference about, e.g. the state of the art, common general knowledge in the art, issues of interpretation or technical prejudice etc. – an inference which is subject to challenge as to its plausibility. Only a document of the first kind can be disregarded on the sole ground that it is published after the priority date. Documents of the second kind do not stand or fall by their publication date even on issues of novelty and inventive step. Disregarding indirect evidence would deprive the party of a basic legal procedural right generally recognised in the contracting states and enshrined in Art. 117(1) and Art. 113(1) EPC 1973.

In **national proceedings** before the Dutch District Court and Court of Appeal, several witnesses were heard, and written statements were introduced from both parties. The Dutch Court of Appeal could not establish an uninterrupted chain of proof that the alleged public prior uses had indeed taken place before the priority date of the contested

patent. After evaluating the Dutch Appeal Court's findings, the board's judgment in **T 665/95** was that no further investigations were necessary and that the conclusion of the Dutch Appeal Court could be followed, with the consequence that the subject-matter of the granted claim 1, contrary to the impugned decision of the opposition division, was considered to be novel.

4.2. Probative value of evidence - individual cases

4.2.1 Evidence sufficient

In **T 162/87** and **T 627/88** it was decided that a **statement made by an employee** of the party alleging prior use could be sufficient. The statements of employees of one of the parties were also used in **T 124/88**, **T 482/89** (OJ 1992, 646), **T 830/90** (OJ 1994, 713), **T 838/92** and **T 327/91**, without any grounds for their credibility being given. The **credibility of witnesses** could not be impugned merely because they were related to one another and had a business relationship with one of the parties (**T 363/90**). In **T 937/93** it was stated that the probative value of the declarations of a witness depended on the circumstances of the particular case.

In **T 1191/97** the appellant's criticism of the evaluation of evidence by the department of first instance did not pose a serious threat to the witness's credibility. The fact that the events at issue had taken place a long time ago could readily explain certain imprecisions in the witness's testimony. The board saw no indication that the witness had been in breach of his obligation to testify to the best of his recollection.

4.2.2 Evidence insufficient

In accordance with the principle of unfettered consideration of evidence items of evidence relevant to a matter at issue have to be given appropriate weight in order to establish reliably what was likely to have occurred. An unsigned statement by an unknown and unnamed person should in principle be given minimal weight (**T 750/94**, OJ 1998, 32).

In **T 332/87** a dated **internal paper**, marked as being confidential and not signed, was - together with an **undated leaflet** - not considered sufficient evidence. In **T 595/89** the board decided that the opponent's in-house documents relating to the installation of a device in an aeroplane and to the sale thereof were not sufficient to prove public prior use.

In **T 204/88** a **letter of tender** was not sufficient to prove public prior use because it was not discernible when and to whom the device was to be delivered and because the device was described in terms too general for anyone to identify whether it corresponded to the invention. In **T 725/89** too, a dated tender was not regarded as sufficient evidence, as it was not proven when the tender had actually been presented, and the date of the tender was only one week prior to the priority date. By contrast, the board took the view in **T 482/89** (OJ 1992, 646) that an **unsigned delivery note**, together with other documents, could constitute sufficient evidence of delivery.

In **T 48/96** the board stated that, in order to prove the allegation that a particular apparatus described in a catalogue had been available to the public before the priority date, it was not sufficient to show that the catalogue had been published on time, because a mere indication in a catalogue did not constitute absolute proof that the described product had in fact been available to anybody; for example, there could have been a delay. It therefore decided not to accept copies of **pages from a catalogue** bearing a date as sufficient proof of availability to the public.

In **T 314/99** concerning the availability to the public of a diploma degree paper ("Diplomarbeit"), the board took the view that the said paper did not become publicly available by its mere arrival in the archive of the Chemistry Department Library of the University. The **"logbook"** produced in evidence was a handwritten note book in which the diploma degree papers received in the archive were entered by the librarians. The logbook itself was not an official publication of the library but essentially an internal document of the library staff. After closer examination of the annotations in the logbook, the board said that it could not be concluded with certainty that the relevant entries were actually made before the relevant priority date and it could not be ruled out that they were added at a later time, when for one reason or another the time frame became relevant. In the absence of further submissions or evidence to refute these arguments, the board could come to no other conclusion than that the evidence of the annotated logbook was unsafe.

In **T 91/98** the respondent (opponent) challenged inventive step on the basis of, in particular, document (8) which was an **entry from the Lexis-Nexis database**. The document did not, however, provide any evidence as to when this information was entered into the database, i.e. as to when it was made available to the public. Neither could the date of availability be taken as the date mentioned in the heading of the entry (September 3, 1985) as this latter date could not be equated to the distribution date of the information and was not even necessarily correct. After detailed evaluation of the declarations and affidavits filed by the respondent the board arrived at the conclusion that the date on which the information contained in document (8) was made available to the public could not be unambiguously defined.

To prove the alleged public prior use, in **T 212/97**, the appellant (opponent) had cited facts based on **hearsay**. The appellant's attention had been drawn several times to the inadequacy of the evidence for the alleged prior uses. He failed to cite any witnesses. However, where public prior use was alleged, an opponent had to do everything he could to provide satisfactory evidence. Here, however, no clear proof of the alleged public prior uses had been provided.

In **T 905/94** the patent proprietor had exhibited a blind at an exhibition. After having considered the evidence regarding the exhibition the board looked at the question of whether use of the same **trade name** for different models could constitute evidence of the fact that the patent proprietor had marketed or described the blinds according to the patent at issue before the date of priority. In the board's opinion, such use could not constitute sufficient evidence since it was common practice in industry for the same

name to be used and retained for a product, the technical characteristics of which changed over time as improvements were made.

In **T 702/99** the board made extensive remarks with regard to the probative value of test evidence. It noted that it is essential that **comparative tests**, conducted by a number of persons as evidence for or against qualities such as an improved "feel" of a product (e.g. cosmetics), be made under conditions which ensure maximum objectivity on the part of those conducting the tests and who may be required at a later date to give evidence in proceedings. Since such evidence is opinion evidence and thus inherently subjective, its value lies in the number of similar or same opinions and the tribunal faced with such evidence will seek to judge the objective value of a number of subjective opinions. Parties to proceedings should adopt the same standards in the preparation of such test evidence as they should in the preparation of experimental evidence. While the use of independent persons would naturally tend to carry more weight, the use of employees may not be objectionable per se as long as the test conditions are designed to ensure that, just as if independent persons were used, the employees are not biased by prior knowledge of either the products under test or of their employer's expectation of the result of their tests.

It is always desirable that such tests can be shown to be "blind"; that the testers have had no part in the making of the claimed invention or research leading up to the invention or the patenting procedure; and that the tests have been conducted under the strictest conditions. The presentation of such evidence must also be accurate, but the format of the presentation is of secondary importance; a carefully prepared report and/or table may convey as much information as a large number of statements from the testers.

In **T 453/04** the board found the **experimental evidence** advanced by the appellant (opponent) to be defective for two reasons. Firstly, the teachings of the patent in suit were not accurately replicated. Secondly, the product presented as representative of the prior art had not been shown to belong to the prior art. Thus the experimental evidence of the appellant did not demonstrate that the process steps set out in claim 1 of the main request resulted in products indistinguishable from those of the prior art.

The opponent having died, the board had to decide in **T 74/00** whether the evidence had shown that an heir or heirs had succeeded to the right of the opponent to appeal or to the appeal itself. In the board's view, the best evidence which could be provided was evidence of the relevant law of succession (here, Japanese law) as applied to the facts of the case in hand and, in particular, by way of **legal opinion** from a Japanese attorney-at-law; the mere filing of copies of a party's correspondence with his instructing Japanese attorneys could not serve as substitute because such correspondence was not evidence per se. In this case the board considered two issues of fact, namely the date of the opponent's death and the issue of succession.

As to the first issue, there were two items of evidence - the statement in a letter from the representative's instructing Japanese patent attorneys that they had no knowledge that she had died before the filing date of the appeal, and the information, appearing from the notice of appeal that she had died during 2002. The board saw in the first item a vague,

second-hand and thus highly unreliable piece of evidence. However, the second item of evidence, while very general as to the date of death, did at least provide a year of death and could thus be said to establish that, at least on the balance of probability, the opponent had still been alive when the appeal was filed.

As to the question whether the two daughters of the deceased inherited all the rights of the appeal jointly or not, the available evidence demonstrated inconsistencies in the crucial matter of the identity of the heirs. The board therefore reached the conclusion that the necessary legal requirement - namely that there must be sufficient evidence of an heir or heirs - had quite simply not been fulfilled. There was accordingly no-one who could continue the appeal, which therefore had to lapse (see also Chapter VII.C.5.1, transfer of opponent status).

In **T 473/93** the board decided that the appellant's surmise that he had been in error in making his statutory declaration was not sufficient to allow orally presented facts which deviated from the declaration to appear more credible. The fact alleged orally therefore had to be regarded as not proven.

In **J 10/04** the Receiving Section had questioned the credibility of a sworn statement. Considering the **sworn statement** to have been based on personal impressions which were subjective and not always reliable particularly regarding a routine task, the Receiving Section had not invited the witness in order to hear her personally. The Legal Board did not share that view and stated that the Receiving Section should have heard the witness personally in order to be able to evaluate her credibility. The board evaluated sworn statements as a form of evidence with a high probative value especially if they were given with the awareness that wilful false statements were punishable by a fine or imprisonment or both under the applicable law. Strong reasons were therefore necessary to disregard this kind of evidence. These reasons could be a set of circumstances which made the statement very unlikely, so that the **credibility of the witness** would become decisive.

The Legal Board also held that the credibility of a person could only be evaluated by oral evidence. The credibility of witnesses could not be impugned merely because they had a business relationship with a party. Moreover, the fact also that the statement was based on personal impressions of the witness could not be a reason to disregard it, because evidence was often based on the personal recollection of a person. If evidence based on personal impression was not credible per se, evidence from witnesses could never be credible.

In **T 905/94**, the board held that the fact that one witness had made his declaration three years earlier than other witnesses was not sufficient reason to make his testimony more credible.

In **T 780/05** the board had also to consider whether an offer of witness evidence was sufficiently substantiated. Here, a request that a witness be heard was made, for the first time, during the discussion of novelty in oral proceedings before the board. The board regarded this request as insufficiently substantiated, because circumstances which

would have enabled the witness to speak reliably on the matter at issue – i.e. precise, first-hand and verifiable knowledge of the public availability in the context of alleged prior use – had not been credibly presented. The unsatisfactory nature of the witness offer was further highlighted by the fact that only late in the oral proceedings a further person was offered as a possible replacement witness, again without substantiation of his suitability as a witness in the matter at issue.

4.3. "Balance of probabilities" and standard of proof - various cases

The facts on which the decision is based must have been established to the satisfaction of the deciding body. The question arises as to what degree of satisfaction is necessary.

The boards of appeal generally apply the standard of the "balance of probabilities", i.e. they are satisfied on the basis that one set of facts is more likely to be true than the other. This standard applies particularly in opposition appeal proceedings (see **T 182/89**, OJ 1991, 391; **T 270/90**, OJ 1993, 725; **T 859/90**, **T 109/91**, **T 409/91**, OJ 1994, 653; **T 1054/92**, **T 296/93**, OJ 1995, 627; **T 326/93**, **T 343/95**) but also in the decisions issued in ex parte proceedings (**T 381/87**, OJ 1990, 213; **T 69/86**, **T 128/87**, OJ 1989, 406; **T 939/92**, OJ 1996, 309). In other cases the board decided on the basis of circumstances of which it was sufficiently certain (see e.g. **T 100/97**).

When an issue of fact is being examined and decided by the EPO on the balance of probabilities, the more serious the issue the more convincing must the evidence be to support it (**T 750/94**, OJ 1998, 32). If a decision on such an issue might result in refusal or revocation of a European patent, for example in a case concerning alleged prior publication or prior use, the available evidence in relation to that issue had to be very critically and strictly examined. A European patent should not be refused or revoked unless the grounds for refusal or revocation (that is, the legal and factual reasons) were fully and properly proved.

In cases of re-establishment of rights it is usually ruled that, on the basis of the evidence furnished, the board is or is not satisfied that the facts adduced to substantiate the application for re-establishment of rights are true. In **T 243/86** and **T 13/82** (OJ 1983, 411), a request was made for "Glaubhaftmachung" (i.e. that the facts on which the application relies be set out) in accordance with Art. 122(3), first sentence, EPC 1973 (now R. 136(2) EPC). However, it has not yet been clarified whether this term means (as it does in German, Austrian or Swiss law) that a lower degree of probability is sufficient.

4.3.1 Public prior use

In **T 782/92**, the board took the view that public prior use had to be proved beyond any reasonable doubt. In **T 472/92** (OJ 1998, 161) the board reaffirmed the principle of the balance of probabilities in normal cases, but made a distinction for cases of public prior use where practically all the evidence in support of an alleged public prior use lay within the power and knowledge of the opponent. In such cases, the patentee seldom had any ready, or indeed any access to it at all. All he could, in practice, do was to challenge that evidence by pointing out any inconsistencies contained in it or to draw attention to any

gaps in the chain of commercial transactions that needed to be established by the opponent in order to succeed on this ground. The board stated that the opponent had to prove the alleged prior use **up to the hilt**, for little if any evidence would be available to the patentee to establish the contradictory proposition that no prior public use had taken place. Later case law also confirmed that, where public prior use is cited, the assessment of probability which normally underlies the boards' opinion must cede to a stricter criterion close to absolute conviction. In other words, there should be a degree of high certainty which is beyond any reasonable doubt (**T 97/94**, OJ 1998, 467; see also **T 848/94** and **T 12/00**).

In **T 970/93** the claims referred to a continuous multi-stand mill plant for producing steel plates. Two prior uses, a mill plant in China and a mill plant in Germany, were put forward by the appellants (opponents). A discussion developed on the subject whether the skilled person would have been able to recognise the relevant feature, i.e. the rolling speed ratio of the mill plant in China, because such ratio could not be derived from a single rolling event. Furthermore, the respondent took the view that both the builders and the owners of the plant would impose an obligation to maintain confidentiality in order not to reveal the actual capacity of the mill, thus putting competitiveness at risk. Following the principle of the balance of probabilities it was, in the board's view, very unlikely that in a period of almost seven years between the start of operations at the plant and the priority date of the patent in question, the mill drive motor speed ratio of the mill would not have become publicly available taking account of the following evidence and circumstances: it was common practice in China to promote and demonstrate newly-installed industrial plants as a means of instruction to young engineers. It was not at all likely that an obligation to maintain secrecy would bar this information path for competition reasons as supposed by the respondent. In the absence of any evidence as to **confidentiality**, the principle also applied that the company that purchased the mill could be considered a member of the public, which through the purchase of the mill and subsequent use thereof took possession of all the relevant information with respect to the rolling speed ratio.

In **T 441/04** the board agreed with the respondent that evidence in document form was normally preferable to witness testimony about long-ago events. But that did not mean that in the case in point such testimony was necessarily excluded per se or less convincing than documentary evidence. Here, the board considered that it had taken due account of the fact that the alleged public prior use – proven by witness testimony – was attributable to the appellant by applying, in its evaluation of the evidence, the (high) standard of proof beyond doubt. The evidence submitted (mainly witness testimony) had measured up to that standard, and therefore no new or additional proof (such as drawings) was needed. The conduct of the opposition division had led to the public prior use being completely disregarded as prior art for inventive-step purposes, and had therefore been inappropriate. The division's insistence that there be no missing links in the chain of evidence submitted went beyond the point at issue (here: the subject-matter of the prior public use) to include proving that the alleged prior use had been public – an issue which, in this case, had not been in dispute.

4.3.2 Content of a disclosure

In **T 793/93** the relevant prior art document had failed to disclose explicitly something falling within a claim. The board held that availability within the meaning of Art. 54 EPC 1973 could still be established if the inevitable outcome of what was literally or explicitly disclosed fell within the ambit of that claim. In the board's view, a **standard of proof much stricter** than the balance of probability, to wit "beyond all reasonable doubt", needed to be applied. It followed that if any reasonable doubt existed as to what might or might not be the result of carrying out the literal disclosure and instructions of a prior art document, in other words if there remained a "grey area", then the case of anticipation based on such a document had to fail (see also **T 464/94**).

In **T 348/94**, the board held that it had not been proven beyond reasonable doubt that the technical contents of the oral presentation at the conference corresponded **in all details** to the relevant article published 10 months later in the conference proceedings. Unless there was proof to the contrary, a written publication, supposedly based on a paper previously read at a public meeting held some time earlier, could not be assumed to be identical to what was disclosed orally but might contain additional information (see also **T 890/96**).

In **T 151/99** the board regarded it as **highly plausible** in the light of the available evidence that a master's thesis had become available to at least one member of the public. If the reference was in a document published before the priority date of the patent in suit then it could be assumed that the said paper had also been made available to the public before the said date.

In **T 204/00** the board observed that, according to established case law, the standard of proof to be applied in establishing the inevitable outcome of a prior art disclosure for the purpose of assessing novelty should be significantly stricter than the balance of probabilities (see **T 793/93** and **T 396/89**). The board held that this was particularly so in the circumstances of the case at issue, where the inevitable result alleged by the appellant was in contradiction with the explicit disclosure of the prior art document D1 and the results obtained by the respondent. In addition, the party submitting the allegation had not only the burden of reproducing the earlier disclosure in such a way as to demonstrate that the alleged inevitable outcome had occurred, but also the burden of proving convincingly that if any significant deviation from the conditions specified in the earlier disclosure was not material to the outcome (see also **T 396/89**).

In **T 1134/06** the board pointed out that, as a first step for evaluating evidence, the reliability of the source must be ascertained. When establishing the state of the art under Art. 54(2) EPC for the purpose of assessing novelty and inventive step on the basis of traditional publications such as published patent applications or specifications the majority of these publications emanate from sources which are considered as reliable. The evidentiary weight of such sources normally resides in the large number of physical, existing copies of the publication, or because the source itself has the character of public authority, such as a patent office. Therefore, publication date and content are assumed to be truthful with a high level of confidence. In the case at issue, however, the

disclosure was made available to the public through the **Internet**. In order to establish that an internet disclosure forms part of the state of the art, the board held that the same strict standard of proof as with prior use or prior oral disclosure must be applied – the same questions "when", "what" and "under which circumstances" must be answered (endorsed by **T 1875/06**). Furthermore, the board took the view that the circumstances which allow the determination of whether a disclosure on the Internet was made available to the public may, where appropriate, also include factors that have a bearing on the reliability of the information, for example, the manner in which information has been procured and date stamped, how it has been preserved by the source, and whether it has remained unaltered since deposit.

In case **T 1210/05**, the board concluded that the contested prior disclosure (public display of a poster identical to document (1) at an Edinburgh congress) had not been sufficiently proven, i.e. beyond all reasonable doubt, based on the following considerations: the fact that the various means of evidence, namely the submitted documents, the affidavits of the witnesses as well as their oral testimony, were not in contradiction with each other was not sufficient for meeting the required standard of proof. Furthermore, the finding of the opposition division rested exclusively on the testimony of one of the witnesses. No independent evidence (in writing or by other persons) was available to support it. This did not mean that the written and oral testimony of the witness was per se insufficient. However, the board stated that there must be good reasons for treating this evidence alone as having established the facts beyond any reasonable doubt. As to the reasons of the decision under appeal, the opposition division was of the opinion that the testimony could only be refused if it thought that the witness was lying. The board found this reasoning to be faulty. It started by accepting as true the matter that had to be proven by the testimony whose credibility was to be evaluated. Furthermore, it was certainly not the case that a person only does not tell the truth if he is being dishonest. A person can be honestly mistaken in his recollection of an event, particularly if the event took place some time ago. Hence, the board did not agree with the opposition division's conclusions that the witness's testimony must be true as there was no evidence that she was lying.

4.3.3 Amendments

The boards have only allowed amendments or corrections if it was certain beyond **any reasonable doubt** that the subject-matter of the application had not been extended beyond that of the application as filed (**T 383/88**, **T 581/91**). When examining Art. 123(3) EPC 1973 the board laid down the principle in **T 113/86** that voluntary amendments requested by the patentee which were not necessitated by any of the grounds for opposition raised by the opponent or by the board should, in principle, not be allowed if there was the slightest doubt that the unamended patent could be construed differently to the patent as amended.

For the standard of proof for allowing amendments and corrections, see Chapter III, amendments.

4.3.4 Claiming a valid priority

In **T 1056/01** the board pointed out that because of the crucial effect a valid priority date had on patentability, the date of filing of the application whose priority was claimed had to be proven in a formal way, namely by a certificate issued by the authority which had received that application (see R. 38(3) EPC 1973, now R. 53(1) EPC; and Art. 4D(3) Paris Convention). Even if no such **formal proof** was prescribed for the timely withdrawal of a previous application pursuant to Art. 87(4) EPC 1973 (see Art. 4C(4) Paris Convention), it appeared appropriate to require an equally high standard of proof, for once there existed a previous application concerning the same invention both dates were equally relevant for establishing the validity of the claimed priority. However, in the case at issue, the timely withdrawal of the UK application for the purposes of Art. 87(4) EPC 1973 could not be established. Unlike facts barring patentability (see for example **T 219/83** cited by the appellant), the timely withdrawal of a previous application was a positive precondition for claiming a valid priority from a subsequent application for the same invention. Hence, the date of the effect of the withdrawal was a fact which could act in the applicant's favour, and she had relied on it just as she had relied on the filing date (and the content) of the subsequent UK application.

In **T 493/06** (transfer of a priority application), the statutory declarations and notarial certifications submitted were sufficient evidence that the **copy** of the transfer agreement was the same as the original.

4.3.5 Abusive conduct

In **G 3/97** and **G 4/97** (OJ 1999, 245 and 270) the Enlarged Board of Appeal held that if the person named as opponent according to R. 55(a) EPC 1973 (now R. 76(2)(a) EPC) is acting on behalf of a third party, such an opposition is inadmissible only if the involvement of the opponent is to be regarded as circumventing the law by abuse of process. The deciding body had to be satisfied on the basis of clear and convincing evidence that the law had been circumvented by abuse of process.

In **T 291/97** the appellant had contended in the statement of grounds of appeal that the publication of document (1) had occurred in consequence of an evident abuse within the meaning of Art. 55(1)(a) EPC 1973, and thus did not constitute prior art citable against the claims at issue. The board decided that the above publication was to be taken into consideration for the application of Art. 54 EPC 1973. It observed in its decision that the finding of an **evident abuse** under Art. 55(1)(a) EPC 1973 was a serious matter. An abuse was not lightly to be presumed. The standard of proof was identified by the words "evident abuse" (German: "offensichtlicher Missbrauch"; French: "un abus évident") as being high: the case had to be clear-cut, and a doubtful case would not be resolved in favour of the applicant. The evidence filed in the case at issue did not meet the standard that the board would consider appropriate, in particular in that virtually every declaration filed contained serious mis-statements that had subsequently been corrected, or the indicated mis-statements had not been relied on. That the errors had been corrected or not relied on was commendable, but left unresolved the problem of whether any part of such a statement could be relied on at all. The board also pointed out that in proceedings

before the EPO it had to be possible to rely on the written evidence as having been checked with the facts; should that not be the case, the party in question would run the risk of having its evidence being disregarded as unreliable as a whole.

4.3.6 Formal requirements

The issue under appeal in **T 1200/01** was whether an opposition of the appellant against the patent could be deemed to have been filed. According to Art. 99(1), last sentence, EPC 1973, this was only the case if the opposition fee had been paid within the opposition period. However, in the case at issue no trace of a notice of opposition nor of a voucher for payment of the opposition fee allegedly filed by the appellant had been found within the EPO. The board noted that, concerning the standard of proof to be applied for establishing the receipt of documents not found within the EPO, it is the established case law of the boards of appeal that, even if proof to this effect can seldom lead to absolute certainty, it must at least show to a high degree of probability that the alleged filing took place (see also **T 128/87**, OJ 1989, 406, cited by the board). It also noted that in some previous cases (see **T 243/86** and **T 69/86**, cited by the board) it was accepted that this standard was met if there were concrete traces of the item sought which, even if they did not show it for certain, indicated a high probability of the lost document having once been in the EPO. Nevertheless, any other means of giving evidence, such as witness testimony, could equally be considered in this context.

The communication noting the loss of rights according to R. 69(1) EPC 1973 (now R. 112(1) EPC) is deemed to have been delivered to the addressee on the tenth day following its posting, unless the letter failed to reach the addressee or reached him at a later date. In the event of any dispute, it is incumbent on the EPO to establish that the letter reached its destination (R. 78(2) EPC 1973; now R. 126(2) EPC). In **J 9/05** and **J 18/05**, the only evidence provided by the examining division was a letter from the Deutsche Post referring to the information received from the foreign postal service, according to which the letter was delivered to an authorised recipient, who, however, was not specified. The board stated that the probative value of the submissions and evidence of the appellant has to be balanced against the probative value of evidence established by the EPO. In this respect it has to be observed that a party submitting that something has not happened is encounters the difficulty to prove this allegation. He can mainly presume what could have happened or what normally would have been done if a letter had been received, in order to cast doubt upon the EPO's evidence. The filing of compelling evidence showing that the letter was not received is hardly ever possible. The EPO is also in a difficult situation if an applicant submits that it has not received a communication. The Office then has to start enquiries with the postal services and has to rely on the information obtained. This information is often not satisfactory since often no details are given. After a certain period the relevant information may not even be obtainable at all. However, this ought not be to the detriment of the applicant, specifically not where communication noting a loss of rights is concerned. These problems could be avoided if such communications were delivered by registered letter with advice of delivery.

Balancing the evidence of the examining division, which consisted of the rather vague letter from the Deutsche Post, against the evidence submitted by the appellant, and taking into account the serious consequences for the appellant, the board came to the conclusion that it had not been sufficiently proven that the applicant received the R. 69(1) EPC 1973 communication. In such a situation, where the EPO bears the burden of proof, the applicant has to be given the benefit of the doubt.

4.3.7 Disciplinary matters

In **D 5/86** (OJ 1989, 210), the board held that an infringement of the rules of professional conduct had to be established to the satisfaction of the disciplinary body before it could impose a disciplinary measure. Absolute certainty was not required, but a **higher degree of probability** which in human experience verged on certainty. A disciplinary measure could not be imposed if there was reasonable doubt as to whether the infringement had occurred.

5. Burden of proof

5.1. Apportioning the burden of proof

5.1.1 General

If a material fact is not or cannot be proven, a decision is taken on the basis of who carries the relevant burden of proof; the fact that the real position cannot be established operates to the detriment of the party which bears the burden of proof for this fact. The EPC contains no explicit provisions in this respect. However, a few principles can be inferred from board of appeal practice. According to **T 200/94** (following established case law), if a board's investigations did not enable it to verify beyond reasonable doubt the facts alleged, this went to the detriment of the party needing to prove them, i.e. the party who relied on these facts.

At all events, in proceedings before the EPO, facts which related to a party's own actions or were the subject of a party's own perceptions could not be denied on the ground of "ignorance" by that party if the presentation of the facts in question was essentially the party's responsibility (**T 247/98**). According to **T 254/98**, a party could not relieve itself of the burden of providing counter-evidence for facts it alleged by simply referring to **T 472/92** (OJ 1998, 161; see above Chapter VI.H.4.3.1) and stating that all the evidence was within the power of its adversary, without bringing proof that not he but only the other party was able to collect the evidence in support of the relevant contention.

In **ex parte proceedings** the applicant bears the burden of proof for the facts in his favour, e.g. the fact that a document cited by the examining division does not form part of the state of the art (**T 160/92**, OJ 1995, 35), the fact that the conditions laid down in Art. 123 EPC 1973 have been met (**T 383/88**) or the fact that a limitation of the claims is admissible (**T 2/81**, OJ 1982, 394). Sufficient disclosure also obliges the applicant to provide evidence of the skilled person's relevant knowledge if there is reason to believe it may not cover all the subject-matter claimed. If reasonable doubts exist about the scope

or public nature of the specialist knowledge required for adequate disclosure of the invention, the applicant shall discharge his duty to disclose by submitting suitable evidence in support of the facts in his favour, in order to fulfil his duty to disclose the invention (**T 82/07**). In **T 32/95** the board found that, once the applicant had indicated sound reasons for doubting whether a cited document belonged to the state of the art, the examiner should have acted as recommended in the Guidelines, i.e. not pursued the matter further if additional investigation failed to produce sufficient evidence to remove that doubt.

With regard to **opposition proceedings**, the principle was laid down in **T 219/83** (OJ 1986, 328) that the patent proprietor is given the benefit of the doubt if the parties make contrary assertions regarding facts barring patentability which they cannot substantiate and, furthermore, the EPO is unable to establish the facts of its own motion (see also **T 293/87** and **T 459/87**). 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).

In **T 998/04** the board emphasised as an obiter dictum that the burden of proof for alleged lack of patentability lies with the opponent and cannot 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 are 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 (e.g. **T 762/04**), an inventive step (e.g. **T 382/93**) or the reproducibility of the invention (e.g. **T 16/87**, OJ 1992, 212; **T 182/89**, OJ 1991, 391), he bears the burden of proof in this respect at first and second instance. In **T 1003/96**, the board confirmed that in case of uncertainty about a prior-art disclosure, the patentee should be given the benefit of the doubt (see **T 230/92**, **T 345/86**, **T 601/91** and **T 968/91**).

In **T 596/99** the board observed that while it was legitimate for an opponent to attack a patent by pointing at an allegedly **erroneous evaluation of the evidence** by the examining division, in opposition proceedings, the burden of proof nevertheless remained with the opponent. In the case at issue the appellant (patent proprietor) therefore rightly stressed that, even if the respondent (opponent) was successful in its effort to cast serious doubt on the persuasiveness of the 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 opponent to actually prove that the subject-matter of claim 1 was unable to solve the said problem, it would have been necessary to submit convincing counterevidence. In summary, the board found that the respondent's arguments were not sufficient to discharge its burden of proof.

If a party relied on the allegation that there was a **general legal maxim**, according to which his appeal would have to be allowed (in the case in question, the principle

whereby decisions of a court of final jurisdiction could be set aside in the event of serious procedural errors), he would have to produce evidence that such a procedural principle existed in most EPC contracting states and was therefore "generally recognised" for the purpose of Art. 125 EPC 1973 (**T 843/91**, OJ 1994, 832). Following on from that, another board stated in **T 833/94** that, when the evidence offered does not directly indicate the truth or falsity of the fact in issue, but requires knowledge of the national law and patent practice, such law and practice has to be proved as does any other fact on which a party bases its arguments.

5.1.2 Various cases

a) Novelty contested

In **T 713/01** the appellant had denied the existence of an "enabling" disclosure in D2 for polymers prepared 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), according to which the criterion for a prior art disclosure to be novelty-destroying was that the claimed subject-matter could be directly and unequivocally inferred from an enabling disclosure in it. The board held that in proceedings before the examining division the burden of proof for an allegedly distinguishing "product-by-process" feature lay with the applicant (see **T 205/83**, OJ 1985, 363 and **T 279/84**). It held that the appellant's arguments were irrelevant, and that the same applied to the question whether lack of novelty could be decided on the basis of the mere probability of an anticipatory disclosure addressed in **T 464/94** and **T 727/95** (OJ 2001, 1).

b) Inventive step contested

In **T 547/88** inventive step was contested. Although the board had asked the parties to issue a joint protocol stating what tests had to be done and under what conditions, each party in fact conducted his own experiments and obtained contradictory results. It was therefore not possible for the board, on the basis of these tests, to conclude definitively that no inventive step was involved. The board held that in such a case the patent proprietor should be given the benefit of the doubt with regard to the relevance of the claimed features to the problem to be solved. Moreover, since the prior art did not suggest the subject-matter of the contested claims, that subject-matter implied an inventive step. The patent was therefore maintained.

In **T 97/00** the respondent (patentee) had alleged that it was up to the appellant to demonstrate that increased activity, improved stability and higher selectivity to C5+ hydrocarbons were not obtained over the whole claimed scope. The board, however, held that, according to established case law, each of the parties to the proceedings bore the separate burden of proof for any fact they alleged (see also **T 355/97**). Therefore, in the case at issue, the burden of proof for showing that the claimed method led to the alleged and unsupported advantageous effects mentioned in the patent in suit rested with the patentee. In the absence of any corroborating evidence that these advantageous effects were obtained, the allegation in the patent in suit of increased activity, improved stability and higher selectivity was unsubstantiated and consequently

such alleged effects were not to be taken into account in assessing inventive step (see also **T 1409/04**).

c) Reproducibility of the invention contested

In **T 792/00** the board found that if the patent contained only an example with a hypothetical experimental protocol, and if this example was to be relied on for showing sufficiency, then the burden of proof lay with the patentee to show that in practice this protocol worked as stated. Evidence that a variation of the protocol worked was unlikely to be enough. The board pointed out that the general rule was that the person who asserted something positive had the burden of proof. Thus, if a patentee asserted that an example in a patent could be carried out as stated, and an opponent denied that, it was up to the patentee to provide proof. However, if the example contained a complete experimental protocol and the patentee affirmed that the results reported had been obtained, a board was likely to accept that the patentee had done enough to shift the burden of proof to the opponent to provide a repeat of the experiment to show that it did not, in fact, work as stated.

d) Content of the priority document

In **T 1147/02** the European application at issue was filed as an international application claiming priority *inter alia* from a French application (P3). However, the priority document as transmitted by the International Bureau and contained in the EPO file did not include two relevant figures of the patent as granted, while these figures were present in a certified copy issued by the INPI. The board dealt with the issue as to which party in appeal proceedings has the burden of proving the exact content of a priority document in order to establish the relevant priority date. The board pointed out that appellant II had challenged the priority date, which was needed to establish the prior art available on file for examining novelty and inventive step. Accordingly, following the principles as established in the case law, appellant II also bore the burden of proving by convincing evidence that the relevant date for the subject-matter at issue was not the filing date of the priority document P3.

e) Formal requirements

In **J 10/91** the board held that if a letter and attached cheque in payment of a fee, had been lost without further evidence or high probability that it had been lost in the EPO, the risk was then borne by the sender. Even conclusive evidence that something had been posted could not be treated as sufficient to prove that a document had been received by the EPO. If the post failed to deliver a document, the applicant would suffer the consequences for failing to file that document, as stated by the board in **J 8/93**.

In **T 632/95** the board confirmed that the burden of proving that a document had been received lay with the party submitting the document just as, vice versa, the EPO bore the burden of proving receipt of the documents it issued.

In **T 1200/01** the board pointed out that under the EPC, the critical event for compliance with a time limit is the date of receipt of an item at the EPO, for which receipt the filing party bears the responsibility. It followed that the burden of proof that filing has been effected fell on this party. The impossibility of furnishing proof of a higher probability that an item was filed than that it was not filed, must therefore go against the filing party. In the case at issue the board held that the evaluation of the evidence referred to did not lead to the conclusion that there was a higher degree of probability that the alleged filing took place than that it did not.

Under R. 82 EPC 1973 (now R. 125(4) EPC), the burden of proof that documents have been duly notified to the parties lies with the EPO. In **T 580/06** the communication from Directorate 4.2.2 (Treasury and Accounts) was sent by fax (see point 6.4 ADA in conjunction with R. 77(2)(d) EPC 1973; now R. 125(2)(b) EPC) and thus duly notified. The question was, however, raised whether the "OK" reference on the transmission sheet of the fax was sufficient proof of receipt; this had been questioned by the addressee. In view of the absence of relevant case law of the boards of appeal of the EPO on the point, the board drew on procedural principles developed for notification by fax in German law, the fax transmission in question having arisen in the territory of the Federal Republic of Germany. Having regard to German case law and in the light of the knowledge gained from it, the board was convinced that an up-to-date objective assessment of the question of receipt of a fax by the addressee needed to take into account the technology underlying faxes. The high reliability of this technology nowadays was based amongst other things on established technical protocols, according to which modern fax machines operated. On the basis of various considerations the board reached the conclusion that the "OK" reference on the transmission sheet of a fax was to be regarded as proof of an error-free and complete transmission, through which the fax had entered into the area of responsibility of the representative. Once the fax had entered the area of responsibility of the addressee indicated by the reference "OK", then a transfer of risk took place so that the recipient bore the risks in his own sphere.

According to the German version of R. 78(2) EPC 1973 (jetzt R. 126 (2) EPC), the EPO must in a case of doubt, "im Zweifel", establish the date on which the letter was delivered to the addressee. In **T 247/98** the board decided that, when establishing the meaning of the term "im Zweifel" in the German version of R. 78(2) EPC 1973, account should be taken of the French and English versions, which assumed that there was a dispute ("en cas de contestation", "in the event of any dispute"). From the general principles concerning the burden of presentation which fell on the parties, it followed that a party seeking the application of a legal provision favourable to its interests had to set out the facts justifying such application, even if it did not ultimately bear the burden of proof for those facts. Although, in the event of a dispute within the meaning of R. 78(2) EPC 1973, the burden of proof for the date of delivery fell on the EPO, this could not be taken to mean that a party wishing to rely on the late delivery of a letter from the EPO had no obligation to contribute to the clarification of circumstances within its own sphere of activity but could sit back, as it were, and wait to see whether the EPO succeeded in ascertaining when the letter had been delivered to the party. A dispute ("Zweifel" in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting.

Having regard to the above, in the case in point the mere absence from the file of the advice of delivery and of the receipt from the appellants' then representative did not constitute a sufficient basis for a dispute ("Zweifel" or "contestatation") under R. 78(2) EPC 1973 over whether the decision had been delivered to the appellants' then representative within ten days of despatch.

5.2. Shifting of the burden of proof

Each party bears the burden of proof for the facts it alleges. If one party furnishes convincing proof of the fact it alleges, the burden of proof for the other party's contrary assertion shifts to the latter (**T 270/90**, OJ 1993, 725). In **T 109/91** the board held that the burden of proof might shift constantly as a function of the weight of the evidence (confirmed e.g. in **T 525/90**, **T 239/92** and **T 838/92**).

By reference to the decision **T 750/94** (OJ 1998, 32) the board stated in **T 929/94** that, in **ex parte proceedings**, when the applicant challenges prima facie evidence concerning a fact, i.e. the nominal publication date of a document, and submits evidence to displace such prima facie evidence, the burden of proof shifts to the examining division to establish that the document was "made available to the public" within the meaning of Art. 54(2) EPC on that date.

In **opposition proceedings** the burden of proving that the objections raised under Art. 100 EPC 1973 have been substantiated lies with the opponent. Once the opposition division has decided to maintain the patent and the opponent has filed an appeal against the said decision, the burden is not automatically shifted to the proprietor of the patent to demonstrate on appeal that the reasons for maintaining the patent were justified (**T 667/94**). However, once the opposition division has decided to revoke the patent, the burden shifts to the proprietor of the patent, who has to demonstrate on appeal that the reasons for revoking the patent were not sound, i.e. that the opposition division's decision was wrong as to the merits (**T 585/92**, OJ 1996, 129; the abbreviated version published in the OJ does not include point 3.2 of the Reasons which is relevant here).

In **T 131/03** the board also took its cue from the principle that in inter partes proceedings the burden of proof rests primarily upon the opponent. However, it pointed out that, when the latter has established a strong presumption that unusual parameters as used to define the claimed subject-matter are inherently disclosed in the prior art, the patent proprietor cannot merely claim the benefit of the doubt. It is incumbent upon him to contribute in establishing to which extent such parameters, which he freely chose to use in the definition of his invention, actually distinguish the claimed subject-matter from the prior art.

The burden of proof generally lies with an opponent to establish insufficiency of disclosure. 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 bears the burden of proof in establishing

the contrary assertion that common general knowledge would indeed enable the skilled person to carry out the invention (**T 63/06**).

In the following cases, the board decided **against** reversing the burden of proof:

In **T 499/00** the allegations made by the respondents and in the contested decision had never been proven. The board felt that the burden of proof could not be reversed to rest with the appellant (patentee) in the prevailing circumstances, where – as opposed to the situation in **T 585/92** – the patent had been revoked by the opposition division not on the strength of a real failure to disclose the information needed to reproduce the claimed subject-matter, but for reasons that the board elsewhere deemed erroneous. In the case in point, the burden of proof could not be shifted to the patentee because revocation could not, in the board's view, be ordered solely in the light of the arguments and factors put forward by the opponents (see also **T 954/93**). The same principle applied to the appellants, but it could not be invoked against them because their arguments and assertions, liable to be confuted in that respect, had nothing to do with the reasons for the decision in the case in point.

In **T 954/93**, too, it was not accepted that the burden of proof had been shifted. In this case, the appellant (opponent) had put forward objections to the patent on the basis of lack of novelty, which would have had to be demonstrated by means of experiments. He had not, however, carried out any tests on the ground that they would have been very expensive. The board considered the allegation unproven and refused to reverse the burden of proof. The fact that experiments would have been very expensive did not shift the burden of proof onto the patent proprietor.

In **T 743/89** it had been proved that a leaflet disclosing the invention had been printed seven months before the priority date, but it was uncertain when the leaflet had been distributed. The board took the view that, although the date of distribution could no longer be ascertained, it was reasonable in any event to assume that distribution had occurred within the seven-month period. The respondents contended that this was not the case, but the board considered this assertion to be so lacking in plausibility that it placed the onus of proof on the respondents.

In **T 453/04** the opposition was rejected, i.e. the grounds alleged pursuant to Art. 100 EPC 1973 were found not to be substantiated. The board referred to the previous case law in **T 667/94** according to which, in such cases, the burden remains with the appellant (opponent) to show that the decision of the opposition division was incorrect. The burden is not automatically shifted to the proprietor to show on appeal that the reasons for maintaining the patent were justified. The board could not share the appellant's view with reference to **T 109/91** that, in the case at issue, the principle regarding the burden of proof should be reversed. In its judgment, the case at issue was significantly different. The provision of a single piece of evidence advanced by the opponent did not correspond to the highly detailed investigation carried out by the opponents in **T 109/91**, even if one were to disregard the other deficiencies in the evidence provided.

In **T 1210/05** the patent proprietor appealed against the decision of the opposition division, which had held that the claimed subject-matter was made available to the public before the priority date of the patent in suit by the display of a poster identical to document (1) at an Edinburgh congress. The board had to decide on whom the burden of proof lay in the appeal proceedings regarding the public availability of a poster identical to document (1) at the Edinburgh Congress. The respondent (opponent) contended that since the opposition division, on the basis of a correct evaluation of the evidence, had decided to revoke the patent due to prior disclosure, the burden of proof lay with the patent proprietor to demonstrate that the reasons given by the opposition division for revoking the patent were not correct. In other words, the appellant had to prove the negative, i.e. that a poster identical to document (1) was not displayed at the Edinburgh congress. The board, however, stated that before the opposition division it is the opponent who bears the burden of proof of demonstrating that the patent does not fulfil the requirements of the EPC. Appeal proceedings do not result in a shift in the burden of proof in the way suggested by the respondent - that is, towards a requirement that the appellant prove a negative. It is clear that in the case where the opposition division has revoked a patent, the appellant must argue before the board why this decision was wrong. In the case in point the appellant had so argued.

Questions relating to the shifting of the burden of proof can also arise in connection with **formal requirements**:

According to **T 128/87** (OJ 1989, 406), a party presenting a cheque to the EPO bears the burden of proof for its receipt by the EPO. However, if the party furnishes sufficient proof that a certain document was filed, such evidence shifts the burden to the EPO to provide a greater weight of evidence to the contrary (**T 770/91** and **J 20/85**, OJ 1987, 102).

I. Representation

As recalled in **J 1/04** for instance, there is no obligation for an applicant having a principal place of business within an EPC contracting state to be represented in proceedings established by the Convention. If, however, the applicant wishes to be represented, he must authorise either an employee or a professional representative or legal practitioner.

The following section looks at problems addressed by the boards arising in cases where the parties are represented in proceedings, either by choice (see previous paragraph) or by obligation (because they have no residence or principal place of business in a contracting state).

Art. 133 EPC contains the general principles governing representation with respect to proceedings under the EPC. It remains unchanged with the entry into force of the EPC 2000 (13 December 2007), save for minor editorial streamlining and changes aimed at increasing the consistency of the text of the EPC as a whole. Art. 134 EPC on representation before the EPO is likewise substantively unchanged but features some editorial amendments, in particular to take account of the deletion of Art. 163 EPC 1973, now largely superseded. The substance of the "grandfather clause" of Art. 163 EPC

1973 has in effect been integrated in Art. 134(3) EPC in simplified form as a permanent feature of the EPC designed to deal with the situation of national representatives of states acceding to the EPC in the future.

The revised Art. 133 EPC is applicable to European patents already **granted** at the time of EPC 2000 entry into force; European patent applications **pending** at the time of EPC 2000 entry into force; European patent applications **filed on or after** the time of EPC 2000 entry into force. The revised Art. 134 EPC is applicable as from the entry into force of the EPC 2000.

1. Professional representatives

1.1. List of professional representatives (Article 134(1) EPC)

Art. 134(1) EPC stipulates that professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO. The requirements for such entry are laid down in Art. 134(2) EPC.

The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters (**D 14/93**, OJ 1997, 561).

In **J 1/78** (OJ 1979, 285) the appellant was entered on the list of professional representatives before the EPO under the letter "V" as "von F., A.". The object of his appeal was to obtain a ruling which would enable him to be entered under the letter "F" as, for example, in the telephone directory. The decision found that the entry was made in accordance with the principles laid down by the President of the EPO whereby the full surname must be entered in alphabetical order. Under German law, former titles of nobility ("von") form part of the surname. The board noted that the purpose of entry on the list was to confer upon the person whose name was entered the right to appear in the European patent grant procedure. A distinction had to be made between entry for the purposes of conferring a right and publication of the list, which latter was not prescribed in the EPC 1973. The EPO issues a directory from time to time for the purposes of meeting public demand for information. In this directory, the person entered on the list could be allowed an additional entry under another letter should he so desire.

1.2. Duty of persons without residence nor place of business within a contracting state to be represented by a professional representative

According to Art. 133(1) EPC, no person shall be compelled to be represented by a professional representative in proceedings established by the EPC. However, Art. 133(2) EPC stipulates that natural or legal persons not having either a contracting state residence or their principal place of business within the territory of one of the contracting states must be represented by a professional representative and act through him in all proceedings established by the Convention (**T 1157/01** reviews the applicable law), other than in filing the European patent application (see **T 451/89** and **T 883/90**). The Implementing Regulations may permit other exceptions.

In **T 213/89** the Japanese inventor replied directly to the EPO with a set of revised application documents, and accompanied by a letter to his representative indicating that the revised documents had also been sent to the representative. The board noted that no confirmation by the representative was received that any of the submissions directly received from the inventor should be regarded as an official reply to an EPO action. Since persons not having a residence or their principal place of business within the territory of one of the contracting states must act through their representative in the proceedings, the said submissions received direct could not be taken into account.

Likewise in **T 717/04**, the representative lodged the appeal for the applicant on 11 March 2004 and paid the prescribed appeal fee simultaneously. The statement of grounds of appeal was received on 18 May 2004. On 27 February 2007, a letter from the appealing applicant, a natural person with an address not within the territory of one of the contracting states, was faxed to the EPO with arguments and a new set of claims to be taken into account. According to Art. 133(2) EPC 1973, since the appealing applicant's address was not within the territory of one of the contracting states, the board concluded that filing claims and arguments such as those in the appealing applicant's letter of 27 February 2007 would have required professional representation. As these submissions were neither made nor endorsed by the representative, the board could not take them into account.

1.3. Professional representatives during the transitional period

One of the conditions for including a professional representative on the EPO list is that he has passed the European qualifying examination (EQE). During a transitional period after the EPC 1973 first entered into force, this requirement could be waived under the conditions laid down in Art. 163 EPC 1973 (see **J 19/89**, OJ 1991, 425; **J 10/81**). For all states acceding to the EPC 1973 at its inception, this period ended on 7.10.1981 (decision of the Administrative Council dated 6.7.1978, OJ 1978, 327). Art. 163 EPC 1973 was one of the transitional provisions, now superseded, and has therefore been deleted in the new EPC 2000.

However, after the above date, under Art. 163(6) EPC 1973, a person with his place of business or employment in a state newly acceding to the EPC 1973 may, during a period of one year as from that state's accession, be added to the list under the conditions laid down in Art. 163(1) to (5) EPC 1973, i.e. without having to pass the EQE. Art. 163(6) EPC 1973 retains all its significance as a grandfather clause and is therefore preserved in the EPC 2000 to deal with the situation of national representatives of states acceding to the EPC in the future. The substance of the **grandfather clause** of Art. 163 EPC 1973 has therefore been **integrated** in **Art. 134(3) EPC 2000** in simplified form, as a permanent provision of the EPC.

The reunification of Germany posed its own problems, in **J 18/92**, **J 30/92**, **J 31/92**, **J 32/92** and **J 33/92**, regarding the admission of professional representatives. The appellants argued that the provisions of Art. 163(6) EPC 1973 should be applied to patent attorneys, even where they had qualified in West Germany and not the former GDR. In the board's view, Art. 163(6) EPC 1973 could only be applied by analogy to

those finding themselves in a similar situation to the patent agents of a country acceding to the EPC. This requirement was fulfilled only by patent agents from the former GDR and not by their colleagues who had already been admitted in the West. The board held that it would be strange if those who were admitted as patent agents in a contracting state were able to become authorised representatives without having to pass the examination merely by way of analogy with people working in a country which had just become a member. The appeals were accordingly dismissed.

1.4. Procedural steps performed by a person other than the professional representative

In **J 28/86** (OJ 1988, 85) the Legal Board of Appeal held that a request for examination filed by a person who was not entitled to act as a representative in accordance with Art. 134 EPC 1973 was invalid. The board noted that the situation did not change because the representative had later been entered on the list of professional representatives. In this capacity he had neither approved nor resubmitted the invalid request he had made earlier.

In decision **T 665/89** the board addressed the question of the admissibility of an opposition by an opponent whose residence was not in a contracting state, where the notice of opposition was signed by a person who was neither a professional representative (Art. 134(1) or Art. 134(7) EPC 1973) nor an employee of the opponent (Art. 133(3) EPC 1973). The board of appeal concluded that the actions of the unauthorised person ought to be judged as if the signature were missing, and thus assumed that the **deficiency** was remediable. The opponent supplied the missing correct signature at the EPO's invitation within the time limit laid down. The document thus retained the original date of receipt in accordance with R. 36(3), third sentence, EPC 1973.

In **T 803/03** the board examined the relevant EPO case law (**J 28/86** and **T 665/89**) and its implications for the case at issue, which concerned an abandonment order signed by a non-entitled person.

In **J 32/86** the board held that the mere appointment of a professional representative to meet the requirement of Art. 133(2) EPC 1973 (the appellant had his residence in the USA) did not automatically have the legal effect of validating acts previously performed by an applicant himself. The EPO was however obliged to give the representative a fair chance to remedy any deficiency of this kind that might have occurred before his appointment and which could still lawfully be remedied by him.

2. Legal practitioners entitled to act as professional representative

2.1. General issues

According to Art. 134(1) EPC, professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on the above list. However, Art. 134(8) EPC

(former Art. 134(7) EPC 1973) provides that professional representation in such proceedings may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in one of the contracting states and having his place of business within such state, to the extent that he is entitled, within the said state, to act as a professional representative in patent matters. The arrangements for legal practitioners set out in Art. 134(8) EPC therefore constituted an exception.

In **J 19/89** (OJ 1991, 425) it was observed that despite all the differences in the designations and career backgrounds of the persons included in the ranks of legal practitioners, the profession had developed on an essentially equal footing in the contracting states as a result of Europe's common legal history and shared legal culture. The board noted that the last clause of Art. 134(7), first sentence, EPC 1973 was necessary because under national law even an actual legal practitioner might be precluded to some degree from acting as a professional representative in patent matters. That clause prevented a "Rechtsanwalt", "legal practitioner" or "avocat" from having more extensive powers of representation before the EPO than he was entitled to before his national patent office. Art. 134(7) EPC 1973 was therefore a special rule limited in scope to the corpus of legal practitioners, which existed under various designations in all the contracting states. Members of the profession of Rechtsanwalt and comparable professions in the contracting states were entitled under Art. 134(7) EPC 1973 to act as professional representatives before the EPO, not by virtue of their status as individual Rechtsanwälte but by virtue of the institution of the profession of Rechtsanwalt as such.

In **J 18/99** the main issue was whether or not the appellant, a legal practitioner (abogado) qualified in Spain and having his place of business in Spain, was entitled under Art. 134(7) EPC 1973 to undertake professional representation of third parties in proceedings before the EPO. The board concluded that for the application of Art. 134(7) EPC 1973 all that was significant was that a legal practitioner qualified in a contracting state was - as such - entitled, within that state, to act as a representative in patent matters. The Convention did not distinguish for this purpose between entitlement to act as a "simple" representative or as a "professional" representative of clients (reference being made to the "travaux préparatoires"). Following the examination of national provisions and conclusions drawn by the OHIM (Communication No. 2/96 of its President of 22 March 1996, point 1), the board concluded that under the current Spanish law, any legal practitioner qualified in Spain and having his place of business in Spain was entitled to represent clients in patent matters before the Spanish Patent and Trademark Office if he presented an authorisation from the party.

2.2. Register of legal practitioners

The register of legal practitioners must be clearly distinguished from the list of professional representatives established in accordance with Art. 134(1) to (4) EPC.

Whereas, according to Art. 134(4) EPC 1973, the entry of a person's name in the list of professional representatives entitles them to act in **all proceedings** established by the EPC 1973, the EPC 1973 does not contain any corresponding provision for legal practitioners. Their competence to undertake representation before the EPO is not

general, but depends directly on their complying with the provisions of Art. 134(7) EPC 1973 (**J 27/95**).

The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters; it would be jeopardised if legal practitioners without such qualifications were included on the list. Accordingly, the conditions for entry on the list of professional representatives under Art. 134(2) EPC 1973 also apply to legal practitioners (**D 14/93**, OJ 1997, 561).

According to the practice of the EPO, legal practitioners who indicate their intention to undertake representation in proceedings before the EPO and present an authorisation are entered in a register of legal practitioners, provided that they comply with the requirements of Art. 134(8) EPC. The Legal Division is responsible for checking these requirements and for the registration of names in, or deletion from, the register of legal practitioners (see also **J 27/95**).

In **J 18/99**, a further issue concerned the appellant's registration as a legal practitioner under Art. 134(7) EPC 1973. The board noted that the appellant, a legal practitioner ("abogado") in Spain, had requested registration as a legal practitioner entitled to act in proceedings established by the EPC in accordance with Art. 134(7) EPC 1973 without filing a signed authorisation, whereas according to the practice of the Legal Division legal practitioners were registered only if they had filed a signed authorisation from a party. The board therefore remitted the case to the Legal Division with the order to register the appellant, provided that he filed the signed authorisation.

2.3. Qualifying conditions according to Article 134(8) EPC

In **J 19/89** (OJ 1991, 425) the Legal Board of Appeal considered whether a patent attorney under national law should, in view of his legal qualifications and entitlement to act as a professional representative in national patent matters, be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC 1973 and hence be authorised to act before the EPO. The board decided that irrespective of his specialist qualifications and powers of representation in national patent matters, a **patent attorney** under national law could not be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC 1973, and therefore was not entitled to act as a professional representative before the EPO (see also **D 14/93**, OJ 1997, 561).

In **T 643/01** the appellant (patent proprietor) contended in particular that the opponent's reply of 28 January 2002 was inadmissible on the ground that it had been signed by Mr R., who was a legal practitioner and member of the Paris Bar but who was allegedly unable to show that he possessed an authorisation conforming to the requirements of R. 101(1) EPC 1973. The appellant requested that, if the signatory concerned was relying on his official status as a professional representative before the EPO, the board should find that French law prohibited such a plurality of offices, since the exercise of the profession of barrister could not properly be combined simultaneously with that of industrial property attorney. In the appellant's view, these provisions should be transposed into the law of the EPC. The board held, in the case at issue, that the

signatory of the impugned pleadings of 28 January 2002 was entitled to act before the EPO and held the appropriate authorisation for that purpose. Mr R. and Mr D., legal practitioners and members of a partnership, were indeed members of the Paris Bar, and the names of both appeared on the list of professional representatives before the EPO. They were therefore both entitled to act in one capacity or the other before the EPO under Art. 134(1) and (7) EPC 1973. The board held that a decision on the legality, in France, of simultaneously exercising the profession of barrister and acting as a professional representative before the EPO fell solely within the jurisdiction of French professional and judicial bodies.

In **J 27/95**, the Legal Board of Appeal first made it clear that the competence of legal practitioners to undertake representation before the EPO depended directly on their complying with the provisions of Art. 134(7) EPC 1973. Thus, each time a legal practitioner made a request to act as a professional representative in proceedings before the EPO, the Legal Division had the right to examine whether he or she satisfied the conditions under Art. 134(7) EPC 1973. If such a request was refused, it could be refiled and reconsidered on the basis of new facts at any time. In its decision the board pointed out that according to Art. 134(7) EPC 1973 a legal practitioner qualified in a contracting state had to have "his place of business in such State". The board noted that in all three languages of the EPC 1973 the expression "his place of business" (in contrast to "a place of business") was used. The board stated that this formulation made it clear that the place of business within the meaning of Art. 134(7) EPC 1973 was the place (if any) at which a person practised his or her profession as legal practitioner.

3. Appointment of a common representative (Rule 151 EPC)

In **J 35/92** the first-named of two individual joint applicants had transferred his rights in the application to a company, which had appointed another representative who had then purportedly withdrawn the application. The second applicant did not agree with the withdrawal. The department of first instance held that the company was entitled unilaterally to withdraw the application by virtue of R. 100(1) EPC 1973, according to which the first-named applicant could be regarded as the representative of both, but the board of appeal disagreed. R. 100 EPC 1973 applied only where no joint professional representative had been appointed, whereas in the case in question the original applicants had appointed a representative, who continued to act for the second applicant. The board therefore concluded that the purported withdrawal of the application by the first-named applicant was invalid. The parties were given two months to appoint a joint professional representative, failing which one would be appointed by the EPO.

In **J 10/96** the Legal Board of Appeal ruled that where several applicants were represented jointly by a professional representative, who during the course of proceedings ceased to represent his clients, the correct procedure to be followed was that contained in R. 100(2), second sentence, EPC 1973, according to which the applicants were to be requested by the EPO to appoint a common representative within two months. If this request was not complied with, the EPO was empowered to appoint the common representative.

In **G 3/99** (OJ 2002, 347) the Enlarged Board of Appeal dealt with the question of the admissibility of joint oppositions and joint appeals. The decision makes it clear that an opposition filed in common, apart from the fact that it is filed by more than one person, is as much a single opposition as an opposition filed by only one person. Consequently, the common opponents are obliged to act in common through their duly determined common representative. In an opposition filed in common, there must in all cases be a common representative (Art. 133(4) and R. 100 EPC 1973), and only that common representative is entitled to act in the opposition proceedings on behalf of all the common opponents taken as a whole.

The decision further notes that an individual common opponent not being the common representative, or a subgroup of the group who filed the opposition in common, but without their common representative, is not allowed to act or intervene on his own or on behalf of one or more or all of the other individuals. Thus, only the common representative is entitled to sign the filed documents (R. 100 and R. 36(3) EPC 1973), the signature of other individuals not being required. At any stage of the procedure, be it the opposition or the appeal procedure, it may also occur that the joint member who is the common representative intends to withdraw from being a joint member, i.e. to withdraw from the proceedings. In such circumstances, he must notify his decision to the EPO with the procedural consequence that, for the determination of a new common representative, the provisions of R. 100(1) EPC 1973 have to be applied for the opposition procedure by virtue of the last sentence of that rule and, for the subsequent appeal procedure, by virtue of R. 66(1) EPC 1973.

It may also occur that the common representative ceases to act in the procedure without the EPO being informed thereof. In both cases, the other joint members must take the appropriate action to continue the procedure in due time and to inform the EPO of the new common representative, if appointed. However, there is no practical need to acknowledge the validity of procedural acts of a joint member who is not the common representative. Since a procedural act performed by a non-entitled person is treated by the EPO in the same way as a missing signature (see **T 665/89**), each joint member or any other person acting on his behalf can perform such an act to avoid missing a time limit, provided the deficiency is remedied within a further time limit set by the board in the communication under R. 36(3) EPC 1973 notified to the common representative and sent for information to the non-entitled person who performed the act. The deficiency can be remedied if the procedural act is signed by the common representative. If, for whatever reason, this person ceases to be a joint member, the signature must be provided by a new common representative appointed pursuant to R. 100 EPC 1973.

G 3/99 was applied in **T 1154/06** in connection with the necessity of appointing a professional representative if the first-named of multiple patent proprietors was not resident in a contracting state.

The issue of the validity of an appeal filed by a person who is not the common representative named under R. 151 EPC (R. 100 EPC 1973) in the notice of opposition is dealt with in the Chapter "Appeal procedure".

4. Authorisations for appointment of a representative

At various points in the following sections there are references to the issue of whether an authorisation actually exists, a problem in a number of cases.

4.1. Filing of the authorisation

R. 101 EPC 1973 redrafted becomes with EPC 2000 **R. 152 EPC**. Especially R. 152 (6) EPC reads, "If a **required** authorisation is not filed in due time, any procedural steps taken by the representative, other than the filing of a European patent application, shall **be deemed not to have been taken**, without prejudice to any other legal consequences provided for **by this** Convention." See also the decision of the President of the EPO dated 12 July 2007 on the filing of authorisations (OJ SE 3/2007, 128).

In **J 12/88** it turned out that the former representative of the appellant had acted before the EPO on behalf of the appellant without being instructed to do so and using a forged authorisation. The board considered all these proceedings to be null and void. There had never been a valid European patent application before the EPO. All fees paid to the EPO on behalf of the appellant never had been due and had to be reimbursed.

In **T 850/96** the appellant had alleged that the opposition was not admissible because the signatories of the notice of opposition did not file an authorisation. According to him an employee must declare with the notice of opposition that he acts as a professional representative. Otherwise he must file an authorisation. In the case under consideration both signatories of the notice of opposition were professional representatives. The board held that Art. 1(1) of the decision of the President of the EPO of 19 July 1991 (OJ 1991, 489) stipulates that a professional representative whose name appears on the list maintained by the EPO **and who identifies himself as such** shall be required to file a signed authorisation only in the circumstances set out in Art. 1(2) and (3) of this decision of the President (now decision of 2007, OJ SE 3/2007, 128). In the case at issue, the deficiency had not been the lack of a signed authorisation, but the failure of the signatories of the notice of opposition to identify themselves as professional representatives.

In **T 425/05**, the respondent/patent proprietor requested the board at the start of the procedure to declare the appeal inadmissible, on the one hand because it had been filed at a date when the original opponent (company I) had been dissolved and had therefore ceased to have legal existence, and on the other because the mistake in the notice of appeal could not be a mere clerical error on the part of the professional representative which could easily be corrected, since the representative manifestly could not act on behalf of company F, which had not yet authorised him to do so. The board began by establishing that the representative's authorisation to act on behalf of company I had never been contested or rescinded. It was equally evident that the original opponent, company I, no longer had legal existence, as it had been dissolved and its assets had passed into the hands of company F, its associate and sole shareholder. The board concluded that company F had succeeded company I as opponent, and therefore also as the client of the representative. Thus the appeal filed by the representative, whose

authorisation, confirmed in the meantime, had never been rescinded, had been implicitly, but necessarily, filed on behalf of his actual client, company F; the identification of company I as the opponent/appellant in the notice of appeal was due to a clerical error which had since been corrected.

In **T 534/07** it was decided that the validity of procedural acts undertaken by the representative for his client was not affected by the existence of a conflict of interest.

See also chapter VII.E.7.4.1 (entitlement to appeal), and in particular **T 1324/06** where the very existence of the authorisation was challenged.

4.2. General authorisations

This subsection deals with the extent of the powers conferred.

In **J 11/93** the applicant formally applied under R. 69(2) EPC 1973 for a decision on the finding that his application was deemed to be withdrawn. He submitted in his statement of grounds of appeal that the official communication under R. 85a(1) EPC 1973 (deleted in EPC 2000) should have been sent to the authorised European representative since he had been duly empowered to act on behalf of the applicant by a general authorisation filed with the EPO in respect of another European patent application. Instead of this the communication was sent directly to the applicant, a US company.

The board observed that the usual form recommended for general powers had not been used and nothing in the document filed with the co-pending application allowed the Receiving Section to infer that the applicant intended the said document to be regarded as a general power rather than a specific one. The board confirmed that the authorisation in suit had never been registered by the EPO as being a general one, and that even if it had been so registered it would then have been incumbent on the applicant to communicate the number allotted to the general authorisation so that the Receiving Section could take it into consideration before sending the communication pursuant to R. 85a(1) EPC 1973 to the applicant at its last known address, rather than to the representative. Under these circumstances the board considered that when the letter pursuant to R. 85a(1) EPC 1973 sent directly to the applicant was issued no European professional representative had yet been appointed by the applicant. Hence the provisions of R. 81 EPC 1973, according to which - if a representative (i.e. a European one) had been appointed - notifications were to be addressed to him, could not apply but consequently only those of R. 78(2) EPC 1973 (version as in force up to 31.12.1998) relating to notifications in respect of addressees not having either a residence or place of business in one of the contracting states and who had not appointed an authorised representative.

In **J 9/99** (OJ 2004, 309) the board decided that the Legal Division had authority to check the authorisation of a representative named in a general authorisation and to issue a formal decision to reject the registration of a general authorisation. A decision not to register a general authorisation can only be issued in respect of a request from a party to

the proceedings within the meaning of R. 101(2) EPC 1973, i.e. either an authorising or an authorised party.

In **J 17/98** the Legal Board of Appeal had to rule on whether communications concerning the deemed withdrawal of applications had been correctly notified to the applicants, who were residents of a non-EPC contracting state, even though general authorisations were held by the EPO on their behalf. The applicants argued that the communications relating to deemed withdrawal should in fact have been notified to the representatives appearing in the general authorisations on file with the EPO. The board held that the filing of a general authorisation to act on behalf of a specific applicant and the notification of the appointment of a representative in an individual application were two separate procedural acts. By definition, general authorisations did not refer to specific cases and did not allow the EPO to assume, without further information from the applicant, that a specific representative had been appointed in a particular case. From the Convention it was clear that the filing of a general authorisation did not imply the appointment of a professional representative in a specific case. In such clear cases directly following from the provisions of the Convention the principle of the protection of legitimate expectations did not require the EPO to issue comprehensive legal advice extending beyond the form in question, provided it was in itself clear and unambiguous.

In case **J 1/04**, the appeal was directed against the findings of the Receiving Section that a loss of rights occurred due to the non-payment of fees within the applicable time limit after notification of the R. 85a and b EPC 1973 (deleted in EPC 2000) communications to the appellant, and that the application was therefore deemed to be withdrawn as from 27 November 2001. The relevant question in this case was whether the notifications of the communications were correctly addressed to the appellant. In the appeal proceedings the appellant no longer contested that the registered letters had come into the hands of its employee, who had picked them up at a local post office. The appellant criticised the EPO's practice of sending communications directly to the applicant, even if the latter had appointed a national representative in the international phase, as discriminative and as disregarding the express wish of the applicant not to handle matters himself.

The board first noted that Art. 133 EPC 1973 makes it clear that there is no obligation for an applicant having a principal place of business within an EPC contracting state to be represented in proceedings established by the Convention. If, however, the applicant wishes to be represented, he must authorise either an employee or a professional representative or legal practitioner. Whatever possibility the applicant prefers, if he does not wish to handle matters himself and therefore wishes to be represented, he must appoint a representative who is entitled, in accordance with the provisions of Art. 134 EPC 1973, to undertake representation before the EPO. In the case at issue the applicant did not do this, although the EPO, in its letter of 6 September 2001, had expressly pointed out to the applicant that an authorisation for the international phase did not comprise an authorisation for the European phase and that disregard thereof could lead to a loss of rights. In response to the appellant's argument, the board said the requirement that only persons fulfilling the conditions for representation before the EPO under Art. 134 EPC 1973 are entitled to undertake representation before the EPO was

not of a discriminative nature. Furthermore, as long as the applicant did not appoint a representative who was entitled to represent him before the EPO, the general principle applied that procedural acts had to be performed by the EPO in relation to the registered applicant as being the party to the proceedings. Thus, notifications had to be addressed to the registered applicant and they had been correctly made if they were addressed to the applicant/appellant in the case at issue. The appeal was dismissed.

In **T 1378/05** the appeal had been validly filed by legal representative G. on the basis of a "mere" authorisation to act "in matters concerning European patent application 'Method for authorisation in file transfer systems'" in proceedings before the German Patent Office, the Federal Patent Court and the - German - Federal Supreme Court. Thus there was no authorisation for proceedings before the European Patent Office. For such cases, Article 2 of the President's decision of 19 July 1991 provided that the legal representative shall be requested to file an authorisation within a period to be specified by the European Patent Office. The appellant filed such an authorisation on 24 August 2007, i.e. within the two-month time limit set by the board in its letter of 27 June 2007 and therefore "in due time" within the meaning of R. 101(4) EPC 1973. The opponent argued that there was clear evidence to show that the authorisation filed subsequently by the patent proprietor was backdated and therefore could not have been signed on "18.12.1997". The filing of this substantively false document could not fulfil the requirement of filing a correct authorisation, so for this reason, too, the appeal had to be deemed not to have been filed. The board could not accept the opponent's argument. It also noted that it did not have to be decided whether the principle of the protection of legitimate expectations already made it imperative in this case to regard the appeal as validly filed by legal representative G., after he had been regarded as the patentee's representative throughout the proceedings so far as well as in the published patent specification. The opponent itself had only challenged this ten years later, after a file inspection at the appeal stage. The appeal was therefore to be deemed filed and was, moreover, admissible in other respects.

In **T 1865/07**, the board noted that, in the circumstances of the case, giving an incorrect general authorisation number was of no consequence.

4.3. Sub-authorisations

In **T 227/92** it was held that a sub-authorisation from a professional representative to a person who was not a professional representative within the meaning of Art. 134 EPC 1973 was invalid. The latter person's role was therefore limited to that of technical adviser to the professional representative.

In **T 382/03** the previous representative, Mr E. of UDL, filed a fax to announce that Mr U., who was not a member of that association, would appear for respondent 1 at the oral proceedings before the board. Mr E. did not notify the board that his association's authorisation was terminating. Hence, that was a situation where the President's decision required the new representative, Mr U., to prove that he was authorised to act on behalf of respondent 1. As Mr U. did not refer to a general authorisation from respondent 1, proof of an individual authorisation had to be provided to the board. In

principle, that could be done by filing a direct individual authorisation from opponent 1, or by filing a sub-authorisation from an authorised representative who was entitled to sub-authorise a third representative. In view of the sub-authorisation from UDL submitted by Mr U. at the oral proceedings, the only issue remaining was whether or not UDL was entitled to give such a sub-authorisation. As Mr G. had filed notice of opposition 1 without filing an authorisation, there was no evidence on file that Mr G. had obtained the power to give sub-authorisations. In the board's view, the issue of whether or not a board considers a representative to be authorised by a party was a matter of proof including a free evaluation of the evidence and overall circumstances in an individual case. To define an appropriate standard of proof with respect to a representative's authorisation, the board took account of the purpose for requiring an authorisation.

For an example of a professional representative entitled by a chain of sub-authorisations to make submissions on behalf a party, see **T 1081/06**.

4.4. Authorisation of an association of representatives

In **J 16/96** (OJ 1998, 347) the EPO Legal Division had informed a company X that its patents department could not be registered as an association of representatives. Such an association meant one consisting solely of professional representatives in private practice. This was clear from the "Communication on matters concerning representation before the EPO" (OJ 1979, 92). Since the members of a company's patent department were not in private practice, they could not be registered as an association.

The board concluded that there was no basis in the Convention for the EPO's practice of restricting R. 101(9) EPC 1973 (now R. 152(11) EPC) to professional representatives "in private practice". An association within the meaning of that provision could therefore also be formed by professional representatives not in private practice. This interpretation of R. 101(9) EPC 1973 was consistent with the Convention's general aim, as stated in its preamble, of providing protection for inventions in the contracting states by a single procedure for the grant of patents. As noted when it was first introduced, R. 101(9) EPC 1973 was to be applicable in various countries, with differing national legal provisions and traditions, where representatives had often pooled their resources by forming some kind of association, such as a firm. This was why it had been reworded, and the original terms "partnership" and "Sozietät" replaced with more general ones: "association of representatives" and "Zusammenschluss von Vertretern". The French term "groupement de mandataires" had remained unchanged (see CI/GT VI/166d/77 of 20.4.1977). In view of this, there was no reason to interpret the term "association of representatives" in a way which limited its meaning. (**J 16/96** cited on this point in **T 656/98**).

5. Oral submissions by an accompanying person

5.1. General

In **J 11/94** (OJ 1995, 596), the Legal Board of Appeal referred the following question to the Enlarged Board of Appeal - might a board of appeal exercise discretion in deciding whether or not a person not entitled under Art. 134(1) and (7) EPC 1973 to represent

parties to proceedings before the EPO could make submissions during oral proceedings in addition to the pleadings by the professional representative. Further, if such discretion existed, which criteria did the board have to observe when exercising it.

The Enlarged Board of Appeal also had to decide on a question referred to in decision **T 803/93** (OJ 1996, 204). This question was whether, and if so in what circumstances, a person other than the professional representative (that is, an accompanying person) might make oral submissions on behalf of a party concerning either legal or technical issues, during oral proceedings under Art. 116 EPC 1973 before an opposition division or a board of appeal. This question went beyond the circumstances of **J 11/94**, which concerned ex parte proceedings involving only legal issues.

The Enlarged Board gave its answer in two decisions, **G 2/94** (OJ 1996, 401) referring to **J 11/94**, and **G 4/95** (OJ 1996, 412) occasioned by **T 803/93**.

In **G 4/95** (OJ 1996, 412) the Enlarged Board noted that the appointment of a professional representative by a party involved the authorisation and identification of the professionally qualified person who was responsible for the presentation to the EPO of all submissions made by the party. Such presentation of a party's case was the essential core of the function of a professional representative under Art. 133 EPC 1973. During oral proceedings, a professional representative was expected to present the entire case of the party that he or she represented.

The Enlarged Board considered separately the presentation of facts and evidence, on the one hand, and the presentation of arguments, on the other hand.

As to the presentation of facts or evidence by an accompanying person, the Enlarged Board held that such oral submissions during oral proceedings - in addition to the complete presentation of the party's case by the professional representative - are not excluded under the EPC. They may be allowed under the overall discretionary control which the EPC gives to the EPO with respect to the filing of facts and evidence.

As to the question whether an accompanying person may make oral submissions during oral proceedings by way of argument, the Enlarged Board pointed out that Art. 133 EPC 1973 made no distinction between written and oral proceedings in connection with the requirements for representation. Thus a professional representative was responsible for all written and oral submissions made on behalf of the party who had appointed him. However, in the context of the **written procedure** provided under the Convention for oppositions and opposition appeals an appointed professional representative could submit additional documents signed by a third person (for example a professor of law or science). Provided that they were submitted under the responsibility and control of the professional representative, they did not have to be excluded from consideration in the proceedings in which they were filed. Similarly, during **oral proceedings** under Art. 116 EPC 1973 in the context of opposition or opposition appeal proceedings, a person accompanying the professional representative of a party was not excluded from making oral submissions in relation to either legal or technical issues on behalf of that party to the proceedings under the control of the professional representative, and in

addition to the complete presentation of the party's case by the professional representative.

The Enlarged Board further held that such oral submissions could not be made as a matter of right, but only with the permission of and at the discretion of the EPO. The following **criteria** should be considered by the EPO when exercising its discretion:

(i) The professional representative should request permission for such oral submissions to be made. The request should state the name and qualifications of the accompanying person and should specify the subject-matter of the proposed oral submissions.

(ii) The request should be made sufficiently in advance of the oral proceedings so that all opposing parties are able properly to prepare themselves in relation to the proposed oral submissions.

(iii) A request made shortly before or at the oral proceedings should, in the absence of exceptional circumstances, be refused unless each opposing party has agreed to the making of the oral submissions requested.

(iv) The EPO should be satisfied that oral submissions by an accompanying person were made under the continuing responsibility and control of the professional representative.

In **G 2/94** (OJ 1996, 401) the Enlarged Board made it clear that there was no difference as a matter of principle between the admissibility of such oral submissions in *ex parte* proceedings and in *inter partes* (opposition) proceedings, and that this matter had been fully considered in the context of opposition proceedings in **G 4/95** (OJ 1996, 412). The Enlarged Board noted that it was important that the board should control the proceedings. The board should exercise its discretion in accordance with the circumstances of each individual case. The main criterion to be considered was that the board should be fully informed of all relevant matters before deciding the case. The board should be satisfied that the oral submissions were made by the accompanying person under the continuing responsibility and control of the professional representative.

In **T 334/94** the board emphasised that for a legal or technical expert to be allowed to make submissions at oral proceedings on behalf of a party and under the control of that party's representative, certain criteria relating to Art. 113(1) EPC 1973 had to be fulfilled. **G 4/95** had ruled that the party wanting such submissions to be made had to ask permission sufficiently in advance of the oral proceedings to give the other parties time to prepare. Only in exceptional circumstances should the EPO allow such a request if made just before the date of the hearing, unless all the other parties agreed. The board noted that the Enlarged Board had not defined what "sufficiently in advance" meant, or laid down a deadline for making such requests. In its view, the **deadline of one month** before the proceedings for filing submissions or new sets of claims was a minimum. On that basis, nominating an accompanying expert one week before the proceedings was not acceptable.

On the other hand, in **T 899/97** the appellant (opponent) requested that a technical expert be allowed to speak during the oral proceedings in order to explain the physical phenomena that occurred when a prior art separator was used. Pointing out that the relevant letter from the appellant had reached him only two weeks before the oral proceedings, and referring to **G 4/95** (OJ 1996, 412) and **T 334/94**, the respondent requested that this technical expert be refused permission to speak.

The board considered the particular circumstances of the case, i.e.:

- that no time limit for making further submissions had been set by the board with the summons to oral proceedings
- that the respondent (patent proprietor), although he had had two weeks' notice of the technical expert's appearance at the oral proceedings, had not taken any immediate action in this respect, but merely objected to his being heard at the beginning of the oral proceedings
- that the respondent, when referring to the criteria (ii) and (iii) mentioned in headnote 2(b) of decision **G 4/95**, had not indicated any specific preparatory measure that had been rendered impossible or hindered by the relatively late presentation by this technical expert
- that this technical expert was one of the authors of the test report (R2) filed by the appellant with the statement of grounds, that the board had raised some questions on this specific technical issue in the annex to the summons to oral proceedings, and that these technical issues had already been discussed before the department of first instance.

With this in mind the board held that the request to hear the technical expert had been submitted sufficiently in advance of the oral proceedings by the appellant, and that the respondent had been able "to properly prepare" himself "in relation to the oral submissions" by this technical expert, including explanations concerning the physical phenomena occurring in prior art separators as tested in R2 (see **G 4/95**).

In **T 621/98**, during oral proceedings, the board was faced with the question of whether the patent proprietor, who was professionally represented, needed to announce in advance his intention to make submissions during the proceedings, pursuant to **G 4/95** (OJ 1996, 412). The board ruled that the patent proprietor was a party to the proceedings and as such was not to be treated as an accompanying person. As a party to the proceedings he had a right to take part in them.

In **T 1208/06** the inventor was not identical to the patent proprietor, so **T 621/98** did not apply. In the circumstances, and applying the criteria of **G 4/95**, the board held the opposition division to have acted correctly by categorising the inventor as an "accompanying person" and not as a party to the proceedings within the meaning of Art. 99(3) EPC and by rejecting the proprietor's request.

In **T 89/04** Mr D. was a vice president of the company OpenTV. Since the company ACTV, Inc. was recorded in the Register of European Patents as the patentee, OpenTV, which was a different legal person, was not a party to the proceedings in accordance with Art. 99(4) and 107, second sentence, EPC 1973. Decision **T 621/98**, to which the patentee/respondent referred, did not apply to the case at issue, since it dealt with a different situation, where the professional representative was accompanied by the patentee. Mr D. was considered to be a person accompanying the representative and, therefore, the criteria set out in decision **G 4/95** had to be met. A request which, as in this case, was made three days before oral proceedings, i.e. not sufficiently in advance, should, in the absence of exceptional circumstances, be permitted only if the opposing party agreed. Since the board saw no exceptional circumstances, and the appellant/opponent objected that he could not prepare himself properly, the board did not allow Mr D. to make oral submissions on behalf of the respondent (patentee) at the oral proceedings.

In **T 475/01** the board, exercising its discretion under the Convention and taking account of the criteria established by the Enlarged Board of Appeal (see **G 4/95**, OJ 1996, 412), allowed oral submissions by the persons accompanying both parties at the oral proceedings. Unlike the respondent, the board took the view that neither the EPC nor the above Enlarged Board decision could be held to imply that a party that represented itself in proceedings was to be treated differently to a professional representative in respect of oral submissions by accompanying persons.

In **T 1212/02** the appellant did not consent to a colleague of the representative of the respondent (opponent) making submissions before the board during oral proceedings. While the representative herself was authorised to act as a professional representative within the meaning of Art. 134 EPC 1973, the same was not true of her colleague, even though he too worked in the patent department of the same firm, the respondent's holding company, and was familiar with the case in point. The appellant (patentee) observed that no provision had yet been made under Art. 133(3) EPC 1973 to allow the employees of one legal person to represent another legal person.

As the appellant had argued, it was true that no legal provision had been made for the representative of one company to be undertaken by an employee of another company connected with the former company. It was also true that it was a matter for the board's discretion to allow a person who was not the professional representative authorised for the case in point to make oral submissions on legal or technical issues before the board, provided the criteria established in **G 4/95** were met. To save time, the board in the case at issue decided on a pragmatic approach and allowed the professional representative's colleague to make submissions, but only after the representative had given an express assurance that she took full responsibility for such submissions.

The board in **T 302/02**, applying **G 4/95**, did not allow the expert to make submissions. In **T 1706/06**, quoting **G 4/95**, the board said that a request made shortly before the oral proceedings should, in the absence of exceptional circumstances, be refused unless each opposing party has agreed to the making of the oral submissions requested. In the case in point the patent proprietor did not agree. Moreover the board considered that the

filing of the request for the technical expert of the opponent to be heard was made "shortly" before the oral proceedings. No exceptional circumstances existed; the board refused the request for the technical expert to be heard. To cite a different example, in case **T 1207/06** the patent proprietor questioned the admissibility of the presentation of submissions at the oral proceedings by the person accompanying the representative of the opponent, objecting that the accompanying person tried to present the entire opponent's case, which, according to **G 4/95**, was not allowed. The board in **T 1207/06** did not agree with this objection and was satisfied that the four criteria in **G 4/95** had been met.

In **T 919/07**, where the requests in writing concerning oral submissions by accompanying persons (one being an employee of one of the parties not allowed to represent this party) did not indicate what such submissions could contribute to the evidence on the file, the board exercised its discretion by deciding that the accompanying persons should be heard in the event that the board wished to ask them questions.

In **T 520/07** the board did not share the respondent/patentee's view that the appellant could not be surprised by its request, the same accompanying person having already made submissions in oral proceedings before the opposition division. In all procedural matters, appeal proceedings were completely separate from first-instance ones, so requests made in the latter had no effect for the former.

For a classic application of the requirements set out in **G 4/95** to a party's contention that, since the accompanying person was preparing for the European qualifying examination, he ought to be given a training opportunity, see **T 378/08**.

See **R 3/08** for a petition for review based on the board's refusal to allow an employee of the petitioner to make submissions at oral proceedings.

5.2. Oral submissions by former members of the boards of appeal

In **J 11/94** (OJ 1995, 596) the authorised representative was accompanied during oral proceedings by a former chairman of the Legal Board of Appeal who had retired about a year and a half previously. The professional representative requested permission for the former board member to make submissions in addition to his own arguments. The case referred to the Enlarged Board therefore encompassed the question whether special criteria applied to the exercise of a board's discretion in relation to a request for the making of additional oral submissions by a former board of appeal member.

The Enlarged Board noted in **G 2/94** (OJ 1996, 401) that there was a potential conflict between what might be seen as a right of former board of appeal members to seek subsequent employment on the basis of their special knowledge by making oral submissions during proceedings before the EPO, and the need for proceedings before the EPO to be conducted free from any suspicion of partiality. The existence of such a potential conflict was well recognised in the context of national judicial systems where it was clear that persons accepting appointments as judges were subject to restrictions if they wished to work in private legal practice after having served as judges. The

existence of such restrictions reflected the generally recognised principle of law that parties to legal proceedings were entitled to a fair hearing before judges who could not reasonably be suspected of partiality. It concluded that the above potential conflict had to be resolved with a view to avoiding any suspicion of partiality during the conduct of proceedings before the EPO. The public interest in the proper conduct of proceedings before the EPO had to prevail over the personal interests of former board of appeal members who wished to make oral submissions on behalf of parties to the proceedings.

It was therefore necessary to place **restrictions** on the admissibility of such oral submissions, at least for a reasonable period of time following termination of a person's appointment as a member of a board of appeal. In the absence of specific legislation, the point in time following termination of his or her appointment after which a former member of the boards of appeal might make oral submissions in proceedings before the board of appeal was **a matter within the judicial discretion** of the boards of appeal. The Enlarged Board found that during either ex parte or inter partes proceedings, a board of appeal should refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, unless it was completely satisfied that **a sufficient period of time** had elapsed following termination of such former member's appointment to the boards of appeal, so that the board of appeal could not reasonably be suspected of partiality in deciding the case if it allowed such oral submissions to be made.

The board of appeal should normally refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, until at least **three years** have elapsed following termination of the former member's appointment to the boards of appeal. After three years have elapsed, permission should be granted except in very special circumstances. Before the expiry of three years, there would normally be too great a risk that the public would consider the making of such submissions in oral proceedings to give an unfair advantage to the party on whose behalf a former member appeared.

The recent case **T 585/06** dealt with the presence of a former member of the boards of appeal at the oral proceedings before the opposition division and acting as consultant of the patent proprietor (see Chapter VII.E.17.4.6, Reimbursement of Appeal Fee).

5.3. Oral submissions by qualified patent lawyers of non-EPC contracting states

Another question of law decided in **G 4/95** above was whether, having regard in particular to the provisions of Art. 133 and Art. 134 EPC 1973, a person who was not qualified in accordance with Art. 134 EPC 1973 but was a qualified patent lawyer in a country which was not an EPC contracting state might present some or all of a party's case as if he were qualified under Art. 134 EPC 1973. The Enlarged Board decided that no special criteria applied to the making of oral submissions by qualified patent lawyers of countries which were not contracting states to the EPC. The criteria set out above were equally applicable to such patent lawyers (see **T 774/05** with respect to US patent attorney).

6. Distinction between presentation of facts and evidence and presentation of arguments

In **G 4/95** the Enlarged Board noted that the distinction between the presentation of facts and evidence, on the one hand, and the presentation of arguments, on the other hand, was of basic importance under the EPC. It noted, as discussed in **T 843/91** (OJ 1994, 818), a practice developed in the boards of appeal "to allow contributions by experts under the control of the authorised representative when it considers it would be useful for the good understanding of the case", thus mirroring the practice within the opposition division. In decision **T 843/91** it was suggested that the legal basis for admitting such oral submissions by "experts" was Art. 117 EPC 1973. In this connection, the Enlarged Board did not accept that Art. 117 EPC 1973 provided a legal basis for hearing oral submissions by an accompanying person involving the presentation of facts and evidence, as was suggested in decision **T 843/91** for example. Art. 117 EPC 1973 and its implementing rules, R. 72 to R. 76 EPC 1973, were solely concerned with setting out the procedure relevant to the formal "taking of evidence". Such procedure necessarily involved as a precondition for its use the making of a decision to take evidence within the meaning of Art. 117 EPC 1973, and that decision had to set out all the matters prescribed in R. 72(1) EPC 1973, as the first stage in the procedure.

J. Decisions of EPO departments

1. Right to a decision

Pursuant to R. 112(1) EPC (former R. 69(1) EPC 1973), the EPO, if it notes that the loss of any rights results from the EPC 1973, must communicate this to the party concerned. If the party disagrees with the finding of the EPO it may apply for a decision on the matter by the EPO (R. 112(2) EPC, former R. 69(2) EPC 1973) or it may request further processing or reestablishment of rights, as the case may be (**J 14/94**, OJ 1995, 824).

The right to a decision after notification of loss of rights is a substantial procedural right which cannot be ignored by the EPO. A party who applies for a decision under R. 112(2) EPC is entitled to receive one. If the correctness of a notification of loss of rights under R. 112(1) EPC is challenged, the EPO has a duty to reply within a **reasonable period of time** having regard to the subject-matter of the communication (see **J 29/86**, OJ 1988, 84; **J 34/92**).

In **J 7/92** the board stated that although it would be preferable for the EPO to issue a communication under R. 69(1) EPC 1973 (now R. 112(1) EPC) quickly, it could not be blamed for having done so in the case at issue over seven months after expiry of the period of grace. The EPC 1973 did not provide that the EPO should note the loss of rights mentioned in R. 69(1) EPC 1973 within a certain period. Nor did it provide any period of time for the ensuing communication. The EPO could not be required to keep a permanent and close eye on every file so as always to act as quickly as possible in order to preserve all the applicant's rights. However, when the EPO had to handle incoming requests or documents containing clear deficiencies which were obviously easy to correct and could be expected to be remedied within the time limit to avoid a loss of

rights, then the question might arise whether - depending on the case - the principles of good faith governing the relations between the parties and the EPO did not demand that the EPO should not fail to draw attention to such deficiencies (on the principle of the protection of legitimate expectations see Chapter VI.A.).

In **J 43/92** the board noted that a decision pursuant to R. 69(2) EPC 1973 (now R. 112(2) EPC) could only validly be applied for in the circumstances defined in R. 69(1) EPC 1973 (now R. 112(1) EPC). Thus, it was a necessary condition for such an application that the EPO previously noted the loss of a right resulting from the EPC 1973 without any decision and communicated this to the party concerned. Otherwise, there was no basis for the EPO to give a decision pursuant to R. 69(2) EPC 1973. The board further noted that R. 69(1) EPC 1973 did not prescribe any particular form for the communications provided therein, distinguishing them from other communications or notifications under the Convention. Even if, according to the Legal Advice No. 16/85 (OJ 1985, 141) communications in which the EPO noted the loss of any right normally contained a reference to the time limit for an application for a decision on the matter under R. 69(2) EPC 1973, such reference did not appear to be necessarily decisive as to the true nature of the communication. Whether a document constituted a communication pursuant to R. 69(1) EPC 1973 should be derived from its substantive content and its context.

2. Composition of the competent departments of first instance

2.1. Examining division

In **T 714/92** the board could not find any indication in the part of the file open to public inspection that the primary examiner had already signed the impugned decision before the date on which he left the examining division. The board held that to take a decision on a date on which the examining division no longer existed in its stated composition, without the examining division ensuring that it be apparent from the part of the file open to public inspection that the member who left the examining division had agreed the text of the decision before leaving, had to be considered as a substantial procedural violation. Thus the impugned decision was set aside as void *ab initio* and without legal effect.

2.2. Opposition division

Art. 19(2) EPC stipulates that an opposition division must consist of three technical examiners, at least two of whom must not have taken part in the proceedings for grant of the patent to which the opposition relates.

In **T 390/86** (OJ 1989, 30) oral proceedings had taken place in the presence of three examiners appointed to form the opposition division. The chairman had announced its decision during the oral proceedings in the presence of the other two examiners. Although the decision had subsequently been duly reasoned in writing, it had been signed by three members other than those before whom the oral proceedings had taken place. The board considered whether the decision of the opposition division was valid having regard to the circumstances. It was clear from Art. 19 EPC 1973 that the power to

examine and decide an opposition pursuant to Art. 101 and Art. 102 EPC 1973 had at all times to be exercised personally by the examiners appointed to do so. The power of a department of the EPO such as an opposition division to issue a decision had not only to be exercised personally but also to be seen, both by the parties and by the public, to be exercised personally. Similarly, where a decision was issued in writing setting out reasons for an oral decision, the parties and the public should be able to see from the written decision that it had been taken by the examiners appointed to the particular opposition division responsible for that oral decision. It was, of course, possible that not all the appointed members were able to sign a written decision (for example through illness). However, in the board's view, if the decision of a particular division was to be legally valid, it had to have been written on behalf of and represent the views of the members who were appointed to that division to decide the issue or issues which were the subject of the decision, and it had to bear signatures which indicated this. As a result, the written reasons for a decision delivered during oral proceedings could only be signed by the members of the deciding body who took part in the oral proceedings. The board therefore held that if, in a case where a final substantive decision had been given orally by an opposition division during oral proceedings, the subsequent written decision giving the reasons for that oral substantive decision was signed by persons who did not constitute the opposition division during the oral proceedings, the decision was null and void.

In its decision **T 243/87** the board of appeal developed further the principles established in **T 390/86**. The board held that even though only one member of the opposition division had been replaced after the oral proceedings, there was no longer any guarantee that the reasoned decision signed subsequently accurately reflected the point of view of all three members who had taken part in the oral proceedings, or even of the majority of the opposition division. In the board's view, the exceptional situation in which one of the appointed members was incapacitated (for example through illness) was quite different. In such cases it was right to accept that, although the reasoned written decision should be signed only by the members of the division who actually took part in the oral proceedings, one of them could sign on behalf of the member unable to do so. It was of course advisable to check that the reasoned written decision represented the point of view of all the members who took part in the oral proceedings.

In **T 251/88** the composition of an opposition division was held to be contrary to Art. 19(2) EPC 1973, because two of the three members had taken part in the proceedings for grant of the patent to which the opposition related. The board of appeal ordered that the decision of the opposition division be set aside and the case be remitted for fresh examination by an opposition division with a different composition (see also **T 382/92**).

In **T 939/91** the chairman of the opposition division had participated as second examiner in the decision to grant the patent in suit, as was clear from EPO Form 2035.4. The board of appeal decided that the opposition division had therefore violated the provisions of Art. 19(2) EPC 1973 and that the decision delivered had to be annulled on the grounds that the department delivering it had not been competent to do so. The board

felt it fair to order reimbursement of the appeal fee, given that violation of the provisions of Art. 19(2) EPC 1973 had to be considered as a substantial procedural violation.

In **T 476/95** the chairman of the opposition division had, at an earlier stage of the grant proceedings, written and signed a negative communication which preceded the decision of the examining division to refuse the application. In the board's opinion, Art. 19(2), first and second sentence, EPC 1973 referred to the participation of members of the opposition division at every stage of the grant proceedings, not only to their involvement in the final decision. The primary examiner in the opposition proceedings had also been a signatory to the decision refusing the application after examination. A breach of Art. 19(2) EPC 1973 was considered to have occurred if both the primary examiner and the chairman of the opposition division had taken part in the grant proceedings.

In **T 960/94** the board held that to comply with R. 68(1), second sentence, EPC 1973 and R. 68(2) EPC 1973 (now R. 111 EPC) a written reasoned decision confirming the orally announced decision was required. Such a written reasoned decision had to be issued on behalf of the very same members of the opposition division who were present at the oral proceedings, as the task of giving a written reasoned decision was personal to those members of the opposition division present at the oral proceedings and could not be delegated to a differently composed opposition division, even if two of the members remain the same (following **T 390/86**, OJ 1989, 30). As no confirmatory written decision had been issued in the names of the members present at the oral proceedings, the decision given orally was void and had to be set aside.

In the case at issue in **T 838/02**, the composition of the opposition division had been contrary to Art. 19(2), second sentence, EPC 1973. The board noted that, in such a situation, previous decisions of the boards of appeal had set aside the contested decision immediately, as in **T 939/91**. In **T 251/88**, however, the board had asked the applicant (appellant) whether he had invoked the procedural violation before deciding on the remittal of the case. The present board noted that it preferred the latter approach. It observed that it might be in the legitimate interest of the parties in an individual case to proceed and to come to a final decision as quickly as possible. A remittal implied a substantial delay, even if the case was treated with priority by the department of first instance. The board therefore considered it appropriate to give the parties an opportunity to comment before deciding on the question of remittal. Since the appellant had requested remittal and the respondents had not objected, the conclusion was that remittal had to be ordered in the absence of any special reasons for doing otherwise (Art. 10 RPBA 1980).

In **T 900/02** a member of the opposition division took employment with the respondent's representative's firm after the oral proceedings; however, no offer to the parties of new oral proceedings was made. The board pointed out that the case law of the boards of appeal showed it to be well-established that a signed written decision issued after oral proceedings should be the decision of those members of the first instance who conducted the oral proceedings and none others. The case-law also showed that a change of composition of an opposition division between oral proceedings and the issue

of a written decision should be avoided and, if that was not possible, parties should be offered new oral proceedings in the event of a change (see **T 862/98**).

3. Suspected partiality

3.1. General principles

Art. 24(3) EPC stipulates that members of a board of appeal may be objected to by any party for one of the reasons mentioned in Art. 24(1) EPC, or if suspected of partiality.

In **G 5/91** (OJ 1992, 617), the Enlarged Board of Appeal commented on the suspected partiality of a member of an opposition division. In the case which had led to the referral, **T 261/88** (OJ 1992, 627), the primary examiner was a former employee of the opponent and had represented that company many times in examination and opposition proceedings before the EPO. The Enlarged Board observed that although the questions referred to it were directly related only to proceedings before an opposition division, the problems involved were of a general character and also had a bearing on the activities of the other EPO departments of first instance charged with the procedure, e.g. the examining divisions (see Art. 15 EPC 1973).

The Enlarged Board stated that it must be considered as a general principle of law that **nobody should decide** a case in respect of which a party may have good reasons to assume partiality. The basic requirement of impartiality therefore also applied to employees of the EPO departments of first instance engaged in decision-making activities affecting the rights of any party. Although the provisions of Art. 24 EPC 1973 on exclusion and objection only applied to members of the boards of appeal and the Enlarged Board of Appeal and not to employees of the EPO departments of first instance, including opposition divisions, this did not justify the conclusion that such employees were exempt from the requirement of impartiality. Furthermore, although Art. 24 EPC 1973 was only applicable to appeal proceedings, it seemed justified to apply the principles underlying the provisions of Art. 24(3), second and third sentences, EPC 1973 to an objection on the ground of suspected partiality before a department of first instance. Such an objection could thus be disregarded if it was not raised immediately **after** the party concerned became aware of the reason for the objection or if it was based on nationality. Finally, the Enlarged Board found that the question whether or not an objection to a member of an opposition division on the ground of suspected partiality was to be considered justified could only be decided in the light of the particular circumstances of each individual case. Such considerations involved factual questions of degree rather than points of law and were therefore not a matter for the Enlarged Board of Appeal to decide.

In interlocutory decision **G 1/05** dated 7 December 2006 (OJ 2007, 362) Ms X, a member of the Enlarged Board of Appeal informed the board that she ought not to be taking part in the referral, since one of the opponents in the case underlying the referral was represented by the law firm in which her husband and her son were partners. The Enlarged Board noted that Art. 24(2) EPC 1973 served to preserve the general principle of law that nobody should decide a case in respect of which a party may have good

reasons to assume partiality by obliging a board member to inform the board accordingly if he or she considers that he or she should not take part in a case for any such reason. This would avoid that the circumstances underlying a notice of withdrawal could come up later in the proceedings and cast a shadow on the decision making process or even the decision taken. Therefore, it held that if a member of a board of appeal in a notice of withdrawal under Art. 24(2) EPC 1973 gave a ground which could by its nature constitute a possible ground for an objection of partiality that ground should normally be respected by the decision on replacement of the board member concerned because it could be expected that the member submitting the notice knew best whether or not a possible suspicion of partiality could arise.

Furthermore, the appellant's representative had questioned the position of Mr Y as a member of the Enlarged Board of Appeal because it would appear that Mr Y, through membership of the board of appeal in a former case, had already taken a position in relation to matters now to be decided. In the Rules of Procedure of the Enlarged Board of Appeal (RPEBA) and the business distribution scheme of the Enlarged Board of Appeal provisions have been set up defining the extent to which board members having already dealt with an issue to be decided by the Enlarged Board of Appeal should be excluded from participation in a referral. The Enlarged Board of Appeal explained that to the extent that participation in a referral pending before the Enlarged Board of Appeal of a board member having already dealt with the matter as a member of a board of appeal was not excluded by the RPEBA and the business distribution scheme of the Enlarged Board of Appeal, an objection of partiality could not be based on that very same fact alone. As regards proceedings before the Enlarged Board of Appeal, the Enlarged Board of Appeal held that, unless there are specific circumstances throwing doubt on the board member's ability to approach the parties' submissions with an open mind on a later occasion, there cannot be any objectively justified, i.e. reasonable suspicion of partiality against a member of the Enlarged Board of Appeal within the meaning of Art. 24(3), first sentence, EPC 1973, for the reason that a position on the matter was adopted in a prior decision of a board of appeal in which the board member concerned had participated.

In **T 281/03** dated 18 March 2005 the board explained that, when assessing partiality, there were two elements which needed to be examined. One was the subjective element as an internal characteristic of the member himself, for example due to a personal interest or dislike of a party. Personal impartiality was to be presumed until there was proof to the contrary. On the other hand, the appearance of partiality involved external aspects and reflected, regardless of whether the member was actually biased or not, the confidence which the board inspired in the public. Since this aspect of partiality related to appearance it did not need to be proven in the same way as actual partiality, but the circumstances had to be judged to see whether they gave rise to an objectively justified fear of partiality (objective element).

3.2. Individual cases

3.2.1 Members of the examining and opposition divisions

In **T 433/93** (OJ 1997, 509) following a substantial procedural violation in connection with a decision issued by a department of first instance, the decision was set aside at the request of a party, and the case was remitted to the department of first instance for re-hearing. Following such remittal, the board found it necessary for the case to be examined and decided by a different composition of **opposition division** (that is, by a composition of three new members), in relation to the grounds of opposition raised and introduced into the proceedings. The board considered that if the case was to be heard further and re-decided by the same composition of opposition division, the members of the opposition division would have to attempt to put out of their minds the result of their previous decision before re-hearing and re-deciding the case.

The board held that the important point was not whether the file record showed any previous evidence of actual partiality by the members of the opposition division during the previous conduct of the case (see **T 261/88** of 16.2.1993), or whether the present members of the opposition division would in fact be unprejudiced or impartial if they re-heard the case, but **whether a party would have reasonable ground** to suspect that they would not receive a fair hearing if the case was re-heard before the same composition of opposition division (whether because of possible prejudice as to how the case should be decided, or because of possible partiality, or otherwise).

In **T 261/88** of 16.2.1993 the board held that a disqualifying partiality presumed a preconceived attitude on the part of a deciding person (in this case the first examiner) towards a party (in this case the patentee) of the case. The fact that the views held on the issues of the case by the examiner differed from those held by the party was itself not disqualifying. The board noted that disqualifying partiality was limited to situations where the opinion of a person responsible for taking decisions affecting the right of parties (e.g. a judge) was swayed by his attitude towards a party. The board examined whether the reasoning underlying the decision under appeal showed such major deficiencies that there was reason to believe that the primary examiner was, either deliberately or inadvertently, trying to "bend" the facts of the case, and that this was done because of a preconceived attitude towards one of the parties. The board could not find anything basically or conspicuously wrong with the analysis of the technical questions.

In **T 143/91** the board held that a member of an opposition division was biased if it could be shown that he had a personal **interest** within the meaning of Art. 24(1) EPC 1973. The mere fact that the member was previously employed by a company dependent on a party to the opposition proceedings was not, however, sufficient proof of such an interest.

In **T 951/91** (OJ 1995, 202) objections under Art. 24 and Art. 19(2) EPC 1973 were raised by the appellant in the statement of grounds of appeal suggesting that the opposition division had been biased in its attitude to the parties. In reaching its decision on this point, the board observed that nothing in the minutes of the oral proceedings,

which the appellant had not criticised, led to the conclusion that the arguments had not been duly considered by the opposition division or that the latter was suspected of bias during those proceedings. The board examined the reasons set out in the appealed decision and observed that the decision itself did not reveal any bias.

In **T 611/01** the board found that a substantial procedural violation had occurred and decided that only a remittal could ensure the case was given the procedurally correct treatment which had previously been denied. The board considered that the new examination proceedings should be conducted by a differently composed **examining division**, that is, by a division of three new members. Such a direction was typically made when there was a question of possible bias against a party and the board emphasised that that was not the case here. However, a differently composed first instance could also be appropriate when a party had reasonable grounds for feeling it might not otherwise have a fair re-hearing, as occurred in **T 433/93** (OJ 1997, 509) or where, as in **T 628/95** of 13.5.1996, remittal to a differently composed first instance was ordered ipso facto on the board's concluding that the decision at first instance was null and void.

The board noted that the appellant had requested a different composition but, even in the absence of such a request, it would have so directed because, after grave procedural irregularities, it was important to ensure, so far as possible, that there should not be any ground for dissatisfaction with the conduct of the further proceedings, such as might well be the case if the same examining division were again to refuse the application even after impeccably conducted proceedings. In the circumstances, and bearing in mind that someone who was not a member of the particular examining division could have been responsible for, or at least involved in the procedural violation, such a direction was also fairer for the members of the examining division who took the decision under appeal.

In **T 900/02** the board observed that it was well-established in the case law of the boards of appeal that a suspicion of partiality or bias could be sufficient to invalidate a first instance decision (see "Case Law of the Boards of Appeal of the EPO", 4th edition 2001, p. 378 et seq.). This reflected a basic principle of procedural law in the contracting states of the EPC (see Art. 125 EPC 1973), namely that all the members of a tribunal had to be above any suspicion of bias. Although often referred to as the rule against bias (or sometimes as a rule of natural justice), it was important to note that, in the majority of cases in which it was invoked, no actual bias or partiality was established and all that occurred was an inference that one or more persons in a decision-making capacity might have had reasons to favour a particular party.

The board noted that in **G 5/91** (OJ 1992, 617) the Enlarged Board held that the question whether or not an objection of suspected partiality was justified could only be considered in the particular circumstances of each individual case. The board considered the appellant's objection in the form of a question: can justice be seen to have been done in the circumstances of the case at issue, namely when a member of the opposition division took employment with the respondent's representative before the written decision was issued? The board found that nothing untoward actually happened in the case at issue; it stated that a suspicion of partiality however had inevitably to arise if a

member of an opposition division, or any other first instance body, first solicits and then accepts employment with a firm in which a partner or other employee was conducting a case pending before that member.

In **T 479/04**, the board observed that the decision in **G 5/91** (OJ 1992, 617) stated the following as an obiter dictum; in respect of opposition proceedings there may be arguments in favour of letting the opposition division itself consider and decide upon such matters by means of an interlocutory decision allowing separate appeal. This would have the advantage of making it possible to have this procedural matter settled before a decision on the substance is taken. According to the board, it could be inferred from this that there was no principle prohibiting an opposition division from deciding itself on an allegation of partiality made against it (see **G 5/91**). The board found that the order in **G 5/91** in fact left it open whether the decision on the opposition division's partiality necessarily had to be taken before its final or interlocutory decision on the substance.

The board held that, although the Enlarged Board had, in the above obiter dictum, considered it advantageous for the procedural matter to be settled before a decision on the substance was taken, it could not be inferred from the order in **G 5/91** that it was forbidden in principle to decide on that matter together with the decision on the substance. The board therefore concluded that the opposition division had not committed any procedural error in the case in hand by deciding itself, as part of the contested decision, on the allegation that it would be impartial.

3.2.2 Members of the boards of appeal

In **T 843/91** (OJ 1994, 818), a newly appointed board had to consider whether the three members of the board of appeal originally appointed could be suspected of partiality. The board agreed with the view held in decision **T 261/88** (see above) that a disqualifying partiality presumed a preconceived attitude towards a party on the part of a person in a decision-making capacity. More precisely, partiality would be knowingly to favour one party by granting it rights to which it was not entitled, or by intentionally disregarding the rights of the other party. The board referred to **G 5/91** (OJ 1992, 617) which stated that the question whether or not an objection to members on the ground of suspected partiality was to be considered justified could only be decided in the light of the particular circumstances of each individual case.

In **T 241/98** of 22.3.1999 a party to the appeal proceedings raised an objection under Art. 24(3) EPC 1973 to a member of the board on the basis of suspected partiality. As the objection was formally admissible the board held oral proceedings on the substantive issue of partiality, excluding the member objected to and including his alternate. As the board was unable to establish any objective basis for a suspicion of partiality, the exclusion of the original member was lifted and the appeal was continued before the board in its original composition.

In **T 1028/96** of 15.9.1999 the board had to consider the correct procedure where an objection of partiality was raised against board members. The board ruled that a preliminary examination for admissibility under Art. 24(3) EPC 1973 was incumbent on

the original board, following which the procedure under Art. 24(4) EPC 1973 might need to be followed if the objection was admissible. An objection by a party that a member of the board had previously "participated in the decision under appeal" (Art. 24(1) EPC 1973) only covered decisions of the examining and opposition divisions and not decisions of the boards of appeal arising from those decisions. An objection under Art. 24(3) EPC 1973 based on "suspected partiality" could give rise to exclusion of board members originally appointed in circumstances where substantially the same crucial facts were at issue in opposition appeal proceedings as had previously been at issue in grant appeal proceedings "in the light of the particular circumstances of each individual case".

According to **T 954/98** of 9.12.1999, the rules for exclusion from a board for partiality should be interpreted not only in the light of the principle of judicial impartiality, but also the principle of "gesetzlicher Richter" (i.e. according to the principle of "the duly designated judge"), such that, firstly, a member whose impartiality was suspect should not handle a case, but secondly that parties should not be able to change the composition of boards at will for no objective reason. Purely subjective impressions or vague suspicions were not enough to disqualify a member. The member's behaviour or situation had to provide objective justification for a party's fears. The mere fact of taking discretionary procedural steps which might disadvantage a particular party was not enough to justify exclusion, not even if the party concerned interpreted those steps as expressing bias against it.

In **T 190/03** (OJ 2006, 502) (see also **T 283/03**, **T 572/03**, all published on 18 March 2005) the proprietor's objections and arguments involved a rather complex combination of possible sources of partiality. The board observed that there were two distinct aspects of partiality involved in the proprietor's objections and the situations envisaged by Art. 24 EPC 1973. Firstly, partiality for subjective reasons, i.e. an actual partiality on the part of the member, for example due to a personal interest or a dislike of a party. Secondly, a suspicion or appearance that there was partiality, which would be derived by an "objective observer" from a particular action of a member, or an assumed response to a proprietor's action. Thus, the board noted that the existence of partiality had to be determined on the basis of the following two tests:

- Firstly, a "subjective" test requiring proof of actual partiality of the member concerned.
- Secondly, an "objective" test where the deciding board judged whether any circumstances of the case give rise to an objectively justified fear of partiality.

Actual partiality was an internal characteristic of the member himself and its presence was clearly objectionable because it went against the principle of a fair trial. However, suspicion and appearances were not enough to show actual partiality. This was because it was a fundamental duty of a member acting in a judicial capacity to take decisions objectively and not be swayed by personal interest or other peoples' comments or actions. Thus, personal impartiality of a member was to be presumed until there was proof to the contrary.

On the other hand, the appearance of partiality involved external aspects and it did not need to be proved in the same way as actual partiality, but the circumstances had to be judged to see whether they gave rise to an objectively justified fear of partiality. This essentially corresponded to the "objective" and "reasonable" grounds identified above in the case law of the EPO.

Applying the above tests to the case at issue, the board came to the following conclusions:

The board held that not admitting amended claims, regardless of whether the board had correctly used its power or discretion to do so, would not give rise to an objectively justified fear of partiality. It also held that at the beginning of an appeal case where a properly constituted board had not performed a procedural step, there were generally no circumstances that gave rise to an objectively justified fear of partiality. Finally, it held that the mere fact that the member concerned gave reasons and explanations of the reasons, which went beyond the facts, in response to an invitation under Art. 3(2) RPBA 2003 did not give rise to an objectively justified fear of partiality under the objective test.

In decision **T 281/03** dated 30 March 2006 the respondent had raised partiality objections to the original chairman, the original technical member and the original legal member. The board in the substitute composition thus had to decide whether these objections were justified. It was alleged inter alia that the acts of the chairman were driven by a desire for revenge based on a former law suit which the respondent himself had initiated.

The board held that even if an application of procedural or substantive law was to be found incorrect, this would be far from proving that the deciding body is willingly violating a party's right. Even less could a party's own attacks on a previous, allegedly flawed, decision of a board of appeal be a basis for alleging partiality of the members of the board in future cases. If this were so, this would give parties an unrestricted possibility of excluding board members from their cases for reasons unrelated to partiality. The board noted that in decision **T 954/98** of 9 December 1999, the board of appeal had set out that the provisions governing objections of suspected partiality serve dual purposes. On the one hand, a member should not act on a case implying a suspicion of partiality, on the other hand it should not be possible for a party to change the composition of the board at will without any objective reason. If the suspicion of partiality was only based on the fact that procedural measures had been taken affecting a party, such a suspicion was not sufficient to justify an objection of partiality. This applied even where the party interpreted those measures as an expression of a prejudice against it. The board concluded that the circumstances of the case and the behaviour of the original board members did not give rise to an objectively justified fear of partiality. Further, the board had to examine whether there were subjective reasons for partiality. The modified board made clear that it was a fundamental duty of a member of a board of appeal acting in a judicial capacity to take decisions objectively and not to be swayed by personal interest or other people's comments or actions. This principle was explicitly contained in the solemn declaration delivered by members of the boards of appeal at the time of their inauguration. Thus, personal impartiality of a member of a board of appeal was to be presumed until there

In **J 15/04** the two legal members appointed held that the chairman should have recused himself in the appeal because of his participation in the decision refusing the parent application. However, the chairman appointed did not share this view and did not envisage availing himself of Art. 24(2) EPC 1973. By administrative order the originally appointed chairman and legal members were replaced by their alternates pursuant to the Business Distribution Scheme for the purpose of taking a decision according to Art. 24(3) EPC 1973 and Art. 3(1) RPBA 2003. The board noted that the exclusion of the originally appointed chairman could be required under the terms of Art. 24(1) EPC 1973, if he had participated in the decision under appeal. It held that according to the wording of this provision, the exclusion of the originally appointed chairman was obviously not justified because the decision under appeal was different from the decision refusing the parent application. As a result, the board found that Art. 24(1) EPC 1973 did not apply to the appeal and that therefore the originally appointed chairman was not excluded from deciding on the subject matter of the appeal. The board also found that as the notices of self recusation were exclusively based on the fact that the originally appointed Chairman did not envisage availing himself of Art. 24(2) EPC 1973 - the reasons for self recusation were unfounded and the exclusion of the two legal members was not consistent with the provisions of the Convention in this respect.

In **T 1020/06** (of 28.11.2008) the board in the substitute composition considered whether there was a ground which could justify a suspicion of partiality within the meaning of Art. 24 (3), first sentence, EPC 1973 if all members of a technical board of appeal participated in a previous decision taken by a board in the same composition and involving similar legal or factual questions. The appellant stated that the widely overlapping matter under discussion raised the serious suspicion that the members of the original board would not take a fresh, neutral and unbiased view on these questions.

The board noted that "it is, however, also commonly recognised in the jurisprudence of the Boards of Appeal and elsewhere that the 'suspicion' by the party must be justified on an objective basis" and that "purely subjective impressions or vague suspicions are not enough" (**G 1/05**, OJ 2007, 362, point 20 of the Reasons). Further, it found that there was no provision in the RPBA or the Business Distribution Scheme (BDS) for a member to be excluded from participation in an appeal case pending before a technical board if that member has already dealt with a similar legal or factual question in another case pending before the same or another technical board. On the contrary, Art. 7 BDS stipulated that where appeals pending before the board are closely linked the chairman may order that the board decides in the same composition. It followed that, to the extent that participation in appeal cases which are closely linked by involving similar legal or factual questions is not excluded by the RPBA and BDS, an objection of partiality could not be based on that fact alone. The board concluded from the above that the circumstances of the case and the conduct of the original board members did not give rise to a justified fear of partiality. In its view, on an objective basis there was nothing to justify any suspicion that any of the original members might have any kind of preconceived attitude towards the questions at issue in the case in point. For these

reasons given, in this particular instance the objections of partiality under Art. 24(3) EPC 1973 against the original board members were rejected.

A request pursuant to Art. 24(3) EPC that a particular member of the Enlarged Board of Appeal not sit in the case for the referral pending under **G 2/08** (Dosage Regimen) was filed by professional representatives acting on behalf of their clients. The complaint originated from a third person, who was a party to a legal action in the United Kingdom in which the novelty of the claim resided solely in a dosage regime. The complaint relied on the fact that the member concerned had chaired the Technical Board of Appeal which decided a previous case. The decision on that case was alleged to be exceptional and in view of this the third person came to the conclusion that it would be very difficult for the member concerned to approach the issues to be decided in the pending referral with an open mind and furthermore, that this would be seen to be the case by those who were interested in the outcome of this referral.

The Enlarged Board pointed out that, according to the EPC, objections of suspicion of partiality were the monopoly of parties to the proceedings. It was nevertheless the case that, pursuant to Art. 4(1) RPEBA 2007, if the Enlarged Board of Appeal had knowledge of a possible reason for exclusion or objection which did not originate from a member himself or from any party to the proceedings, then the procedure of Art. 24(4) EPC was to be applied. It found that the statements alleged did not represent "prima facie" an abuse of procedure purporting to delay the proceedings or to damage the reputation of the member concerned, but rather represented a "possible reason for objection" as required by Art. 4(1) RPEBA 2007. It decided to proceed with the procedure under Art. 24(4) EPC as prescribed by Art. 4(1) RPEBA 2007 in fine.

The Enlarged Board noted that the boards of appeal and the Enlarged Board of Appeal respectively act as judicial bodies and apply general principles of procedural law. Duly established by law, members of the Enlarged Board of Appeal have the duty to sit in the cases allocated to them according to their jurisdiction both "ratione legis" and "ratione materiae". That is, parties to judicial proceedings have a right to have their case considered and decided by the judge designated or appointed by law (*Droit d'être jugé par son juge naturel*; *Recht auf den gesetzlichen Richter*). Further, once established by law the judge is deemed to act in good faith and is therefore presumed impartial until proven otherwise (cf ECHR, *De Cubber v. Belgium*, 26 October 1984; *ETTL v. Austria*, 23 April 1987; *Hauschildt v. Denmark*, 24 May 1989; *Academy Trading Ltd et al. v. Greece*, 4 April 2000).

On the merits of the complaint, the Enlarged Board noted that on a subjective basis, there was no reason to doubt the personal impartiality of the member concerned, all the more so as he/she confirmed that he/she was not biased. On the other hand the complaint did not contain any reason permitting any reasonable doubt in that respect. Nor could anything in the behaviour of the member concerned give rise to any kind of objection. However "suspicion of partiality" could also be justified on an objective basis having due regard to the presumption that members of the boards of appeal act in good faith and are deemed impartial. The Enlarged Board of Appeal accepted as its own the reasoning developed in decision **G 1/05** (OJ 2007, 362, points 20 to 26 of the Reasons),

and reiterated that "to the extent that participation in a referral pending before the Enlarged Board of Appeal of a board member having already dealt with the matter as a member of a board of appeal is not excluded by these provisions, an objection of partiality cannot be based on that very same fact alone" (point 27 of the Reasons). It decided that there was nothing, in the member of the Enlarged Board's behaviour or in the decision, that could justify any suspicion against this member, who therefore remained a member of the Enlarged Board of Appeal in the case at issue. The Enlarged Board noted that the decision in question was taken by a board of appeal composed of three members, and as such reflected the reasoning and findings of the board as a judicial body rather than those of its respective members. Decisions are taken by majority vote and deliberations are secret. It could not be presumed that the decision represented the personal thoughts of the member concerned.

3.2.3 Members of the Enlarged Board of Appeal

In the interlocutory decision of the Enlarged Board of Appeal **G 3/08** dated 16 October 2009 it was noted that according to established case law of the Boards of Appeal, of the Enlarged Board and also of national courts of member states, the mere fact that a board member had expressed a view on the legal issue to be decided on a previous occasion, be it in a prior decision or in literature, be it in a prior position in the EPO or as an expert for external political institutions, could not lead to the conclusion of doubts as to impartiality. Nor does a purely subjective impression that the opinions of a board member might be disadvantageous to a particular interest justify an exclusion.

4. Date of decision

4.1. Entry into force of decisions

The Enlarged Board of Appeal has held that it is necessary to distinguish between decisions taken after the closure of the debate in oral proceedings and decisions taken following written proceedings. Where oral proceedings are held, the decision may be given orally. The decision becomes effective by virtue of its being pronounced. The equivalent of that point in time in written proceedings is the moment the decision is notified. Once it has been pronounced and, in the case of written proceedings, notified, the decision enters into force and cannot be amended, even by the department that issued it. A decision may only be revoked by the department that issued it by way of an interlocutory revision under Art. 109 EPC 1973 if one of the parties has filed an admissible and well-founded appeal (**G 12/91**, OJ 1994, 285).

4.2. Completion of the internal decision-making process

In **T 586/88** (OJ 1993, 313) the board referred the following point of law to the Enlarged Board of Appeal: "If the decision of an examining or opposition division is pronounced not at the end of oral proceedings but following written proceedings or proceedings continued in writing after oral proceedings, at what point is the internal decision-making process within that department of the EPO completed?".

In **G 12/91** (OJ 1994, 285) the Enlarged Board of Appeal stated that the point of law referred was of vital importance to the general question of determining the final point at which a first-instance department of the EPO could still take account of further submissions by the parties. The Enlarged Board noted that the point in time at which a decision entered into force, i.e. the moment it was pronounced or notified, was not the last moment at which parties could still submit observations. This had to be done **at an earlier point** in the proceedings to allow the decision-making department time to deliberate and then issue its decision based on the parties' submissions.

As far as oral proceedings were concerned, established board of appeal case law had this point in time determined to be the time of closure of the debate, which was fixed by the decision-making department - having first heard the parties' submissions - to allow itself time to consider its decision. Once the debate had been closed, further submissions by the parties had to be disregarded unless the decision-making department allowed the parties to present comments within a fixed time limit or decided to reopen oral proceedings for further substantive debate on the issues.

In the case of decisions taken following written proceedings, the final moment at which fresh matter submitted by the parties could still be taken into account had to correspond to the time of closure of the debate during oral proceedings. The need to ensure legal certainty required that this moment be as clearly fixed as the moment when the debate was closed during oral proceedings. Neither the EPC 1973 nor its Implementing Regulations contained any provision fixing that moment.

The Enlarged Board of Appeal reached the conclusion that the point in time at which the internal decision-making process was completed was the date on which the formalities section handed over the date-stamped, post-dated decision to the EPO postal service. This was a date the parties could ascertain very easily, because, as the President of the EPO had explained, it was always three days prior to the date stamped. Internal EPO instructions made it clear that a period of three days always elapsed between the date-stamping of a decision and its despatch. If, for whatever reason, the EPO postal service was unable to despatch the decision on the date stamped, it returned the decision to the formalities section where it was given a new date, which again pre-dated the date of actual despatch by three days. This practice ensured that the date of despatch was always stamped on the decision three days before it was actually despatched. It thus fulfilled the need for strict legal certainty which the handing down of a decision had to ensure.

When a decision is handed over by the formalities section to the EPO postal service for notification, it is taken from the file and is therefore removed from the power of the department that issued it. This moment marks the completion of proceedings before the decision-making department. Once proceedings have been completed the decision-making department can no longer amend its decision. It must disregard any fresh matter the parties may submit to the EPO thereafter. Seeing that it is important for the parties to know at which point in time the decision-making process following written proceedings is completed, this point in time should be clearly indicated in the decision (see also **T 631/94**, OJ 1996, 67).

In **T 798/95** the decision to grant a European patent was handed over to the EPO postal service for notification on 25.8.1995 during the official working time of the EPO. On 25.8.1995, at 6.47 pm, the appellant filed a request by telefax for amendment of the application under R. 86(3) EPC 1973. The board held that a request for amendment filed after the completion of the proceedings up to grant before an examining division was to be disregarded even if the filing of the request and the completion of the proceedings occurred on the same date. The board noted that the proceedings before the examining division were completed not later than at the end of the official working time on that date. Thereafter, the examining division could no longer amend its decision, as it was not competent to consider the request. The appellant's submissions that the examining division had been responsible for the application all day on Friday, 25.8.1995 and that it was possible to amend the application until issue of the decision were therefore not correct.

5. Form of decisions

5.1. General issues

In **T 390/86** (OJ 1989, 30) the board stated that when a substantive decision is given orally during oral proceedings it must be formally notified to the parties in writing (R. 68(1) EPC 1973, now R. 111(1) EPC) and formally completed by giving reasons for the decision in writing (R. 68(2) EPC 1973, now R. 111(2) EPC). In the board's judgment, it was clear from R. 68 EPC 1973 and Art. 108 EPC 1973 that until a substantive oral decision was formally completed in writing and notified to the parties, the two-month period within which a notice of appeal had to be filed did not begin.

In **J 8/81** (OJ 1982, 10) the board stated that in accordance with the normal practice of the EPO, the contents of the communication ought to have been identified as a decision, so as to preserve the clear distinction made in the EPC 1973 and Implementing Regulations between decisions and communications (see e.g. R. 68 and 70 EPC 1973, now R. 111 and 113 EPC). The letter ought also to have drawn attention to the possibility of appeal and the provisions of Art. 106 to Art. 108 EPC 1973, in conformity with R. 68(2) EPC 1973. The fact that the requirements of R. 68(2) EPC 1973 were not fully complied with did not, however, mean that the letter was merely a communication. Whether a document issued by the EPO constituted a decision or a communication depended on the substance of its **contents**, not on its **form** (**J 43/92**, **T 222/85**, OJ 1988, 128, **T 713/02**).

In **T 165/07** the board stated that, according to the established case law of the boards of appeal, whether a document constitutes a decision or not depends on the substance of its content and not on its form (see e.g. **J 8/81**, OJ 1982, 10). The criterion of substance has to be assessed in its procedural context (see **T 713/02**, OJ 2006, 267). The decisive question was whether the document at issue, when objectively interpreted in its context, could have been understood by its addressees as a final, i.e. not merely preliminary, and binding determination of substantive or procedural issues by the competent organ of the EPO.

In **T 42/84** (OJ 1988, 251) the board held that the alleged failure of the EPO to enclose the text of Art. 106 EPC 1973 to Art. 108 EPC 1973 with the decision neither invalidated the decision nor did it constitute a substantive procedural violation. R. 68 EPC 1973 (now R. 111 EPC) stated that the written communication of the possibility of appeal had to draw the attention of the parties to the provisions laid down in Art. 106 to Art. 108 EPC 1973, the text of which should be attached. However, it also stated that the parties could not invoke the omission of that communication. This had, in the board's view, to be read as applying also to the omission of the text of the articles alone.

In **T 222/85** (OJ 1988, 128) the board noted that the contents of a "communication" never constituted a "decision". This distinction was important, because only a "decision" could be the subject of an appeal - see Art. 106(1) EPC 1973. In the case at issue the communication only represented a preliminary view, on an ex parte basis, and was not binding upon the department of the EPO which sent it. In contrast, the contents of a "decision" were always final and binding in relation to the department of the EPO which issued it, and could only be challenged by way of appeal.

In **J 20/99** the board noted in its decision that all EPO departments should, if quoting a decision of the boards of appeal or any other legal authority, identify that authority and place the cited passage(s) in quotation marks. It found that the examining division had raised in its communication some objections having in mind the reasons of a decision of a board of appeal that were repeated verbatim without any quotation marks or attribution. The board had observed that the situation then was completely different from that which the examining division had in mind.

In **T 830/03**, after a written reasoned decision was notified to the parties, the formalities officer informed the parties that the written decision "was only a draft". A second written decision intended to supersede the first written decision had been issued by the EPO.

The board noted that the need for legal certainty required a presumption of validity in favour of a written decision which was notified to the parties by an opposition division in accordance with the formal requirements of the EPC 1973, in particular R. 68 to R. 70 EPC 1973 (now R. 111 to 113 EPC). Once the decision was pronounced and the (first) written decision, in the case at issue, notified to the parties, the opposition division was bound by it even if it considered its decision not to "have any legal effect" (see **T 371/92**, OJ 1995, 324). The decision could be set aside only by the second instance on the condition that an allowable appeal was filed under Art. 106 EPC 1973. With the filing of the first notice of appeal, the power to deal with the issues involved in this case passed from the department of first instance to the appeal instance (devolutive effect of the appeal).

Therefore, in the judgment of the board, the written decision, which was notified to the parties by the opposition division in accordance with the formal requirements of the EPC 1973, in particular R. 68 to R. 70 EPC 1973 (now R. 111 to 113 EPC), constituted the only legally valid written decision. All actions carried out by the opposition division after the notification of the decision, and a fortiori after the filing of the first appeal, were ultra vires and thus had no legal effect.

5.2. Inconsistency between oral and written decisions

In **T 666/90** the opposition division had indicated during oral proceedings that it would maintain the European patent as amended if new documents conforming to the version of the claims it had said it would allow were submitted. Although such a set of claims had not yet been formally submitted in writing by the applicants' representative during oral proceedings, the representative had given an undertaking to do so later and had done so by the deadline set. The written decision had revoked the patent however. The board held that this inconsistency between the oral and written decisions was in breach of R. 68(1) EPC 1973 and was hence a substantial procedural violation.

In **T 425/97** an appellant submitted as sole ground of appeal the inconsistency existing between the written decision and the form of the patent held to be patentable by the opposition division at the oral proceedings. The board held that any substantive deviation, as in this case, of the decision notified in writing from the decision taken at the oral proceedings and given orally, amounted to a procedural violation.

5.3. Reasons for the decision

5.3.1 Introduction

According to R. 111(2) EPC (former R. 68(2) EPC 1973), decisions of the European Patent Office open to appeal shall be reasoned. The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a department of first instance (see inter alia **T 34/90**, OJ 1992, 454 and **G 9/91**, OJ 1993, 408). A reasoned decision issued by the first instance department meeting the requirements of R. 111 EPC is accordingly a prerequisite for the examination of the appeal (**T 1182/05**).

5.3.2 Reason for main and auxiliary requests

Under R. 111(2) EPC (former R. 68(2) EPC 1973), decisions of the EPO which are open to appeal must be reasoned. According to the established case law of the boards of appeal, a reasoned decision must be given **for each** of the different requests (main and auxiliary requests). Although in exceptional circumstances a reference in the reasons for a decision to grounds given in preceding communications may be allowed, it must be quite clear from those grounds which considerations played a crucial role for the division responsible when it took its decision (**T 234/86**, OJ 1989, 79). It must be ensured that, before issuing a decision revoking the patent solely on the basis of the patent proprietor's main request, the proprietor has expressly withdrawn all subordinate requests (see **T 81/93**, **T 5/89**, OJ 1992, 348). If the patentee files one or more auxiliary requests in addition to a main request and does not withdraw any of them, an opposition division is obliged in its decision to give reasons why each successive request is either not admissible (in the exercise of its discretion under R. 57(1) and R. 58(2) EPC 1973) (**T 155/88**, **T 406/86**, OJ 1989, 302; **T 951/97**, OJ 1998, 440) or not allowable on substantive grounds. If an opposition division allows an auxiliary request without giving reasons in its decision why the main request or preceding auxiliary requests are not

allowable, that decision should be set aside as void and without legal effect, and the appeal fee refunded on the basis of a substantial procedural violation (see **T 484/88**).

In **T 966/99** the board held that the appellant's first auxiliary request, according to which the written decision should provide reasoning as to why the withdrawn main request might not be allowable, had to be rejected.

The board made a number of observations in its decision. It observed that R. 66(2) EPC 1973 in combination with Art. 113(2) EPC 1973 meant that the decision dealing with revocation or maintenance of the patent needed to include reasons only in respect of those of the patentee's requests concerning the text of the patent that were still pending. As soon as a request was withdrawn by the patentee, there was no longer a procedural basis for the board to consider and decide upon it. Further, Art. 113(2) EPC 1973 gave the patentee the exclusive right to file requests relating to the text of the patent; therefore such requests by parties to the proceedings other than the patentee were not admissible. Accordingly, the board could not include reasons in the decision in respect of such texts if submitted by the appellant (opponent). Moreover, it followed from Art. 107 EPC 1973, as underlined by the Enlarged Board in **G 9/91** (OJ 1993, 408), that the inter partes appeal procedure aimed to give the losing party the opportunity to challenge the decision of the opposition division on its merits. When the decision under appeal was set aside as a consequence of the withdrawal of the main request, the appellant was no longer adversely affected by the maintenance of the European patent in accordance with that request.

5.3.3 Compliance with the requirements of Rule 111(2) EPC (former Rule 68(2) EPC 1973)

In **T 856/91**, the contested decision referred to the knowledge of prominent skilled persons and cited "a statement by a well-known expert" but contained no information enabling the reader to infer who these persons were or exactly what they had said. The board took the view that this incomplete information did not constitute a breach of R. 68(2) EPC 1973 (now R. 111(2) EPC), since it was sufficient for a decision to be reasoned in some way, even if the reasoning was incomplete and deficient.

In **T 647/93** (OJ 1995, 132) the appellants had lodged an appeal against the decision of the examining division to refuse the application and claimed that the latter had committed substantial procedural violations in that, inter alia, it had not followed the procedure set out in the Guidelines, or provided a written reasoned decision as required by R. 68(2) EPC 1973. The board observed that the reasons for the refusal were somewhat enigmatic, and that there was no basis for them in the EPC 1973. However, the board held that even if the reasons for the decision were not well founded, this did not mean that the decision was not reasoned at all within the meaning of R. 68(2) EPC 1973 (now R. 111(2) EPC).

In **T 70/02** the board found that by simply stating "no convincing arguments have been found in your letter" in response to letters in which the objections put forward were exhaustively discussed by the applicant, the examining division had adopted an unfair

attitude, leaving the applicant without any indication as to why his arguments had not been found convincing, so that he had been unable to react against the conclusions of the examining division.

In accordance with R. 68(2) EPC 1973 (now R. 111(2) EPC), decisions of the EPO which are open to appeal must be reasoned. In this respect the board accepted that reasoning did not mean that all the arguments submitted should be dealt with in detail, but it was a general principle of good faith and fair proceedings that reasoned decisions should contain, in addition to the logical chain of facts and reasons on which they were based, at least some reasoning on crucial points of dispute in this line of argumentation in so far as this was not already apparent from other reasons given, in order to give the party concerned a fair idea of why its submissions were not considered convincing and to enable it to base its grounds of appeal on relevant issues.

5.3.4 Non-compliance with the requirements of Rule 111(2) EPC (former Rule 68(2) EPC 1973)

In **T 493/88** (OJ 1991, 380) the board held that a decision of an opposition division rejecting an opposition had not been correctly reasoned within the meaning of R. 68(2), first sentence, EPC 1973 (now R. 111(2) EPC) if, after giving the reasons why the opposition division, unlike the opponent, considered the subject-matter of the patent to be new, it failed to state the reasons why it considered that the subject-matter also involved an inventive step.

In **T 292/90**, regarding inventive step, the examining division had merely said that the claimed process amounted to an obvious juxtaposition of the teachings of documents 2, 3 and 4. There was no explanation of how the examining division had arrived at this conclusion. The board considered this form of reasoning to be insufficient. The reasoning given in a decision open to appeal had to enable the appellants and the board of appeal to examine whether the decision was justified or not. A decision on inventive step therefore had to contain the logical chain of reasoning which had led to the relevant conclusion (see also **T 52/90**).

In **T 153/89** the examining division had given no reasons for finding in its decision that the subject-matter of the dependent claims was not inventive. The board of appeal took the view that the perfunctory statement in the contested decision did not permit the board to judge whether this issue had been sufficiently investigated, or investigated at all. The examining division's decision on such grounds did not amount to a reasoned decision.

In **T 740/93** the case had been sent back to the department of first instance because of a procedural violation (incorrect composition of the opposition division), with the order for further prosecution by a correctly composed opposition division. The new opposition division rendered a decision which was nearly identical to the first one. The board held that, in accordance with R. 68(2) EPC 1973 (now R. 111(2) EPC), decisions of the EPO which were open to appeal had to be reasoned. In this respect the board accepted that reasoning did not mean that all the arguments submitted should be dealt with in detail, but it was a general principle of good faith and fair proceedings that reasoned decisions

should contain, in addition to the logical chain of facts and reasons on which every decision was based, at least some reasoning on crucial points of dispute in this line of argumentation, in so far as this was not immediately apparent from the reasons given, in order to give the party concerned a fair idea of why his submissions were not considered convincing. Since the second decision was nearly identical to the first one, it did not meet the requirements of R. 68(2) EPC 1973, in that it was not sufficiently reasoned, which failure amounted to a substantial procedural violation.

In **T 227/95** the appellants submitted that the decision of the opposition division to maintain the patent in amended form was not reasoned within the meaning of R. 68(2) EPC 1973 (now R. 111(2) EPC). In its decision, the board agreed with this view. The decision contained no reasons on the merits of the case. Instead, it merely stated: "for the reasons it is referred to the decision of the board of appeal dated 24.01.94" (**T 527/92**). However, decision **T 527/92** contained no such reasons, since the case was remitted to the opposition division for further prosecution. The board in that case decided only that the patent could not be maintained in accordance with the patentees' (then) main request. The examination of the auxiliary request was left entirely to the department of first instance.

In **T 698/94** the board noted that neither the minutes of the oral proceedings before the opposition division nor the "Summary of Facts and Submissions" of the appealed decision itself contained the slightest hint at the arguments brought forward by the parties. It was impossible for the parties to the proceedings to see how the opposition division had arrived at its conclusion of lack of novelty. As a result, the losing party was deprived of its legitimate right to challenge the reasoning on which the decision was based, which was the very purpose of proceedings before the boards of appeal (see **G 9/91**, OJ 1993, 408). The board explained that the requirement of R. 68(2) EPC 1973 (now R. 111(2) EPC) for decisions to be "reasoned" meant that the decision had expressly to set out the logical chain of argument upon which the conclusion and therefore the final verdict were based, in respect of each and every ground that had been pleaded and substantiated. The de facto absence of reasoning in the decision under appeal represented a substantial procedural violation.

In **T 135/96** the opposition division had completely ignored two documents as well as some lines of argument developed by the appellants (opponents) in support of their allegation that the claimed subject-matter lacked an inventive step. The board held that the failure to consider these documents and arguments, which were relevant to the ground of lack of inventive step on which the decision under appeal was based, constituted a violation of the right to be heard and thus a substantial procedural violation as well as a fundamental deficiency in the first-instance proceedings. Moreover, the decision under appeal was not in conformity with R. 68(2) EPC 1973 (now R. 111(2) EPC), since it gave no reason why the subject-matter of the independent claims was considered to involve an inventive step in respect also of the two additional lines of argument developed by the opponents.

In **T 652/97** the board held that the principle enshrined in R. 68(2) EPC 1973 (now R. 111(2) EPC) ensured a fair procedure between the EPO and parties to proceedings,

and the EPO could only properly issue a decision against a party if the grounds on which it was based had been adequately reasoned. The decision had not provided the opponent with any reasoning concerning its main argument, which conflicted with the requirements of R. 68(2) EPC 1973 and constituted a substantial procedural violation.

In **T 615/95** in an annex to its decision, the examining division considered that an interlocutory revision could only be possible on condition that several objections were overcome. These objections were unrelated to the grounds of refusal and had clearly no link at all to the decision under appeal. The board held that an examining division's decision should not be supplemented normally by annexes dealing with issues having no relation to the issues dealt with in the reasons for this decision.

In **T 473/98** (OJ 2001, 231) the board held that it is entirely appropriate and desirable in the interests of overall procedural efficiency and effectiveness that an opposition division should include in the reasons for a revocation decision pursuant to Art. 102(1) EPC 1973 employing the standard decision formula, by way of obiter dicta, findings which could obviate remittal in the event of the revocation being reversed on appeal.

In **T 278/00** (OJ 2003, 546) the board noted that while the tenor of the decision under appeal was unambiguous, namely that the application at issue lacked inventive step pursuant to Art. 56 EPC 1973 and unity pursuant to Art. 82 EPC 1973, it was established case law that R. 68(2) EPC 1973 (now R. 111(2) EPC) required the decision to contain, in logical sequence, those arguments which justified the tenor. In the board's view, the reasoning of a decision under appeal must be taken as it stands. It held that the requirements of R. 68(2) EPC 1973 could not be construed in such a way that, in spite of the presence of unintelligible and therefore deficient reasoning, it was up to the board or the appellant to speculate as to what might be the intended meaning of it. The board had to be in a position to assess on the basis of the reasoning given in the decision under appeal whether the conclusion drawn by the first instance was justified or not. That requirement was not satisfied when the board was unable to decide which of the various inconsistent findings indicated in and justifying the decision under appeal were correct and which were false (see also **T 316/05**).

In **T 897/03** the board held that a decision that leaves it to the appeal board and the appellant to speculate as to which of the reasons given by the examining division in different communications might have been decisive for the refusal of the application, could not be considered to meet the requirements of R. 68(2) EPC 1973. The decision under appeal did not contain any specific reasons, but merely referred to various communications issued by the examining division (see **T 652/97** and **T 278/00**, OJ 2003, 546).

In **T 963/02** the board stated that if a decision was merely reasoned by a reference to a preceding communication, the requirement of R. 68(2), first sentence, EPC 1973 was only met if the communication referred to itself fulfilled the conditions defined in **T 897/03** and **T 278/00** above. The decisive reasons for refusal had to be clear from the reference, for the party and for the board of appeal. This applied, in particular, if reference was made to more than one preceding communication, dealing with a number of issues, and

possibly having as basis different sets of claims. The decision under appeal must not leave it to the board and the appellant to speculate as to which of the reasons given in preceding communications might be essential to the decision to refuse the application (see **T 897/03**).

In **T 1356/05** (also **T 1360/05**) the applicant requested a decision on the state of the file. The board held that such a request was not to be construed as a waiver of the right to a fully reasoned first instance decision, even in the light of the suggested procedure in the Guidelines (Guidelines E-X, 4.4 - June 2005 version; see also **T 1309/05**). The board stated that quite apart from the fact that no provision of the Guidelines could override an article or rule of the EPC 1973, such as R. 68(2) EPC 1973 (now R. 111(2) EPC) (**T 861/02**), it noted that the quoted passage in the Guidelines did not discuss in detail the procedure to be followed if such a request was presented during oral proceedings, and it was not at all apparent that the suggested procedure was to be applied under such circumstances. On the contrary, it appeared rather to concern the situation where an applicant relied only on the written procedure. The term "state of the file" implied that all relevant facts and arguments were already on file - i.e. they exist in a written form -, which could hardly be the case immediately following oral proceedings if, as in the case at issue, oral arguments had been made.

In **T 1709/06** the board noted that although the Guidelines for Examination E-X, 4.4, suggested a procedure for issuing a decision "on the state of the file" taking a standard form, a number of decisions of the boards of appeal (see **T 1309/05**, **T 1356/05**) have pointed out that a standard decision form for issuing a decision "on the state of the file" which refers to several communications, leaving it up to the board of appeal to construct the applicable reasons by "mosaicing" various arguments from the file, or, which leaves it in doubt which arguments apply to which claim version, does not meet the "reasoned" requirement of R. 68(2) EPC 1973 (now R. 111(2) EPC). The wording of the impugned decision did not allow the applicant or the board to properly discern the grounds on which the examining division had refused the application. The board took the same view as in the above-cited cases **T 1309/05** and **T 1356/05** that the form of decision adopted by the examining division in the case in point was not appropriate for meeting the requirements of a reasoned decision within the meaning of R. 68(2) EPC 1973 (now R. 111(2) EPC). In addition, it was the consistent case law of the boards of appeal (see e.g. **T 740/93**) that a "reasoned" decision should deal with all important issues of dispute. The board thus considered that the failure to deal with the arguments submitted by the applicant also infringed R. 68(2) EPC 1973 (see R. 111(2) EPC).

In **T 1182/05** the board observed that a number of decisions of the boards of appeal pointed out that a decision form which refers to several communications, leaving it to the board of appeal and the appellant to speculate as to which of the reasons given by the examining division in its communications might be essential to the decision to refuse the application did not meet the "reasoned" requirement of R. 68(2) EPC 1973 (now R. 111(2) EPC) (see **T 861/02**, **T 897/03**, **T 276/04** and **T 1309/05**). In the case at issue the examining division, in response to the appellant's request "to render a decision on the record", refused the application using EPO form 2061 for a so-called "decision on the state of the file". The Guidelines for Examination in the EPO (June 2005; now April 2010)

E-X 4.4, provides for a standard form which was entirely appropriate in the special case where the examining division fully expressed and reasoned its objections to the application text in preceding communications. However, the decision of the examining division did not contain any specific reasons. Thus it was left to the board and to the appellant to speculate as to which were the decisive reasons for the refusal. This was at odds with the established jurisprudence of the boards of appeal that for the requirements of R. 68(2) EPC 1973 (now R. 111(2) EPC) to be fulfilled the decision must include, in logical sequence, the arguments justifying the order. The grounds upon which the decision was based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision (see **T 278/00** (OJ 2003, 546)). The applicant's request "to render a decision on the record" was not to be construed as a waiver of the right to a fully reasoned first-instance decision, even in the light of the suggested procedure in the Guidelines (see **T 1309/05**, **T 583/04**). In its decision, the examining division should have explained the precise reason or reasons for its decision and why the counterarguments of the applicant were not considered convincing. By failing to do so the examining division did not issue a reasoned decision within the meaning of R. 68(2) EPC 1973 and therefore committed a substantial procedural violation.

In **T 63/05** the board interpreted the appellant's letter as a request for a reasoned decision on the basis of the file as it stood at that date, that is, the appellant did not want to receive a substantive communication from the board, or file any more comments. In these circumstances, the board noted that the decision could of course be based on arguments necessary to refute the points made in the appellant's grounds of appeal, but which were not previously communicated to the appellant. It was equally self-evident that the board could reach a decision adverse to the appellant. The request for a decision on the record and the withdrawal of the request for oral proceedings were submitted of the appellant's own free will (*volenti non fit injuria*).

In **T 1123/04** the board noted that it was established jurisprudence of the boards of appeal that the opportunity to present comments and arguments guaranteed by Art. 113(1) EPC 1973 was a fundamental principle of the examination, opposition and appeal procedures. As pointed out in decision **T 508/01** this was not just a right to present comments but also to have those comments duly considered. Further, the board noted that R. 68(2) EPC 1973 (now R. 111(2) EPC) stipulates that decisions of the European Patent Office which are open to appeal must be reasoned. The criteria for the "reasoning" are, for instance, elaborated in the Guidelines, Part E-X, 5 : the requirement in R. 68(2) EPC 1973 for a "reasoned decision" was not only motivated by the basic legal principle that a party should be informed of the detailed grounds of a negative decision, but that such reasoning and grounds should be comprehensible to those conducting a later judicial review (R. 68(2) EPC 1973: "Decisions ...which are open to appeal"). It should not be necessary for a board of appeal to have to reconstruct or even speculate as to the possible reasons for a negative decision in the first instance proceedings. In principle, a decision referred to in R. 68(2) EPC 1973 should be complete and self-contained.

In **T 1366/05** the deciding body, here the opposition division, decided on the issue of novelty, namely that the claimed subject matter of the patent in suit was not novel in view of the prior art (Art. 54 EPC 1973). The appellant objected to the decision under appeal revoking the patent for lack of novelty *inter alia* as being insufficiently reasoned in violation of R. 68(2) EPC 1973 (now R. 111(2) EPC). The board, before considering the substantive issue of novelty, examined whether the decision under appeal respected the requirement of that provision. It held that there was no reasoning in the written decision proper to the opposition division for its conclusion that the subject-matter of the claims lacked novelty or a written decision of an opposition division revoking a patent for lack of novelty to be reasoned under R. 68(2) EPC 1973, it had to contain a logical chain of reasoning starting with the identification of that portion of the prior art used to justify the conclusion that the claimed subject-matter lacks novelty. The sole statement of the conclusion reached did not constitute reasoning within the meaning of R. 68(2) EPC 1973. The board stated that the mere summary of a party's submission was not *per se* a reasoning proper to the deciding body and held that a written decision which was based on such a deficient reasoning was not reasoned within the meaning of R. 68(2) EPC 1973, which failure amounted to a substantial procedural violation.

In **T 265/03** the board held that the decision of the examining division could not be considered to be a reasoned decision within the meaning of R. 68(2) EPC 1973 (now R. 111(2) EPC), in the sense that it was not reasoned in relation to the subject matter on file, i.e. the applicant's latest request. The board stated that it was clear that the applicant's request for a decision "on the status of the file" was only a waiver of his right under Art. 113(1) EPC 1973 to present comments on the reasons for a likely refusal, such waiver being in accordance with his expressed intention not to comply with the summons to oral proceedings. Such a request was not to be construed as a waiver of the right to a fully reasoned first-instance decision. As a matter of fact, the "state of the file" was not restricted to those documents on file which were issued by the EPO, but also included all those documents and arguments which were filed by the applicant prior to (or even simultaneously with) his request for a decision "on the status of the file". Therefore, it was clear that the request of the applicant encompassed all the requests filed. The examining division was obliged by R. 68(2) EPC 1973 to issue a decision presenting all the legal and factual reasons for refusing the application. The board made it clear that the duty to provide reasons in administrative decisions was a fundamental principle in all contracting states, R. 68(2) EPC 1973 being simply an expression of this principle. Further, from the point of view of the practical functioning of the system envisaged in the EPC, without a reasoned decision within the meaning of R. 68(2) EPC 1973, the board could not examine the appeal (Art. 110 EPC 1973).

In **T 750/06** the applicant informed the examining division that it had withdrawn its request for oral proceedings and requested "that a decision now be taken based on the current state of the file, in light of the telephone discussion". A decision to refuse the European patent application was issued by the examining division. The decision stated that the applicant was informed that the application did not meet the requirements of the EPC. The applicant was also informed of the reasons therein. The examining division stated that the applicant had filed no comments or amendments in reply to the last communication but had requested a decision according to the state of the file. The board

held that the contested decision could not be considered to be a fully reasoned decision within the meaning of R. 68(2) EPC 1973 (now R. 111(2) EPC) because it did not present a full exposition of all the legal and factual reasons for refusing the application. Some additional features (a) and (b) included in claims 1 and 8 of the applicant's latest request were never discussed in the course of the first instance proceedings. The board could not find in the file any communication from the examining division pursuant to Art. 96(2) and R. 51(2) EPC 1973, namely a communication inviting the applicant to file observations within a period fixed by the examining division. The board noted that a record of a telephone consultation was not *sensu stricto* a communication pursuant to Art. 96(2) EPC 1973 and "the term "state of the file" implied that all relevant facts and arguments were already on file - i.e. they existed in a written form - which could hardly be the case immediately following a phone call".

In **T 246/08** the board noted that established jurisprudence has interpreted Art. 113(1) EPC 1973 to mean that the comments presented must be considered in the ensuing decision (**J 7/82**, OJ 1982, 391). Thus a decision which explicitly fails to take into account potentially refutative arguments submitted by a party, i.e. arguments which may militate against or cast doubt on the decision in question, contravenes Art. 113(1) EPC 1973, thereby constituting a substantial procedural violation. In brief, a decision must show that all potentially refutative arguments adduced by a party are actually refutable.

There was no evidence in the decision that the examining division took the applicant's evidence and arguments into consideration. As stated in **T 763/04** "it is not sufficient to observe Art. 113(1) EPC 1973 merely formally by granting the applicant the procedural possibility for presenting comments, as was the case here. This procedural step fell short of its legislative purpose and remained a pure formality, if there was no trace in the file that such comments were indeed read and discussed on the merits, beyond a mere acknowledgement of their existence. In summary, Art. 113(1) EPC 1973 required not merely that a party be given an opportunity to voice comments, but more importantly it required that the deciding instance demonstrably hears and considers these comments." The board ruled therefore that the failure to take into due account a potentially refutative argument of the applicant when deciding the case deprived the applicant of its right to be heard in contravention of Art. 113(1) EPC 1973 and amounted to a substantial procedural violation.

On inadequate reasons given in the decision at first instance, and the circumstances in which reimbursement of the appeal fee is justified, see Chapter VII.E.17.

5.4. Signatures on a decision

In **T 390/86** (OJ 1989, 30) the board noted that although R. 70 EPC 1973 (now R. 113 EPC) states that "any communication from the EPO is to be signed by and to state the name of the employee responsible", there was nothing in R. 68 EPC 1973 (now R. 111 EPC) or elsewhere in the Convention which specifically required the decision of a first-instance department of the EPO (i.e. a decision which was open to appeal) to be signed by the employee or employees responsible. The board, however, having regard to the principles which were applicable, came to the conclusion that if the decision of a

particular division was to be legally valid it had to bear the signatures of the members who had been appointed to that division to decide the issue or issues which were the subject of the decision.

In **T 243/87** the decision was substantiated and issued in writing after oral proceedings. The decision was signed by two members who had taken part in the oral proceedings and by one who had not. The board ruled that the latter signature rendered the decision null and void. It ordered remittal to the department of first instance, and a refund of the appeal fee because a substantial procedural violation had occurred.

In **T 1170/05** the issue to be considered was whether the decision of the first instance, which bore the signatures of only two of the three members of the division (not bearing the signature of a deceased examiner), was to be regarded as legally valid. The written decision of the examining division (Form 2048 dated 15 March 2005) bore the signatures of the first examiner and of the chairman, who also signed on behalf of the deceased second examiner. In a handwritten and signed note, the chairman explicitly declared that the written grounds reflected those which had been discussed during the deliberation of the examining division, and which had led to the decision announced at the end of the oral proceedings. The board found that, the course of action taken by the examining division in the unfortunate circumstance of the case complied with the case law of the boards of appeal and, in particular, with decision **T 243/87**. As there was no reason to question the content of the chairman's handwritten declaration or to suspect that the minutes of the oral proceedings were not based on a draft made by the second examiner, the board assumed that the written grounds for refusing the application indeed reflected the deliberation of the examining division at the end of the oral proceedings, and that, in accordance with the cited case law of the boards of appeal, the contested decision was to be regarded as legally valid.

In **T 777/97** the appellant had requested correction of the description before the opposition division. The first examiner had signed the correction decision also on behalf of the division's absent chairman. The board ruled that the decision was valid.

In **T 999/93** the board held that if a decision of a particular division is to be legally valid, it must have been written on behalf of and represent the views of the members who were appointed to that division to decide the issues forming the subject of the decision, and it must bear signatures which indicate this.

In **D 8/82** (OJ 1983, 378) the board had to decide whether a signature was valid, where the surname appeared only as a mark in which one could still discern the first letter and which was recognisably intended as a signature. The board held that the signature was valid since in several contracting states of the EPO there is no requirement that a signature be legible or recognisably composed of letters. It is enough that it serves to identify the signatory.

In **T 225/96**, the file showed that the contested decision had been signed by only the first examiner on the opposition division, and not by its chairman, second examiner and legal member. The board sent the case back for regularisation. The division however replied

that the three non-signing members were not at this stage of the proceedings prepared to put their names to a text issued without their knowledge or approval.

The board decided that this response meant the division had not yet finalised a reasoned decision; the document sent to the parties was merely a draft from the first examiner. But to issue the parties with a draft decision not approved by all division members present at the oral proceedings was a substantial procedural violation. The board added that if, as it had first imagined, the signatures had merely been missing, this could have been corrected under R. 89 EPC 1973 (now R. 140 EPC) which allows correction of linguistic errors, errors of transcription and obvious mistakes in EPO decisions. It also noted that the forms accompanying the decisions are never signed, because they are computer-generated and therefore, under R. 70(2), first sentence, EPC 1973 (now R. 113(2) EPC), a seal may replace the signature. In general, the decision as notified to the parties is presumed to be authentic.

6. Correction of errors in decisions

6.1. General issues

In decisions of the EPO, only linguistic errors, errors of transcription and obvious mistakes may be corrected (R. 140 EPC, former R. 89 EPC 1973).

In **T 212/88** (OJ 1992, 28) the board held that the absence of a chairman's or minute-writer's signature at the end of an opposition division's decision was a rectifiable, obvious error within the meaning of R. 89 EPC 1973 (now R. 140 EPC). In the case in question a second examiner had been referred to in the minutes as a member of the opposition division, although in fact he was not a member and did not take part in the oral proceedings. The board held that correction of the two errors had to be by means of a decision under R. 89 EPC 1973 with retrospective effect from the date of the original decision. The same board emphasised the retrospective effect of corrections under R. 89 EPC 1973 in **T 116/90** but stated that it was unnecessary to re-date the decision as from the date of correction.

In **T 850/95** (OJ 1997, 152) the decision to grant under R. 51(6) EPC 1973 had been despatched when the applicant filed two additional pages of the description, which had been omitted due to a clerical error when the applicant filed a complete set of replacement pages for the text of the application, and requested their inclusion in the patent specification. He was informed that the technical preparations for the publication of the patent specification had been completed. The applicant requested that the patent be re-published incorporating the missing pages. The request for correction was refused by the examining division on the ground that the corrections specified did not relate to passages in the patent specification where the division wished to base its decision on a different text.

The board found that, according to the practice of the EPO, the decision to grant issued by the examining division (an electronically generated form) referred to the documents approved by the applicant under R. 51(4) EPC 1973, so that they became an integral

part of the decision to grant. It followed from this that errors in the specification might also be corrected under R. 89 EPC 1973 (now R. 140 EPC). The board held that, in a decision to grant, if the text given for grant was not and obviously could not be the text corresponding to the real intention of the examining division, there was an obvious mistake within the meaning of R. 89 EPC 1973, and the text erroneously indicated could be replaced by the text on which the examining division actually wanted to base its decision. The board noted that the filing of replacement pages for the whole specification should be avoided unless the extent of the amendments made it absolutely necessary.

In **T 425/97** in a note from the opposition division concerning a consultation by telephone it was stated that appellant II (patentee) had drawn the opposition division's attention to an obvious error in the minutes and in the decision. This consultation was followed by the dispatch by telefax of a revised version of the "Facts and submissions" and the "Reasons" of the decision and a revised form of the minutes. A new term for appeal was not set. In a short accompanying communication, the opposition division informed the parties that the correction was made according to R. 89 EPC 1973 (now R. 140 EPC), and had "become necessary because auxiliary request 7 and 8 obviously had been confounded". No trace of said auxiliary request 8 was however to be found in the foregoing history of the case. In the corrected form of the decision, a completely fresh text of the valid claim was enclosed. The minutes were corrected accordingly.

The board referred to **G 8/95** which dealt with the scope of R. 89 EPC 1973 (now R. 140 EPC), stating that the difference between an appeal against a decision and a request for correction of a decision may be seen in the fact that in the first case the remedy is directed against the substance of the decision and in the latter case against the form in which the decision was expressed. This means that it could be within the scope of R. 89 EPC 1973 to correct the text of the patent if it is not and cannot be in the form corresponding to the intention of the deciding instance (**T 850/95**, OJ 1997, 152). The board found however that, in the case at issue, the intention of the opposition division had apparently changed between the oral proceedings and the issue of the written decision in its original version. The claim on which the revised version of the decision was based was substantially different from the non-revised one. Moreover, the text of the minutes of the oral proceedings attached to the decision was not the original one, but was also modified to bring it into agreement with the decision. For these reasons, the original decision could not be revised under R. 89 EPC 1973 since the modifications introduced would change not only the form but its very substance.

In **T 212/97** the board pointed out that R. 89 EPC 1973 (now R. 140 EPC) permitted the opposition division to correct an obvious mistake in the copy of the decision notified to the parties. In the case at issue, a fourth person had been named as a member of the opposition division although no such person had been mentioned in the original document.

In **T 965/98** the board issued a decision orally on the basis of claims submitted during oral proceedings. However, during preparation of the written reasons, the appellant requested correction of an obvious error in the claims. The board agreed to the

correction under R. 88 EPC 1973 (now R. 139 EPC) and amended its original decision to take account of the correction under R. 89 EPC 1973.

In **T 867/96** the patentee had requested the correction under R. 89 EPC 1973 (now R. 140 EPC) of a sentence, in the reasons for a board of appeal decision, stating that all the parties had agreed that a certain document represented the closest prior art. The board pointed out that the case was closed, as *res judicata*, and therefore no longer before it. Citing in particular **G 8/95** (OJ 1996, 481) and **G 1/97** (OJ 2000, 322), the board held that only the board which had taken a decision could decide whether it required correction. Furthermore, establishing whether correction was necessary involved studying the facts, implying in general and up to a certain point that such requests were admissible. The current board thus ruled that the request for correction was admissible. However, it also held that this particular request did not fulfil the requirements of R. 89 EPC 1973, was unfounded and should therefore be refused.

In **T 367/96** the board noted that according to decision **G 1/97** (OJ 2000, 322), R. 89 EPC 1973 should be limited to its narrow wording. Accordingly, R. 89 EPC 1973 (now R. 140 EPC) only allows for correction of formal errors in the written text of the decision notified to the parties in accordance with R. 68 EPC 1973 (now R. 111 EPC). R. 89 EPC 1973 does not however pave the way to reexamination of the factual or legal issues on which a decision is based, nor to reversal of any conclusion derived by the deciding body from a consideration of these issues.

In **T 1093/05** (OJ 2008, 430) the examining division had issued a communication under R. 51(4) EPC 1973 dated 30 June 2003. This included amendments it had made to the claims and the description of its own motion. In a letter the applicant said the examining division's proposed amendments were totally unacceptable and asked that the patent be based on the original claims. Subsequently, the grant decision was issued without having seen the applicant's reply. It stated that a patent was being granted with the documents indicated in the communication pursuant to R. 51(4) EPC 1973 dated 30 June 2003. The patentee asked for the grant decision to be corrected under R. 89 EPC 1973 (now R. 140 EPC) so as to enable the patent to be granted with the text agreed by the patentee and for publication of a duly corrected specification. The board noted that the appellant was challenging the substance of the grant decision, which should not have been issued the way it was. However the right way to do that would have been to appeal against it. The correction request could not succeed because it challenged the form of the grant decision, and the examining division wanted to issue it in that form. In the case at issue no appeal against the grant decision was filed. Instead, the appellant chose to request correction under R. 89 EPC 1973. But this case did not fulfil the conditions of that rule, since it was not an obvious mistake, because the examining division did not want to base its decision on the original claims.

6.2. Errors in the printed version of the European patent specification

In **T 150/89** some printing errors in the published patent specification were found which were not present in the version accepted by the EPO. The board found that such omissions should normally be corrected as a matter of routine. The decision to grant was

legally binding as regards existence and scope of the patent (Art. 97 EPC 1973). The specification reproduced that decision (Art. 98 EPC 1973). It was an official document published by a public authority for general information, and as such had legal force before the courts. It was therefore subject to the same correction criteria as the grant decision itself under R. 89 EPC 1973 (now R. 140 EPC). That provision did not cover matters of fact or substance; only obvious errors could be corrected. The EPO could make such corrections **on request or of its own motion**. Thus the specification was to be brought into line with the decision to grant, and whether this took the form of a reprint or a corrigendum (which was a matter for the department of first instance, or possibly its formalities officer, to decide) should clearly indicate the correction made.

In **T 55/00** the examining division had sent a "Communication under R. 51(4) EPC 1973" to the representative of the appellant. The enclosed documents contained only pages 1 to 40 of the description. However, the text of the communication did not take into account the intention of the examining division to omit pages 41 to 44 of the description. The appeal was against the decision of the examining division to refuse the appellant's request for correction of errors under R. 89 EPC 1973 (now R. 140 EPC). He had requested the issue of a corrected patent specification.

The board held that a correction under R. 89 EPC 1973 was not possible, because the non-inclusion of pages 41 to 44 of the description was due to the discretion of the examining division and not to any error. The board held that because the Convention does not provide for any possibility to amend or revoke a patent once granted - except as a result of an opposition procedure - and because the patent proprietor is not allowed to file a notice of opposition against his own patent, it is very important to check the decision and documents. The appellant had had the opportunity to check the documents as a complete set. The board held that the EPO complied with the requirements of R. 51(4) EPC 1973 not only in communicating the text on form 2004 but also in enclosing a complete set of the relevant documents. The text on form 2004 indicated explicitly that "a copy of the relevant documents is enclosed". The enclosed documents also formed a relevant part of the communication. It was therefore not sufficient to check only whether the documents enclosed were the documents referred to in the communication; the contents of the relevant documents had also to be checked.

6.3. Competence to correct a decision under Rule 140 EPC (former Rule 89 EPC 1973)

In **G 8/95** (OJ 1996, 481) a question of law was referred to the Enlarged Board of Appeal to decide which board of appeal (either the technical board or the Legal Board) was competent to decide on appeals from a decision of an examining division refusing a request under R. 89 EPC 1973 (now R. 140 EPC) for correction of the decision to grant. In the view of the Enlarged Board, the **basis** of such a request for correction was not that the party was not granted what it had requested. Rather, such a request was based on the allegation that there was a linguistic error, error of transcription or similar obvious mistake.

The Enlarged Board noted that the competence to correct errors in a decision under R. 89 EPC 1973 (now R. 140 EPC) lay with the body which had given the decision. Hence, in the examination procedure the examining division had to decide on a request to correct errors in the decision to grant. If the request for correction of the decision to grant concerned the grant of the patent, then the decision on the correction had also to concern the grant of the patent, since it was the request of the party which defined the subject of the dispute. The Enlarged Board also agreed with the statement made in **J 30/94** (OJ 1992, 516) that it was the decision to refuse the request for correction which was under appeal. According to the Enlarged Board, this did not alter the subject of the dispute before the second instance. The decisive criterion in Art. 21(3)(a) EPC 1973 was not that the decision under appeal was itself the decision to grant. It was sufficient for the decision to "concern" the grant, and this was necessarily the case if the subject of the decision was the text in which the patent was to be or had been granted, since this was the result of the substantive examination and defined the rights conferred by the patent. The Enlarged Board came to the conclusion that the decision refusing a request for correction of the decision to grant concerned the grant of the patent. It was, therefore, the technical boards as defined in Art. 21(3)(a) and (b) EPC 1973 which had to decide on appeals from a decision of an examining division refusing a request under R. 89 EPC 1973 for correction of the decision to grant.

In **J 12/85** (OJ 1986, 155) the board noted that the existence of inconsistencies in the decision to grant a patent might be a ground for filing a request for correction based on R. 89 EPC 1973 (now R. 140 EPC). However, a board of appeal could only examine appeals from decisions of other instances of the EPO (Art. 21(1) EPC 1973). Thus it could not examine a request for a correction of the decision under appeal based on R. 89 EPC 1973. A decision on such a request had first to be taken by the department of first instance before the matter could be referred to a board of appeal. The board further noted that inconsistencies did not affect the validity of the decision to grant the patent nor imply that the appellant was "adversely affected" by this decision.

In **J 16/99** the board held that when correction of the priority date of a granted patent is requested, there may be a case for correction under R. 89 EPC 1973 (now R. 140 EPC) of the EPO's decision to grant. The board found that R. 89 EPC 1973 was applicable since, being applicable to errors of transcription and obvious mistakes in a decision of the EPO, it allowed the correction of errors in, inter alia, decisions to grant, without the limiting requirement that proceedings be pending.

The board also found that the formalities officer who had taken the decision under appeal had no authority to take a decision under R. 89 EPC 1973. Such decisions had to be made by the examining division (see **G 8/95**, OJ 1996, 481), and were not one of the category of decisions which could be delegated to formalities officers (see the Notice of the Vice-President of DG 2 of the EPO, OJ 1984, 317, as revised by the further Notice, OJ 1989, 178 - the version applicable at the time of the decision under appeal - and again revised, with no effect on the point at issue here, by Notice in OJ 1999, 504).

During the opposition proceedings, the respondent in **T 226/02** had requested a correction to the description of the patent as granted under R. 88 EPC 1973 (now R. 139

EPC). The tenor of the written decision, which was signed by the members of the opposition division, was that the opposition was rejected. The written grounds for the decision included a section at the end under the rubric "Decision". In this section it was indicated that the opposition was rejected and that the description of the patent was amended according to R. 89 EPC 1973 (now R. 140 EPC). The board considered that the opposition division acted *ultra vires* in taking a decision under R. 89 EPC 1973 to correct a decision of the examining division. The board held that only the body which took a decision was entitled to correct that decision to the form which the body had intended the decision should take. Thus, only the examining division was entitled to correct its own decision.

7. Principles for the exercise of discretion

In **J 4/87** the appellant submitted that there was nothing in the Convention which prevented the EPO from exercising discretion in cases of exceptional delay in the post. The board, however, held that as a matter of law the EPO had no general discretion as suggested by the appellant. The EPO could only exercise discretion if the power to do so could be derived from the Convention.

In **J 20/87** (OJ 1989, 67) the Receiving Section had rejected a request for a partial refund of the European search fee. In the reasons for its decision it was stated, *inter alia*, that the criteria for the refund of the European search fee were defined in Art. 10 RFees and these did not leave room for any discretion in favour of the applicant. In the case in question, these criteria had not been fulfilled. The board confirmed the finding of the Receiving Section and found that there was no support anywhere for the idea that the EPO was entitled to exercise any general discretion based on equity in respect of refunding the fee for the European search report. In fact, the existence of such a discretionary power could lead to serious difficulties in practice, bearing in mind the very large number of applications before the EPO and the great variety of possible borderline cases to be considered individually on such a general basis.

In **T 182/88** (OJ 1990, 287) the board clarified its case law concerning the exercise of the discretion given to EPO departments. The board held that when exercising discretion, whether for or against a particular party, the reasons for the exercise of that discretion should be given. In any case where the Convention gave discretion to a department of the EPO in relation to an issue in proceedings before it, general principles of law required such discretion to be exercised having regard to the factors which were relevant to that issue. Those factors were in turn determined by considering the purpose of the exercise of the discretion in its context, and in the context of the Convention as a whole (see **T 183/89**). The board stressed that discretion had always to be exercised on a case-by-case basis, having regard to the particular circumstances. Discretion had always to be exercised judicially, by taking into account those factors which were legally relevant to the issue in question and ignoring those which were not. Showing consideration to parties before the EPO should not be confused with the proper exercise of discretion according to law.

The board made it clear that where the Convention had given discretion to a department of the EPO in relation to proceedings at first instance before it, such discretion was normally best exercised by the department of first instance, because it had control over the proceedings and should be aware of all the factors which were relevant to the exercise of its discretion. Furthermore, once a department of first instance had exercised its discretion, in any appeal against a decision involving the exercise of that discretion a board of appeal was normally reluctant to interfere with such a decision, unless the reasoning in the decision had clearly been based on wrong principles.

In **G 7/93** (OJ 1994, 775) the Enlarged Board stated that if an examining division had exercised its discretion under R. 86(3) EPC 1973 (now R. 137 EPC) against an applicant in a particular case and the applicant filed an appeal against the way in which discretion had been exercised, it was not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, in order to decide whether or not it would have exercised its discretion in the same way as the department of first instance. If a department of first instance was required under the Convention to exercise its discretion in certain circumstances, it should have a certain degree of freedom when doing so, without interference from the boards of appeal. In the circumstances of a case such as that before the referring board, a board of appeal should only overrule the way in which a department of first instance had exercised its discretion if it came to the conclusion either that the department had not exercised its discretion in accordance with the proper principles as set out above, or that it had done so in an unreasonable way, and had thus exceeded the proper limits of its discretion (see also **T 640/91**, OJ 1994, 918).

8. Legal status of the Guidelines for Examination in the EPO

In **T 162/82** (OJ 1987, 533) and **T 42/84** (OJ 1988, 251), two boards of appeal ruled on the discretionary power of examining divisions to depart from the EPO Guidelines. According to these two decisions, the Guidelines were only general instructions intended to cover normal occurrences. Thus, an examining division could depart from them provided it acted in accordance with the EPC 1973. In reviewing the decision of an examining division, a board of appeal would wish to ensure uniform application of the law and judge whether the division had acted in accordance with the Convention, not whether it had acted in accordance with the Guidelines.

In **T 647/93** (OJ 1995, 132) the board stated that it was normally desirable for examining divisions to act in accordance with the Guidelines, but pointed out that these were not rules of law, so failure to follow a procedure set out in them was not in itself a substantial procedural violation (**T 51/94**, **T 937/97**).

In **T 1561/05** the board confirmed that the Guidelines for Examination in the European Patent Office were not binding on the boards of appeal (applying **T 162/82**, OJ 1987, 533).

9. Duties not entrusted to formalities officers

In **T 161/96** (OJ 1999, 331) the appellant requested that the opposition fee be considered to have been paid in due time and that the notice of opposition I be deemed to have been filed validly within the opposition period. He applied for a decision by the EPO under R. 69(2) EPC 1973 (now R. 112(2) EPC). The appellant was informed under R. 69(2), second sentence, EPC 1973 by a formalities officer of the opposition division that no loss of rights had occurred. The opposition division later rejected opposition I as inadmissible.

The board held that the **act of informing** an opponent under R. 69(2), second sentence, EPC 1973 (now R. 112(2) EPC) did not belong to the duties entrusted to formalities officers of the opposition divisions by virtue of the powers transferred to the Vice-President of Directorate-General 2 of the EPO by order of the President of the EPO dated 6.3.1979, under R. 9(3) EPC 1973 (see Notice dated 15.6.1984, OJ 1984, 319, as revised and supplemented on 1.2.1989, OJ 1989, 178; now Decision dated 12.7.2007; OJ SE 3/2007, 107). The appellant was not therefore entitled to rely on the formalities officers's communication that no loss of rights had occurred.

In **T 808/03** the purported decision to grant *restitutio in integrum* in relation to the filing of the notice of appeal was made by a formalities officer acting on behalf of the examining division pursuant to R. 9(3) EPC 1973 and the Notice of the Vice-President of Directorate-General 2 dated 28.4.1989 (OJ 1999, 504). Item 11 of this notice entrusted formalities officers with "Decisions as to applications under Art. 122(4) EPC 1973, where the application could be dealt with without the further taking of evidence under R. 72 EPC 1973". Art. 122(4) EPC 1973 vested jurisdiction for deciding on applications for *restitutio in integrum*, and provided that: "The department competent to decide on the omitted act shall decide on the application."

The board noted that the omitted act was the filing of a notice of appeal and the department competent to decide whether an appeal was admissible and thus *inter alia* whether a notice of appeal met the requirements of the EPC 1973 was the board of appeal of the EPO (R. 65(1) EPC 1973; see **T 949/94** of 24.3.1995 and **T 473/91**, OJ 1993, 630). This competence in relation to admissibility of an appeal was, however, subject to an exception, since Art. 109(1) EPC 1973 empowered the department of first instance in *ex parte* proceedings to set aside its own decision if it considered an appeal to be "admissible and well-founded".

The board observed that this did not constitute full jurisdiction to decide whether an appeal was admissible; there was no power to decide that an appeal was not admissible, nor was there power to decide that an appeal was admissible but not well-founded. There was only the limited power to set aside *uno actu* its own decision if the appeal was considered admissible and well-founded. Moreover, the board found that even if it were considered that the examining division, acting under the limited jurisdiction over admissibility vested in it by Art. 109(1) EPC 1973, qualified as "the department competent to decide on" the due filing of a notice of appeal within the meaning of Art. 122(4) EPC 1973, this power would not be susceptible of being split and partially

entrusted to a formalities officer for "decision" pursuant to item 11 of the notice of the Vice-President of DG2 referred to above. For these reasons it was decided to declare the purported decision of the department of first instance to allow the request for *restitutio in integrum* null and void.

10. Jurisdiction

In **J 42/92** the board had to decide whether a request under R. 88, second sentence, EPC 1973 could be made after grant. It came to the conclusion that a request under R. 88 EPC 1973 (now R. 139 EPC) for amendments to the description or claims could only be filed during the pendency of application or opposition proceedings. Under Art. 97(4) EPC 1973, the decision to grant a European patent took effect on the date on which the European Patent Bulletin mentioned the grant. After that date, R. 88 EPC 1973 could only be applied while opposition proceedings were pending.

The board also pointed out that there was no reason why, once no application or opposition proceedings were pending before the EPO, decisions on the question of corrections (bearing in mind the requirement of obviousness to a skilled person) should not fall within the sole jurisdiction of the national courts or other authorities responsible for proceedings in which this question might arise (see also **T 777/97**).

K. Other procedural questions

1. Language privilege

1.1. General

According to the revised Art. 14(2) EPC, a European patent application shall be filed in one of the official languages or, if filed in **any other language**, translated into one of the official languages. The new words "any other language" imply that an application may be filed in any language in accordance with Art. 5 PLT, which states that, for the purpose of obtaining a filing date, a description of the invention in a language of the applicant's choice must be accepted. Natural or legal persons having their residence or principal place of business within the territory of a contracting state having a language other than English, French or German as an official language, and nationals of that state who are resident abroad, may file documents which have to be submitted within a given time limit in an official language of that state, according to Art. 14(4) EPC (Art. 14(2) and (4) EPC 1973). These persons thereby become entitled to a fee reduction under R. 6(3) EPC (R. 6(3) EPC 1973). The EPC 2000 provides that the fee reductions also apply to requests for limitation or revocation under Art. 105a EPC and to petitions for review under Art. 112a EPC.

In **G 6/91** (OJ 1992, 491) the Enlarged Board of Appeal ruled that the persons concerned were only entitled to the fee reduction under R. 6(3) EPC 1973 if they filed the **essential item of the first act** in filing, examination, opposition or appeal proceedings in an official language of the state concerned other than English, French or German, and supplied the necessary translation no earlier than simultaneously with the original.

This principle has since been applied in a number of decisions, for example in **T 367/90** of 3.6.1992, **T 385/90** and **T 297/92**. See also the decisions below.

1.2. European patent application

In view of the fact that applications may be filed in any language, the special provisions under Art. 14(4) EPC for applicants from contracting states with a language other than English, French or German as an official language are no longer applicable to the filing of the application itself, but only to subsequently filed documents.

These decisions concern the application of the EPC 1973.

In **J 7/80** (OJ 1981, 137) the Legal Board of Appeal held that where documents making up an application were partly in an official language of the EPO and partly in another language which was an official language of a contracting state, then, for the purposes of deciding whether the application complied with Art. 14(1) or (2) EPC 1973, in accordance with Art. 80(d) EPC 1973, the significant language was that used for the description and claims. Other documents making up the application should normally be corrected by translation into that language.

In **G 6/91** (OJ 1992, 491) the Enlarged Board of Appeal ruled that, to be able to claim the fee reduction it was sufficient for the **notice of appeal** to be filed as the essential item of the first act in appeal proceedings in an official language of a contracting state and be translated into one of the official languages of the EPO. Subsequent items, such as the statement of grounds of appeal, could then also be filed in an EPO official language.

In **J 15/98** (OJ 2001, 183) the board decided that, where a patent application was filed in one of the languages referred to in Art. 14 EPC 1973, a **date of filing** was to be attributed under Art. 80 EPC 1973, irrespective of the fact that the applicant had neither its residence nor principal place of business in a contracting state nor was a national of a contracting state, provided that all the other requirements of Art. 80 EPC 1973 were satisfied. The board in **J 6/05** did not concur with this view. According to this decision, until the revised EPC 2000 entered into force, an application filed in an official language of a contracting state other than English, French or German, e.g. in the Finnish language, did not produce the result provided for in Art. 80 EPC 1973, i.e. no date of filing was attributed, if the other conditions provided for in Art. 14(2) EPC 1973, namely the applicant having its residence or principal place of business within the territory or being a national of that (same) contracting state (here, Finland), were not fulfilled (see also **J 9/01**).

Under the EPC 2000, the wording of Art. 14 EPC implies that an application may be filed in any language. However, a translation into an official language must be filed. According to Art. 14(2) EPC, if a required translation is not filed in due time, the application shall be deemed to be withdrawn.

1.3. Examination proceedings

In **J 21/98** (OJ 2000, 406) the appellant (patent applicant), who had filed a **request for examination** in Italian within the time limit provided for under Art. 94(2) EPC 1973, and a simultaneous English translation, had been refused the 20% reduction in the examination fee pursuant to Art. 14 EPC 1973. According to the Receiving Section, the written request for examination in the Italian language should have been filed together with the request for grant. However, according to the board, Art. 94(2) EPC 1973, in connection with Art. 75, Art. 92 and Art. 94(1) EPC 1973, was to be interpreted such that, within the grant procedure, the request for examination constituted an **autonomous step** quite separate from the (previous) step of filing the patent application, enabling the applicant to consider whether to continue the grant procedure in the light of the search report. Since the EPC 1973 gave the applicant the right to file the request for examination after the publication of the search report, it followed that the same right had to be owed to the applicant who wanted to avail himself of the option provided for in Art. 14(2) and (4) EPC 1973 (see also **J 22/98**, **J 6/99**, **J 14/99** and **J 15/99**).

The right to file the request for examination after the publication of the search report can now be found in R. 70(1) EPC.

In **J 36/03** the board held that the examination fee should be reduced if the request for examination was filed in an authorised non-official language, even in cases where the **application was transferred, before the examination fee was paid**, to an applicant who was not one of the persons referred to in Art. 14(2) EPC 1973.

1.4. Opposition proceedings

As far as opposition proceedings are concerned, the board decided in **T 290/90** (OJ 1992, 368) that to be granted a 20% reduction in the opposition fee under R. 6(3) EPC 1973, that part of a notice of opposition which was governed by R. 55(c) EPC 1973 (R. 76(2)(c) EPC) should always be filed in a non-official authorised language. It was inadmissible for a German opponent to file an opposition in the Dutch language even if represented by a Dutch patent attorney (**T 149/85**, OJ 1986, 103).

1.5. Appeal proceedings

In **T 1152/05** the notice of appeal was filed in Dutch by a company which had its principal place of business in the US and thus could not benefit from the provisions of Art. 14(4) EPC. A translation into French was filed on the same day. The notice of appeal was, in accordance with Art. 14(4) EPC, deemed not to have been filed. Following **G 6/91** (OJ 1992, 491), where the translation was filed at the same time as the original, the EPO could not take it as the "official" notice of appeal and ignore the original as superfluous.

1.6. Request for or notification of fee reduction

In **T 905/90** (OJ 1994, 306, Corr. 556) it was held that neither a request for a fee reduction, nor a notification that only a reduced fee had been paid, was an essential part

of the first act of the relevant proceedings. This was in contrast to the **notice of appeal**, which, although linguistically insensitive, was clearly essential to appeal proceedings (applying **G 6/91**; see also **J 4/88**, OJ 1989, 483).

1.7. Translations

Under Art. 14(4) EPC, those entitled to file in an official language of a contracting state under that sub-paragraph must supply a translation in English, French or German in accordance with the Implementing Regulations.

Several decisions have dealt with the legal consequences of failure to comply with a time limit for filing a translation in an official language. Where the applicant failed to observe the time limit provided for in Art. 14(2) EPC 1973 in conjunction with R. 6(1) EPC 1973, the application was **deemed withdrawn** under Art. 90(3) EPC 1973 (**J 18/01**). According to **T 323/87** (OJ 1989, 343) and **T 193/87** (OJ 1993, 207) respectively, a notice of appeal or a notice of opposition was deemed not to have been received under Art. 14(5) EPC 1973 (now **deemed not to have been filed**, Art. 14(4) EPC). However, in **T 126/04** the board did not follow **T 323/87** with respect to the legal consequence of failure to comply with the time limit. It held that the only possible interpretation of the reference in R. 65(1) EPC 1973 to R. 1(1) EPC 1973, which itself referred to Art. 14(4) EPC 1973, was that R. 65(1) EPC 1973 determined the legal consequence of failure to file a translation of the notice of appeal as required by Art. 14(4) EPC 1973. The legal consequence was therefore the **inadmissibility of the appeal**. It was not a case of conflict within the meaning of Art. 164(2) EPC 1973, since R. 65(1) EPC 1973 was a *lex specialis*.

In the EPC 2000, the provisions of R. 65(1) EPC 1973 are now to be found in R. 101(1) EPC, which does not refer to R. 3(1) EPC, the equivalent to R. 1(1) EPC 1973.

In **T 170/83** (OJ 1984, 605) a debit order was filed in error in Dutch. The board held that Art. 14 EPC 1973 did not apply - a debit order did not have to contain text in a language at all, whilst remaining quite clear. The question whether a debit order in a non-official language was effective therefore did not arise.

In **T 700/05**, the board found that, taking into account that Euro-PCT applications were deemed by Art. 153(2) EPC to be European applications and the principle that they thus had to be treated as favourably as applications made in a Contracting State, a PCT application originally filed in Japanese had to be treated in the same way as an application filed in the language of a Contracting State which language was not an official language of the EPC. The provision of Art. 14(2) EPC 1973 had thus to be applied by analogy to allow also the translation into English of an original PCT application in Japanese to be brought into conformity with the original Japanese text of the application throughout the proceedings before the EPO, i.e. also including opposition and appeal proceedings.

2. Inspection of files

2.1. General

Art. 128 and 93(1) EPC have not been changed in substance. Art. 128(5) EPC is amended such that the particulars which the EPO may communicate to third parties or publish can be specified in the Implementing Regulations.

According to **J 5/81** (OJ 1982, 155), under Art. 128 EPC 1973, the confidential treatment of patent applications ceases on publication of the application, not on expiry of the 18-month period mentioned in Art. 93(1) EPC 1973.

Any person who can prove that the applicant has invoked the rights under the European patent application against him may obtain inspection of the files **before the publication of the application** and without the consent of the applicant under Art. 128(2) EPC. According to **J 14/91** (OJ 1993, 479), these rights could be said to have been invoked where the invocation of rights was formulated in relation to the first filing in a contracting state but the subsequent European application was mentioned at the same time. Any dispute between the applicant and a third party concerning the latter's right to inspect the files pursuant to Art. 128(2) EPC 1973 was best decided in oral proceedings convened at short notice.

In **J 27/87** the board confirmed the Receiving Section's decision to refuse a request pursuant to Art. 128(2) EPC 1973, because there was no proof that the applicants had invoked their rights under the application against the appellants. The extracts from correspondence in which the applicants' representative asserted that his clients had developed a new technology and mentioned the patent application were not deemed sufficient evidence.

Where a priority document reached the EPO in time, but was actually filed by a third party in connection with another application, the board held that the priority claim was lost. One reason given was that R. 38(3) and R. 104b(3) EPC 1973 (at the date of the decision R. 111(2) EPC 1973 and now R. 163(2) EPC) ensure that a certified copy of the previous application is available to third parties requesting inspection of the file. This would clearly not be the case where a document is included only in a completely unrelated file (**J 11/95**).

In the case before the board in **T 1101/99**, the opponent (appellant) requested inspection of the files under Art. 128 EPC 1973 in respect of documents arising from the international preliminary examination. The appellant's request was not directed to the IPEA but to the EPO acting, after grant of the patent, outside its PCT functions. A **formalities officer** acting for the opposition division rejected the request for inspection of the file. The board noted that the term 'granting of inspection' set out in the Notice of the Vice-President of DG 2 of the EPO concerning the entrustment to formalities officers of certain duties normally the responsibility of the opposition divisions of the EPO (dated 28.4.1999, OJ 1999, 504, point 13) apparently referred only to a positive decision, whereas in the decision under appeal the request for inspection was rejected. The board

found that there was no justification for interpreting the delegation of duties beyond its actual wording such that it would also cover the rejection of requests for file inspection.

2.2. Exclusion from inspection under Rule 144 EPC

R. 144 EPC (previously R. 93 EPC 1973) indicates those parts of the file which are to be excluded from inspection pursuant to Art. 128(4) EPC.

In **T 811/90** (OJ 1993, 728) the board held that filed documents which, following a substantial procedural violation, were to be withdrawn from the part of the file available for public inspection and which did not fall under the exclusions listed in R. 93 EPC 1973 had to be returned to the filing party if it so requested. Similarly, documents marked "confidential" which did not belong to classes of documents to be excluded from file inspection were returned to the party concerned without note being taken of their contents (**T 516/89**, OJ 1992, 436; see also the later decision of the President of the EPO, OJ 2001, 458). See also **T 760/89** (OJ 1994, 797) in chapter VI.H.3.4 (keeping of evidence).

In **T 50/99** the appellant put forward plausible commercial reasons for keeping a contract and its English translation in a non-public part of the appeal file. The respondent did not object and the decision of the board did not depend on the documents. The request was granted.

In **T 264/00** two internal documents, belonging respectively to the appellant and to the respondent and concerning the outcome of a confidential meeting between two of their employees, contained confidential information on the conception, manufacture and marketing of some of the respondent's products. The board held that the dissemination of this information might effectively be prejudicial to legitimate economic interests. Pursuant to R. 93(d) EPC 1973, therefore, the documents had not been made available to the public.

In **T 379/01** the board stressed that the provisions concerning the exclusion of documents from file inspection stipulated exceptions from the principle of public inspection of files pursuant to Art. 128(4) EPC 1973, thus requiring a **narrow construction** of those provisions. Pursuant to the decision of the President of the EPO dated 7.9.2001 concerning documents excluded from file inspection (OJ 2001, 458), documents had to be excluded from file inspection at the reasoned request of a party only if their inspection would be prejudicial to the legitimate personal or economic interests of natural or legal persons. The board concluded that a merely **abstract** prejudice to hypothetical personal or economic interests was not a sufficient bar. The party requesting such exclusion should rather show that public access to certain documents would be prejudicial to specific and concrete personal or economic interests.

3. Register of Patents

3.1. General

Art. 127 EPC has been redrafted in order to clarify that the Register kept by the EPO is called, "European Patent Register". It is also now clarified that the Implementing Regulations specify in detail which particulars of European patent applications and patents, including the proceedings concerning them, are to be recorded in the European Patent Register (see R. 143 EPC). There is no change in substance. The provisions of R. 92(1) EPC 1973 can now be found in R. 143(1) EPC. However, the EPC 2000 introduces two new procedures which have to be mentioned in the European Patent Register:

- the request for limitation or revocation of a European patent (Art. 105a to 105c EPC), and
- the petition for review by the Enlarged Board of Appeal (Art. 112a EPC).

According to **J 5/79** (OJ 1980, 71), no entries could be made in the Register of Patents prior to publication of the European patent application (Art. 127 EPC 1973). Even in the case of published applications, R. 92(1)(u) EPC 1973 provided that the date of re-establishment of rights was to be entered only if loss of the application (R. 92(1)(n) EPC 1973) or the revocation of the patent (R. 92(1)(r) EPC 1973) had been entered in the Register.

An entry in the Register of European Patents recording the withdrawal of a patent application fulfilled the same function as a publication in the European Patent Bulletin in that it amounted to a notification to the public (**J 25/03**, OJ 2006, 395; see also **J 14/04** and **J 12/03**).

3.2. Registration of licences

As to the recording in the Register of European Patents of an exclusive licence under a patent **already granted**, the Legal Board of Appeal ruled in its decisions **J 17/91** (OJ 1994, 225) and **J 19/91** that registration was no longer possible once the patent had been granted because the EPO had renounced jurisdiction in favour of the national offices of the contracting states designated in the request for grant.

3.3. Transfer

Art. 72 EPC provides that an assignment of a European patent application must be made in writing and requires the signatures of the parties to the contract. This Article remains unchanged under the EPC 2000. Under R. 22 EPC (R. 20(1) EPC 1973), a transfer of a European patent application is recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the EPO that the transfer has taken place. This is in line with the PCT system (R. 92bis.1 PCT). The

new wording of R. 22(1) EPC does not imply any change of practice with respect to the standard of evidence required if transfers are to be registered.

In **J 38/92** and **J 39/92** the Legal Board of Appeal ruled that a transfer could only be recorded in the Register of European Patents on the basis of an official document in accordance with R. 20(1) EPC 1973 (previous version) if that document **directly** verified the transfer. It did not suffice if a judgment was submitted which mentioned another document from which it was possible to verify the transfer.

Assessing whether there were documents satisfying the EPO that a transfer had taken place in accordance with R. 20(1) and (3) EPC 1973 and making the entry in the register was the responsibility of the relevant department of first instance. Accordingly, in appeal proceedings, substitution of another party for the original applicant was possible only once the relevant department of first instance had made the entry or where there was clear-cut evidence of a transfer (**J 26/95**, OJ 1999, 668; see also **T 976/97**).

In **J 12/00** the board summarised the preconditions for registering a transfer of a European patent application as follows: (i) a request of an interested party (R. 20(1) EPC 1973); (ii) the production of documents satisfying the EPO that the transfer has taken place (R. 20(1) EPC 1973); and (iii) the payment of an administrative fee (R. 20(2) EPC 1973). The case at issue concerned an invention by an employee whose rights to the patent had allegedly been automatically transferred to the employer. Documents were produced specifying the obligation, but, according to the board, these only created the obligation to assign rights but did not constitute the assignment itself. Moreover, certain inventions were exempt from the obligation to transfer. Other documents produced concerned registrations in different countries on the basis of documents other than assignment documents. The board stressed that the specific requirements of the EPC 1973 defined what was required for the registration of a transfer of rights before the EPO, so there was no point in showing what might or might not be sufficient for another patent office in cases of the transfer of rights.

Arts 20, 21 and 106(1) EPC 1973 remain substantively unchanged under the EPC 2000. Under Art. 20 EPC the Legal Division is responsible for decisions in respect of entries in the Register of European Patents and their deletion. An appeal lies to the Legal Board of Appeal, not to a technical board (Art. 106(1) and Art. 21(2) EPC). The entitlement of the patent proprietor entered in the Register of Patents may not therefore be questioned in opposition and subsequent appeal proceedings (see **T 553/90**, OJ 1993, 666).

A transfer can be recorded in the Register of European Patents even after deemed withdrawal of a patent application, if it is still possible that restitutio is available and the successor in title has taken, together with his request for registering the transfer, procedural steps suitable for restoring the application (**J 10/93**, OJ 1997, 91).

4. Stay of proceedings under Rule 14(1) EPC

R. 13 EPC 1973 has been streamlined and renumbered as R. 14 EPC. In the revised Art. 97 EPC formal requirements have been transferred to the Implementing Regulations.

4.1. Rule 14(1) EPC (Rule 13(1) EPC 1973)

4.1.1 General

Under R. 14(1) EPC the EPO must stay the proceedings for grant ex officio if a third party provides it with evidence (under the EPC 1973, 'proof') that he has instituted proceedings against the applicant seeking a decision within the meaning of Art. 61(1) EPC (see **J 28/94**, OJ 1997, 400; **T 146/82**, OJ 1985, 267 and **J 10/02**), unless the third party communicates to the EPO in writing his consent to the continuation of such proceedings. The patentee will not be heard but may file a request with the Legal Division not to suspend proceedings. An appeal may be filed against the Legal Division's decision adversely affecting the applicant, proprietor or third party respectively (**J 28/94**, OJ 1997, 400).

Decision **J 15/06** followed **J 28/94** (OJ EPO 1997, 400). The communication ordering suspension was considered to be a preliminary procedural measure "sui generis" which was justified as a preventive measure to preserve the third party's possible rights to the patent in dispute and took immediate effect.

The respondent's withdrawal of its request for suspension of the proceedings significantly changed the procedural situation in the appeal proceedings. There was no provision in the EPC 1973 that the withdrawal of a request for suspension had the effect that the suspension was automatically terminated. However, the existence of a legitimate interest of a third party was an unwritten prerequisite for a further stay of the proceedings under R. 13 EPC 1973. The withdrawal was therefore equivalent to and to be interpreted as consent to the continuation of the proceedings pursuant to R. 13(1) EPC 1973. See also **J 18/06**.

A decision of the examining division to grant a European patent (Art. 97(2) EPC 1973) did not take effect on the date the decision-making process following written proceedings before that division was completed, but on the date on which the European Patent Bulletin mentioned the grant (Art. 97(4) EPC 1973). In the interim period, **proceedings for grant** were still **pending** before the EPO and a request for suspension of proceedings under R. 13 EPC 1973 was admissible (**J 7/96**, OJ 1999, 443). See also **J 33/95** of 18.12.1995 and **J 36/97** both also referred to in **J 15/06**. In both these decisions, the competence of the EPO to order suspension pursuant to R. 13(1) EPC 1973 after the publication of the mention of the grant of a patent was acknowledged provided that an allowable request had been filed before the publication. Suspension of the proceedings for grant meant that the legal status quo existing at the time they were suspended was maintained, i.e. neither the EPO nor the parties might validly perform any legal acts while the proceedings were suspended (**J 38/92** and **J 39/92**).

In **J 10/02** the appellant argued that in the case where an appeal was lodged against a decision to suspend grant proceedings, the provision of R. 13 EPC 1973 appeared to be in conflict with the provisions of Art. 106(1) EPC 1973 (unchanged under the EPC 2000). The board, however, pointed out that the suspensive effect of an appeal served to provide an appellant with provisional legal protection in the sense that no action should be taken to implement the decision of the department of first instance in order not to deprive the appeal of its purpose. However, if the grant proceedings were continued and the appellant were to arrive at a definitive end to the grant proceedings in its favour, this would be more than the appellant could achieve if it succeeded with the appeal under consideration.

4.1.2 Opening of proceedings before a national court

According to **T 146/82** (OJ 1985, 267), suspension had to be ordered if satisfactory proof of the opening of relevant proceedings before a national court was given to the EPO by a third party, provided that the European patent application had not been withdrawn or was not deemed to have been withdrawn.

In **J 6/03** the legal board held that R. 13(1) EPC 1973 referred to proceedings which resulted directly, i.e. generally and automatically, in decisions mentioned in Art. 61(1) EPC 1973. The provision was therefore not applicable in respect of decisions of courts of third states (here, Canada).

In **J 36/97** the board held that in connection with R. 13 EPC 1973, it was sufficient for the board to ascertain that the party requesting suspension of the proceedings had opened proceedings against the applicants in a contracting state for the purpose of seeking a judgement that it was entitled to the grant of the European patent. Neither the jurisdiction of the national court whose decision was to be recognised nor the validity of such decision might be reviewed by the boards of appeal (see also **J 8/96** and **J 10/02**).

In **J 7/00** it was held that **national law** determined when and how legally relevant civil proceedings were opened in a contracting state. Under the Code of Civil Procedure in Germany, entitlement proceedings opened when the complaint was served.

In **J 9/06** the Legal Board pointed out that, according to **G 3/92** (OJ 1994, 607), the courts of the contracting states have jurisdiction to decide claims to entitlement to the right to the grant of a European patent. The Legal Board concluded that it was not possible for the EPO, nor was it its function in the context of the examination of a request to suspend proceedings under R. 13 EPC 1973, to examine whether the subject-matter disclosed in a European patent application in respect of which suspension was requested corresponded to the disclosure of another application, ownership of which was disputed before a national court. It was within the sole competence of that national court to interpret the extent of the claimant's claim and it was not for the EPO to perform any such interpretation in the context of a decision on suspension.

The EPO was only entitled to suspend the proceedings for grant under R. 13 EPC 1973 if there was clear and unambiguous proof that the claimant's request in the proceedings

before the national court was for judgment that he was entitled to the grant of the European patent application which was to be suspended. As this was not the case, the requirements of R. 13(1) EPC 1973 for suspending the grant proceedings had not been met.

4.2. Rule 14(3) EPC (Rule 13(3) EPC 1973)

Under R. 14(3) EPC, upon staying the proceedings for grant, the EPO may set a date on which it intends to resume the proceedings for grant, regardless of the stage reached in the national proceedings under R. 14(1) EPC. This provision was to be found in R. 13(3) EPC 1973. The wording has been amended.

The board held in **T 146/82** (OJ 1985, 267) that if, in accordance with R. 13(3) EPC 1973, the EPO set a date on which it intended to continue the proceedings for the grant of the European patent, the date might be varied or the order staying the proceedings might be discharged at the subsequent request of the applicant or of the third party who applied for the order.

In **J 33/03** the legal board pointed out that, in contrast to the position under R. 13(1) EPC 1973, under R. 13(3) EPC 1973 it was in the discretion of the EPO to decide whether proceedings were to be resumed. In exercising its discretion, the interests of the parties had to be balanced, but the board was neither competent nor qualified to decide which party the European application might belong to, or even which outcome of the entitlement proceedings might be more likely.

The aim of R. 13 EPC 1973 was to prevent an unauthorised applicant from impairing a true proprietor's position by amending the application without its consent. As the patent application was virtually ready for grant, that was no longer possible. The board concluded that, in the circumstances of the case, granting the patent would at most deprive the third party of a comfortable legal position, but continuing to stay the proceedings could occasion real loss to the applicant.

When exercising its discretion under R. 13(3) EPC 1973, the board in **J 10/02** took into account the fact that the entitlement proceedings only concerned part of the invention and the duration of the suspension.

5. Notifications

If a representative has been appointed, notifications shall be addressed to him in accordance with R. 130(1) EPC (previously R. 81(1) EPC 1973). See decisions **J 39/89**, **J 22/94**, **J 17/98**, **T 703/92** and **T 1281/01** in addition to those below.

In **J 19/92** the Legal Board of Appeal held that notifications to an applicant's representative were duly made if they were despatched before the representative relinquished his brief. The notification to the applicant did not therefore have to be repeated after the brief had been relinquished. On the contrary, it was the representative who was obliged to inform his client of the notification. In **T 247/98** the board confirmed

that what determined whether a R. 81(1) EPC 1973 notification was to be sent to the representative was the legal situation **at the time when the document was despatched**.

However, in **T 703/92** the written decision and minutes of the oral proceedings were sent not to the authorised representative but to the opponents. The board found that, as the provision relating to notification had not been observed, the question whether a notification had effectively taken place depended (in accordance with R. 82 EPC 1973) on whether and when the representative had received the full decision. R. 82 EPC 1973 also remains unchanged but is renumbered as R. 125(4) EPC.

In **T 812/04**, the board pointed out that R. 101(6) EPC 1973, in conjunction with R. 81(1) EPC 1973, clearly indicated that, until the termination of an authorisation had been communicated to the EPO, the latter was obliged to notify communications, decisions or other documents to the duly appointed representative and that these notifications alone would have valid effects. The fact that the appellant had filed the notice of appeal himself imposed no obligation on the Registry of the boards of appeal to inquire about the legal status of relations between the applicant (client) and the duly appointed representative or to send the documents and communications subsequently to the client direct. R. 101(6) EPC 1973 has been streamlined and renumbered as R. 152(8) EPC.

In its decision **J 5/04**, the board made it clear that the initial designation of a representative at the time when the international application had been filed with a receiving Office other than the EPO (here: INPI) did not meet the requirements for the valid designation of the representative for the regional phase before the EPO.

In **J 35/97**, a communication under R. 85b EPC 1973 was handed not to the appellant or his spouse (regulation dated 19.12.1995 to protect customers of the postal service in Germany-RPCPS, BGBl I, p. 2016) but to a third party not authorised by the appellant to accept it. The said party was in the addressee's business premises, but not an employee. In the board's view, that meant that notification under Section 12(1) and (2) RPCPS had not occurred. Nor did the party qualify under any of the categories of "substitute addressee" defined in Section 13 RPCPS. There was also no evidence that the appellant had ever seen the communication. The board therefore found the EPO had not shown notification to have been properly effected.

R. 85b EPC 1973 has been deleted in view of the extended scope of application of further processing under Art. 121 EPC.

In **T 172/04** the appellant admitted that the notification concerned was received by an employee authorised to receive post on its behalf. The circumstance that the representative himself only had knowledge of the notification several days or weeks later was therefore irrelevant, as the only legal condition to consider i.e. delivery to the addressee, was established.

This was followed in **T 743/05** and **T 261/07**. In **T 743/05** the board pointed out that a different interpretation (i.e. that it had to be brought to the attention of the professional representative himself), would lead to uncertainty for all the users of the European Patent system, as the answer to the question whether notification had effectively taken place could in that case depend entirely on the honesty, goodwill or organisational skills of the professional representative. In **T 261/07** the decision to revoke the patent was delivered (by registered letter with advice of delivery) to a person who was not an employee of the patentee (to whom the notification was addressed), but of a company that received letters on behalf of the patentee. No acknowledgement of receipt was on file for the patentee, who claimed never to have received the decision. Following **T 172/04** and **T 743/05**, the board held that for reasons of legal certainty, delivery to the addressee is effected once a person authorised by the addressee has received the letter.

In **J 9/96** the Legal Board of Appeal held that notification of a communication posted as an ordinary letter in accordance with R. 78(2) EPC 1973 was deemed to have been made when despatch had taken place. However, if the communication did not reach the addressee and was not returned to the EPO, the legal fiction of deemed notification could not be applied, unless the EPO could establish that it had duly despatched the communication (see also **J 27/97** and **J 32/97**). Under R. 78(1) EPC 1973 notifications by post shall be by registered letter (some with advice of delivery).

According to **J 27/97**, facsimile transmissions of notifications did not satisfy the requirements of R. 77(1) and (2) EPC 1973 and could not therefore be considered as regular notification within the meaning of Art. 119 EPC 1973 and R. 77 EPC 1973. However, under the new R. 127 EPC, notification may be effected by such technical means of communication as are determined by the President of the EPO and under the conditions laid down by him. There was no equivalent provision in the EPC 1973.

In **T 580/06** notification of a shortfall under point 6.4 ADA was sent only by fax. This form of notification was in keeping with point 6.4 ADA in conjunction with R. 77(2)(d) EPC 1973. However, the President had not laid down conditions for notifications by fax within the meaning of that rule; in particular, postal confirmation of the fax had not been made compulsory. Thus the notification had been made in due form. In the board's view, the "OK" on a fax transmission report was to be regarded as evidence of complete and error-free transmission, by which the fax had entered the recipient's domain. Once that had happened, risk was transferred, and the recipient was responsible for any risks within his own domain.

When establishing the meaning of the term "im Zweifel" in the German version of then R. 78(3) EPC 1973 (now R. 126(2) EPC), account should be taken of the French and English versions, which assume that there is a dispute ('en cas de contestation', 'in the event of any dispute'). A dispute ('Zweifel', literally 'doubt' in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting. The mere absence of the advice of delivery or the receipt from the file was not in itself sufficient to give rise to a dispute ('Zweifel') within the meaning of this rule (**T 247/98**).

6. Unity of the European patent application

Art. 118 EPC and Art. 60(3) EPC remain unchanged in substance.

A patent was owned in one designated state (UK) by one company (A) and in other designated states by another related company (B). Only company B filed an appeal against revocation of the patent. The respondents raised the question whether the revocation decision had become final as regards the UK, where only A had a patent, since the appeal filed by B and the subsequent decision of the board of appeal on it could not affect the decision under appeal with regard to the UK but only with regard to the designated states for which B was the patent proprietor.

The board held that the **principle of unitary procedure** leading up to the grant of one European patent must be taken into account. This principle derived from Art. 118 EPC 1973, which explicitly stated that applicants for different contracting states should, for the purpose of proceedings before the EPO, be regarded as joint applicants or proprietors. Thus the decisions of the departments of both first and second instance took effect for all the designated states (**T 119/99**).

In **J 2/01** (OJ 2005, 88) the board had to deal with a divisional application filed only in the name of one of the two joint applicants for the parent application. The board pointed out that a consequence of the unity requirement under Art. 118 EPC 1973 was that, when two or more persons filed an application in common, they could not acquire a procedural status different from that of a single applicant, because otherwise each of them could perform different and contradictory procedural acts, including the filing of different versions of the patent to be granted. Therefore, joint applicants only acquired the procedural status of one applicant in common, i.e. they constituted **a single party in the legal sense** and they held the rights and obligations derived from that procedural status jointly in respect of the application. The legal fiction in Art. 60(3) EPC 1973 applied to the joint applicants in common.

L. Interpretation of the EPC

1. The Vienna Convention on the Law of Treaties

The Vienna Convention on the Law of Treaties applies only to agreements which postdate its entry into force, and therefore not to interpreting the EPC 1973. In **J 8/82** (OJ 1984, 155) the board noted however that it was well recognised that Art. 31 and Art. 32 of the Vienna Convention about the interpretation of treaties merely codified existing public international law. In its first decision (**G 5/83**, OJ 1985, 64), the Enlarged Board of Appeal endorsed this, pointing out that the International Court of Justice, the European Court of Human Rights, the Federal German Constitutional Court ("Bundesverfassungsgericht") and the House of Lords had also applied the principles of interpretation in Art. 31 and Art. 32 of the Vienna Convention to treaties to which strictly they did not apply. It concluded that the EPO should do the same. Art. 31 of the Vienna Convention states that a treaty must be interpreted in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object

and purpose. **T 128/82** (OJ 1984, 164) adds that under Art. 32 of the Vienna Convention recourse may also be had to supplementary means of interpretation, such as the international treaty's legislative history (e.g. the preparatory work and the circumstances in which the treaty was concluded), in order to confirm the meaning arrived at by applying Art. 31 of the Vienna Convention or to determine the meaning when applying Art. 31 of the Vienna Convention leaves the meaning ambiguous or obscure, or produces a meaning which is obviously nonsensical or unreasonable. In **J 4/91** (OJ 1992, 402), for example, the Legal Board of Appeal drew on historical material relating to the EPC 1973 to support its view, arrived at from a teleological and systematic interpretation of the relevant provisions, regarding the additional period for paying renewal fees. **G 1/98** (OJ 2000, 111) discussed the purpose of Art. 53(b) EPC 1973, its relationship to other international treaties and legal texts, and its legislative history. In **G 3/98** and **G 2/99** (OJ 2001, 62 and 83), the Enlarged Board reached its conclusions on Art. 55(1) EPC 1973 after interpreting the wording and considering also the legislator's intention and the aspects of systematic, historical and dynamic interpretation.

In **G 1/07** the Enlarged Board of Appeal noted that no general principle of narrow interpretation of exclusions from patentability which would be applicable a priori to the interpretation of any such exclusions can be derived from the Vienna Convention. Rather, the general rule in Article 31, point 1 of the Vienna Convention that a treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose must apply to the exclusion clauses contained in the EPC in the same manner as to any other provision.

2. Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS)

2.1. The requirement for the judicial review of decisions

In **T 557/94** the board discussed the TRIPS requirement for the judicial review of decisions revoking a patent. While recognising that the European Patent Organisation was not a party to TRIPS the board investigated whether the basic principle of judicial review under Art. 32 TRIPS was satisfied by the EPC 1973. It found that in any case, under Art. 111(1), second sentence, EPC 1973, the board of appeal was empowered either to decide on the merits of the case **or** to remit the case; it was not restricted to the latter alternative if the opposition division maintained the patent and the board was considering revoking the patent for the first time. Reading Art. 32 TRIPS in the context of the usual structure of judicial review in the EPC contracting states and the EPC 1973 itself, this provision guaranteed an instance for judicial review in revocation proceedings, but did not oblige the reviewing instance to remit the case to the department of first instance for continuation of proceedings when revocation was being considered by the judicial instance for the first time.

The right of the parties to fair proceedings if a relevant document was introduced only at the appeal stage was a quite different matter. According to the case law of the boards such a procedural situation called for careful consideration.

In **T 1173/97** (OJ 1999, 609) the board, however, thought that, although TRIPS could not be applied directly to the EPC 1973, it was appropriate to take it into consideration in connection with the patentability of computer program products, for TRIPS was aimed at setting common standards and principles concerning the availability, scope and use of trade-related intellectual property rights. It thus gave a clear indication of current trends. The appellant's reference to current practice at the US and Japanese patent offices caused the board to emphasise that the legal position in the USA and Japan differed greatly from that under the EPC 1973; only the EPC 1973 contained an exclusion such as that in Art. 52(2) and (3) EPC 1973. These developments nevertheless represented a useful indication of modern trends and, in the board's view, could contribute to the further highly desirable (worldwide) harmonisation of patent law.

2.2. Interpretation of Article 87 EPC in the light of TRIPS

In **G 2/02** and **G 3/02** (OJ 2004, 483) some issues on provisions of the EPC 1973 which admitted of different interpretations required consideration by the Enlarged Board, namely the provisions of the EPC 1973 concerning the recognition of priority from India and the TRIPS Agreement. The Enlarged Board held that the TRIPS Agreement did not entitle the applicant for a European patent application to claim priority from a first filing in a state which was not at the relevant dates a member of the Paris Convention but was a member of the WTO/TRIPS Agreement. The Enlarged Board noted that neither the European Patent Organisation nor the EPO was a member of the WTO/TRIPS Agreement; there was no provision in either instrument to allow their adherence thereto. As a formal matter, general multilateral treaties containing rules of general (conventional) law, such as the TRIPS Agreement, were a source of international law for the contracting parties and for no one else.

The Enlarged Board held that TRIPS provisions, like decisions of the European and International Courts of Justice and national decisions, were elements to be taken into consideration by the boards of appeal but were not binding on them. Whereas it was legitimate for the boards of appeal to use the TRIPS Agreement as a means to interpret provisions of the EPC 1973 which admit of different interpretations, specific provisions of TRIPS could not justify ignoring express and unambiguous provisions of the EPC 1973. To do so would usurp the role of the legislator. This was confirmed by the fact that the legislator of EPC 2000 found it necessary to revise Art. 87 EPC 1973 in order to implement the TRIPS Agreement.

The Enlarged Board explained that the European Patent Organisation as a public international organisation had an internal legal system of its own (see the judgment of the High Court of England and Wales [Patents Court] in *re Lenzing AG's European patent (UK)* [1997] R.P.C. 245, at 264). The EPC 1973 provided an autonomous legal system for the granting of European patents. In legal terms, neither the legislation of the contracting states nor the international conventions signed by them were part of this autonomous legal system. Within the framework of the system established by the EPC 1973, legislative power rested with the contracting states alone and was exercised by either an inter-governmental conference (Art. 172 EPC 1973) or the Administrative Council (Art. 33 EPC 1973). The EPO was not itself party to the WTO and the TRIPS

Agreement. Thus, the obligations deriving from the TRIPS Agreement did not bind the EPO directly but only such contracting states of the EPC 1973 as were members of the WTO and the TRIPS Agreement. In this connection, it was irrelevant whether some or all of the contracting states of the EPO were party to the TRIPS Agreement. Even if all of them had become members of the TRIPS Agreement on 1 January 1995, so that no problems of reciprocity under the Indian patent law would have arisen, a notification under Art. 87(5) EPC 1973 would still have been required.

3. Interpretation of the various language texts of the EPC (Article 177 EPC)

In **J 8/95** it was held that Art. 177(1) EPC 1973 was based on the assumption that the authors of the EPC 1973 had one intention, which was to be determined using the three versions of the EPC 1973. Even if one language version of a provision were found to differ from the other two versions, no legal consequences could be derived from that version other than those which could be derived from the other two versions - regardless of the language of the proceedings. A difference in the wording in one language would have to be considered only in so far as it could form one element of the interpretation. In the case at issue, however, the provision under consideration, even in the allegedly different version, could readily be understood in context in the same way as the other two official languages, with the result that all three versions of the provision corresponded as far as content was concerned.

4. Interpretation of the EPC by the boards of appeal

4.1. Decisions of the Administrative Council concerning a question of interpretation

In **J 16/96** (OJ 1998, 347) the issue was whether an association of representatives within the meaning of R. 101(9) EPC 1973 could also be formed by professional representatives who did not work in private practice. The Administrative Council of the European Patent Organisation had decided at its 4th meeting in 1978 that an association within the meaning of this rule could only be an association consisting of professional representatives in private practice. The Legal Board of Appeal pointed out that in their decisions the boards of appeal were not bound by any instructions and complied only with the provisions of the EPC 1973 (Art. 23(3) EPC 1973). The boards of appeal could not be formally bound by a decision of the Administrative Council concerning a question of interpretation, nor could such a decision be deemed to be an instruction for their decisions. However, such a decision was a relevant element in interpretation.

According to the Vienna Convention on the Law of Treaties, the EPC 1973 had to be interpreted "in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose" (Art. 31(1) Vienna Convention). According to Art. 31(3)(a) Vienna Convention, "any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions" had also to be taken into account. Interpreting the case in accordance with Art. 31(1) of the Vienna Convention, the board concluded that an association within the meaning of R. 101(9) EPC 1973 could also be an association of

representatives not engaged in private practice. The intended aim of the Council's decision, which was to eliminate ambiguities in the application of R. 101(9) EPC 1973, had, in the light of recent developments in the profession, not been achieved, and as such the decision was less important in relation to the other factors involved in interpretation.

4.2. Taking national decisions into account

In **T 98/00** the board held that Art. 69(1) EPC 1973 did not deal with the issue of amendments, which was regulated by Art. 123 EPC 1973. The provisions of Art. 69(1) EPC 1973 were primarily intended to be applied by the courts responsible for deciding on infringement cases, and thus they were not designed to be a substitute for the requirements of Art. 123(3) EPC 1973.

In **T 452/91** the board took the view that in proceedings before the instances of the EPO, questions of patentability were to be decided solely in accordance with the Convention. No national decision should be cited as if it were binding on the EPO, and claims should not be refused by the EPO on the ground that their "patentability cannot be upheld under the jurisdiction of one member state". It could be that the law in most or all other contracting states was different. The reasoning that led the national instance to its conclusion might well lead an EPO instance to a similar conclusion under the Convention, but this would first need a careful assessment of the Convention, and of relevant EPO board of appeal case law, a comparison with the legislation and case law on which the national instance reached its conclusion, and a study of the position in other contracting states.

4.3. Implementing Regulations

In **T 991/04** the board noted that as R. 65 EPC 1973 (now R. 101 EPC) in its wording at the time of the decision was also part of the very first version of the EPC 1973 the validity of R. 65(2), second sentence, EPC 1973, could not be seriously questioned by a reference to the principle laid down in Art. 164(2) EPC 1973 that in the case of conflict between the provisions of the EPC 1973 and those of the Implementing Regulations, the provisions of the EPC 1973 should prevail. The fact that requirements stipulated by an article of the EPC 1973 needed to be specified by the Implementing Regulations did not create a case of conflict. As the EPC 1973 itself did not define the requirements establishing the admissibility of an appeal, R. 65 EPC 1973 specified these requirements in an authentic way. The board stated that the Diplomatic Conference as the legislator of the European patent system drafted the first versions of the EPC 1973 and the Implementing Rules as a legal unity which should be read in a consistent way. In this regard the Implementing Regulations had the function of an **authentic interpretation of the EPC 1973**.

4.4. Differences between national legislation and the EPC

In **J 9/07** the board stated that according to Art. 1 EPC 1973 the EPC established a system of law common to the contracting states for the grant of patents for inventions.

This common system of law is applicable to all European patent applications irrespective of which contracting states have been designated in the European patent application. Although in general a high degree of harmonization between the EPC and national laws is desirable and has indeed been achieved, differences between national legislation and the EPC are not ruled out by Art. 2(2) EPC 1973 or Art. 66 EPC 1973 in this regard. The board stated that, save to the extent that the Convention expressly provides otherwise, the EPO is not allowed to take into consideration with respect to the designated state concerned a specific national legal provision which would be more favourable for the applicant than the provisions of the EPC. This is because this would have the consequence of giving European applications unequal treatment as regards the requirements for grant depending on which state or states have been designated, contrary to Art. 1 EPC 1973. It would also go against the principle of the unity of the application enshrined in Article 118 EPC 1973 since, if a more favourable national provision were to be applied in relation to the designated state concerned, distinguishing between a case in which the designated state concerned is the only one designated and a case in which further states have been designated as well would appear arbitrary and unjustifiable.

5. Allocation of responsibilities in the EPC

In **J 5/01** the applicant had requested that the number of the second priority application be corrected. The request for correction under R. 88 EPC 1973 was rejected by a decision of the Receiving Section.

The board found that said decision of the Receiving Section was taken after the applicant had indicated under Art. 96(1) EPC 1973 that he wished to proceed further with the application, at which point in time the examining division became responsible for the examination of the application and the Receiving Section ceased to be responsible (Art. 16 EPC 1973 in conjunction with Art. 18(1) EPC 1973). The board held that the wording of Art. 16 and Art. 18 EPC 1973 as they stood left no room for an interpretation according to which the responsibility for a European patent application could be split between the Receiving Section and the examining division. The board observed that a clear and mutually exclusive allocation of this responsibility in the Convention prevailed over considerations of procedural or cost economy (contrary to **J 8/82**). Thus, relying on the point in time at which a request for correction was made rather than on the two acts mentioned in Art. 16 EPC 1973 (request for examination or indication under Art. 96(1) EPC 1973) would be *contra legem*.

M. Right to a European patent

Art. 61 EPC deals with the remedies available where a person other than the patent applicant is held by a national court to be the person entitled to the grant of a European patent. The Article remains unchanged in substance. The conditions contained in Art. 61(1) EPC 1973 have been transferred to the Implementing Regulations (see R. 16 EPC and R. 17 EPC).

In **G 3/92** (OJ 1994, 607), the Enlarged Board of Appeal was called upon to consider the application of Art. 61(1)(b) EPC 1973 in the following circumstances:

The appellant had lodged a European patent application in 1988. The search report revealed the existence of a prior application filed in 1985 for substantially the same invention by a third party, to whom the appellant had revealed the invention in confidence in 1982. This prior application had been published, and in 1986 deemed to be withdrawn for non-payment of the examination fee. Thereupon the appellant claimed from the UK Patent Office Comptroller, and was granted, entitlement to a patent for the invention disclosed in the prior European application under Section 12(1) UK Patents Act 1977. The appellant was thus allowed under Section 12(6) UK Patents Act 1977 to file a new application in the UK to be treated as having the same filing dates as the prior European application. The appellant then filed a new European patent application in respect of the invention disclosed in the prior application under Art. 61(1)(b) EPC 1973 in 1990.

The referring Legal Board of Appeal took the view in its interlocutory decision **J 1/91** dated 31.3.1992 (OJ 1993, 281) that the Comptroller's decision was a final decision within the meaning of Art. 61 EPC 1973. However, whilst entitlement to a patent was a matter for national courts to decide, those courts had no power directly to provide a remedy under the Convention, that being a matter to be dealt with by the EPO under Art. 61 EPC 1973.

The referring board then went on to consider whether pendency was required under Art. 61 EPC 1973. As the article was open to differing interpretations, the board decided to refer the question to the Enlarged Board.

The Enlarged Board of Appeal held that when it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Art. 61(1) EPC 1973, files a new European patent application in respect of the same invention under Art. 61(1)(b) EPC 1973, it is not a pre-condition for the application to be accepted that the earlier original usurping application is still pending before the EPO at the time the new application is filed.

The Legal Board of Appeal therefore ruled in **J 1/91** dated 24.8.1994 that the conditions of Art. 61(1)(b) EPC 1973 had been met and accordingly remitted the patent application to the Receiving Section for further prosecution.

VII. PROCEEDINGS BEFORE THE EPO

A. Preliminary and formalities examination

1. Introduction

Under Art. 16 EPC, the Receiving Section is responsible for the examination on filing and the examination as to formal requirements of European patent applications. For further details see 3.4 below. See also **T 1012/03**.

Pursuant to Art. 90(1) EPC the EPO examines whether the application satisfies the requirements for the accordance of a date of **filing** in accordance with the Implementing Regulations (R. 40 EPC). If the application fails to meet these requirements, the EPO will inform the applicant of any deficiencies and advise him that the application will not be dealt with as a European patent application unless he remedies the disclosed deficiencies within two months (previously one month under R. 39 EPC 1973). If the applicant does this, he shall be informed of the date of filing accorded by the EPO (R. 55 EPC). Art. 91 EPC 1973 has been deleted, all necessary matter now being covered by Art. 90 EPC and many provisions having been transferred to the Implementing Regulations. The new Article applies to all applications pending on 13.12.2007 and to applications filed on or after that date.

The **examination as to formal requirements** under Art. 90(3) EPC starts, if a European patent application has been accorded a date of filing. If the application fails to meet the requirements of this Article, the applicant shall be given an opportunity to correct any deficiency (Art. 90(4) EPC and R. 58 EPC). If any deficiency is not corrected, the application shall be refused (Art. 90(5) EPC). Under Art. 90(5) EPC, the omission of the designation of the inventor now also leads to a refusal of the application and no longer to the application being deemed withdrawn as under Art. 91(5) EPC 1973.

2. Accordance of a date of filing - language of the filed documents

Art. 80 EPC deals with according a date of filing, but the detailed provisions concerning the requirements have been moved to the Implementing Regulations (R. 40 EPC).

Under the new Art. 14(2) EPC, which applies to applications filed on or after 13.12.2007, an application may now be filed in **any** language. If the European patent application is filed in a language other than one of the official languages, a translation into one of the official languages is to be filed within **two** months of filing (Art. 14(2) and R. 6(1) EPC).

The decisions below consider the application of the EPC 1973.

The Legal Board held in **J 18/96** (OJ 1998, 403) that the requirements under Art. 80 EPC 1973 for according a filing date were not fulfilled if the description and claims were filed in two different official languages. However, if, notwithstanding this deficiency, the Receiving Section left the applicant for a considerable time in the justified belief that the

application was validly filed, then his legitimate expectations might be cited as regards according a filing date.

In **T 382/94** (OJ 1998, 24), the claims and description had been filed in German, but the drawings contained text matter in English. The board held that the EPC did not make the accordance of a filing date dependent on any text matter in the drawings being in a language in accordance with Art. 14(1) or (2) EPC 1973. If the drawings were filed in full on the date of filing, they formed part of the application as filed, even if they contained text matter in an official language other than the language of proceedings. There was nothing to prevent the application being amended on the basis of a translation of this text matter into the language of the proceedings.

In **J 15/98** (OJ 2001, 183) the board held that an application filed in one of the languages referred to in Art. 14 EPC 1973 (here Spanish) produced the result provided for in Art. 80 EPC 1973, i.e. a date of filing was attributed, irrespective of the fact that the applicant neither had its residence nor principal place of business in a Contracting State nor was a national of a Contracting State, provided that all the other requirements of Art. 80 EPC 1973 were satisfied.

In **J 22/03**, the Legal Board of Appeal referred to its decision in **J 18/96** and explained that, under Art. 80(d) EPC 1973, the documents filed must contain a description and one or more claims in one of the languages referred to in Art. 14(1) and (2) EPC 1973, in order for a date of filing to be accorded. Art. 14(1), second sentence, EPC 1973 stated that European patent applications must be filed in **one** of the official languages. The principle that applications are to be monolingual could therefore clearly be inferred from that provision. Since Art. 80(d) EPC 1973 referred to that provision, accordance of a date of filing required that the description and the patent claim(s) be in the same (permitted) language. (Art. 80(d) EPC 1973 has been moved to R. 40(1)(c) EPC and amended to read, 'a description or reference to a previously filed application'.)

3. Application documents

3.1. Filing of application documents

The requirements which must be fulfilled by a European patent application are set out in Art. 78 EPC, which has not been substantively amended. One of the requirements of a European patent application is that a filing fee and a search fee be paid (Art. 78 EPC, R. 38 EPC). Under the EPC 1973, failure to pay one of the fees within one month of filing the European patent application lead to a one-month grace period from notification of a communication pointing out the failure to observe the time limit (R. 85a(1) EPC 1973). Under the EPC 2000, the time limit remains the same, but the grace period has been deleted; failure to pay now leads to the application being deemed to be withdrawn (Art. 78(2) EPC). The EPO will notify the applicant of the loss of rights according to R. 112(1) EPC and the applicant can respond by requesting further processing within two months of the communication (Art. 121 EPC, R. 135 EPC) if the EPO does not take a decision under R. 112(1) EPC - according to R. 112(2) EPC, an appealable decision must be requested within two months of this communication by the party concerned, if it

considers the finding of the EPO inaccurate. These provisions apply to applications pending on 13.12.2007 and to European patents already granted at the time if the time limit for requesting further processing has not expired, and to applications filed on or after 13.12.2007 and to patents granted in respect of such applications.

The geographic restriction for the filing of a European patent application to Munich and The Hague has been removed from Art. 75 EPC. Under R. 35 EPC (previously R. 24 EPC 1973), European patent applications may be filed in writing with the EPO in Munich, The Hague or Berlin, or the authorities referred to in Art. 75(1)(b) EPC.

Applications may also be filed by facsimile and in electronic form (through the EPO online services). See, for example, the decision of the President of the European Patent Office dated 26 February 2009 concerning the electronic filing of documents. The possibility of filing applications by facsimile and in electronic form existed also prior to the introduction of the EPC 2000.

Two decisions under the EPC 1973 pointed out the need to ensure - if the applicant wished to be accorded a particular date of filing - that application documents were actually received by the EPO itself or by a competent national authority by that date. This was particularly important where applications were filed by post.

In **J 18/86** (OJ 1988, 165) the board stated that under R. 24 EPC 1973 in conjunction with Art. 75(1)(b) EPC 1973 the date of filing of a European application was always the date on which the application documents were actually received, either by the EPO directly or by a competent national authority. Nothing in the EPC 1973 admitted of the possibility of applying a provision of any national law to the determination of the date of filing of a European patent application.

In **J 4/87** (OJ 1988, 172), the board held that in the event of an unforeseeable postal delay causing non-compliance with a time limit, if R. 85(2) EPC 1973 (relating to general interruption or subsequent dislocation in the delivery of mail in a Contracting State) was not applicable so as to extend the time limit, the EPO had no discretion to extend it. Applying the principles set out in **J 18/86** above, the date of filing was the actual date of receipt by the EPO or a competent national authority. See also **J 13/05**.

In **J 7/97** a European patent application had been filed with the EPO by fax, but one page of the description was missing. This was not considered an 'obvious error' and a filing date was granted for the application but omitting the page which was not faxed. See now new R. 56 EPC, which corresponds to the provisions of Art. 5(6) PLT and provides that, if the applicant files a missing part of the description or drawings within two months from the filing date or the communication under R. 56(1) EPC, the application will be re-dated.

In **J 13/04**, the board observed that, under Art. 78(2) EPC 1973, the filing and search fees must be paid within one month of the filing of the European patent application (see now R. 38 EPC). Consequently, the time limit for payment of these fees in the case at hand could not be determined on the basis of either the date on which the application

was forwarded to the EPO or the date on which the receipt had been issued under R. 24(2) EPC 1973 but rather only on the basis of the date on which the application had been received by the competent national authority, provided that the date of that filing was also the date of filing within the meaning of Art. 80 EPC 1973.

3.2. Subsequent filing of missing parts of the description or missing drawings

Under R. 43 EPC 1973, an application in relation to which the drawings were filed after the date of filing, could be re-dated to the date on which the drawings were filed.

Under R. 56 EPC, this procedure has been modified and, in addition, extended to apply also to missing parts of the description. Where the applicant files missing parts of the description or missing drawings within two months of the date of filing or of a communication by the EPO inviting him to file the missing parts, the application is re-dated to the date on which the missing parts were filed. However, if the application claims priority, the missing parts of the description or the missing drawings are completely contained in the earlier application and all the requirements of R. 56(3) EPC are fulfilled, the application is not re-dated but retains the date on which the requirements laid down in R. 40(1) EPC were fulfilled.

R. 56 EPC applies only to applications filed after the entry into force of EPC 2000 (**J 3/06**, OJ 2009, 170). Applications filed before 13 December 2007 can be seen to be subject to EPC 2000 as regards the applicability of the Implementing Regulations when the article corresponding to the rule in question also applies to patent applications filed prior to 13 December 2007 under Article 1 of the Administrative Council's decision of 28 June 2001. However, a rule in the Implementing Regulations can be assumed to apply to a particular EPC 2000 article when it puts a more detailed construction on that article, in keeping with the purpose of "implementing" the EPC. This is not true of the relationship between Art. 90 and R. 56 EPC because R. 56 EPC does not elucidate Art. 90 EPC. In the context of the system as a whole, R. 56 EPC relates to Art. 80 EPC (filing date), which is not in the catalogue of provisions stated to be also applicable to pending procedures as soon as EPC 2000 was to enter into force. Consequently, the rules relating to it do not apply either.

The decisions below consider the application of the EPC 1973.

In **J 19/80** (OJ 1981, 65) it was held that if a part of a drawing was missing, the missing part was not to be considered as a missing drawing for the purposes of R. 43 EPC 1973; the whole figure was to be considered as an incorrect drawing. The correction of drawings is dealt with in R. 139 EPC (previously R. 88 EPC 1973).

However, according to **G 3/89** and **G 11/91** (OJ 1993, 117 and 125), the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) might be corrected under R. 88, second sentence, EPC 1973 only within the limits of what a skilled person would have derived directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed. Such a correction was of a

strictly declaratory nature and thus did not infringe the prohibition of extension under Art. 123(2) EPC 1973. Documents not meeting this condition might not be used for a correction under R. 88, second sentence, EPC 1973 even if they were filed together with the European patent application. These included, inter alia, priority documents, the abstract and the like.

According to **J 1/82** (OJ 1982, 293), if a sheet including two complete figures was late-filed, these could not be considered incorrect drawings for the purposes of R. 88 EPC 1973 - the late filing of one or more complete figures was dealt with in R. 43 EPC 1973. (See now R. 56 EPC, where the wording 'missing parts of drawings' has deliberately been avoided.)

3.3. Replacing the invention

R. 88 EPC 1973 has been slightly redrafted and renumbered as R. 139 EPC.

R. 139 EPC gives the EPO discretion in allowing corrections. In **J 21/85** (OJ 1986, 117) the Legal Board had held that R. 88 EPC 1973 did not permit an invention covered by a request for grant of a patent to be exchanged for another, even if a request for correction under R. 88 EPC 1973 was submitted immediately the application had been filed and it was demonstrated beyond doubt that the inventions were unintentionally confused.

In **T 726/93** (OJ 1995, 478), however, the board exercised its discretion by allowing the erroneously filed wrong claims and description to be replaced by the documents which the appellant had actually intended to file.

In **J 21/94** (OJ 1996, 16) doubts were raised about **T 726/93** and the following question was referred to the Enlarged Board: "Can the complete documents forming a European patent application, that is the description, claims and drawings, be replaced by way of a correction under R. 88 EPC 1973 by other documents which the applicant had intended to file with his request for grant?" In **G 2/95** (OJ 1996, 555), the Enlarged Board ruled that they could not.

In decision **J 21/94**, taken on 20.1.1997 and terminating the appeal proceedings, the Legal Board concluded that the originally disclosed invention B could be accorded a filing date even if there were contradictions between the request for grant (which related to invention A) and the application documents (which disclosed invention B). If a further invention (here invention A) was disclosed during grant proceedings, it could not be given a filing date unless it was clear that protection for this invention was now sought.

3.4. Extent of competence of the Receiving Section

Art. 16 EPC 1973 contained a limitation in time of the Receiving Section's responsibility. The Receiving Section was 'responsible up to the time when a request for examination has been made or the applicant has indicated under Art. 96(1) EPC 1973, that he desires to proceed further with his application.' This provision has been deleted from the EPC to ensure greater flexibility in allocating specific tasks of the EPO. The responsibility

of the Receiving Section and the Examining Division is now set out in R. 10 EPC. The new Art. 16 EPC has been provisionally applicable since 29.11.2000.

R. 139 EPC, second sentence, (previously R. 88 EPC 1973) lays down as a condition for acceptance of a request for correction concerning a description, claims or drawings that a correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. This often requires a technical examination of the file, so that the question has arisen under R. 88 EPC 1973 whether the Receiving Section was competent to deal with the correction in such a case.

In decision **J 4/85** (OJ 1986, 205) the board made it clear that the duties of the Receiving Section did not include a technical examination of the file; it should not, therefore, take a decision on a request for correction necessitating such an examination, but should leave the request in abeyance until the file had been transferred to the examining division. However, in **J 33/89** (OJ 1991, 288) the board pointed out that the Receiving Section remained competent for decisions on requests for correction of drawings under R. 88, second sentence, EPC 1973 unless the request necessitated a technical examination.

According to **J 5/01**, the wording of Art. 16 EPC 1973 and 18 EPC 1973 as they stood left no room for an interpretation according to which the responsibility for a European patent application could be split between the Receiving Section and the examining division. The clear and mutually exclusive allocation of this responsibility in the EPC prevailed over considerations of procedural or cost economy (contrary to **J 8/82**, OJ 1984, 155). Thus, relying on the point in time at which a request for correction was made rather than on the two acts mentioned in Art. 16 EPC 1973 (request for examination or indication under Art. 96(1) EPC 1973) would be *contra legem*.

The board pointed out that corrections under R. 88 EPC 1973 were not a matter which formed part of the examination on filing or of the examination as to formal requirements (Art. 90 and 91 EPC 1973). Rather, the wish or the need for a correction might arise during the whole grant procedure and even afterwards, e.g. during opposition proceedings; nor do the nature of the issue or the specific tasks of the two bodies in question suggest that the responsibility for deciding on corrections under R. 88, first sentence, EPC 1973, should be retained with the Receiving Section. (The Receiving Section had issued a decision rejecting the applicant's request for correction of the number of the second priority application.) For corrections necessitating a technical examination see **J 4/85**, OJ 1986, 205.

In **J 13/02**, the board took the view that the fact that the EPC 2000 versions of Art. 16 to 18 EPC were already applicable in accordance with Art. 6 of the Revision Act did not alter the fact that the Receiving Section's competence came to an end once a valid request for examination has been made with the result that the examining division had to examine whether the application met the requirements of the EPC 1973 (Art. 94(1) EPC 1973 in conjunction with Art. 96(2) and 97(1) and 97(2) EPC 1973).

4. Identity of the applicant

Under Art. 80(c) EPC 1973, one of the requirements for the accordance of a filing date was that the application contained 'information identifying the applicant'. Art. 80 EPC now provides that the date of filing of a European patent application shall be the date on which the requirements laid down in the Implementing Regulations are fulfilled. The current provisions (R. 40(1)(b) EPC), include the amended 'information identifying the appellant or the allowing the applicant to be contacted'. Art. 80 EPC is applicable to European patent applications filed on or after 13.12.2007.

The decisions below consider the application of the EPC 1973.

In **J 25/86** (OJ 1987, 475) it was pointed out that the requirement of Art. 80(c) EPC 1973 for "information identifying the applicant" was to be considered as having been met whenever it was possible to establish beyond reasonable doubt the identity of the applicant on the basis of all data contained in the documents filed by the applicant or his representative.

In Art. 60(3) EPC the principle is established that the EPO assumes the applicant to be entitled to the European patent. This fiction only relieves the EPO of any need to investigate the existence of the entitlement. However, when a person referred to in Art. 60(1) EPC, other than the applicant, disputes the entitlement to the grant of a European patent, the entitlement may be modified under the conditions provided for in Art. 61 EPC.

In **J 7/80** (OJ 1981, 137), the board held that if the wrong applicant was named in an application and the wrong applicant and the correct applicant were both companies forming part of the same group of companies then the mistake could be corrected under R. 88 EPC 1973, if there was sufficient evidence to support the request for correction.

Following **J 7/80** (OJ 1981, 137) it was held in **J 18/93** (OJ 1997, 326), **J 17/96** and **J 31/96** that a correction substituting the name of the applicant was allowable under R. 88 EPC 1973 if there was sufficient evidence to support the request for correction. This rule was not in conflict with the provisions of Art. 61 EPC 1973, which concerned ownership disputes. R. 88, second sentence, EPC 1973 was not applicable. It was only necessary to verify whether there was sufficient evidence to support the request under R. 88 EPC 1973 for correction of the applicant's name; where the correction of a mistake was requested and R. 88, second sentence, EPC 1973 was not applicable, the EPO had to be satisfied that a mistake had been made, what the mistake was and what the correction should be. In **J 8/80** (OJ 1980, 293), the board added that, in order to avoid any abuse, the burden of proving the facts had to be a heavy one.

A correction under R. 88, first sentence, EPC 1973 was retroactive to the original date of filing (**J 3/91**, OJ 1994, 365; **J 2/92**, OJ 1994, 375) and the application was restored to the form which it should have taken on the filing date if the error had not been made (**J 4/85**, OJ 1986, 205).

In **J 17/97** and **J 18/97** the representative had filed the parent application in the name of Int. Inc., but the divisional application in the name of S.medica. Due to the different identities of the applicants, the Receiving Section had refused to treat the application as a divisional application. In its decisions, the Legal Board did not allow the request for correction to replace the name of the applicant of the divisional application with the name of the applicant of the parent application pursuant to R. 88 EPC 1973 because the appellant had not proved that the divisional application had been filed in error by S.medica and should have been filed by Int. Inc.

5. Designation of states

5.1. Article 79(2) EPC

For case law on Art. 79(2) EPC 1973 (as in force until 30.6.1997), please refer to the "Case Law of the Boards of Appeal of the European Patent Edition", 5th Edition.

5.1.1 Article 79(2) EPC (as in force from 13.12.2007)

Art. 79 EPC has been amended so that all the contracting states party to the EPC at the time of filing of the European patent application shall be deemed to be designated in the request for grant of a European patent. Since 1.4.2009, a flat designation fee has been payable for one or more contracting states designated (Art. 2(3) RFees). Applicants continue to have the option of withdrawing designations pursuant to Art. 79(3) EPC. The revised Art. 79 EPC is applicable to all European patent applications filed on or after 13.12.2007.

5.1.2 Article 79(2) EPC 1973 (in force from 1.7.1997 to 12.12.2007)

Art. 79(2) EPC 1973, in force from 1.7.1997 to 12.12.2007, introduced the provision according to which designation fees were payable up to six months from the date on which the European Patent Bulletin mentioned the publication of the European search report. Precautionary designation of all EPC contracting states was replaced by **express designation of all states party to the EPC 1973** on the date of filing. Those states for which designation fees had been validly paid, and where under R. 23a EPC 1973 the application was thus comprised in the state of the art, were published in the European Patent Bulletin.

5.2. Effect of non-payment of the designation fee

Since 1.4.2009 a single designation fee has been payable in respect of all the Contracting States of the EPC. R. 39 EPC in force from that date provides that the designation fee shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report. Where the designation fee is not paid in due time or the designations of all the Contracting States are withdrawn, the European patent application shall be deemed to be withdrawn.

The applicant can request further processing, unless he has waived his rights to receive a R. 112(1) EPC communication and to request further processing by crossing the appropriate box in the Request for grant form.

R. 39 EPC as amended from 1.4.2009 applies to European patent applications filed on or after that date, as well as international applications entering the regional phase on or after that date.

The decisions below consider the application of the EPC 1973.

In **G 4/98** (OJ 2001, 131), the Enlarged Board of Appeal held, overruling **J 22/95** (OJ 1998, 569), that, without prejudice to Art. 67(4) EPC 1973, the designation of a contracting state party to the EPC in a European patent application did not retroactively lose its legal effect and was not deemed never to have taken place if the relevant designation fee had not been paid within the applicable time limit.

The Enlarged Board of Appeal further held that since in its opinion no general retroactive effect was attached to the fact that a designation was deemed to be withdrawn, the deemed withdrawal necessarily took effect upon expiry of the time limits mentioned in Art. 79(2) EPC 1973 and R. 15(2), R. 25(2) and R. 107(1) EPC 1973, as applicable, and not upon expiry of the period of grace provided by R. 85a EPC 1973. Art. 76(2) EPC has therefore been amended, to ensure that only those contracting states which remain designated in the earlier application at the time of filing of a divisional application are deemed to be designated in the divisional application.

5.3. Correction of designation of states in Euro-PCT applications

Under Art. 121 EPC, where a designation is deemed withdrawn for any contracting state in respect of which the designation fee has not been paid (R. 39(2) EPC), the applicant may now apply for further processing. The case law below considers the application of the EPC 1973.

J 17/99 explained that with respect to corrections of designations in Euro-PCT applications, the same principles shall apply as for Euro-direct applications (see also chapter IX, The EPO acting as a PCT authority).

J 27/96 concerned a Euro-PCT application which originally designated all the contracting states for a European patent, but on entry into the regional phase only designated and paid fees for ten. The board acknowledged that correction of a mistake pursuant to R. 88 EPC 1973 by adding the designation of a state had in principle been allowed by the legal board of appeal (see **J 3/81**, OJ 1982, 100). However, it could remain undecided whether the R. 88 EPC 1973 could have been applied to the designations purported to be missing, as the lack of fee payment in due time was not a mistake that could be corrected under R. 88 EPC 1973 and was therefore a failure which could not be remedied (referring to **J 21/84**, OJ 1986, 75). Nor could the appellant's auxiliary request to replace expressly designated states with other non-designated states succeed - the designated states were not designated erroneously - rather the error lay in the omission

of the non-designated states. Moreover, were there a retroactive effect of the correction, this did not mean that the applicant would be reinstated into the procedural phase when designations had to be made and fees paid or that, in consequence, the whole procedure in that phase would be available to him again. Correction of a mistake was an isolated procedural measure and not a case of re-establishment into a procedural phase as a whole.

In **J 3/01** the Legal Board of Appeal was concerned with the same problem, in that the appellant's request was aimed at a reinstatement into an earlier procedural phase by means of a correction under R. 88 EPC 1973. The board held that correction under R. 88 EPC 1973 did not reverse the effect of decisions already taken on the basis of the uncorrected document and did not re-open a procedural phase already terminated or a time limit already expired. In other words, a procedural loss of right only indirectly caused by the incorrect document would not be remedied by a later correction of the document pursuant to R. 88 EPC 1973. This principle also characterised the functional and essential difference between a correction under R. 88 EPC 1973 on the one hand and *restitutio in integrum* pursuant to Art. 122 EPC 1973 on the other hand (see also **J 25/01**). The board concluded that correction under R. 88 EPC 1973, to include designation of the UK following failure to pay the designation fee, was not allowable, as it would be in breach of Art. 122(5) EPC 1973, according to which re-establishment into periods for payment of designation fees was not allowable.

6. Priority

6.1. Filing of priority documents

Under R. 52(2) EPC, a declaration of priority shall preferably be made on filing the European patent application, but it may still be made with sixteen months of the earliest priority date claimed.

In **J 1/80** (OJ 1980, 289) it was stated that as R. 38(3) EPC 1973 permitted an applicant to file certified copies of the priority documents at any time before the end of the sixteenth month after the date of priority, there was only a deficiency which he must be given an invitation to correct if the priority documents had not been filed at the end of the period. (See now R. 53 EPC).

6.2. Correction of priority declarations

New R. 52(3) EPC concerns the possibility to correct the declaration of priority. New R. 52(2) EPC and (3) EPC apply the time periods laid down in the PCT for the addition or correction of priority claims to Euro-direct applications, with the necessary terminological adjustments, in order to avoid treating Euro-PCT and Euro-direct applications differently. Pursuant to R. 52(3) EPC, an applicant may correct a declaration of priority within 'sixteen months from the earliest priority date claimed, or, where the correction would cause a change in the earliest priority date claimed, within sixteen months from the correct earliest priority date, whichever sixteen-month period expires first, provided that such correction may be submitted until the expiry of four months from the date of filing

accorded to the European patent application'. However, for easy publication, a declaration of priority may not be made or corrected after a request under Art. 93(1)(b) EPC has been filed (R. 52(4) EPC).

The new system thus introduces a significant relaxation of the requirements as compared to R. 38(2) EPC 1973, under which at least the date and State of the previous application had to be indicated on filing. The decisions set out below were reached under the EPC 1973.

Under the EPC 1973, the Legal Board allowed correction of state designations under R. 88, first sentence, EPC 1973 (now R. 139 EPC), early on (**J 8/80**, OJ 1980, 293; **J 12/80**, OJ 1981, 143; **J 3/81**, OJ 1982, 100; **J 21/84**, OJ 1986, 75). Shortly afterwards the rather strict principles developed in these decisions were also applied in cases where correction of priority declarations was at stake. Although a mistake correctable under R. 88, first sentence, EPC 1973 could be an incorrect statement or the result of an omission, all the previous cases related to omitted priority declarations (**J 3/82**, OJ 1983, 171; **J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121; **J 11/89** and **J 7/90**, OJ 1993, 133).

In the four decisions **J 3/91** (OJ 1994, 365), **J 6/91** (OJ 1994, 349), **J 9/91** and **J 2/92** (OJ 1994, 375), the Legal Board refined the principles to be applied to corrections of priority declarations. In **J 6/91** it analysed and summarised the previous case law, pointing out that the applicant had to prove a mistake, i.e. that the document filed with the EPO did not express the true intention of the person on whose behalf it was filed. In the earlier decisions the burden of proof on the applicant was defined as a heavy one. In **J 9/91**, however, the board took the view that the omission of a priority declaration would, in nearly every case, be an error. Thus, as a general rule, there was no need in cases of this kind to require special evidence to discharge the burden on the applicant of proving that a mistake had been made.

Despite the fact that R. 88, first sentence, EPC 1973 allowed correction without any time bar, the Legal Board followed the established case law requiring a request for correction of a priority claim to be made sufficiently early for a warning to be included in the publication of the application (**J 3/82**, OJ 1983, 171; **J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121). This principle was upheld because the EPO, when exercising its discretionary power under R. 88, first sentence, EPC 1973 had to balance the applicant's interest in gaining optimum protection and a third party's interest in maintaining legal security and, in particular, in ensuring that the published application data were correct.

The board noticed, however, that the previous case law in special circumstances already allowed the correction even without such a warning:

- (i) if the EPO was partly responsible for the fact that no warning was published (**J 12/80**, OJ 1981, 143) and/or
- (ii) if the interest of the public was not seriously affected because

- the mistake was obvious (in this sense, implicitly, **J 8/80**, OJ 1989, 293);
- only a second or further priority was added (**J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121; **J 11/89**);
- the public was otherwise informed about the full scope of protection sought by the applicant (**J 14/82**, OJ 1983, 121).

In **J 3/91**, **J 6/91** and **J 2/92** it was held that even after publication of a European patent application without a warning, the priority declaration could be corrected under R. 88, first sentence, EPC 1973 provided that there was an **obvious discrepancy** in the published application indicating that something was wrong. In such a case the interests of third parties were not adversely affected by the correction.

In **J 3/91** the board held that an experienced practitioner could have noticed the obvious discrepancy because the claimed Japanese priority date (31.12.1983) and the European application date (3.1.1984) were close together and the Japanese file number was mentioned.

In **J 6/91** the international application in suit claiming priority from a US continuation-in-part application was itself presented as a continuation-in-part application and referred back to an earlier US application. In view of this and other special circumstances, the board allowed the addition of a (first) priority claim referring to the earlier US application.

In **J 2/92** the US priority date claimed for a PCT application was, owing to a clerical error, a Saturday when the USPTO was closed, instead of the previous Friday. The correct date was indicated on the priority document. Owing to a further clerical error in the request for transmittal of priority documents under R. 17.1(b) PCT (a typing error in the document number), the Receiving Office - in this case the USPTO - transmitted the wrong document to WIPO. The board allowed its replacement even after publication of the international application, adding, however, that this might not always be possible (see also **T 33/06**).

In the parallel cases **T 972/93** and **T 973/93** the examining division had refused a request for the priority date to be corrected. European patent application E1 claimed the priority of a French application F1, from which two French divisional applications F2 and F3 were filed within the priority year claiming the priority of the parent application. At issue in **T 972/93** and **T 973/93** were European applications E2 and E3, which claimed the priority of F2 and F3 respectively. In error however, the filing date of F2 and F3 was given as the priority date. This mistake was detected during examination proceedings, after E2 and E3 had been published with the wrong priority date, because E1 was discovered as a prior right within the meaning of Art. 54(3) EPC 1973 (Art. 54 EPC has been substantially amended - see chapter I.C., novelty).

The board of appeal allowed the correction (following **J 6/91**, OJ 1994, 349), ruling that the mistake was apparent, because only eight months separated the filing date of E2 and E3 from the incorrect priority date, whereas the priority year was usually exploited to the

full. The interests of third parties had not been adversely affected because the precautionary filing of two European divisional applications with respect to E1, which had the same content as F2 and F3, made it possible to gain protection for the subject-matters of E2 and E3 with the priority of F1.

On the other hand, in **J 7/94** (OJ 1995, 817) the board did not allow the correction. It held that the mere fact that an existing priority was not claimed could not justify adding this priority by correction. The correction of priority data, not requested sufficiently early for a warning to be included in the publication of the application, was only allowable if it was justified by special circumstances (confirming **J 6/91**, OJ 1994, 349). See also **T 796/94**.

In **J 11/92** (OJ 1995, 25) it was held that an incomplete priority declaration could be corrected, by the addition of an omitted priority in special circumstances, even after publication of the European patent application without a warning to the public that a request for correction had been made, provided that the public had been informed about the full scope of European patent protection sought, by way of a second European or Euro-PCT patent application, filed as a precautionary measure by the applicant in due time (referring to **J 6/91**, OJ 1994, 349).

In **T 713/02** (OJ 2006, 267), the board held that the examination of a request for correction of priority data after the publication of the application was not to be restricted to that portion of the facts and circumstances which in a decision of a board of appeal in another case were considered not to preclude the correction. Therefore, in the case before the board, it could not be ignored that the requested correction by addition of an earlier priority date would eliminate from the state of the art pursuant to Art. 54(2) EPC 1973 a highly relevant document, which the applicant had previously de facto accepted as comprised in that state of the art (see, however, the Notice from the European Patent Office regarding decision **T 713/02** (OJ 2006, 293), according to which the EPO's departments of first instance do not, for the time being, follow the findings that no decisions, except where a total loss of rights should be remedied, may be taken in the applicant's favour prior to the decisions terminating the granting procedure).

In **J 16/08** the request for correction of the designation of states was allowed in the unusual circumstances of the case. Following the case law summarised in **J 7/90** (OJ 1993, 133) and endorsed in **J 6/02**, the board applied the three conditions to be met by such a request for correction - firstly, that the error was an excusable oversight; secondly, that the request for correction was filed without undue delay upon discovery of the error, and thirdly, that the request for correction was, in the public interest, made early enough to enable publication of a warning with the European patent application. No such warning was required in the circumstances of this case, as the application had erroneously been published showing all contracting states as designated. Third parties were therefore not prejudiced by the correction, since no publication had ever indicated that the territorial scope of the invention was limited to two contracting states.

7. Applicability of Article 110(3) EPC 1973 (Rule 100(3) EPC)

The Legal Board held in **J 29/94** (OJ 1998, 147), that if the appellants fail to reply in due time to an invitation under Art. 110(3) EPC 1973, the European patent application was deemed withdrawn, even if the appeal relates to formal points, as the effect of the appeal, namely that the board of appeal is now competent for the case, applied to the entire application (see Chapter VII.D.3, devolutive effect of appeal).

R. 100 EPC combines a reworded R. 66(1) EPC 1973 and Art. 110(2) and (3) EPC 1973 and concerns the examination of appeals. If the applicants fail to reply in due time to an invitation under R. 100(2) EPC, the European patent application is deemed to be withdrawn under R. 100(3) EPC.

8. Publication of the application

In **J 5/81** (OJ 1982, 155) it was stated that the key date for completion of the technical preparations for publication under Art. 93 EPC 1973 specifiable pursuant to R. 48(1) EPC 1973 could be said to give the applicant a certain minimum period of time within which his withdrawal of the application also prevented its publication. If the application was not withdrawn until after the key date, the applicant could no longer rely on its not being published. Nevertheless, the EPO was allowed by law to prevent publication, at its own discretion. See now Art. 93(1) EPC, and R. 67(1) and 68(1) EPC.

B. Examination procedure

1. Request for examination

1.1. General issues

Under the EPC 2000 Art. 94 EPC combines former Art. 94 and 96 EPC 1973, and deals with the initiation as well as the conduct of the examination procedure. Art. 94(1), first sentence, EPC is nearly identical with Art. 94(1) EPC 1973. R. 70 EPC regulates the practical arrangements for filing the request for examination, including the form and the time limit. R. 70(1) EPC stipulates that the applicant may request examination of the European patent application up to six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request may not be withdrawn. R. 70(1) EPC contains the details relating to the request for examination under Art. 94(2) EPC.

According to Art. 94(1) EPC, the European Patent Office shall, in accordance with the Implementing Regulations, examine on request whether the European patent application and the invention to which it relates meet the requirements of this Convention. The request shall not be deemed to be filed until the examination fee has been paid (Art. 94(1), second sentence, EPC; former Art. 94(2) EPC 1973).

In **J 21/98** (OJ 2000, 406) the board stated that Art. 94(2) EPC 1973, especially when considered in connection with the provisions of Art. 75 EPC 1973 (governing the filing of

the European patent application), Art. 92 EPC 1973 (concerning the European search report), and paragraph 1 of the same Art. 94 EPC 1973, had to be interpreted in the sense that, within the granting procedure, the request for examination constituted an autonomous step, which had to be kept quite separate from the (previous) step of filing the European patent application. In particular, the provision of Art. 94(1) EPC 1973, pursuant to which, for the examination of the application to be started, the applicant had to file a written request, showed that, according to the Convention, the patent application was not considered as the only necessary step to be taken by the applicant to obtain the grant of a patent, since a further step was necessary, consisting in a written request for examination - that meant a new declaration of intention to continue the grant procedure. Thus the applicant was given the right to know the outcome of the search report before deciding whether to ask for the prosecution of the grant procedure by means of the request for examination, which implied the payment of the related fee, or to drop said procedure. The provisions of the Convention were indeed clearly aimed at giving the applicant the possibility to properly consider the convenience of a further prosecution of the grant procedure in the light of the outcome of the search report.

In **J 12/82** (OJ 1983, 221) the board found that the unequivocal terms of Art. 94 EPC 1973 did not permit any wide interpretation - in fact the Article required that the request be written, filed within a certain period and accompanied by payment of the fee within the same period. In addition it should be noted that the authors of the EPC 1973, i.e. the contracting states, gave the request filed within the time limit extensive effects: it could not be withdrawn (Art. 94(2), last sentence, EPC 1973), yet on the other hand, if it was filed late the patent application was automatically deemed to be withdrawn (Art. 94(3) EPC 1973). The board held that the mere payment of the examination fee within the time limits provided for in Art. 94(2) EPC 1973 could not be a substitute for filing the request itself in good time. EPO Form 1001.1 for request for grant now contains the written request for examination.

In **J 25/92** the board found that in so far as the applicant for a European patent application had to use the EPO forms, he only had to ensure that the examination fee was paid in time, as the first condition - that the request be written and filed within a certain period - was fulfilled. That meant that the payment of the fee in due time really constituted the request.

In **J 4/00** the board held that a request for examination under Art. 94 EPC 1973 required, over and above payment of the examination fee, that the underlying intention of an applicant that his application should proceed to examination was manifested in a written statement made by the applicant or his representative addressed to the EPO and received there in time. While this requirement was quite distinct from that of payment of the examination fee, there was no prescribed form of words for a request for examination which could be contained in the same document as a debit order or other payment instruction. To qualify as a request for examination, in the circumstances of the case the only reasonable interpretation of the text filed with the EPO had to be that the applicant thereby wanted to inform the EPO that he wished to have the application examined pursuant to Art. 94 EPC 1973.

1.2. Request for examination under Rule 70 EPC

R. 70(1) EPC stipulates that the applicant may request examination of the European patent application up to six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request may not be withdrawn. R. 70(1) EPC contains the details relating to the request for examination under Art. 94(2) EPC.

Under the EPC 2000 the substance of former Art. 96(1) and (3) and R. 51(1) EPC 1973 has been incorporated in R. 70(2) and (3) EPC.

Under R. 70(2) EPC (former Art. 96(1) EPC 1973) if the request for examination has been filed before the European search report has been transmitted to the applicant, the European Patent Office shall **invite the applicant** to indicate, within a period to be specified, **whether he wishes to proceed further** with the application, and shall give him the opportunity to comment on the search report and to amend, where appropriate, the description, claims and drawings.

In **J 8/83** (OJ 1985, 102) and **J 9/83** the board found that if a supplementary European Search report has to be drawn up in respect of an international application which was deemed to be a European patent application, the applicant was entitled to receive the invitations provided for in Art. 96(1) EPC 1973 and R. 51(1) EPC 1973. Since in the case of such an international application, responsibility for examination of the application did not pass to the examining division until the applicant had indicated under Art. 96(1) EPC 1973 that he desired to proceed further with his application, the applicant might obtain a refund of the examination fee if in response to the invitation under Art. 96(1) EPC 1973 he withdrew his application, or allowed it to be deemed to be withdrawn.

The board noted that the provisions of Art. 96(1) EPC 1973 and R. 51(1) EPC 1973 clearly operated in the respective interests of applicants, third parties and the EPO by encouraging applicants to review their applications critically and realistically in the light of the European search report, before substantive examination began. The opportunity given by the EPO to obtain a refund of the substantial fee for examination by withdrawing the application at that stage, or allowing it to be deemed to be withdrawn, provided an additional incentive to withdraw cases which were unlikely to succeed.

1.3. Amendments after receipt of the European search report

Before receiving the European search report, the applicant may not amend the description, claims or drawings of a European patent application unless otherwise provided. After receipt of the European search report, the applicant may, of his own volition, amend the description, claims and drawings (R. 137(1), (2) EPC, former R. 86(1), (2) EPC 1973).

In **J 10/84** (OJ 1985, 71) the board noted that the general purpose of R. 86(2) EPC 1973 was to permit the applicant for a European patent to make voluntary amendments in order to take the results of the European search report into account.

Following receipt of the European search report and before receipt of the first communication from the examining division, the applicant may, of his own volition, amend the description, claims and drawings (R. 86(2) EPC 1973). Moreover, since he has the right under R. 51(1) EPC 1973 to comment on the European search report at that stage, he can expect to receive the examining division's response to his comments in the first communication, which can be to his advantage because of his right to submit amendments with his reply to that communication (R. 86(3) EPC 1973; see **J 8/83**, OJ 1985, 102 and **J 9/83**).

2. Substantive examination of the application

2.1. Communications pursuant to Article 94(3) EPC and Rule 71(1) EPC

The purpose of the examination is to ensure that the application and the invention to which it relates, meet the requirements set out in the relevant articles of the Convention and Rules of the Implementing Regulations.

Under the EPC 2000, Art. 96(2) EPC 1973 has been incorporated in the new Art. 94(3) EPC. According to Art. 94(3) EPC if the examination reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the examining division shall invite the applicant, **as often as necessary**, to file his **observations** and, subject to Art. 123(1) EPC to **amend the application**. In line with EPO practice, it has now been made clear that the EPO may not only invite the applicant to file his observations, but may also invite him to amend the application in accordance with Art. 123 EPC.

Further, according to R. 71(1) EPC (former R. 51(2) EPC 1973) in any communication under Art. 94(3) EPC the examining division shall, where appropriate, invite the applicant to **correct any deficiencies** noted and to amend the description, claims and drawings within a period to be specified.

According to the established case law of the boards of appeal, it is left to the examining division's discretion to decide whether to issue a **further invitation**. The words "as often as necessary" indicate that the examining division may use its discretion to act according to the circumstances. Under Art. 113(1) EPC, however, it is not necessary to give the applicant repeated opportunities to comment on the examining division's submissions if the main objections to the grant of a European patent remain the same. A further invitation to present comments following a substantiated communication in which deficiencies were recorded is only appropriate if it would appear likely that, in the light of the applicant's reply, the examination proceedings would terminate in the granting of a patent (see **T 84/82**, OJ 1983, 451; **T 161/82**, OJ 1984, 551; **T 162/82**, OJ 1987, 533; **T 243/89**, **T 300/89**, OJ 1991, 480; **T 793/92** and **T 516/93**).

In **T 640/91** (OJ 1994, 918) the board stated that the requirement in Art. 96(2) EPC 1973 that the examining division must invite the applicant to file his observations "as often as necessary" implicitly recognised that in certain circumstances the examining division would be legally **obliged** to invite further observations from the applicant before issuing a

decision. Having regard to Art. 113(1) EPC 1973, there was a "necessary" legal obligation for an examining division to invite further observations from an applicant before issuing a decision adversely affecting him, where the division might be inclined to issue an immediate decision on the ground that he had shown lack of good faith in his previous observations. The board pointed out, moreover, that it was in principle not the function of an examining division to assess either the degree of collaboration from applicants or their good faith when deciding whether or not to invite further observations in the exercise of its discretion under Art. 96(2) EPC 1973. The exercise of this discretion depended primarily upon whether or not there was a reasonable prospect that such an invitation could lead to the grant of a patent (see also **T 855/90**, in which the board found that the examining division had exercised its discretion unreasonably).

In **T 802/97** the board noted that when applying Art. 96(2) EPC 1973 to determine in a specific case whether an applicant should be given a further opportunity to present comments or amendments before refusing an application after a single official communication, the established practice of the examining divisions as set out in particular in the Guidelines for Examination in the EPO is to **warn** the applicant who had made a **bona fide attempt** to deal with the examining division's objections, e.g. by a telephone conversation or by a short further written action, that the application will be refused unless he can produce further more convincing arguments or makes appropriate amendments within a specified time limit. Only when the applicant has not made any real effort to deal with the objections raised in the first communication, should the examining division consider immediate refusal of the application, this however being an exceptional case.

In **T 201/98** the board accepted that in the case at issue the appellant's response to the single communication was a bona fide attempt to deal with the examining division's objections. However it was the established jurisprudence of the boards of appeal that an examining division did not exceed its discretionary power by immediately refusing an application, provided that the decision complied with Art. 113(1) EPC 1973, i.e. was based on grounds on which the appellant had had an opportunity to present comments, see **T 84/82** (OJ 1983, 451) and **T 300/89** (OJ 1991, 480). In the case before it, the board considered that the decision of the examining division was based on grounds on which the appellant had had an opportunity to present comments in accordance with Art. 113(1) EPC 1973.

In **T 1002/03** the board stated that it was established jurisprudence of the boards of appeal that an examining division did not exceed its discretionary power pursuant to Art. 96(2) EPC 1973 ("as often as necessary") by proceeding to an immediate refusal after a first communication, provided that the decision complied with Art. 113(1) EPC 1973, i.e. was based on grounds on which the appellant had had an opportunity to present comments. In the case in point, the examining division's first and only official communication under Art. 96(2) EPC 1973 stated that the deficiencies mentioned in the IPER gave rise to objections under the corresponding provisions of the EPC. In reply to the official communication the appellant filed a new set of claims in which only claim 1 had been amended to overcome the objection of lack of clarity in the IPER. In the board's view **no special warning** in the official communication was necessary in these

circumstances. Accordingly the appellant's right to be heard (Art. 113(1) EPC 1973) was not violated and the examining division did not exercise its discretion in an unreasonable way by refusing the application after a single official communication.

In **T 89/93** the board again held that the examining division could not refuse an application after a first communication if the applicant had made a **serious attempt** to overcome the objections raised or if it appeared likely that continuing the procedure would lead to a positive result. Following **T 908/91**, the board decided, however, that reimbursement of the fee for appeal would not be equitable.

In **T 79/91** the board held that the refusal of the application after only one communication was not contrary to Art. 96(2) EPC 1973 because it was unlikely that further communications would have produced a positive result.

In **T 63/93** the board stated that a patent application could be refused after the first communication if the applicant's response failed to convince the examining division, particularly where the claimed subject-matter had not been substantially modified (see also **T 66/83** and **T 304/91**).

In **T 246/08** the communication under Art. 96(2) EPC 1973 was sent with a time limit of one month. The board noted that Art. 120 EPC states that the Implementing Regulations shall specify inter alia the time limits which are to be observed in proceedings before the EPO and are not fixed by the Convention. R. 132(2) EPC (former R. 84 EPC 1973) stipulates that, unless otherwise provided, a period specified by the EPO may be neither less than two months nor more than four months. Although, in some circumstances, this period may be extended, it may not be shortened. The sending of a communication setting a time limit of only one month, and stipulating that failure to respond in due time would result in the application being deemed withdrawn (Art. 96(3) EPC 1973), amounted to a further substantial procedural violation, since it deprived the applicant of its right to the conventional minimum period of two months to prepare and submit its response.

2.2. Contents of a communication according to Article 94(3) EPC and Rule 71(2) EPC

Under the procedure set out in Art. 94(3) EPC, (former Art. 96(2) EPC 1973) any communication shall contain **a reasoned statement** covering, where appropriate, **all the grounds** against the grant of the European patent (R. 71(2) EPC, former R. 51(3) EPC 1973). Moreover, the examining division should invite applicants as often as necessary to file their comments.

In **T 5/81** (OJ 1982, 249) the appellant submitted that, in the only communication sent, the examiner had failed to comment on claim 5, an omission which was contrary to Art. 96(2) EPC 1973 and R. 51(3) EPC 1973. The board noted that an appeal might relate only to a decision subject to appeal within the meaning of Art. 106(1) EPC 1973 and not to preparatory measures. Art. 96(2) EPC 1973 and R. 51(3) EPC 1973 applied exclusively to that **preparatory procedure**. A failure to comply with these requirements

could not be taken into consideration unless it had some influence on the decision to refuse, as in the case of a breach of Art. 113(1) EPC 1973. The appellant's objection was unfounded, not only for this reason, but also because the examiner commented on the content of the claim in question by drawing attention to the possibility of formulating an independent claim based thereon. Since the appellant did not make use of that possibility, the examining division was not obliged to discuss it when refusing the application. The allusion thereto in the reasons for the decision did not form part of the *ratio decidendi* and was intended solely to demonstrate that the examining division was aware of the fact that the application might contain patentable subject-matter. A refusal under these circumstances was not open to challenge.

In **T 161/82** (OJ 1984, 551) the board noted that a distinction had to be made between the grounds on which a decision was based (ie the requirements of the Convention which were not satisfied by the application or the invention to which it related) and the reasoned statement explaining in greater detail why the examining division was of the opinion that such grounds existed (see R. 51(3) EPC 1973). Art. 113(1) EPC 1973 did not require an applicant to be given repeated opportunity to comment on arguments of the examining division so long as the decisive objections to the grant of the European patent remained the same except for some supplementary observations concerning the applicant's arguments which did not convince the examining division.

In **T 568/89** the board held that whether the given reason was correct or not was a matter of judgment and not of procedure.

In **T 20/83** (OJ 1983, 419) the board noted that Art. 96(2) EPC 1973 prescribed that the examining division had to draw all obstacles to patentability to the applicant's attention. This conclusion related to the requirements for patentability as laid down in the Convention itself. The validity of a patent in various contracting states was however not an immediate condition under the Convention (see **T 830/91**, OJ 1994, 728).

In **T 98/88** the board pointed out that R. 51(3) EPC 1973 did not make it compulsory for communications in accordance with Art. 96(2) EPC 1973 to set out all the grounds against the grant of the patent. The board's view in this case was that deferral of the examination in respect of the requirements under Art. 52 EPC 1973 until a clear version of the claims had been received did not conflict with R. 51(3) EPC 1973.

2.3. Amendments after receipt of the first communication (Rule 137(3) EPC)

After receipt of the first communication from the examining division, the applicant may, of his own volition, amend once the description, claims and drawings, provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the examining division (R. 137(3) EPC, former R. 86(3) EPC 1973).

In **T 229/93** the board found that in the circumstances of the case at issue the examining division should have considered refusing to consent to the amendments pursuant to R. 86(3) EPC 1973, since the filing of such amendments after the expiry of the time limit

for answering the first communication of the examining division in the form of a completely retyped description was contrary to the requirement of procedural economy (see **T 113/92**).

In **T 300/89** (OJ 1991, 480) the board pointed out that, even if it were possible for the examiner to envisage amendments which might lead to the grant of a patent, the burden lay with the applicant to propose amendments if he so wished (including various alternatives in the form of auxiliary requests). These amendments could be proposed in the applicant's observations in reply to the first communication (Art. 96(2) EPC 1973) from the examining division, where any objections were raised (**T 599/92**). It also held that an applicant had a right to request oral proceedings at any time, but if he wished to avoid the risk of an adverse decision being issued without oral proceedings being appointed, he should request oral proceedings at the latest in his observations in reply to such (here, first) communication under Art. 96(2) EPC 1973.

2.4. Admissibility of further amendments (Rule 137(3) EPC)

Under Art. 123(1) EPC, a European patent application or a European patent may be amended in proceedings before the EPO, in accordance with the Implementing Regulations. R. 137(3) EPC (former R. 86(3) EPC 1973) is of particular relevance.

R. 137(3) EPC stipulates that after receipt of the first communication from the examining division, the applicant may, of his own volition, amend once the description, claims and drawings, provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the examining division." It is therefore a matter of **discretion** for the latter.

In giving or withholding such consent, the examining division has to exercise its discretion responsibly and in accordance with the principles as set out in the decision **G 7/93** (OJ 1994, 775) which, although made in relation to amendments made in the pre-grant stage, are of general validity. The Enlarged Board pointed out that in the exercise of its discretion under R. 86(3) EPC (now R. 137(3) EPC), an examining division is required to consider **all relevant factors** which arise in a case. In particular, it must consider both the applicant's interest in obtaining a patent which is legally valid in all of the designated states, and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent, and must balance these interests against one another (**T 1982/07**).

Once an examining division has exercised such discretion, a board of appeal should only overrule it if it comes to the conclusion either that the examining division did not exercise its discretion in accordance with the right principles or that it exercised its discretion in an unreasonable way and had thus exceeded the proper limit of its discretion (see **T 237/96** with particular reference to **G 7/93**, OJ 1994, 775 and **T 182/88**, OJ 1990, 287).

In **T 43/83** the board noted that according to R. 86(2) and (3) EPC 1973 an applicant was entitled to amend his application twice of his own volition. In the case at issue the applicant had not availed himself of these two opportunities. According to R. 86 (3) EPC

1973 he needed the consent of the examining division for further amendments, so that the examining division was fully entitled to decide on the application after the first communication and to refuse the application exclusively on grounds which had already been mentioned in their first communication, thus satisfying Art. 113(1) EPC 1973 as well.

In **T 951/97** the board noted that whether or not consent was given was at the discretion of the examining division and depended on the facts of the individual case, on the nature of the grounds for seeking an amendment, and equally on the stage of the procedure. It was easier to secure an amendment at an earlier rather than at a later stage (see **T 529/94** and **T 76/89**).

In **T 1105/96** (OJ 1998, 249) the board noted that the admissibility of any main or auxiliary request which was filed after the reply to the first communication from the examining division was a matter within the discretion of the examining division (R. 86(3) EPC 1973). Such discretion must be exercised lawfully having regard to the relevant circumstances. In a case such as this, where an examining division had indicated that a further request in the form of an amended text for the main claim of an application would be allowable, it was difficult to imagine any circumstances in which it would be lawful for the examining division to deny the admissibility of such request, in the exercise of such discretion. Certainly, in the circumstances of the case at issue, the rejection in advance of such a further auxiliary request unless all preceding requests were abandoned was an abuse of procedure, an unlawful exercise of discretion under R. 86(3) EPC 1973 and thus a substantial procedural violation within the meaning of R. 67 EPC 1973.

In **T 166/86** (OJ 1987, 372) the board held that under R. 86(3) EPC 1973, further amendments - which included the submission of a separate set of claims for a given contracting state - could only be made with the consent of the examining division (see Legal Advice No. 4/80, OJ 1980, 48). The examining division had to take the decision on whether to consent to the requested amendment after due assessment of the particular circumstances. In particular, this involved balancing the EPO's interest in speedy completion of the proceedings against the applicant's interest in obtaining a patent which was legally valid in all the contracting states. The examining division would not be able to refuse its consent to an amendment if, for good reasons, the applicant was only at that late stage in a position to request the amendment, or if the requested amendment was obviously essential for him and to take it into account would not appreciably delay the grant procedure. In the board's view, the latter situation was the case here.

In **T 182/88** (OJ 1990, 287) and **T 166/86** (OJ 1987, 372), the board decided that a separate set of claims submitted at a late stage in the proceedings was admissible under the particular circumstances. It added that the EPO's user-friendly reputation should clearly be excluded from consideration during the exercise of any discretion by the EPO. The showing of consideration towards parties before the EPO should not be confused with the proper exercise of discretion according to the law. It was also held that when a decision hinged on the exercise of discretion, the **reasons should be given**.

In **T 872/90** the board held that neither the remark "the applicant has already once amended the claim" nor a reference to R. 86(3) EPC 1973 could be considered to represent a reasoning because, in the board's opinion, such statements solely constituted a reference to the power given to the examining division by the this rule.

In **T 246/08** the examining division declared in a fax that no consent was given to further amendments under R. 86(3) EPC 1973. A similar declaration, stating that no further amendments were consented to, was reiterated in the minutes of the oral proceedings and in a subsequent communication, although the minutes contained a new argument. The board stated that it is the established jurisprudence of the boards of appeal that the power of the examining division to consent to amendments under R. 137(3) EPC is a discretionary power that has to be exercised after considering all the relevant factors of the specific case and balance in particular the applicant's interest in obtaining an adequate protection for his invention and the EPO's interest in bringing the examination to a close in an effective and speedy way. Moreover, the exercise of a discretionary power has to be reasoned, otherwise it would be arbitrary. Thus, in **T 872/90** the then deciding board held that neither the remark "the applicant has already once amended the claim" nor a reference to R. 86(3) EPC 1973 could be considered as reasoning, because such statements solely constituted a reference to the power given to the examining division by the above rule. It followed that a refusal of consent to amend made in advance of any amendment being submitted could not be a reasonable exercise of discretion pursuant to R. 137(3) EPC. Indeed in the judgement of the board it was ipso facto a substantial procedural violation since it risked deterring an applicant from making an amendment which could not reasonably have been forbidden. The board made it clear that there was a world of difference between a pre-emptive formal declaration that no amendments would be admitted and advising the applicant that a discretionary power to permit or refuse amendment exists and would be exercised in the event that amendments were submitted.

2.5. Amendments relating to unsearched subject-matter

Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept (R. 137(4) EPC; former R. 86(4) EPC 1973).

In **T 442/95**, at the beginning of the substantive examination, the examining division had raised a lack of unity objection against the claims as filed on the basis of the finding that these related to three different groups of inventions. Later, the appellants filed amended claims based on the subject-matter of the three groups. These claims were refused by the examining division on the grounds of lack of novelty. In the appeal proceedings the appellants submitted new claims, based on subject-matter which did not appear in the claims as filed. They submitted that the description of this newly claimed subject-matter was to be found in the description. In the board's judgment, the subject-matter claimed had not been searched and did not combine with the originally claimed and searched groups of inventions to form a single general inventive concept. There was no need at this stage to investigate whether the application as filed provided support for such a claim, because under R. 86(4) EPC 1973 the claim was not admissible. The only path

open to the appellants was to pursue the subject-matter of said claim in the form of a divisional application.

In **T 613/99**, the EPO as International Searching Authority considered that the invention forming the subject-matter of claims 1 and 2 of the international application related to acts excluded from patentability. On the basis of R. 39(1)(iii) PCT, it refrained from searching these two claims but established an international search report on the remaining claims. The examining division having stated in a later communication that claims 1 and 2, in view of the amendments made to them, no longer concerned subject-matter excluded from patentability, the applicants responded by filing a fresh set of claims comprising these two claims only. Subsequently, the examining division refused the European patent application, explaining that R. 86(4) EPC 1973 was applicable in this case since the amended claims related to matter which had not been the subject of an international search.

The board of appeal decided that this line of argument was not acceptable. It stated that R. 86(4) EPC 1973 referred to a particular situation, i.e. where subject-matter was described but not claimed in the original application and was therefore not searched; where that subject-matter failed to meet the requirement for unity of invention with the matter claimed in the application; and where, following the search report, the applicants had filed fresh claims relating only to this unsearched matter. In this situation, the patentability of these fresh claims could not be examined in the context of the original application, since this would have amounted to a derogation from the principle endorsed in **G 2/92** (OJ 1993, 591), according to which the invention to be examined had to be an invention for which a search fee had been paid. In the case at issue, the situation was entirely different. The claimed subject-matter in the application under consideration had been claimed in the original application and had therefore been searched, even if it had not been possible to carry out a meaningful search. Moreover, the invention forming the subject of claims 1 and 2 of the application at issue was substantially the same as that which formed the subject of claims 1 and 2 of the original application. In such a situation, if the examining division rejected a finding of the search division regarding matter excluded from the search, a so-called additional European search could be carried out at the request of the examining division.

In **T 443/97** the appellant (opponent) had argued that the amended claim contravened R. 86(4) EPC 1973. The board stated that the amended claim did not relate to unsearched subject-matter. Moreover, it pointed out that R. 86(4) EPC 1973 related to issues concerning lack of unity of invention. It was also clear from the EPO Notice dated 1.6.1995 (OJ 1995, 409) that R. 86(4) EPC 1973 concerned examination proceedings, and particularly those cases in which no further search fees requested by the search division for non-unitary subject-matter had been paid by the applicant. The purpose of R. 86(4) EPC 1973 was to exclude any amendment which circumvented the principle according to which a search fee must always be paid for an invention presented for examination. The board noted that unity of invention was a requirement of an administrative nature and that the administrative purposes of this requirement were fulfilled when the examination procedure had been concluded, i.e. when the patent had

been granted (see **G 1/91**, OJ 1992, 253). Therefore, R. 86(4) EPC 1973 was not relevant for the opposition case at issue.

In **T 708/00** (OJ 2004, 160) the application had been refused by the examining division, principally on the grounds that the new claims were not allowable under R. 86(4) EPC 1973. The board pointed out that R. 86(4) EPC 1973 did not apply when the applicant had not paid the search fee in respect of a non-unitary invention relating to the originally filed claims in spite of being invited to do so under R. 46(1) EPC 1973. In that case, the application could not be examined further, and a divisional application would have to be filed if protection were sought (see **G 2/92**, OJ 1993, 591). Under R. 86(4) EPC 1973, amended claims could only be refused if the subject-matter of the claims filed originally and that of the amended claims was such that, had all the claims originally been filed together, a further search fee would have been payable - on top of the search fees payable in respect of the claims actually filed at the outset - in respect of the amended claims, relating to a different invention within the meaning of R. 46(1) EPC 1973 (see also **T 319/96** and **T 631/97**, OJ 2001, 13).

The board noted that a subsequent amendment to limit the subject-matter of the main claim by additional features disclosed in the application as filed did not generally affect the notion of unity of invention under either R. 86(4) or R. 46(1) EPC 1973.

In **T 353/03** the examining division had stated in its decision of refusal that the new feature in claim 1 had not been searched and that, for that reason, the application was refused according to Art. 97(1) in conjunction with R. 86(4) EPC 1973. The board observed that the ground for refusal under R. 86(4) EPC 1973 had been raised in the appealed decision for the first time with respect to the subject-matter of claim 1 underlying the decision. The applicant had thus had no opportunity to present his comments before the decision was issued. That contravened the applicant's rights as laid down in Art. 113(1) EPC 1973 and amounted to a substantial procedural violation.

The board found that in its decision the examining division did not take into account the fact that R. 86(4) EPC 1973 mentioned another condition which also had to be fulfilled for amended claims to be rejected, namely that the unsearched subject-matter did not combine with the originally claimed invention to form a single general inventive concept (lack of unity). There was no discussion in the appealed decision as to why the subject-matter of new claim 1 was not in unity with original claim 1. The board came to the conclusion that the appealed decision was not reasoned within the meaning of R. 68(2) EPC 1973.

R. 86(4) EPC 1973, which was introduced with effect from 1.6.1995, was intended to prevent amendments of the application which circumvent this principle that a search fee must always be paid for an invention presented for examination. R. 86(4) EPC 1973 stops applicants switching to unsearched subject-matter in the reply to a communication from the examining division and makes means available for the EPO to react when different subject-matter is claimed not simultaneously but in sequence as is the case when the applicant drops the existing claims and replaces them with originally non-

unitary subject-matter extracted from the description (**T 274/03**; with regard to R. 86(4) EPC 1973, see Notice of 1.6.1995, OJ 1995, 409, 420 et seq.).

In **T 274/03** the board noted that it was clear that post-search "switching" of subject-matter clearly implied a significant change in the nature of the subject-matter being claimed which was not normally comparable to the addition of features taken from the description to further define an element that was already a feature of the original main claim. The board was of the opinion that an amendment amounting to the restriction of an original main claim by including complementary features from the original description into the claim represented an admissible reaction of an applicant vis-à-vis an objection against the patentability of the unamended claim and did not constitute an abuse of the system of the nature which R. 86(4) EPC 1973 was introduced to prevent (**T 377/01** and **T 708/00**). This type of amendment should not therefore in general be judged as contravening the requirements of the rule, **even though an additional search could be required**. In this context it was to be observed that the implicit finding of lack of unity between the originally claimed and later claimed subject-matter, which was a prerequisite for an objection under R. 86(4) EPC 1973, had to, with amendments of the type under consideration here, be a posteriori. The Guidelines for Examination in the EPO made it clear however that this form of objection to lack of unity should be the exception, with benefit of the doubt being given to the applicant (see also Guidelines C-III, 7.7 - April 2010 version).

In **T 1242/04** (OJ 2007, 421) during the search phase a declaration under R. 45 EPC 1973 was sent to the applicant reminding him that a search would be carried out during examination if the deficiencies that necessitated a R. 45 EPC 1973 declaration were corrected. During the examination phase, no "additional" search was carried out. The examining division refused the European patent application for lack of technical character in accordance with Art. 52(2) and (3) EPC 1973.

The board noted that R. 45 EPC 1973 applied to cases which did not comply with the provisions of the Convention to such an extent that it was not "possible" to carry out a "meaningful search" into the state of the art on the basis of all or some of the claims. Thus a R. 45 EPC 1973 declaration was allowed only where a search was not possible. In other cases the search division would draw up a partial search report, "so far as is practicable". In the board's view, R. 45 EPC 1973 related only to the practicability of a search and not to the potential relevance of its results in subsequent substantive examination. That was clear from the actual wording of the rule, which referred to the impossibility of carrying out a meaningful search in the event of serious violations of the provisions of the Convention, for example a fundamental lack of clarity or the absence of any technical character whatsoever. If these criteria were not met, searching could not be refused by reference to R. 45 EPC 1973, regardless of whether the search in the search division's view would not produce any result of significance to subsequent proceedings. In the final analysis, the search is the basis for substantive examination (and now also for the extended European search report under R. 44a EPC 1973, and not vice versa. Moreover, it was not evident that claims directed only to technical features that the search division deemed "trivial" could prevent a meaningful search into the state of the art, which in fact ought to be particularly simple in such a case. The board held

that where the application's subject-matter had non-technical aspects, a declaration under R. 45 EPC 1973 might be issued only in exceptional cases in which the claimed subject matter, i.e. the entire set of claims including parallel and dependent claims, clearly had no technical character. In the board's view, however, it was not always necessary in such circumstances to carry out an additional search in the documented prior art. According to the established case law of the boards of appeal it was possible to raise an objection of lack of inventive step without documented prior art (see e.g. **T 939/92**, OJ 1996, 309). That should be allowable where the objection was based on "notorious knowledge" or indisputably forms part of the common general knowledge. In such cases it would be inappropriate to carry out an additional search for documented prior art on purely formal grounds (see also **T 690/06**).

In **T 1515/07** the board noted that according to the case law of the boards of appeal an examining division need not carry out an additional search if the technical features of the claims are notoriously well known. In the case at issue the examining division, starting from the prior art acknowledged by the applicant in the description and submitted at the oral proceedings, identified a combination of technical features not known from this prior art, but considered obvious for a skilled person. The examining division did not find these features notorious. In other words, the case was, in the examining division's view, a perfectly normal one, where the invention differed from the closest prior art by certain technical features and any objection based on lack of inventive step required substantive evidence and argument.

The board held that in such normal circumstances an additional search had to be carried out if a search under R. 63 EPC had not been carried out. It was true that the case law allowed discretion in this respect, but this discretion was limited to the special cases of notoriously known features or those explicitly accepted by the applicant as known. In all other cases, an additional search had to be performed (see **T 690/06**, point 2 of the reasons). In particular, as long as no search had been performed an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contained at least one technical feature which was not notorious (see **T 690/06**). According to the examining division's own judgment, the present case did not fall under the above exceptions. The examining division instead considered that it was not "necessary" to carry out a search because a decision could be reached anyway. However, the general acceptance of this argument would lead to the conclusion that substantive examination served as a basis for the search and not vice versa, a finding that decision **T 1242/04** explicitly warned against. Under these circumstances the examining division was held to have committed a substantial procedural violation within the meaning of R. 103(1)(a) EPC by not performing an additional search that was manifestly necessary. It was therefore equitable to reimburse the appeal fee. The board also held that an express request for a search was not provided for (see Art. 92(1) EPC), and expedience was no justification for leaving out an obligatory procedural step.

In **T 690/06** regarding the procedure before the examining division the board was of the opinion that the examining division should have performed an additional search since the database partitioning and access control features were neither non-technical nor notorious. Following the principles set out in decision **T 1242/04** (OJ 2007, 421), the

board considered that, as long as no search has been performed, an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contained at least one technical feature which was not notorious. The term "notorious" had to be interpreted narrowly.

2.6. Issue of a further communication under Article 113(1) EPC

Under Art. 113(1) EPC, the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

In **T 734/91** the applicant had filed a fresh set of claims to overcome all the objections mentioned in the examining division's communication. The board confirmed that the applicant should not be given repeated opportunities to comment on the same objections but pointed out that, where an applicant had made a **bona fide attempt** to overcome the objections raised by the examining division, Art. 113(1) EPC 1973 might require him to be given the opportunity to present his comments on the grounds for refusing the amended claims.

In **T 907/91** the examining division refused the application without informing the applicant of its grounds for not accepting the amended documents submitted after receipt of the first communication and after oral proceedings. The board held this action to be in breach of Art. 113(1) EPC 1973 because, prior to issuing the contested decision in written or oral proceedings, the examining division should have given its reasons for refusing to accept the amended documents. Such grounds could be of a formal nature or relate to substantive patent law, depending on the relevant provisions. However, other grounds could also be brought to bear, based on generally recognised principles of procedural law (see Art. 125 EPC 1973), such as the applicant's attempt to delay proceedings by submitting an excessively large number of requests for amendments in clear abuse of the patent grant procedure.

In **T 951/92** (OJ 1996, 53) the board summed up the case law by stating that Art. 113(1) EPC 1973 was intended to ensure that, before a decision refusing an application for non-compliance with a requirement of the Convention was issued, the applicant had been **clearly** informed by the EPO of the essential legal and factual reasons on which the finding of non-compliance was based. This was so that in advance of the decision he knew both that the application might be refused and why, and also so that he might have a proper opportunity to comment upon the reasons and/or to propose amendments so as to avoid refusal of the application. Thus the term "grounds or evidence" in Art. 113(1) EPC 1973 should **not** be **narrowly** interpreted. In particular, in the context of the examination procedure the word "grounds" did not refer merely to a ground of objection to the application in the narrow sense of a requirement of the Convention which was considered not to be met. The word "grounds" should rather be interpreted as referring to the **essential reasoning**, both legal and factual, which led to refusal of the application (**T 187/95**). In other words, before a decision was issued an applicant had to be informed of the requirement which he had to meet and had to have an opportunity of meeting it. If a communication under R. 51(3) EPC 1973 and pursuant

to Art. 96(2) EPC 1973 did not set out the essential legal and factual reasoning to support a finding that a requirement of the Convention had not been met, then a decision based on such a finding could not be issued without contravening Art. 113(1) EPC 1973, unless and until a communication had been issued which did contain the essential reasoning. If a decision was issued in the absence of a communication containing essential reasoning, Art. 96(2) EPC 1973 was also contravened, since in order to avoid contravening Art. 113(1) EPC 1973 it was "necessary" to issue a further communication (see also **T 520/94**, **T 750/94**, OJ 1998, 32; **T 487/93** and **T 121/95**).

In **T 309/94** the board found that the examining division, in its last communication before its decision, had hinted to the appellant (patent applicant) that a positive decision, e.g. to grant a patent, could be expected if amended claims in the sense indicated by this department of first-instance were filed. Accordingly, the appellants filed such claims. Without any further information, and deviating from the impression given to the appellants, the examining division then issued a decision refusing the application. This deprived the appellants of the opportunity to present comments or counter-arguments and thus infringed the requirements of Art. 113 EPC 1973. The board held that this amounted to a substantial procedural violation justifying reimbursement of the appeal fee.

In **T 92/96** the board found that, after notification of a correctly reasoned communication from the examining division, the applicants had had an opportunity to comment on the objections set out therein, but had confined themselves to suggesting a **minor correction** to the claim. A correction of this kind was not such as to lead the examining division to modify its opinion, as the essential features of claim 1, which had been considered to lack an inventive step, had remained unchanged. It had therefore to be expected that the examining division would decide to refuse the application after receiving the applicants' letter, since the applicants had made no real effort to reply to the objections. In the board's view, the applicants had therefore suffered no prejudice, and the examining division was not obliged, by virtue of the provisions of the EPC 1973 or of the principle of good faith, to issue a new communication or to grant a telephone interview to discuss the problem of inventive step on which it had already given a negative ruling. Consequently, the examining division had not committed a procedural violation, particularly with regard to Art. 113(1) EPC 1973, and under these circumstances the reimbursement of the appeal fee requested by the appellants on the basis of R. 67 EPC 1973 was not granted.

In **T 946/96** the board noted that if an examining division refused its consent to a further amendment under R. 86(3) EPC 1973, the recognised correct procedure for the examining division to follow was clearly set out in the Guidelines; If a request for amendment was to be refused under R. 86(3) EPC 1973, the applicant first had, in compliance with Art. 113(1) EPC 1973 to be sent a communication giving the reasons for refusing the amendment. Here, the first indication given to the appellant that the examining division was not prepared to consent to the introduction of the claims submitted was in the decision under appeal. This was a substantial procedural violation by the examining division. Art. 113 EPC 1973 had also to be complied with in the case of

a refusal of consent under R. 86(3) EPC 1973, irrespective of how many previous communications had been issued.

The board went on to say that if the examining division refused consent of the latest submitted amended claims under R. 86(3) EPC 1973, this did not automatically revive previous sets of claims which the examining division had consented to consider under R. 86(3) EPC 1973 - unless the applicant had indicated that he was relying on these as an auxiliary request. The correct procedure was to notify the applicant of the grounds for intending to refuse consent to the latest set of claims and to ask him whether he wanted a decision on that basis. If the applicant then maintained his request solely on the basis of these claims, and any further arguments by the applicant did not persuade the examining division to change its mind, then a decision should be given in which the **reasons for the refusal** of consent under R. 86(3) EPC 1973 were stated, and the application would be refused under Art. 97(1) and 78(1)(a) EPC 1973 on the basis that it contained no claims to which the applicant had agreed.

In **T 802/97** the board held that if a decision included several grounds, it should meet the requirements of Art. 113(1) EPC 1973 with respect of each of the grounds. In the board's judgment, if a decision of the EPO included several grounds supported by respective arguments and evidence, it was of fundamental importance that the decision as a whole met the mandatory requirements of Art. 113(1) EPC 1973. Leaving it up to the deciding body to suggest which of the grounds were to be considered as the basis of the decision and which were not - and did not therefore need to comply with the requirements of Art. 113(1) EPC 1973 - could only lead to legal uncertainty and confusion of the parties. An exception from the above principle could be obiter dicta which were not part of the grounds on which a decision is based.

In **T 275/99** the board held that the requirements of Art. 113(1) EPC 1973 were met if the appealed decision was entirely based on the grounds, facts and evidence which were already known to the appellant from the extensive international preliminary examination report (IPER) which had been drawn up for the description and the claims of the international application corresponding exactly to the European application refused and which had been incorporated by way of reference in an official communication of the examining division.

In **T 587/02** the appellant (patent applicant) had appealed on the ground that the impugned decision violated the right to be heard (Art. 113(1) EPC 1973) because the first substantiated objection under the Convention was contained in the decision to refuse the application. The board observed that in **T 275/99** it had been held that Art. 113(1) EPC 1973 could be met by the incorporation, by way of reference, of an IPER in an official communication from an examining division, and it found no objection to citing an IPER from an International Preliminary Examining Authority other than the EPO, provided that it constituted a reasoned statement as required by R. 51(3) EPC 1973, using language corresponding to that of the Convention; in the case of an inventive step objection that would require a logical chain of reasoning which could be understood and, if appropriate, answered by the applicant.

The board noted that the communication preceding the decision drew attention to the IPER drawn up by the USPTO and found it necessary to consider the wording of the IPER to see whether the objections giving rise to refusal and their basis in the Convention could be identified. In the board's view the IPER failed to meet this test, and it also observed that the refusal of the application after one action implied that the appellant had made no real effort to deal with the examining division's objections (see also **T 802/97**). Given that the appellant had deleted claims 1 to 11 and had presented arguments even though no clear case to be answered had been made, that was patently not the case.

The board pointed out in **T 268/00** that the right to be heard pursuant to Art. 113(1) EPC 1973 only precluded a decision's being taken on the basis of fresh evidence and grounds, while the use of a **fresh argument**, here based on a particular technical opinion, in a decision still based on grounds communicated beforehand was not precluded. Hence the technical argument in the decision under appeal addressed by the appellant, whether fresh or not, did not violate any of the appellant's rights. As to the technical substance of that argument, whilst the appellant might neither agree with the finding of the examining division nor with the technical argument given, a divergence of views between the examining division and the appellant on the substantive issue of inventive step did not amount to a procedural violation.

In **T 497/02** the appellant, relying on the then applicable Guidelines, had complained that he had not been sent a written communication prior to the oral proceedings giving the reasons for the refusal under R. 86(3) EPC 1973, nor any prior telephone indication, and that this amounted to a violation of his rights under Art. 113(1) EPC 1973. The board noted that an applicant cannot expect to amend his claim request(s) a bare month before the date set for oral proceedings, and still before the oral proceedings be sent a written communication or given a telephone notification indicating that the examining division proposed to exercise its discretion under R. 86(3) EPC 1973 against the admission of the new request(s), and the reasons for this. The applicant must expect to have to deal with any problems with such late requests at the oral proceedings.

The board observed that the purpose of R. 86(3) EPC 1973 was to give the examination division a discretion to refuse amendments to the claims not made in answer to the first communication, so as to ensure that the examination procedure was brought to a conclusion in as few actions as possible (see Guidelines). From this and the Guidelines C-VI, 4.12 (earlier version), the board saw the purpose of the then applicable Guidelines as being to give an applicant an opportunity to avoid the situation of having a negative decision merely on the ground of there being no text agreed to by the applicant.

In **T 1237/07** according to Art. 96 EPC 1973 the department of first instance had to invite the applicant as often as necessary to comment on its observations. However, this Article and R. 51 EPC 1973 left the examining division discretion to assess when such an opportunity was necessary and when it was more appropriate to put an end to the written phase and hold oral proceedings (see e.g. **T 1578/05**). The board noted that the simple fact that the applicant requested a new communication under R. 51(4) EPC 1973 to be the next step instead of the scheduled oral proceedings was not binding for the

examining division as long as it gave the applicant the possibility to discuss the outstanding issues, bearing in mind that, contrary to the assertion of the appellant, the right to present comments enshrined in Art. 113(1) EPC 1973 did not necessarily need to be exercised in writing but could be satisfied by way of oral proceedings. The refusal by the examining division of new oral proceedings was part of the same course of action taken by the examining division in exercising its discretion according to Art. 96 EPC 1973.

2.7. Informal communications

2.7.1 Telephone conversations

In **T 300/89** (OJ 1991, 480) the board held, in relation to the appellant's complaint as to the failure of the examiner to telephone as requested, that the practice in relation to such informal communications was clearly set out in the Guidelines. Such informal communications and the practice relating to them should be clearly distinguished from the formal examination procedure governed by Art. 96(2) EPC 1973 and R. 51 EPC 1973. The examiner's discretion as to whether to make such an informal communication had to be exercised in accordance with the Guidelines, having regard to the particular circumstances of each individual case. An exercise of such discretion adversely to an applicant, such as in the case in question, could not by its nature be a procedural violation, however, because the procedure for such conversations was informal in the sense that it was not governed by the EPC 1973, but was additional to the procedure provided by the EPC 1973. In any event, in the board's view, in the case in question no criticism could properly be made of the examiner in relation to his failing to telephone the appellant.

In **T 160/92** (OJ 1995, 35) the appellant claimed that in two telephone conversations with the primary examiner he was misled into believing that a refusal was not imminent, as a further communication would be issued as the next step of the procedure. The board noted that telephone calls between examiners of the EPO and applicants, in some situations, could be a tool for speeding up an otherwise slower procedure. However, one should be warned against expecting too much from them in critical situations, as misunderstandings could happen more easily than in writing, sometimes promoted by the fact that one of the two participants in the conversation might not be fully prepared for dealing with the case. It was with good reason that the procedure before the EPO was in principle, with the exception of oral proceedings under Art. 116 EPC 1973, a written procedure. Moreover, in the examination (as well as in the opposition) procedure the primary examiner was only one of a division of three examiners, it being well-known that his individual statements could not be binding for the division. Furthermore, telephone conversations were not provided for in the Convention and did not, as such, form part of the formal procedure before the EPO.

The board did not deny that the principle of good faith should govern all the actions relating to procedural matters, even the informal ones, of employees of the EPO towards parties to the proceedings. However, before the decision of the examining division could be set aside it would have to be manifestly clear that the rules of procedure as laid down

in the Convention had been infringed. Since telephone conversations did not form part of the said formal procedure, the board did not consider it necessary to conduct a detailed investigation aimed at clearing up what was said in the above-mentioned telephone calls, the sequence of procedurally relevant facts being already clearly established in the file. The board held that the answer to the controversial question whether the applicant was misled about the possibility of imminent refusal of the application must be sought by focusing on the procedurally relevant content of the file.

2.7.2 Interviews

In principle, the refusal of a request for an interview with the examiner concerned does not contravene any of the rules of procedure contained in the Convention. If the applicant requests an interview, the request should be granted unless the examiner believes that no useful purpose would be served by such a discussion (Guidelines C-VI, 6.2 - April 2010 version).

In **T 98/88** it was held that Art. 116 EPC 1973 gave every party the absolute right to oral proceedings, but not the right to an interview with a particular member of an examining division. It is for the examiner concerned to decide whether such an interview should take place (see also **T 235/85**, **T 19/87**, OJ 1988, 268; **T 409/87**, **T 193/93** and **T 589/93**).

In **T 409/87** the appellant had requested an interview which had been denied by the examining division without giving reasons. The board observed that although the decision under appeal did not indicate specifically why the requested interview had not been granted, it was clear from it that the examining division had considered that such an interview would not have served any useful purpose. Under such circumstances, the examiner did not need to grant the interview requested. As an interview, in contrast to oral proceedings, was not a procedural step provided by the Convention, the refusal to grant a request for an interview was not a decision open to appeal and, therefore, did not fall under the provision of R. 68(2), first half-sentence, EPC 1973.

In **T 182/90** (OJ 1994, 641) the appellant did not request oral proceedings before the examining division but instead asked only for an interview. The board held that no contravention of Art. 116(1) EPC 1973 as alleged by the appellant could be recognised.

In **T 872/90** the board held that, in accordance with established case law (see **T 19/87** OJ 1988, 268), if any reasonable doubt existed in the minds of the examining division as to the true nature of a potentially ambiguous request made to it by the applicant it was clearly desirable, as a matter of practice, that the examining division should seek clarification from the party concerned, in particular because the right to an oral hearing provided by Art. 116 EPC 1973 was an extremely important procedural right which the EPO should take all reasonable steps to safeguard. Violation of this right had, therefore, in principle, to be considered as a substantial procedural violation within the meaning of R. 67 EPC 1973 unless the circumstances and reasons for the refusal to grant that right could be considered as a mere error of judgment. Having regard to the somewhat ambiguous nature of the request for an opportunity "to be heard", which in the first place

gave rise to the interpretation to represent a request for an informal interview, the allowance or refusal of which was entirely a matter of discretion, the board found that such an error of judgment had in fact occurred and there was no procedural violation in this respect (see **T 19/87**, **T 283/88**, **T 668/89** and **T 589/93**).

In **T 366/92** the statement that the applicant "would welcome the opportunity to discuss the case with the Examiner at an informal interview ..." did not constitute a request for oral proceedings under Art. 116 EPC 1973.

In **T 299/86** (OJ 1988, 88) the board held that the right of a party to request oral proceedings under Art. 116 EPC 1973 was in no way affected by the fact that such party could have also requested and/or attended an interview with the examiner.

In **T 808/94** the board stated that informal interviews (also called "personal consultation") and/or informal consultations by telephone which were carried out by the primary examiner alone could not replace duly requested oral proceedings under Art. 116 EPC 1973, which were to take place before all members of the examining division (Art. 18(2) EPC 1973).

Board of appeal case law concerning oral proceedings in examination proceedings is dealt with in Chapter VI.C.

2.8. Failure to reply to the communication from the examining division (Article 94(4) EPC)

According to Art. 94(4) EPC, if the applicant fails to reply in due time to any communication from the examining division, the application shall be deemed to be withdrawn. New Art. 94(4) EPC under the EPC 2000 corresponds in essence to Art. 96(3) EPC 1973.

In **T 685/98** (OJ 1999, 346) the phrase "fails to reply in due time to any invitation under ... paragraph 2" in Art. 96(3) EPC 1973 was to be construed in the light of the purpose of the invitation pursuant to Art. 96(2) EPC 1973 and R. 51(2) EPC 1973, which was to afford the applicant an opportunity to exercise his right to present comments in accordance with Art. 113(1) EPC 1973.

In **T 160/92** (OJ 1995, 35) the board held that Art. 96(3) EPC 1973 did not require "a complete reply", but only "a reply" in order to avoid the consequence of having the application deemed to be withdrawn. A letter of reply to a communication of the examining division filed in due time by the applicant and dealing with substantial points of this communication constituted a reply within the meaning of Art. 96(3) EPC 1973 and thus, from the point of view of procedural law, ruled out the possibility of deemed withdrawal.

In **J 29/94** (OJ 1998, 147) the board observed - in relation to Art. 110(3) EPC 1973 - that there was another form of reply which could result in a refusal, and not in the deemed

withdrawal of the application; if the applicant did not want to reply in substance to the communication, it was permissible for him to ask for a decision on the file as it stood.

In **T 685/98** (OJ 1999, 346) the board noted that prior to a valid refusal under Art. 97(1) EPC 1973 the applicant must either have exercised his right to comment or have waived this right. It held that a simple procedural request made by the applicant after receipt of the R. 51(2) EPC 1973 communication could not be treated as a waiver of the right to present comments during the remainder of the four-month term set for reply. When the applicant neither replied in substance to the objections raised nor waived his right to present comments, then the refusal of the application was *ultra vires* and voidable *ab initio* because under Art. 97(1) EPC 1973 the application was to be refused, if no different sanction was provided for by the Convention. However, Art. 96(3) EPC 1973 provides a different sanction for failure to reply, namely the deemed withdrawal of the application.

In unclear cases there can be no presumption that an applicant has waived his right to be heard under Art. 113(1) EPC 1973. As was emphasized by the Enlarged Board of Appeal in decision **G 1/88** (OJ 1989, 189), surrender of a right cannot be simply presumed ("a jure nemo recedere praesumitur"). Hence a decision to refuse pursuant to Art. 97(1) EPC 1973 based on such a presumption and taken before expiry of the term originally set for reply to a communication contravened Art. 113(1) EPC 1973 and thus involved a substantial procedural violation. The board made it clear that where an applicant's letter of reply to a first R. 51(2) EPC 1973 communication contained only a procedural request devoid of any substantive implications, the examining division had no power to refuse the application under Art. 97(1) EPC 1973.

In **J 5/07** the board held that the filing of a divisional application did not constitute a response to an invitation by the examining division in the parent application within the meaning of Art. 96(3) EPC 1973. The board noted that a divisional application was legally and administratively separate and independent from the grant proceedings concerning the parent application (see **G 1/05** (OJ 2008, 271; points 3.1 and 8.1 of the reasons; **T 441/92**). The filing of a divisional application leaves the text of the patent application objected to unamended.

2.9. Refusal of a European patent application under Article 97(2) EPC (former Article 97(1) EPC 1973)

Under Art. 97(2) EPC (former Art. 97(1) EPC 1973) if the examining division is of the opinion that the European patent application or the invention to which it relates does not meet the requirements of this Convention, it shall refuse the application unless this Convention provides for a different legal consequence.

A European patent application which fails to meet one of the requirements of the Convention has to be **refused in its entirety**, without its being necessary to consider whether the application as a whole, e.g. a dependent claim, might contain material indicative of an inventive step (**T 5/81**, OJ 1982, 249; **T 293/86**, **T 398/86** and **T 98/88**). In **T 162/88** it was stated that if the European patent application in the version submitted

or approved by the applicant contained a claim which the examining division considered unallowable, the examining division had to refuse the European patent application in its entirety under Art. 97(2) EPC and not just the claim concerned (see also **T 117/88**, **T 253/89** and **T 228/89**).

In **T 11/82** (OJ 1983, 479) the board held that a European patent application had to satisfy the conditions laid down in the Implementing Regulations (see Art. 78(3) EPC 1973). If, in the opinion of the examining division, the application did not do so, the examining division was obliged by Art. 97(1) EPC 1973 to refuse it.

In several decisions the boards pointed out that it was highly desirable that the examining division should give an appealable decision with **sufficient reasoning** on all the issues that had been properly raised by the EPO during the examination proceedings and dealt with substantively in the applicant's reply. Such "complete" decisions streamlined the procedure rendering remittal to the department of first instance unnecessary; the board could decide all issues already raised in the department of first instance without depriving the appellant of the opportunity to have them considered at two instances (see **T 153/89**, **T 33/93** and **T 311/94**).

In **T 839/95** the examining division did not take a final decision as provided for in Art. 97 EPC 1973. Instead, it issued a decision indicated as an interlocutory decision under Art. 106(3) EPC 1973 rejecting the main and two auxiliary requests and stating that the invention claimed according to the third auxiliary request was found to meet the requirements of the Convention.

The board noted that an interlocutory decision in the case of an allowable auxiliary request is foreseen in the instructions to examiners only for auxiliary requests in opposition proceedings. It did not consider it appropriate for the department of the first instance to proceed in the same way in grant proceedings. In the board's judgment, the purpose of the interlocutory decision in opposition proceedings was intended to save the proprietor the further cost of fulfilling the formal requirements under R. 58(5) EPC 1973 before there was a final decision on the version in which the patent could be maintained (**T 89/90**, OJ 1992, 456). A corresponding situation did not exist in grant proceedings because there was no adverse party who might object to the version to which the applicant had agreed. The appeal was admissible, since the appellant was adversely affected by the rejection of his preceding requests.

In **T 856/05** the appellant applicant had argued that since the decision of the examining division did not give any reasons for refusing claim 6, it was not reasoned, thereby contravening R. 68(2) EPC 1973. The board held that it was sufficient for the examining division, when deciding to refuse a European patent application under Art. 97(1) EPC 1973, to state one ground only which in their opinion would prejudice the grant of a European patent, since the EPC did not contain any provision which would allow a European patent to be partially granted. In the case at issue, the examining division was unable to grant a patent because it was of the opinion that the subject matter of claim 1 did not involve an inventive step. Consequently, the examining division was under no obligation to comment on the other claims.

2.10. Amendments filed before the boards of appeal

Under R. 137(3) EPC (former R. 86(3) EPC 1973), after receipt of the first communication from the examining division, the applicant may, of his own volition, amend once the description, claims and drawings, provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the examining division.

In **T 63/86** (OJ 1988, 224) the board noted that the wording of the whole of R. 86(3) EPC 1973 pointed specifically to the examining division. In cases of minor amendments filed during the appeal, it might be appropriate for a board of appeal to exercise the discretion of the examining division under R. 86(3) EPC 1973. However, where substantial amendments had been proposed which required a substantial further examination in relation to both the formal and substantive requirements of the Convention, such further examination should be carried out, if at all, by the examining division as the first instance, only after the examining division had itself exercised its discretion under R. 86(3) EPC 1973 (**T 47/90**, OJ 1991, 486; **T 1/92**, OJ 1993, 685; **T 296/86**, **T 341/86**, **T 347/86**, **T 501/88**, **T 531/88**, **T 317/89** and **T 184/91**).

In **T 1051/96** the appellants re-introduced on appeal matter which, having been objected to under Art. 82 EPC 1973 by the examining division, had not been further prosecuted by them. The board held that the applicant could not be allowed, on appeal from a decision refusing the restricted claim on some other ground, such as lack of inventive step, to put forward a request which reverted to the broader claim and thus re-introduced matter open to the objection of lack of unity. It decided that the admission of this request into the proceedings should be refused in the exercise of the board's discretion under R. 86(3) EPC 1973 (see **T 63/86**, OJ 1988, 224). The board noted that this was because, as was clear from the Convention, in particular Art. 96 EPC 1973, and had been stated in **G 10/93** (OJ 1995, 172), it was the task of the examining division, and not that of the board of appeal, to carry out a full examination as to patentability requirements. Proceedings before the boards of appeal in ex-parte cases were primarily concerned with examining the contested decision.

3. Examination proceedings after issuance of the Rule 71(3) EPC communication

3.1. Introduction

Under the EPC 2000, R. 71(3) EPC states as follows, "Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it, and shall invite him to pay the fees for grant and printing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within a period of four months. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the text intended for grant."

R. 71(3) EPC (former R. 51(4) EPC 1973) followed the decision of the Administrative Council of 9 December 2004 (OJ 2005, 8), according to which the period for paying the fees for grant and printing, as well as for filing a translation of the claims, was not extendable. The period – 4 months – is laid down in R. 71(3) EPC.

If the fees for grant and printing or the claims fees are not paid in due time or if the translation is not filed in due time, the European patent application shall be deemed to be withdrawn (R. 71(7) EPC; former R. 51(8) EPC 1973). Some decisions commented in the present section 4 relate to earlier versions of former R. 51(4) EPC 1973 (now R. 71(3) EPC). Nevertheless, they may also be applicable to new R. 71(3) EPC.

3.2. Approval of the text by the applicant

3.2.1 Clear and unambiguous approval of the text

In **J 12/83** (OJ 1985, 6) the board held that an applicant for a European patent could be "adversely affected", within the meaning of Art. 107 EPC 1973, by a decision to grant the patent if the patent were granted with a text not approved by the applicant, contrary to Art. 97(2)(a) EPC 1973. Approval, for the purposes of that Article, had to be established "in accordance with the provisions of the Implementing Regulations" (here R. 51(4) EPC 1973).

In **J 13/94** the board observed that any approval of the text, in accordance with R. 51(4) EPC 1973, might thus have serious procedural consequences for applicants. Hence, according to the case law of the Legal Board of Appeal, declarations by applicants should only be treated as valid approval under R. 51(4) EPC 1973 if they were clear and unambiguous which, in particular, implied that:

- the approval was not subject to any condition (**J 27/94**, OJ 1995, 831);
- it was clear to which text the applicant had given his approval (**J 29/95**, OJ 1996, 489).

In **J 27/94** (OJ 1995, 831) the board held that in the interests of legal certainty a procedural declaration had to be unambiguous (confirming **J 11/94**, OJ 1995, 596). This implied that it must not be subject to any condition, leaving it open whether the EPO could proceed further on the basis thereof. It found that the examining division should not have treated the letter in question as valid approval under R. 51(4) EPC 1973, because it contained a condition which made the approval invalid. The approval of the text intended for grant was a necessary requirement for the next step in the proceedings, i.e. the communication under R. 51(6) EPC 1973. It had to be clear for the EPO when receiving the declaration whether or not it was an appropriate basis for the despatch of this communication. In the interests of legal certainty the board stated that procedural declarations had to be unambiguous. The examining division should have objected to the invalid approval, with the eventual consequence foreseen in R. 51(5), first sentence, EPC 1973.

In **T 971/06** the board noted that the approval by an applicant or patent proprietor under Art. 97(2)(a) EPC 1973 was a principle underlying all decisions of the EPO (see Art. 113(2) EPC 1973). Accordingly, it was perfectly clear that it was an absolute pre-condition of any decision of the examining division to grant a patent that an applicant had to have consented to the proposed text. If that pre-condition were not fulfilled, the only courses of action open to the examining division were to refuse the application under Art. 97(1) EPC 1973 or, if possible amendments or corrections remain to be considered, to continue the examination. So strict was the approval condition that, as the case law showed, the only valid approval was that which was unconditional, unambiguous and clear (see **J 13/94** of 4 October 1996; **J 27/94**, OJ 1995, 831; and **J 29/95**, OJ 1996, 489). The board held that in the absence of a valid approval, the examining division had no power to make a decision to grant and any decision to grant purportedly made without the applicant's valid approval could have no legal effect. Any such purported decision was therefore a nullity.

3.2.2 Rule 71(3) EPC communication refusing main and first auxiliary requests (former Rule 51(4) EPC 1973, 2002 version)

In **T 1181/04** (OJ 2005, 312) the appellant (patent applicant) filed an appeal against the communication under R. 51(4) EPC 1973 issued by the examining division refusing the main request and the first auxiliary request.

The board noted that the communication under R. 51(4) EPC 1973 from the examining division gave the appellant the impression that no possibility was available to him other than to pay and accept the proposed text or not to pay and lose the application. This impression was even stronger because reasons for turning down the higher-ranking requests were also contained in the document and no indication was given as to how to proceed if the appellant wished to maintain these higher-ranking requests. The board observed that where approval was not given, this also had a legal consequence, namely the refusal of the application in accordance with Art. 97(1) EPC 1973. The legal consequence of the non-existence of the applicant's approval was not the same as that foreseen for the failure to pay the fees or to file the translation. In the former case the application was refused, whereas in the latter it was deemed to be withdrawn. The board noted that the fact that an applicant's disapproval of the text proposed for grant had special legal consequences also made it necessary to ensure that disapproval was clearly established by the examining division.

The board noted that the communication sent to the applicant reflected an EPO practice that did not provide for a procedure to be followed in the event that the applicant did not agree with the version proposed by the examining division. The board found that this practice was not justified by the Convention. The applicant's approval of the text proposed for grant by the examining division was an essential and crucial element in the grant procedure and its existence or non-existence needed to be formally ascertained. Further, the applicant should be given the opportunity to express his disapproval of the text proposed for grant by the examining division with a communication under R. 51(4) EPC 1973 and to obtain an appealable decision refusing his requests.

In **T 1255/04** (OJ 2005, 424) the board followed decision **T 1181/04**. The board held that in cases where there was a request which was considered allowable and on which a R. 51(4) EPC 1973 communication was to be sent, but there were also higher-ranking requests which were not allowed, the communication under R. 51(4) EPC 1973 was deficient if it was not accompanied by reasons why the higher-ranking requests were not allowed. The R. 51(4) EPC 1973 communication should, in addition, expressly mention the option of maintaining the disallowed requests, thus reminding the applicant and the examining division of the possibility for the applicant to ask for a written appealable decision on these higher-ranking requests.

The board noted, furthermore, that if the applicant maintained a still pending higher-ranking request discussed at the oral proceedings before the examining division, that request could not be refused under R. 86(3) EPC 1973. A decision which merely stated that the application was refused because there was no version approved of by the applicant within the meaning of Art. 113(2) EPC 1973 on which a patent could be granted, would be inadequately reasoned, because it did not give the substantive reasons why the version the applicant had approved of was not in conformity with the patentability requirements of the Convention.

3.3. Legal basis for refusing an application if no text submitted or agreed

Art. 113(2) EPC states that the EPO shall examine, and decide upon, the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or the proprietor of the patent.

In **T 32/82** (OJ 1984, 354) the board held that in accordance with Art. 113(2) EPC 1973, it could only decide on the European patent application in the text submitted to it or agreed by the applicant. It followed that when deciding the appeal the board had no authority under the Convention to order the grant of a European patent containing claims which were different from those submitted by the applicant in their content or interdependency. Even if the board had indicated to an applicant that a dependent claim might be allowable if rewritten as an independent claim but the applicant had not expressly requested the board to consider it as such, the board was not obliged to do so.

In **T 872/90** the board held that, in view of the requirement of Art. 113(2) EPC 1973 according to which the EPO would consider and decide on the European application only in the text submitted to it, or agreed, by the appellant, former claims which had been replaced by newly filed claims could no longer be considered to constitute a text agreed to by the applicant.

In **T 647/93** (OJ 1995, 132) the board found that the provision of Art. 113(2) EPC 1973 was a fundamental procedural principle, being part of the right to be heard, and was of such prime importance that any infringement of it, even as a result of a mistaken interpretation of a request, had, in principle, to be considered to be a substantial procedural violation. In any case, such violation occurred when, as in the case in question, the examining division did not make use of the possibility of granting

interlocutory revision under Art. 109 EPC 1973, after the mistake had been pointed out in the grounds of appeal (see **T 121/95**).

In **T 237/96** the board noted that in circumstances in which, as in the case in question, amendments proposed by the applicant were not allowed by the examining division by virtue of R. 86(3) EPC 1973 and the applicant did not give its agreement to any other version of the application documents, the established practice of the EPO, sanctioned by consistent case law, was to refuse the application on the ground that there was no version approved by the applicant within the meaning of Art. 113(2) EPC 1973 on which a patent could be granted.

In **T 169/96** the board held that according to Art. 113(2) EPC 1973, the EPO was bound to the requests of the applicant or proprietor. In case of main and auxiliary requests, this meant that the EPO was also bound to the order of the requests. Before a decision could be taken on the basis of an auxiliary request, the main request had to be examined and decided upon (**T 484/88**, dated 1 February 1989). This principle was violated by the examining division. The applicants were only invited to indicate their approval of the text according to auxiliary request III. Therefore, their express disapproval related necessarily only to this version of the application. There was nothing in the file which could be interpreted as a withdrawal of the main request and the auxiliary requests I and II. Hence, these requests were pending when the decision under appeal was taken and the failure to give a decision on these requests was a violation of Art. 113(2) EPC 1973. The failure to deal with the requests preceding auxiliary request III violated also R. 68(2) EPC 1973. If a decision related to several requests, it had to give reasons for the rejection of each one (**T 234/86**, supra). The fact that the first examiner had expressed a preliminary view in a previous communication which might be applicable to these requests could not replace reasons in the decision itself. Whereas the reasons of a decision might, in the interest of procedural economy, refer in appropriate cases to previous communications, it had to be clear from the decision which considerations led the division to its conclusions (**T 234/86**, supra) (see also **T 1439/05**).

In **T 246/08** the decision under appeal specified the legal grounds for refusing the main request as "the application is lacking a valid set of claims for the main request as required by Art. 78(1) EPC". The board noted that the Guidelines for Examination indicated Art. 113(2) EPC 1973 as the legal basis for refusing an application in the circumstances of the case before it, i.e. in which no agreed claim text existed (C-VI.4.9, 5th paragraph, version of December 2007; see also version of April 2009). However, the board preferred the approach of the examining division for the reason that Art. 78(1)(c) EPC 1973 was a requirement of the application not only for according a filing date, but also for substantive examination and grant (Singer/Stauder, EPC, 3rd ed., Art 78(6) and Benkard, EPC, Art 78, 2nd paragraph) whereas Art. 113(2) EPC 1973 was silent as to the legal consequence of the absence of an agreed text. The board held that although an examining division should normally apply the Guidelines, failure to do so was neither a mistake in law nor a procedural violation. For the reasons set out, in this particular instance the board saw the deviation as a matter for approval rather than reproach.

In **T 255/05** the board observed that the appellant's "auxiliary request" was not one single request but encompassed numerous requests. It was totally undefined in which order these four requests and any such combination requests should be considered by the board. The board noted that according to Art. 113(2) EPC 1973, the EPO should consider or decide upon the European patent application only in the text submitted to it, or agreed, by the applicant. It was therefore the applicant's responsibility to define the text on the basis of which it requested a patent to be granted. In the case of auxiliary requests this included the requirement that the applicant had also to indicate the order in which the requests were to be examined. This was so because filing an auxiliary request meant that such a request was only filed in the event that the preceding request was not allowed by the board. As a consequence, when the appellant, even after having been invited to do so by the board, did not clearly indicate the order in which its several requests were submitted and what the exact content of each of these requests was, there was no text submitted or agreed by the applicant within the meaning of Art. 113(2) EPC 1973 and no request which could be considered by the board. Therefore, the appellant's "auxiliary request" had to be disregarded.

3.4. Amendments filed in reply to a communication under Rule 71(3) EPC

Under R. 71(4) EPC the applicant may, within the period laid down in paragraph 3, requests amendments under R. 137, paragraph 3 EPC, or the correction of errors under R. 139 EPC.

According to **G 7/93** (OJ 1994, 775) the approval of a notified text submitted by an applicant pursuant to R. 71(3) EPC (former R. 51(4) EPC 1973) does not become binding. The criteria for accepting or refusing requests for amendment under R. 137(3) EPC (former R. 86(3) EPC 1973), or correction under R. 139 EPC (former R. 88 EPC 1973), have not been changed by the new R. 71 EPC (former R. 51 EPC 1973).

In **T 375/90** the board noted the conditions defined by the boards of appeal limiting the extent of the discretion which may be exercised when applying R. 86(3) EPC 1973, where amendments were proposed by the applicant after issue of the R. 51(4) EPC 1973 communication:

(i) There is no discretion in the obligation to admit amendments which remove deficiencies constituting violations of the EPC 1973 (see **T 171/85**, OJ 1987, 160 and **T 609/88**).

(ii) In all other cases the EPO's interest in a speedy completion of the proceedings must be balanced against the applicant's interest in the grant of a patent with amended claims (see **T 166/86**, OJ 1987, 372; **T 182/88**, OJ 1990, 287 and **T 76/89**).

The board noted that the Guidelines C-VI, 4.8 and 4.9 (old version) stated that the communication under R. 51(4) EPC 1973 did not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure and only minor amendments would be considered within the period under R. 51(4) EPC 1973. Moreover, the applicant had to give good reasons for proposing the changes only at this

stage of the proceedings. These rules of the Guidelines also reflected the call for the balance of interests applicable when judging cases falling under category (ii) mentioned above. It followed from the foregoing considerations that the examining division (or the board acting within its competence), when applying the provisions of R. 86(3) EPC 1973, was **not completely free** to deny any examination of the respective amended documents.

In **T 171/85** (OJ 1987, 160) the applicants argued that the amendment requested was covered by R. 88 EPC 1973 and could therefore be made even after communication of approval under R. 51(4) EPC 1973. The board noted that it was true that, in the generally-accepted view, corrections under R. 88, second sentence, EPC 1973, could be made at any time prior to the decision to grant. However, the board considered that in this particular case the requirement of R. 88, second sentence, EPC 1973, was not met. The board took the view that although correction under R. 88, second sentence, EPC 1973 was not possible, the documents nonetheless contained an inconsistency which should properly have been removed before the communication under R. 51(4) EPC 1973 was issued. If this was not done the precondition for grant under Art. 97(2) EPC 1973 that the application meet the requirements of the Convention appeared not to have been met. The board of appeal saw no reason why an inconsistency between claims or between claims and the description should not be removed, in agreement with the examining division and the applicant, even if the latter had communicated approval of the (faulty) text under R. 51(4) EPC 1973. Nor as a rule would it seem necessary to set aside and replace the communication under R. 51(4) EPC 1973; this need be done only if in a contracting state there might be a loss of rights under Art. 65(3) EPC 1973 unacceptable to the applicant.

In **T 1/92** (OJ 1993, 685) the board found that if, according to R. 51(6) EPC 1973, it could not be established beyond doubt at the end of the time limit under R. 51(4) EPC 1973 that the applicant approved the text in which the examining division intended to grant the European patent, the examining division could not proceed to the grant of the patent and R. 51(5) EPC 1973 applied. The board further noted that, as the appellants' requests that their approval be disregarded and that the time limit for response to the R. 51(4) EPC 1973 communication be extended, were filed within the four-month period given in that communication, they were entitled, in accordance with R. 51(5) EPC 1973 to make observations upon invitation by the examining division, should it not consent to the proposed amendments. This meant that, in any circumstance, the appellants were entitled to a response dealing with their requests. Under R. 51(4), last sentence, EPC 1973 they were further automatically entitled to the requested extension. R. 51(5) EPC 1973 expressly entitled the applicant to a response from the examining division to a request for amendment, if this request was filed on time. As a result, no final decision could be taken until that time limit had expired, and only then if there was unambiguous approval.

In **T 999/93** the decision to refuse the application under R. 51(5), first sentence, EPC 1973 for lack of any approved text of the application (Art. 113(2) EPC 1973), was incorrect since the fact that the appellant never withdrew the main and first and second auxiliary requests as well as the appellant's letter of 6.4.1993 (disapproval of the text

proposed for grant, but request for a decision on the main request) clearly showed that he indeed approved and proposed the text according to his higher-ranking requests (see also R. 51(5), second sentence, EPC 1973). The decision would instead have required reasoning as to the substance of the main, first auxiliary and second auxiliary requests.

In **T 237/96** the board held that the broadening of the scope of claim 1 requested by the applicant after receipt of the examining division's communication under R. 51(4) EPC 1973 so as to encompass one originally disclosed embodiment was not consistent with his previous submission that said embodiment was not part of the invention, raised new issues as to clarity and inventive step and was not supported by any argumentation in favour of the allowability of the amended claim. The board found that the examining division, in refusing to consent to the amendment under R. 86(3) EPC 1973, did not exercise its discretion in a wrong or unreasonable manner. Had it given its consent to the amended version of the claim, it would have been necessary to restart examination from the beginning, which, given the *prima facie* lack of clarity of the claim, would have led to a considerable delay.

In **T 1066/96** the board noted that, pursuant to R. 51(5) EPC 1973, the examining division had the discretion not to consent under R. 86(3) EPC 1973 to amendments proposed by the applicant within the period set by the communication under R. 51(4) EPC 1973. However, in that case, R. 51(5) EPC 1973 explicitly provided that the examining division should, before taking a decision, request the applicant to submit his observations within a period it was to specify and should state its reasons for so doing. These provisions had to be seen in the light of the general rule laid down in Art. 113(1) EPC 1973, under which the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

In this context, it was clear that further amendments could not be excluded wholesale in advance, but the discretion under R. 86(3) EPC 1973 had to be exercised on a case by case basis balancing the interests of the EPO and the applicant against one another (see **G 7/93**, OJ 1994, 775). Therefore, in exercising its discretion under R. 86(3) EPC 1973 in a negative way, an examining division could only refuse an application if, before issuing a decision, it had informed the applicant of the fact that the further amendments requested would not be admitted and of the reasons for not admitting said amendments, thereby taking due account of the applicant's reasons for such late filing of further amendments. If the applicant maintained its request and its counterarguments were not considered convincing by the examining division, the application had to be refused under Art. 97(1) EPC 1973, since it contained no claims to which the applicant had agreed.

In **T 121/06** the examining division had issued a R. 51(4) EPC 1973 communication in which they had made changes to the text submitted by the appellants. In the annex to this communication document D4 was cited for the first time. The board noted that issuing a R. 51(4) EPC 1973 communication containing amendments was not foreseen in the EPC. However, according to the Guidelines for Examination C-VI, 15.1 (old version), an examining division could, instead of issuing an Art. 96(2) EPC 1973 communication, include amendments in the R. 51(4) EPC 1973 communication.

Considering in particular that this communication triggered a phase of strict time limits for paying fees and filing translations, the amendments had to be such that the applicant could be reasonably expected to accept them. This procedure was thus only applicable as long as the amendments proposed by the examining division were minor. In the case at issue, however, the R. 51(4) EPC 1973 communication indicated substantial amendments to two independent claims based on a document never cited before. This was more than merely tidying up an examination result already agreed upon for final confirmation. The communication effectively initiated an entirely new examination phase, during which the applicant would generally not be expected to agree without presenting arguments. Thus, issuing a communication under R. 51(4) EPC 1973 in which amendments were proposed, which the applicant could not reasonably be expected to accept without further discussion, constituted a substantial procedural violation.

In **T 1093/05** the board noted that to grant a patent in a text not approved by the applicant was in breach of Art. 97(2)(a) and 113(2) EPC 1973 and thus a substantial procedural violation. The board stated that in those circumstances it was established board of appeal and Enlarged Board of Appeal case law that an examining division was bound by its final decision on an application, which could be set aside only following an admissible, reasoned appeal (see **G 12/91**, OJ 1994, 285; **G 4/91**, OJ 1993, 707; **T 371/92**, OJ 1995, 324; **T 1081/02**; **T 830/03**). In view of this established case law, the board could not subscribe to the view expressed in **T 971/06** that an erroneous decision was a nullity and therefore no appeal needed to be filed against it.

The board noted that the communication under R. 51(4) EPC 1973 was supposed to bring the substantive procedure to an end and should as a rule be based on a text approved by the applicant. If in this communication the examining division suggested amendments, it had to ensure that an approved text existed before it issued the grant decision – especially since no second communication under R. 51(4) EPC 1973 was issued if the applicant responded with amendments which the division considered allowable. To avoid this kind of problem, the division should make only such amendments in the communication under R. 51(4) EPC 1973 as it could reasonably expect the applicant to accept, as stipulated in the Guidelines for Examination in the EPO, Part C VI, 15.1 (old version). Otherwise, it must issue a communication under Art. 96(2) EPC 1973 (see also **T 121/06**).

In **T 1064/04** the board stated that the principles in **G 7/93** (OJ 1994, 775) could be considered generally applicable to new requests put forward at a late stage of the proceedings, where the applicant had already had at least one opportunity to amend the application and the examining division has already completed substantive examination of the application. The board found that the examining division had exercised its discretion in a reasonable way in accordance with the applicable principles. A late stage of the examination proceedings had been reached at the end of the oral proceedings, and any amendments thereafter fell to be considered under the principles derivable from decision **G 7/93**.

3.5. Re-opening examination after approval of the text for grant

In **G 10/92** (OJ 1994, 633) the Enlarged Board stated that if examination proceedings were re-opened by the examining division after approval in accordance with R. 51(4) EPC 1973, because - for whatever reason - the proposed text for grant was to be amended, R. 51(4) EPC 1973 required that the applicant once again be informed of the text in which the examining division intended to grant the European patent. The same was true in appeal proceedings. The approval in accordance with R. 51(4) EPC 1973 given before the department of first instance was equally binding on an appeal. If the board of appeal then concluded that the patent had to be amended prior to grant, the applicant again had to approve the amended text, approval being stated before the board if the board was ruling on the issue, or to the examining division if the matter had been remitted.

In **G 10/93** (OJ 1995, 172) the Enlarged Board held that the examining division was not bound by the view - whether positive or negative - expressed in the examination pursuant to Art. 96(2) EPC 1973; examination proceedings could be re-opened "for whatever reason" after the approval in accordance with R. 51(4) EPC 1973.

3.6. Examination after remittal for further prosecution

In **T 79/89** (OJ 1992, 283) the board rejected the appellant's main request, and remitted the case to the department of first instance for further prosecution on the basis of the auxiliary request. In this case, Art. 111(2) EPC 1973 was applicable, according to which the department of first instance shall be bound by the ratio decidendi of the board of appeal, insofar as the facts are the same. The ratio decidendi of the board of appeal's previous decision was that the subject-matter of the main request was not allowable, but that the grant of a patent in accordance with the auxiliary request was subject to a consideration of its patentability by the examining division. In this case, in the board's judgment, following the issue of the board's previous decision, the examining division clearly had no power to re-open examination on the basis of the claims which the appellant requested (with subject-matter corresponding to the previously rejected main request). Having examined the subject-matter of the auxiliary request for patentability and found no objection to it, the examining division was bound to issue a communication under R. 51(4) EPC 1973 with a text based on the auxiliary request. Furthermore, in the absence of approval of such text, in the board's judgment the examining division was bound to refuse the application, for the reasons set out in its decision. Since the examining division had no power to re-open examination in respect of the claims as requested by the appellant, in the context of the appeal in question the board necessarily had no power to re-open examination in respect of such claims, because it could only exercise power which was within the competence of the examining division (Art. 111(1) EPC 1973). Thus, the main request of the appellant had to be refused.

3.7. Amendments under Rule 71(5) EPC communication

Under R. 71(5) EPC (former R. 51(6) EPC 1973), if the examining division does not consent to an amendment or correction requested under paragraph 4, it shall, before

taking a decision, give the applicant an opportunity to submit, within a period to be specified, his observations and any amendments considered necessary by the examining division, and, where the claims are amended, a translation of the claims as amended. If the applicant submits such amendments, he shall be deemed to have approved the grant of the patent as amended. If the European patent application is refused, withdrawn or deemed to be withdrawn, the fees for grant and printing, and any claims fees paid under paragraph 6, shall be refunded.

Enlarged Board of Appeal decision **G 7/93** (OJ 1994, 775) related to an earlier version of R. 51(6) EPC 1973. Nevertheless the criteria set out in that decision still apply to the procedure under R. 71(3) to (5) EPC.

In **G 7/93** the Enlarged Board stated that the wording in R. 86(3) EPC 1973, "No further amendment may be made without the consent of the examining division", simply meant that the examining division might or might not give its consent to a request for amendment by the applicant. However, since the underlying object of a R. 51(6) EPC 1973 (earlier version) communication was to conclude the granting procedure on the basis of the approved text, a request for amendment which was received by an examining division after such a communication has been issued should be considered in a different way from a similar request for amendment received at a much earlier stage in the overall examination procedure, and in particular before approval by the applicant of a notified text. Such a request should be considered in the context of the very late stage in the pre-grant procedure at which it had been made, and against the background that the examining division had already completed its substantive examination of the application, and that the applicant had already had at least one opportunity to amend the application. Against such a background, allowing a requested amendment after the issue of a R. 51(6) EPC 1973 communication would be the exception rather than the rule. Nevertheless, the question remained in what kind of circumstances it would be appropriate to make an exception to the normal rule.

In response to a referral in **T 830/91** (OJ 1994, 728), the Enlarged Board of Appeal looked initially at the question of the admissibility of amendments to the patent application after a R. 51(6) EPC 1973 communication. Decisions **T 1/92** (OJ 1993, 685) and **T 675/90** (OJ 1994, 58) had differed in their interpretation of this point.

The Enlarged Board of Appeal concluded that the approval of a notified text submitted by an applicant pursuant to R. 51(4) EPC 1973 was **not** rendered **binding** by virtue of a communication being issued in accordance with R. 51(6) EPC 1973. Even following the issue of such a communication and until the issue of a decision to grant the patent, it was left to the discretion of the examining division under R. 86(3) EPC 1973, second sentence, whether or not to allow amendment of the application.

In the Enlarged Board's view, when considering the possible circumstances when it might be appropriate for an examining division to exercise its discretion under R. 86(3) EPC 1973 to allow an amendment after issue of a R. 51(6) EPC 1973 communication, it should be borne in mind that a request for amendment at that stage might arise either as a result of a realisation by the applicant of the need for amendment,

or as a result of a point raised by the examining division, or as a result of consideration of observations made by a third party pursuant to Art. 115 EPC 1973. In any of these circumstances, the discretion to allow amendment should be exercised according to the same principles. Of course, an objection should only be raised by an examining division at that stage of the proceedings if it was prepared to allow amendments to meet the objection. When exercising its discretion following the issue of a R. 51(6) EPC 1973 communication, an examining division had to consider **all relevant factors**. In particular it had to consider and balance the applicant's interest in obtaining a patent which would be legally valid in all of the designated states, and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent. Having regard to the object of a communication under R. 51(6) EPC 1973, which was to conclude the grant procedure on the basis of the previously approved text, allowance of a request for amendment at that late stage in the grant procedure would be the **exception** rather than the rule.

A clear example of an exceptional case when it might be appropriate to allow amendment was, in the Enlarged Board's view, where the applicant requested separate sets of claims to be substituted in respect of designated states which had made reservations under Art. 167(2) EPC 1973. Similarly, other **minor amendments** which did not require the re-opening of substantive examination and which did not appreciably delay the issuing of a decision to grant the patent might be allowable after a R. 51(6) EPC 1973 communication had been issued.

As to the second question referred to it, of whether the EPO was obliged to consider reservations under Art. 167(2) EPC 1973 as constituting requirements of the Convention which had to be met in accordance with Art. 96(2) EPC 1973, the Enlarged Board of Appeal held that, under Art. 96(2) EPC 1973, an examining division was required to consider whether the application or the invention to which it related met the requirements of the Convention. When a contracting state to the Convention made a reservation under Art. 167(2) EPC 1973 it reserved the right to make provisions in its national law on the matters set out in Art. 167(2) EPC 1973. Such provisions of national law were clearly not "requirements of the Convention" within the meaning of Art. 96(2) EPC 1973.

Thus **G 7/93** supersedes on this point decisions **T 860/91** and **T 675/90**, in which it was held that the discretionary power conferred by R. 86(3) EPC 1973 to allow amendments no longer existed after a R. 51(6) EPC 1973 communication had been issued.

3.8. Amendments after completion of the examination procedure

In **T 798/95** the decision to grant the European patent was handed over by the formalities section of the examining division to the EPO postal service for notification. The request for amendment of the application under R. 86(3) EPC 1973 was filed on the same day at 6.47 pm, thus after completion of the proceedings. Referring to **G 12/91** (OJ 1994, 285), the board held that a request for amendment under R. 86(3) EPC 1973 filed after completion of the proceedings up to grant before an examining division was to be disregarded, even if the filing of the request and the completion of the proceedings occurred on the same date.

4. Withdrawal of the patent application or abandonment of parts thereof

4.1. Withdrawal of patent application as a whole

A valid notice of withdrawal which has been received at the EPO is binding on the applicant, although, in the case of withdrawal by mistake, R. 139 EPC (R. 88 EPC 1973) may be applicable (see e.g. **J 10/87**, OJ 1989, 323, and **J 4/97**).

A request for withdrawal of a European application should only be accepted without question if it is completely unqualified and unambiguous (**J 11/80**, OJ 1981, 141). In **J 11/87** (OJ 1988, 367) the board added that where there was even the slightest doubt as to the proprietor's actual intent such a declaration should be construed as a declaration of withdrawal only if the subsequent facts confirmed that such had been his true intent.

In **J 15/86** (OJ 1988, 417) the board stated that there was a recognised difference between passive abandonment and active withdrawal of a European patent application. Each case in which there was a dispute as to the applicant's intention had to be considered on its own facts. A written statement by the applicant or his representative had to be interpreted in the context of the document as a whole and the surrounding circumstances. Similarly, **J 7/87** (OJ 1988, 422) ruled that the language used had to be interpreted in the light of the surrounding circumstances, from which it had to be clear that the applicant really wanted immediate and unconditional withdrawal rather than passive abandonment leading in the course of time to deemed withdrawal. Actual withdrawal did not depend on whether the applicant had used the term "withdrawal".

In **J 6/86** (OJ 1988, 124) the board considered the statement "the applicant wishes to abandon this application" as an unambiguous withdrawal of a European patent application, since nothing in the circumstances under which the statement had been made could be taken as qualifying such an interpretation. It is too late to ask for retraction of a notice of withdrawal once the withdrawal has been notified to the public in the European Patent Bulletin (see **J 15/86**, OJ 1988, 417). In this case it was alleged that the withdrawal had been made by mistake.

In **J 4/97**, the applicants informed the EPO three days after withdrawal that their request had been made erroneously and should be cancelled. The EPO informed the applicants that the withdrawal had come into force and was binding, and notification of the withdrawal was later published in the European Patent Bulletin. However, the board held that the withdrawal of the application could be corrected under R. 88 EPC 1973. The legal considerations contained in **J 10/87** concerning the retraction of a withdrawal of a designation of a contracting state applied equally to the withdrawal of a patent application as a whole. In particular, it had to be ascertained that the withdrawal had been due to an excusable error, that there was no undue delay in seeking retraction, and that the retraction of the withdrawal had not adversely affected the public interest or the interests of third parties.

In the circumstances of the case at issue, the board held that the mere fact that the withdrawal was retracted after only three days was a strong indication that it had indeed been made in error. The error resulted from confusion between two similar reference numbers assigned by the appellants to their patent applications. In the board's opinion this mistake could be considered as an excusable oversight. The public interest was not affected because the withdrawal was retracted before the corresponding entry was made in the Register of European Patents and more than six weeks before the withdrawal was officially notified to the public in the European Patent Bulletin. Thus, at the time the general public was informed of the withdrawal, the public part of the file clearly showed that a request for cancellation of the withdrawal had been filed thereby warning third parties relying on the information published by the EPO. The interests of third parties could be protected if a national court applied Art. 122(6) EPC 1973 *mutatis mutandis*.

In **J 14/04** the board rejected the request for correction of the withdrawal of the application. It agreed with **J 10/87** that the public interest lay in being able to rely on information officially published by the EPO. However, the board took the view that the Register of European Patents constituted an official publication (see also **J 37/03** and **J 38/03**), and as, at the time of the request for withdrawal, access to the Register was freely offered to the public on the Internet, the request for withdrawal was available to the public on the date the Register indicated the request for withdrawal was recorded. It was of no relevance whether the file was actually consulted on this date. Nor did the board consider that Art. 122(6) EPC 1973 could apply *mutatis mutandis* to cases of correction under R. 88 EPC 1973.

The Legal Board held in **J 25/03** (OJ 2006, 395) that entries in the Register of European Patents also amounted to notification to the public from the day of their publication as well as publication in the European Patent Bulletin. The board rejected the request for correction of the withdrawal of the patent application and added that it was of no relevance that only four days had elapsed between mention of the withdrawal in the Register and mention of the request for retraction of the withdrawal. Legal certainty would suffer unacceptably if further delay were permitted for retraction of the withdrawal in such circumstances where even after inspection of the complete file there would not have been any reason for a third party to suspect, at the time of the official notification to the public of the withdrawal, that the withdrawal could be erroneous and later retracted.

In **J 4/03** the Legal Board noted that the request for retraction of the withdrawal of the application had been made after notification of the withdrawal in the European Patent Bulletin, the means of official publication of the EPO. That meant that the public had already received the information that the application no longer existed so that the principal precondition for allowing a correction was not met (see also **J 7/06**).

In **J 19/03** the Legal Board decided that the notice of withdrawal did not contain a relevant error or mistake which could be corrected under R. 88, first sentence, EPC 1973. The board found that under R. 88, first sentence, EPC 1973, it was not sufficient to prove that a divergence had occurred between the true intention of the applicant and the declaration filed by its representative; rather it was additionally required that this divergence was caused by an error of the person who was competent to make the

decision on the procedural act before the EPO. Therefore, as a rule, in cases where the party was represented by a professional representative the error pursuant to R. 88 EPC 1973 must be an error of the representative in expressing his own intentions. This requirement was not met in the case in point.

4.2. Abandonment of parts of an application

If an applicant or patent proprietor abandons claims the question arises whether his aim is the substantive abandonment of the relevant subject-matter of his application or patent, or whether his intention is to file a divisional application in respect of the subject-matter involved or whether the action is merely an attempt to reformulate the claims to take account of objections made by the EPO or an opponent.

If the abandonment has substantive effect, there is no possibility of reinstating the abandoned subject-matter, either as part of pending grant or opposition proceedings or by filing a divisional application. This is the assumption if the relevant parts of the description are also abandoned.

In **J 15/85** (OJ 1986, 395) it was held that if an applicant cancels claims in a patent application but fails to state at the time that their deletion is without prejudice to the filing of a divisional application, the examining division is obliged to withhold its consent to the subsequent filing of a divisional application.

However, a declaration of abandonment can be interpreted to the effect that there was no intention to abandon definitively the subject-matter of the application or patent. In **T 910/92** the applicants had expressly abandoned several claims in their application, but later retracted their declaration and requested that the claims deleted from the application be reinstated in a divisional application. The board considered under what circumstances it was possible to retract a declaration of abandonment. It referred to the case law, which required that the real intention of the party making the declaration be established, taking into account all the circumstances of the case, and concluded that in this case the appellants' real intention was not to abandon part of the original disclosure altogether, but to avoid the lack of unity that had arisen as a result of the change in the protection sought. In contrast to the case in **J 15/85** the board did not see any need in this case to protect the public interest by generally prohibiting the retraction of a declaration of abandonment. It could be expected that any third parties interested in the proceedings relating to the application in question would have asked to inspect the files at suitable intervals up until the conclusion of the proceedings.

In **J 13/84** (OJ 1985, 34) the board applied the same criteria to the interpretation of a declaration of abandonment as the case law had developed for declarations of withdrawal of an application. In particular, all the circumstances had to be taken into consideration and not just the preceding declarations. In the case in question the applicants had deleted their claim 21 in response to a communication from the examining division, adding that "in accordance with the examiner's suggestion, we are filing a divisional application for the intermediate products ... and for their method of preparation". The Receiving Section took the view that the divisional application, with the

former claim 21 as its subject-matter, was not filed within the period of two months prescribed in R. 25(1)(b) EPC 1973 (in the version which entered into force on 7.10.1977; the provision was deleted with effect from 1.10.1988). It argued that claim 21, which had already been divided out from the application on 6.6.1983 and therefore no longer formed part of the parent application on 31.8.1983 (the date of filing of the divisional application), could no longer be converted into a divisional application. The board did not share this view and called for the declaration of abandonment to be interpreted in the same way as a declaration of withdrawal of an application, i.e. taking into account all the circumstances. It added that, generally speaking, and as stated in the summary of the Legal Board's decision in **J 11/80** (OJ 1981, 141), a request for withdrawal should only be accepted without question if it is completely unqualified and unambiguous.

The board also referred to decisions **J 24/82**, **J 25/82** and **J 26/82** (OJ 1984, 467), in which it was found that, where claims were withdrawn specifically under R. 25(1) EPC 1973 (in the version which entered into force on 7.10.1977), the applicant's restrictive intention was not to be interpreted in isolation on the strength of particular statements but in the context of the entire procedure. The board took the view that in this case no express intention to drop the claim ensued from the circumstances. The divisional application was therefore admissible.

In **T 118/91** the board ruled that the inclusion of a particular claim in a divisional application did not mean that claim had been dropped from the parent application.

4.3. Non-payment of further search fees in the case of lack of unity

According to **T 178/84** (OJ 1989, 157) it was clearly the intention of R. 46(1) EPC 1973 (R. 64(1) EPC) to regard subject-matter as abandoned in a particular patent application if, in response to an invitation according to this rule, the further search fee was not paid for this subject-matter within the time limit set by that rule. Since a different view was taken in **T 87/88** (OJ 1993, 430), the President of the EPO referred the matter to the Enlarged Board of Appeal which, in **G 2/92** (OJ 1993, 591), held that an applicant who failed to pay the further search fees for a non-unitary application could not pursue that application for the subject-matter in respect of which no search fees had been paid. He would have to file a divisional application in respect of such subject-matter. However, non-payment was not to be equated with the abandonment of parts of the application.

4.4. Non-payment of claims fees

If an applicant fails to pay claims fees, he is considered under R. 45(3) EPC (former R. 31 EPC 1973) to have abandoned the claims. Apart from resolving the specific question whether certain parts of the application were part of the description or were claims, decision **J 15/88** (OJ 1990, 445) made clear that such abandonment of certain claims could only cause a substantive loss of subject-matter if the subject-matter involved was contained only in the claims and not also in the description or drawings. The board held that an applicant who declined to pay claims fees when they were demanded ran the risk that features of a claim deemed to have been abandoned

pursuant to R. 31(2) EPC 1973, which were not otherwise to be found in the description or drawings, could not subsequently be reintroduced into the application and, in particular, into the claims. The idea that there could be forced abandonment of subject-matter, in reliance on R. 31(2) EPC 1973, appeared rather to be in conflict with the principles of higher law to be deduced from Art. 52(1) EPC 1973 in conjunction with Art. 123(2) EPC 1973. An applicant normally had the right to derive subject-matter from any part of the description, claims or drawings as originally filed. This view has since been confirmed in other ex parte proceedings, namely **T 490/90**.

5. Consolidation of proceedings

In **J 17/92** the board first pointed out that Legal Advice No. 10/81, since replaced by Legal Advice No. 10/92 (OJ 1992, 662), the text of which did not differ in any material respect, was not binding on EPO bodies. Thus the possibility of consolidation that it interpreted into the Convention and the preconditions that it laid down for such consolidation were subject to review by the boards of appeal. The board held that allowing consolidation was something both permissible and desirable under the Convention, in accordance with the desire expressed in the preamble to the Convention that such protection be obtainable in the contracting states by means of a single procedure for the grant of patents. Consolidation was not only in the interest of applicants, but also in that of the public not to have to take account of two separate European patents with the same text. However, the board also found that the conditions to be imposed on consolidation should not be more restrictive than necessary. It therefore took the view that the condition that the two applications at issue as filed had to be identical was too stringent. Where, as in the case in point, an applicant was seeking to consolidate a Euro-PCT application for certain contracting states with a direct European application for other contracting states, it was not unnatural for the direct European application to be adapted to European requirements and the Euro-PCT application to contain claims adapted to the requirements of the applicant's home country. The board found that if the form of claims with which the applicant wished to proceed in the consolidated applications was acceptable either as an amended set of claims or as being identical to the set of claims as filed, consolidation should be possible. In the case at issue the differences related only to dependent claims and to the introduction of a claim in the first medical use format. In the board's view, such an amended set of claims should *prima facie* not prevent consolidation.

6. Entry into force of a decision to grant a European patent

Under Art. 97(3) EPC (former Art. 97(4) EPC 1973) the decision to grant a European patent shall take effect on the date on which the mention of the grant is published in the European Patent Bulletin. New Art. 97(3) EPC is essentially identical to Art. 97(4), first sentence, EPC 1973. The provisions concerning the minimum period that must lapse before the grant can take effect have been deleted from the Article. With the other grant formalities being transferred to the Implementing Regulations (see R. 71 EPC), this matter too was more appropriately regulated at a lower legislative level. Consequently, Art. 97(6) EPC 1973 was deleted as unnecessary.

Under the EPC 2000, Art. 98 EPC stipulates that the European Patent Office shall publish the specification of the European patent as soon as possible after the mention of the grant of the European patent has been published in the European Patent Bulletin. The contents of the specification are transferred to the Implementing Regulations (see R. 73(1) EPC). Art. 98 EPC now contains the words "as soon as possible" in order to indicate that it is not always technically possible to publish the specification on the same day as the mention of the grant.

In **J 7/96** (OJ 1999, 443) the board did not share the view of the department of first instance and the applicant that the proceedings for grant were concluded on the date the examining division reaches its decision to grant a European patent under Art. 97(2) EPC 1973. The board noted that it was true that this date represented the date on which the process of reaching a decision on the application within the examining division was concluded; both the EPO and the applicant were bound by the decision as far as the text of the patent to be granted, the claims, description and drawings were concerned, and the subject-matter of the text of the patent became *res judicata* at that date. Thereafter, the EPO could no longer amend its decision and had to disregard any fresh matter the parties might submit (see **G 12/91**, OJ 1994, 285). Only linguistic errors, errors of transcription and obvious mistakes could be corrected later under R. 89 EPC 1973. The date on which the decision to grant the European patent was reached was thus clearly decisive as regards the EPO and the applicant.

The board noted that under Art. 97(4) EPC 1973, the decision to grant a European patent referred to in Art. 97(2) EPC 1973 does not take effect until the date on which the European Patent Bulletin mentions the grant. It is from this date of mention that, in accordance with Art. 64(1) EPC 1973, a European patent confers on its proprietor the same rights in respect of each Contracting State in respect of which it is granted as would be conferred by a national patent granted in that State. The mention also marks the time when the responsibility of the EPO comes to an end and the national patent systems take over, the granted patent becoming a bundle of national patents. It also marks the start of the period during which a notice of opposition may be filed (Art. 99(1) EPC 1973). Thus, the date of publication of the mention of the grant of the patent is the date on which the grant of the patent takes legal effect with respect to third parties, and on which the extent of protection conferred on the applicant is determined once and for all by means of the accompanying publication of the specification of the patent pursuant to Art. 98 EPC 1973. During the period between the decision to grant the patent (Art. 97(2) EPC 1973) and the publication of the mention of the grant (Art. 97(4) EPC 1973), the application is deemed to be **still pending** before the EPO. As the department of first instance itself admits in its decision, and as is also not disputed by the applicant, according to established EPO practice it is still possible during this **interim period** to take some limited action in respect of the application, which may, for example, be withdrawn or transferred. Applicants may even withdraw individual designations if they so wish. For its part, the EPO continues to have certain rights or obligations concerning the patent during this period; for example, the annual fees fall due and transfers of rights in the patent must be registered by the EPO.

In **J 23/03** the appellant requested that the designation country GR incorrectly marked with a cross be corrected to GB. After a considerable exchange of correspondence, the examining division refused the request for correction on the ground that, from the date of publication of the patent, public interest in the reliability of the published information overrode the patent proprietor's interest in a correction, especially as he had had several opportunities to check the designation information in the course of the proceedings, namely after the notification of forms 2004 and 2005.

The board stated that R. 88 EPC 1973 did not contain an explicit reference to a time limit and that a request for correction could therefore be submitted at any stage of the patent grant procedure (see also **J 6/02**). This also applied to the correction of incorrect designation information in the application documents as requested by the appellant. The board nevertheless found that the appellant's request for correction of the designation information in the application documents had been submitted to the EPO only on 29.4.2002. Mention of the grant of his patent had appeared in the Patent Bulletin over a month before that date. Under Art. 97(4) EPC 1973, mention of the patent grant led to the grant of the patent taking effect and to the patent grant proceedings being concluded. At the time that the appellant submitted his request for correction, therefore, the proceedings were no longer pending (see **J 7/96**, OJ 1999, 433 and **J 42/92**).

The board held that the pendency of patent grant proceedings was, however, a requirement for the submission of an admissible request for correction because after that date the bundle of European patents granted under a single system divides into national patents which are then no longer administered by the EPO but by the appropriate national offices.

7. Errors in the Patent Bulletin

Art. 97(3) EPC (former Art. 97(4) EPC 1973) stipulates that the decision to grant a European patent shall take effect on the date on which the mention of the grant is published in the European Patent Bulletin.

In decision **J 14/87** (OJ 1988, 295) the question arose to what extent a deficiency in the publication of the mention of grant of a European patent, i.e. the omission of important particulars relating to the grant, might render the patent ineffective. The board held that in principle deficiencies in the publication of the mention of grant in the European Patent Bulletin did not necessarily render the decision to grant within the meaning of Art. 97(4) EPC 1973 ineffective. Nevertheless, this matter could be decided only in the light of the case in question and the fact that the purpose of the publication was to draw the attention of interested parties to the grant of the patent, and also that any decision to file an opposition had, under normal circumstances, to be based on a careful examination of the extent of the protection conferred by the patent and not solely on the particulars given in the European Patent Bulletin. Such an examination could be carried out satisfactorily only if the patent specification was published at the same time as the mention of grant of the patent.

8. Metric or SI units

R. 49(10) EPC (former R. 35 EPC 1973) stipulates that values shall be expressed in units conforming to international standards, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement shall also be expressed in units conforming to international standards. Only the technical terms, conventions, formulae, signs and symbols generally accepted in the field in question shall be used.

Former R. 35 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It has been renumbered as R. 49 EPC. In new R. 49(10) EPC the single principle at issue – that applicants must use the nomenclature and signs generally accepted in the technical field in question – is stated in a general form.

Decision **T 561/91** (OJ 1993, 736, see also **T 176/91** and **T 589/89**) led to the amendment of R. 35(12) EPC 1973 (now R. 49(10) EPC) since it found that the R. 35(12) EPC 1973 (earlier version) only required applicants for a European patent to express weights and measures in metric units. The wording of R. 35(12), first sentence, EPC 1973 was amended to make it clear that metric units meant SI units: "Physical values shall be expressed in the units recognised in international practice, wherever appropriate in terms of the metric system using SI units." R. 35(12) EPC 1973 was amended by decision of the Administrative Council of 13.12.1994 and entered into force on 1.6.1995 (OJ 1995, 409).

C. Special features of opposition and appeal proceedings

1. Late submission

1.1. Introduction

1.1.1 General

Under Art. 114(1) EPC, the EPO is obliged to examine the facts of its own motion, and in doing so, it is not restricted to the facts, evidence and arguments provided by the parties and the relief sought. According to Art. 114(2) EPC, however, the EPO may disregard facts or evidence which are not submitted in due time by the parties concerned. The apparent contradiction between these two principles has generated a considerable body of case law. In **T 122/84** (OJ 1987, 177) the board summarised the historical development of the principle of ex officio examination with regard to late submission on the basis of the "travaux préparatoires" to the EPC 1973.

The boards of appeal have developed different approaches to the consideration of late submissions. One line of thought is that Art. 114(1) EPC takes precedence over Art. 114(2) EPC; the main criterion for deciding admissibility is the relevance of the prior art (**T 156/84**, OJ 1988, 372). A second approach is that of "complexity" (**T 633/97**) where the decision to admit late-filed documents is governed by a general interest in the appeal proceedings being conducted in an effective manner. **T 718/98** does make the point that

admissibility of a document should be refused if it is done as a strategic measure, irrespective of its relevance (see **T 169/04**).

The boards stress that an opponent is required to submit all his objections during the opposition period, setting each out in full.

Precise rules governing appeal proceedings are also laid down in the Rules of Procedure of the Boards of Appeal (RPBA 2003), which were comprehensively amended in 2003. The criteria laid down therein for the admission of new submissions take account of the other parties' right to fair proceedings, and are aimed at having proceedings conducted more pragmatically and reliably. The boards were given express discretion to decide on the admissibility of subsequent amendments to a party's submissions (irrespective of whether they are facts, evidence or requests) (full details in CA/133/02). This discretion is exercised with particular attention to the complexity of the new material submitted, the current state of the proceedings and the need for procedural economy (Art. 13(1) RPBA 2007). The RPBA were amended again in 2007; this time the provisions on subsequent amendments were renumbered but unchanged.

1.1.2 Late filing

The boards stress that an opponent is required to submit all his objections during the opposition period, setting each out in full. In **T 117/86** (OJ 1989, 401) it was pointed out that facts and evidence in support of an opposition which were presented after the nine-month period had expired were out of time and late, and might or might not be admitted into the proceedings as a matter of discretion under Art. 114(2) EPC 1973. Boards had to ensure that proceedings were conducted expeditiously, and other parties fairly treated. The parties should submit all the facts, evidence and arguments relevant to their case as early and completely as possible, particularly when such an evidence was already known to the party concerned (see **T 101/87**, **T 237/89**, **T 951/91**, OJ 1995, 202, **T 34/01**, **T 1182/01**, **T 927/04**, **T 1029/05**).

Filing "on time" refers not only to facts and evidence submitted by the opponent within the nine-month opposition period but also to those that the patent proprietor may advance in his response to the grounds for opposition within the four-month time limit. New facts and evidence would be regarded as having been filed on time if the filing was occasioned by an argument or a point raised by another party or in the appealed decision so that, under the circumstances of the case, the new facts, documents and/or evidence could not have been filed earlier. The submission of facts and evidence within successive time limits could then also be "on time", if the principle of procedural economy has been duly observed, i.e. the submitting party has taken due care in the proceedings (**T 156/84**, OJ 1988, 372; **T 201/92**, **T 238/92**, **T 389/95**, **T 532/95**, **T 502/98**, **T 468/99**, **T 574/02**).

Under Art. 12(2) RPBA 2007 the statement of grounds of appeal and the reply must contain a party's complete case, and should inter alia specify expressly all the facts, arguments and evidence. Under Art. 13(1) RPBA 2007 any amendment to a party's submissions after it has filed its statement of grounds of appeal or reply may be admitted

and considered at the board's discretion. Art. 13(3) RPBA 2007 adds that amendments sought to be made after oral proceedings have been arranged will not be admitted "if they raise issues which the board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings." Art. 12(4) RPBA 2007 points out that in exercising this discretion the board can also disregard late submissions which were not admitted as late filed in the first-instance proceedings. Art. 12(4) RPBA 2007 also instructs us that consideration is unlikely to be given to new submissions that should have been presented in the first-instance proceedings.

1.2. Examination as to relevance

1.2.1 General

For a long time, board of appeal practice was governed by the landmark decision **T 156/84** (OJ 1988, 372), according to which the principle of examination by the EPO of its own motion under Art. 114(1) EPC 1973 took precedence over the possibility under Art. 114(2) EPC 1973 of disregarding facts or evidence not submitted in due time. Accordingly, the main criterion for deciding on the admissibility of late-filed documents and evidence was their **relevance**, i.e. their evidential weight in relation to other documents already in the case (see e.g. **T 322/95**, **T 475/96**, **T 864/97**, **T 892/98**, **T 605/99**). If the board conducted "examination as to relevance" when exercising its discretion under Art. 114(2) EPC 1973, then the admission of a citation (such as an anticipatory document) which had been filed late (i.e. could have been submitted earlier) depended on whether it was decisive (relevant) for the outcome of the case (see **T 258/84**, OJ 1987, 119). The EPO was therefore obliged to assess the citation's relevance by considering the facts. If, having regard to the facts of the case as a whole, the new submission had no material bearing on the decision, the board could, according to Art. 114(2) EPC 1973, disregard the submission without having to give **detailed** reasons (see **T 156/84**, OJ 1988, 372, **T 71/86**, **T 11/88**, **T 705/90**).

In **T 326/87** (OJ 1992, 522) the board took the same line, on the grounds that Art. 114(2) EPC 1973 set a legal limit on the inquisitorial duties of the appeal boards and that these duties should not be interpreted as extending to carrying out a roving enquiry into facts alleged and evidence adduced at a late stage of the proceedings. The main criterion for deciding on the admissibility of a late-filed document was its relevance (see also **T 286/94**).

Regarding examination as to relevance, the board explained in **T 560/89** (OJ 1992, 725) that Art. 114(2) EPC 1973 allowed the EPO to disregard documents which contained no more information than the documents filed on time and did not disclose matter which could change the outcome of the decision. According to the decision in **T 611/90** (OJ 1993, 50), late-filed evidence, documents and other matter could be rejected by the boards of appeal on the ground of their irrelevance, i.e. on the basis that they were no more "weighty" or "cogent" than documents which were already in the case (**T 237/03**).

However, the late-filed evidence had to be admitted into the case and taken into account if it was relevant - i.e. if it might cause the patent to be revoked or its scope to be limited (**T 164/89** and **T 1016/93**).

According to **T 97/90** (OJ 1993, 719) the wording of Art. 114(1) EPC 1973 did not mean that the boards of appeal had to conduct rehearings of the first-instance proceedings, with unfettered right, and indeed obligation, to look at all fresh matter regardless of how late it was submitted. Art. 114(2) and Art. 111(1) EPC 1973 set a clear limit to the scope of any new matter that could be introduced into an appeal by the parties so that cases on appeal had to be, and remain, identical or closely similar to those on which decisions at first instance had been rendered. This case law was confirmed by the boards of appeal inter alia in **T 26/88** (OJ 1991, 30; where it was stated that the essential function of the appeal procedure was to determine whether the decision issued by a department of first instance was correct on its merits), **T 326/87** (OJ 1992, 522), **T 229/90**, **T 611/90** (OJ 1993, 50) and **T 339/06**.

1.2.2 Examination as to relevance with regard to G 9/91 and G 10/91

Numerous decisions, in particular **T 1002/92** (OJ 1995, 605), have looked at the extent to which the principles set out by the Enlarged Board of Appeal in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) with regard to the admissibility of fresh grounds of opposition influence the admissibility of late-filed new "facts, evidence and arguments" in support of grounds of opposition already contained in the notice of opposition.

In the landmark decision **T 1002/92**, the board reached the following conclusion: **in proceedings before the opposition divisions**, late-filed facts, evidence and related arguments which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55(c) EPC 1973 in support of the grounds of opposition on which the opposition is based should only exceptionally be admitted into the proceedings if, prima facie, there are clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent in suit.

The criteria governing the admission of late-filed facts, evidence and arguments are more restrictive and stringent in proceedings before the boards of appeal than in opposition proceedings.

In **T 1002/92** the board held that in contrast to the first-instance proceedings, the appeal procedure is a judicial procedure and therefore "less investigative". Therefore, as regards **proceedings before the boards of appeal**, new facts, evidence and related arguments which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55(c) EPC 1973 in support of the grounds of opposition on which the opposition is based should only very exceptionally be admitted into the proceedings in the appropriate exercise of the board's discretion and if such new material was prima facie highly relevant in the sense that it could reasonably be expected to change the eventual result and was thus highly likely to prejudice maintenance of the European patent in suit. In addition other factors relevant to the case, in particular whether the patentee objected to the admissibility of the new material and

the reasons for any such objection, and the degree of procedural complication that its admission was likely to cause, should be taken into account. In general the later such new material was filed, the greater the degree of procedural complication it was likely to cause.

Many decisions have affirmed **T 1002/92** (**T 212/91**, **T 951/91**, OJ 1995, 202 and **T 255/93**, **T 481/00**, **T 994/00**, **T 1235/01**, **T 982/02**, **T 671/03**, **T 1027/03**, **T 151/05**, **T 1600/06**).

Late-filed evidence is only admissible under the established case law of the boards of appeal if it is more relevant than the evidence already on file (**T 1557/05**).

In **T 874/03** the board, considering a prior-art document and its English translation, which were first filed at the oral proceedings before the board, acknowledged that it was immediately apparent that this fresh material might represent the closest prior art. In accordance with Art. 10b(3) RPBA 2003, such facts and evidence might not in principle be admitted into the proceedings because their admission would lead to an adjournment of the proceedings. However, an exception to the above principle was justified if the patent proprietor agreed to the admission of the fresh material. The board stipulated that, as emphasised by the Enlarged Board in **G 9/91** (OJ 1993, 409), it might in some cases be in the patent proprietor's own interest that such facts and evidence were not excluded from consideration in the centralised procedure before the EPO. It pointed out that such fresh material had to be *prima facie* highly relevant in order to be admitted into the proceedings exceptionally with the agreement of the patent proprietor.

In **T 931/06** the board stated that when assessing inventive step, a late filed document may be considered if it belongs to the same or a closely related technical field and discloses subject-matter conceived for the same or a similar purpose as the contested patent. In the light of **T 1002/92** such a document would then be *prima facie* relevant in the sense that it might prejudice the maintenance of the patent, at least in unamended form.

1.3. Other criteria applied in the assessment of late submissions

1.3.1 General

In other decisions, the relevance of late-filed documents was no longer viewed as being the only decisive criterion for admitting them. Other criteria, such as how late the documents were and whether their submission constituted a procedural abuse or whether admitting the late-filed documents could lead to an excessive delay in the proceedings, were also held to be decisive. Late-filed facts, evidence and arguments from the appeal proceedings could also be excluded owing to the curtailment of the principle of examination by the EPO of its own motion (see **T 534/89**, OJ 1994, 464; **T 17/91**, **T 951/91**, OJ 1995, 202; **T 1019/92**, **T 1182/01**, **T 927/04**).

Under Art. 13(1) RPBA 2007, it is at the board's discretion to admit and consider any amendments to a party's submissions after it has filed its grounds of appeal or reply. The

discretion is exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.

In **T 188/05** the board did not share the appellant/opponent's view that it was obliged to admit relevant evidence irrespective of how late it had been filed, provided that it cast doubt on the patent's validity. The case law of the boards of appeal establishes quite clearly that the first instance and the boards of appeal have a discretion to admit late-filed submissions and that the exercise of this discretion depends on the facts of each case but pertinent matters may include the relevance of the new material, whether it could have been produced before and if so why it was not, whether other parties and/or the board itself are taken by surprise, and how easily they can and whether they have adequate time to deal with it.

1.3.2 Abuse of procedure

a) Where there is abuse of procedure

In some cases the boards of appeal have disregarded late-filed material on the grounds of abuse of procedure.

In **T 951/91** (OJ 1995, 202) the board refused to take account of late-filed evidence **even before it was actually submitted** and pointed out that the discretionary power given to the departments of the EPO pursuant to Art. 114(2) EPC 1973 served to ensure that proceedings could be concluded swiftly in the interests of the parties, the general public and the EPO, and to forestall tactical abuse. Parties had to take into account the possibility that late-filed material would be disregarded and do their best to submit the facts, evidence and arguments relevant to their case as early and completely as possible. If a party failed to do so without adequate excuse, and admitting the evidence would lead to an excessive delay in the proceedings, the boards of appeal were fully justified in refusing to admit it in exercise of the discretion provided by Art. 114(2) EPC 1973. The board held that the submission of further fresh experimental data proposed to be filed by the appellant (opponent) some 20 months after the statement of grounds of appeal had been filed as an abuse of procedure.

In **T 496/89** the board pointed out that the late introduction of documents and of other matter into the appeal proceedings is inimical and contrary to the public interest, quite apart from being unfair to the other party. Attempts by either party to spring a surprise on the other by deliberate late-filing, as well as inadvertent omissions to present arguments and the evidence needed to support them, ran counter to the spirit and intent of the Convention (see also **T 430/89**).

In **T 270/90** the board refused to consider late-filed experimental data, on the grounds that the principle of fairness had been breached. In point of fact, the data was irrelevant anyway, but this was only a secondary consideration.

In **T 741/91** the board stated that filing evidence only one day prior to the oral proceedings before the opposition division, thus not allowing the other party to consider

and respond to it during the oral proceedings, was not acceptable conduct on the part of the submitting party. The opposition division should disregard such evidence by exercising the discretion conferred upon it under Art. 114(2) EPC 1973.

The board in **T 718/98** decided that a party's introduction, at a very late stage of the proceedings, of evidence which could have been filed much earlier, as a strategic measure to improve its own case against the opposing party, amounted to an abuse of procedural rights and was therefore rejected independently of the possible relevance of the evidence.

In **T 135/98** the appellant (patent proprietor) had sought and obtained a postponement of the oral proceedings in order to be able to prepare and file further evidence in the form of independently conducted experiments. The evidence eventually filed was not the evidence for which the appellant had sought an adjournment. In the board's judgment, it had been unfair for the appellant to remain silent for four months, knowing that he would be filing evidence the other parties and the board did not expect. It had to be remembered that any postponement of oral proceedings granted in favour of an appellant acted as an extension of the suspensive effect of an appeal and thus, in the case of an appealing patentee, of the time during which respondent opponents risked an allegation of infringement if they worked an invention which had already been found unpatentable by the opposition division. In the circumstances, the appellant's behaviour had been an abuse of procedure.

In **T 446/00**, the board identified various forms of behaviour as abuses of procedure, including non-compliance with a procedural direction of the board requiring a party to take a certain step or steps. It was also an abuse of procedure for a party to adopt an unequivocal position on an issue and subsequently to depart from that position without explanation. That applied particularly, but not solely, in contested inter partes proceedings, in which another party was entitled to rely on that position as part of the case it had to meet. Furthermore, the board stated that it was the duty of any party to proceedings, whether ex parte or inter partes, to make its own case and to formulate its own requests.

b) Where there is no abuse of procedure

In some other decisions, the boards of appeal held that there had been no tactical abuse and took the late-filed documents into account under the principle of examination by the EPO of its own motion, since these might have put maintenance of the patent at risk (see **T 110/89**, **T 315/92**). An abuse of procedure presumes a deliberate withholding of information (see **T 534/89**).

In **T 1019/92** the board reached the conclusion that the fact that an opponent, after the end of the opposition period, subsequently submitted prior art material originating from itself, did not constitute an abuse of the proceedings in the absence of evidence that this was done deliberately for tactical reasons. The board admitted the late-filed document into the proceedings.

In **T 330/88** the board held that the right to be heard had not been contravened by virtue of a relevant document being submitted late during oral proceedings. The representative was given sufficient time during the oral proceedings held on two consecutive days to consider this document, consisting of only seven pages including the claim page and two figure sheets. He could be expected to be able to react to this new situation either by rejecting the document as irrelevant or by filing amended claims.

In **T 671/03** the opposition division did not admit documents D6 to D16 into the proceedings, stating that they had been filed more than two years after the expiry of the opposition period and were *prima facie* not so complete as to substantiate the alleged prior use. Three more documents were filed during the appeal proceedings. The board regarded all these documents as late-filed, and it was at its discretion to admit them. However, it was not apparent to the board that the submission of documents D6 to D19 had been deliberately delayed for tactical reasons. It therefore held that the late filing was not an abuse of procedure. Documents D6 to D19 could therefore not be disregarded without considering their relevance. Following a detailed examination of the relevance of the various documents, the board concluded that only D18 could be admitted into the proceedings under Art. 114(2) EPC 1973 because it was *prima facie* highly relevant, i.e. most likely prejudiced the maintenance of the European patent (**T 1182/01**, **T 1029/05**).

In **T 151/05** the fact that the appellant relied first on prior use 2 and then, after having realised that this argument was not sufficiently substantiated, on other evidence for demonstrating the common general knowledge was seen by the board as a misjudgment but not as an abuse of the proceedings. Consequently, the board considered the relevance of the documents.

In **T 1757/06** the opponent (Dow chemical Company of Midland) submitted a patent publication filed by Dow Italia of Milan two months before the oral proceedings before the board of appeal. The board held that the opponent and the applicant were separate corporate entities, but nevertheless it would be expected that companies of the same commercial group would have knowledge of their own patent documents. Normally the attempt of a party to file at a late stage one of its own publications will fail, as this is considered to be an abuse of procedure. Although in this case the board did not find that there had been an abuse, it pointed out that the filing at a very late stage of a document that the opponent should have been aware of from the outset of the proceedings could not be condoned.

1.3.3 Procedural economy

In **T 633/97** the board found that the complexity of the examination necessitated by the late-filed material should also be a criterion for considering it. It explained that once oral proceedings had been arranged in appeal cases, the decision to admit new evidence or requests into the procedure should hinge neither on a fixed time limit for their submission nor on their merit. It should instead be governed primarily by a general interest in the appeal proceedings being conducted in an effective manner, i.e. in dealing with as many of the issues raised by the parties as possible, while still being brought to a close within a

reasonable time. New submissions should normally be disregarded if the **complexity of the technical or legal issues** raised was such that neither the board nor the other party could be clearly expected to deal with them without adjournment of the oral proceedings. Complex fresh subject matter filed at short notice before or during oral proceedings ran the risk of being not admitted to the proceedings without any consideration of its relevance or allowability (see **T 1050/00**, **T 1213/05**).

In **T 1044/04** the board stated that the late-filed document was a relatively short document which did not raise further complex substantive questions with regard to technical or legal issues complicating the appeal proceedings (see **T 633/97**). Thus the board, when exercising its power referred to in Art. 10a(4) RPBA 2003 (Art. 12(4) RPBA 2007) decided to admit the late-filed document D6 into the appeal proceedings.

In **T 151/05** the board admitted the documents into the proceedings pursuant to Art. 114(2) EPC 1973 and stated that the filing of the documents was not late to such an extent that the respondent could not adequately prepare his defence.

In **T 1557/05** the board held with regard to the admissibility into the appeal proceedings of documents D6 to D9 filed by the appealing opponent that, while the proceedings were *inter alia* based on the notice of appeal and statement of grounds pursuant to Article 108 EPC 1973 under Art. 10a(1)(a) RPBA 2003 (Art. 12(1) RPBA 2007), this did not mean that all evidence filed with the statement of grounds automatically became admissible evidence in the appeal proceedings and that the principles established in Art. 114 EPC 1973 no longer applied. It was still at the board's discretion under Art. 114(2) EPC 1973 to disregard late-filed facts, evidence and arguments.

In **T 188/05** the board held that the admission of the appellant's new submission would alter his case in a way that would raise issues which the board and the respondent could not reasonably be expected to deal with without adjournment of the oral proceedings. The material was therefore not admitted to the proceedings under Article 10b(3) RPBA 2003 (Art. 13(3) RPBA 2007).

In **T 1774/07** the introduction of the new documents into the proceedings without adjourning oral proceedings would have been contrary to the principle of equal treatment of the parties. The board thus concluded that the documents, independently on their relevance, were not to be introduced into the proceedings.

1.3.4 Late submission of experimental data

In some decisions experimental data was submitted about one or two months prior to the oral proceedings before the boards of appeal. They were not admitted into the proceedings under Art. 114(2) EPC 1973 as having been late-filed. The reason invoked was that the handling of such data was more cumbersome and time-consuming than that of scientific publications, since most of the time they call for counter-experiments (**T 342/98**, **T 120/00**, **T 157/03**). In **T 760/05** the board confirmed that filing an experimental report shortly before the date indicated by the board as ultimate date for filing submissions ran counter to the principle that sufficient time should remain for the

adversary to study it and perform counter-experiments. Similarly, in **T 569/02**, the board held that comparative experiments normally required careful consideration by the other party, including discussions with technical experts who could not be expected to be immediately available. It might also be necessary for the other party to repeat the tests or perform other tests themselves. The board did not consider that the **relevance of the tests** played a role, since even relevant evidence of this type should not be filed at such a late stage in the proceedings. The comparative tests filed one month before the oral proceedings were found inadmissible regardless of their possible relevance.

Moreover, if oral proceedings have been arranged in inter partes proceedings, experiment results must be submitted sufficiently well in advance for the other party to have the opportunity to perform counter-experiments (e.g. **T 270/90**, OJ 1993, 725; **T 939/90**, **T 375/91**, **T 685/91**, **T 305/94**). Very late submission of experiment results (seven weeks before the oral proceedings) is contrary to a fair and expedient procedure (**T 375/91**, **T 1008/05**).

In **T 685/91** the board also confirmed that the opposition division had rightly decided not to consider the experiment report, which was submitted about one month prior to the oral proceedings before the opposition division, because such a short period was clearly insufficient to carry out counter-experiments. However, the report was admitted into the appeal proceedings since the same comparative data had been submitted together with the statement of grounds of appeal in support of the objection of lack of inventive step raised initially in the statement of grounds of opposition.

In **T 356/94** the board added that any late-filed facts or evidence could be admitted in the opposition proceedings in so far as such facts or evidence were subsequently discussed by the parties concerned in accordance with Art. 113(1) EPC 1973, which meant allowing the parties sufficient time, depending on the nature of the facts or evidence submitted, to provide explanations. Taking into consideration comparative tests presented on the same day as oral proceedings were held could constitute an infringement of the other party's right to be heard, since the latter had had no material opportunity to check them.

1.3.5 Public prior use

a) Non-consideration of late submission of public prior use

Stricter standards have been set by the boards of appeal particularly in the case of the admissibility of late-filed evidence of public prior use by the opponent. On the basis of Art. 114(2) EPC 1973, the boards did not include late-filed evidence in the proceedings because in the specific circumstances there had been an abuse of procedure and a breach of the principle of good faith. In such cases the boards chose to refrain from examining the **potential relevance** of the submission (see **T 17/91**, **T 534/89**, OJ 1994, 464 and **T 211/90**). In **T 985/91** the board was of the view with reference to **T 17/91** that late-filed documents should only be admitted into the proceedings under certain circumstances if they related to alleged prior use.

In **T 17/91** an allegation of prior use based on the opponents' own activities had been filed two years after the expiry of the opposition period, with no good reason for the delay. This, in the board's view, constituted an abuse of the proceedings and a breach of the principle of good faith. Irrespective of its potential relevance, the allegation was therefore to be disregarded under Art. 114(2) EPC 1973.

Taking a similar line, the board ruled in **T 534/89** (OJ 1994, 464) that an objection based on prior use by the opponents themselves which was raised only after the expiry of the opposition period (Art. 99(1) EPC 1973), although the factual circumstances were known to the opponents and there was nothing to prevent the objection being raised during that period, constituted an abuse of procedure. From this, the board concluded that when abuse of procedure was manifest, in view of the fact that a party deliberately refrained from raising an issue even though the necessary supporting evidence was available, it would be contrary to the principle of good faith to admit such evidence by applying Art. 114(2) EPC 1973 in that party's favour.

Four weeks before the oral proceedings in **T 211/90** the appellant alleged public prior use for the first time. However, the evidence was already familiar to the appellant before expiry of the opposition period. The board held that the fact that the appellant was unaware of the relevance of this evidence, even though familiar with it at the time of filing the opposition, did not justify its introducing the evidence into the proceedings for the first time at such a late stage - irrespective of the reasons why it did not become aware of the potential relevance of this material until then. Neither the fact that the appellant had changed representatives during the appeal proceedings, nor the fact that it was the new representative who first recognised the relevance of this material could justify taking it into account. The board therefore decided not to consider this material in the further proceedings, without examining its potential relevance.

If prior use is alleged for the first time in the appeal proceedings, and not in the statement of grounds but at a later stage shortly before the oral proceedings, admissibility to the proceedings is only an option if the new material is *prima facie* highly relevant (**T 503/94**, **T 1037/01**).

In **T 481/99** the board said that the principle that late-filed facts, evidence and related arguments should only exceptionally be admitted into the proceedings by the opposition division (see e.g. **G 9/91**, OJ 1993, 408 and **T 1002/92**, OJ 1995, 605) did not imply that a late-filed allegation of prior use, which would be relevant if proven, was to be automatically disregarded on the ground that the new facts first needed to be established by taking evidence. However, if the submissions and/or documents relating to the late allegation of prior use showed inconsistencies or even contradictions, the deciding body was entitled to disregard the alleged prior use pursuant to Art. 114(2) EPC 1973 without further enquiries. The board saw no reason to deviate from the opposition division's decision to disregard the disputed alleged prior use, as it had correctly exercised its discretionary power.

In **T 380/00** the appellant (opponent) relied for the first time in the statement of the grounds of appeal on the non-confidential disclosure of technical features of the

invention by an engineer during a job interview. In support of this argument, the appellant filed a statutory declaration by the engineer and a series of drawings which were allegedly produced during the interview. The board stated notably that the statutory declaration did not identify the persons present at the interview and that the technical drawings were marked confidential. It further considered that the respondent (patentee) had convincingly submitted that according to standard practice the persons present at the interview on behalf of the prospective employer would have felt bound by an at least implicit obligation of confidentiality, and the appellant had not provided any evidence to the contrary in the statement of the grounds of appeal. The board ultimately considered that the alleged public prior use by the engineer was too poorly substantiated to justify further investigation of the matter.

On the issue of documents relating to prior use submitted during appeal proceedings, the board in **T 508/00** ruled that poor communications within a company or a group of subsidiary companies did not constitute adequate and acceptable grounds for allowing the late submission of evidence concerning alleged prior use.

b) Consideration of late submission of public prior use

In **T 847/93** the board remitted the case to the department of first instance because the prior use asserted by the opponent referred not to his own business but to a device produced by a third company and supplied to him.

In **T 628/90** an allegation of public prior use, which was filed for the first time in appeal proceedings and was adequately substantiated, was taken into account because of its possible relevance to enable thorough consideration to be given to the patentability of the subject-matter of the contested patent (see also **T 150/93**, **T 947/99**).

In **T 252/95**, the appellant cited in his grounds of appeal a public prior use which he had not put forward in the opposition proceedings. The board admitted this new submission - in deciding whether it was late, it had to consider the entire technical contribution in the opposition proceedings and the reasons given in the contested decision for refusing the opposition. The appellant had convincingly explained why he had been unable to respond to the opposition division's decision by continuing to argue on the basis of the public prior use originally cited, and why this new public prior use was required for a further-reaching discussion of the features.

In **T 947/99** the appellant submitted with regard to the circumstances of the late claim concerning public prior use that he had only become aware of the possibility that there might have been public prior use in the course of proceedings conducted in parallel before the Patents Court in London at a meeting on 17 May 1999. In the board's opinion, the appellant had given a very clear explanation and sound reasons as to why the claim of public prior use had been made and why it could not have been made any earlier.

1.4. Consideration of late-filed facts, evidence and arguments in opposition proceedings

1.4.1 Submission after expiry of the period for filing the notice of opposition

According to **T 1002/92** (OJ 1995, 605), in proceedings before the opposition divisions, late-filed facts, evidence and arguments that went beyond the "indication of the facts, evidence and arguments" presented as part of the notice of opposition pursuant to R. 55(c) EPC 1973 in support of the grounds of opposition on which the opposition was based should only exceptionally be admitted into the proceedings if, *prima facie*, there were reasons to suspect that such late-filed documents would prejudice the maintenance of the European patent in suit.

In **T 214/01** the board decided to admit documents, which had been filed by the opponent on the "final date" within the meaning of R. 71a EPC 1973 in preparation for the oral proceedings before the opposition division. Since the appellant (opponent) in the statement of grounds had questioned the opposition division's choice not to admit all these documents into the proceedings, the board took the opportunity to note that, although Art. 114(2) EPC 1973 gave an opposition division discretion not to consider evidence not submitted in due time, the division was obliged to give reasons for its decision not to consider such evidence if the opponent remained of the view that it was relevant. It was not acceptable that (relevant) pieces of evidence filed outside the opposition period were not mentioned at all in the decision under appeal.

Already, in **T 705/90** the board pointed out that any decision to disregard late-filed documents had to be accompanied by a statement of reasons. It was not enough simply to point out that the documents were late.

1.4.2 Opposition divisions' exercise of discretion

In **T 267/03** the board decided that a late submission not admitted by the opposition division was not to be admitted by the board if the opposition division had correctly exercised its discretionary power under Art. 114(2) EPC 1973.

In **T 927/04** the board noted that the opposition division decided not to admit document D8, since it was *prima facie* not relevant for demonstrating a prior use. The board, having considered the evidence of D8 and the opposition division's decision that such evidence was not admissible, was satisfied that the opposition division did not misuse its discretion under Art. 114(2) EPC 1973 when it elected to disregard document D8. Consequently, the board decided not to introduce document D8 into the proceedings.

In **T 624/04** the board remarked on the interpretation of Art. 12(4) and Art. 13 RPBA 2007 that under Art. 10a(4) RPBA 2003 (Art. 12(4) RPBA 2007), the board may refuse to admit facts, evidence and requests (not arguments), which were furnished within the time limits of Art. 10a(1) RPBA 2003 (Art. 12(1) RPBA 2007), if this material could already have been supplied at first instance but was not, or was filed then but not admitted.

In **T 876/05** the board rejected the opponent's argument that filing new documents a few days before the oral proceedings before the department of first instance was destined for failure and that it was therefore preferable for him not to file those documents until the appeal stage. The board held that Art. 10a(4) RPBA 2003 (Art. 12(4) RPBA 2007) put documents that could have been submitted before the department of first instance and documents which had been submitted but had not been admitted on an equal footing. Had these documents been filed in the opposition proceedings, the worst that could have happened was that they would have been regarded as inadmissible by the opposition division, so the consequences would have been no different than if they had not been filed. Exercising its discretion under Art. 10a(4) RPBA 2003, the board decided, when examining the patentability of the filed requests, to consider only the documents that appeared immediately relevant.

In **T 609/99** the board stated that despite the proprietor's objection to the admission of evidence which had been disregarded in the opposition procedure pursuant to Art. 114(2) EPC 1973, the board might, in certain circumstances, take account of this evidence without any implication that it was *prima facie* highly relevant. This exercise of discretion was not inconsistent with the criteria set out in **T 1002/92**.

1.4.3 Request withdrawn before the opposition division

In **T 390/07** the request at issue was not a new request but one which was before the opposition division and on which no decision was made as it was withdrawn. The only basis on which a request withdrawn at first instance may be admitted on appeal is that, as in the case of any other request filed on appeal, it may overcome the reasons for the decision actually given on another request. The claim request which was replaced by another request in proceedings before the opposition division because it was manifest that it would fail, thereby avoiding a formal decision, and which was filed on appeal, was considered inadmissible by the board.

1.5. Justification for late filing

1.5.1 General

According to the established case law of the boards of appeal, late filing is justifiable if it is an appropriate and immediate reaction to developments in the previous proceedings (**T 855/96**). Late filing is also admissible in order to support the reasoning to date (**T 561/89**) and to prove claimed common general knowledge, if challenged (**T 106/97**, **T 1076/00**). **T 339/92** held that late-filed material should be considered, provided it does not delay the proceedings. In some decisions, the ruling was that the lateness was less significant when the party was reacting to a finding in the decision in suit or to submissions made by the other side.

In **T 502/98** the board stated that this might be the case if, for example, certain facts or evidence became relevant only after a party had submitted an unforeseeable amendment to the claims, or a new experimental test report, or had for the first time challenged the existence of common general knowledge undisputed up to that moment.

In **T 85/93** (OJ 1998, 183) the board pointed out that evidence of common general knowledge, like any other evidence in support of an opponent's submissions, should be filed at an early stage in the proceedings before the opposition division, and might be rejected as inadmissible at the board's discretion if filed for the first time during appeal proceedings. In **T 274/99** the board considered the late-filed textbook under Art. 114(1) EPC 1973 – although late-filed documents, including those that prove common general knowledge, could be disregarded under the boards' case law – because it provided a better understanding of the state of the art, it was obviously relevant, its submission could be seen as reasonable as far as the respondent was concerned, and its consideration did not delay the proceedings in any way.

In **T 736/99**, prior-art document D4 was submitted two years and eight months after expiry of the term set by Art. 108 EPC 1973. The board did acknowledge that the fact that the amendment to claim 1 was such as to imply a shift of priority date was not something which was flagged in the decision under appeal. Nevertheless, legally, the opponent had received constructive notice of the priority shift in the decision under appeal, and a first submission of intermediate prior art in response to it after expiry of the four-month period for filing the statement of the grounds of appeal had to be regarded as a late submission, whose admission was a matter for the discretionary power of the board pursuant to Art. 114(2) EPC 1973. In the board's judgment, D4 was sufficiently relevant in relation to the issue of inventive step for it to be admitted into opposition appeal proceedings despite being submitted late.

In **T 1105/04** the board referred to **T 736/99** and admitted a late-filed document into the proceedings, because it was considered by both parties as the closest prior art document.

In **T 875/06** the board found that the additional evidence D14 and D15 did not change the appellant's case but simply backed up the arguments made previously because these documents were more relevant with regard to the cited aspects of the invention than the documents already entered into the proceedings. Since the consideration of D14 and D15 did not significantly alter the legal framework and facts of the case in respect of the first-instance proceedings, the board admitted these documents into the proceedings under Art. 13(1) RPBA 2007. In **T 113/96** and **T 426/97**, involving similar cases, the boards admitted new prior-art documents.

In **T 259/94** the appellants submitted new evidence - including documents reflecting common general knowledge and reports of tests - two years after filing the appeal. The respondent did not object to their introduction into the appeal proceedings. The board held that in such circumstances the principle of "*volenti non fit iniura*" empowered it to admit the late-filed evidence.

1.5.2 Justified reaction to the opposition division's decision

In **T 101/87** the board drew a distinction between (a) the case of an opponent attempting to find further prior art when the opposition division had decided that the original citations did not warrant revoking or restricting the patent, and (b) the case of an opponent

making a further search in response to substantial amendments of a claim or to comments from the opposition division regarding a missing link in a chain of argument. In the latter case, new documents could be admitted into the proceedings, instead of being regarded as late-filed.

In **T 49/85** the board stated that a reference filed by an opponent for the first time with its statement of grounds was not submitted in due time unless representing the effective counter evidence to a newly emphasised reason given in the decision (see also **T 172/85** and **T 561/89**). The same applied if the party reacted to its opponent's submission, e.g. in **T 705/90**, where documents I to N were cited by the appellant in its observations in support of an argument presented in response to the respondent's statement of grounds. Similarly, in **T 238/92** the board of appeal did not consider a document presented for the first time with the statement of grounds of appeal as "late-filed", since it served as the first evidence of a feature considered in the contested decision as essential for the assessment of inventive step (see also **T 117/92**).

In **T 927/04** the board stated that, it was legitimate for a party who had lost in opposition proceedings to try to improve its position in appeal by filling a presumed missing link, as in the case in point, with respect to the issue of prior use. Taking further into account the fact that the documents had been submitted at the earliest possible moment by the appellant, namely at the beginning of the appeal proceedings, the filing of these documents could thus not represent an abuse of proceedings. Consequently, the board decided to introduce these documents into the proceedings.

In **T 1380/04** D16 was submitted for the first time with the statement of grounds. In the board's view, the submission of D16 along with the statement of grounds was a justified reaction to the opposition division's decision. However, this in itself was not enough to justify admitting the document into the proceedings. The document would also have to relate more to inventive step *prima facie* than any other document already in the proceedings. The board concluded that D16 was so relevant to the issue of inventive step that it had to be considered in the rest of the proceedings. D16 was therefore admitted into the proceedings.

1.5.3 Change of representative

In **T 430/89** the explanation for the late submission of arguments and a document was that the representative had only recently taken over the case. The board held that this could not be accepted as a justification for tardiness.

In **T 785/96**, under cover of a letter sent just one month before the oral proceedings before the board, the appellant filed additional experiments. The appellant stated that the reason for this late filing was a change of representative, after which the necessity of the experiments had appeared. The board confirmed the decision **T 97/94** (OJ 1998, 467) and stated that a change of representative did not form an acceptable ground for late filing unless it was due to force majeure. The new representative was obliged to continue the proceedings from the point they had reached when he took over from his predecessor (see also **T 552/98**).

In **T 736/99**, prior-art document D4 was submitted two years and eight months after expiry of the term set by Art. 108 EPC 1973. As the appellant (opponent) accepted unreservedly, a change of professional representative was not an objective excuse for delay.

1.6. Examination of the arguments

According to the case law of the boards of appeal, Art. 114(2) EPC 1973 provides no legal basis for disregarding late-filed arguments. Art. 114(2) EPC 1973 (Art. 114(2) EPC, unchanged) refers to late-filed facts and evidence, but not arguments ("Tatsachen und Beweismittel" in German; "faits et preuves" in French). Late-filed arguments cannot therefore be disregarded on the grounds that they were submitted for the first time at the oral proceedings (**T 92/92**, **T 704/06**).

In **T 92/92**, the board held that the EPC in the English version made a clear distinction between "facts and evidence" on the one hand and "arguments" on the other in Art. 114(1) EPC 1973 and that Art. 114(2) EPC 1973 did not refer to arguments. Art. 114(2) EPC 1973 was to be interpreted such that the parties' right to argue their case was not unduly restricted.

The Enlarged Board of Appeal defined "new arguments" in opinion **G 4/92** (OJ 1994, 149) not as new grounds or evidence, but as reasons based on the facts and evidence which have already been put forward (**T 131/01**, OJ 2003, 115). In **T 604/01**, facts in the legal sense are to be understood as the circumstances and incidents of a case, looked at apart from their legal bearing. In the case in question, the board decided that the appellant's submission in the oral proceedings should have been classified only as an argument. In **T 926/07** the board stated that facts are claimed subject-matter which must, where applicable, be substantiated by evidence. Arguments, by contrast, are the expositions generated when the law is applied to facts and evidence filed on time. Arguments based on facts filed on time are therefore to be admitted at every stage of the opposition and opposition appeal proceedings.

Taking a similar line in **T 861/93**, the board ruled that decisions referred to by a party in support of its arguments were never citations which, under Art. 114(2) EPC 1973, could be rejected as being late. Arguments were not covered by the said provision. Therefore, decisions to which a party referred in support of its arguments should be regarded as part of these arguments and should not be rejected as being filed late.

Filing with the statement setting out the grounds of appeal, new documents reinforcing the line of attack already made before the department of first instance had to be considered as the normal behaviour of a losing party and did not constitute an abuse of procedure (**T 113/96**, **T 1034/01**, **T 1177/04**, **T 1267/05**).

Under R. 71a EPC 1973 (R. 116 EPC, unchanged) new facts and evidence do not need to be considered after the time stated in the summons, unless they are admitted on the grounds that the subject of the proceedings has changed. R. 71a EPC 1973, and Art. 114(2) EPC 1973 on which it is based, refer to late-filed facts and evidence but not to

new arguments, which can be made at any stage in the proceedings (**T 131/01**, OJ 2003, 115; **T 926/07**).

In **T 131/01** (OJ 2003, 115) the board had to point out that it followed that new relevant arguments in respect of previously submitted facts presented after the time indicated in the summons had to be taken into account by the opposition division under R. 71a EPC 1973.

1.7. Documents cited in the patent specification or search report

A document considered during the examination procedure is not automatically scrutinised in opposition or opposition appeal proceedings, even if it is quoted and acknowledged in the contested European patent (**T 155/87**, **T 198/88**, OJ 1991, 254; **T 484/89**, **T 652/99**). According to **T 291/89** this also applied to a document cited in the search report. In **T 111/04** the board agreed with the case law and considered that this applied also to evidence filed during the grant proceedings.

In **T 536/88** (OJ 1992, 638) the board pointed out, however, that the document cited and acknowledged in the description of the contested patent itself as the closest prior art and on the basis of which the technical problem in the description was formulated remains an exception. Such a document also forms part of the opposition or opposition appeal proceedings even if it is not expressly cited within the opposition period (**T 541/98**, **T 652/99**, **T 454/02**, **T 86/03**).

In **T 140/00** although document (7) had been cited in the specification of the patent in suit, it had merely been acknowledged as conventional background art; it was not considered therein as essential or as the closest prior art and starting point of the claimed invention. Therefore, that document did not automatically form part of the appeal proceedings and, thus, was late-filed evidence subject to a discretionary decision of the board.

In **T 234/90**, **T 300/90** and **T 501/94** (OJ 1997, 193) the board held that a document indicated in a citation as the closest prior art for the purpose of elucidating the technical problem set out in the citation did not automatically form part of the opposition or opposition appeal proceedings if not expressly cited within the opposition period.

Regarding this issue, the board commented in **T 387/89** (OJ 1992, 583) on the scope of the principle of ex officio examination under Art. 114(1) EPC 1973 in opposition proceedings. In the board's view, neither an opposition division nor a board of appeal had any duty to reconsider the relevance of documents cited in the European search report if such documents had not been relied upon by the opponents to support their grounds of opposition. Under Art. 114(1) EPC 1973, however, an opposition division or appeal board could introduce new documents into the opposition proceedings if it had good reason to suppose that the documents could affect the outcome of the decision (**T 420/93**). In **T 588/89** the board similarly introduced a document into the appeal proceedings under Art. 114(1) EPC 1973, because, in its view, the document reflected the closest prior art and raised doubts as to whether an inventive step had taken place.

In **T 219/92** a document cited in the search report had to be taken into consideration in view of its relevance. The board also considered it justifiable to exercise its discretion under Art. 111(1) EPC 1973 to decide the case having regard to this document, since the responsibility for the late citing lay with the respondents and the decision was not to the appellant's disadvantage.

2. Withdrawal of opposition

2.1. Impact of withdrawal of opposition on proceedings before the EPO

2.1.1 Withdrawal of opposition during opposition proceedings

R. 84(2) EPC (unchanged from the previous R. 60(2) EPC 1973) provides that the opposition proceedings may be continued by the EPO of its own motion if the opposition is withdrawn.

In **T 197/88** (OJ 1989, 412) the board, referring to **T 156/84** (OJ 1988, 372) held that if an opposition was withdrawn after the dispatch of the communication pursuant to R. 58(4) EPC 1973, the opposition proceedings should, in principle, be continued by the opposition division of its own motion in the public interest. According to the board, proceedings ought to be continued if they had reached such a stage as to be likely to result in limitation or revocation of the European patent without further assistance from the opponent and without the opposition division itself having to undertake extensive investigations.

In **T 558/95** the board noted that the main request had been refused by the opposition division before the opposition was withdrawn. The decision concerning this request was thus final; even after the withdrawal of the opposition, it could no longer be reviewed by the department of first instance. The continuation of the proceedings by the EPO of its own motion under R. 60(2) EPC 1973, second sentence, therefore applied only to the auxiliary request, which had not been the subject of a final decision.

According to **T 283/02**, withdrawal of an opposition was a definitive procedural declaration which took away the opponent's status as an active party to the proceedings. Such a declaration did not require the agreement of either the opposition division or the patent proprietor. It took effect as soon as it was received by the EPO. The decision whether or not to continue the proceedings under R. 60(2) EPC 1973 thus rested solely with the opposition division.

2.1.2 Withdrawal of the opposition during appeal proceedings

The effects of this vary, depending on whether the opponent in the appeal proceedings is the appellant or the respondent.

In **G 8/93** (OJ 1994, 887) the Enlarged Board held that if the **opponent as sole appellant** filed a statement withdrawing his opposition this immediately and automatically terminated the appeal proceedings, irrespective of the patentee's consent.

The proceedings were also terminated if in the board's view the requirements under the Convention for maintaining the patent were not met. The Enlarged Board emphasised the distinction between the power to initiate and continue proceedings and the power to clarify the facts in pending proceedings. According to its case law, in appeal proceedings the former was **exclusively** the province of the appellant, whereas the latter might be exercised by the board subject to Art. 114 EPC 1973 provided proceedings were pending.

This confirmed the earlier case law (see **T 117/86**, OJ 1989, 401; **T 129/88**, OJ 1993, 598; **T 323/89**, OJ 1992, 169; **T 381/89** and **T 678/90**). Any statements made following withdrawal of the opposition are irrelevant (see **T 381/89**). **T 544/89** is overruled.

If, however, the **opponent** is the **respondent**, withdrawal of the opposition does not affect the appeal proceedings (see e.g. **T 135/86**, **T 362/86**, **T 373/87**, **T 194/90**, **T 629/90**, OJ 1992, 654; **T 138/91**, **T 329/92**, **T 627/92**, **T 463/93**, **T 798/93** (OJ 1997, 363), **T 78/95**, **T 4/04** and **T 340/05**). The board therefore has to reexamine the substance of the opposition division's decision. However, it could set it aside and maintain the patent as requested by the appellant only if the specification meets the requirements of the EPC. When the board examines the decision, evidence can be cited which has been submitted by an opponent before the opposition was withdrawn (**T 340/05**, see also **T 900/03**). However, under **T 789/89** (OJ 1994, 482) withdrawal of an opposition by the respondent means the respondent ceases to be party to the appeal proceedings in respect of the substantive issues; he remains party to them only as regards apportionment of costs (confirmed by **T 82/92**, **T 884/91**, **T 329/92** and **T 340/05**). **T 484/89** on the other hand found that the respondent remained party to the proceedings although not obliged to take an active part. The opposition division's decision is not examined "by the Office of its own motion", but as a result of the appeal, i.e. on the basis of the "request" by the appellant for the contested decision to be revoked (**T 958/92**).

For the consequences of withdrawal of the opposition as regards the board's powers of ex officio examination of the facts, see chapter VII.E.6.4 below, facts under examination.

3. Intervention

3.1. General

Under Art. 105 EPC, to intervene admissibly in opposition proceedings a party must show either that proceedings for infringement of the same patent have been instituted against him, or that following a request of the proprietor of the patent to cease alleged infringement, the third party has instituted proceedings for a ruling that he is not infringing the patent. Under Art. 105(2) EPC, an admissible intervention shall be treated as an opposition. In the course of the revision of the EPC, Art. 105 EPC was redrafted to clarify its meaning. The word 'court' has been deleted entirely, since an action for declaration of non-infringement need not be instituted before a court in all states. The

details relating to intervention have been transferred to the Implementing Regulations (see R. 89 EPC).

In **T 446/95**, in which an infringement action had been based on a French national patent, the board held that the intention and purpose of an intervention in accordance with Art. 105 EPC 1973 was to enable the assumed infringer to defend himself against the action by the patentee based on the opposed **European patent**, in order to prevent the EPO and the national courts handing down contradictory decisions on the validity of European patents. In the case in question, the fact that the European patent had claimed priority from the French patent and that France had been designated was irrelevant, as there was no legal basis for intervening in the European patent on the basis of an infringement action relating to the French patent. The admissibility of an intervention before the EPO could not depend on a provision of national law. The intervention was therefore inadmissible.

3.2. Intervention of an alleged infringer in opposition proceedings

In **G 4/91** (OJ 1993, 339) the Enlarged Board held that the intervention under Art. 105 EPC 1973 of an assumed infringer in the opposition proceedings presupposed that opposition proceedings were pending at the time he gave notice of intervention. Moreover, a decision of the opposition division on the relief sought had to be regarded as conclusive in the sense that the opposition division no longer had the power thereafter to amend its decision. The Enlarged Board further held that proceedings before an opposition division were terminated when such a conclusive decision was issued, irrespective of when this decision became final. Thus, if, after an opposition division had issued a decision terminating the proceedings, and none of the parties to the opposition proceedings filed an appeal, any notice of intervention filed during the two-month period for appeal under Art. 108 EPC 1973 was invalidated. See also **T 791/06**, where an intervention was filed after the oral proceedings before the opposition division when the decision was pronounced but before notification of the written decision. The board held that it had not been filed during pending opposition proceedings but considered the intervention to have been filed during the appeal proceedings.

In **G 3/04** (OJ 2006, 118), the Enlarged Board concluded, *inter alia*, that the valid intervener only acquired the status of an opponent, irrespective of whether the intervention occurred during the proceedings before the opposition division or at the appeal stage. In either case his rights and obligations were the same as those of other opponents. For opposition proceedings in particular, this meant that an intervener in proceedings before the opposition division, where all the opponents had withdrawn their oppositions, could continue the proceedings alone and, if need be, file an appeal, since he had the same status as an opponent under Art. 99 EPC 1973 (see also 3.3 below).

In **T 631/94** (OJ 1996, 67) the board noted that when a decision to terminate opposition proceedings, taken in written proceedings, was handed over to the EPO postal service, it became public and effective and had therefore been issued. If the parties to the proceedings leading to that decision did not appeal, the opposition proceedings were

completed at that point in time and thereafter intervention based on Art. 105 EPC 1973 was no longer possible.

3.3. Admissibility of intervention in appeal proceedings

In **G 1/94** (OJ 1994, 787) the Enlarged Board concluded that Art. 105 EPC 1973 should apply to appeal proceedings. The term "opposition proceedings" was not restricted to the department of first instance, but could also refer to such proceedings at second instance. Intervention during appeal proceedings was therefore admissible. A notice of intervention filed during the two-month period for appeal has no legal effect if no appeal is filed (**G 4/91**, OJ 1993, 707; see also 3.2 above).

3.3.1 Intervener's rights in appeal proceedings

a) Fees payable

Where a party intervenes only at the appeal stage, several decisions have stated that no appeal fee need be paid if the party is not seeking appellant status in his own right (see **T 27/92**, **T 684/92**, **T 467/93**, **T 471/93**, **T 590/94**, **T 144/95**, **T 886/96** and **T 989/96**). In **T 1011/92** and **T 517/97** (OJ 2000, 515) the board ruled that an intervener must pay the fee if he wants to have his own right to appeal proceedings, in the sense that he can continue them if the original appellant withdraws his appeal. However, in **T 144/95**, where an intervention was filed during appeal proceedings and an appeal fee paid, the board ordered the appeal fee to be refunded (at the request of the intervener) - under Art. 107 EPC 1973, an admissible appeal could only be filed by a party who was already a party to the proceedings leading to the decision and who was adversely affected by it. Where the intervention was filed during appeal proceedings, the intervener could not satisfy these conditions, and, (referring to **G 1/94**, OJ 1994, 787), could not be considered as an appellant. Whilst Art. 105 EPC 1973 provided an exception to the time limit for payment of the opposition fee under Art. 99 EPC 1973, no such exception was made concerning the appeal fee.

b) Withdrawal of appeal

The Enlarged Board ruled, in **G 3/04** (OJ 2006, 118), that the proceedings cannot be continued, after the only appeal has been withdrawn, with a party who has intervened during the appeal proceedings (see also **T 694/01**, OJ 2003, 250).

c) Opposition grounds raised

In the course of the revision of the EPC, only minor linguistic changes were made to Art. 100 EPC, concerning the grounds for opposition, in order to align the three official languages.

In **G 1/94** (see 3.3 above), the Enlarged Board also examined the question of whether an intervener during appeal proceedings could raise any of the grounds for opposition under Art. 100 EPC 1973 even if they had not yet been examined by the opposition division,

and found in the affirmative. If a fresh ground for opposition was raised, the case should be remitted to the department of first instance unless the patent proprietor wished the board to rule on it there and then. In **T 694/01** (OJ 2003, 250), it was made clear that where a board has decided to maintain a patent on the basis of a given set of claims and a description to be added to them, in subsequent appeal proceedings confined to the issue of the adaptation of the description the previous decision is *res judicata* and the intervener cannot therefore challenge this decision by introducing a new ground of opposition.

3.4. Time limit

3.4.1 Time limit for intervention

In the course of the revision of the EPC, the time limit for intervention was transferred from Art. 105 EPC 1973 to R. 89(1) EPC, which states that notice of intervention shall be filed within three months of the date on which proceedings referred to in Art. 105 EPC are instituted. The word 'court' has been deleted entirely, since an action for declaration of non-infringement does not have to be instituted before a court in all states.

In **T 452/05**, the board considered three dates which could possibly have triggered the three month period: the date on which the request for an interim injunction was made, the date on which the request was granted, or the date when the injunction order was served upon the opponent. In the board's view, only the last date should be regarded as the decisive point in time, as only from that date onwards could the opponent provide evidence of the proceedings that entitled it to intervene. The applicable starting point for calculating the three-month period for intervention was always the date of the institution of the **first** court action, when the sole available period for intervention started to run. The two alternative starting points under Art. 105(1) EPC 1973 for calculating the three-month period for intervention were mutually exclusive (**T 296/93**, OJ 1995, 627). See also **T 144/95**. Art. 105 EPC 1973 could not be used to give an opponent who failed to file an appeal in time a second chance, as the opponent does not fulfil the requirement of being a third party (**T 1038/00**).

3.4.2 Other time limits

In **T 392/97** the would-be interveners requested that the date for the appointed oral proceedings be postponed and submitted that they had not been duly summoned to the oral proceedings in accordance with R. 71(1), second sentence, EPC 1973 which stipulated at least two months' notice. In the board's view, R. 71(1) EPC 1973 did not stipulate that the requirement of a two-month period also applied if, subsequent to a duly effected summons, there was an intervention by a third party. As a general principle, an intervener entered the proceedings at the stage they were at on the date of intervention, including **pending time limits**. Issuing a further summons or adjourning the date would in this case clearly conflict with the previous agreement between the opponent and the patentee as to the fixing of the oral proceedings and with the legitimate interest of the parties in bringing the proceedings before the EPO to a conclusion. The request for postponement of the appointed oral proceedings was therefore rejected.

3.5. Assessment of procedural act

The principle that the assessment of the nature of a procedural act taken by a party before the EPO is to be made with consideration of its actual substance rather than with consideration of its form or name applies equally when deciding whether national infringement proceedings have been commenced (**T 188/97**).

In **T 195/93** the board held that if a patentee simply sent a legal warning letter asking the intervener to stop production and sale of a product covered by the patent, this could not be regarded as institution of proceedings for a court ruling even if under national law the addressee became liable for damages 30 days after receiving the letter. The intervention was therefore rejected as inadmissible. Similarly, according to **T 392/97**, Art. 105 EPC 1973 required that an intervener should prove both that the patentee had requested that he cease alleged infringement of the patent **and** that he had instituted proceedings for a court ruling that he was not infringing the patent. Thus where the letter was sent not to the allegedly infringing company, but to an unrelated one which it was assumed was about to acquire it, the first requirement was not fulfilled and their interventions were inadmissible. The first requirement was also not fulfilled in **T 446/95**, where the letter merely set out a position adopted in response to a letter from the purported intervener, and did not give notice to cease infringement. According to **T 887/04** of 14.11.06, it was for the assumed infringer to prove, first, that he had received a "request" to cease the infringement, i.e. that he had been expressly asked to do so, and, second, that he had been required to "cease", i.e. put an end to, the infringement. Proof of mere warnings or threats of legal action had therefore to be considered insufficient.

4. Article 115 EPC

Under Art. 115 EPC, any person may present observations concerning the patentability of the invention in respect of which the application has been filed, following the publication of the European patent application. The requirement under the previous Art. 115(2) EPC 1973, that the observations be communicated to the applicant for or proprietor of the patent, was transferred in the course of the revision of the EPC to R. 114(2) of the Implementing Regulations. R. 114(1) EPC provides in addition that any observations by a third party shall be filed in writing in an official language of the EPO and state the grounds on which they are based. It also explicitly provides that R. 3(3) EPC applies. This provides that documentary evidence, and, in particular, publications, may be filed in any language. The EPO may, however, require that a translation in one of its official languages be filed, within a period to be specified. If a translation is not filed in due time, the EPO may disregard the document in question.

4.1. General principles

In proceedings before the boards of appeal, the board generally does not intervene of its own motion, but only at the request of the appellants; the principle of free disposition applies. However, this principle is also subject to restrictions, including those provisions drafted with the public interest in mind. These include Art. 115 EPC, governing observations by third parties (see e.g. **T 60/91**, OJ 1993, 551). The board in **T 156/84**

(OJ 1988, 372) found that the real reason for the provision in Art. 115 EPC 1973 enabling third parties to present observations was that account had to be taken not only of the interests of the parties involved; the EPO also had a duty vis-à-vis the public not to grant or maintain patents which it was convinced were not legally valid. (This was also behind the introduction of the principle of examination by the Office of its own motion in Art. 114(1) EPC 1973).

4.2. Who can make observations

Art. 115 EPC 1973 provided that "any person" may present observations, whilst the German version referred to "jeder Dritte" and the French to "tout tiers". The revised EPC has aligned the English version with the German and French, so that it now refers to "any third party". See **T 338/89** of 10.12.1990 and **T 811/90**. In the latter case, the patentee had filed an appeal against a decision of the opposition division concerning the removal of certain documents from the public part of the file. The opponent was not a party to the impugned decision and was consequently not entitled to be a party to the proceedings before the board. His request was therefore inadmissible but was admitted as an observation by a "third party" under Art. 115 EPC 1973.

Similarly, where an intervention is concerned, in **T 446/95** the intervention of a company was inadmissible, so its auxiliary requests were also inadmissible. However, there was nothing to prevent the company's observations and the documents it had filed from being dealt with under Art. 115 EPC 1973.

4.3. Time limit for observations under Article 115 EPC

4.3.1 General

There is no provision either in Art. 115 EPC or elsewhere in the EPC imposing any limit on the period within which observations under Art. 115 EPC have to be presented or empowering the EPO to disregard facts which come to its notice in this way whenever they are presented (see **T 156/84** (OJ 1988, 372); and also **T 283/02**, which follows **T 156/84**).

Similarly, the board in **T 390/90** stated that Art. 115 EPC 1973 set no upper time limit to the presentation by persons wishing to make adverse observations concerning the patentability of inventions which were the subject of patent applications/patents. Art. 115 EPC 1973 thus provided a sufficient outlet for non-parties to attack patents challenged by others in what in effect were centralised revocation ("opposition") proceedings (confirmed in **G 9/91**, OJ 1993, 408), as well as in the course of appeals from decisions in such proceedings. Observations could be made during the appeal procedure, although intervention was no longer possible.

The board in **T 156/84** (OJ 1988, 372) also concluded that the provisions of Art. 115 EPC 1973 applied not only to the period before grant but also to the post-grant period, this being apparent from the reference in paragraph 2 of the article (now in R. 114 EPC) to communication of the observations to the applicant for or proprietor of the patent.

A document submitted under Art. 115 EPC 1973 during opposition proceedings, but after the time limit for filing the notice of opposition had expired, was discussed in the appeal proceedings, but not taken into account as it was found not proven to be publicly available at the relevant time and thus did not form part of the state of the art (**T 314/99**).

4.3.2 Observations by third parties and Article 114(2) EPC

In the course of the revision of the EPC, minor editorial amendments were made only to the German version of Art. 114 EPC.

The board in **T 156/84** (OJ 1988, 372) invoked Art. 115 EPC 1973 as an aid to the interpretation of Art. 114(2) EPC 1973, reasoning that Art. 114(2) EPC 1973 evidently did not apply to facts presented in observations by third parties concerning the patentability of the invention pursuant to Art. 115(1) EPC 1973 since it was clear from the sentence "That person shall not be a party to the proceedings before the European Patent Office" that such a person is not one of the parties referred to in Art. 114(2) EPC. This served to reinforce the view that Art. 114(2) EPC could not apply to such facts since "due time" could have no meaning in respect of facts which did not have to be presented within a limited period. The board further found that it would be ridiculous if the opponent had to file documents found late through a third party in accordance with Art. 115 EPC 1973, if he wished to ensure that they would not be disregarded under Art. 114(2) EPC 1973. To avoid this anomaly the board concluded that late-filed relevant material could not be excluded at all, even if filed by the parties.

The board in **T 951/91** (OJ 1995, 202) also considered the application of Art. 114(2) EPC 1973 but qualified this reasoning from **T 156/84**. It pointed out that it is no less arguable that Article 31 of the Vienna Convention on the Law of Treaties should be applied, as it had been on numerous occasions by the Enlarged Board and boards of appeal, to the interpretation of Art. 115 EPC 1973. By interpreting the wording of Art. 115 EPC 1973 in the light of their object and purpose, it was clear that they were intended exclusively to cut down, and not to extend, the rights of third parties, still less to extend their rights beyond the rights of parties to proceedings before the EPO.

4.4. Extent of scrutiny

4.4.1 Article 114 (1) and Article 115 EPC

An opposition division may, in application of Art. 114(1) EPC, of its own motion raise a ground for opposition not covered by the statement pursuant to R. 76(2)(c) EPC but referred to by a third party under Art. 115 EPC after the expiry of the time limit laid down in Art. 99(1) EPC (see e.g. **G 9/91** (OJ 1993, 408)). The Enlarged Board emphasised that the consideration of grounds not properly covered by the statement pursuant to R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) should only take place before the opposition division in cases where, *prima facie*, there were clear reasons to believe that such grounds were relevant and would in whole or in part prejudice the maintenance of the patent.

As far as observations filed by a third party during appeal proceedings are concerned, the board in **T 667/92** of 27.11.1996 also referred to decision **G 9/91** (OJ 1993, 408) and opinion **G 10/91** (OJ 1993, 420). Here it was concluded that in an inter partes appeal procedure, in consideration of its purpose and with reference to decisions **G 7/91** and **G 8/91** (OJ 1993, 356 and 346, respectively), the provisions of Art. 114(1) EPC 1973 had to be interpreted in a more restrictive manner than in an opposition procedure and that, accordingly, fresh grounds for opposition raised by an opponent or referred to by a third party under Art. 115 EPC 1973 after expiry of the time limit laid down in Art. 99(1) EPC 1973 might in principle not be introduced at the appeal stage, unless the patentee agreed. Consent being withheld, the board disregarded the observations made by the third party under Art. 115 EPC 1973.

The board in **T 580/89** (as the referring board) was bound by these conclusions of the Enlarged Board in **G 9/91** and found it had no power to examine the patentability of the subject-matter of claims which were not opposed in the notice of opposition but were the subject of observations by the third party under Art. 115 EPC 1973 that did not reach the EPO until after the decision of the opposition division had been taken.

In **T 690/98** the question arose of whether observations filed by a third party could give rise to a reassessment by the Office of its own motion, under Art. 114(1) EPC 1973, of the patentability of the subject-matter of the contested patent, even if the appeal proved to be inadmissible. In the board's view, the answer was no, since the admissibility of an appeal, according to Art. 110(1) EPC 1973, was a prerequisite for examination of the appeal. The substance of the contested decision could only be examined when admissibility was established. Therefore, objections by third parties lodged at the appeal stage were not to be examined by the Office of its own motion.

Furthermore, the provision of Art. 115(1) EPC 1973, third sentence (Art. 115(1) EPC, second sentence), that a third party shall not be "a party to proceedings before the European Patent Office" assumed that proceedings were pending before the EPO.

Finally, an examination of the facts by the Office of its own motion under Art. 114(1) EPC is only possible where proceedings are pending before the EPO. Art. 114(1) EPC provides, specifically, that "in proceedings before it", the EPO shall examine the facts of its own motion. If no appeal procedure is pending, the submissions of a third party are also excluded from consideration by the Office of its own motion. See also **T 328/87** (OJ 1992, 701), where the board held that when an opposition was inadmissible, it was not possible for the EPO to examine the facts of its own motion under Art. 114(1) EPC 1973.

4.5. The nature of the observations

Art. 115 EPC stipulates that the observations by the third party must concern the patentability of the invention to which the application or patent relates. In **T 951/93** observations concerning the novelty of the patent were admitted. The board noted that a third party filing observations under Art. 115(2) EPC 1973 could not be a party to the proceedings before the EPO (now Art. 115(1) EPC) and was therefore not heard by the

deciding instances. The observations were to be examined as submitted and assessed with regard to credibility. See also **T 598/97** and **T 51/87**, where observations by third parties were admitted. In the latter case, the board expressed surprise that the examining division was fully satisfied with the information provided by the description as filed, although its attention had quite clearly been directed to the relevance of a particular document by a series of critical observations filed under Art. 115 EPC 1973. In **T 918/94** the only experimental evidence in connection with certain reactions in the claims came from third parties according to Art. 115 EPC 1973 and was negative in nature. It was taken into consideration by the board.

4.6. The form the observations should take

In **T 189/92** the board held that it was the responsibility of the third party to ensure that the facts and evidence filed were not only unequivocally clear but also as complete as possible, so that they could be handled directly by the investigating instance without doubt and without further inquiry. In particular, if a third party filed documents in a non-EPO language, a translation in one of the official languages of the EPO should be enclosed. Under the revised EPC, the observations must be filed in an official language (R. 114 EPC). Documents or publications may be submitted in any language, but a translation into an official language can be required and the document disregarded if the translation is not submitted in due time (R. 3 (3) EPC).

In the proceedings before the opposition division, a third party filed observations under Art. 115 EPC 1973 citing public prior use as an obstacle to patenting. The public prior use had allegedly taken place when access to installations was given to another company without any obligation to maintain secrecy. The opposition division did not take these observations into account, as the alleged facts had not been proven with near certainty (**T 301/95** of 28.3.2000). See also **T 73/86**.

In **T 41/00**, a document submitted during the appeal proceedings by a third party under Art. 115 EPC 1973 appeared to come closer to the claimed subject-matter than any of the prior art citations considered during the examination procedure. However, the question of whether the document was available to the public at the priority date of the patent was still open, so the case was remitted to the department of first instance.

In **T 953/02** the respondent had challenged the submission under Art. 115 EPC 1973 because of a signature which was deficient, i.e. not that of a natural person. The submission by the third party, which was not a party to the proceedings, was filed substantially less than one month before the oral proceedings. The board did not admit it into the proceedings. This also removed any need to consider the arguments set out in the respondent's letter or the literature enclosed.

4.7. The legal position of the third party

It is explicitly stated in the EPC (both 1973 and 2000), that a third party does not become a party to the proceedings. In contrast, a bundle of procedural rights is created in respect of the opponent because, in contrast to the third party who presents observations under

Art. 115 EPC, the opponent becomes a party to the opposition proceedings (see **G 4/88**, OJ 1989, 480). The third party, not being a party to proceedings, does not enjoy the right to be heard by the EPO (**T 951/93**). Nor, where the submissions by the third party are incomplete, can further investigations be carried out, such as the hearing of witnesses. This would require co-operation with the third party, which, as it is not a party to the proceedings, is not possible. The board therefore did not consider the third-party observations in this case (**T 908/95**). As a third party within the meaning of Art. 115 EPC is not a party to any proceedings and has no more than an opportunity to "present observations", the admissibility of these observations is entirely a matter for the board (**T 390/07**).

In **T 283/02** the opposition division had referred, in the summary of facts and requests in the contested decision, to third-party observations as having been filed by the opponent. In the board's view, this mistake had not played a decisive role in the subsequent handling of the information concerned. Contrary to the appellant's assertion, the opposition division had not completely ignored the third-party observations. It had correctly forwarded the observations to the patent proprietor. Its reference to the opponent as the source of the observations was incorrect, but this had not affected the outcome of the proceedings.

In **T 951/91** the board found that Article 31 of the Vienna Convention could be applied to the interpretation of Art. 115 EPC 1973. By interpreting the articles in the light of their object and purpose, it was clear that they were intended exclusively to cut down, and not to extend, the rights of third parties, still less to extend their rights beyond the rights of parties to the EPO.

4.8. Miscellaneous provisions where Article 115 EPC is considered

4.8.1 Amendment of the European patent application

When considering the possible circumstances when it may be appropriate for an examining division to exercise its discretion under R. 86(3) EPC 1973 (now R. 137 EPC) to allow an amendment after issue of a R. 51(6) EPC 1973 communication (now R. 71 (5) EPC), it should be borne in mind that a request for amendment at that stage may arise as a result, inter alia, of consideration of observations made by a third party pursuant to Art. 115 EPC. In any of the circumstances, the discretion to allow amendment should be exercised according to the same principles (**G 7/93**, OJ 1994, 775). See chapter VI.J.7, exercise of discretion, for further details of those principles.

4.8.2 Interlocutory decisions in examination proceedings

It was held in **T 839/95** that an interlocutory decision in the case of an allowable auxiliary request, whilst foreseen in the instructions to examiners for auxiliary requests in opposition proceedings, was not appropriate in ex parte examination proceedings. One reason given in support of this was that third parties might raise objections concerning the patentability of an invention under Art. 115 EPC 1973. It seemed to the board legitimate that such objections be taken into account as long as the substantive

examination of the application was not finished. If a final decision on part of the application was taken before that stage of the proceedings, the effect of observations by third parties would be restricted. See **G 12/91** (OJ 1994, 285) for details of when a decision becomes final (chapter VI.J.4, date of decision).

4.8.3 Substantial procedural violation

In **T 283/02**, the opposition division had duly forwarded the observations by third parties to the patentee, who had made no comment. The failure of the opposition division to mention these observations in its decision did not constitute a substantial procedural violation, even though a mention would have been desirable.

4.9. Remittal following filing of observations

A board may choose to remit a case to the department of first instance as a result of observations filed under Art. 115 EPC. See, for example, **T 249/84** and **T 176/91**.

In **T 929/94**, a preliminary examination by the board of the third-party observations and the supporting material showed that an entirely new case based on new facts and evidence had been presented against the patentability of the claimed invention in these observations. In order to preserve the applicant's right to review through appeal of any adverse decision of the department of first instance, the board remitted the case for examination of and decision upon such new material, as requested by the applicant.

In **T 41/00** the case was remitted to the department of first instance because the question of whether the document filed with the third-party observations was available to the public at the priority date of the patent was still open.

5. Transfer of party status

The new version of R. 22(1) and (3) EPC (formerly R. 20(1) and (3) EPC 1973) involves no change in practice as to the nature and extent of the evidence required for registering transfers. Thus the transfer of a European patent application has effect vis-à-vis the EPO only at the date when and to the extent that the EPO is supplied with **documents** providing evidence that it has taken place. While the effects of such a transfer on the party status of the applicant/proprietor are regulated in the EPC itself, the conditions or criteria for a valid transfer of opponent status are clarified by established case law.

5.1. Party status as opponent

5.1.1 Substantive requirements

Where opposition proceedings are pending before the EPO, it may be transferred or assigned to a third party as part of the opponent's business assets, together with the assets in the interests of which the opposition was filed. In **G 4/88** (OJ 1989, 480), the Enlarged Board of Appeal, after noting that R. 60(2) EPC 1973 (now R. 84(2) EPC) implicitly acknowledged the transmission of the opposition to the opponent's heirs and

that, by analogy, the opposition could be transmitted to the opponent's universal successor in law, held that the opposition constituted an inseparable part of the enterprise's assets; therefore, in so far as those assets were transferable or assignable under the applicable national laws, the opposition which was part of them had also to be regarded as transferable or assignable in accordance with the principle that an accessory when annexed to a principal object ("accessio cedit principali") becomes part of the principal object (see also **T 349/86** and **T 475/88**).

Subject to that restriction, the principle that a transfer together with the relevant assets is allowable has been applied not only to oppositions as such but also to the right to lodge an appeal against an adverse decision of the opposition division (see **T 563/89**). In **T 659/92** (OJ 1995, 519) the board stated in this regard that a party's rights in a case may indeed be transferred at any stage of opposition appeal proceedings, but in the case in point it held that the opposition had not been transferred as an "inseparable part" of the opponent's business assets.

Later case law also refers to **G 4/88** and **T 659/92**:

In **T 799/97** the opponent went bankrupt during the first-instance opposition proceedings. The representative wanted to continue the proceedings with company D, which had acquired the bankrupt firm. The opposition division refused this request on the grounds that the purchase contract showed that not all the opponent's assets had been transferred; certain items and liabilities were not covered by the deal. Nevertheless, the board concluded that opponent status had indeed been transferred to company D. In the board's view, there was nothing in either **G 4/88** or **T 659/92** to indicate that opponent status was transferred only in the event of an unqualified transfer of all receivables and liabilities.

The case law of the Enlarged Board of Appeal on the transfer of opponent status was also considered by the board in **T 711/99** (OJ 2004, 550). It held that opponent status could be transferred to a singular successor when a commercial department was sold, but this was an exception to the general principle in law whereby an opposition was not freely transferable, as defined in **G 4/88** (OJ 1989, 480) considered together with **G 3/97** (OJ 1999, 245). This exception was to be narrowly interpreted and precluded an opponent parent company from being recognised, in the event of the sale of a subsidiary that had always been entitled itself to file oppositions, as having the right to transfer its opponent status, by contrast to an opponent who sold a commercial department that was an inseparable part of the opposition but was not itself entitled to file oppositions. Thus, opponent status could only be transferred together with the assignment of part of the commercial activity of an opponent with sole legal authority, where the transferred company division or department was not a legal person and therefore lacked legal authority. However, that did not apply in this case, in which, even though the transferred company was a wholly owned subsidiary of the parent company, it was still entitled to act on its own behalf in opposition, having full legal authority – a feature of legal personality.

In cases where the opposition is allocated to two different parts of a business, opponent status can be transferred to a third party only by transferring both parts of the business or the whole firm (**T 9/00**, OJ 2002, 275).

Unlike transfers between both legal and/or natural persons, where the opposition is transferable together with business assets, an opposition could pass from a deceased opponent to his or her **heirs** without any requirement that it be accompanied by any particular assets of the deceased (**T 74/00**). A deceased opponent's heir or heirs could only be ascertained by reference to the particular national laws of succession applicable to the estate of the deceased opponent, meaning that the person or persons seeking to establish that they had the right to succeed to an opposition had to produce satisfactory evidence. If more than one heir of the deceased opponent was established, the relevant national law could be decisive. In any case, as with other multiple opponents, all persons identifiable as heirs inheriting the opposition had at all times to be ascertainable and act through a common representative, and the EPO had to be informed if any of them ceased for any reason to be a member of the multiple opponent.

5.1.2 Formal requirements

The EPC does not contain any explicit provisions regarding the formal requirements for the transfer of opponent status. Nevertheless, the boards of appeal have consistently held that formal requirements have to be fulfilled for the opponent status to be considered as transferred. This finding has mostly been based on an application, by analogy, of the general procedural principle laid down in R. 22 (3) EPC (former R. 20 (3) EPC 1973). Some boards however expressed doubts concerning this analogy (e.g. **T 261/03**; see also referral **T 1091/02**, OJ 2005,14).

As **G 4/88** (OJ 1989, 480) did not mention any further procedural requirements for the valid transfer of the opponent's procedural status, it was left to subsequent case law to establish that a new opponent acquired party status as opponent and as party to the appeal proceedings only on production of documents providing evidence of legal succession (e.g. **T 870/92**, **T 19/97**, **T 478/99**). There is no need for the opposing party's agreement. Until evidence of the transfer has been provided, the original party to the proceedings continues to have the relevant rights and obligations (**T 413/02**). If no evidence of legal succession is produced, the mere declaration by a company designated as legal successor to the original opponent that it is the original opponent's legal successor is not sufficient to substantiate the transfer of the status of opponent and of party to the appeal proceedings (**T 670/95**).

Nor is opponent status bound up with the existence of a commercial interest in the revocation of a patent (**T 298/97**, OJ 2002, 83). The possession of a commercial interest in the revocation of a patent is not sufficient to allow a successor in business to take over and conduct opposition appeal proceedings in the absence of evidence of a transfer of the right to do so together with the related business assets of the opponent. In the absence of such evidence, the transfer of an opponent's business assets to two separate persons cannot give either of them the right to take over and conduct opposition or

opposition appeal proceedings. When such evidence is present, only the transferee established by such evidence can acquire such a right.

The board in **T 19/97** held that there was a clear distinction between the substantive transfer of opponent status as a business asset and its procedural validity in the case at issue. As a formal requirement, the procedural validity of a transfer of opponent status was dependent on the submission of a duly substantiated request within the proceedings. On grounds of procedural certainty, a change of party based on an assignment could not take place outside the proceedings without the formal cognisance of the board and also could not have retroactive effect, as otherwise procedural acts or decisions could be respectively performed or taken without the involvement of the new opponent as the only legitimate party.

Even if transfer is possible before the new owner initiates appeal proceedings, the EPO must be supplied with evidence of the transfer before the appeal is lodged, or else the appeal will be inadmissible (**T 1137/97**). In case **T 261/03** the EPO was first informed of the transfer of business by a letter submitted by a third party to which the appellant referred later in the notice of appeal. Under the circumstances of the case before it, the board treated the information submitted by the third party as if it had been submitted by the appellant and as from the date on which the notice of appeal explicitly referred to it. Although the same board entertained doubts with regard to an analogous application of R. 20(1) EPC 1973 (now R. 22(1) EPC) concerning the recording of a transfer of a European patent application in the Register of European patents, it interpreted the intention of the appellant to acquire opponent status and to have the relevant evidence submitted to the EPO as an implicit request for the recording of transfer. Such a request was deemed as filed automatically without the payment of an administrative fee (R. 20(2) EPC 1973 - now R. 22(2) EPC - not applicable by analogy; see also **T 413/02**).

In **T 956/03** the board considered the question of the **time limit** for filing such evidence. According to the board, the case law showed a definite balance in favour of the view that a transfer could only be acknowledged from, at the earliest, the date when adequate evidence to prove the transfer had been filed. This was desirable in the interest of legal certainty and, within that principle, to ensure that the identity of an opposing party was known. If the transfer took place before the appeal period expired, then the entitlement of the transferee to replace the opponent had to be established by filing the necessary evidence before the appeal period expired. In **T 428/08** the appellant had argued that it ought to be admissible to submit evidence of legal succession after the appeal period had expired, as evidence of prior use could also be submitted after the opposition period had expired without being rejected as grounds for opposition. The board initially distinguished between the conditions for an admissible opposition, which were regulated in the EPC, and the validity of a transfer of opponent status, which was governed by criteria established in consistent case law rulings. Different circumstances meant different legal consequences. In the case in point the board relied on case law which made the date when the transfer became valid explicitly dependent on the date when evidence of it was supplied, in keeping with the procedural certainty requirement for the identities of the parties to the proceedings to be clear at all times. Hence the appellant had wrongly maintained that **T 670/95** had failed to answer the question whether

evidence could still be submitted after the appeal period had expired, as in point 2 of the grounds of that decision it was expressly stated that the proceedings were to be conducted with the original party until evidence of the transfer had been supplied. In the board's view this formulation ruled out any retroactive change of party status after the evidence had been submitted.

With regard to the requirements for the **filing of evidence**, the board in **T 6/05** drew a line between those cases where the opponent status is transferred together with the assignment of business assets and the cases of universal succession via merger - like the case at issue. Whereas in the former cases, the party status might either remain with the original opponent or be transferred to the new one, the universal successor of a patent proprietor automatically acquired party status in proceedings pending before the EPO, since R. 20(3) EPC 1973 did not apply in the context of universal succession in law. The successor acquired party status from the date on which the merger became effective and not only once sufficient evidence to this effect had been produced. The principles for transferring a European patent were to be applied *mutatis mutandis* to the transfer of opponent status. In the case of universal succession of the opponent, there could only be one (legal) person who had rights and obligations, with the consequence that there was necessarily and automatically a continuation of the existing legal status as opponent from the date of merger. It could thus be established unambiguously and without any legal uncertainty, at any point in time in the proceedings who in fact was the opponent having party status, regardless of the date when sufficient evidence to this effect was filed.

5.1.3 The Enlarged Board's decision in G 2/04

In view of the divergent solutions adopted up to that point by the boards of appeal with regard to both substantive and formal requirements for the transfer of opponent status, in **T 1091/02** (OJ 2005, 14) the board saw the need to refer the following questions to the Enlarged Board of Appeal:

1. (a) Can opponent status be freely transferred?

1. (b) If question 1(a) is answered in the negative, can a legal person who was a 100%-owned subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates acquire opponent status if all its shares are assigned by the opponent to another company and if the persons involved in the transaction agree to the transfer of the opposition?

2. If question 1(a) or (b) is answered in the affirmative:

(a) Which formal requirements have to be fulfilled before the transfer of opponent status can be accepted? In particular, is it necessary to submit full documentary evidence proving the alleged facts?

(b) Is an appeal filed by an alleged new opponent inadmissible if the above formal requirements are not complied with before expiry of the time limit for filing the notice of appeal?

3. If question 1(a) and (b) is answered in the negative:

Is an appeal admissible if, although filed on behalf of a person not entitled to appeal, the notice of appeal contains an auxiliary request that the appeal be considered filed on behalf of a person entitled to appeal?

The questions referred to the Enlarged Board of Appeal were answered in **G 2/04** (OJ 2005, 549) as follows:

I. (a) The status as an opponent cannot be freely transferred.

I. (b) A legal person who was a subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates cannot acquire the status as opponent if all its shares are assigned to another company.

II. If, when filing an appeal, there is a justifiable legal uncertainty as to how the law is to be interpreted in respect of the question of who the correct party to the proceedings is, it is legitimate that the appeal is filed in the name of the person whom the person acting considers, according to his interpretation, to be the correct party, and at the same time, as an auxiliary request, in the name of a different person who might, according to another possible interpretation, also be considered the correct party to the proceedings.

5.1.4 Individual cases dealing with the legal validity of transfers

In **T 425/05**, at the date of filing the appeal, the original opponent no longer legally existed. The status of opponent had been transferred by universal succession to company F. The original opponent had therefore been succeeded by F as the opponent contesting the patent and in respect of the authorisation to act on the opponent's behalf and represent him as a client. The appeal filed by the professional representative, whose authorisation, confirmed in the meantime, had never been rescinded, was therefore implicitly, but necessarily, filed on behalf of the new opponent. Absurd consequences would ensue, moreover, if the professional representative's authorisation to act were taken to have lapsed at the date when the original opponent legally ceased to exist: the notification of the impugned decision would then also be considered null and void since that date, and the time limit for appeal would only start to run when a new notification, which would now become necessary, had occurred. The board concluded that no discontinuity had arisen in prosecuting the opposition, which had therefore not lapsed, and that the appeal was admissible.

In **T 384/08** the board starts from the premises that an opponent status may be transferred or assigned to a third party as part of the opponent's business assets, together with the assets in the interests of which the opposition was filed (see **G 4/88**, OJ 1989, 480). In this context, the term "business" has to be understood in a broad sense as

describing an economic activity which is or could be carried on by the opponent and which constitutes a specific part of his business assets. In the present case, the term "business" also encompasses the opponent's core activity of scientific research and development activities (R&D) in the field of micro-arrays. Such a business exists and is transferable even if the firm has closed its day-to-day operations and is going to be dissolved in view of financial difficulties. While in such circumstances one may possibly speak of a business "in a frozen state" or a "residual" business, a firm has still a business as long as there are business assets which allow the carrying out of its core activities connected with them. The fact that many tangible assets (excluding patent portfolio and laboratory equipment necessary for the business activities) were sold off in an auction in order for the company to become a more attractive takeover or merger candidate, did not result in a transfer of business.

Moreover, the board had to ascertain whether an asset purchase agreement signed between the original opponent as seller and the buying firm established a valid business (and opponent status) transfer. The board concluded that that was the case. The mere fact that certain assets (here: contractual employment arrangements, cash, marketable securities, accounts receivable) had been explicitly excluded from the agreement was as such not sufficient for concluding that the contract did not result in the transfer of business; the excluded assets were of no importance for continuing the micro-array business and what remained of the original opponent afterwards was an empty shell.

In the following cases a transfer of opponent status was found to be legally invalid:

In **T 1178/04**, B had filed a declaration to establish that the opposition had been transferred from the registered opponent D to B. At the opposition stage the patent proprietor made no submissions other than expressing "slight doubts". The opposition division held the transfer to be valid. In response to the appeal filed by B, the proprietor questioned the opposition division's decision on the transfer of the opposition status and asked the board to consider whether the transfer "was legitimate". The board explained that the duty of the EPO to examine, ex officio, the status of the opponent at all stages of the proceedings extended not only to the admissibility of the original opposition but also to the validity of any purported transfer of the status of opponent to a new party. The doctrine of no reformatio in peius was of no application in relation to the exercise of such duty. Considering the validity of the transfer of opponent status, the board cited **G 2/04** (OJ 2005, 549), according to which opponent status could not be transferred by a parent company when it sold its wholly owned subsidiary, even where the opposition was filed by the parent in the interests of the subsidiary. This conclusion applied a fortiori in the case at issue where the transaction had nothing to do with the sale of any assets by the parent/opponent but rather with the sale of part of an indirect subsidiary's business. Hence the transfer was found to be legally invalid.

In **T 503/03** the appellants maintained that the transfer of opponent status from appellant II to appellant III was clear from the fact that the opposition related to business operations performed by a former wholly-owned subsidiary of appellant II which had been sold to appellant III. Citing the relevant Enlarged Board case law (**G 4/88**, OJ 1989, 480; **G 2/04**, OJ 2005, 549), the board concluded that it was not possible for the parent

company's opponent status to be transferred when the subsidiary was sold, irrespective of whether the transfer was to be made to the subsidiary or – as in the case in point – to the new parent company. Hence in the case in point it was not possible for appellant III to acquire party status in the opposition proceedings by purchasing the subsidiary of appellant II.

In **T 426/06** the board did not allow the requested transfer of opponent status because the general agreement between opponent and appellant that had been submitted did not meet the requirements for evidence of a valid transfer of party status. In the circumstances the board did not comment on the disputed issue of whether the agreement as such, submitted without any further documents such as a contract of sale, could constitute suitable evidence of the transfer of part of the business assets.

The board in **T 428/08** found that if the notice of appeal did not indicate how the transfer to the appellant was supposed to have taken place, it was not the board's duty to examine the relevant trade registers to ascertain the missing information. Besides, the trade registers did not show what rights had been transferred in the case in point, as they merely referred to a particular business division. The transfer of a division from one legal entity to another was significantly different from universal succession, where one entity was in legal terms fully merged with another and the record of the merger in the trade register implied that all rights had been transferred to the other entity at the time when the record was added to the register, and that the entity ceding them had legally ceased to exist at that time. Where a division was transferred from one entity to another, both continued to exist as legally independent entities even after the transfer had been recorded in the register. Only the intention of the parties as laid down in the contract of transfer determined which rights or assets were assigned to the division in question (see also **T 561/01**). Thus in the case in point opponent status was deemed not to have been transferred.

5.2. Party status as proprietor

Where the European patent is transferred during opposition proceedings the new patent proprietor entered in the Register of Patents takes the place of the previous patent proprietor both in the opposition and in the appeal proceedings. His entitlement may not be questioned in these proceedings (**T 553/90**, OJ 1993, 666).

For a transferee of a patent to be entitled to appeal, the necessary documents establishing the transfer, the transfer application and the transfer fee pursuant to R. 20 EPC 1973 (now R. 22 EPC) must be filed **before** expiry of the period for appeal under Art. 108 EPC 1973 (unchanged). Later recordal of the transfer does not retroactively validate the appeal (**T 656/98**, OJ 2003, 385). The board confirmed in **T 593/04** that, in appeal proceedings, substitution of another party for the patent proprietor is possible only once the relevant department of first instance has made the entry or where there is clear cut evidence of a transfer (see also **J 26/95**, OJ 1999, 668). The original party, as long as the transfer has not been proven, remains a party to the proceedings, with all its rights and obligations (see **T 870/92**). Moreover, a name change does not result in a change of legal identity (see **T 19/97**).

In **T 15/01** (OJ 2006, 153) the board distinguished between the situation where a party acquired a patent through a transfer, as in **T 656/98** and through a merger, as in the case before the board. It held that R. 20(3) EPC 1973 (now R. 22(3) EPC) did not apply in the latter case, where the change of proprietor status was caused by universal succession of law. The universal successor of a patent applicant or patentee automatically acquired party status in proceedings pending before the EPO.

6. Limitation, revocation, surrender or lapse of the patent

6.1. Limitation/revocation

6.1.1 Limitation/Revocation - Article 105a-c EPC

With the entry into force of the EPC 2000, Art. 105a EPC has been introduced, pursuant to which a European patent may be revoked or limited at the request of the proprietor. Limitation can be achieved by an amendment of the claims. The effect of a successful limitation or revocation is that the patent is limited or revoked ab initio (Art. 68 EPC) and in respect of all the Contracting States in which it has been granted. It takes effect on the date on which the mention of the decision to limit or revoke is published in the European Patent Bulletin (Art. 105b(3) EPC).

There is no time limit as to when the request for limitation/revocation can be made. However, it is a precondition that no opposition proceedings (including opposition appeal proceedings) in respect of the patent are pending (Art. 105a(2) EPC). If they are, then the request is deemed not to have been filed (R. 93(1) EPC). If limitation proceedings are pending at the time of the filing of an opposition, the limitation proceedings are terminated (R. 93(2) EPC). If a patentee wishes to revoke his patent whilst opposition proceedings are ongoing, he may do so but not by using the procedure set out in Art. 105a-c EPC (see point 6.1.2. below). If he wishes to limit his patent, he may be able to do so by amending it in the course of the opposition and opposition appeal procedure.

The decision as to whether a request for limitation or revocation under Art. 105a EPC is granted is taken by the examining division (R. 91 EPC). If the request is admissible, the examining division examines whether the amended claims constitute a limitation of the claims of the European patent as granted or amended, and whether they comply with Art. 84, 123(2) and 123(3) EPC (R. 95(2) EPC). No examination of the claims with regard to Art. 52-57 EPC is foreseen. The decision of the examining division is appealable before the technical boards of appeal.

6.1.2 Requests for revocation during opposition and opposition appeal proceedings

The procedure for limitation/revocation pursuant to Art. 105a-c EPC is not available during opposition and opposition appeal proceedings. However, a patent may still be revoked during such proceedings at the request of the patent proprietor.

If the patent proprietor states in opposition or appeal proceedings that he no longer approves the text in which the patent was granted and will not be submitting an amended

text, the patent is to be revoked. This is supported by Art. 113(2) EPC, which provides that a patent may be maintained only in a version approved by the patent proprietor. If there is no such version, one of the requirements for maintaining the patent is lacking (**T 73/84**, OJ 1985, 241, followed by numerous decisions, see also **T 157/85**).

If the patent proprietor himself requests that the patent be revoked, the decision to revoke the patent is given without substantive examination as to patentability. The examination as to whether the grounds for opposition laid down in Art. 100 EPC prejudice the maintenance of the patent becomes impossible since the absence of a valid text of the patent precludes any substantive examination of the alleged impediments to patentability (**T 186/84**, OJ 1986, 79).

In **T 237/86** (OJ 1988, 261) the board stated that a direct request for revocation sufficed, whatever the form of the words, when it was made clear to the boards that appellant and respondent agreed that the patent should be revoked. In **T 459/88** (OJ 1990, 425) the board stated that if, in proceedings before the EPO, the patent proprietor himself requested that his patent be revoked, there could scarcely be any more cogent reason for revoking it since it could not be in the public interest to maintain a patent against its proprietor's will. The patent was thus revoked by the board exercising its powers under Art. 111(1) EPC 1973 (see also the more recent decisions **T 655/01**, **T 1187/05**, **T 1526/06**).

There must be no doubt that the proprietor applying to have the patent revoked is requesting revocation with the consequences specified in Art. 68 EPC 1973 (Art. 68 EPC), namely the cancelling of the effects of the European patent application and the resulting patent as from the outset (**T 186/84**, **T 347/90**, **T 386/01**).

In **T 237/86**, the statement "We herewith abandon the above patent" was held equivalent to a request for revocation to which the board could accede under Art. 111(1) EPC 1973 (see also **T 347/90**). In **T 92/88** the words "the patent has been allowed to lapse in all designated states" were held to amount to a request for revocation. In a number of cases the boards have decided that a request by a patent proprietor to withdraw "the application" amounted to a request to revoke the patent (**T 264/84**, **T 415/87**, **T 68/90** and **T 322/91**).

In **T 347/90** the appellant (patent proprietor) gave notice during the appeal proceedings that he was withdrawing his application. Here the board interpreted his statement as a request for the revocation of the patent, and dismissed the appeal without going into the substantive issues, so that the patent's revocation by the department of first instance was confirmed. In **T 18/92** the patent proprietor (appellant) had specifically requested revocation of the patent. The board interpreted this request as a withdrawal of the appeal. Withdrawal of the appeal meant that the first-instance decision revoking the patent took effect. In **T 481/96** the board examined the two solutions and endorsed **T 18/92**.

Where the respondent (patent proprietor) states that the patent has been abandoned 'since' a particular date, this cannot be considered to be a request for revocation, as it

does not indicate that the patent has been abandoned ab initio. The case law on requests for revocation therefore does not apply and the appeal must be examined as to its merits (**T 973/92**).

6.2. Surrender, lapse and expiry of the patent

6.2.1 Surrender of patent

Under the provisions of the EPC 1973, the patent proprietor was unable to terminate the proceedings by informing the EPO of his surrender of the European patent, since this was not provided for in the EPC 1973; at this stage in the proceedings, notices of surrender had to be addressed, as far as national law permitted, to the national authorities of the designated contracting states (**T 73/84**, OJ 1985, 241; **G 1/90**, OJ 1991, 275; see **T 123/85**, OJ 1989, 336 and **T 196/91**). Under the provisions of the EPC 2000 the patent proprietor may request that the European patent be revoked pursuant to Art. 105a EPC. The existence of the new procedure does however not preclude patent proprietors from giving notices of surrender to national authorities.

6.2.2 Continuation of the opposition proceedings (Rule 84(1) EPC)

If a European patent has lapsed or been surrendered in all the designated states, the opposition proceedings may, under R. 84(1) EPC (R. 60(1) EPC 1973), be continued at the request of the opponent, provided the request is filed within two months of a communication from the EPO informing the opponent of the surrender or lapse. The rule establishes no legal obligation on the EPO to ascertain of its own motion the legal status of a European patent and does not apply in the event of an alleged surrender or lapse of a European patent, unless confirmation thereof has been received by the EPO from the appropriate authorities of all the designated contracting states (**T 194/88**, **T 809/96**, **T 201/04**).

The boards of appeal have applied R. 84(1) EPC in opposition appeal proceedings. Below are references to cases where opposition appeal proceedings have been terminated or continued pursuant to R. 84(1) EPC.

6.2.3 Cases concerning termination of opposition appeal proceedings

In **T 329/88** the board of appeal applied R. 60(1) EPC 1973 by analogy to appeal proceedings and terminated the proceedings without any decision on the issues, since during the appeal proceedings the European patent had expired in all the designated contracting states and the appellant (opponent) had not requested continuation of the appeal proceedings (see also **T 762/89**, **T 714/93**, **T 165/95**, **T 749/01**, **T 436/02**, **T 289/06**). It should be noted here that termination of proceedings had no repercussions corresponding to those of revocation under Art. 68 EPC 1973; instead, it was based on the fact that the patent had already expired without ab initio effect for each designated contracting state.

If the appellant (opponent) expressed doubts concerning a respondent's (patent proprietor's) claim that a patent had lapsed or been surrendered, then the lapse had to be registered with the EPO or properly proved. Otherwise, R. 60(1) EPC 1973 was not applicable and the appeal procedure continued (**T 194/88**, **T 682/91**, **T 833/94**).

6.2.4 Cases concerning continuation of opposition appeal proceedings

In **T 1213/97** the patent had expired for all designated contracting states during the opposition appeal proceedings. The appellant (opponent) requested a decision on the state of the file which implied a request for the continuation of the appeal proceedings for the purpose of issuing a decision. The board exercised its power under R. 60(1) EPC 1973 to continue the appeal proceedings.

In **T 598/98** too the patent had lapsed for all designated contracting states since a time subsequent to the opponent's filing of the appeal, and the appellant (opponent) had requested continuation of the proceedings. The request was allowed. The board maintained that the opponent's legitimate interest in retroactive revocation was one of the elements that could be a factor in the board's decision to terminate or continue the proceedings under R. 60 EPC 1973. It also stated that the general interest in a central ruling on the patentability of an invention claimed in a patent did at any rate justify continuing the proceedings until a final decision was taken if the case was essentially ready for decision at the time when the patent lapsed and if it also made a significant difference to the patent's fate whether a decision was taken on the merits or the proceedings were simply terminated.

In contrast to the case law cited above, **T 708/01** concerns the situation where the patent proprietor had appealed against the decision of the opposition division to revoke the patent. The patent had expired in all the designated contracting states. The board decided that R. 60(1) EPC 1973 only applied, if at all, to the extent that the appellants were required to state whether they wished to maintain the appeal. The proprietors could also apply to have the patent maintained in amended form with effect only for the past. In the case in point the appellants stated that they wished to maintain the appeal. The board decided to continue the proceedings.

7. Apportionment of costs

7.1. Principle that each party must bear its own costs

Under Art. 104(1) EPC, each party to opposition proceedings must, as a rule, meet the costs it has incurred. However, the opposition division or board of appeal may, for reasons of equity, order a different apportionment of the costs incurred during taking of evidence or in oral proceedings. At the appeal stage Art. 16(1) RPBA 2007 also applies, allowing the board, subject to Art. 104(1) EPC, to order a different apportionment where costs arise as a result of: (a) amendments pursuant to Art. 13 RPBA 2007 to a party's case as filed pursuant to Art. 12(1) RPBA 2007; (b) extension of a time limit; (c) acts or omissions prejudicing the timely and efficient conduct of oral proceedings; (d) failure to

comply with a direction of the board; or (e) abuse of procedure (see old version RPBA in OJ 2003, 89).

As part of the revision process, Art. 104(1) EPC was slightly redrafted and together with Art. 104(2) EPC was amended such that the details of a decision ordering a different apportionment of costs and the procedure for fixing them were transferred to the Implementing Regulations (see R. 88 EPC, formerly R. 63 EPC 1973). Minor amendments were made to Art. 104(3) EPC (alignment in the three official languages, editorial improvement/clarification).

In its decision of 28 June 2001 the Administrative Council established transitional provisions *inter alia* for Art. 104 EPC (see OJ SE 1/2007, 197), according to which the revised Art. 104 EPC applies to:

- European patents already granted at the time of the EPC 2000's entry into force
- European patents granted in respect of European patent applications pending at that time.

In **T 133/06** the board added that Art. 104 EPC belonged to the procedural provisions in the sense that it did not regulate any substantive issue about a patent application or a granted patent, but only issues raised during opposition or appeal proceedings, and related to them. It is a general principle of law that a new procedural law is immediately applicable but has no retrospective effect unless otherwise provided. In other words, when deciding whether the new Art. 104 EPC is applicable in appeal proceedings initiated under EPC 1973, the board must take into consideration not only the fact that, according to the transitional provisions, the new Art. 104 EPC is applicable to granted patents, but also the date of the event which gives rise to the application of this article. This is the only way to give the new procedural provision an immediate application without giving it a retrospective effect.

The phrase "taking of evidence" used in Art. 104(1) EPC 1973 referred generally to the receiving of evidence by an opposition division or a board of appeal (**T 117/86**, OJ 1989, 401; **T 101/87**, **T 416/87**, **T 323/89**, OJ 1992, 169; **T 596/89** and **T 719/93**). The boards' case law refers to Art. 117(1) EPC (unchanged in substance), according to which "taking of evidence" covers the giving or obtaining of evidence generally in proceedings before departments of the EPO, whatever the form of such evidence, and includes, in particular, the production of documents and sworn statements in writing. The EPC revision transferred the details of the procedure for taking evidence to the Implementing Regulations (R. 118-120 EPC; see chapter VI.H, law of evidence).

7.2. Equity of a different apportionment of costs – case groups

There is no definition of equity in the EPC. The boards of appeal therefore had to develop the criteria determining whether costs were to be apportioned on a case-by-case basis. In a number of decisions it has generally been stated that apportionment of costs is justified if the conduct of one party is not in keeping with the care required, that is if

costs arise from culpable actions of an irresponsible or even malicious nature (see, for example, **T 765/89**, **T 26/92** and **T 432/92**). However, according to **T 717/95** no abuse has taken place if a party to the proceedings misinterpreted the content of a citation when comparing it with the subject-matter claimed in the disputed patent.

A thorough examination of the decisions of the boards of appeal reveals that requests for a different apportionment of costs are often filed in different scenarios various scenarios in which costs are incurred for:

- late submission of documents and/or requests (see point 7.2.1 below);
- acts or omissions prejudicing the timely and efficient conduct of oral proceedings (see point 7.2.2 below);
- abuse of procedure (see 7.2.3 below).

7.2.1 Late submission of documents and/or requests

Fresh grounds for opposition submitted in appeal proceedings may be considered only with the approval of the patentee (**G 10/91**, OJ 1993, 420). In **T 1002/92** (OJ 1995, 605), however, the board focused on the issue of the late submission of facts and evidence to substantiate the original grounds for opposition cited in the proceedings before the opposition division. In interpreting Art. 114(2) EPC 1973 (unchanged), the board applied the principles laid down in **G 10/91** and held that late-filed facts, evidence and related arguments should only exceptionally be admitted into the proceedings if, prima facie, there were clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent.

Where facts and evidence supporting the opposition are submitted at a late stage in the proceedings and another party incurs considerably higher costs as a result, a different apportionment of the costs may be ordered for reasons of equity (see **T 10/82**, OJ 1983, 407; **T 117/86**, OJ 1989, 401; **T 101/87**, **T 326/87**, OJ 1992, 522; **T 416/87**, OJ 1990, 415; **T 323/89**, OJ 1992, 169; **T 596/89**, **T 622/89**, **T 503/90**, **T 611/90**, OJ 1993, 50; **T 755/90**, **T 110/91**, **T 161/91**, **T 705/92**, **T 867/92**, OJ 1995, 126; **T 719/93** and **T 970/93**). The relevant factor in deciding on the costs is whether or not there are cogent reasons justifying the late submission; it is regarded as irrelevant whether the material in question has any bearing on the decision on the merits. However, it should be pointed out that, in several cases, requests for apportionment of costs have been refused, despite an unjustified delay, because there was no proof that higher costs had been incurred (see, for example, **T 297/86**, **T 212/88**, OJ 1992, 28; **T 443/90**, **T 582/90**, **T 267/92**, **T 306/93**, **T 486/94** and **T 9/95**, **T 207/03**).

According to board of appeal case law, if a party introduces important facts or evidence at a late stage of the proceedings, without cogent reasons for the delay, this may be taken into account in the apportionment of costs (see **T 117/86**, OJ 1989, 401; **T 326/87**, OJ 1992, 522; **T 97/90**, **T 611/90**, OJ 1993, 50; **T 110/91**, **T 705/92**, **T 847/93**, **T 1016/93** and **T 574/02**). If the reasons for the late citing of a document do not point towards

negligence or other circumstances that would amount to an abuse of procedure, there is no reason of equity which would justify an apportionment of costs in the other party's favour (**T 1016/93**).

a) Late submission was unjustified

In **T 117/86** (OJ 1989, 401) the appellants had produced, together with their statement of grounds, two new documents and an affidavit in support of the contention that the opposed patent lacked an inventive step. The board concluded that the fact that new documents were presented after the nine-month period for filing opposition could itself give rise to additional expenditure for the other party, and that the costs should be apportioned differently for reasons of equity.

The board in **T 83/93** held that it was an abuse of the appeal procedure to submit five new documents as evidence 40 months after the end of the opposition period (without giving reasons) and to revive an objection under Art. 100(c) EPC 1973 (unchanged in substance) on the basis of new facts and evidence 51 months after the end of the opposition period. As a result of the appellant's unsubstantiated late filing of evidence, the respondent had incurred higher costs than if all the evidence had been submitted within the nine-month opposition period, in which case all the items (prior art documents and comparison of the original documents with valid documents) could have been dealt with in a single operation.

The fact that the appellant relied in the statement of grounds of appeal on three new documents exclusively, and for the first time even raised the **issue of novelty** on the basis of a document already discussed in the patent in suit, was regarded in **T 416/87** (OJ 1990, 415) as an abuse of the opposition procedure. By introducing arguments and documents which bore little relation to the content of those filed in the original opposition, the appellant had produced virtually a new opposition at the appeal stage. This could not, by definition, be the purpose of an appeal. The late filing of documents must have considerably increased the costs incurred by the respondent, compared to what they would have been if all facts and evidence had been filed within the nine-month period. Although the respondent clearly envisaged requesting a decision on costs in the event of oral proceedings only, the abuse of procedure justified the apportionment of costs incurred during the taking of evidence.

In **T 867/92** (OJ 1995, 126) the claims had been amended during the opposition proceedings. Eighteen months after the claims had been amended the appellant (opponent) cited in the statement of grounds of appeal a **new prior art** document. The board held that the EPC does not impose a time limit for citing new prior art in response to an amendment of the claims. However, an opponent who cites new prior art with a considerable delay with no special reason justifying the delay runs the risk of having to bear the proprietor's costs incurred in attending oral proceedings which cannot bring the case to an end because of the new citation. However, as there was no suggestion that the appellant (opponent) wilfully abused the procedure in the case at issue, the board considered that it would be equitable to order the appellant to pay only half those costs.

In **T 514/01**, the board found that the late allegation of **public prior use** during the first oral proceedings before the opposition division had given rise to additional costs because second oral proceedings before the opposition division had been needed to investigate the alleged prior public use. The award of costs was therefore equitable, which meant that the board could not grant the request made by the appellants (opponents) that the costs decision ordering them to bear the costs of the first oral proceedings be set aside.

In **T 931/97**, it was only in the appeal proceedings that the opponent had submitted new evidence, which were already **known** to the patentee from earlier proceedings before the German Patent Office. The board held that in such a case - where the patentee knew the documents and could assess their prospects - a different apportionment of costs was not justified.

In **T 416/00** the appellant (opponent) submitted a document which had been cited in the patent in suit and mentioned in the opposition proceedings but had never been discussed between the parties until the appeal proceedings, and had even been expressly excluded before the opposition division. The board found that the opponent's attempt to make surprising use of a document that it had disregarded in the oral opposition proceedings ran counter to the speedy conclusion of the proceedings before the two departments, both in the interest of the parties and in the interest of the general public and the EPO. Even if this was not a deliberate tactic on the opponent's part, the result was the same in terms of the principle of fairness governing proceedings and required in relations both among the parties and between the parties and the EPO. As the respondent's request for a different apportionment of costs was well-founded, the costs of the oral proceedings at issue were charged to the appellant.

In **T 671/03** document D18 was first filed in the appeal proceedings and deemed to constitute an **amendment to the appellant's submissions** pursuant to Art. 10b RPBA 2003 (now Art. 13 RPBA 2007). If it had been filed within the opposition period, there would have been no need to discuss its admission during the oral proceedings in the appeal. The costs for preparing and attending the oral proceedings before the board, which mainly discussed the admission of D18, could have been avoided. For reasons of equity the board ordered a suitably modified apportionment of costs.

Remittal to the department of first instance does not mean that the late filing of documents by the respondent gives rise to a disproportionate cost burden in relation to the appeal at issue (**T 1182/01**). Where a document successfully introduced at a late stage is of such relevance that the board decides to remit the case to the department of first instance in order to allow the patentee to have his case decided by two instances of jurisdiction, then in the absence of any convincing explanation for the late introduction of that document, the costs between the parties should be apportioned in such a way that the late-filing party should bear all the additional costs caused by his tardiness. Costs should only be shared between the parties if there exist strong mitigating circumstances for the late filing of facts, evidence or other matter, for example, where the document introduced was obscure and therefore difficult to get hold of (**T 326/87**, OJ 1992, 522 and **T 611/90**, OJ 1993, 50).

The board in **T 874/03** ruled that when late filing of facts and evidence necessitated remitting the case to the department of first instance, the costs of any oral proceedings in the appeal proceedings were normally to be borne by the party responsible for the late filing. The filing of document D4 for the first time during the oral proceedings, and its subsequent admission into the proceedings, would inevitably increase the costs to be incurred by the appellant (patent proprietor) in defending his patent, compared with the normal costs he would have incurred if D4 had been filed in due time. Such late submission was not justified by a change in the subject of the proceedings. Therefore it was equitable in the case at issue that the expenses (travelling and accommodation costs for the appellant's two participants) incurred by the appellant (not acting through a professional representative) in connection with the oral proceedings in the appeal should be borne by the respondent.

b) Late submission was unjustified, but not disadvantageous

In a number of cases the boards have refused a different apportionment of costs despite unjustified late submission because they were of the opinion that the belated introduction of new documents was not disadvantageous to the other party.

In **T 330/88** the respondents filed a new document two days prior to the oral proceedings. The board took the view that the late filing was unjustified but that an apportionment of costs would not be equitable as the appellants had had **sufficient time** to deal with the document, especially since the decision was not taken until four months after the oral proceedings and following the opportunity to present comments.

In **T 633/05**, the appellant referred for the first time in the statement of grounds of appeal to a document which had been cited in the European search report but not considered in the opposition proceedings. In the board's view, the appellant sought to provide new evidence in support of a line of argument already put forward in the opposition proceedings, namely the fact that certain features of the present invention were known in the art. As the said document was cited in the statement of grounds of appeal and was anyway part of the examination file, the respondent had had ample time to study the content of this fairly short document and prepare a rebuttal against the appellant's allegation that it disclosed some key features of the contested patent. Thus, the board had no reason to suspect that the appellant's late filing might have been aimed at delaying the appeal proceedings, or that it resulted in the respondent being burdened with unreasonable additional costs.

In **T 525/88**, the late filing was unjustified, but the request for apportionment of costs was rejected because the documents were of **no relevance** and did not affect the decision. The same applied in **T 534/89** (OJ 1994, 464) and **T 876/90**.

In **T 882/91**, the board did not look into whether the unjustified late submission had led to higher costs because it was of the opinion that the other party had not had to spend very **much additional time and energy** on the documents which had been submitted late and that there was therefore no reason to apportion costs (see the decisions on similar cases in **T 737/89**, **T 685/91**, **T 556/90**, **T 231/90** and **T 875/91**).

In **T 28/91** three documents which had already been submitted to the opposition division were re-submitted at a later stage in the appeal proceedings. The board ruled that the late submission was not disadvantageous as no new arguments had been introduced, and therefore no additional work had been necessary (see also **T 133/06**).

In **T 938/91** an alleged prior public use was filed for the first time, with drawings pertaining thereto, together with the statement of grounds for appeal. The patentees had requested a different apportionment of costs on the grounds that the complicated drawings required considerable extra effort. The board rejected this request, taking the view that the additional effort involved in studying the drawings would have been necessary even if they had been submitted in good time. No additional costs had therefore been incurred as a result of the late submission.

T 336/86 involved a special case. The appellants submitted a prior patent belonging to the respondents for the first time in the appeal proceedings, which destroyed the novelty of the patent in suit. The respondents requested an apportionment of costs as the oral proceedings would not have been necessary had the patent been presented earlier. The board agreed that the late submission was not justified and that higher costs had been incurred as a result. However, as the respondents either had - or should have - been aware of the **existence of their own patent**, it took the view that an apportionment of costs was not justified.

c) Late submission was justified

In principle, costs are not apportioned differently if the late submission of facts and evidence appears justified. The boards have assumed in particular that belated submission is justified or that no abuse of procedure has taken place if new documents are filed for the first time at a later stage in the proceedings as a reaction to communications from the board, comments from the other party or amendments of the patent or decisions of the department of first instance which make such documents necessary in the first place (see **T 582/88**, **T 638/89**, **T 765/89**, **T 472/90**, **T 556/90**, **T 334/91**, **T 875/91**, **T 81/92** and **T 585/95**).

In **T 712/94** the board allowed the appellant (opponent) to introduce facts and evidence on alleged prior use at the appeal stage, whilst refusing the respondent's (patentee's) request for apportionment of costs. The patentee had been made aware of the prior-use documents during negotiations conducted well before the first-instance decision was taken. Thus they had **not taken him by surprise** when later introduced into the appeal proceedings following failure of the negotiations. The board could therefore see no reasons of equity requiring a different apportionment of costs.

In **T 1167/06** the board did not consider it an abuse of procedure that two weeks before the oral proceedings the appellant filed three further auxiliary requests, additional arguments and four short documents, the latter illustrating common general knowledge on issues that had already been discussed. The need to **translate the requests and documents** and the resultant costs were in the nature of the European procedure with three official languages and affected all parties in equal measure. As the language of the

proceedings for the patent was German, the respondent had to expect many submissions to be made in that language. The respondent stated that an additional representative had had to deal with the late filing and travel to the oral proceedings because the representative assigned the case had been on leave at the time in question. In the board's view, however, the representative's absence on leave was not the fault of the other party. Moreover, the respondent (opponent) had been represented by the same two representatives before the opposition division, so the additional representative had not needed much time to familiarise himself with the latest dossier updates.

Similarly, in **T 29/96** the request for a different apportionment of costs was refused. A new document which was fairly simple and straightforward in content had been filed together with the statement of grounds of appeal. The board ruled that this was the earliest possible moment that the document could have been submitted. In any event, the introduction of the new document could not be regarded as having given rise to a new opposition; it had not introduced new closest prior art, but was merely a new secondary information source. In the case before the board, it was logical for the appellant, as the losing party in the opposition proceedings, to introduce the document into the appeal proceedings in an effort to **improve his position by filling a gap** referred to in the impugned decision.

In **T 1171/97** the board rejected a request for apportionment of costs because it was satisfied that the new documents which had become known to the appellants (opponents) in the course of another search had not been filed in order to obstruct the proceedings, but because they contained aspects which, **according to the statement of the opposition division**, had not been found in the previously available references.

In **T 554/01**, the applicant submitted a number of documents following the negative decision taken by the opposition division. The board held that the mere fact that certain documents had been submitted at a late stage did not justify a finding that there had been an abuse on the part of the applicant, especially where they had been submitted as a result of a legitimate desire **to supplement the line of argument** which had been unsuccessful before the department of first instance. Moreover, the respondents had not shown that they had incurred additional costs as a result of the documents' introduction into the proceedings.

In **T 507/03** the opposition division had regarded the claimed invention as being patentable over the documents cited by the opponent. As a reaction to the reasons given in the impugned decision, the opponent (appellant) filed a new set of documents in the appeal proceedings, after the nine-month period for filing opposition. Refusing the request for a different apportionment of costs due to the late filing, the board argued that, according to Art. 108 EPC 1973 (minor editorial changes only) and R. 65 EPC 1973 (now R. 101 EPC), a statement of grounds of appeal had to identify the extent to which amendment or cancellation of the decision was requested. This, however, did not forbid a losing opponent from filing new pieces of prior art if it was felt that they could counter the reasons given in the appealed decision. Further, the new documents were all **easily understandable** and had not caused **an unreasonable amount of extra work** such as

to justify departure from the normal rule that each party meets its own costs pursuant to Art. 104 EPC 1973.

In case **T 242/04**, the board held that the respondent's late filing was made **in response to a communication of the opposition division** for making written submissions and took place roughly one month before expiry of the final date accorded in the communication as well as roughly two months before the date for oral proceedings. The circumstances were therefore not such that there was no justification for the late filing or that it could be held that the respondent acted in bad faith. In addition, the appellant who requested an apportionment of costs and, in particular, reimbursement of the travel costs of a technical expert, neither gave any reasons let alone any evidence for the necessity of the technical expert's presence at the hearing before the opposition division, nor provided any evidence that the respective trip was caused only by the said late filing. Therefore, a different apportionment of costs was not regarded as justified.

The board in **T 333/06** found that the appellant's maintenance of his request for admission of the fresh ground for opposition - lack of inventive step - and of the new supporting documents after being notified of the board's preliminary negative opinion did not constitute abuse, as that opinion was not a final decision. Furthermore, while the appellant might have acknowledged that the new documents were not relevant to novelty, objectively he could not be censured for having maintained them in the hope that his oral presentation would result in the admission of lack of inventive step as a fresh ground for opposition and hence of the new documents relevant to inventive step. Thus while this had admittedly made the respondent's preparations for oral proceedings more difficult than they would have been if the appellant had withdrawn the new documents, the procedural conduct on the part of the appellant which had necessitated those preparations was not abusive but one of the appellant's legitimate prerogatives.

d) Late submission justified, but different apportionment ordered for reasons of equity

In **T 847/93**, the board admitted a statement of grounds of appeal documenting new prior art. Mitigating circumstances for the late filing of new facts and evidence were put forward by the appellants and were held to be credible by the board. On the other hand, the board was also of the opinion that it was credible that the costs incurred by the respondents were higher as a result of the introduction of an entirely fresh case than if the facts and evidence had not been filed at a late stage. It therefore decided to order an apportionment of costs under Art. 104(1) EPC 1973 according to which the appellant had to pay the respondents 50% of the costs incurred by the respondents - after remittal to the department of first instance - in respect of the subsequent oral proceedings and the taking of evidence as well as in any subsequent appeal. In **T 1137/97**, a belatedly submitted document was likewise admitted into the proceedings and a different apportionment of costs was ordered. In determining the costs, the board itself, exercising its discretion under Article 111(1) EPC 1973 (unchanged), awarded a fixed sum of EUR 2 500 to avoid the need for an exact investigation of the amount, which would have been more burdensome for the parties.

In **T 937/00**, the board found that all the requests presented by the appellant in writing in advance of the oral proceedings were clearly inadmissible and their filing could hardly be considered appropriate in the circumstances of the case, in which the appellant had chosen to file an exceptionally high number of independent claims in response to the notice of opposition: he had presented amended independent claims 2, 5, 29 and 69 at the appeal stage only, having filed no fewer than six different versions of the claims during the opposition procedure, and independent claims 5 and 58 had in effect countered the limitations brought to independent claims 2 and 29. At the very end of the oral proceedings, he had even filed a third auxiliary request according to which all the claims which had been contested in the appeal procedure were simply abandoned. In these circumstances, the board felt compelled to admit the belated auxiliary request, as had the board rejected the appellant's third auxiliary request, the appeal would have been dismissed and the revocation of the patent would have become final. The board also remitted the case to the department of first instance, none of the remaining claims having ever been considered by the opposition division. However, the board deemed it appropriate for reasons of equity to order an apportionment of the costs of the oral proceedings such that the appellant bore 50% of the costs incurred by the respondent in travel expenses and remuneration for his representative for the purpose of attending the oral proceedings.

7.2.2 Acts or omissions prejudicing the timely and efficient conduct of oral proceedings

a) Failure of a party to appear at oral proceedings

A party requesting oral proceedings is not obliged to be represented at them. Its duly announced absence could not be considered as improper behaviour. However, the boards consider it highly undesirable for summoned parties to announce too late or not at all that they will not be attending. Such conduct is inconsistent both with the responsible exercise of rights and with the basic rules of courtesy (see for example **T 434/95**, **T 65/05**).

There is an equitable obligation on every party summoned to oral proceedings to inform the EPO as soon as he knows that he will not be attending as summoned, regardless of whether he himself or another party requested the oral proceedings and of whether or not a communication accompanied the summons to oral proceedings. If a party who has been summoned to oral proceedings fails to attend as summoned without notifying the EPO in advance, an apportionment of costs in favour of another party, who has attended as summoned, may be justified for reasons of equity in accordance with Art. 104(1) EPC 1973 (established case law, see for example **T 930/92**, OJ 1996, 191; **T 123/05**).

i) Different apportionment of costs ordered

In **T 909/90** oral proceedings had been appointed at the appellants' request. Without giving the board or opponents any advance notice, the appellants did not attend the oral proceedings. Nor did they comment on the board's communication. For this reason in particular the oral proceedings contributed nothing new to the case. The board ordered

the apportionment of costs without examining whether higher costs had been incurred as a result of the appellants' failure to appear.

In **T 937/04** the appellant and patent proprietor informed the board by fax sent only to the EPO and not to the other parties on Friday, 17 February 2006, after business hours, at 16.27, that he would not attend the oral proceedings. Reasons justifying the filing of this information at such a late stage were not provided. The other parties were thus informed by the registrar of the board on Monday, 20 February 2006, i.e. one working day before the oral proceedings, that the appellant would not attend them. The board stated that the appellant, by informing solely the EPO and not the other parties, had failed to exercise all due care required and concluded that, for reasons of equity, an apportionment of costs should be accorded in favour of the respondent. According to the board in **T 1079/07**, however, to inform the EPO and any other party to the proceedings about the intention not to attend oral proceedings in due time is a matter of courtesy and respect rather than a procedural obligation to be met (see also **T 69/07**).

In cases where a party **delays** his decision not to attend oral proceedings or the communication of this decision to the board, an apportionment of costs in favour of the other party may be justified insofar as the costs were directly caused by the fact that the notice was not filed in appropriate time before the oral proceedings. In **T 91/99**, the board stated that, where an appellant failed to give notice that he would not be attending the oral proceedings until two working days before the date set for the proceedings, this could constitute negligent or wilful conduct which had to be considered under Art. 104(1) EPC 1973; however, in the case at issue, there was no culpable conduct on the part of the appellant which could justify an apportionment of costs under Art. 104(1) EPC 1973 (by contrast, in **T 693/95** and **T 338/90** costs were awarded because notice of the appellant's absence had been given, in the former case, only an hour before the oral proceedings and, in the latter, at the time when the oral proceedings were due to start).

The appellants' **failure** to advise the board **in time** that they would not be appearing at the oral proceedings was likewise the reason for ordering them to bear the costs in **T 434/95**. The decision referred to the Enlarged Board's opinion in **G 4/92** (OJ 1994, 149), which construed the right to be heard as meaning that a decision adversely affecting a party which was duly summoned but did not appear could not be based on facts put forward for the first time during oral proceedings. The board held that the Enlarged Board's opinion was not relevant to its decision on the request for cost apportionment, as in the case in point there was no submission that could entail the presentation of new facts. The issue in the present case was rather the procedural consequences of a party's action in choosing not to attend. The opinion applied to substantive decisions on patents in suit, but not to the present case, where the respondent had presented no new facts in the oral proceedings (see also **T 641/94** and **T 123/05**).

In **T 53/06** the appellant requested oral proceedings "in case the board considers not to set the decision aside". As soon as it received the board's summons to oral proceedings and communication, the appellant knew not only that oral proceedings would take place

but also that the condition it had itself placed on its own request for oral proceedings had been fulfilled, since the communication clearly indicated that the board's provisional opinion was that the decision under appeal would not be set aside. However, the appellant neither replied to the communication nor indicated at all, let alone as soon as it knew, that it would not attend oral proceedings. Since the respondent had, in the absence of any submissions from the appellant additional to those in the grounds of appeal, nothing to add to its own case in its reply to the grounds of appeal, the **oral proceedings proved to be unnecessary**. Accordingly, it was clear to the board that, as a result of the appellant's conduct, the oral proceedings were not only unnecessary but also an inefficient use of the time and effort of both the respondent and the board. Furthermore, the appellant could have made its position known well in advance of the date appointed for the oral proceedings, and thereby not only spared the respondent and the board unnecessary work but also allowed the date for the oral proceedings to be used for another pending appeal. In those circumstances, an apportionment of costs in favour of the respondent was held to be appropriate under Art. 16(1)(c) RPBA as well as under Art. 16(1)(e) RPBA 2007 (see also **T 212/07**).

ii) Refusal of a request for apportionment of costs

The non-appearance of a party generally does not adversely affect the party which did attend. A different apportionment of costs cannot be ordered if the parties which are affected have neither shown nor claimed that they incurred additional costs because the appellants were not present (**T 544/94**; see also **T 632/88** and **T 507/89**).

In **T 591/88** both parties had requested that oral proceedings be held - both in fact filing an "**unconditional**" request. Without giving any advance notice, the respondents failed to appear. The appellants requested apportionment of costs on the grounds that the oral proceedings would not have been necessary had they known that the respondents would not be attending. The board rejected a different apportionment of costs because the appellants had made an "unconditional" request for oral proceedings, i.e. also covering the eventuality that the other party would not appear.

In **T 65/05** the respondent maintained that, like the appellant, it would not have attended the oral proceedings if it had been informed in time that the opposing party would not be appearing. In the case in point the board considered it doubtful that the oral proceedings could therefore have been waived or that the respondent would then at any rate not have attended them or would have withdrawn its request for oral proceedings. Both parties had submitted auxiliary requests for oral proceedings. The board had issued the summons without an opinion on the merits, in particular without any announcement or intimation that it was likely to decide in the respondent's favour. Therefore the respondent could not rely on a favourable decision purely on the basis of its written submissions if it stayed away from the oral proceedings. In these specific circumstances the board deemed it likely that that respondent (patent proprietor) would have appeared at the oral proceedings to defend its interests even if it had known that the opposing party would not be there. The request for a different apportionment of costs was therefore rejected (see also **T 190/06**).

In **T 435/02**, both the appellant and the respondent had filed an **auxiliary request** for oral proceedings. When filing its request, the respondent had wanted to attend the oral proceedings to ensure that the board would not overturn the decision under appeal without its having the opportunity to present its case orally. In response to the appellant's decision not to attend the proceedings, the respondent gave notice that it too would not be attending and commented that it had wished to attend "merely to rebut statements/arguments made by the patentee during these proceedings". Although the board expressly informed the parties that the oral proceedings would be held as planned, the respondent failed to attend. The respondent requested a different apportionment of costs because the appellant had withdrawn its request for oral proceedings so late that the respondent had incurred costs which no longer could be recovered. The board refused the request on the grounds that, contrary to the respondent's claim, its failure to appear was not a response to the appellant's decision not to attend but the result of a choice not to take the opportunity which it had requested to present its case orally.

In **T 275/89** (OJ 1992, 126) the appellant's representative filed a request that the oral proceedings scheduled for 09.00 on 3 May be adjourned, on the grounds that the appellant was unable to attend the oral proceedings owing to illness. The request was submitted so late, i.e. in the afternoon of 30 April, that it was **impossible** in view of the public holiday the following day to notify the respondents **in time**: they had already set out during the afternoon of 1 May. The request for adjournment was refused however and the oral proceedings took place without the appellant. The respondents requested a different apportionment of costs on the grounds that they would not have attended either had they known that the appellant would not be appearing. The board, however, took the view that the appellant could not be made responsible for the fact that the respondents had chosen to make an early start to the journey. Furthermore, the only matter of importance was whether the appellant's absence rendered the oral proceedings unnecessary. This question had to be answered in the negative. The request for costs was therefore rejected.

In **T 849/95** the respondent submitted a request for apportionment of costs, as the appellant had not informed the EPO in good time that he would not be taking part in the oral proceedings which he too had requested. The board rejected the request, as the oral proceedings were arranged not only at the request of both parties, but also because the board itself required further airing of facts on the part of the respondent. The oral proceedings would not have been cancelled even if the appellant had informed the EPO in good time.

In **T 838/92** too, the appellants stayed away from the oral proceedings. The respondents requested a different apportionment of costs as they had appeared with **seven witnesses**. The board rejected the request because the witnesses had been summoned at the respondents' instigation in order to prove the prior uses alleged by the latter. There was therefore no reason to impose the costs on the appellant (cf. also **T 273/07**).

- b) Request for scheduling or postponement of oral proceedings; withdrawal of request for oral proceedings

On the basis of Art. 116(1) EPC 1973 (unchanged) any party has the exclusive right to request oral proceedings if it considers them to be necessary. The fact that one of the parties has to travel a longer distance than the other does not make the request for oral proceedings abusive. Furthermore, an objection of abuse based on the fact that the problems to be discussed in oral proceedings are simple ones and could easily be presented in writing cannot be sustained (**T 79/88**).

In **T 407/92** the appellant and opponent as a party of right requested the apportionment of costs because they considered it an abuse that the respondents, after the first oral proceedings, had presented numerous additional sets of claims and requested **additional oral proceedings**, although the board, at the end of the first oral proceedings, had declared that the proceedings should be continued in writing on the basis of the three auxiliary requests presented by the respondents during the first oral proceedings. The board could not see any abusive conduct in the present case because, due to the relatively complex technical content of the patent in suit, the board itself considered it necessary to have a further oral discussion with the parties. The request was therefore rejected.

In **T 297/91** it had, for a number of reasons, not been possible to decide all the issues during the first oral proceedings, with the result that the respondent (patent proprietor) had requested that oral proceedings be held for the second time and that the costs incurred be borne by the appellant. The board rejected the request for apportionment of costs because the further oral proceedings had become necessary for reasons beyond the patent proprietor's control.

In **T 432/92** **postponement** of the oral proceedings was requested two days prior to the agreed date as the father of the respondents' representative had died on the previous day. The appellants requested a different apportionment of costs because their representative had already travelled from America to the EPO, thereby incurring unnecessary costs. They argued that the respondents could have been represented by someone else from their patent attorney's firm. The board refused the request because there had been no recognisably wrongful or irresponsible conduct on the part of the other party. The board was of the opinion in particular that the respondents could not be expected to be represented by a different patent attorney, who would have had to prepare two oral proceedings in one day (one for an ongoing parallel case) and to travel as well.

In **T 42/99**, appellant I announced, as early as one month prior to oral proceedings, that experts would attend those proceedings. Only shortly before the appointed date for the proceedings, appellant II submitted a request that statements by an expert be admitted at the oral proceedings. Appellant II also requested the postponement of the oral proceedings so that its expert would have enough time to prepare. The board decided to postpone the appointed date to enable both appellants to be accompanied by experts at the oral proceedings. However, in doing so, the board also regarded it as equitable to

order a different apportionment of costs. In its reasons the board took the view that, although a reply from appellant II to the announcement by appellant I that experts would attend the oral proceedings would not have been possible within the time limit set by the board, a "response" to the aforementioned announcement should have followed immediately and not shortly before the appointed date for oral proceedings. At this late stage, it was plausible that the representative of appellant I had made arrangements for the trip to Munich and a hotel reservation, which could not be cancelled without a financial loss.

In **T 99/05**, the appellant submitted, 13 days before the oral proceedings, a new experimental report in view of which the respondent asked for postponement of the oral proceedings. The appellant strongly objected to such a postponement. Since, in the board's view, the question of postponing the oral proceedings was linked to the question of whether the late-filed experimental report should be introduced into the proceedings, the board deemed it appropriate to maintain the oral proceedings in order to hear the arguments of the parties concerning the relevance of the late-filed experimental report of the appellant, and hence to decide on the introduction or not of this report into the proceedings. However, the oral proceedings did not result in a final decision with regard to patentability and second oral proceedings were scheduled in order for the respondent to be allowed sufficient time to file counter-experiments. Whilst the late filing did not represent an abuse of proceedings, it was evident that the final outcome of the proceedings had been delayed. Therefore, the board found it appropriate for reasons of equity to order a different apportionment of costs.

Nothing in the EPC prevents a party from **withdrawing a request for oral proceedings** at any stage of the procedure. The withdrawal of such a request is not culpable conduct as such and cannot be a factor in assessing whether reasons of equity exist in accordance with Art. 104(1) EPC 1973 (**T 91/99**).

In **T 154/90** (OJ 1993, 505) the opponents had initially insisted on oral proceedings, although the opposition division did not consider that they were necessary. However, **eight days** before the arranged date the opponents informed the opposition division that they wished to cancel the oral proceedings. For reasons of internal organisation at the EPO, the opposition division did not receive this letter until after the date of the oral proceedings. The board of appeal ruled that eight days was a sufficient period of time for the oral proceedings to be cancelled, since no evaluation of new facts or arguments was needed (the case was different in **T 10/82**, OJ 1983, 407). Since the letter was received too late for purely internal reasons, the opponents were not at fault. They were not obliged to bear a part of the costs of the other party. A change of opinion regarding the necessity of oral proceedings could not be regarded as culpable conduct either (see also **T 383/05**).

In **T 29/96** the respondent informed the board and appellant, **four working days** before the date set for oral proceedings, that it was abandoning the patent and no longer requesting oral proceedings. However, the declaration abandoning the patent was not completely unambiguous. The board refused the appellant's request that costs be awarded against the respondent; it had been clear that the oral proceedings would

probably be superfluous. Also, the appellant could have contacted the DG 3 Registry to find out about the course the proceedings would be taking. The board also dismissed the appellant's further argument that additional costs had been incurred in clarifying the legal position following abandonment of the patent; these would have arisen anyway, even without the (cancelled) oral proceedings.

In **T 556/96**, the appellant withdrew his request for oral proceedings **early in the afternoon preceding** the oral proceeding. By that time, the opposing party's representative had already set off. The board ruled that the appellant had withdrawn his request too late. The fact that the other party had also unconditionally requested oral proceedings was irrelevant; it too could have withdrawn the request, had it known in time that the appellant would not be attending. The board therefore ordered the appellant to pay the costs incurred by the respondent in preparing and attending the oral proceedings.

In **T 490/05**, on the day before oral proceedings, the proprietor had withdrawn both his request for oral proceedings and his request to have the impugned decision set aside. For the opponent that had the major benefit that even before oral proceedings it was clear that the impugned decision revoking the patent was sure to be made final. This gave him the advantage of being able to focus his preparations for the oral proceedings on the proprietor's request for apportionment of costs. Thus there were no reasons of equity for sharing the costs incurred by the opponent. Another factor the board considered was that the opponent had not responded to the proprietor's first request for apportionment. The respondent in fact took the oral proceedings themselves as an opportunity to set out his position on the apportionment of costs.

c) Other cases

An apportionment of costs is justified if excessive costs are incurred for the oral proceedings and caused mainly by one party (see **T 49/86**).

In **T 1022/93** the appellant had refrained from communicating in the written appeal procedure why, in his opinion, the amended process claims should be considered inventive and from specifying that the additional example described a process according to the amended set of claims. This made it impossible either to remit the case without oral proceedings or to deal with the substance of the case at the oral proceedings. For reasons of equity, therefore, the appellant was required pursuant to Art. 104(1) EPC 1973 to reimburse to the respondent the costs incurred as a result of the participation at the oral proceedings before the board.

However, in the majority of cases, the boards have found that there was no abuse and have accordingly refused to order a different apportionment of costs.

Parties have repeatedly tried to bring about an apportionment of costs on the grounds that no new arguments have been put forward during oral proceedings by the party which requested them and that therefore there has been an abuse of the oral procedure. Although costs were apportioned on these grounds in **T 167/84** (OJ 1987, 369), the

boards otherwise unanimously took the view that the right to oral proceedings was absolute and therefore not subject to any conditions (**T 614/89**, **T 26/92**, **T 81/92** and **T 408/02**). The absence of new arguments is not a reason for apportioning costs - as was found in **T 303/86**, **T 305/86**, **T 383/87**, **T 125/89** (departing from the decision at first instance) and **T 918/92**.

In **T 905/91** the respondents had requested a different apportionment of costs on the grounds that the appellants had not brought prepared auxiliary requests to the oral proceedings, which had therefore continued into the afternoon. The board rejected the request for the following reasons. Firstly, the appellants had endeavoured to take account of the reservations expressed by the board and had filed new documents. Secondly, oral proceedings served specifically to clarify the situation completely through the direct exchange of arguments and, if necessary, to rephrase the patent application in the light of the outcome of the discussion. The duration of oral proceedings depended on the particular case; at any rate it was not unusual for such proceedings to continue into the afternoon, and the parties should be prepared for this.

In **T 210/98**, the respondent requested an apportionment of costs on the ground that the appellant had withdrawn three auxiliary requests at the beginning of the oral proceedings for which the preparation had been time-consuming. The board refused the request, stating that it was normal for parties to prepare themselves thoroughly for oral proceedings. A change of view was one of the situations with which a professional representative could be confronted during oral proceedings. As it was not exceptional for requests to be changed or withdrawn during oral proceedings as a result of the discussion held, no abuse of procedure could be seen in the withdrawal of requests at the beginning of the oral proceedings, which had apparently been a reaction to convincing written arguments.

In **T 668/03** the appellant requested an apportionment of costs in view of the fact that oral proceedings had to be held for a second time. As a matter of fact, the former oral proceedings had to be adjourned because the identity of one of the opponents had been drawn into doubt by the appellant during the first oral proceedings. The board pointed out that it was the duty of the respondent to make it clear throughout the procedure who belonged to the group of common opponents. However, had the appellant raised this issue before the first oral proceedings, it could have been dealt with in writing and thus the costs for further oral proceedings could have been avoided. Therefore, the board could not detect any reasons of equity which could be used to order a different apportionment of costs.

7.2.3 Abuse of procedure

Exceptions to the principle that each party must bear its own costs may also be made in cases of abusive conduct in which it is equitable to make an award of costs against one of the parties. In a number of cases, parties have sought to obtain a different apportionment of costs on the basis of an abuse of the procedure.

a) Filing of opposition or appeal

An apportionment of costs is often requested on the grounds that the notice of opposition or appeal has been incorrectly filed.

In **T 170/83** the opponents had used an incorrect form for payment of the opposition fee, thereby giving rise to a decision by formalities to reject the opposition; the opponents thereupon filed an appeal against this decision. The patent proprietors (respondents) requested that the appeal costs be awarded against the appellants, since it was their error which had rendered the proceedings necessary. The board rejected the request, taking the view that the appeal proceedings were not improper. An abuse justifying the apportionment of costs could only be rooted in the party's conduct **during the proceedings**.

In a number of cases the boards took the admissibility or allowability of an opposition or an appeal to be an indication that no abuse had taken place (e.g. **T 7/88** and **T 525/88**). Similarly, in **T 506/89**, the board found that the opponent's filing of an appeal did not constitute an abuse of procedure and therefore rejected the request for a different apportionment of costs, since it had decided, in the oral proceedings, to maintain the patent as amended. Nor was there an abuse of procedure where the appeal was filed without new arguments (**T 605/92**) or where the appellant's chances of success were considered to be low (**T 318/91**). In **T 99/87**, the board held that there had been no abuse in either the discussion during the oral proceedings or the respondent's formulation of new claims.

b) Withdrawal of opposition or appeal

An appellant is entitled to withdraw his appeal at any time. Based on the principle of free party disposition, this right may not be restricted, even implicitly by the threat of cost apportionment, on the grounds that oral proceedings have been scheduled and the opposing party cannot be notified in time. As a rule, the benefits that respondents derive from the withdrawal of the appeal will offset the costs that they incur, even if they are avoidable. That is the case even if the appeal is only formally pending on account of the request for cost apportionment (**T 490/05**).

In **T 85/84** the appellants withdrew the appeal in a telex to the EPO and the respondents' representative **48 hours** before the date of the oral proceedings. The EPO forwarded this information, together with the decision to cancel the oral proceedings, to the respondents' representative, a member of its patent department, by telex sent at 4.17 pm. The telex did not reach the patent department until the next day. By this time, however, the respondents' representative had already departed in order to prepare for the oral proceedings in Munich. He requested apportionment of costs. Although the opposition and the appeal had been withdrawn, a decision was given on the apportionment of costs (see also **T 765/89**). The board refused to apportion the costs as the respondents' representative had been informed in good time that the oral proceedings would not be taking place. Internal delays in forwarding the communication were not the fault of the appellants. The representative's departure for Munich a day

before the oral proceedings was not warranted by the distance and therefore not necessary from the point of view of the oral proceedings. The appellants should have been able to assume that their communication had reached the representative in good time. There had been no culpable conduct.

In **T 614/89** the appellants withdrew the appeal for financial reasons **four days** before the date set for oral proceedings. The respondents were notified the same day. Respondents I filed a request for apportionment of costs on the grounds that they had already prepared themselves for the oral proceedings and the appellants must have known long before the date set that the appeal stood no chance of success. The board took a decision on the request, rejecting it on the grounds that the appeal had been withdrawn sufficiently promptly that no costs had been incurred for the oral proceedings. It also ruled that the right to oral proceedings was subject to no restrictions and that the appellants had acted neither negligently nor with wilful intent (see also **T 772/95**).

In **T 674/03**, the opponent withdrew its appeal **nine days** before the date set for the oral proceedings. The board held that the exercise of an absolute procedural right did not, in principle, constitute abuse. There was no evidence that the opponent had at any time acted in such an improper or negligent manner that a different apportionment of the costs was justified, especially where the costs for which reimbursement was sought were such as were usually incurred by a party in defending its interests in appeal proceedings.

c) Other cases

In **T 952/00**, the board found that the requirement of equity was a matter for the body hearing the case to decide at its discretion in the light of the facts. The wrongful act, whether intentional or simply the result of culpable negligence, had to be judged in the light of the normal behaviour of an ordinarily diligent party. It also had to be clearly and obviously the direct cause of the costs which should not have been incurred. In the case in point, it was important to compare the evidence given by the opposing party at first instance with the additional evidence he had had to give at the appeal stage, bearing in mind the evidence to the contrary given by the patent proprietor at both instances. The board found that the statements made by the proprietor on the accuracy of the opponent's allegations had varied considerably over time, whereas the opponent's allegations had remained consistent. The board concluded that without the false statements of the patentee the opponent would not have been required to go to the expense of gathering further evidence. The request of the opponent (appellant) for an apportionment of costs was therefore to be granted.

In decision **T 461/88** (OJ 1993, 295) the board decided that the appellants' insistence on hearing witnesses was clearly compatible with the principle of the responsible exercise of rights, as this may well have been the only means of proving the alleged public nature of the prior use. The board refused the request for apportionment of costs.

In **T 269/02** the appellant had been given sufficient opportunity during the protracted written proceedings and at the oral proceedings before the opposition division to amend its claims to alleviate the problem under Art. 123(2) EPC 1973. However, the appellant

had chosen not to do this, with the result that the patent was revoked on the ground of Art. 123(2) EPC 1973, rendering necessary the present appeal proceedings which dealt solely with the issue of amendment. In view of this, the respondent argued that the appellant's conduct had been far from exemplary and, if the appeal were to be allowed, and the case remitted to the opposition division, the appellant should be made to bear the costs incurred as a result of the present appeal proceedings. Contrary to the respondent's assertions, the board stated that in cases such as the present, where the patent had been revoked in opposition proceedings, the appellant must be given the opportunity to study the decision of the opposition division duly substantiated in writing in order to enable it to decide on the **formulation of appropriate requests** for the appeal proceedings. In these circumstances, the board did not find that the appellant had abused or exceeded its legitimate rights, thereby arbitrarily causing the respondents to incur costs which, in all fairness, ought to be reimbursed. The request for an apportionment of costs was therefore refused.

Similarly, the circumstances underlying **T 916/05** did not, according to the board, justify a different apportionment of costs. Since the patent proprietor was adversely affected by the decision of the opposition division, it was entitled to file an appeal and submit any arguments which, in its view, might be of use in defending its patent before the second instance. The fact that some of the arguments had not been presented before and could have been filed in oral proceedings before the opposition division, had such proceedings taken place, was in the board's opinion irrelevant and could not be regarded as an abuse of procedure. In fact, an appellant could not be prevented from choosing a **different line of arguments** when making its case before a board of appeal.

In **T 162/04** the respondent requested a different apportionment of costs because it had had to invest a considerable amount of time and effort in considering the numerous requests submitted by the appellant during the appeal proceedings. However, the appellant's requests were later **withdrawn** rendering the time and effort of the respondent, in its view, useless. In the board's judgment, such conduct did not amount to an abuse of procedure. Indeed, the conduct of the appellant, who by withdrawing the contested requests and by **replacing** them with other requests was apparently trying to overcome the objections which had been raised, was not as such objectionable but had to be considered as a legitimate defence of its case. The request for an apportionment of costs was therefore refused.

The request for apportionment of costs made by the respondent in case **T 248/05** was mainly based on the alleged **lack of clarity** of the category of claim 1 as granted and the vagueness in this respect of the appellant's submissions in the statement setting out the grounds of appeal. The board held, however, that the alleged lack of clarity of the category of the claimed subject-matter and the possible associated additional costs which could be incurred by a clarification of this subject-matter would not justify an apportionment of the respondent's costs on the appellant. Firstly, the criticised elements of claim 1 and the alleged vagueness of the statement setting out the grounds of appeal were entirely irrelevant for the subject-matter of the appeal in point, i.e. the findings of the opposition division on added subject-matter. Secondly, lack of clarity of a claim or of

a submission could hardly be regarded as an abuse of procedure unless this were intentional. The board therefore saw no legal basis for any apportionment of costs.

7.3. Procedural aspects

7.3.1 Filing a request for apportionment of costs

The practice before the boards of appeal is that all requests by parties, including any requests as to costs, should be made before any decision is announced in oral proceedings (**T 212/88**, OJ 1992, 28) - in the case cited here, however, the request for apportionment of costs was considered **exceptionally**, because the parties were not, at the time, aware of this practice.

There is no basis for deciding on a different apportionment of costs if the party which would benefit from the decision did not request apportionment and even made it known that it would not enforce any such decision (**T 408/91**). This applied even if the board considered an apportionment of costs to be equitable (see also **T 125/93**).

A request for apportionment of costs submitted by the respondent merely as a party to the appeal proceedings as of right (Art. 107, second sentence, EPC 1973; editorial changes in German and French; unchanged in English) must be rejected as inadmissible as it would otherwise contravene the principle of equal treatment (**T 753/92** and **T 514/01**, **T 1237/05**).

In **T 896/92** the request for a different apportionment of costs was rejected for lack of substantiation and because of the absence of obvious reasons. In decision **T 193/87** (OJ 1993, 207) the board likewise refused the apportionment of costs, because it could not see any reasons of equity which could justify such an apportionment of the costs, nor had the respondent brought forward any evidence in this respect. In several decisions, the boards of appeal have stressed the importance of submitting evidence to support a request for a different apportionment of costs (e.g. **T 49/86**, **T 193/87**, **T 212/88**, OJ 1992, 28; **T 404/89**, **T 523/89**, **T 705/90**, **T 776/90** and **T 306/93**).

7.3.2 Competence issues

In **T 765/89** it was stressed that the board was still responsible for deciding on the request that costs be awarded against the appellants even if the latter had withdrawn their appeal. Where an opponent/respondent withdraws his opposition during appeal proceedings, he ceases to be a party to the appeal proceedings as far as the substantive issues are concerned but retains his party status in so far as the question of apportionment of costs is still at issue (**T 789/89**, OJ 1994, 482).

In **T 1059/98**, with regard to the respondent's request for apportionment of costs, the board stated that no request had been made before the opposition division for apportionment of the costs incurred in connection with the oral proceedings held before that department of first instance, and the opposition division had neither considered nor decided upon this matter in the decision under appeal. Art. 21(1) EPC 1973 (unchanged)

provided that a board of appeal could only examine appeals from decisions of EPO departments of first instance. That clearly meant, in the circumstances of the case, that the board could not examine and decide upon a request for apportionment of costs incurred as a result of oral proceedings before the opposition division, if that request was presented for the first time before the board of appeal and thus no decision had been taken on it by the department of first instance. The board was therefore not competent to consider and decide upon the respondent's request for apportionment of costs, which was rejected accordingly.

As a matter of principle costs are not apportioned in transfer proceedings (**J 38/92**, OJ 1995, 8).

7.3.3 Apportionable costs

Under R. 88(1) EPC (former R. 63(1) EPC 1973), the apportionment of costs is dealt with in the decision on the opposition. Only those expenses necessary to assure proper protection of the rights involved may be taken into consideration. The costs include the remuneration of the parties' representatives.

This rule is frequently applied in the case law of the boards of appeal (**T 167/84**, OJ 1987, 369; **T 117/86**, OJ 1989, 401; **T 416/87**, OJ 1990, 415; **T 323/89**, OJ 1992, 169). In **T 930/92** (OJ 1996, 191) the board held that, when fixing the amount of costs to be paid to a party, in addition to the remuneration of the professional representative of that party, the expenses incurred by an employee of that party in order to instruct the professional representative before and during oral proceedings could be taken into consideration under R. 63(1) EPC 1973, if such instruction was necessary to assure proper protection of the rights involved. In **T 326/87** (OJ 1992, 522), all the costs incurred as a result of the remittal to the department of first instance were deemed to be apportionable.

In **T 758/99**, the board held that a decision on the apportionment of **future** costs in appeal proceedings caused by the late filing of documents depended on the course of the subsequent procedure and, in the absence of the necessary facts, could not be decided at that stage. The board refrained from such an "open-ended" award of costs, agreeing with the appellant's objection that the consequences of such an award were unpredictable (see also **T 133/06**). For these reasons the board deviated from the judgment given in **T 611/90**, in which the legitimately incurred future costs had been apportioned. The board remitted the case to the department of first instance and ordered that a decision on the request for apportionment of costs would be taken at a later stage.

The amount of costs to be paid under a decision apportioning them is fixed, on request, by the **registry of the opposition division**. The fixing of costs by the registry may be reviewed by a decision of the opposition division on a request filed within the period laid down in the Implementing Regulations (Art. 104(2) EPC 1973). Under the new R. 88(3) EPC this period amounts to one month after the **communication** on the fixing of costs. It also requires that the relevant request be filed in writing and state the reasons on which

it is based. Moreover, the request is not deemed to be filed until the prescribed fee has been paid. The requirements are thus essentially the same as those for an appeal.

In **T 668/99**, the question was raised as to whether the prohibition of reformatio in peius also applies if the proceedings are not referred to a higher level of jurisdiction but are continued within the same level of jurisdiction, as is the case with a **legal remedy against the fixing of the costs** by the opposition division registry. The board recalled that an appeal and a request for an opposition division decision have far more similarities (suspensive and devolutive effect) than differences, and so the position of the sole requester is comparable to that of the sole appellant. The board was therefore satisfied that the prohibition of reformatio in peius also had to apply to a request under Art. 104(2), second sentence, EPC 1973.

Where the **boards of appeal** have to rule on the apportionment of costs, they have the power under Art. 104(1) and (2) and Art. 111(1) EPC 1973, and having due regard to Art. 113(1) EPC 1973, not only to apportion but also to fix the costs (see e.g. **T 934/91**, OJ 1994, 184). The scope of the apportionment depends on the specific circumstances of the individual case. The party to the proceedings who caused the additional costs may be ordered to pay all or a part of those costs (**T 323/89**, OJ 1992, 169).

Since the filing of new material after expiry of the opposition period may cause the other party to incur additional costs, the board, in **T 117/86** (OJ 1989, 401), ordered that the appellant should pay the respondent 50% of his representative's costs in preparing and filing the response to the appeal (see also **T 83/93**).

In **T 715/95**, new documents were submitted only in the appeal proceedings. The delay was not justified. However, because the documents were so relevant the board admitted them and remitted the case to the department of first instance. But it also ordered the late-filing party to pay 50% of the cost of the oral proceedings, and 100% of that of the further proceedings at first instance. Similarly, in **T 45/98**, the appellant submitted new documents only in the appeal proceedings. They were admitted into the proceedings, but the case was not remitted to the department of first instance. With regard to the apportionment of costs, the board ordered that the appellant should pay 45% of the costs incurred by the opposing party's representative in the appeal proceedings.

7.3.4 Appeal solely against the decision on costs inadmissible

R. 97(1) EPC (former Art. 106(4) EPC 1973) states that the apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. As a rule, therefore, an appeal relating to apportionment of costs must be regarded as inadmissible if the appeal relating to the revocation of a patent is rejected as inadmissible for lack of merit and there is no other admissible request. However, if the impugned decision did not take into account the withdrawal of the request for oral proceedings and is thus based on a substantial procedural violation, the part of the impugned decision relating to apportionment of costs must be set aside (see e.g. **T 154/90**, OJ 1993, 505).

In **T 1237/05** the board found that the opponent, not being adversely affected by the patent's revocation, was not entitled to appeal solely against the apportionment of costs. The opponent's appeal, in view of Art. 106(4) EPC 1973, was inadmissible on that count alone. The mere fact that an appeal, in this case the proprietor's, was admissible did not in itself make the opponent's appeal admissible (the opponent in any case not being adversely affected by the first-instance decision on the merits) because it related only to cost apportionment. A distinction had to be drawn between appeal proceedings (initiated by at least one admissible appeal) and an appeal lodged by a party; the wording of Art. 106(4) EPC 1973 clearly referred to an appeal lodged by one of the parties to the proceedings, regardless of the existence of other appeals lodged by the other parties.

In **T 753/92** respondents I were adversely affected by the decision under appeal only in so far as their request for apportionment of costs was rejected. If respondents I had lodged an appeal against this decision, the appeal, with the apportionment of costs as its sole subject, would have been inadmissible under Art. 106(4) EPC 1973.

In **T 668/99**, the board took the view that, since no appeal had been lodged against the opposition division's decision on costs, that decision had become final upon expiry of the time limit for filing a notice of appeal. It found that the decision on costs mentioned in the request had not been submitted with the appeal, nor was there any indication of an implicit challenge to that decision. The fact that, under Art. 104(1) EPC 1973, the decision on costs might have to be made by the EPO did not change the outcome either. The board held that, unlike general procedural requirements, which - as had been consistently held - had to be reviewed at all times, including in the appeal procedure, the issuance of a decision on costs by the EPO did not necessarily mean that that decision had also to be reviewed by the EPO. The review of a decision at a higher level of jurisdiction required an appeal by one of the parties.

In **T 420/03** the question arose whether the "additional decision" concerning the apportionment of costs fell within the scope of appeal. While the notice of appeal remained completely silent as regards the decision on the apportionment of costs, the request for cancellation of this decision was contained in the statement setting out the grounds of appeal. In the case before it, the board found that the notice of appeal did not contain any explicit statement concerning the apportionment of costs, and there was no other statement in the notice of appeal which could be interpreted - at least indirectly - that this was also the subject of the appeal.

D. Opposition procedure

1. Legal nature of opposition proceedings

1.1. Introduction

Opposition is an independent inter partes procedure following the grant procedure (see **G 1/84**, OJ 1985, 299; see also **T 279/88**; **T 182/89**, OJ 1991, 391; **T 387/89**, OJ 1992, 583; **T 198/88**, OJ 1991, 254; **T 373/87**). It is a purely administrative procedure which is initiated only on request, i.e. by the filing of opposition within the prescribed period. It

thus differs fundamentally from the appeal procedure, which must be regarded as a judicial procedure and is, by its very nature, less investigative (see **G 7/91** and **G 8/91**, OJ 1993, 356 and 346; **G 9/91**, OJ 1993, 408).

In opposition proceedings, the EPO must investigate the facts of its own motion. However, this **principle of ex officio examination** is subject to a variety of restrictions designed to improve procedural transparency and efficiency, prevent delays by concentrating the proceedings and limit the risks run by the parties.

Any person having doubts about the legal validity of a European patent may file a reasoned notice of opposition in writing. Opposition is a legal remedy by which granted patents can be revoked or limited but which - unlike an appeal - has neither suspensive effect nor the effect of transferring the case to a superior instance (see **T 695/89**, OJ 1993, 152). The opponent determines the extent to which the patented subject-matter may be examined in opposition proceedings (**principle of party disposition**). Therefore, a document taken into account in the procedure before the examining division is not automatically evidence to be considered in opposition or opposition appeal proceedings, even if quoted and acknowledged in the opposed patent (**T 198/88**, OJ 1991, 254).

The following sections deal in more depth with the content of the fundamental principles applicable to the opposition procedure, which have been addressed in several decisions of both the boards and the Enlarged Board of Appeal.

The provisions relating to the opposition procedure were largely left unchanged when the EPC was revised. In particular, Art. 100 and 101 EPC were reworded and, for the sake of clarity, restructured, with part of Art. 102 EPC 1973 being inserted into the new Art. 101 EPC. Certain provisions governing specific aspects of the opposition procedure were moved to the Implementing Regulations. Some of the provisions in the re-numbered Rules 75 to 89 EPC were worded more concisely and adapted to the revised EPC 2000, whilst others were rendered more precise, but none were amended in substance.

1.2. Contentious inter partes proceedings

Post-grant opposition takes the form of contentious proceedings between parties who normally represent opposing interests and who should be treated equally fairly.

The Enlarged Board came to the above conclusion in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), in which it addressed fundamental aspects of the opposition procedure. It held that opposition took place only after grant of the European patent, i.e. at a point in time when the proprietor was enjoying in each designated contracting state the same rights as would be conferred by a national patent granted in that state (Art. 64 and Art. 99 EPC; substance unchanged). Thus, the relief sought by the opponent was not, as in traditional pre-grant opposition, refusal of the patent application but revocation of the patent as granted (in its entirety or in part) with effect ex tunc in all designated contracting states (see Art. 68 EPC 1973; amended). Furthermore, the grounds for opposition (Art. 100 EPC 1973, substance unchanged) being limited to and essentially the same as

the grounds for revocation under national law (Art. 138 EPC 1973; amended), it appeared that the concept of post-grant opposition under the EPC differed considerably from that of the classic pre-grant opposition. The opposition procedure before the EPO thus had several important features more in common with the concept of the traditional revocation procedure and its effect was more similar to that of such a procedure.

As soon as the notice of opposition has been filed, the procedure automatically becomes bilateral, no matter whether the opposition is valid, admissible or allowable. R. 79(1) EPC (R. 57(1) EPC 1973) expressly requires the opposition division to communicate the opposition to the proprietor of the patent, and the Guidelines D-IV, 1.5 (old version) provide that communications and decisions about whether the opposition is deemed to have been filed and is admissible are also to be notified to the patent proprietor. Thus, the Convention does not provide for a decision by an opposition division "to end the ex parte proceedings" (T 263/00).

1.3. Only one opposition procedure where multiple oppositions

According to Art. 99 (3) EPC (Art. 99 (4) EPC 1973), opponents shall be parties to the opposition proceedings as well as the patent proprietor. It is clear from this provision that multiple admissible oppositions do not initiate a corresponding number of parallel opposition proceedings but only a single one. Each opponent can rely on an opposition ground duly submitted by other opponents and communicated to all parties in accordance with R. 79 (2) EPC (R. 57 (2) EPC 1973), both in the opposition proceedings and in any subsequent appeal proceedings (T 270/94, T 620/99, T 774/05).

2. Admissibility of the opposition

2.1. Entitlement to file an opposition

2.1.1 Introduction

An opponent's status is a procedural status, and the way it is substantiated is a matter of procedural law (G 3/97 and G 4/97, OJ 1999, 245 and 270). This is laid down in Art. 99(1) EPC in conjunction with Art. 100 (both provisions unchanged in substance), R. 55 and R. 56(1) EPC 1973 (now R. 76 and R. 77(1) EPC). According to those provisions, the opponent is the person who meets the conditions set out therein for filing an opposition, in particular that of identifiability. The EPC sets no other explicit formal conditions for opponents.

It is a principle firmly established by board of appeal case law that the admissibility of an opposition is examined by the EPO of its own motion. An objection that the opposition is inadmissible because the opponent is not entitled to file an opposition may be raised at any stage of the proceedings, i.e. even at a late stage before the board of appeal, because the admissibility of the opposition is an indispensable procedural requirement for any substantive examination of the opposition submissions (see T 289/91, OJ 1994, 649; T 28/93, T 590/94, T 522/94, OJ 1998, 421; T 960/95 and T 1180/97). If the board of appeal has good reasons for examining the admissibility of an opposition

(**T 199/92**), it may and is obliged to do so, even if the patent proprietor has not challenged admissibility during either opposition or appeal proceedings (**T 541/92**). In **G 4/97** (OJ 1999, 270), the Enlarged Board of Appeal reaffirmed that the admissibility of an opposition could be challenged during the appeal proceedings on grounds relating to the identity of an opponent, even if no such objection had been raised before the opposition division.

The case law on the **transfer of opponent status** is dealt with separately in Chapter VII.C.5.1.

The status of opponent can also be acquired by an assumed infringer who has **intervened** in pending opposition proceedings (see also Chapter VII.C.3, intervention).

2.1.2 Opponent's motives irrelevant

The EPC does not require that the **opponent have his own interest** in the outcome of the opposition proceedings; Art. 99(1) EPC 1973 (substance unchanged) states that "any person" is entitled to file a notice of opposition. As early as in **G 1/84** (OJ 1985, 299) the Enlarged Board held that the motives of the opponent were in principle irrelevant (otherwise, no doubt, the phrase "any person" would have been rendered as "any person interested"), whilst his identity was of primarily procedural importance (similarly in **T 635/88**, OJ 1993, 608; **T 590/93**, OJ 1995, 337). Following that case law, the board in **T 798/93** (OJ 1997, 363) found that the EPC and its attendant provisions contained no requirements as to the opponent's personal circumstances or motives for acting. Requests for the opposition to be declared inadmissible therefore had to be refused if, as in the case under consideration, they were based on either an objection regarding a particular aspect of the opponent's status, such as his profession (professional representative before the EPO) or his field of technical expertise (different from that of the opposed patent), or on his lack of motives for acting (statement by the opponent saying that his only reason for acting was to complete his training).

In **G 3/97** and **G 4/97** (OJ 1999, 245, 270) it was held in this regard that the EPC 1973 legislator had expressly designed the opposition procedure as a legal remedy in the public interest, which under Art. 99(1) EPC 1973 (substance unchanged) was open to "any person". Requiring an opponent to show an interest, of whatever kind, in invalidating the patent would be incompatible with that. The opponent's motives were irrelevant for the EPO, in the absence of evidence of abusive conduct.

2.1.3 Filing of opposition by patent proprietor or inventor

Given the purpose and special nature of the opposition procedure, patent proprietors may not oppose their own patent. In **G 9/93** (OJ 1994, 891), the Enlarged Board of Appeal departed from the view taken in **G 1/84** (OJ 1985, 299) and held that patent proprietors were not covered by the expression "any person" used in Art. 99(1) EPC 1973 (substance unchanged). The provisions of Part V of the EPC and the corresponding Implementing Regulations were clearly based on the assumption that the opponent was a person other than the patent proprietor and that the opposition

proceedings were always *inter partes*. The case law established in the **G 1/84** decision is thus obsolete.

In **T 3/06** the patentee argued that opponent 2 as the inventor of the patent in suit could not validly file an opposition even if the plain language definition of "any person" in Art. 99(1) EPC (substance unchanged) did not prevent inventors from filing an opposition. The patentee suggested that the ruling in **G 9/93** (OJ 1994, 891), which eliminated patent proprietors from the definition of "any person", should be updated to exclude, in the circumstances, the inventor also, as he was a shareholder of the patent proprietor. The board held the patent proprietor and the opposing inventor to be different persons. The inventor, although a shareholder in the patent proprietor, was not an executive of the company, nor did he have any substantial influence on commercial and judicial decisions concerning the business of the patent proprietor. In particular, the patent assignment contracts constituted evidence for the fact that this right was exclusively in the patent proprietor's possession. Finally, the alleged infringement by the inventor of contractual agreements or a fiduciary duty was a matter relating to the internal relationship between the parties and as such had no bearing on the present opposition and appeal proceedings. In the board's view, the conduct of the opposition and appeal proceedings by both parties demonstrated that the present proceedings were clearly contentious. The hypothetical possibility of an abuse of law by the inventor co-operating with the patent proprietor could be ruled out. The board came to the conclusion that the opposition of opponent 2 (inventor) was admissible, and it did not allow the patentee's request to refer to the Enlarged Board of Appeal the question whether an opposition filed by the named inventor was admissible.

2.1.4 Filing of opposition on behalf of a third party - straw man

Referrals **T 301/95** (OJ 1997, 519) and **T 649/92** (OJ 1998, 97) asked whether an opposition is inadmissible if the opponent is a "straw man" acting for some other person. In **G 3/97** and **G 4/97** (OJ 1999, 245, 270) the Enlarged Board of Appeal ruled that the opponent is the person who fulfils the requirements of Art. 99(1) EPC in conjunction with Art. 100 EPC 1973 (both provisions unchanged in substance), R. 55 and 56(1) EPC 1973 (now R. 76 and 77(1) EPC). Filing the opposition makes him formally the legitimate opponent.

A third party who incites him to file the opposition cannot perform any procedural acts, and is certainly not treated as a party to the proceedings. The EPO also lacks the procedural scope for investigating the allegation that a straw man is involved. So an opposition is not inadmissible purely because the person named as opponent in accordance with R. 76(2)(a) EPC (R. 55(a) EPC 1973) is acting on behalf of a third party. It is however inadmissible if the opponent's involvement is to be regarded as circumventing the law by abuse of due process. Such circumvention of the law arises, **in particular**, if:

- the opponent is acting on behalf of the patent proprietor. According to **G 9/93** (OJ 1994, 891), a proprietor cannot oppose his own patent; opposition is an *inter partes* procedure, so the patentee and opponent must be different persons.

- if the opponent is acting on behalf of a client in the context of activities which, taken as a whole, are typically associated with professional representatives, without possessing the necessary qualifications pursuant to Art. 134 EPC 1973 (wording amended). This would be the case if a person not entitled to act as a professional representative were acting on a client's behalf and carrying out all the activities typically carried out by professional representatives, while himself assuming the role of a party in order to circumvent the prohibition on his acting as a professional representative.

However, circumvention of the law by abuse of process **does not arise purely** because a professional representative files an opposition in his own name on behalf of a client; an opponent with either a residence or principal place of business in an EPC contracting state is acting on behalf of a third party who does not meet this requirement. In determining whether the law is being circumvented by abuse of process, the principle of the free evaluation of evidence is to be applied. The burden of proof lies with the person alleging that the opposition is inadmissible. The deciding body has to be satisfied, on the basis of clear and convincing evidence, that such abuse is occurring.

In the light of the above principles developed by the Enlarged Board of Appeal, the previously relevant case law is largely considered no longer to apply (see **T 10/82**, OJ 1983, 407; **T 635/88**, OJ 1993, 608; **T 25/85**, OJ 1996, 81; **T 582/90**, **T 289/91**, OJ 1994, 649; **T 548/91**, **T 339/93**, **T 590/93**, OJ 1995, 337; **T 798/93**, OJ 1997, 363; for details see also "Case Law of the Boards of Appeal of the EPO", 3rd ed. 1998, p. 424 et seq. and 425 et seq.).

2.1.5 Repeated filing of an opposition by the same person

In **T 9/00** (OJ 2002, 275), the board pointed out that repeated filing of an opposition by the same person could be objected to for lack of legitimate interest. It ruled that a (legal) person who filed two different notices of opposition to the same granted patent acquired party status as opponent only once, even if both notices complied with the requirements of Art. 99(1) EPC 1973 (substance unchanged) and R. 55 EPC 1973 (now R. 76 EPC). Both gave lack of novelty and inventive step as the grounds of opposition. Since the later opposition did not entail any change in the legal situation in the opposition proceedings compared to the earlier one, the board dismissed it as inadmissible for lack of a general legitimate interest. Nor could such an interest be inferred from the fact that the later opposition was assigned to a different part of the company from the earlier opposition and only that part of the company had been transferred to a third party.

In **T 9/00**, the two oppositions had been filed two months apart, albeit by the same opponent, and differed in content. An opposition fee had been paid for each one. There were no cross-references between the oppositions. The opponent subsequently stated that, although the double filing had been a mistake, it still wished to maintain the two oppositions. The circumstances in **T 774/05**, however, were quite different - both factually and in terms of the opponent's intentions. Here, the board found that the filing requirements could only have been met for one opposition and that the opponent had intended to maintain a single opposition, as was shown by the faxed statement that the cheque for the opposition fee was to be used for the opposition. The only indication of

separate oppositions was that the filed documents each stated that they were an opposition. The board, however, considered that this was not an indication that the opponent intended to file two oppositions but rather a mere indication of their content. The opposition was therefore held to be admissible.

In **T 966/02**, the same opponent had filed two oppositions to the contested patent under Art. 100(a) EPC 1973 (substance unchanged), only the second of which cited the document D1 on which the opposition division based its decision. In the board's view, however, the question in this case was less whether the second opposition was admissible than whether the material in the second opposition was admissible. It was questionable whether the opposition division had even been competent to use the document cited in the second opposition. The board stated that, irrespective of whether or not the second opposition filed had to be regarded as admissible, the first opposition had been filed in due form and time and was therefore admissible, and opposition proceedings had been initiated as a result. If the second opposition also had to be regarded as admissible, the department of first instance was obliged to take account of the material it cited. However, if it had to be regarded as inadmissible, the department of first instance was competent, under the rule on examination of its own motion in Art. 114(1) EPC 1973 (unchanged), to take account of the material cited in the inadmissible opposition if (i) another admissible opposition had been filed and (ii) there was reason to do so because the material was relevant. Both conditions were met in the case in hand. There was therefore no need to decide whether the second opposition was admissible, since the department of first instance was, in any event, competent to take account of both document D1 and any other relevant material cited in the second set of pleadings.

2.1.6 Admissibility of a joint opposition - multiple opponents

a) Payment of a single opposition fee

Under Art. 99(1) EPC (substance unchanged), any person may file a notice of opposition. The boards of appeal dealt in several decisions with the interpretation of the words "any person". In **T 272/95** (OJ 1999, 590), for example, the board considered the issue of interpretation and, in view of the need for clarification, referred to the Enlarged Board, inter alia, the question whether an opposition filed by more than one person was to be regarded as admissible where only one opposition fee had been paid.

In **G 3/99** (OJ 2002, 347), the Enlarged Board of Appeal held that an opposition filed in common by two or more persons, which otherwise met the requirements of Art. 99 EPC 1973 (now Art. 99 in conjunction with R. 75 EPC) and Rules 1 and 55 EPC 1973 (now R. 3 and 76 EPC), was admissible on payment of a single opposition fee. The payment of the opposition fee was linked to the filing of an opposition and not to the number of persons who filed the opposition. There was no procedural difference with respect to an opposition filed by a single natural person, by a single legal person or by a single body equivalent to a legal person by virtue of the law governing it.

With respect to the interpretation of the words "any person" in Art. 99(1) EPC 1973, the Enlarged Board of Appeal held that, as regards an opposition filed in common by a plurality of persons, the common opponents had to be either a natural person, a legal person, a body equivalent to a legal person by virtue of the law governing it or a combination thereof.

b) Representation, legal status and composition of a multiple opponent

In **G 3/99** (OJ 2002, 347), the Enlarged Board also held that, in an opposition filed in common, there had to be in all cases a **common representative** (Art. 133(4) EPC 1973 and R. 100 EPC 1973; substance unchanged) and only that common representative was entitled to act in the opposition proceedings on behalf of all the common opponents taken as a whole. Consequently, an individual opponent who was not the common representative - or sub-group of the common opponents not including the common representative - was not entitled to act or intervene on his own or on behalf of one or more or all of the other individuals. Only the common representative was entitled to sign the filed documents; the signatures of other individuals were not required (point 14 of the reasons). Since the EPO treated a procedural act performed by a non-entitled person in the same way as a missing signature (see **T 665/89**), each common opponent or any other person acting on his behalf could perform such an act to avoid missing a deadline, provided the deficiency was remedied within an additional period set by the board in the communication under R. 36(3) EPC 1973 (now R. 50(3) EPC), notified to the common representative and sent for information to the non-entitled person who performed the act. The deficiency was remedied if the procedural act was signed by the common representative (point 20 of the reasons).

In order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it had to be clear throughout the proceedings who belonged to the group of common opponents or common appellants. If either a common opponent or appellant (including the common representative) intended to withdraw from the proceedings, the EPO had to be notified accordingly by the common representative or by a new common representative determined under R. 100(1) EPC 1973 (substance unchanged) in order for the withdrawal to take effect.

Referring to this case law in its interlocutory decision in **T 482/02** of 9.02.2005, the board stated that, where it was doubtful whether an opposition had been filed on behalf of a body which enjoyed legal personality in its own right or on behalf of several natural persons acting in common, the opponents (here a UK partnership) should be invited to establish that the body was a legal person or an equivalent thereto. If this was not established, the opposition was to be considered as having been filed on behalf of the several natural persons as common opponents (see also **T 866/01**). In that case the opponents still had to furnish the names and addresses of the partners in order to comply with R. 55(a) EPC 1973 (now R. 76(2)(a) EPC). If this information was not received within a period specified by the board, the opposition had to be rejected as inadmissible under R. 56(2) EPC 1973 (now R. 77(2) EPC), irrespective of whether or not such information would have been sufficient to prevent rejection under R. 56(1) EPC 1973 (now R. 77(1) EPC).

Similarly, in **T 315/03** (OJ 2005, 246), the board followed the decision of the Enlarged Board in **G 3/99**, adding that, while admissibility of an opposition by multiple opponents had to be kept under review throughout the proceedings, parties could not expect the opposition division or board to do this alone. It was clear that the board had neither the resources nor the knowledge of the relevant laws of all the contracting states necessary to police the composition of, and the legal status of all members of, multiple opponents. Once prima facie admissibility was acknowledged, it had to be up to the party or parties seeking to challenge admissibility to make a case of inadmissibility. However, the board saw no reason in the case before it to question the legal status of the multiple opponents, the respondent not having pointed to any evidence which suggested the legal status of the various persons in question was other than the opposition division held. If the respondent wished to challenge those conclusions, it was incumbent on it to produce or point to some evidence to question such conclusions - for example evidence from official registers or the results of inquiries showing that a legal person never or no longer existed, or evidence that under the relevant national law a legal person did not have the status found by the opposition division.

With regard to changes over time in the **composition** of a multiple opponent, the board agreed with the respondent that the absence over eleven and a half years of any notification concerning the 1200 members of opponent 6 ("opposition club") could in itself be considered an indication that the "clear throughout" condition had not been complied with. On the other hand, the fact that certain opponents only came into being for the purpose of filing opposition to one patent could not in itself be an objection to admissibility; an opponent's motive or lack of motive was irrelevant (see **G 3/97**, OJ 1999, 245). Similarly, it appeared to the board to be wholly irrelevant that an opponent, whether individual or multiple, might be supported by others. Such supporters clearly could not take any part in the proceedings and could not affect its outcome. In relation to any proceedings there were likely to be non-parties who wanted to see a particular party succeed (e.g. employees or shareholders of a company which was a party). If some opponents - as in this case - made varying reference to their supporters in the belief that this might influence the result, then that was of course incorrect. However, support for a party could not per se be a reason to challenge admissibility.

2.2. Formal requirements for opposition and filing in due time

2.2.1 Fundamentals

According to R. 150(1) EPC (Art. 99(1) EPC 1973) the notice of opposition must be filed within **nine months** of the publication of the mention of the grant of the European patent in the European Patent Bulletin. In the interests of legal certainty, the Convention lays down certain requirements for an opposition that must be met before the opposition period expires. These include the requirements that the opponent be sufficiently identified, the patent opposed be indicated, the notice of opposition be in writing, specific grounds be stated and the opposition fee be paid.

Until the requirements of R. 150(1) EPC (Art. 99(1) EPC 1973) regarding the filing of an opposition in due time have been met, a potential opponent is not a party to any proceedings before the EPO (see **T 152/85**, OJ 1987, 191).

In **T 438/87** the question addressed was whether a delay in **publication** of the European patent specification could in any way affect calculation of the time limit for filing an opposition. The board of appeal concluded that, in the case before it, the date of publication was the point from which the opposition period began, because the mention of the grant of the patent in suit had been brought to the public's attention in the normal way, irrespective of what problems may have affected publication of the patent specification and what consequences such untoward event might have for certain third parties owing to their geographical location.

2.2.2 Identity of the opponent

R. 76(2)(a) EPC (R. 55(a) EPC 1973) provides that the notice of opposition must contain the name and address of the opponent and state where his residence or principal place of business is located, in accordance with the provisions of R. 41(2)(c) EPC (R. 26(2)(c) EPC 1973), which deals with the precise particulars by which such identity needs to be established. If the identity of an opponent is not established before expiry of the period allowed for filing an opposition, the opposition is inadmissible (**T 25/85**, OJ 1986, 81). This defect cannot be remedied (**T 590/94**).

In **T 870/92** the board emphasised that, when indicating a legal entity, failure to use its exact official designation (R. 26(2)(c) and 61a EPC 1973; now R. 41(2)(c) and 86 EPC) did not necessarily mean that the opposition was inadmissible. An incorrect designation which nevertheless sufficed to indicate the party's identity had to be distinguished from the absence of such information. Errors in a designation could be corrected at any time (R. 88, first sentence, EPC 1973, now R. 139, first sentence, EPC; see also **T 828/98**).

In **T 1165/03**, the respondent had several reasons to question the admissibility of the opposition of opponent 1, these reasons having largely been provided by the opponent himself or those acting on his behalf. One concerned the opponent's identity and, in particular, the assessment of the identity card evidence, which had been produced at a very late stage, namely during the oral proceedings before the board. The board regarded an identity card or passport as the best evidence of identity but with the same proviso as applies to all evidence, i.e. that its value could be offset or even negated by other evidence. In this case, two different photocopy identity cards had been filed: the first had been sent to the opposition division and, although even less legible than the copy later faxed to the board, it was clearly not a copy of the same document as that shown in the fax and subsequently filed during the oral proceedings. The letter signed in the opponent's name said his name had only been used accidentally in relation to the proceedings and that he was more often at his work address than the home address shown on the identity card. However, there was no legible address on the earlier photocopy card on file. Moreover, the work address in the letter was not that shown on the second photocopy card filed with the board. The board therefore held that the identity card evidence was inherently unreliable and inconclusive.

2.2.3 Title of the invention

Under R. 76(2)(b) EPC (R. 55(b) EPC 1973), the notice of opposition must contain, *inter alia*, the number of the patent, the name of the proprietor and the title of the invention. If the identification of the patent against which the opposition has been filed is insufficient, the opposition must be rejected as inadmissible under R. 77(1) EPC (R. 56(1) EPC 1973), unless the deficiency has been remedied before expiry of the opposition period.

In **T 317/86** (OJ 1989, 378) the opponent had not indicated the title of the invention within the period specified under R. 56(2) EPC 1973 (now R. 77(2) EPC). The board decided that omission from the notice of opposition of the title of the invention - merely an item of bibliographical data identifying the contested patent - did not constitute a deficiency within the meaning of R. 56(2) EPC 1973 (now R. 77(2) EPC), provided that the other particulars available to the EPO were together sufficient to identify easily and beyond doubt the patent being contested by means of an opposition.

In **T 344/88** the board of appeal considered whether the citing by the opponent of the wrong number for a patent specification contravened R. 55(c) EPC 1973 (now R. 76(2)(c) EPC), if the mistake was not corrected until after expiry of the opposition period. The first patent specification cited by the opponent bore no relation at all to the invention. However, the notice of opposition contained enough detailed information for it to have been possible to identify the actual patent specification intended. The board of appeal allowed the number to be corrected. Given such a detailed submission of facts, it would have been taking formal requirements too far to reject the opposition simply because the wrong number had been given for a cited patent specification. Whether or not the EPO actually effected a correction between receipt of the notice of opposition and expiry of the period of opposition was irrelevant. The sole decisive factor was that the error was recognisable within the period for opposition and that the opposition division was able, on the basis of the description of the citation, to establish the latter's identity beyond all doubt.

In **T 335/00** and **T 336/00**, the R. 55(b) EPC 1973 (now R. 76(2)(b) EPC) requirements were not strictly fulfilled. Among other things, the title of the invention was missing, and the opposition was directed to the application. The board nonetheless deemed the opposition admissible because the contested patent was identifiable uniquely and fairly easily on the basis of the specified publication number. Even the mistake of opposing an application and the omission of the title did not seem serious enough to the board to render the opposition inadmissible.

2.2.4 Payment of the opposition fee

R. 150(1), last sentence, EPC (Art. 99(1), last sentence, EPC 1973) states that a notice of opposition is not deemed to have been filed until the opposition fee has been paid. According to the board in **T 152/85** (OJ 1987, 191), payment of an opposition fee is thus a factual requirement, which must be fulfilled within the nine-month opposition period if an opposition is to be admitted. Failure to pay an opposition fee within the required period where the filing of an opposition is intended is a factual mistake which cannot be

rectified once the time limit for filing an opposition has passed. Nor could the failure to pay the opposition fee in time be rectified on the basis of R. 88 EPC 1973 (now R. 139 EPC). It was apparent from the wording of R. 88 EPC 1973 (now R. 139 EPC) that the clear policy of the EPO was to distinguish between a mistake in a document and other kinds of mistakes, such as failure to pay a fee in time, and only to allow correction of mistakes in a document.

2.2.5 Other requirements

In **T 193/87** (OJ 1993, 207) the board found that if a notice of opposition was filed in a language of a contracting state other than an official language of the EPO and the **translation** prescribed in Art. 14(4) EPC 1973 (now reworded and combined with Art. 14(5) EPC 1973) was not filed in due time, the notice should be deemed not to have been received, and the opposition fee was to be refunded (following **T 323/87**, OJ 1989, 343). Since the opposition had not come into effect, there was no question of examining its admissibility under R. 56(1) EPC 1973 (now R. 77(1) EPC).

In **T 960/95** the notice of opposition was filed **without having been signed**. The board stated that a notice of opposition should be duly signed (R. 36(3), first sentence, EPC 1973 in conjunction with R. 61a EPC 1973, now R. 50(3), first sentence, EPC in conjunction with R. 86 EPC). The omission of the signature was remedied within the time limit set by the opposition division, and the notice of appeal therefore retained its original date of receipt (R. 36(3), third sentence, EPC 1973, now R. 50(3), third sentence, EPC). Similarly, in **T 1165/03**, the board rejected the respondent's argument that the absence of a signature on the notice of opposition as filed was fatal because the opponent had remedied the deficiency by supplying a signature when invited to do so under R. 36(3) EPC 1973 (now R. 50(3) EPC). The question whether that or any other signature of the opponent on file was genuine might arise in the light of subsequent developments, but the file showed that a signed notice of opposition had ultimately been filed within the prescribed period.

2.3. Substantiation of the opposition

2.3.1 Legal basis for the opposition

The legal basis for opposition is Art. 100 EPC (substance unchanged), which contains an exhaustive list of grounds. Accordingly, opposition may only be filed on the grounds that the subject-matter of the European patent is not patentable, the European patent does not sufficiently disclose the invention or the subject-matter of the European patent goes beyond what was originally disclosed. Each ground for opposition listed in Art. 100 EPC corresponds to a requirement for grant laid down elsewhere in the EPC.

The Enlarged Board of Appeal set out a number of fundamental principles applicable in this area in **G 1/95** (OJ 1996, 615):

Whereas the grounds for opposition in Art. 100(b) and (c) EPC 1973 each related to a single, separate and clearly delimited legal basis on which an opposition could be based,

i.e. insufficient disclosure or unallowable amendment before grant, the same did not apply to Art. 100(a) EPC 1973. Art. 100(a) EPC 1973 not only referred to the general definition of patentable inventions under Art. 52(1) EPC 1973 and the exceptions to patentability under Art. 53 EPC 1973, but also to a number of definitions given in Art. 52(2) to (4) and 54 to 57 EPC 1973 for the terms "invention", "novelty", "inventive step" and "industrial application", which, when used in conjunction with Art. 52(1) EPC 1973, set specific requirements and therefore constituted separate grounds for opposition in the form of separate legal objections or bases for opposition. Taken together, Art. 52 to 57 EPC 1973 therefore did not, for the purposes of Art. 100(a) EPC 1973, constitute a single objection to the maintenance of the patent, but a collection of different objections, some of which were completely independent of each other (e.g. Art. 53 and Art. 52(1), 54 EPC 1973), and some of which might be more closely related (e.g. Art. 52(1), 54 and Art. 52(1), 56 EPC 1973). For an opposition to be admissible under Art. 100(a) EPC 1973, it had to be based on at least one of the legal bases for an opposition, i.e. on at least one of the grounds for opposition set out in Art. 52 to 57 EPC 1973.

One function of R. 55 and 56 EPC 1973 (now R. 76 and 77 EPC) was to establish what the notice of opposition had to contain in order to be admissible. R. 55(c) EPC 1973 specified that the notice of opposition had to contain a statement of the extent to which the European patent was opposed and of the grounds (i.e. the legal reasons mentioned above) on which the opposition was based and an indication of the facts, evidence and arguments presented in support of these grounds, i.e. the substantiation. The wording of (c) showed clearly the distinction made between the grounds, meaning the legal reasons or legal bases such as those under Art. 100(a) EPC 1973 and the substantiation. Accordingly, in the context of Art. 99 and 100 EPC 1973 and of R. 55(c) EPC 1973, a "ground for opposition" had to be interpreted as meaning an individual legal basis for an objection to the maintenance of a patent. It followed in particular that Art. 100(a) EPC 1973 contained a collection of different legal objections (i.e. legal bases), or different grounds for opposition, and was not directed to a single ground for opposition.

2.3.2 Need to indicate facts and evidence

A formal requirement for the admissibility of the opposition is substantiation of the specified ground.

Under R. 76(2)(c) EPC (R. 55(c) EPC 1973) the notice of opposition must contain three items: a statement of (i) the extent to which the European patent is opposed and (ii) of the grounds on which the opposition is based as well as (iii) an indication of the facts, evidence and arguments presented in support of those grounds. For the opposition to be admissible, it is sufficient that one of the grounds for opposition fulfils the requirements of R. 55(c) EPC 1973. Nowhere in the EPC is there any basis for the concept of partial admissibility of oppositions. The concept of "inadmissibility" is only applicable to the notice of opposition as a whole (as held in **T 653/99**; see also **T 212/97** and **T 65/00**). The boards have already set out the circumstances in which the **third requirement** of an indication of the facts, evidence and arguments is met. If it is met, the opposition is deemed to be sufficiently "substantiated" and thus admissible.

The question whether a notice of opposition meets the requirements in R. 76(2)(c) EPC must be determined on expiry of the nine-month opposition period. A notice objectively complying with the requirements **on the relevant date** is not rendered inadmissible where the opponent later cites prior art not mentioned in it to support his line of argument (**T 1019/92**; see also **T 104/06**).

According to the board in **T 182/89** (OJ 1991, 391), if a ground for opposition is alleged in the notice of opposition but not substantiated as required by R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) within the nine-month period for opposition, it had to be rejected on the same basis as if it were inadmissible under R. 56(1) EPC 1973 (now R. 77(1) EPC). If this approach was not taken, an opponent could easily abuse the procedure by alleging more than one ground, but supporting only one of them, in the notice of opposition; then, at a later stage in the opposition proceedings, he might bring forward facts and evidence in support of the other alleged grounds for opposition, thus causing delay and an increase in costs. In the board's view, this should not be allowable.

In **T 222/85** (OJ 1988, 128) the board of appeal held that the third requirement was only satisfied if the contents of the notice of opposition were sufficient for the opponent's case to be **properly understood on an objective basis**. The board reasoned that the purpose of the third requirement of R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) (in combination with the first two requirements) was to ensure that the notice of opposition set out the opponent's case sufficiently so that both the patentee and the opposition division knew what that case was. Whereas the requirements of R. 55(a) and (b) EPC 1973 (now R. 76(2)(a) and (b) EPC) and the requirements (i) and (ii) of R. 55(c) EPC 1973 could be considered as **formal** in nature, the third requirement of R. 55(c) EPC 1973, in combination with Art. 99(1) EPC 1973, was **substantive** in nature, and called for reasoning which went to the merits of the opponent's case. A well-drafted opposition ought to contain reasoning that was full but concise. And in general, the less reasoning that a notice of opposition contained, the greater the risk that it would be rejected as inadmissible. The board held that the question whether a particular notice of opposition met the minimum substantive requirements of Art. 99(1) EPC 1973 and R. 55(c) EPC 1973 could only be decided in the context of each individual case (since various relevant factors, such as the complexity of the issues raised, varied from case to case). Thus, depending upon the circumstances of each individual case, the requirement of R. 55(c) EPC 1973 would only be satisfied if there was sufficient indication of the relevant "facts, evidence and arguments" for the reasoning and merits of the opponent's case in relation to the grounds of opposition to be properly understood by the opposition division and the patentee. This had to be assessed on an objective basis, from the point of view of a reasonably skilled person in the art to which the opposed patent related (similarly **T 925/91**, OJ 1995, 469; see also **T 2/89**, OJ 1991, 51).

The issue of the sufficiency of the notice of opposition in this respect had to be distinguished from the issue of the **strength** of the opponent's case. On the one hand, an unconvincing ground for opposition might have been clearly presented and argued. Conversely, a deficient submission might be rejected as inadmissible even though, if properly drafted, it would have succeeded (see e.g. **T 621/91**, **T 3/95**, **T 152/95** and **T 1097/98**).

In **T 204/91** the board stated in particular that the term "indication" in R. 55(c) EPC 1973 had to be construed as requiring **more than a mere hint** at a number of possible attacks upon the patent and at the likely support for each such possible attack, which indication or hint might then be augmented by the subsequent late filing, possibly even at the appeal stage, of further evidence, arguments or other matter - even of fresh grounds of objection. Rather, the scope and depth of "indication" needed to be such as to enable the patentee and the opposition division to see clearly just what attack was being mounted against the patent, and what evidential support was being adduced for that attack. In other words, the patentee and the opposition division had to be put in a position of understanding clearly the nature of the objection submitted as well as the evidence and arguments in its support. This required the elaboration of the relevant circumstances of the case to such an extent that the patentee and the opposition division were able to form a definitive opinion on **at least one ground of opposition** raised, without the need to make further investigations (see **T 453/87** and **T 279/88**). The fact that a patentee must be able to understand, without undue burden, the case made against his patent in the notice of opposition does not, however, exclude the possibility that he may have to undertake a **certain amount of interpretation**, as was held in **T 199/92**.

In **T 934/99** the board stated that R. 55(c) EPC 1973 did not imply the requirement of a logical line of reasoning in the sense that the arguments brought forward in the notice of opposition had to be cogent or convincing. Rather, the criterion was whether the arguments presented were relevant and, where necessary as the result of a reasonable interpretative effort, specific enough to allow a person skilled in the art to form a reasoned opinion of whether the line of reasoning on which the opponent apparently relies was (logically) correct ("convincing") or not (i.e. wrong).

R. 76(2)(c) EPC (R. 55(c) EPC 1973) does not prescribe such a complete "indication of the facts, evidence and arguments presented in support" as to permit a conclusive examination on that basis alone (see **T 1069/96**). Likewise, the EPC does not require, for the admissibility of an opposition, that an argument brought in support of the opposition has to be conclusive in itself for it to be admissible. Considering the evidence is part of the process of ascertaining whether the opposition is well founded in substance. Under Art. 101(1), first sentence, EPC (Art. 101(1) EPC 1973) this can only be done if it has already been determined that the opposition is admissible (see **T 234/86**, OJ 1989, 79, **T 453/87** and **T 2/89**, OJ 1991, 51). In that connection, false statements in the notice of opposition cannot affect its admissibility. The statements made in the opponent's pleadings need not be true; the opposition division and the patentee simply have to be able to follow them. Either they ascertain that there is an error in the reference, or that the view taken in the opposition is wrong, or that there is no error and the view taken is correct. This is purely a question of the merits of the case (see **T 534/98**). In **T 353/06** the board differentiated between the corroborative value of the facts and evidence and the failure to indicate such facts and evidence in support of the grounds of opposition. It noted that establishing that the alleged prior use was indeed public, is a matter of proof and has little bearing on the admissibility of the opposition.

In **T 426/08**, the board examined the respondent's argument that, although evidence need not be produced but merely indicated by expiry of the opposition period, the admissibility of the opposition was not determined solely on the basis of the notice of opposition, but rather on the basis of the notice and the evidence indicated in it and produced either before or after the opposition deadline. Dealing with this argument, the board drew a distinction between evidence produced before and after the deadline and between indication and proof.

It was true that, when examining admissibility, the board could regard evidence produced before the deadline as serving as an indication, and in particular concretisation, of facts and/or evidence. However, it was irrelevant for the question of admissibility whether the content of such evidence could actually serve as proof of the facts. In any event, it would be unfair if there were a possibility that evidence produced by the opponent before the deadline in the absence of any obligation to do so - might act to its detriment, e.g. because it was inconclusive. For the purpose of examining admissibility, the board could not take account of evidence indicated during the opposition period but not produced until after the deadline as either an indication or proof of the facts. That would run counter to the wording of the EPC provisions applicable to the opposition procedure.

2.3.3 Various cases

a) Sufficient substantiation of the grounds for opposition

Several decisions of the boards of appeal considered in greater detail, when examining the admissibility of the opposition, what constitutes sufficient substantiation in the notice of opposition.

In **T 134/88** the opposition did not deal with all the features of the contested claim, but still satisfied the requirements of R. 55(c) EPC 1973 (now R. 76(2)(c) EPC). The board summed up by saying that an opposition directed against alleged lack of inventive step in the case of a combination invention was generally inadmissible if it related only to the assessment of one individual feature - to be admissible, it would have to deal with the invention as a whole, or at least with its **essential** content, so that when the facts on which the opposition was based were indicated, circumstances became recognisable which enabled the patent proprietor and the assessing body to pass conclusive judgment on the asserted grounds for opposition without having to make enquiries of their own (see also e.g. **T 1279/05**, **T 114/07**).

In **T 185/88** (OJ 1990, 451) the board ruled that grounds for opposition were in due form if the only document cited in support of the sole assertion of lack of inventive step (in this case a German patent specification), although actually published **after** the date of filing or priority, nevertheless contained a reference to a publication known **before** the date of filing or priority (in this case a German unexamined application or "Offenlegungsschrift").

In **T 406/92** the opponent had claimed in the notice of opposition that D4 reproduced in writing what had been presented orally at a conference. Reference to this conference was made in a footnote in D4. The opposition division rejected the opposition. In its

decision it argued *inter alia* that the talk represented as corresponding to document D4 could not be regarded as belonging to the state of the art in accordance with Art. 54(2) EPC 1973 (unchanged), as the footnote left open to what extent the talk corresponded to the later publication. The board decided that how accessible an oral description was to the public depended on the "how" (talk, discussion, radio or television programme, etc.) and the "where" (public conference, factory building, etc.). The notice of opposition had given information in this respect. Whether the said conference was actually public and whether the content of the talk really did correspond to the disclosure of D4 did not affect the **admissibility** of the opposition, but could be significant for assessing the **allowability** of the opposition in terms of substantive law. For these reasons the opposition was regarded as admissible (see **T 786/95**).

In **T 533/94** and **T 534/94** the correlation between the individual features of the claimed invention and the relevant passages of the prior art documents in the notice of opposition had been made in the form of tables and it had not been explicitly indicated what particular statements were alleged to destroy the novelty of the invention or form a basis for an argument on obviousness. The board found that this did not affect the notice's admissibility. The board observed that a notice of opposition was addressed to the opposition division and the patentee who were not only skilled in the art but also competent in examining novelty and inventive step. Thus, in the board's judgment, a detailed and exhaustive discussion of matters which were implicit to such skilled persons was not needed to understand the opponent's case and, therefore, not an admissibility requirement (see also **T 534/98**, in which it was held, with reference to the prevailing view in the case law, that substantiation of an opposition did not require proof of a claim concerning common general knowledge, unless the claim was called into question by another party or by the EPO).

In **T 521/00** the board had to assess whether the alleged opposition ground of insufficient disclosure pursuant to Art. 100(b) EPC 1973 (substance unchanged) had been substantiated in the notice of opposition. The appellant had referred to **T 65/00**, in which it was stated that, for an opposition to be admissible, it was sufficient that the arguments were such that an arguable case was established, it being irrelevant whether the arguments brought forward by the opponent referred to Art. 84 or 83 EPC 1973. The board admitted that this statement would cover the case under consideration, but could not concur with it. According to the board, the mere establishment of an arguable case would not comply with R. 55(c) EPC 1973 (now R. 76(2)(c) EPC), which required that an indication of the facts, evidence and arguments be presented in support of the alleged opposition grounds. This provision should not be undermined by lowering its requirements even more, as the Enlarged Board had stressed its significance in **G 9/91** (OJ 1993, 408) and **G 10/91** (OJ 1993, 420). The board therefore preferred to follow **T 134/88** (see above), in which it had been found that allegations which could not be subsumed under one of the opposition grounds had to be left out of consideration.

In **T 864/04** the respondents had raised the objection that the opposition was inadmissible because the notice of opposition solely relied on evidence that was not as a matter of law able to support the objections made because it did not form state of the art under Art. 54(1) or 56 EPC 1973 (unchanged). Later reliance on corresponding evidence

whose identification required some investigation could not cure this defect. In later submissions the respondents explained that the opposition division was wrong when it regarded D1a as "cited" in the notice of opposition as there was not a "clear reference to the relevant previous publication", "apparent at first sight" in the meaning of **T 185/88** (OJ 1990, 451, see above). Thus, according to the respondents there was an undue burden on them to find out which application had been published before their patent application. However, the board noted that the cited case law, **T 185/88**, was an application of Art. 99(1) EPC 1973 (substance unchanged) and R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) to the specific circumstances of the case where there was a confusion of documents, i.e. a document had been erroneously cited instead of the corresponding unexamined application. It was clear that the facts of the current case with respect to the situation of D1a were totally different and the question did not arise therefore in the same terms. Rather, the point to assess there with regard to the question whether document D1a was appropriately identifiable evidence was whether its express mention in the notice of opposition in relation to D1 was sufficiently precise to enable the reader (in that case the patentee) to find out the date of the publication of this precise document. In the board's view, that was indeed the case because no undue burden was involved to discover D1a's publication date, D1a being the parent patent of D1.

The appellant (patent proprietor) in **T 1218/04** argued that the notice of opposition was clearly insufficient because, in its reply, it had had to speculate as to the opponent's possible lines of attack. The board, however, found that this was not an objective criterion for assessing whether the notice of opposition was sufficient within the meaning of R. 55(c) EPC 1973. In opposition proceedings, parties were free to choose the line of action they considered the best. The fact that, in the case before it, the patent proprietor had written a long reply in response to the short submissions in the notice of opposition was not in itself evidence that those submissions had been insufficient. The long reply might in fact be seen as an attempt by the patent proprietor to improve its defence by exploring all the attacks which the opponent might mount.

b) Insufficient substantiation of the grounds for opposition

In **T 448/89** (OJ 1992, 361) the board of appeal followed decision **T 222/85** (OJ 1988, 128) and rejected the opposition as inadmissible. The board held that the requirement under R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) for facts and evidence in support of the grounds to be indicated was not fulfilled if several different subject-matters were described in a document cited as prejudicial to novelty and it was neither stated nor readily discernible which of them incorporated all the features of the contested claim. In this case the objection of lack of inventive step had not indicated the facts, evidence and arguments. A general reference to all publications cited in the European search report was not enough if it was neither stated nor readily discernible which document was being presented in support of which argument.

The board in **T 545/91** based its decision on this case law, rejecting the opposition as inadmissible because, even though the submitted document relied upon contained 200 pages, the notice of opposition made no specific reference to any particular passages. Even if the opponent's contention were correct that an expert would immediately find the

relevant chapter in the index, the board held that further clarification was necessary as this chapter was 86 pages long and contained subjects not directly related to each other (see **T 204/91**).

In decision **T 550/88** (OJ 1992, 117) the board of appeal considered whether **national prior rights** could as a matter of law constitute "facts or evidence" relevant to the ground of lack of novelty under Art. 54(1) and (3) EPC 1973 (substance unchanged). If not, such facts and evidence did not support the ground for opposition which had been alleged and therefore did not satisfy the requirement of R. 55(c) EPC 1973 (now R. 76(2)(c) EPC). In the board's judgment, on the proper interpretation of Art. 54(3) EPC 1973, national prior rights were not comprised in the state of the art, and only prior European patent applications filed under the Convention could be considered as such under Art. 54(3) EPC 1973. The board of appeal decided in this case that the opposition was inadmissible because the only facts and evidence indicated in the notice of opposition were references to national prior rights.

In **T 182/89** (OJ 1991, 391) the board held that in order to establish insufficiency, a **mere statement** by an opponent that one example in a patent had been repeated once "exactly as described" without obtaining exactly the described results as set out and claimed in the patent was clearly in principle quite inadequate to discharge the burden of proof. Indeed, if a notice of opposition alleged insufficiency under Art. 100(b) EPC 1973 (substance unchanged) as the sole ground of opposition, and contained such a statement as the only indication of "facts, evidence and arguments" in support of this ground, there would, in the board's view, be good grounds for rejecting such a notice of opposition as inadmissible, on the basis that it contained no sufficient indication of facts and evidence which, **even if subsequently proved**, could provide legal and factual reasons for revoking the patent.

Similarly, in **T 511/02**, the question was raised as to whether the appellant (opponent) had fulfilled its duty of substantiation pursuant to Art. 99(1) EPC 1973 (substance unchanged) and R. 55(c) EPC 1973 (now R. 76(2)(c) EPC). The board considered the content of the notice of opposition, noting that the appellant had cited fitting instructions and instructions for use and installation and had indicated their publication date. Fitting and installation instructions did not generally bear a publication date but a coded or uncoded printing date, and were not therefore "published" in the true sense of the word but were made available to the public by being distributed with the product to be fitted or installed. In the board's view, therefore, the term "publication date" used by the appellant was at the very least misleading. The citations in the case at issue likewise did not indicate when and how the cited instructions had been made available to the public. Since this factor was crucial to the establishment of whether the citations formed part of the prior art and thus whether they could actually be cited against the patent, no adequate indication had been given of the relevant facts and evidence (see also **T 1271/06**).

In **T 522/94** (OJ 1998, 421) the board commented by way of obiter dictum on the significance of admissibility. The opponent had not set out enough facts for the opposition division to be able to determine the issues of novelty and inventive step. The

board stressed that admissibility of the opposition was an important aspect when checking the opposition as to formal requirements, and that to go into the merits of the case where there was a lack of admissibility could not be justified by the theory "that a patent cannot be maintained when its lack of validity strikes the eye". There was no such "eye-striking case" if the facts, evidence and arguments were insufficient. The requirement of admissibility was not to be circumvented by over-emphasising the ex officio principle and shifting the burden of establishing the case from the opponent to the opposition division.

2.3.4 Public prior use alleged in the opposition

a) Adequate substantiation of the relevant circumstances

In accordance with the Enlarged Board of Appeal's decision in **G 1/95** (OJ 1996, 615), alleged prior public use does not constitute a ground for opposition under Art. 100(a) EPC 1973 (substance unchanged) but is a fact cited to substantiate such a ground (**T 190/05**).

As stated above, a claim is deemed to be sufficiently substantiated if it can be understood by the EPO and the other parties without their having to investigate the matter themselves. Thus, the board will generally consider an allegation of public prior use only if it is sufficiently substantiated, i.e. where it can be readily seen how the public prior use took place (this was not the case in e.g. **T 6/86**, **T 329/86** and **T 78/90**). If an opponent wishes to rely upon prior use as being part of the state of the art for the purpose of Art. 54(2) EPC 1973 and as part of the legal and factual framework within which the substantive examination of the opposition is to be conducted, the notice of opposition must indicate within the opposition period all the facts which make it possible to determine the date of prior use, what has been used, and the circumstances relating to the prior use. In **T 538/89** the board stressed that the evidence specified could be submitted after expiry of the period for opposition since R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) only required that it be indicated (see also **T 752/95**, **T 249/98**). Nomination of a witness for a subsequent examination of the witness was deemed to constitute indication of evidence (see also **T 28/93** and **T 988/93**).

Public prior use is only adequately substantiated if specific details are given of what was made available to the public, where, when, how and by whom (**T 328/87**, OJ 1992, 701; **T 93/89**, OJ 1992, 718; **T 1002/92**, OJ 1995, 605 and **T 212/97**). In cases of alleged public prior use, particular substantiation is required in the notice of opposition. However, a distinction must still be made between examining the admissibility of the opposition and its substantive merit. Decisions **T 194/86**, **T 328/87** (OJ 1992, 701), **T 93/89** (OJ 1992, 718), **T 232/89**, **T 538/89**, **T 754/89**, **T 78/90**, **T 600/90**, **T 877/90**, **T 441/91**, **T 602/91**, **T 988/91**, **T 541/92** and **T 927/98** held that to be able to determine whether an invention has been made available to the public by prior use, the following circumstances have to be clarified:

(i) when the act of prior use occurred

(ii) what was made available to the public through that use

(iii) the circumstances of the act of use, i.e. where, how and by whom the subject-matter was made public through that use

Establishing that this prior use was indeed public has little bearing on admissibility (**T 1022/99**).

The issue the board had to resolve in **T 241/99** was whether, in the event of a purported **sale to a small, closed group of customers**, it was sufficient to indicate the buyers in the form "customers X, Y, Z ..." The board referred to case law under which a single proven sale without obligation to maintain secrecy was sufficient to render the sold article available to the public within the meaning of Art. 54(2) EPC (**T 482/89**, OJ 1992, 646). In such cases, however, the requirements of R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) were met only if the name and address of the sole buyer were indicated within the opposition period. The board therefore did not consider the encoded customer details in the computer printout (list of customer numbers) to be an indication of the customers' identity. The board further deemed that even the two witnesses called to prove the correctness of the computer printout were only likely to be able to say something about the circumstances in which it was generated. As, in the interests of legal certainty, it had to be possible to decide on the admissibility of an opposition on the basis of the file as it stood at the end of the nine-month opposition period, it was too much to ask of the patent proprietor and the opposition division that a called witness had to be heard first in order to find out whether he personally knew anything at all about the circumstances of the sale that might be evidence of availability to the public. The board therefore dismissed the opposition as inadmissible.

For more details on the evaluation of evidence in the case of alleged public prior use, see Chapter VI.H.4.3.1, law of evidence.

b) Examination by the EPO of its own motion

Under Art. 114 EPC 1973 (unchanged) the EPO has a limited obligation to undertake an examination of its own motion with regard to public prior use.

In **T 129/88** (OJ 1993, 598) the board noted that although a board of appeal had an obligation under Art. 114(1) EPC 1973 (unchanged) to investigate matters of its own motion, that obligation did not extend as far as investigating an allegation of public prior use, where the party previously making that allegation had withdrawn from proceedings and it was difficult to establish all the relevant facts without that party's co-operation. The reason for this was that the obligation to investigate of its own motion imposed on the EPO by Art. 114(1) EPC was not unlimited in its scope, but was confined by considerations of reasonableness and expediency. Therefore, if the opponents withdrew the opposition, thereby indicating that they were no longer interested in the outcome of the opposition, then, although the EPO might have the power, depending on the state of residence of relevant witnesses, to compel them to give evidence, either before the EPO or before the court of a contracting state, in the interests of procedural economy it should

not normally investigate the issue any further. It would be different if a relevant public prior use had already been substantiated by documents of undisputed authenticity, or if the material facts with respect to the alleged public prior use were undisputed (see **T 830/90**, OJ 1994, 713; **T 887/90**, **T 634/91**, **T 252/93** and **T 34/94**).

2.4. Procedural aspects of the examination of admissibility

According to R. 77(1) EPC (R. 56(1) EPC 1973), if the opposition division notes that the notice of opposition does not comply with the provisions of R. 150(1) EPC (Art. 99(1) EPC 1973, i.e. the provisions governing, inter alia, the time limit for filing a notice of opposition), it must reject the notice of opposition as inadmissible.

In **T 222/85** (OJ 1988, 128) the board stated that a communication under R. 57(1) EPC 1973 (now R. 79(1) EPC) indicating the admissibility of an opposition was not a decision of the opposition division, and the sending of such a communication did not prevent the subsequent rejection of the notice of opposition as inadmissible under R. 56(1) EPC 1973 (now R. 77(1) EPC), for example if the admissibility was challenged by the patent proprietor in the proceedings (see also **T 621/91**).

In **G 1/02** (OJ 2003, 165), the Enlarged Board of Appeal examined whether a formalities officer was competent to decide on the consequences of late payment of the opposition fee and thus on the inadmissibility of an opposition. Taking the view that **T 295/01** (OJ 2002, 251) and **T 1062/99** were divergent, the President asked the Enlarged Board of Appeal to consider whether points 4 and 6 of the Notice of 28.04.1999 conflicted with provisions of a higher level (OJ 2002, 466). In the reasons for its decision, the Enlarged Board stated that the provisions of the Notices of the Vice-President DG 2 were valid on the basis of R. 9(3) EPC 1973 (now R. 11(3) EPC), under which formalities officers could be entrusted with duties falling to the examining and opposition divisions and involving no technical or legal difficulties. It therefore concluded that points 4 and 6 of the Notice of 28.04.1999 did not conflict with provisions of a higher level.

As soon as an opposition had been rejected as inadmissible, the opposition procedure was regarded as legally terminated and substantive examination could no longer be initiated. The inadmissibility of an opposition, when finally decided, or an appeal, had the effect of transferring the European patent to the national jurisdiction of the designated states, which then assumed sole responsibility for assessing the patent's validity with reference to their own legislation. The board therefore came to the conclusion that it was inconsistent with the procedural principle referred to above for the decision rejecting the opposition as inadmissible to consider that opposition's merits. Remarks on substantive matters in a decision rejecting the opposition as inadmissible had no legal effect. However such remarks should, on principle, be avoided as a procedural deficiency of this kind could result in legal uncertainty during the national phase and could disadvantage either the proprietor or the opponent (**T 925/91**, OJ 1995, 469; see also **T 328/87**, OJ 1992, 701).

3. Substantive examination of the opposition

3.1. Basic principles

In **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board held that R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) made sense only when interpreted as having the **double function** of governing (together with other provisions) the admissibility of the opposition and of simultaneously establishing the legal and factual framework within which the substantive examination of the opposition was in principle to be conducted.

The **legal framework** of an opposition case is defined solely by (i) the extent to which the patent is actually opposed and (ii) the grounds upon which it is opposed, whilst its **factual framework** is determined by the facts, evidence and arguments adduced and set out in the notice of opposition pursuant to R. 55(c) EPC 1973. It is thus self-evident that neither grounds not actually supported by such facts, evidence and arguments, nor claims not actually opposed (as distinct from being merely formally mentioned in the notice of opposition) can be properly regarded as making up the "legal and factual framework" of the opposition (**T 737/92**). A distinction has to be made between the two main requirements of R. 55(c) EPC 1973, i.e. the indication of the extent to which the European patent is opposed and the grounds for opposition.

3.2. Examination of the legal framework of the opposition

3.2.1 Extent of opposition

R. 150(1) EPC (Art. 99(1) EPC 1973) provides, inter alia, that "notice of opposition shall be filed in a written reasoned statement". R. 76(2)(c) EPC (R. 55(c) EPC 1973) requires the notice of opposition to contain, inter alia, "a statement of the extent to which the European patent is opposed". Opposition proceedings constitute an exception to the general rule under the EPC that a European patent after grant is no longer within the competence of the EPO but becomes a bundle of patents within the jurisdiction of the designated contracting states. Opposition proceedings are an exceptional procedure whereby, during a limited period of time, a centralised action for revocation of a European patent may be brought before and decided by the EPO.

With this background in mind, the board in **T 9/87** (OJ 1989, 438) held that an opponent's statement pursuant to R. 55(c) EPC 1973 of "the extent to which the European patent is opposed", in combination with the grounds of opposition, provided a definition of the issues raised by the opposition and, therefore, of the extent of competence of the EPO in relation to the examination of the opposed European patent under Art. 101 EPC 1973 (new Art. 101 EPC combines Art. 101(1) and (2) with Art. 102(1) to (3) EPC 1973).

The case law of the boards of appeal had for some time been divided on the extent to which the opposition division or a board of appeal could examine the patent in accordance with Art. 101 and 102 EPC 1973 (now merged in R. 101 EPC). Some boards had advocated that examination be restricted to the contested claims (e.g. **T 9/87**,

OJ 1989, 438 and **T 192/88**). Others had favoured unrestricted examination of the grounds for opposition and the claims in accordance with Art. 114(1) EPC (unchanged) (e.g. **T 156/84**, OJ 1988, 372; **T 266/87**, **T 197/88**, OJ 1989, 412; **T 493/88**, OJ 1991, 380 and **T 392/89**).

In **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board held that the requirement of R. 55(c) EPC 1973 to specify the extent to which the patent was opposed within the time limit prescribed by Art. 99(1) EPC 1973 (substance unchanged) would be pointless if, later on, other parts of the patent could freely be drawn into the proceedings. This would also be contrary to the basic concept of post-grant opposition under the Convention. Subject-matter not included by the opponent in his opposition was therefore not subject to any "opposition", nor were any "proceedings" within the meaning of Art. 114 and Art. 115 EPC (substance unchanged) in existence concerning the non-opposed subject-matter. Consequently, the EPO had no competence to deal with them at all (see **T 443/93**).

However, the subject-matter of claims depending on an independent claim which had fallen in opposition or appeal proceedings could be examined as to patentability even if it had not been explicitly opposed, provided its validity was *prima facie* in doubt on the basis of information already available.

The possible effect of **G 9/91** (OJ 1993, 408) on the practice of the boards of appeal was discussed in **T 376/90** (OJ 1994, 906). As regards the requirement of R. 56(1) EPC 1973 in conjunction with R. 55(c) EPC 1973 (now R. 77(1) in conjunction with R. 76(2)(c) EPC) that the notice of opposition contain a statement of the extent to which the European patent is opposed, the board proceeded on the accepted principle that statements were to be interpreted in the way that an addressee would understand them, taking into account the surrounding circumstances (see, in this respect, **T 1/88**, in which the board based its interpretation of equivocal procedural acts on the "objective value of the explanation"). However, the board added that, although it had been the general practice, where patents were opposed without an explicit statement of the extent to which they were opposed, to interpret the absence of such a statement as an indication of the opponent's intention to oppose the patent concerned in its entirety, the continuance of this "liberal" practice appeared questionable in the light of **G 9/91**. Indeed, in the extreme case where the extent to which a patent was opposed was in serious doubt, this might lead to a rejection of the opposition as inadmissible. However, this legal point was not decided in the case in hand because there could be no such serious doubts in the circumstances.

The following gives an account of some specific board decisions in this area:

In **T 1019/92** the requirement of R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) was found to be met by an explicit request that the patent be revoked in its entirety. The board held that, in these circumstances, if an opponent requested revocation of the patent in its entirety, then the fact that no specific prior art material had been cited against a dependent claim did not exclude that claim from the opposition.

In **T 1066/92**, claims 3, 4 and 5 (out of ten) were challenged by an opposition. Rejection of these claims was requested on the grounds of lack of novelty and lack of inventive step. The opposition division maintained the patent in amended form only on the basis of claims 1 and 2 as granted. The patentee lodged an appeal against the decision. The board noted that neither within the time limit for opposition nor even later in the proceedings before the opposition division had the opponent made any specific request to extend the opposition to granted claims 6 to 10. The opponent expressed his opinion that Art. 114(1) EPC 1973 (unchanged) gave the opposition division the power to extend the opposition, especially if non-extension would result in the maintenance of claims which were obviously not patentable. The board stated that, following **G 9/91** (OJ 1993, 408), the opposition division had no power to extend the opposition to granted claims 6 to 10 and therefore was not entitled to revoke these claims. Apart from the fact that the board did not consider the subject-matter of granted claims 6 to 10 to be, *prima facie*, not patentable, the opponent's opinion was not supported by **G 9/91**. It further stated that the decision of the Enlarged Board left no room for any extension of the opposition beyond the statement under R. 55(c) EPC 1973 (point 10 of the reasons). The board saw no reason to deviate from the conclusions laid down in **G 9/91** and held that granted claims 6 to 10 should have been maintained by the opposition division. The decision to revoke the non-opposed claims was therefore *ultra vires* and had to be set aside.

In **T 114/95** the respondent (patent proprietor) contended that the appeal was not admissible in respect of the granted independent claim 4, because the appellant had not substantiated any reason in accordance with Art. 100 EPC 1973 (substance unchanged) in its notice of opposition against the subject-matter of this claim. The board held that if an opponent requested revocation of the patent in its entirety, it was sufficient to substantiate the ground(s) for opposition in respect of **at least one claim** of the patent for the requirements of R. 55(c) EPC 1973 to be met (see **T 926/93**, OJ 1997, 447; **T 1180/97**). R. 55(c) EPC 1973 did not refer to claims but rather required that the notice of opposition should contain a statement of the extent to which the patent was opposed. The board also found that there was no limitation set by the EPC on allowing an opponent whose opposition was considered admissible to support and use grounds, evidence and arguments for revocation of the patent that were submitted by other opponent(s). Therefore, in the case at issue, the appellant was allowed to rely on submissions for lack of inventive step brought forward against granted claim 4 by the other opponent, who did not appeal.

3.2.2 Scope of examination of the grounds for opposition

Proceedings before the EPO provided for in respect of European patent applications and patents are governed by the **principle of party disposition** (*ne ultra petita*), according to which the procedure is - with some exceptions - initiated on request, and the **principle of ex officio examination** laid down in Art. 114(1) EPC (unchanged), according to which the EPO examines the facts of its own motion and is not restricted by the arguments or requests of the parties (see **G 9/92**, OJ 1994, 875; **G 4/93**, OJ 1994, 875).

Certain restrictions have, however, been placed upon the principle of *ex officio* examination in order to make EPO proceedings clearer, accelerate them and therefore

limit the risks to the parties. The principle is likewise subject to restrictions with respect to the examination of the grounds for opposition, but this is less a question of competence than of a consistent application of procedural principles. In first instance proceedings the opposition division should examine **only those grounds** for opposition which the opponents have submitted within the time limit for opposition and have properly supported with facts and evidence. Grounds extending beyond this may only be considered in exceptional cases to which special conditions apply (**G 10/91**, OJ 1993, 420).

In **G 9/91** (OJ 1993, 408), the Enlarged Board of Appeal considered the extent to which an opposition division or board of appeal has the power to rule on the patentability of parts of a patent not challenged in the notice of opposition. It decided that opposition proceedings were pending only in so far as the patent was contested in the "statement of the extent to which the European patent is opposed" prescribed under R. 55(c) EPC 1973 (now R. 76(2)(c) EPC). Subject-matter not challenged in the statement was therefore not the subject of "opposition" within the meaning of Art. 101 and 102 EPC 1973 (new Art. 101 EPC combines Art. 101(1) and (2) with Art. 102(1) to (3) EPC 1973) or "proceedings" within the meaning of Art. 114 and 115 EPC 1973 (substance unchanged). Accordingly, the opposition division or board of appeal could only rule on the revocation or maintenance of a patent **to the extent** that it was contested in the notice of opposition.

In this connection, the Enlarged Board drew the following distinction: in the case of the extent to which the patent was opposed, it was a question of the formal competence of an opposition division or a board of appeal to deal with a non-opposed part, whilst the problems connected with the grounds for opposition were more concerned with the procedural principles to be applied where the European patent or part of it had been correctly opposed. Whilst the Enlarged Board could find **no legal basis** in Art. 114(1) EPC 1973 (unchanged) **for an obligatory review** of the grounds for opposition not covered by the statement pursuant to R. 55(c) EPC 1973 (now R. 76(2)(c) EPC), it did examine whether that article actually **empowered** the opposition division or board of appeal to investigate such grounds at all. It then held that an opposition division or a board of appeal was not obliged to consider all the grounds for opposition referred to in Art. 100 EPC 1973 (substance unchanged), going beyond the grounds covered by the statement under R. 55(c) EPC 1973. Exceptionally, however, the opposition division could, in application of Art. 114(1) EPC 1973, consider other grounds for opposition, which, *prima facie*, in whole or in part would seem to prejudice the maintenance of the European patent.

To reflect this case law, the wording of Art. 101(1) EPC was changed in the revised text to make it clear that the opposition division is **not necessarily** obliged to examine all the grounds for opposition ("at least one ground for opposition").

As regards the investigative power of the boards under Art. 114(1) EPC, read in conjunction with the proviso "*mutatis mutandis*" in R. 100(1) EPC (previously R. 66(1) EPC 1973), it is their judicial character that sets the limits to this power. To permit the shifting of the legal and factual framework of the opposition in appeal, in a

mistaken reliance on the wording of Art. 114(1) EPC (unchanged), read in isolation from the rest of the EPC, and in particular R. 100(1) EPC (R. 66(1) EPC 1973), would offend the legal principles contained and expressed in the EPC and explained in the case law of the Enlarged Board (see e.g. **T 737/92**).

Following the decision in **G 10/91**, the board held in **T 274/95** (OJ 1997, 99) that, if a ground for opposition was substantiated in the notice of opposition but was subsequently not maintained during the opposition division proceedings (in the case in question, a statement to that effect had been made by the opponent during oral proceedings), the opposition division was under no obligation to consider this ground further or to deal with it in its decision, unless the ground was sufficiently relevant to be likely to prejudice maintenance of the patent.

In **T 223/95** the appellant had argued that the opposition division should take steps of its own motion to establish by investigation the level of knowledge of the person skilled in the art. The board observed that such an investigative approach 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. In the board's opinion, it was unrealistic to suppose that the opposition division could seek, gather and select evidence in an entirely impartial fashion; herein lay an essential distinction between the functions of the examining divisions and the opposition divisions. For that reason it was the responsibility of the opponent himself to present to the opposition division the facts, evidence and arguments in support of the grounds on which the opposition was based.

3.2.3 Fresh grounds for opposition

a) Basic principles

In **G 1/95** and **G 7/95** (OJ 1996, 615 and 626; consolidated proceedings) the Enlarged Board of Appeal dealt with the meaning of the legal concept of "grounds for opposition" under Art. 100 EPC 1973 (substance unchanged). It noted that the function of this provision was to provide, within the framework of the EPC, a limited number of legal bases, i.e. a limited number of objections on which an opposition could be based. The Enlarged Board observed that, on the one hand, all "grounds for opposition" mentioned in Art. 100 EPC 1973 had their counterparts in other articles of the Convention. On the other hand, whereas the grounds for opposition in Art. 100(b) and (c) EPC 1973 each related to a single legal basis on which an opposition could be based, i.e. insufficient disclosure and unallowable amendment before grant respectively, the same did not apply to Art. 100(a) EPC 1973. Art. 100(a) EPC 1973 referred not only to the general definition of patentable inventions according to Art. 52(1) EPC 1973 (reworded), and to the exceptions to patentability according to Art. 53 EPC 1973 (reworded), but also to a number of definitions under Art. 52(2) to (4) EPC 1973 (reworded; paragraph (4) deleted and inserted into Art. 53(c)) and Art. 54 to 57 EPC 1973 (partly reworded, otherwise unchanged) ("invention", "novelty", "inventive step" and "industrial application") which, in conjunction with Art. 52(1) EPC 1973, defined specific requirements and thus formed

separate grounds for opposition. Taken together, these provisions (Art. 52 to 57 EPC 1973), in conjunction with Art. 100(a) EPC 1973, therefore did not constitute a single objection to the maintenance of the patent, but rather a collection of different objections or legal bases. For an opposition to be admissible within the framework of Art. 100(a) EPC 1973, it followed that it had therefore to be based on at least one of the legal bases for an opposition, i.e. on at least one of the grounds for opposition set out in Art. 52 to Art. 57 EPC 1973.

In considering the proper application of Art. 114(1) EPC 1973 (unchanged) during opposition appeal proceedings, the Enlarged Board of Appeal also decided on the meaning of the legal concept "**fresh ground for opposition**" as used **G 10/91** (OJ 1993, 420, point 18 of the reasons). It found that this term must be interpreted as having been intended to refer to a ground for opposition which was neither raised and substantiated in the notice of opposition, nor introduced into the proceedings by the opposition division in accordance with the principles set out in **G 10/91** (point 16 of the reasons).

In **G 1/95** (OJ 1996, 615), the Enlarged Board decided that, in a case where a patent had been opposed on the grounds set out in Art. 100(a) EPC 1973 (substance unchanged), but the opposition had only been substantiated on the grounds of lack of novelty and lack of inventive step, the ground of unpatentable subject-matter based on Art. 52(1) and (2) EPC 1973 (substance unchanged) was a fresh ground for opposition and accordingly could not be introduced into the appeal proceedings without the agreement of the patentee (see also the referring decision **T 937/91**, OJ 1996, 25).

In **G 7/95** (OJ 1996, 626), the Enlarged Board decided that, in a case where a patent had been opposed under Art. 100(a) EPC 1973 (substance unchanged) on the ground that the claims lacked an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty vis-à-vis the said documents based on Art. 52(1) (substance unchanged) and 54 EPC 1973 (amended) was a fresh ground for opposition and accordingly could not be introduced into the appeal proceedings without the agreement of the patentee. However, the allegation that the claims lacked novelty in view of the closest prior art document could be considered in the context of deciding on the ground of lack of inventive step (see also the referring decision **T 514/92**, OJ 1996, 270).

b) Individual cases

In **T 135/01**, the board took the view that the mere observation in the course of an opposition procedure, whether by a party or the opposition division, that the subject-matter of a claim was new having regard to the prior art did not mean that **lack of novelty** was thereby introduced **as a ground for opposition**. Thus an assessment of inventive step generally began with a determination of the point of novelty, which implied a finding that the subject-matter of the claim was new. Treating such a routine affirmation of novelty as introducing the opposition ground of lack of novelty would be tantamount to including the latter ground as an invariant concomitant of the opposition ground of lack of inventive step, which would be contrary to decision **G 7/95** (OJ 1996, 626). In particular,

the present board saw, as a requirement for affirming that lack of novelty was in substance raised in the opposition procedure as a ground for opposition, the presence of a contention, by a party to the proceedings or by a third party presenting observations pursuant to Art. 115 EPC 1973 (substance unchanged) or by the opposition division, to the effect that the subject-matter of a claim was not new having regard to some specific prior art.

According to the board's judgment in case **T 514/04**, the lack of novelty objection originally raised against claim 5, relating to a process for the preparation of a product, could not extend to the products obtained from this process, including the products to claims 1 to 4, and that consequently the lack of novelty objection raised against claims 1 to 4 for the first time before the board was a fresh ground for opposition.

In **T 928/93** the opponent had alleged that the patented subject-matter lacked novelty. This objection failed, because the subject-matter known in the art and the claimed subject-matter did not have the same features, although they showed the same effect. According to consistent case law, the disclosure of prior art does not extend to the equivalents of the subject-matter described therein. **Objections based on lack of an inventive step** were raised for the first time by the appellant (opponent) in his reply to the summons to oral proceedings. Having regard to the decisions of the Enlarged Board in **G 10/91** (OJ 1993, 420) and **G 7/95** (OJ 1996, 626), and since the respondent had also failed to give his consent, such a new ground for opposition was not to be taken into consideration.

In **T 131/01** (OJ 2003, 115), the patent had been opposed under Art. 100(a) EPC 1973 (substance unchanged) on the grounds of lack of novelty and inventive step, and the ground of lack of novelty had been substantiated pursuant to R. 55(c) EPC 1973 (now R. 76(2)(c) EPC). The board held that a specific substantiation of the ground of lack of inventive step was neither necessary - given that novelty was a prerequisite for determining whether an invention involved an inventive step and such prerequisite was allegedly not satisfied - nor generally possible without contradicting the reasoning presented in support of lack of novelty. The objection of lack of inventive step was thus not a fresh ground for opposition and so could be examined in the appeal proceedings without the agreement of the patentee.

In **T 635/06** the notice of opposition specified that the patent in suit was opposed for lack of novelty and inventive step as the respective boxes of the standard EPO form had been crossed and as the notice explicitly indicated both grounds. In the circumstances of the case it was not possible for the opponent to substantiate the ground of lack of inventive step by any analysis going beyond its arguments against novelty. The opponent was thus limited to the position that a comparison of the disclosed composition and the claimed subject-matter revealed no distinguishing feature, the presence of which would, however, be necessary for a detailed objection to inventive step. Hence, the ground of lack of inventive step was considered by the board to be sufficiently addressed and, thus, properly raised in the notice of opposition.

Other factors must be considered in cases in which **amended claims** are introduced:

G 10/91 (OJ 1993, 420) stresses that amendments must be examined fully for compatibility with the EPC. Thus, where the respondents (opponents) first raised an objection under Art. 100(b) EPC 1973 (substance unchanged) during the appeal proceedings to an amended claim, the appellants could not refuse permission to discuss the new ground (**T 27/95**).

In **T 922/94**, the board stressed that Art. 102(3) EPC 1973 in conjunction with R. 66(1) EPC 1973 (now Art. 101(3)(a) and R. 82 in conjunction with R. 100(1) EPC) conferred wide powers upon the boards to consider all possible objections under the EPC, pleaded or not pleaded, that might arise from an amendment of the claims originally filed. Although objections concerning the requirements of Art. 123(2) EPC 1973 (substance unchanged) were not expressly pleaded under R. 55(c) EPC 1973 (now R. 76(2)(c) EPC), but formed part of the opposition division's decision, the board held that the objection under Art. 123(2) EPC 1973 formed part of the legal framework of the decision under appeal and the appellant could not rely on **G 10/91** for its request not to admit this ground into the appeal proceedings.

The fact that amendments had been made to a claim in the course of the opposition proceedings did not allow an opponent to raise an admissible objection under Art. 123(2) EPC 1973 at the appeal stage in the absence of the patentee's agreement, if such objection resulted from an amendment made before grant and had not been originally raised as a ground for opposition under Art. 100(c) EPC 1973 pursuant to R. 55(c) EPC 1973 (**T 693/98**).

The introduction of a feature into an independent claim, which feature was present in the claims and in the description as granted, could not be considered as an amendment which legitimated the admittance of Art. 100(b) EPC 1973 as a fresh ground of opposition, which required that a European patent as a whole had to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (**T 1053/05**).

c) Scope of examination of new grounds for opposition

i) In opposition proceedings

In **T 736/95** (OJ 2001, 191) the ground referred to by the appellant under Art. 100(c) EPC 1973 (substance unchanged) had not been raised in the notice of opposition. The opposition division had decided not to admit the newly submitted ground, without giving the parties any indication that it considered it to be less pertinent. The question which then arose was whether the fresh ground could be examined at all under Art. 114(1) EPC 1973 (substance unchanged). Having regard to the Enlarged Board of Appeal's decisions in **G 10/91** (OJ 1993, 420) and **G 1/95** (OJ 1996, 615) and to the Guidelines for Examination in the EPO, the board concluded that the department of first instance at least had to examine whether a fresh ground was relevant. The aim of first-instance proceedings was to avoid invalid patents. Therefore, in the case in question, the opposition division ought first to have examined under Art. 114(1) EPC 1973 whether the ground raised under Art. 100(c) EPC 1973 could prejudice maintenance of the patent

before rejecting it as inadmissible. Since it did not do so, but based its refusal to admit the ground only on the fact that it had been raised late, the opposition division deprived the appellant of the opportunity to have the relevance of this ground, and thus its admissibility, examined on appeal.

In **T 433/93** the board held that, in all normal cases, if an opposition division decided to introduce a new ground for opposition into the proceedings in addition to the ground(s) for opposition which the opponent had raised and substantiated in the notice of opposition, this should be done in writing as early as possible in the proceedings. The written notification to the patent proprietor from the opposition division informing the proprietor that a new ground for opposition would be introduced into the proceedings should at the same time ensure that the proprietor was informed not only of the new ground for opposition (i.e. the new legal basis for the opposition), but also of the legal and factual reasons (i.e. its substantiation) that would in effect substantiate the new ground which would lead to a finding of invalidity and revocation, so that the proprietor was fully informed of the case which he had to meet, and had a proper opportunity to present comments in reply. If, in a very exceptional case, an opposition division decided for the first time during oral proceedings that a new ground of opposition should be introduced into the proceedings, it would in principle be appropriate, even during oral proceedings, for the opposition division to notify the proprietor in writing both of the introduction of the new ground and of the legal and factual reasons which substantiated such a new ground. In this way, possible misunderstandings would be avoided, and the notification would be part of the written file record of the case.

According to the board in **T 520/01**, where a ground was substantiated within the opposition period and the party which had raised the ground neither appeared at the opposition oral proceedings nor withdrew the ground, the ground had to be dealt with by the opposition division and could be taken up by other appellants in subsequent appeal proceedings.

ii) In appeal proceedings

New grounds for opposition may be considered only with the patent proprietor's consent (**G 10/91**, OJ 1993, 420).

According to **T 758/90**, it is not certain from **G 9/91** or **G 10/91** whether grounds for opposition which were considered by the opposition division on submission by one opponent only and then taken up by a different opponent as the sole appellant can only be examined by the board with the patentee's consent. However, the question was left unresolved as it was irrelevant for the decision on the case in hand. In **T 774/05**, however, the board decided to admit a ground not mentioned in the notice of opposition of the first opponent, but included in the notice of opposition of an opponent whose appeal was held inadmissible. In the opinion of the board, it could be derived from the wording of Art. 99(4) EPC 1973 (now Art. 99(3) EPC, wording unchanged), that even when there was more than one opponent, there was only a single opposition procedure and the same applied to opposition-appeal proceedings.

T 986/04 concerned further appeal proceedings following remittal to the opposition division by the board in the previous appeal proceedings, **T 1116/97**. In its notice of opposition and the first appeal proceedings, the opponent had raised objections under Art. 100(c) EPC 1973 (substance unchanged) which the opposition division considered unjustified, revoking the patent on other grounds. In the subsequent continuation of the opposition proceedings following remittal, the ground under Art. 100(c) EPC 1973 was not mentioned by any party, nor was it mentioned in the decision under appeal. It was first mentioned by the respondent in the subsequent appeal proceedings, and the appellant objected to its introduction. The board held that the ground could therefore only be considered if it had already been in the preceding opposition proceedings - in decision **G 9/91** (OJ 1993, 408) the Enlarged Board of Appeal had explained that the purpose of the appeal procedure was mainly to give the losing party the chance to challenge the decision on its merits. In the absence of a reassertion of this ground in the continued opposition proceedings and its consequent absence in the reasoning for the decision under appeal, the ground could not be considered to have been in the opposition proceedings leading to the current appeal proceedings and was thus a fresh ground for the appeal.

The boards have considered the effects of **G 10/91** (OJ 1993, 420) as regards the following problems: how to proceed where a ground for opposition has been examined by the opposition division of its own motion; and, how to proceed where a ground for opposition has been put forward during opposition proceedings but for some reason not examined by the opposition division.

If an opposition division has examined of its **own motion** a ground for opposition, then the board of appeal is empowered to rule on it (see e.g. **T 309/92**, **T 931/91**). In **T 1070/96**, the board found that, since appeal proceedings aimed at a judicial decision on the correctness of a first-instance decision, it was irrelevant which opponent raised a particular objection or whether this particular opponent was still party to the proceedings, provided that the objection was dealt with in the decision under appeal.

However, the mere reference to Art. 100(c) EPC 1973 (substance unchanged) in the decision under appeal did not imply that the corresponding ground for opposition was introduced into the proceedings, if the decision under appeal did not deal in a substantial way with this ground for opposition (**T 128/98**).

In **T 986/93** (OJ 1996, 215) it was held that a board of appeal is not barred from considering a belatedly submitted **ground of opposition** which had been **disregarded** by the opposition division pursuant to Art. 114(2) EPC 1973 (substance unchanged) if the board is of the opinion that the opposition division exercised its discretion in this respect wrongly. The board interpreted opinion **G 10/91** to the effect that "new grounds for opposition" meant all those grounds not put forward until the appeal stage, rather than those - as argued by the appellant - not submitted within the opposition period under R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) or else disqualified by the opposition division under Art. 114(2) EPC 1973.

In **T 274/95** (OJ 1997, 99) the board held that a ground for opposition which was substantiated in the notice of opposition but which was subsequently **not maintained** before the opposition division, if sought to be re-introduced during appeal proceedings was not a "fresh ground for opposition" within the meaning of opinion **G 10/91**, and could consequently be re-introduced into the appeal proceedings without the agreement of the patent proprietor, in the exercise of the board of appeal's discretion.

In **T 101/00**, by contrast, the objection of insufficient disclosure was not substantiated in the notice of opposition and therefore not addressed in the decision on the opposition. The appellant (opponent) had not raised the objection until the oral proceedings before the board, when it referred to a passage in the notice of opposition. The board concluded that the objection had to be regarded as a fresh ground for opposition and therefore could not be considered. Neither the EPO nor the patentee was able, on the basis of the notice of opposition, to ascertain objectively and without any doubt that the opposition was actually intended to be based on Art. 100(b) EPC 1973 (substance unchanged) and what facts and evidence supported the objection.

The circumstances were different in **T 736/05**, in which - apart from a reference to "insufficient disclosure" in the notice of opposition and the related finding in the reasons for the contested decision - the objection of insufficient disclosure had twice been mentioned during the appeal proceedings before it was actually raised. The board rejected the objection. Although the contested decision contained the words, "It is requested to revoke the patent ... based on ... insufficient disclosure", the board nevertheless concluded that the objection constituted a fresh ground for opposition which could only be considered with the consent of the patent proprietor/respondent, on the basis of:

- (i) the EPO opposition form 2300 used to file the opposition, in which only lack of novelty and lack of inventive step had been ticked as grounds for opposition
- (ii) the opposition division's finding that there was no justification for an objection under Art. 100(b) EPC 1973 and
- (iii) the case law cited.

In **T 520/01** the board stated that, where a ground of opposition, here insufficiency, was **expressly not maintained** in opposition oral proceedings by the only party which had relied on the ground, and the opposition division did not deal with the ground in its decision, the re-introduction of the ground in appeal proceedings constituted a fresh ground which, following opinion **G 10/91** (OJ 1993, 420) by analogy, required the permission of the proprietor. Even if, read strictly on its wording, **G 10/91** did not apply to withdrawn grounds which were originally sufficiently substantiated, the board found it necessary to consider an analogous application of the said opinion in the case before it with regard to its general approach towards matter not examined at first instance being (re-)introduced at the appeal stage. One important factor was the procedural results which could ensue. One likely effect would be that the case would have to be remitted to the department of first instance and the patentee would find himself again in exactly the

same position as at the start of the original oral proceedings before the opposition division. The board considered that such a possibility was not in accordance with the view expressed in opinion **G 10/91** that the patentee should not face unforeseeable complications at a very late stage in the proceedings. Such a possibility would be an unreasonable burden on the patentee and an open door to abuse (however, see also **T 1066/92**).

In the board's view in **T 798/05** the opposition division should at least have examined whether *prima facie* there were clear reasons to believe that the newly raised ground of non-reproducibility prejudiced the maintenance of the patent. The opposition division should also have discussed the issue with the parties. Yet as neither the minutes of the oral proceedings nor the opposition division's decision mentioned any such examination or discussion, the conduct of the proceedings constituted a procedural violation. The board further stated that the conditions for admitting late-filed evidence under Art. 114(2) EPC 1973 (substance unchanged) were not the same as those for late-filed grounds. Moreover, decisions could not be applied by way of interpretation to other situations to which they did not relate, nor could they be taken without any indication of grounds. A decision had to be substantiated by the department of first instance in such a way that the parties and the board could clearly comprehend the criteria on which it was based.

3.3. Examination of the factual framework of the opposition

In **T 1002/92** (OJ 1995, 605) the board stated that, when considering the admissibility of a further ground for opposition not covered by the notice of opposition after expiry of the opposition period, both before an opposition division and before a board of appeal, the Enlarged Board was necessarily implicitly considering the admissibility of such a fresh ground in combination with at least an indication of the **fresh facts and evidence** intended to support it. The mere stating of a fresh ground without any indication of the fresh facts, evidence and argument supporting it would obviously be inadmissible, either within or after expiry of the opposition period. It would be illogical to have one criterion for the admissibility of late-filed new facts, evidence and arguments in combination with a fresh ground, and a different criterion for judging the admissibility of late-filed new facts, evidence and arguments in support of a ground for opposition already covered by the opposition statement. Hence, in the board's view, it followed that the principles set out by the Enlarged Board in the opinion **G 10/91** (OJ 1993, 420) as underlying the admissibility of fresh grounds for opposition, were also generally applicable to the admissibility of late-filed new facts, evidence and arguments intended to support grounds for opposition already covered by the opposition statement.

Likewise, where amended claims were introduced in the opposition proceedings there could be no objection to the opponent's submitting new citations and new arguments against the new claims (**T 623/93**). The examination by the opposition division of a new submission justified in this way was in keeping with Enlarged Board of Appeal decision **G 9/91** (OJ 1993, 408, point 19 of the reasons).

In **T 154/95** the board ruled that in opposition or appeal proceedings it was basically irrelevant how an opponent came across documents or other evidence made available to

the public. Thus there was nothing to stop an opponent from citing a prior use invoked in the same case by another opponent whose opposition was inadmissible because it had been filed after expiry of the opposition period.

4. Amendments in opposition proceedings

4.1. Admissibility

4.1.1 Basic principles

Once a decision to grant has been issued, the European examination procedure is closed and the outcome is binding on the applicant and the EPO in so far as no further amendments - save for corrections under R. 140 EPC (R. 89 EPC 1973) - may be made. However, if an opposition is filed, the patent in suit may be amended. Although patent proprietors are not free to make such amendments at their discretion, because opposition proceedings are not a continuation of the examination proceedings, they are entitled under R. 80 EPC (R. 57a EPC 1973) - without prejudice to R. 138 EPC (R. 87 EPC 1973) - to respond to an opponent's objections by amending the description, claims and drawings, provided that the amendments are occasioned by grounds for opposition specified in Art. 100 EPC (substance unchanged), even if the respective ground has not been invoked by the opponent. The new provisions also apply to all proceedings pending on that date. R. 80 EPC is thus applied as *lex specialis* to amendments in opposition proceedings.

Any amendments made in opposition proceedings must be occasioned by the grounds for opposition specified in Art. 100 EPC 1973 (substance unchanged). It is not necessary, however, for the ground for opposition in question actually to be invoked by the opponent. For example, in opposition proceedings admissibly brought on the grounds of non-patentability, the patent proprietor can also submit amendments to remove added subject-matter (Guidelines D-IV, 5.3 - old version). In opposition proceedings, the patent proprietor may likewise file one or more alternative sets of claims on which the opposition division may base a decision to maintain the patent in amended form, listing those claims in order of preference (EPO Legal advice No. 15/05 (Rev.2), OJ 2005, 357).

In **T 1149/97** (OJ 2000, 259), the board took the view that the relevant EPC provisions could be regarded as reflecting the formal aspects of a procedural cut-off effect associated with the grant of a patent in the opposition phase. The grant of a patent in such a phase did not constitute a general cut-off point in that the patent had to be defended in unamended form, but amendments were admissible only as a reaction to actual or possible grounds of opposition or to conflicting earlier national rights. Compliance with the restrictions imposed by R. 57a and 87 EPC was thus a prerequisite for any further considerations as to possible substantive cut-off effects for amendments after grant during opposition proceedings. Such **substantive** cut-off effects, in the board's view, could only be based on Art. 123(3) EPC (see also Chapter III.B., amendments).

In **T 323/05** the board stated that R. 57a EPC 1973 (now R. 80 EPC) established a limit to the amendments which could be made to the patent in suit, namely the amendments had to be occasioned by grounds of opposition specified in Art. 100 EPC 1973 (substance unchanged), even if the respective ground had not been invoked by the opponent. Art. 84 EPC (unchanged) and R. 57a EPC 1973 were the two provisions which had to guide the patent proprietor when he was invited by the opposition division to adapt the description. In other words, the amendments had to be appropriate and necessary, and nothing more.

Amendments occasioned by **national prior rights** - which are not included in the grounds for opposition specified in Art. 100 EPC - are also admissible during opposition proceedings. The reference to R. 138 EPC (R. 87 EPC 1973), which as a general provision of the EPC 1973 also applies to opposition proceedings, makes this absolutely clear (see prior practice in **T 550/88**, OJ 1992, 117).

This was also confirmed by the board in **T 15/01** (OJ 2006, 153). In that case, the appellant had justified the filing of separate claims for Spain and Greece on the grounds that a number of claims as granted might be ineffective in Spain and Greece, since the reservations made by both contracting states under Art. 167(2)(a) EPC 1973 (now deleted) were still in force on the date of filing of the application. The board held that, although the EPC 1973 did not contain an explicit provision for the corresponding situation where an applicant or proprietor wished to take into account the reservation made by an EPC contracting state under Art. 167(2)(a) EPC 1973, it had been the established practice of the EPO from the very beginning to accept the filing of separate sets of claims for such contracting states. This practice had also been confirmed by the Enlarged Board of Appeal in **G 7/93** (OJ 1994, 775), in which the Enlarged Board of Appeal regarded such situations as an exceptional case in which amendments might be appropriate at a very late stage of the examination procedure. The technical board further made clear that the general purpose of R. 57a EPC 1973 (now R. 80 EPC) was to allow amendments only where they were made to overcome an objection against the validity of the European patent. It followed from the reference to R. 87 EPC 1973 (now R. 138 EPC) that, within the framework of the centralised opposition procedure before the EPO, amendments were also to be allowed where the patentee intended to overcome a possible ground of invalidity which only existed in respect of a particular contracting state. Thus, R. 57a EPC 1973 was not infringed by the formulation of a separate set of claims for a contracting state in which, due to a reservation made under Art. 167(2)(a) EPC 1973, certain product claims as granted would be considered invalid or ineffective.

Since the EPC does not provide for surrender of the patent in opposition proceedings, so that - even if they issue an express statement to that effect - patent proprietors cannot surrender their patent either wholly or in part during such proceedings, they can merely request that the patent be amended. In requesting that the **patent be maintained in a limited form**, a patent proprietor is merely attempting to delimit it to meet objections raised by the EPO or the opponents and does not, by virtue of such limitation, irrevocably surrender subject-matter not covered by the request as limited. In principle, the patentee proprietor is free to withdraw such a request at any time during opposition

proceedings or to amend it subsequently and, in particular, to resume a defence of the patent as granted, unless this would constitute an abuse of procedural law or the proprietor is prevented from doing so by the prohibition of *reformatio in peius*. This is established case law (see **T 123/85**, OJ 1989, 336; **T 296/87**, OJ 1990, 195; **T 155/88**, **T 225/88**, **T 217/90**, **T 715/92**, **T 752/93**, **T 1037/96**, **T 445/97**, **T 473/99**, **T 880/01**, **T 794/02**, **T 934/02**, **T 1213/05**, **T 1394/05**).

According to the case law in **T 123/85** (OJ 1989, 336), there is nothing to stop patent proprietors who have defended only a limited version of their patent in opposition proceedings from seeking to reinstate the patent as granted in any subsequent appeal proceedings. However, this is subject to the conditions laid down in **G 9/92** and **G 4/93** (OJ 1994, 875; accordingly, the position taken in **T 369/91**, OJ 1993, 561, is obsolete).

4.1.2 Filing date of amendments

R. 80 EPC (R. 57a EPC 1973) addresses the purely substantive aspects of the proprietor's entitlement to amend his patent, and does not specify the point in time up to which amendment is allowed; here existing practice remains unchanged. This restriction of the right to amend is in line with the object and purpose of opposition proceedings, and does away with the need for a discretionary provision like R. 137(3) EPC (R. 86(3) EPC 1973) (see Notice from the EPO dated 1.06.1995 concerning amendment of the EPC 1973, the Implementing Regulations and the Rules relating to Fees, OJ 1995, 409).

As already mentioned, the boards of appeal have derived, in particular from R. 79(1) EPC (R. 57(1) EPC 1973), the principle that the proprietor has no right to have amendments admitted in any stage of opposition proceedings. At the discretion of the opposition division or the board of appeal, amendments can be refused if they are neither appropriate nor necessary. In particular, late-filed amendments can be refused if they are not a fair attempt to overcome an objection made. In general, the question whether an amendment is appropriate can only be answered on the basis of its content, i.e. after it has actually been submitted. To refuse any further amendment is only appropriate if it is evident after various unsuccessful amendments that the proprietor is not seriously trying to overcome the objections but is only delaying the proceedings (**T 132/92**).

Claims filed late (i.e. just before or at the hearing) are subject to the same principles in opposition proceedings as in appeal proceedings. In **T 648/96** the amendments requested in oral proceedings before the opposition division were simply a response to arguments put forward. The board said EPO deciding instances have a discretion to consider documents (including claims) filed in particular during oral proceedings, if they respond to the instance's or the opponent's objections, or are clearly grantable. Undesirable delays in the proceedings should, however, be avoided.

In **T 382/97** the appellant (patentee) came up with three auxiliary requests only at the beginning of oral proceedings. The appellant tried to justify disregarding the time limit set by the opposition division under R. 71a EPC 1973 (now R. 116 EPC) by citing

R. 57a EPC 1973 (now R. 80 EPC) which, it asserted, "was created as a *lex specialis* for amendments during opposition proceedings" and did not "specify the point in time up to which the amendment is allowed". Indeed, the board agreed that R. 57a EPC 1973 explicitly established the patent owner's right to amend its patent according to the criteria laid down in that rule. However, the board could not accept the appellant's argument that the absence of a time limit in R. 57a EPC 1973 entitled a patent proprietor to submit amendments to its patent at any time, i.e. also during oral proceedings, without good reason. In the board's judgment, R. 57a and 71a EPC 1973 together governed the procedural preconditions for amendments to a patent by its proprietor before the opposition division, which amendments of course had to comply with Art. 123(2) and (3) EPC 1973 (substance unchanged): R. 57a EPC 1973 created the legal basis for amendment, and R. 71a EPC 1973 governed the deadline for doing so. The board emphasised in this connection that amendments not complying with a time limit set under R. 71a EPC 1973 might nevertheless be admissible if there were good reasons for their late submission. Finally, the board noted that the patent owner's right to amend its patent under R. 57a EPC 1973 did not equate to an automatic right to file additional auxiliary requests. Any amendment had to be carried out in the most expedient manner, which had to be established by the opposition division, taking into due account the interests of all parties.

In **T 463/95** the opposition division refused the main request to maintain the European patent in amended form, for the reason that claim 29 had been submitted only one week prior to the oral proceedings and was not clearly allowable because the subject-matter of claim 29 did not involve an inventive step vis-à-vis the prior art. The board noted that the opposition division exercised a discretionary power in relation to requests for amendment in oppositions before it, and stated that consideration of a new or amended independent claim could reasonably be expected when such a new or amended claim resulted from a combination of features taken from granted claims which had been specifically opposed, since the opponents should already be familiar with the subject-matter. The board further noted that the appellant (patent proprietor) had indicated that he had become aware of a possible infringement only at a late stage and that he had to defend his legal interest within the scope of granted claims. The board concluded that under these circumstances the opposition division should have asked the parties to comment on claim 29. Only if there was a substantial difference in the subject-matter of claim 29 could it have been rejected as inadmissible for not being clearly allowable. In the present case, however, the patentee was acting within the normal framework to salvage as much as possible after granted claim 1 had fallen.

4.1.3 Filing amended claims

The principles for dealing with amendments to opposed patents developed by the boards of appeal also apply to the filing of additional dependent or independent claims in opposition or subsequent appeal proceedings.

a) Filing of dependent claims (sub-claims)

The addition of new dependent claims which do not correspond to any claims as granted is not appropriate or necessary to overcome a ground for opposition and therefore impermissible (see e.g. **T 794/94**, **T 674/96**, **T 24/96**). As explained in **T 829/93** and **T 317/90**, the addition of a dependent claim is not a response to an objection that the claimed subject-matter is not patentable because it neither limits nor amends the subject-matter claimed in the relevant independent claim. The fact that dependent claims can serve as an important safety net should the corresponding independent claim ultimately be refused does not render it legitimate to add them to a remaining, broader independent claim in opposition proceedings.

In **T 711/04**, the board took the view that the decision in **G 9/91** (OJ 1993, 408) did not answer the question to what extent a patent proprietor may amend a non-opposed claim in opposition or appeal proceedings. Rather, it merely set out the legal and factual framework for substantive examination of the patent in suit. In accordance with those principles, not even the patent proprietor could propose amendments because the subject-matter of a non-opposed claim was not the subject of an "opposition" within the meaning of Art. 101 and Art. 102 EPC (new Art. 101 EPC combines Art. 101(1) and (2) with Art. 102(1) to (3) EPC 1973; R. 82 EPC) or "proceedings" within the meaning Art. 114 and Art. 115 EPC (substance unchanged). The Enlarged Board of Appeal had also found, however, that this basic principle was not directly applicable where the only subject-matter outside the specified scope of the opposition were dependent claims which had to be regarded as implicitly covered (see point 11 of the reasons). This exception for sub-claims was, the board found, entirely justified by the fact that a sub-claim combined with a main claim and requested as a new main claim had to be examined as to its form and substance in order to ascertain whether or not the combination of the claims had extended the protection sought. This also showed that the theoretical legal construct underlying the **G 9/91** decision, i.e. that there were no proceedings within the meaning of Art. 114 or Art. 115 EPC (substance unchanged), was untenable in the case in hand. A patent proprietor wishing to limit the patent to the subject-matter of a non-opposed sub-claim had to combine that sub-claim with the corresponding main claim. The non-opposed sub-claim was inevitably amended as a result, even if the amendment might appear to be a mere technicality.

b) Filing of independent claims

The case law described above is, in principle, equally applicable to cases in which new independent claims are filed in response to a ground for opposition.

In **T 610/95** the appellant failed to provide a reasoned argument to show that the filing of new independent claim 5 was indeed necessitated by a ground for opposition. The board referred to **G 1/84** (OJ 1985, 299), which made it clear that the opposition procedure was not designed to be, and was not to be misused as, an extension of the examination procedure. It would, in the board's opinion, contravene the principles set out in **G 1/84** if it was considered admissible to amend the text of a granted patent during opposition proceedings, while maintaining the sole independent claim under opposition, by

incorporating an additional new independent claim which as such had no counterpart in the granted patent and, accordingly, was neither the subject of substantive examination in the examination procedure nor open to opposition owing to its non-existence in the granted patent.

In **T 223/97** the board confirmed that the addition during opposition proceedings of one or more independent claims while maintaining the main claim in question could not be considered to be a restriction to the main claim in order to meet the ground for opposition raised against it. Thus the mere addition of new claims to the claims as granted was inadmissible because such amendments could not be said to meet a ground for opposition. These new claims were thus not admissible, even if they otherwise satisfied the dual conditions of Art. 123(2) and (3) EPC (substance unchanged). However, the replacement of one independent claim as granted by several, for example two, independent claims each directed to a respective specific embodiment covered by the independent claim as granted was admissible if the replacement was occasioned by grounds for opposition specified in Art. 100 EPC.

Referring to the above decision, the board held in **T 181/02** that only in exceptional cases could the replacement of a granted single independent claim by two or more independent claims be occasioned by a ground for opposition, for example in cases where a granted independent claim covered two specific embodiments. Such a situation might also arise if two granted dependent claims (e.g. claims 2 and 3) were linked in parallel to a single independent claim (claim 1). Then the filing of two independent claims (e.g. including the features of claims 1 and 2, and 1 and 3) might be possible (moreover thereby decreasing the number of claims).

However, in the case at issue, the board saw no reason why it should require two independent claims to overcome an objection based on Art. 100 EPC (substance unchanged). It was normally sufficient for the patentee to remain with a single independent claim solely by modifying the granted claim once, i.e. by adding one or more features to the granted single independent claim. Adding a second independent claim was in normal cases not needed to avoid revocation of the patent on the basis of the unmodified or modified granted single independent claim, and furthermore did not do anything to help avoid revocation (see also **T 610/95**).

The board in **T 263/05** (OJ 2008, 329) cited the above case law, adding that R. 57a EPC (now R. 80 EPC) did not prohibit an amendment to a granted patent containing a single independent claim whereby several independent claims were introduced if such an amendment was a necessary and appropriate response to a ground for opposition. When examining the amendments, the board did not have to decide whether the ground for opposition would occasion the replacement of a granted single independent claim by two or more independent claims only in "exceptional cases". Rather, it had to be asked in each individual case whether the proposed amendments were an appropriate and necessary response designed to avoid revocation of the patent and could thus be regarded as occasioned by the grounds for opposition. In the case in question, the board found that they were: they were derived from a combination of the claim under attack with other granted claims, a form of amendment which was usually the most appropriate

and the least likely to give rise to difficulties. Given that the patent proprietor was no longer able to file a divisional application, the board considered that it could not have framed a set of amended, dependent claims without giving up protected subject-matter which was not the target of the lack of novelty attack.

In **T 937/00**, the board made some observations concerning the filing of multiple independent claims in response to an opposition, the admissibility of subsequent amendments and the conduct of the opposition procedure in such cases. In response to the opposition, the patentee had filed two separate sets of claims, these sets respectively comprising 18 and 21 independent claims. The board referred to **G 1/91** (OJ 1992, 253), according to which the unity of invention did not come under the requirements which a European patent must meet. The board saw also no objection of principle to a patentee amending his claims in response to an opposition so that they comprised several independent claims directed to different subject-matters originally covered by a single generic claim of a given category, when such a claim could not be maintained.

However, the board noted in the case at issue that the filing of multiple independent claims directed to different inventions might unduly complicate and delay the opposition procedure, in particular when this filing was followed by a series of further amendments. An efficient and possibly complete examination of the opposition might for instance become virtually impossible if subsequent amendments were proposed in a piecemeal way rather than addressing all the objections raised by the other party as soon as these objections arose, if they manifestly gave rise to new issues, in particular if they introduced new claims which did not result from any combination of the claims in the granted version, or if they introduced features for which there was no unambiguous support in the application documents as originally filed. In the case in point, taking into consideration the exceptionally high number of independent claims introduced at the opposition stage and also the fact that the granted patent was based on no fewer than fourteen priority applications and that the subject-matter of the only two generic independent claims as granted lacked novelty in view of one of the appellant's own earlier patent applications, the opposition division's refusal to admit the subsequent amendments did not appear to be unduly unfair in the circumstances.

c) Application of Rule 43(2) EPC (Rule 29(2) EPC 1973) in opposition proceedings

R. 29(2) EPC 1973 has been renumbered as R. 43(2) EPC but its substance has not been amended. It provides that a European patent application may not contain more than one independent claim in the same category unless they involve (i) a plurality of interrelated products, (ii) different uses of a product or apparatus or (iii) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

According to the board's view in **T 1416/04**, a request containing a plurality of independent product claims might be allowable under R. 57a EPC 1973 (now R. 80 EPC) in order to provide an amendment of a granted set of claims containing only one independent product claim, if the amended independent claims arose from the deletion

of previous claims. With regard to the form of the claims, the board did not consider it relevant for the case before it to decide whether R. 29(2) EPC 1973 applied to opposition cases or not: even if R. 29(2) EPC 1973 should be considered applicable, the subject matter in the granted claims could not appropriately be covered by one independent claim so that the requirements of this rule would have been met anyway. If R. 29(2) EPC 1973 were not considered applicable to opposition cases at all, by virtue of its wording which relates to a European patent "application" and not to a granted patent, then there could be no objection under this rule against the form of the claims.

In **T 1/05** the board did not regard the introduction of product-by-process claims as an amendment occasioned by a ground of opposition. The submission of such claims demonstrated that these amendments were not directed addressing a ground of opposition but were intended to compensate for the effects of an amendment that had been made to address such a ground, namely deletion of the product claims.

The scope and potential applicability of R. 29(2) EPC 1973 (now R. 43(2) EPC) in opposition proceedings was addressed thoroughly in **T 263/05** (OJ 2008, 329). Based on **G 1/91** (OJ 1992, 253), the board took the view that, in the case before it, it had to be determined whether it was still reasonable to require that the amended claims meet the requirements of R. 29(2) EPC 1973. Having considered the purpose and legislative history of the rule, the board concluded that it could not apply across the board to all amendments made during opposition proceedings. If it did, it would be impermissible to make any amendment introducing non-unitary claims, something which was not only permissible in opposition proceedings but also clearly appropriate given that the patent proprietor was no longer able to file a divisional application. To conclude that R. 29(2) EPC 1973 applied across the board in opposition proceedings would have watered down the decision in **G 1/91**. R. 29(2) EPC 1973 could not be applied in opposition proceedings to prohibit the amendment of a patent as granted where it would be unreasonable to demand that the amended claims comply with it. This was the case where, otherwise, R. 29(2) EPC 1973 would force the patent proprietor to abandon potentially valid subject-matter already contained in the claims as granted. The board could not envisage any circumstances in opposition proceedings in which R. 29(2) EPC 1973 would be of any application because, once it had been established that an amendment to the claims was necessary and appropriate having regard to grounds for opposition, it would inevitably be unreasonable to impose the additional requirement that the amendment complied with the purely administrative provisions of R. 29(2) EPC 1973.

4.1.4 Amendments intended to remedy a lack of clarity

Objections to the clarity of claims or any consequent requests for amendment are only relevant to opposition proceedings in so far as they can influence the decisions on issues under Art. 100 EPC (substance unchanged) or arise in relation to the subject-matter to be amended as a consequence of such issues. This was the view taken by the board in **T 127/85** (OJ 1989, 271), to which it added that it would be an abuse of opposition proceedings if the patent proprietor were allowed merely to tidy up and improve his disclosure by amendments not specifically necessitated by the grounds advanced for the opposition, even if those amendments were to comply with Art. 123 EPC 1973

(substance unchanged). This applied equally to amendments during opposition proceedings intended merely to clarify ambiguities in the claims or description.

According to R. 81(3) EPC (R. 58(2) EPC 1973) limited consideration of amendments is intended to help expedite and streamline opposition proceedings (see e.g. **T 406/86**, OJ 1989, 302; see also **T 24/88**, **T 324/89** and **T 50/90**).

In this connection, the board pointed out in **T 23/86** (OJ 1987, 316) that Art. 84 EPC 1973 (unchanged) was an EPC requirement relating to applications that under Art. 102(3) EPC 1973 (now Art. 101(3)(a) and R. 82 EPC) had to be taken into account in opposition proceedings whenever the patent proprietor made any amendments. However, Art. 84 EPC 1973 was not itself a ground for opposition under Art. 100 EPC 1973 (substance unchanged) - an opposition could not be based on the assertion that a patent claim was unclear under Art. 84 EPC 1973. In **T 792/95**, another board confirmed the principle that, in opposition proceedings and subsequent appeal proceedings, only such amendments could be made as were necessary in the light of the grounds for opposition under Art. 100 EPC 1973; it referred in this connection to **G 1/84** (OJ 1985, 299), according to which the opposition procedure is not designed to be, and is not to be misused as, an extension (or continuation) of the examination procedure.

In **T 113/86** the board of appeal followed this principle, ruling against the admissibility of amendments proposed by the patent proprietor which were not necessary to take account of the grounds for opposition invoked by the opponent under Art. 100 EPC 1973 or by the board under Art. 114 EPC 1973 (unchanged), if there were the slightest possibility of a different interpretation being given to the patent specification before and after the amendments. The protection conferred by the patent would actually be extended if, as a result of amendments to clarify the granted claims, the claims could be more widely construed than a court would have construed them by the application of Art. 69 EPC 1973 (substance unchanged). However, the board was of the opinion that the removal of an inconsistency between a claim and the description should be allowed if the inconsistency arose from an error, provided that the error was so obvious to a skilled person in the light of the patent specification as a whole that an interested third party could have anticipated the extent of protection conferred by the amended claim. In these circumstances the request for the correction of an error did not represent an abuse of opposition proceedings. Moreover, the removal of the discrepancy was in the interests of legal certainty.

However, where a deficiency results from a discrepancy between the description and the claim, lack of clarity in the invention's disclosure can be objected to because that requirement comes under Art. 83 EPC (unchanged), not Art. 84 EPC, and may therefore be taken into consideration in opposition proceedings (see e.g. **T 175/86**).

In **T 565/89** the board held that in opposition appeal proceedings the clarity of claims was irrelevant under Art. 102(1) EPC 1973 in conjunction with R. 66(1) EPC 1973 (now Art. 101(2), first sentence, in conjunction with R. 100(1) EPC), since this was not a ground for opposition under Art. 100 EPC 1973 (substance unchanged) ; it therefore refused to entertain a clarity objection to the claim in question. However, deciding on the

claim's patentability meant looking closely at its content and - under Art. 69(1) EPC 1973 (substance unchanged) - using the description and drawings to interpret it. This principle was followed inter alia by **T 89/89** and **T 62/88**. In **T 16/87** (OJ 1992, 212) where the patentee and the opponent disagreed on the interpretation of a term in a claim, the board also made it clear that Art. 69(1) EPC 1973 also applied to opposition proceedings when the meaning of a claim had to be objectively determined to assess the novelty and inventiveness of its subject-matter.

In **T 64/85** during opposition proceedings the patent proprietor had first amended his claim 1 and then asked as his main request that the patent be maintained as granted. The opponent was of the opinion that the patent proprietor had, by his amendments, abandoned certain subject-matter. Since both the opponent and the public ought to be entitled to trust that this subject-matter was no longer protected, such abandonment should not be reversible. However, the board took the view that the amendments made in this case did not affect any embodiment in the description or the drawings, with the result that they did not unambiguously limit the protection originally sought but rather clarified features which were already implicitly comprised in the description (**J 15/85** decision not applicable to this case). The board also held that an amendment made before the opposition division had commented on patentability could not be definitive (see also **T 168/99**).

In **T 684/02** the board considered whether subject-matter which had been deleted during the examination procedure in order to avoid inconsistencies in the patent specification could be reinstated in subsequent opposition proceedings. Reference was made to the previous case law in **T 1149/97** (OJ 2000, 259) and **T 37/99**, where the boards had concluded that the reinstatement of subject-matter which, in view of Art. 84 (unchanged) and 69 EPC 1973 (substance unchanged), had been deleted or indicated as no longer relating to the invention before grant in order to avoid inconsistencies in the patent specification should as a rule not be admissible under Art. 123(3) EPC 1973 (substance unchanged) after grant. Based on the reasons and considerations set out in the above decisions, the board stated that the particulars deleted from the patent application before grant and considered in the case at issue could not be reinstated with regard to Art. 123(3) EPC 1973.

4.2. Substantive examination of amendments

In all cases in which amendments are requested by a patentee which were compatible with Art. 123 EPC 1973 (substance unchanged), Art. 102(3) EPC 1973 (now Art. 101(3)(a) and R. 82 EPC) conferred on the opposition division and the board of appeal jurisdiction, and thus the power, to decide on the amended patent in the light of the requirements of the EPC as a whole (**T 472/88**). This jurisdiction was thus wider than that conferred by Art. 102(1) and (2) EPC 1973 (both now Art. 101(2) EPC) which expressly limited jurisdiction to the grounds of opposition mentioned in Art. 100 EPC 1973 (substance unchanged). When substantive amendments were made to a patent, both instances have the power to deal with grounds and issues arising from those amendments even if they were not (and could not be) specifically raised by an opponent

pursuant to R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) (**T 227/88**, OJ 1990, 292; see **G 9/91**, OJ 1993, 408; **T 472/88** and **T 922/94**).

Following the decision in **T 227/88**, the board in **T 301/87** (OJ 1990, 335) added that when amendments were made to a patent during an opposition, Art. 102(3) EPC 1973 required them to be examined to ascertain if the EPC 1973, including Art. 84 EPC 1973, was contravened as a result. However, Art. 102(3) EPC 1973 did not allow objections to be based upon Art. 84 EPC 1973 if they did not arise out of the amendments made. It would be somewhat absurd if making a minor amendment were to enable objections outside Art. 100 EPC 1973 to be raised which had no connection with the amendment itself.

The board also concluded in **T 367/96** that Art. 102(3) EPC 1973 did not allow objections of lack of support by the description of an amended main claim if said claim resulted in substance from the combination of claims of the patent as granted in accordance with the cross-references therein and thus concerns a specific object which as such was already claimed in the patent as granted.

The question whether and, if so, to what extent an opposition division or a board of appeal has the power to examine the clarity of amended claims derived from combinations of claims as granted was addressed in **T 1459/05**. The board decided not to follow the existing case law, according to which there is no power to examine under Art. 84 EPC where the amendments creating the lack of clarity consist of a combination of claims as granted which is in line with the correct cross-references. The board found that an exception had to be made in the case before it because the assessment of the claimed subject-matter depended on the technical significance of the sole added feature, since any difference from the prior art could only be defined on the basis of that feature. However, its technical significance was so unclear for the skilled person that any such difference was not apparent or at least could not be identified with a degree of uncertainty still reasonably acceptable to the skilled person. Irrespective of the circumstances of the specific case and in view of the sharp increase in the number of patent claims over the preceding years, the board also questioned the extent to which the clarity of all possible combinations claimed in a complex set of claims was - or even could be - examined so thoroughly before grant that it could be assumed that all clarity problems had been resolved, with the result that further examination in opposition proceedings could ultimately be dispensed with. The board held that it had to be able to exercise its discretion and deviate, exceptionally on a case-by-case basis, from the general practice ruling out any power of examination under Art. 84 EPC in the case of combinations of claims as granted. In particular, discretion had to be exercised where a strict application of the prescribed approach, which in principle excluded the raising of an objection on the grounds of clarity, would give rise to a situation in which a further examination of the patent documentation, e.g. in relation to novelty and inventive step, would be made considerably more difficult or might not even lead to a meaningful result.

In **T 656/07** the lack of clarity arose - at least in part - from the amendments that had been carried out after grant of the patent. The board held that this lack of clarity could be objected to in opposition proceedings because it was generated by the amendments

made during this procedure, even if the contested feature as such was already present in the claims as granted but in another combination. It was not enough to state that a feature was present in the granted version in order to limit the power of investigation of the board as far as clarity objections arising from an amendment was concerned. It was also necessary to ascertain the effect produced by the amendments introduced into the claim as a whole since a feature of a claim was not to be seen in isolation, but through its interaction with the other features of the claimed combination. In the opinion of the board it could not be stated that there was a general rule in the jurisprudence that a combination of granted claims should not be challenged for lack of clarity. Whenever amendments were requested by a patentee in the course of opposition proceedings, Art. 101(3)(a) EPC conferred upon both the opposition division and the boards of appeal jurisdiction and thus the power to apply the whole of the EPC including Art. 84 EPC.

In **T 853/02** the patent at issue concerned a milking system for mammals. The respondent argued that the amended disclaimer, in so far as it attempted to exclude two-way valves, was not supported by the description of the patent in so far as this passage contemplated using a two-way valve as a variable pressure source. The board, however, considered that this objection did not directly relate to the amended disclaimer because it could have also been raised for the unamended disclaimer which also referred to the terms "without using a two-way valve pulsator". In other words, this objection did not concern the amendments that led to claim 1 of the main request but claim 1 of the patent as granted. Therefore, this objection represented an attempt to raise an objection under Art. 84 EPC 1973 to a feature already present in claim 1 of the patent as granted. Since Art. 84 EPC 1973 was not a ground of opposition, the board considered this objection as being inadmissible.

In **T 648/96** the board found that the opposition division's failure, in the contested decision, to address the substance of the opponent's "lack of clarity" objections to the amended documents was a substantial procedural violation; under Art. 102(3) EPC 1973 (now Art. 101(3)(a) and R. 82 EPC), it should have examined of its own motion whether the amendments complied with Art. 84 EPC 1973 (unchanged) and Art. 123(2) and (3) EPC 1973 (see also **T 740/94**).

4.3. Additional search in the case of amendments

In **T 503/96** the board considered the criteria for the need for an additional search in relation to restrictive amendments. It referred to the Guidelines B-III, 3.5 (old version), which state, "In principle, and in so far as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended...". The board stated that whether or not to commission an additional search in a particular case was a matter for the administrative discretion of the opposition division, but if an inappropriate criterion was invoked when exercising this discretion, doubt would inevitably be raised as to whether the discretion was reasonably exercised.

Since, in the case of amendment of the claims in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the

requirements of the EPC (**G 9/91**, OJ 1993, 408, point 19 of the reasons), it was not inappropriate for an opponent to make observations on a possible need for an additional search to enable this full examination to be carried out (Guidelines D-VI, 5 - old version). The judgment on whether an additional search was necessary and the obligation to perform this search if it was judged to be necessary were administrative matters for the EPO.

5. Procedural aspects

The sections below deal with board decisions on individual aspects of the opposition procedure, in particular cases relating to the grant or breach of the right to be heard and to acceleration of the proceedings in the case of pending infringement proceedings. The possibility of resuming opposition proceedings in the event of a **withdrawal of the opposition** (R. 60(2) EPC 1973; now R. 84(2) EPC) and the impact of such a withdrawal on opposition and appeal proceedings is dealt with separately in Chapter VII.C.2. For the case law on resumption of opposition proceedings in the event of **surrender or lapse** of the patent, see Chapter VII.C.6.2.

5.1. Principle of impartiality

Opposition divisions in inter partes proceedings should refrain from making suggestions to the parties.

In **T 293/92** the opposition division, instead of limiting itself to evaluating the parties' requests, took a more active role in that it suggested in a communication the wording of a claim thought to be allowable. The board stated that apart from being undesirable from the point of view of impartiality in inter partes proceedings, such suggestions might also lead to confusion as regards the provisional and non-binding nature of communications written in proceedings before the EPO. In the case in question, the opposition division, by suggesting an allowable independent claim, had led the parties to assume that the claims on file were not allowable; the opposition division's change of mind during the oral proceedings might be seen as rather unexpected and surprising for the parties.

5.2. Right to be heard

5.2.1 Principle of equal treatment and opportunity to make comments

In inter partes proceedings such as opposition proceedings the right to be heard is inextricably linked to the **principle of equal treatment**. Consequently, no party should be given preferential treatment in the number of times it is allowed to present its case orally or in writing. The opposition division is therefore required to ensure that the parties can exchange their submissions in full and have equal opportunity to comment on them. The fact that a full exchange of submissions takes up more time than a partial exchange of submissions does not justify the violation of a fundamental procedural rule. If the opposition division considers a multiple exchange of submissions expedient, it must give each party equal opportunity to comment. Thus, the opposition division may invite a party to submit a **rejoinder to the reply** to the notice of opposition, but in that case it is

obliged to invite the other party to **respond to that rejoinder**, after which it must decide again whether a third exchange of submissions is expedient. The fact that R. 79(3) EPC (R. 57(3) EPC 1973) leaves it to the opposition division, "if it considers it expedient", to invite the opponents to reply cannot be interpreted as an authorisation to derogate from the fundamental principles of equal treatment referred to above. The opposition division must exercise this discretionary power before starting a second exchange of submissions, i.e. before issuing the invitation to submit the rejoinder, as is made clear in R. 79(3) EPC (see **T 190/90**; and also **T 669/90**, OJ 1992, 739; **T 682/89** and **T 439/91**).

In **T 532/91**, another board likewise considered the principle of equal treatment; if the opposition division considered it expedient to start a **second exchange of submissions** and to indicate to the opponents the possibility of submitting a rejoinder, it was obliged to do so, **in the same way**, to the appellants (patent proprietors), so that the exchange of submissions could be completed and to place the parties on the same footing as regards the number of times they could present their arguments. The board failed to see why, during the same exchange of submissions, the opposition division had written to the opponents: "You are at liberty to file your rejoinder ..." and to the appellants: "Please take note", which could have led the latter to be unsure of their right to submit a rejoinder. Such inequality of treatment was incompatible with the principle of equal treatment - particularly since it was the patent proprietors who had been treated less favourably - and in itself constituted a procedural error.

In **T 789/95** the file contained no indication that a copy of the opponent's observations had been forwarded to the patent proprietor. It was therefore to be assumed that the communication of the observations to the patent proprietor had been omitted, in contravention of the Guidelines D-IV, 5.4 (old version). In the board's view, this constituted a substantial procedural violation, as it infringed the principle that all parties to proceedings must be accorded the same procedural rights.

In **T 678/06** the board found that the opposition division had not respected the principle of equal treatment for the parties: it had given the respondent's expert an opportunity to comment but had denied the appellant the right to hear his technical expert. Thus the appellant's technical expert had been unable to challenge the respondent's allegations. The respondent had been placed at an advantage. In inter partes proceedings, however, the right to be heard is inextricably linked to the principle of equal treatment. The opposition division was required to ensure that the parties were able to exchange their submissions in full and have equal opportunity to comment on them.

5.2.2 Invitation to file observations

a) "As often as necessary"

Art. 101(1) EPC (Art. 101(2) EPC 1973) reinforces the right to be heard laid down in Art. 113 EPC by requiring the opposition division, when examining an opposition, to invite the parties "as often as necessary" to comment, within specified periods, on its own communications or those filed by other parties. Where necessary, any communication to the proprietor of the European patent must contain a reasoned

statement covering all the grounds against the maintenance of the European patent (R. 81(3) EPC; R. 58(3) EPC 1973).

Art. 101(1) EPC does not require as a rule that the grounds for not maintaining the patent invariably be set out in a communication, but only if this is "necessary". Such "necessity" can arise only in efforts to establish the facts or in view of Art. 113(1) EPC. So the opposition division **must issue a communication only** if it considers this necessary, e.g. to take up **new** substantive or legal arguments or draw attention to points still requiring clarification. R. 81(3) EPC which merely contains instructions concerning the content of any communications that may have to be issued, adds nothing to the above consideration of principle. Accordingly, the provisions of Art. 101(1) EPC and R. 81(3) EPC cannot be interpreted as meaning that the opposition division is obliged in every case to issue at least one communication before giving its decision, unless it is necessary to do so on the basis of Art. 113(1) EPC (see e.g. **T 275/89**, OJ 1992, 126; **T 538/89**, **T 682/89** and **T 532/91**).

Not issuing at least one communication under Art. 101(2) EPC cannot in itself substantiate an allegation of infringement of the right to be heard under Art. 113 EPC (see e.g. **T 774/97**). For example, the boards see no need under Art. 113(1) EPC for the opposition division to announce its opinion in advance in a communication or to give a further opportunity to the patentee to declare whether he is interested in a limited patent if, despite having been informed of an additional objection of the opponent, he does not react but maintains his sole request for maintenance of the patent with the amended claims (see e.g. **T 165/93**). Nor is it necessary under Art. 113(1) EPC to give a party a **repeated opportunity** to comment on the argumentation of the EPO body, so long as the decisive objection against the contested procedural action remains the same (see e.g. **T 161/82**, OJ 1984, 551; **T 621/91**).

However, an invitation to file observations is required if the EPO intends to consider evidence filed late by an opponent in view of its relevance and the patent proprietor has not commented on such evidence. In **T 669/90** (OJ 1992, 739), relating to the use and terms of a previous EPO form, the board held that, if the EPO sent a communication which (on a reasonable interpretation) misled a party into believing that it was not necessary to defend its interests by filing observations in reply to new facts and evidence filed by an adverse party, and if such new facts and evidence then formed the basis for a decision adversely affecting the misled party, the latter had not had "an opportunity to present its comments" within the meaning of Art. 113(1) EPC 1973. Such a procedure was also not a fair procedure and was contrary to the principle of good faith governing relations between the EPO and parties to proceedings before it. The board did not agree with decision **T 22/89**, in which, in similar circumstances, the board had found that it could be inferred from the teaching of the document in question ("the relevance of the document existed beyond any doubt") that such a document would have a decisive role in the decision (see also **T 582/95**).

A violation of the principle of the right to be heard under Art. 113(1) EPC and of Art. 101(1) EPC in conjunction with R. 79(3) EPC (Art. 101(2) in conjunction with R. 57(3) EPC 1973) has also occurred if a patent is revoked in the absence of a prior

communication from the opposition division and the decision in question states that the claims include grantable subject-matter (e.g. **T 103/97**). The fact that the patentee had not requested oral proceedings was interpreted in the case in question as meaning that it had waived any further amendments to the claims.

b) Limitation of the parties' observations to the "necessary and expedient"

Whilst, in opposition proceedings, the patent proprietor has a right under Art. 101(1) in conjunction with R. 79(1) EPC (Art. 101(2) EPC 1973 in conjunction with R. 57(1) EPC 1973) to file observations on the notice of opposition, it is apparent from Art. 101(1) EPC and R. 79(3) EPC that observations of the parties are only admissible in so far as, in the exercise of its discretion, the opposition division considers them expedient. In other words, the parties should be invited to file observations and amendments only if such an invitation is "appropriate" and such observations should be limited to what is "necessary" in the light of the grounds submitted for the opposition (see **T 406/86**, OJ 1989, 302). It is namely in the interests of the efficient conduct of opposition proceedings that observations by parties should be properly limited to what is necessary and expedient (**T 295/87**, OJ 1990, 470; **T 7/95**).

In this context, the case law refers to the "general principles" applying to the opposition procedure (see communication of the EPO, OJ 1985, 272): The EPO's aim is to establish as rapidly as possible, in the interests of both the public and the parties to the opposition proceedings, whether or not the patent may be maintained given the opponent's submissions. It seeks to achieve this by means of a speedy and streamlined procedure, which implies firm control by the opposition division at all stages. This requirement must, however, be balanced against the need to allow the parties to present their cases adequately so that the correct decision can be made. The later version of the information from the EPO on the opposition procedure remains unchanged in this regard (see OJ 1989, 417).

5.2.3 Communication and invitation to file observations under R. 82(1) EPC (Rule 58(4) EPC 1973)

R. 82(1) EPC (R. 58(4) EPC 1973) provides that the opposition division is to inform the parties of the text in which it intends to maintain the patent and invite them to state their observations within two months if they disapprove of that text. The boards of appeal have frequently addressed the issue of when it is necessary to send the parties such a communication.

In **T 219/83** (OJ 1986, 211) and **T 185/84** (OJ 1986, 373) the board stated that, after oral proceedings in an appeal from opposition proceedings, the parties had to be sent a communication pursuant to R. 58(4) EPC 1973 only if they could not reasonably be expected to state their observations concerning the maintenance of the European patent in the amended form definitively during the oral proceedings. This case law was confirmed in several decisions (e.g. **T 75/90**, **T 895/90** and **T 570/91**).

In **T 446/92** it was stated that, in a case where a duly summoned opponent was not represented at oral proceedings, the decision of the board to maintain the contested patent in amended form in accordance with a request of the patentee submitted during those proceedings could nevertheless be given orally pursuant to R. 68(1) EPC 1973 (now R. 111(1) EPC) at the end of the proceedings, if no new facts or evidence were dealt with during the proceedings. Under these circumstances, the application of R. 58(4) EPC 1973 could be dispensed with because the patent in suit was maintained with an amended text emanating from and approved by the patentee (see, in this respect, **G 1/88**, OJ 1989, 189) and, furthermore, because the opponent's deliberate decision to refrain from being represented at oral proceedings before the board was to be regarded as being tantamount to a tacit abandoning of his right to present comments pursuant to Art. 113(1) EPC 1973 and R. 58(4) EPC 1973. In the previous decisions **T 424/88**, **T 561/89** and **T 210/90** the board did not send the parties/participants a communication pursuant to R. 58(4) EPC 1973, even though the appellants (opponents) had not attended the oral proceedings.

5.2.4 EPO communications to "take note" and sufficient time to submit a response

An invitation by the opposition division to file observations under Art. 101(1) EPC (Art. 101(2) EPC 1973) can be distinguished from a communication from the EPO in that the latter merely invites the recipient to take note. Communications, signed by the formalities officer and inviting the appellants to "take note" of the opponents' submissions, are not communications of the opposition division within the meaning of Art. 101(1) EPC, which require a period to be fixed for reply (normally four months; see Guidelines E-VIII, 1.2 - April 2010 version). It is at the discretion of the recipient to reply to this communication if he finds it necessary, having reviewed the significance of the material sent to him. If he intends to reply but for any reason is prevented from doing so within a reasonable period of time, then the appropriate action is to inform the opposition division of his difficulties (see **T 582/95**).

The boards of appeal have dealt in a series of decisions with the issue of fixing a reasonable period which provides the recipient of an EPO communication with an adequate opportunity to reply:

The right to be heard enshrined in Art. 113(1) EPC (substance unchanged) requires that the party concerned be given **sufficient time** to submit an adequate response if the EPO decides to communicate to a party to proceedings before it an objection raised by another party without an express invitation to reply within a specified time limit. Thus, a decision relying on such objections cannot be taken until an adequate period of time has expired in which the other party can be fairly expected to present its comments. The question regarding what period of time is sufficient for this purpose is a **question of fact** which has to be answered on the basis of the merits of each individual case. Since any time limit set by the EPO should not be shorter than **two months** (see R. 132 EPC, R. 84 EPC 1973), thus regardless of whether or not the action required within such a time limit is simple or can be performed immediately, normally, i.e. in the absence of any exceptional circumstances, an adequate period of time for presenting comments should not be shorter than that mentioned above (**T 263/93**). Thus, in **T 430/93**, the board found

that there had been a violation of the right to be heard where the respondent had been granted a total of five months to comment on the appellant's reply to the opposition, whereas the appellant was subsequently neither granted sufficient time (a few days) to file observations nor even invited to do so.

Exceptional circumstances in which a shorter period of time was held to be acceptable were mentioned in **T 275/89** (OJ 1992, 126). In this case, the objection was made that the interval between the notification to the patentee of a submission from the opponents and the date the decision was issued was too short to allow the appellant to file observations. The board noted that the opposition division had waited for somewhat longer than a month before taking its decision. In the board's view, in the case of a communication which was issued for information purposes only and which did not set a time limit for response, a period of **one month** (which in the present case was exceeded) sufficed as a rule to comply with the requirements of Art. 113 EPC. Moreover, the documents on which the decision under appeal was based had already been mentioned in the notice of opposition together with an assessment of their substantive and legal significance, so that the decision under appeal was not based on fresh matter.

In **T 494/95**, the board took the view that the interval of more than one month between the notification of the patent proprietor's reply to the opposition and the date of issuing the decision was sufficient to allow the appellant (opponent) a reasonable opportunity to present his comments, or at least to indicate an intention of so doing, or to request oral proceedings. In the board's view, it was clear from R. 57(3) EPC 1973 (now R. 79(3) EPC), from the EPO information "Opposition Procedure in the EPO" (OJ 1989, 417) and from previous decisions that, if oral proceedings did not take place and the decision was based solely on grounds on which the parties concerned had had an opportunity to present their comments, a decision could be taken without further notice upon expiry of the period allowed to the patent proprietor for submitting observations. Here, the board could not see that any procedural violation had occurred, as the decision was neither based on grounds unknown to the appellant (Art. 113(1) EPC 1973), nor was the opposition division invariably obliged under the EPC to set a time limit for the appellant's response to the patent proprietor's observations or to suggest that any such response should be made.

By contrast, in another case in which difficult technical questions had to be considered, not even a time period of about one month was considered sufficient to give the appellant a realistic opportunity to inform the opposition division of his intention to file a substantive reply and to ask for an appropriate time limit for this purpose, let alone to present substantive comments (**T 263/93**; see also **T 494/95**).

In **T 914/98** the board stated that the **seventeen-day** period which elapsed between the appellants receiving the reply of the respondents and the handing over of the decision to the EPO internal postal service was manifestly **too short** to give the appellants an adequate opportunity for comment. According to the board, in view of the case law the appellants could not reasonably have expected a decision to be issued so quickly.

5.2.5 Opportunity to comment - case groups

a) Opportunity to comment on new grounds of opposition

Art. 113(1) EPC, in which the requirement that the parties be heard is enshrined, provides that decisions of the EPO may only be based on grounds or evidence on which the parties have had an opportunity to present their comments. The term "grounds or evidence" in Art. 113(1) EPC should not be narrowly interpreted. In particular, in the context of the examination procedure the word "grounds" does not refer merely to a ground of objection to the application in the narrow sense of a requirement of the Convention which is considered not to be met. The word "grounds" should rather be interpreted as referring to the essential reasoning, both legal and factual, which leads to a refusal of the application. In other words, before a decision is issued, an applicant must be informed of the case which he has to meet, and must have an opportunity of meeting it (see **T 951/92**, OJ 1996, 53; see also **T 105/93**). This interpretation of Art. 113(1) EPC is equally applicable in the context of opposition proceedings: thus the patent proprietor must be informed (normally in writing) not only of the new ground of opposition (i.e. the new legal basis for the opposition), but also of the **essential legal and factual reasons** (i.e. its substantiation) which could lead to a finding of invalidity and revocation. Thereafter the patent proprietor must have a proper opportunity to present comments in reply to the new ground and its substantiation (see **T 433/93**).

In **T 656/96**, the opponent had based his opposition solely on the invention's purported lack of inventive step. However, lack of novelty was advanced as a ground for opposition for the first time in the oral proceedings and in the absence of the patent proprietor, who had previously informed the division that he would not be attending oral proceedings. The opposition division revoked the contested patent, even though it had not originally raised a novelty objection in its communication under Art. 101(2) EPC 1973 (now Art. 101(1) EPC). In such circumstances, the board referred to the case law of the Enlarged Board of Appeal distinguishing between the opposition ground of lack of novelty and that of lack of inventive step (**G 7/95**, OJ 1996, 626) and recognising the opposition division's competence to consider, exceptionally under Art. 114(1) EPC 1973 (substance unchanged), fresh grounds for opposition which, *prima facie*, appear, either in whole or in part, to prejudice maintenance of the European patent (**G 10/91**, OJ 1993, 420). In the case in hand, the board held that, particularly in the light of the opinion on novelty expressed in the communication from the opposition division, no *prima facie* case against maintenance of the patent could be gathered from the file, so that the appellant had been entitled to consider that the question of novelty would play no part before the opposition division. The appellant must therefore have been taken by surprise by the decision taken in his absence by the opposition division at the oral proceedings to revoke the patent on the grounds of lack of novelty, grounds on which he had not been asked, nor had any reason, to express an opinion.

In **T 270/94**, the board found that the opposition division had infringed Art. 113(1) EPC 1973 by preventing opponent 1, who had based its opposition solely on lack of novelty, from commenting on an opposition ground of lack of inventive step duly submitted by opponent 2 and communicated to all the parties in accordance with R. 57(2) EPC 1973

(now R. 79(2) EPC). Furthermore, the board observed that Art. 114(2) EPC 1973, relied on by the opposition division, was not applicable to the case, because it indicated only that the EPO could disregard late-filed facts or evidence, whereas the case in hand involved arguments put forward by one of the parties to the proceedings in relation to a ground of opposition submitted in due time by another party.

In **T 1164/00**, the board held that the opposition division was in principle entitled to introduce a new ground of opposition even at the late stage of oral proceedings, since, in its view, it was apparent that the patent in suit did not comply with the requirements of Art. 83 EPC 1973 (unchanged). However, in this case, the annex to the summons to oral proceedings did not contain any indication of the opposition division's intention to introduce a new ground of opposition, which meant that the appellant was made aware of the factual and legal reasons supporting the introduction of this new ground for the first time during the oral proceedings. The board therefore concluded that the appellant had not been notified in writing as early as possible and, not having been informed beforehand of the factual and legal reasons, had been taken by surprise and had not had a fair opportunity during the oral proceedings to prepare a proper defence against this new objection. In those circumstances, the opposition division ought to have adjourned the oral proceedings in order to give the appellant sufficient time, in accordance with Art. 113 EPC 1973 (unchanged), to prepare a suitable defence against the new objections (see also **T 433/93**, OJ 1997, 509 and **T 817/93**).

b) Opportunity to comment on uncontested claims

In **T 293/88** (OJ 1992, 220) the board found that the decision of the opposition division to revoke the patent without issuing any communication in advance disregarded the fact that the validity of claims 7, 9 and 10 had not been challenged at all and that the parties reasonably ought to have been given a further opportunity to fall back on that position in such circumstances. The onus of raising such related additional matter with the parties was on the opposition division under Art. 113(1) EPC 1973 (unchanged) - which it had not done in this case (unlike **T 9/87**, OJ 1989, 438; here it was held that the opposition division had no obligation to examine uncontested claims in different categories which related to different inventions).

c) Opportunity to comment on provisional opinions of the opposition division

In **T 558/95** the opposition division had issued two written communications before the oral proceedings stating that, "in the provisional opinion of the opposition division", the subject-matter described in the public prior use did not prejudice the contested patent within the terms of Art. 100(a) EPC 1973 (unchanged). The patent proprietor therefore found it "surprising" that detailed consideration was given to the public prior use during the oral proceedings. However, the board held that provisional opinions of this kind were not binding on the further proceedings. Especially in view of the fact that the opponent continued to elaborate his arguments against these comments by the opposition division, the possibility of a different assessment by the opposition division could not be ruled out from the start.

d) Opportunity to comment where the opposition is rejected as inadmissible

If an opposition is rejected as inadmissible but the division does not say why, thereby preventing the opponent from responding, it infringes his right to comment (**T 1056/98**).

e) Opportunity to comment after remittal to the department of first instance

Normally, where a document has been sent to one of the parties, said party is given sufficient time to respond thereto before a department of the EPO takes a decision (**T 263/93**). If the case is to be remitted to the department of first instance for further prosecution, the recipient of a document still has, in view of the remittal, the opportunity to contest the arguments put forward by the other party for the purposes of the remitted case (see **T 832/92**).

Under Art. 113(1) EPC 1973 (unchanged), the opposition division must expressly give the parties an opportunity to present observations after remittal to it of a case by a board of appeal for further prosecution on the basis of new evidence, even if submissions with respect to this new evidence have already been made during the preceding appeal proceedings (see **T 892/92**, OJ 1994, 664; see also **T 769/91**). In **T 120/96** another board shared this view and added that the term "opportunity" in Art. 113(1) EPC 1973 could only be given effective meaning by applying the principles of good faith and the right to a fair hearing. For such an opportunity to exist, it is necessary that the parties be expressly asked whether or not they wish to present, within a fixed period of time, their comments, or if, as in the case at issue, the parties have already made detailed submissions during the previous appeal proceedings, whether or not these submissions should be regarded as complete. On these grounds alone, the board found that the immediate termination of the opposition proceedings following the remittal, without any intervening communication announcing the resumption of proceedings, was inconsistent with Art. 113(1) EPC 1973.

The board also found it desirable for the opposition division to clarify whether any requests submitted originally, i.e. before the opposition proceedings had been interrupted by the appeal proceedings, were being maintained, modified or withdrawn, or whether further requests would be submitted. Following the established case law of the boards of appeal (see e.g. **T 892/92**, OJ 1994, 664), the board was of the opinion that further proceedings on remittal by the board of appeal ordering "further examination of the opposition" should be regarded as a continuation of the original opposition proceedings, particularly in view of the fact that the original interlocutory decision to maintain the patent unamended was set aside by the board and was therefore no longer legally effective. Consequently, the appellant's original requests - including his subsidiary request for oral proceedings - which had never been withdrawn or amended became effective again after remittal, so the opposition division should not have taken a decision adversely affecting the appellant without giving him an opportunity to present his case orally (Art. 116(1) EPC 1973; substance unchanged).

5.3. Acceleration of proceedings in the case of pending infringement proceedings

If the opposition division is unable to process an opposition case speedily on account of the amount of work in hand, the Guidelines D-VII, 1.1 (April 2010 version) stipulate that it should, in principle, process submissions in order of receipt. The Guidelines then list the exceptional cases in which an opposition must be given priority, as laid down in two EPO notices dated 19.05.1998 (OJ 1998, 361 and 362): the EPO will accelerate the processing of an opposition if it is informed by a party to the proceedings or by the national court or other competent authority of a contracting state that infringement actions are pending.

T 290/90 (OJ 1992, 368) gave the board of appeal the opportunity to comment on accelerated processing of oppositions and appeals. In a case involving seven oppositions, one had been rejected on formal grounds, leading the opponent to file an appeal on 12.04.1989. A communication under R. 69(1) EPC 1973 (now R. 112(1) EPC) stating that the opposition was deemed not to have been filed was issued on 2.06.1989, followed by a decision under R. 69(2) EPC 1973 (now R. 112(2) EPC) on 29.01.1990. The patent proprietor requested accelerated processing of the appeal because an infringement action was pending and, in view of the probable number of infringing products on the market, the longer the opposition proceedings took, the more difficult it would be for him to enforce the patent.

The board held that accelerated processing was a basic principle of procedural law. It was essential for patents to be enforceable in practice, and timing was often a matter of great importance for patent proprietors and their competitors. It was therefore important not only to rule on the appeal quickly but also to bring the opposition proceedings to a speedy conclusion. Hence, if several oppositions were filed and the admissibility of one of them was questioned, the opposition had to be processed up to the point where it was ready to be decided at the same time as the appeal was being examined, so that the opposition could be decided soon after completion of the appeal proceedings. Pursuant to Art. 106(1), second sentence, EPC 1973 (suspensive effect of appeal; unchanged), the potentially inadmissible opposition had to be considered admissible unless and until the board of appeal decided otherwise.

6. Decisions of the opposition division

6.1. Revocation of a European patent by way of a decision

In **T 26/88** (OJ 1991, 30) the board of appeal had to rule on an appeal against a formalities officer's decision to revoke a patent under Art. 102(4) EPC 1973 (now R. 82(3), second sentence, EPC) because the printing fee had been paid late. The board considered whether the revocation should have been issued in the form of a decision at all, concluding that the loss of rights under Art. 102(4) EPC 1973 had occurred by operation of law ("automatically") and that the formalities officer should have issued a communication concerning loss of rights in accordance with R. 69(1) EPC 1973 (now R. 112(1) EPC).

The President of the EPO took the matter up under Art. 112(1)(b) EPC 1973 (unchanged). In **G 1/90** (OJ 1991, 275) the Enlarged Board of Appeal stated that the revocation of a patent under Art. 102(4) and (5) EPC 1973 (now R. 82(3), second sentence and (2) EPC) **required a decision**. It drew a comparison between the various procedural stages (grant, opposition and revocation, in connection with the future Community patent) and concluded that the wording of the regulations clearly indicated in each case whether a decision or a communication had to be issued concerning the loss of rights under R. 69(1) EPC 1973 (now R. 112(1) EPC). The Enlarged Board also considered the issue of legal certainty and, in the light of the "travaux préparatoires" relating to R. 69 EPC 1973, discussed the question of when a loss of rights noted in accordance with that provision became non-appealable. It found that the procedure of pronouncing revocation by way of a decision led neither to legal uncertainty nor to misunderstandings. Whereas, in the grant procedure, there was a clear basis for the deemed withdrawal of an application, no such possibility existed with oppositions because the patent proprietor was unable to abandon his granted patent by making a declaration to the EPO. The Enlarged Board confirmed that it was up to the legislator to decide when to issue a communication pursuant to R. 69(1) EPC 1973, which is followed on request by a decision (R. 69(2) EPC 1973), and when a decision was not preceded by such a communication. If the EPC had laid down different provisions for grant and opposition, that did not constitute an inherent contradiction.

6.2. Interlocutory decisions

6.2.1 General

In **T 376/90** (OJ 1994, 906) the first question to be decided was whether the opposition was admissible, and whether it was correct for the preliminary decision on this point to be made appealable only together with the final decision. As to the latter point, the opposition division decided on the admissibility in an interlocutory decision within the meaning of Art. 106(3) EPC 1973 (now Art. 106(2) EPC), i.e. a decision which did not terminate the proceedings as regards one of the parties. In the board's view, according to the clear language of that provision, such an interlocutory decision could only be appealed together with the final decision, unless the decision allowed separate appeal. Whether to allow a separate appeal was within the discretion of the opposition division. The board held that this discretion under Art. 106(3) EPC 1973 was properly exercised by the opposition division with a view to enabling a decision on the substantive issues to be reached as soon as possible.

In **G 9/92** (OJ 1994, 875), the Enlarged Board of Appeal set out the implications of an admissible appeal against an interlocutory decision of the opposition division where the sole appellant is, on the one hand, the patent proprietor and, on the other, the opponent. If the patent proprietor is the sole appellant against an interlocutory decision maintaining a patent in amended form, neither the board nor the non-appealing opponent as a party to the proceedings as of right may challenge the maintenance of the patent as amended in accordance with the interlocutory decision. If, however, the opponent is the sole appellant against such an interlocutory decision, the patent proprietor is primarily restricted to defending the patent in the form in which it was maintained by the opposition

division in its interlocutory decision. The board may reject as inadmissible any amendments proposed by the patent proprietor as a party to the proceedings as of right if they are neither appropriate nor necessary.

6.2.2 Maintenance of the European patent as amended

The long-established practice of the EPO of delivering interlocutory decisions subject to appeal when a patent is maintained as amended was described in detail by the Enlarged Board of Appeal in **G 1/88** (OJ 1989, 189).

According to Art. 102(1) to (3) EPC 1973 (deleted; now Art. 101(2) and (3)(a) EPC) a decision on an opposition to a European patent can involve revocation of the patent, rejection of the opposition or maintenance of the patent as amended, the latter requiring the publication of a new European patent specification. Under Art. 102(3)(b) EPC 1973 (now R. 82(2) EPC) a prerequisite for maintenance of the patent as amended is that the printing fee be paid.

With these regulations in mind, the EPO very early on adopted the device of an interlocutory decision, for which there is no express provision, in order to establish in the first place the text of the amended specification. Only after this interlocutory decision has come into force are the fee for printing and a translation of the claims in the other official languages requested pursuant to R. 58(5) EPC 1973 (now R. 82(2) EPC). Once these requirements have been fulfilled what is then a non-appealable final decision on maintenance of the patent as amended is given and the new patent specification is published.

A decision to maintain the European patent - even an interlocutory decision - can of course only be given if there is a text "submitted or agreed" by the patent proprietor pursuant to Art. 113(2) EPC 1973 (unchanged). In that connection Art. 102(3)(a) EPC 1973 (now R. 82(1) EPC) states that it must be established, "in accordance with the provisions of the Implementing Regulations", that the patent proprietor approves the text. It has accordingly been standard practice for the EPO's opposition divisions always to proceed in accordance with the relevant R. 58(4) EPC 1973 (now R. 82(1) EPC) even where the text has already been "submitted or agreed" by the patent proprietor during the proceedings and rejected by the opponent.

Before **G 1/88** was issued, a board held in **T 390/86** (OJ 1989, 30) that Art. 102(3) EPC 1973 and R. 58(4) EPC 1973 did not preclude that an opposition division could, in the course of opposition proceedings, make a (final) interlocutory decision in respect of a substantive issue raised by the opposition, before the sending of any R. 58(4) EPC 1973 communication. What was precluded by R. 58(4) EPC 1973 was that the opposition division should "decide on the maintenance of the European patent" in an amended form without first informing the parties of the amended text in which it was intended to maintain the patent and inviting their observations. However, neither Art. 102(3) EPC 1973 (now Art. 101(3)(a) and R. 82 EPC) nor R. 58(4) EPC 1973 precluded an opposition division from giving **decisions on substantive issues** in the opposition before sending a communication under R. 58(4) EPC 1973, and before "deciding to

maintain the patent in amended form". For example, an opposition division could during the course of an opposition make a (final) interlocutory decision (either orally or in writing) that a particular proposed amendment contravened Art. 123 EPC 1973 (substance unchanged). Similarly, in the board's view, an opposition division could make a (final) interlocutory decision during the course of an opposition that the main claim, for example, of the opposed patent could not be maintained. Such a **substantive interlocutory decision** was not a decision actually to maintain the patent in amended form, but was preliminary to such a decision. The taking of such substantive interlocutory decisions during the course of opposition proceedings was desirable both in order to move the proceedings forward towards a conclusion, and, in appropriate cases as envisaged in Art. 106(3) EPC 1973 (now Art. 106(2) EPC), to allow a party to appeal such an interlocutory decision before the opposition proceedings were terminated. It was further held that in a case where a final substantive decision had been given, an opposition division had no power thereafter to continue examination of the opposition in relation to the issues which were the subject of that decision, either under R. 58(5) EPC 1973 (now R. 82(2) EPC) or at all. Further submissions from the parties relating to such issues were inadmissible.

In **T 89/90** (OJ 1992, 456) the opponents had lodged objections to an interlocutory decision which maintained the patent as amended. The board observed that the EPC contained no general rules as to when an interlocutory decision could or should be delivered. The relevant department therefore had to use its discretion in judging whether an interlocutory decision was appropriate in an individual case or whether the matter could only be settled in a decision terminating proceedings. This involved weighing up various considerations such as whether an interlocutory decision would accelerate or simplify the proceedings as a whole (clarifying a disputed question of priority, for example, could be of key importance for the form and length of the subsequent proceedings) and clearly also included the issue of costs. In the board's view, it was clear that the established practice of delivering appealable interlocutory decisions under Art. 106(3) EPC 1973 (now Art. 106(2) EPC) where a patent was maintained as amended was based on the weighing up of such cost aspects. The board concluded that this practice was both formally and substantively acceptable.

E. Appeal procedure

1. Legal character of appeal procedure

The provisions governing the appeal procedure are set out in Art. 106 EPC to Art. 111 EPC and R. 99 EPC to R. 103 EPC and in the Rules of Procedure of the Boards of Appeal. R. 100(1) EPC plays an important role since it stipulates that, unless otherwise provided, the provisions relating to proceedings before the department which had taken the decision impugned shall apply to appeal proceedings. (The substance of the previous R. 66(1) EPC 1973 has not been changed). This application by analogy is, however, not automatically permissible in every case and for every provision (**G 1/94**, OJ 1994, 787). Criteria therefore had to be established for when such an analogy was permissible and when not. To this end it was necessary to analyse the legal nature of the appeal procedure.

Appeal proceedings are wholly separate and independent from the proceedings at first instance. Their function is to give a judicial decision upon the correctness of a separate earlier decision taken by a department (**T 34/90**, OJ 1992, 454; **G 9/91**, OJ 1993, 408; **G 10/91**, OJ 1993, 420; **T 534/89**, OJ 1994, 464; **T 506/91**). In **T 501/92** (OJ 1996, 261) the board deduced from this principle that any procedural request or statement made by a party during proceedings in the first instance was not applicable in any subsequent appeal proceedings, and had to be repeated during the latter if it was to remain procedurally effective.

In decision **G 1/99** (OJ 2001, 381) the Enlarged Board held that the appeal procedure is to be considered as a judicial procedure (see **G 9/91**, OJ 1993, 408, point 18 of the reasons) proper to an administrative court (see **G 8/91**, OJ 1993, 346, point 7 of the reasons; likewise **G 7/91**, OJ 1993, 356). In an older decision (**G 1/86**, OJ 1987, 447), the Enlarged Board also addressed this question. In **G 9/92** and **G 4/93** (both OJ 1994, 875) it was decided that the extent of appeal proceedings is determined by the appeal.

These characteristics of the appeals procedure not only serve as criteria when assessing whether a provision may be applied analogously in individual cases; they also have general legal consequences in many respects. It follows from the characteristics set out by the Enlarged Board that the general principles of court procedure, such as the entitlement of parties to direct the course of the proceedings themselves ("principle of party disposition"), also apply to appeals (see **G 2/91**, OJ 1992, 206; **G 8/91**, **G 8/93**, OJ 1994, 887; **G 9/92** and **G 4/93**), that a review of the decision taken by the department of first instance can, in principle, only be based on the reasons already submitted before that department (**G 9/91**, **G 10/91**), and that the proceedings are determined by the petition initiating them (ne ultra petita) (see **G 9/92** and **G 4/93**). The Enlarged Board has also made it clear that the decision-making powers of opposition divisions, and of the boards in opposition appeal proceedings, are circumscribed by the statement under R. 55(c) EPC 1973 of the extent to which the European patent is opposed. They have no powers to decide and thus investigate anything extending beyond that statement (see **G 9/91**). This defined the sphere of application of Art. 114(1) EPC 1973, and clarified the distinction between the power to initiate and determine the object of proceedings, on the one hand, and the power to examine the facts then relevant, on the other. The individual procedural consequences and the Enlarged Board's decisions are discussed in greater detail below.

2. Suspensive effect of the appeal

Under (the unchanged) Art. 106(1) EPC, an appeal has suspensive effect. The Legal Board of Appeal defined this effect in **J 28/94** (OJ 1995, 742), in which a third party claimed entitlement to the grant of the patent and requested suspension of the proceedings for grant under R. 13(1) EPC 1973. The board took the view that the appeal's suspensive effect meant the contested decision had no legal effect until the appeal was resolved. Otherwise appeal would be nugatory.

Thus, if a decision refusing to suspend the publication of the mention of grant of a patent were appealed, publication should be deferred until the appeal was decided. If (as here) this was not possible for technical reasons, the EPO should take all necessary steps to advise the public that the mention of grant was no longer valid (see also **T 1192**, OJ 1993, 685).

The suspensive effect of the appeal was further expounded on in **J 28/03** (OJ 2005, 597). According to the Legal Board of Appeal, suspensive effect means that the consequences following from an appealed decision do not immediately occur after the decision has been taken. Actions normally taking place after a decision are "frozen". Suspensive effect does not have the meaning of cancellation of the appealed decision. Even after an appeal the decision as such remains and can only be set aside or confirmed by the board of appeal. Moreover, the status of a divisional application filed while an appeal against the decision to grant a patent on the parent application is pending depends on the outcome of that appeal.

According to **T 591/05**, the suspensive effect of an appeal was a direct consequence of, and was subordinate to the appeal itself (Art. 106(1) EPC 1973) and, consequently, no circumstance directly arising from the suspensive effect of the appeal could be invoked in support of the admissibility of the appeal itself.

3. Devolutive effect of the appeal

The provisions of Art. 110(2) and (3) EPC 1973 can now be found in R. 100(2) and (3) EPC respectively, substantially unchanged.

On appeal, the first instance loses its competence for the further prosecution of the application for all contracting states - the appeal does not leave a part of the application pending in the first instance. Thus, deemed withdrawal of the application pursuant to Art. 110(3) EPC 1973 applied in the case of a failure to reply to a communication pursuant to Art. 110(2) EPC 1973 in ex parte appeal proceedings, even where the decision under appeal did not refuse the application, but only a particular request. The board reasoned that even if the appealed decision concerned only the designation of a state and not the application as a whole, according to the principle of unity of the application and of the patent in the proceedings the suspensive effect of the appeal affected the application as a whole. Since it was bound by the Convention, a deviation from the clear wording of a provision of the Convention could only be considered if the provision was in breach of a higher legal principle or was purely arbitrary. The board decided it was not, as the validity of a designation was part of the grant procedure - the decision to grant had to identify the states for which the patent was granted (**J 29/94**, OJ 1998, 147).

The devolutive effect of the appeal does not affect the competence of the department of first instance to decide on a request concerning the contents of the minutes of the oral proceedings held before it. What is devolved is the subject-matter decided by the appealed decision (**T 1198/97**).

According to **T 1382/08**, the devolutive effect of an appeal before a board extends only to that part of the impugned decision which is indicated in the statement of grounds for appeal and actually challenged by the appeal. For the board, therefore, the extent to which the impugned decision is to be amended, as defined under R. 99(2) EPC, is simultaneously the limit of the devolutive effect. This in turn implies that the impugned decision's part not covered by the statement of grounds of appeal also cannot be part of the appeal proceedings and consequently becomes final on expiry of the time limit for appeal.

4. Language of the proceedings

The same language arrangements apply to appeals as to all other EPO proceedings. Under R. 3(1) EPC any party may use any EPO official language in written proceedings, and under R. 4(1) EPC any party to oral proceedings may use an official language of the EPO other than the language of the proceedings, provided he either gives the EPO at least one month's notice or arranges for interpreting into the language of the proceedings. These provisions remain substantially unchanged from the corresponding R. 1(1) and 2(1) EPC 1973 respectively.

In **T 34/90** (OJ 1992, 454) the respondent did neither. His representative argued that because he had lawfully used an alternative official language in oral proceedings before the opposition division, he should be allowed to use the same language in the hearing before the board. Although he did not actually say so, this plainly implied that appeal proceedings were simply a continuation of the first-instance (i.e. opposition) proceedings. From the principle that appeal proceedings were wholly separate and independent from first-instance proceedings for the purpose of deciding the admissibility of using an alternative official language under R. 2(1) EPC 1973 - and for other procedural purposes - the board inferred that a party could use such a language in oral proceedings before it only if he again gave the requisite notice (see also communication of the Vice-President DG 3, OJ 1995, 489).

In **J 18/90** (OJ 1992, 511) the board recognised that in written proceedings and decisions, organs of the EPO might also use an official language other than the language of proceedings, provided all parties to the proceedings had given their agreement (see also **T 788/91**).

In **T 706/91** the appeal had been drawn up in accordance with R. 1(1) EPC 1973 in one of the official languages, namely German. The appellant had therefore cited passages from the disputed European patent's claims and description in that language, even though they had been drawn up in French as the language of the proceedings. The board decided that these references were admissible (see also chapter VI.K.1, language privilege).

5. Procedural status of the parties

5.1. Parties to appeal proceedings

Under Art. 107, second sentence, EPC (unchanged in English and French), the parties to proceedings before the department of first instance are also parties to the ensuing appeal proceedings, even if they have not personally filed an appeal. Pursuant to Art. 99(3) EPC, opponents as well as the patentee are parties to opposition proceedings. In addition, Art. 105 EPC makes provision for intervention by the assumed infringer.

For other proceedings, the general principle applies that the parties to them are those whose legal interests are affected by the decision at issue. In **T 811/90** (OJ 1993, 728), for example, opposition proceedings had been concluded and the time limit for lodging an appeal had expired. Only the patent proprietor lodged an appeal, but against a separate decision on a point incidental to the opposition. It was held that the other party had no right to be a party to the appeal as he had not been a party to the relevant decision. However, in a decision concerning an appeal against a Legal Division decision refusing to suspend grant proceedings under R. 13 EPC 1973, the applicant was to be treated as a party to the proceedings. The request for suspension could not be separated from the grant proceedings. The applicant's legal position was directly affected by suspension, because for its duration he was denied the rights under Art. 64(1) EPC 1973 (**J 33/95**). According to **T 838/92**, nothing in the EPC 1973 enabled an opposition division or board of appeal to exclude a party from ongoing proceedings.

A patent applicant who was not heard when grant proceedings were suspended at a third party's request pursuant to R. 13 EPC 1973 could still challenge the justification for that suspension. He was a party as of right to any appeal proceedings initiated by the third party against rejection of the latter's request by the EPO (**J 28/94**, OJ 1997, 400).

In **T 643/91** the appeal of opponent 1 was rejected as inadmissible. Opponent 2 filed an admissible appeal. Opponent 1 was considered by the board to be "any other party to the proceedings" under Art. 107 EPC 1973 and, as a consequence, to be a party as of right in the appeal proceedings of opponent 2. However, in **T 898/91** it was held that an opponent whose opposition has been rejected as inadmissible by the opposition division and who has not filed an appeal against this decision is not entitled to be a party to any appeal by the patent proprietor, because he ceases to be a party to the opposition proceedings once the decision on the admissibility of its opposition takes full legal effect. Where a company is dissolved and thus ceases to be a legal person, it loses its capacity to be a party to any proceedings. If it was the original appellant, the appeal consequently lapses (**T 353/95**). However, a party's opponent or appellant status does not lapse merely as a result of bankruptcy proceedings being issued (**T 696/02**).

Where two opponents lodge appeals contesting different sets of claims and one subsequently withdraws its appeal, it becomes a party as of right under Art. 107 EPC and the other opponent becomes the sole appellant (see e.g. **T 233/93**).

Third parties commenting under Art. 115 EPC 1973 on the patentability of the invention claimed are not parties to the proceedings before the EPO. See also chapter VII.C.4, Article 115 EPC".

5.2. Rights of parties under Article 107 EPC

Art. 107 EPC remains unchanged. In the course of the revision of the EPC, minor editorial amendments were made to Art. 107 EPC in the German and French versions only.

In appeal proceedings, the case law recognises the right of all parties to be heard (see **J 20/85**, OJ 1987, 102; **J 3/90**, OJ 1991, 550; **T 18/81**, OJ 1985, 166; **T 94/84**, OJ 1986, 337; **T 716/89**, OJ 1992, 132), albeit within the limits of expediency (see **T 295/87**, OJ 1990, 470). The parties also have a right to oral proceedings.

Furthermore, **G 1/86** (OJ 1987, 447) recognised the validity of the principle that all parties must be treated equally in similar legal situations in proceedings before the boards of appeal.

Decision **T 73/88** (OJ 1992, 557) deduced from this that all parties to proceedings had the right to continue appeal proceedings. If there was already one valid appeal, no further appeals were needed and the fees paid for appeals filed later had to be refunded. However, in decision **G 2/91** (OJ 1992, 206) the Enlarged Board disagreed. It took the view that from the legal point of view the status of parties who had filed an appeal was not comparable with that of those who had not. It was clear from generally recognised principles of procedural law that the appellant alone could decide whether the appeal filed by him was to stand. Art. 107, second sentence, EPC 1973 only guaranteed non-appellants who were party to proceedings of the first instance that they were parties to **existing** appeal proceedings. A person who was entitled to appeal but did not do so, settling instead for being "automatically" a party to the appeal proceedings, had no independent right of his own to continue those proceedings if the appellant withdrew his appeal. He acquired that right only by filing an appeal himself and paying the associated appeal fee. By the same token, there was also no reason to refund the fee for any appeals filed after the first, unless the requirements of R. 67 EPC 1973 were met. The related issue of whether non-appealing parties can file substantive requests is dealt with in **G 9/92** and **G 4/93** (both OJ 1994, 875; see chapter VII.E.6.1, *reformatio in peius*). (NB. The requirements of R. 67 EPC 1973, now R. 103 EPC, have been altered.)

The parties must be given equally fair treatment (**G 9/91**, OJ 1993, 408, point 2 of the reasons).

In **T 1072/93** the board held that the freedom of the board to offer specific advice to one of the parties as to how an objection might be overcome, even when such an objection stemmed from the board itself, was severely limited, especially in inter partes proceedings where the preservation of judicial impartiality was a paramount requirement. In **T 253/95**, the same board confirmed that boards of appeal in inter partes proceedings must be strictly impartial and found that alerting a party to a possible argument against

him and on a ground on which the burden of proof rested on him, in advance of the oral proceedings, would amount to a clear violation of the principle of impartiality, irrespective of the fact that the communication setting out such an argument would also be sent to the other party. In **T 394/03** the board held that, even though the opposition division's decision to reject the opposition had been annulled, it was not necessary, in the absence of a request, to give the patentee and respondent another opportunity to comment, nor, given the impartiality of the board, was there any requirement on principle to do so. Following **T 394/03**, the board in **T 902/04** having regard to procedural economy, the principle of party disposition and the requirement for judicial impartiality in inter partes proceedings, found it appropriate to decide the case. Since the opponent's request was allowed, there was no need to hold the oral proceedings which only the opponent had requested on a purely auxiliary basis.

In **T 864/02**, the board found that, according to some case law, a non-appealing party as of right did not have the same procedural status in all respects as did an appellant e.g., it did not have an independent right to continue appeal proceedings if the appellant withdrew its appeal (see **G 2/91**, OJ 1992, 206 and **G 9/92**, OJ 1994, 875). However, the case law also confirmed the right to be heard of all parties to pending proceedings, a specific aspect of the principle that all parties to proceedings pending before the EPO must be treated fairly and equally, as confirmed by **G 1/86** (OJ 1987, 447). According to the board, the only basic legal difference between an appellant and a party as of right lay in the way they became parties to the appeal procedure, the former by notice of appeal and the latter under Art. 107 EPC 1973. Once they were parties to the appeal procedure they had exactly the same rights. The party as of right was thus entitled to raise a novelty objection where the notice of opposition had raised this ground and the submission therefore lay within the framework of the opposition procedure. In **T 591/01** and **T 475/97** the respective parties as of right were allowed to submit requests.

6. Extent of scrutiny

In the course of the revision of the EPC, minor editorial amendments were made to the German version of Art. 114 EPC. Only minor amendments were made to the English and French versions of Art. 111 EPC. The requirements for the admissibility of an appeal in Art. 110(2) and (3) EPC 1973 have been moved to R. 100 EPC.

Appeals give losing parties the opportunity to challenge first-instance decisions adversely affecting them, and to try to have them set aside or changed. The appeal constitutes the subject-matter of the proceedings (**G 9/91**, OJ 1993, 408; **G 10/91**, OJ 1993, 420, point 18 of the reasons; **G 9/92**, OJ 1994, 875). The board's power to decide is determined by the appellant's request(s). The legal and factual framework on which the contested decision was based determines the limits within which this power may be exercised (**G 9/91**, **G 10/91**, especially point 18 of the reasons). In the case of an opposition, this means that the opponent's first-instance requests determine the extent to which the patent is challenged, and the grounds for opposition to be considered, at both first and second instance. Beyond that, the boards have no power to decide. By way of exception to this principle, dependent claims can be examined if the material already available casts doubt *prima facie* on their validity, and a new ground for opposition can

be considered with the patentee's consent (**G 9/91**, **G 10/91**, **T 362/87**, OJ 1992, 522). The appellant's request also defined the limits for applying Art. 114(1) EPC 1973; beyond it, there was no power to examine the facts (**G 9/92**, points 3 and 4 of the reasons).

In admissible opposition appeal proceedings, in the absence of a "request" or reply from a respondent indicating that the decision of the opposition division should not be amended or set aside, a board of appeal had still to examine and decide whether the appeal was allowable, in accordance with Art. 110 and 111 EPC 1973 (**T 501/92**, OJ 1996, 261). The board also upheld **T 34/90** (OJ 1992, 454), according to which the procedural statements made during the first-instance proceedings are not applicable to the appeal proceedings.

6.1. Binding effect of requests - no reformatio in peius

The question of law referred to the Enlarged Board of Appeal in **G 9/92** and **G 4/93** (both OJ 1994, 875) asked whether and to what extent a board of appeal could depart from the request formulated in the notice of appeal when deciding opposition appeal proceedings, to the disadvantage of the appellant.

The Enlarged Board took several factors into account. The aim of the appeal was to eliminate an 'adverse effect'. As the filing of an appeal was subject to a time limit, it would not be consistent to allow non-appealing parties the unrestricted right to alter the extent of the proceedings by submitting their own requests without limitation of time. A non-appealing party as a respondent had the opportunity to make what it considered to be appropriate and necessary submissions in the appeal proceedings to defend the result obtained before the department of first instance.

The Enlarged Board thus concluded that:

1. If the **patentee** was **sole appellant** against an interlocutory decision maintaining his patent in amended form, neither the board of appeal nor the non-appealing opponent (as party to the proceedings as of right under Art. 107, second sentence, EPC 1973) could challenge maintenance of the patent as thus amended.

2. If the **opponent** was **sole appellant** against an interlocutory decision by an opposition division maintaining the patent in amended form, the patentee was primarily restricted in the appeal proceedings to defending the patent as thus maintained. Amendments proposed by the patentee (as party to the proceedings as of right under Art. 107 EPC 1973, second sentence) could be rejected by the board as inadmissible if they were neither appropriate nor necessary (see e.g. **T 321/93**).

a) General issues

The doctrine of reformatio in peius cannot be extended to apply separately to each point decided by the opposition division (**T 327/92**; see also **T 401/95** and **T 583/95**).

In **T 149/02** the board stated that the two general principles of procedure - prohibition of reformatio in peius and the devolutive effect of the appeal, which conferred on the board the power to consider its subject-matter - were complementary and had to be implemented in such a way that they did not exclude each other.

In **T 1178/04** (OJ 2008, 80) the board held that where the issue was a person's right to be a party, the principle of no reformatio in peius was of no application, bearing in mind the fact that the principle of no reformatio in peius was taken mainly from the well established principle in German law ("Verschlechterungsverbot"). This principle has no application in those cases where (a) there exist procedural preconditions for making relevant requests to the court ("Verfahrensvoraussetzungen") and (b) these preconditions are of a kind that cannot be waived or dispensed with ("unverzichtbare Verfahrensvoraussetzungen"), such that the court must itself be satisfied that they have been fulfilled. According to the board, in the context of patent proceedings such as these, preconditions of this kind included the admissibility of the opposition itself and the capacity of a person to be a party to the proceedings in the first place.

According to **T 1194/06**, there is no reason to assume that the Enlarged Board of Appeal in **G 1/99** (OJ 2001, 381), considered even a substantial limitation of the scope of protection unacceptable. Nor did **G 1/99** distinguish between different "types" of unallowable amendment. The board could thus see no reason to assume that an amendment concerning an unallowable disclaimer should be treated in any way differently than other unallowable amendments, even if the question of what was considered to be an unallowable disclaimer was clarified after the decision **G 1/99**.

b) Patentee as sole appellant

Applying the principles expounded in **G 9/92** and **G 4/93** the board concluded in **T 856/92** that in a case where the patentee and sole appellant appealed only in respect of some of the claims held allowable in the opposition division's interlocutory decision, neither the board nor the opponent might challenge those claims not questioned by the appellant.

In **T 598/99** the board observed that the principle of reformatio in peius applied so as to prevent a sole appellant being put in a worse situation than he was in before he appealed. Where the patentee was the sole appellant, the principle could not serve to protect the opponent/respondent from being put in a worse situation than he was in before the appeal (**G 9/92**, OJ 1994, 875 and **G 4/93**, OJ 1994, 875). Indeed, whenever a sole patentee was successful in his appeal against the revocation of his patent, the opponent would be in a worse position than before. The fact that the opponent was not entitled to appeal against the decision to revoke the patent was immaterial in that respect.

The board in **T 659/07** found that the applicability of the legal principle of the prohibition of reformatio in peius depends on the procedural status of a case, which had therefore to be examined prior to the substantive merits of a request. Where the patentee is the sole appellant, the board further held that the patent as maintained by the opposition division

in its interlocutory decisions, cannot be objected to by the board, either at the request of the respondent/opponent or ex officio, even if the patent as maintained would otherwise have to be revoked on the ground that a feature present in both claim 1 as granted and as maintained introduces added subject-matter contrary to Art. 123(2) EPC 1973.

c) Opponent as sole appellant

In **T 752/93**, **T 637/96**, and **T 1002/95** the opposition division had maintained the patent in amended form and only the opponent had appealed. The non-appealing patentee proposed amendments during the appeal proceedings. In **T 752/93** and **T 1002/95** the board found that amendments proposed by a non-appealing patentee could, according to **G 9/92**, be rejected as inadmissible by the board of appeal if they were neither appropriate nor necessary, i.e. had not been occasioned by the appeal. According to **T 752/93** the patentee should therefore have the opportunity to correct erroneous amendments if these were detected later in the proceedings. Similarly, in **T 637/96**, the respondent (patentee) was able to request restoration of the claim as granted, as the amendment made to it in opposition proceedings did not change its subject-matter (i.e. the claim as granted and amended meant the same thing) and was therefore unnecessary. In **T 752/93** and **T 637/96** the amendments were found not to worsen the sole appellant's position and the boards thus considered them appropriate and necessary. In **T 1002/95** the board pointed out that under R. 57a EPC 1973, which came into force after decisions **G 9/92** and **G 4/93**, a patentee was entitled to make "appropriate and necessary" amendments occasioned by grounds for opposition specified in Art. 100 EPC 1973, even if the respective ground was not invoked by the opponent.

In **T 23/04** the board made it clear that the requirements of *reformatio in peius* do not imply any right of the appealing party (opponent) to dictate the form any proposed amendments may take, and certainly to prescribe a form of amendment which would be maximally disadvantageous to the patent proprietor.

In **T 1380/04** the board, referring to **G 1/99** (OJ 2001, 381), held that the deletion of a term by the patentee/respondent could not be allowed, as this would have worsened the legal position of the appellant, contrary to the prohibition of *reformatio in peius*. It was immaterial that the term had only been introduced at the suggestion of the opposition division, as this did not alter the fact that approval of this amendment was the responsibility of the proprietor.

d) Revocation of patent

The principles of **G 9/92** were applied in **T 169/93** to the situation where the patent had been revoked, not amended. The patentee appealed against the decision to revoke (for lack of inventive step). The opposition division had found the patent sufficiently disclosed and novel. The appellant submitted that these issues could not be reopened, as none of the opponents had appealed this finding, relying on decisions **G 9/91** (OJ 1993, 408), **G 10/91** (OJ 1993, 420) and **G 9/92** (OJ 1994, 875). The board disagreed, pointing out that the respondents were unable to file an appeal, not being adversely affected under

Art. 107 EPC 1973, their request for revocation having been granted. Moreover, as the patent had been revoked, it was not possible for the appellant to have an even worse outcome. It was thus open to the respondents to re-argue matters which had already been at issue before the opposition division. See also **T 1341/04**, where the board further noted that the situation arising from a decision to revoke a patent was legally different from the one in which the patent had been maintained by the opposition division in amended form, where the decision could be appealed by both patentee and opponent. It was this situation which led to the conclusion in **G 9/92** and **G 4/93** that the patent proprietor is primarily restricted during the appeal proceedings to defending the patent in the form in which it was maintained by the opposition division, in a case where the opponent is the sole appellant.

e) Exceptions to the rule

Limited exceptions to the rule against *reformatio in peius* exist. In **G 1/99** (OJ 2001, 381) the Enlarged Board of Appeal answered the question referred to it in **T 315/97** (OJ 1999, 554), namely, "Must an amended claim which would put the opponent and sole appellant in a worse situation than if he had not appealed - e.g. by deleting a limiting feature of the claim - be rejected?".

The Enlarged Board held that **in principle** such a claim must be rejected. However, an exception to this principle might be made where the opposition division had allowed an inadmissible amendment. In the case at issue the opposition division had done just that with the agreement of the proprietor, who was thus not adversely affected by the decision and unable to appeal. The patent proprietor (respondent) had filed during the appeal proceedings a main request including the added (and unallowable) limiting feature, and an auxiliary request deleting it (and thus widening the claim). The Enlarged Board found that the main request had to be rejected because it did not meet the requirements of the Convention. Moreover, if the principle of *reformatio in peius* were to be applied without considering the specific circumstances of the case, the auxiliary request would also have to be rejected because it would put the opponent (appellant) in a worse situation than if it had not appealed. The only possible course the board could then take would be to revoke the patent, there being no further remedy for the proprietor. The proprietor would thus definitively lose any protection as a direct consequence of an inadmissible amendment being held allowable by the opposition division. The Enlarged Board considered it inequitable for the patent proprietor not to be given a fair opportunity to mitigate the consequences of errors of judgment made by the opposition division. The patent proprietor should thus be allowed to file requests in order to overcome this deficiency, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limited the scope of the patent as amended;
- if such a limitation was not possible, for an amendment introducing one or more originally disclosed features which extended the scope of the patent as maintained, but within the limits of Art. 123(3) EPC 1973;

- finally, if such amendments were not possible, for deletion of the inadmissible amendment, but within the limits of Art. 123(3) EPC 1973, even if, as a result, the situation of the opponent was made worse.

See **T 594/97**, **T 994/97**, **T 590/98**, **T 76/99** and **T 724/99** for application of the principles enunciated in **G 1/99**.

According to **T 809/99** a non-appealing patent proprietor is primarily restricted on appeal to defending the claims as maintained by the opposition division. If these claims are not allowable, the principle of prohibition of reformatio in peius applies, i.e. an amended claim which would put the opponent and sole appellant in a worse situation than if it had not appealed must be rejected.

The board went on to say that the only exception to this principle as set out in **G 1/99** requires consideration of a particular sequence of possibilities for overcoming the deficiency presented by the claim(s). The first solution for overcoming the deficiency to be considered (an amendment introducing one or more originally disclosed limiting features which would not put the opponent (appellant) in a worse situation than it was in before it appealed) in fact concerns a limitation of the scope of the claim. Such limitation can also be achieved by deleting the alternative embodiment in the claim, which led to the deficiency.

The proprietor's argument that the limitation to only one of the two alternatives would render the scope of protection too narrow for it to be commercially interesting is not a valid reason for dismissing this solution and proceeding to the next possible solution indicated in **G 1/99** (point 2.4 of the reasons).

According to an obiter dictum in **T 239/96**, the board took the view that, in the absence of a provision on cross-appeal (in German "Anschlussbeschwerde"), reformatio in peius could not be ruled out altogether under the Convention, as it might serve as a means of avoiding unnecessary litigation, while still satisfying the legitimate expectations of the parties for a fair hearing.

6.2. Subject-matter under examination

The admissibility of the opposition, being an indispensable procedural requirement for any substantive examination of the opposition submissions, must be checked ex officio in every phase, including any ensuing appeal proceedings (**T 240/99**).

No part of a patent's subject-matter (e.g. individual claims) not opposed within the nine-month time limit can be reviewed in either opposition or appeal proceedings. The opponent's statement under R. 76(2)(c) EPC (R. 55(c) EPC 1973) establishes the extent to which the patent is contested and thus the formal competence of the opposition division or board of appeal. The only exception to this principle concerns an opposition explicitly directed **only** to the subject-matter of an independent claim. In such a case, subject-matter covered by claims which depend on the independent claim can also be examined as to patentability (see e.g. **G 9/91**, OJ 1993, 408; see also **T 323/94**).

According to **T 896/90**, detailed grounds for opposition for a single granted independent claim do not mean that only that part of the patent is being contested, if the opponent has indicated that he wants the whole patent revoked. However, in **T 737/92** the board found that an opposition was filed only to the extent that it was substantiated.

Where two opponents lodge appeals contesting different sets of claims and one subsequently withdraws its appeal, it becomes a party as of right under Art. 107 EPC 1973 and the other opponent becomes the sole appellant. The scope of the appeal is defined by the latter's request, which the non-appealing party may not exceed and which binds the board (**T 233/93**).

Where the patentee appeals the revocation of the patent, the board is not bound by the findings of the opposition division; the whole case, including those claims considered novel by the opposition division, and objected to by the non-appealing opponent, must be considered (**T 396/89**). Furthermore, if the patent proprietor as the sole appellant in the opposition appeal proceedings makes amendments to the version of the patent adopted in accordance with an interlocutory decision of the opposition division, the board is both competent and obliged ex officio to examine those amendments from both a formal and a substantive point of view, even if the respondents expressly agree to them (**T 1098/01**). Similarly, where the patent proprietor was respondent on appeal against the decision of the opposition division as a whole, it was the board's power and duty to decide for itself on each issue addressed and it was not bound by any finding of that decision (in the respondent's favour) (**T 36/02**).

Claims which remain unchanged after the removal of the references in dependent claims need not be examined in opposition appeal proceedings to see if they contain grounds for opposition raised for the first time in those proceedings, unless the patentee consents (**T 968/92**).

According to **T 123/85** (OJ 1989, 336), the EPC makes no provision for patentees to surrender their patents during opposition proceedings (referring to **T 73/84**, OJ 1985, 241; **T 186/84**, OJ 1986, 79) nor surrender part of the patent so as to limit it. Thus a request withdrawn during opposition proceedings may nonetheless be considered in any ensuing opposition appeal proceedings. This view was followed in many decisions, including **T 296/87** (OJ 1990, 195), **T 934/02**, **T 699/00**, **T 794/02** and **T 1276/05**. In **T 900/94** the board explained that the submission of a restricted version of the claims in the proceedings before the department of first or second instance is in accordance with the consistent practice of the EPO, as established in decision **T 123/85** (OJ 1989, 336) and confirmed in **T 153/85** and **T 133/87**, and not to be considered as a partial abandonment of originally filed subject-matter.

In **T 1018/02**, it was stated that amendments of a European patent had to comply with R. 57a EPC 1973. According to this rule, amendments were possible provided that they were occasioned by grounds for opposition. However, this did not mean that, if a patent proprietor in the first instance chose to defend a main request which was limited in scope compared with the claims as granted, then he could not during the appeal proceedings go beyond the limits of that request. In accordance with **T 407/02**, a patent proprietor

who had only defended his patent in limited form before an opposition division, was in principle allowed on appeal to return to a broader version or even to the patent as granted.

According to **T 386/04**, an appellant/proprietor, whose patent has been revoked, is entitled to seek maintenance of the patent as granted even though its main request before the opposition division had only been the maintenance of the patent in more limited form. The exception to this is where to allow the proprietor to revert to the amended claims would amount to an abuse of procedure. According to the board, this long-standing principle is not contradicted by decisions **T 528/93** or **T 840/93** (OJ 1996, 335), which are concerned with new claims raising new issues, and is not contrary to the statement by the Enlarged Board of Appeal in decision **G 9/91** (OJ 1993, 408), concerning the purpose of an appeal. In this context, there is no procedural logic in distinguishing between cases in which the patent has been revoked and cases in which the patent has been maintained.

In **T 528/93**, the board had held that where a request was withdrawn during opposition proceedings and was thus not the subject of the contested decision, a virtually identical request filed during appeal proceedings was not the subject of the appeal, because the appellant was not adversely affected by the decision of the opposition division as far as this request was concerned.

Reviewing and eliminating any ambiguities in the claims and description which are not necessary to refute substantiated grounds of opposition is not part of the review of the contested decision carried out during opposition appeal proceedings. In the event of ambiguities in the claims which are not connected to changes in the granted documents, Art. 69 EPC 1973 stipulates that the description and drawings must be used to interpret the claims, not that the claims must be changed (**T 481/95**).

In **T 653/02** it was held that a board has no competence to examine a newly formulated claim derived by combination of granted claim 1 with a sub-claim not being within the extent to which the patent had been opposed; this did not fall within the exception allowed by **G 9/91** (OJ 1993, 408). In **T 646/02** the board found that the case at issue differed from the facts before the board in **T 653/02**, in that the subject-matter not opposed was described in the patent and was part of the independent claim as granted but was not itself the subject-matter of a dependent claim of the patent as granted. Whether or not the board had competence to examine depended, however, only on whether the patent was clearly restricted to a subject-matter not covered by the notice of opposition. This was done in **T 646/02** by restriction to the subject-matter of the **deliberately excluded dependent claim** and, in the case at issue, by restriction to **deliberately excluded variants** of the invention. The board held that the exception in **G 9/91** was not therefore applicable in the present case either, since it was applicable only to subject-matter implicitly covered by the notice of opposition and not to those explicitly excluded.

In line with **G 9/91**, a patent proprietor could in appeal proceedings, amend an uncontested **dependent** claim in accordance with R. 57a EPC 1973 (**T 711/04**).

Although the appeal procedure is to be considered as a judicial procedure in accordance with **G 9/91** (OJ 1993, 408), this does not mean that a board in examining an appeal within the framework of the legal grounds and facts submitted by the parties is limited to only considering passages in documents indicated and facts submitted by the parties. Examination of the appeal may raise further relevant questions within this framework and parties thus be invited to file observations. Moreover, where amendments of the claims were made during opposition proceedings, these are to be fully examined as to their compatibility with the requirements of the EPC (**T 1355/04**).

If an application for which no search had been carried out in accordance with R. 45 EPC 1973, *inter alia* for lack of clarity of the claims, had been refused for the same reason, a board of appeal need only examine whether the claims failed to comply with the clarity requirement of Art. 84 EPC 1973 to such an extent that it was not possible to carry out a meaningful search. Having found that the claims fulfilled the requirements of the EPC to such an extent that it should have been possible to carry out a search, the board in **T 1873/06** remitted the application to the examining division for an additional search to be performed and the substantive examination to be continued. R. 45 EPC 1973 has been streamlined and is now R. 63 EPC. Art. 84 EPC has been subject to minor editorial amendment in English and German only.

6.3. Patentability requirements under examination

6.3.1 Ex parte proceedings

In **G 10/93** (OJ 1995, 172) the Enlarged Board ruled that, where the examining division had refused an application, the board had the power to examine whether the application or the invention to which it related met the requirements of the EPC 1973. This also held good for requirements the division had not considered in the examination proceedings or had regarded as fulfilled. The board should then, where appropriate, decide either to rule on the case itself or send it back to the examining division.

This followed from the fact that ex parte review was not of a contentious nature. It involved examination of the patentability requirements in proceedings in which only one party (patent applicant) was involved. The departments involved at every instance had to ensure that these requirements were fulfilled. In ex parte proceedings, therefore, the boards of appeal were not restricted either to examination of the grounds for the contested decision or to the facts and evidence on which that decision was based, and could include new grounds even though in ex parte cases too the main aim of appeal proceedings was to review the contested decision.

This decision was based on case **T 933/92**, in which an examining division had refused an application for non-compliance with Art. 123(2) EPC 1973. Whilst sharing the examining division's view with respect to Art. 123(2) EPC 1973, the board felt the application should be refused for lack of inventive step. In the board's view, the question whether grounds could be added or replaced was not resolved by **G 9/91** and **G 10/91**.

The extent of the obligation to review a case where the appeal is partially withdrawn is discussed in Chapter VII.E.11.1.

6.4. Facts under examination - applying Article 114 EPC in appeal proceedings

Parties have no right to determine what facts will be taken into account in a board's decision. On the contrary, Art. 114(1) EPC (which remains unchanged) - and which also applies in appeals proceedings - requires the board to establish the facts of its own motion (see **T 89/84**, OJ 1984, 562 and **J 4/85**, OJ 1986, 205; the former superseded in so far as the view was taken that a respondent's "cross-appeal" was not necessary).

As the Enlarged Board made clear in **G 8/93** (OJ 1994, 887), the board's obligation under Art. 114(1) EPC 1973 existed only once proceedings were pending (see also **T 690/98**). Earlier, **T 328/87** (OJ 1992, 701) had already ruled that the facts could be investigated only if the appeal was admissible. There were, however, limits to this obligation, for example under Art. 114(2) EPC 1973, where facts and evidence are submitted late. The same applied if an opponent/respondent withdraws his opposition: in **T 34/94** the board found that, "if in the event of withdrew of the opposition the opponent is the respondent, the board may take into account evidence which was submitted by the opponent prior to withdrawal of the opposition. However, for reasons of procedural economy, the duty of the EPO to examine the facts of its own motion pursuant to Art. 114(1) EPC 1973 does not extend to its having to examine the submission of the opponent that a previous oral disclosure took place if the crucial facts were difficult to ascertain without his co-operation" (this confirmed the case law in **T 129/88**, OJ 1993, 598; **T 830/90**, OJ 1994, 713; **T 887/90**, **T 420/91** and **T 634/91**; see also **T 252/93**).

T 182/89 (OJ 1991, 391) sets out what the obligation to investigate involves; Art. 114(1) EPC 1973 should not be interpreted as requiring the opposition division or board of appeal to ascertain whether there was support for grounds for opposition not properly substantiated by an opponent, but as enabling the EPO to investigate fully the grounds for opposition which were both alleged and properly substantiated pursuant to R. 55(c) EPC 1973 (see also **T 441/91** and **T 327/92**). In **T 263/05** (OJ 2008, 329) the board accepted that it had an ex officio duty under Art. 114(1) EPC 1973 to examine amended claims, but only for prima facie non-compliance with the EPC, e.g. lack of clarity or conciseness.

T 60/89 (OJ 1992, 268) held that when alleged facts put forward without proof as causing lack of novelty had occurred a long time previously and the question was no longer pursued by the parties it was not obliged to investigate the matter ex officio under Art. 114(1) EPC 1973. Nor did the board in **T 505/93** consider itself obliged to carry out any further investigation when the opponents refused to take part in oral proceedings where the content of a prior use was to be clarified.

If departments of first instance and/or parties fail to take account of highly relevant matter which is clearly available in the EPO file and which relates to a ground of opposition, the board's competence extends to rectifying the position by consideration of that matter

provided, of course, the parties' procedural rights to fair and equal treatment are respected. This is not only consistent with Enlarged Board decisions **G 9/91** (OJ 1993, 408) and **G 10/91** (OJ 1993, 420), but incumbent on the board as the last instance in proceedings concerning the grant or maintenance under opposition of European patents (**T 385/97**). It enhances acceptance of the boards' decisions and their standing as the only judicial body ruling on patentability with effect for all the designated contracting states, if those decisions based on all material are submitted during the appeal proceedings. A document presented in such proceedings should therefore be taken into account if it is not completely irrelevant or at odds with considerations of procedural economy (**T 855/96**).

In **T 715/94** the board held that it was entitled to find novelty-destroying a document submitted but considered irrelevant before the examining and opposition divisions, as novelty had already been questioned and the document cited in the appellant's notice of opposition.

In **T 87/05**, it was held that the provisions of the RPBA governing the admission into the proceedings of belated requests for the most part codified the established case law of the boards of appeal on the admissibility of such requests, account being taken of, inter alia, the complexity of the new subject-matter, the current state of the proceedings and the principle of procedural economy (see Art. 13 RPBA 2007).

In the context of an appeal by an appellant/opponent from an opposition division decision maintaining the patent in amended form, the board of appeal only has to consider the appeal as regards claims upon which the appellant/opponent has advanced arguments and those claims that are dependent, either wholly or partially, on these claims, and has to apply the provisions of Art. 114(1) EPC 1973 in a restricted manner (**T 223/05**).

6.5. Arguments under examination

The question of whether a party has discharged its onus of proof in relation to the availability to the public of a document is an argument and not a new ground of appeal. The prohibitions or restrictions on additions to the extent to which a patent is opposed, the raising of a new ground for opposition or the introduction of new facts or evidence, do not apply to the admission of a new argument. Indeed, the very purpose of appeal proceedings, particularly oral proceedings, is to provide an opportunity for a losing party to throw new light on relevant aspects of matters which have been decided to his detriment and/or to draw attention to facts in the reasoning of the department of first instance that resulted in a decision adverse to him. This can, in practice, best be achieved by reliance on new arguments. Whilst it is desirable that all relevant arguments be brought at the earliest possible stage of the proceedings, there is no requirement in Art. 108 EPC 1973 that the statement of grounds of appeal be exhaustive as to the arguments to be brought (**T 86/94**).

Similarly, in **T 432/94** the appellant was allowed to redefine the problem to be solved by the invention. The board stated that it could not be concluded from Art. 108, third sentence, EPC 1973 that an appellant was bound to the line of argument he used in the

statement of grounds for the whole appeal proceedings; this dealt with an admissibility requirement and did not limit the matter in dispute in appeal proceedings.

6.6. Review of first-instance discretionary decisions

If the way in which a department of first instance has exercised its discretion on a procedural matter is challenged in an appeal, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, and to decide whether or not it would have exercised such discretion in the same way as the department of first instance. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion if the board concludes it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (**T 640/91**, OJ 1994, 918; see also **T 182/88**, OJ 1990, 287; **T 986/93**, OJ 1996, 215; **T 237/96** and **G 7/93**, OJ 1994, 775). See also **T 1119/05**.

7. Filing and admissibility of the appeal

According to Art. 108 EPC a notice of appeal shall be filed in accordance with the Implementing Regulations within two months after the date of notification of the decision. Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid. The content of the notice of appeal which was previously set out in R. 64 EPC 1973 is now in R. 99 EPC. In view of the future use of electronic means of communication, it was found useful to avoid references to 'in writing' or 'in written form' and leave such regulation to the Implementing Regulations and these have therefore been deleted from the EPC.

The admissibility of an appeal can only be assessed as a whole (**T 382/96**). There is no support in the EPC for a notion of 'partial admissibility' of an appeal (**T 774/97**). See also **T 509/07**.

7.1. Transitional provisions

If notice of appeal was filed before the revised EPC entered into force, the appeal's admissibility must be assessed under the provisions of the EPC 1973, in line with the principle (*tempus regit actum*) that entitlement to perform a procedural act is governed by the law in force when the act took place (**T 1366/04**).

The decision whether an appeal is admissible according to the relevant provisions, geared to the fulfilment of the requirements for admissibility within a certain legally defined period, depends entirely on the substantive and legal position at the time of expiry of the time limits. Since the belated fulfilment of admissibility requirements after the expiry of the time limit cannot be taken into account in the examination of admissibility, so too a change in the legal position occurring after the expiry of the time limit for fulfilling the admissibility requirements can have no impact, either to the appellant's advantage or to his detriment, on the assessment of admissibility (**J 10/07**; OJ 2008, 567). In **T 2052/08**, the board, citing the finding in **J 10/07** that R. 103 EPC

should not be applied to appeal cases concerning patent applications filed before the entry into force of the EPC 2000, found that, as **J 10/07** concerned the reimbursement of the appeal fee in situations where a substantial procedural violation had occurred at first instance, its conclusions should not be taken as implying a statement on the applicability of R. 103 EPC.

In **T 616/08**, the board found that, to the extent that it was relevant whether an aligned or the original version of a rule applied, there was a gap in the law which needed to be closed by case law as long as the legislator was not active. Art. 107, 109 and 111 EPC were not mentioned in the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 ("transitional provisions"), although Art. 106, 108 and 110 EPC were. The board took into account the purpose of the transitional provisions (namely, to avoid the use of different versions of the EPC over a prolonged period), and the fact that there was nothing to indicate any intention to use new and old versions of Articles covering appeal proceedings in parallel. It therefore decided to apply Art. 107, 109 and 111 EPC and the rules appertaining to them where Art. 106, 108 and 110 EPC were applicable.

The board referred to **J 10/07** (OJ 2008, 567), where the Legal Board had concluded that Art. 107 and 111 EPC 1973 should be applied to applications filed before the cut-off date, but considered that the continued application of all EPC 1973 articles which had not been addressed in the transitional provisions did not appear to be in line with the legislators' objectives that the revised provisions should quickly take effect in practice and that the use of different variations of the EPC over a prolonged period should be avoided.

7.2. Appealable decisions

Under Art. 106(1), first sentence, EPC appeals lie against decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division. This Article remains unchanged in all three official languages.

7.2.1 Departments

The boards can hear appeals only against the decisions taken by other EPO departments (**J 12/85**, OJ 1986, 155). There is thus no right of recourse to the boards of appeal in respect of extensions of patent applications and patents to the extension states. Instead, it is the respective national jurisdiction which is responsible (**J 9/04**, see also **J 2/05**).

7.2.2 Decisions

Whether a document constitutes a 'decision' or not depends on the substance of its content and not on its form (**J 8/81**, OJ 1982, 10; see also **J 26/87**, OJ 1989, 329; **J 13/92**, **T 263/00** and **T 713/02**, OJ 2006, 267). It is, therefore, not relevant that the text in question is in the form of a mere letter, nor does it matter if it states "... it is decided" to

allow the request. Nor is the fact decisive that the Notice of the Vice-President DG2 dated 28.4.99 uses the wording "Decisions concerning the correction of errors ..." (**T 713/02**, OJ 2006, 267). An appeal against a formalities officer's letter rejecting the opposition as inadmissible was held to be an appealable decision in **T 1062/99**. A "decision" needs to involve a reasoned choice between legally viable alternatives (**T 934/91**, OJ 1994, 184).

The case law of the boards of appeal has established that the following are **not** regarded as appealable decisions by other EPO departments:

(i) A request under R. 89 EPC 1973 for correction of a contested decision. Not until the request has been decided at first instance can the matter be referred to the board (**J 12/85**, OJ 1986, 155).

(ii) The preparatory steps referred to in Art. 96(2) EPC 1973 and R. 51(3) EPC 1973 (**T 5/81**, OJ 1982, 249).

(iii) A communication under R. 57(1) EPC 1973 (**T 222/85**, OJ 1988, 128), or R. 69(1) EPC 1973 (**J 13/83**).

(iv) A communication from the opposition division finding that an opposition has been validly filed, and stating that the decision will be taken on that point at the oral proceedings (**T 263/00**).

(v) An order by a director of a department of first instance (such as an opposition division) rejecting an objection to a member of the division on the ground of suspected partiality. The composition of the division could, however, be challenged on such a ground in an appeal against its final decision or against a separately appealable interlocutory decision under Art. 106(3) EPC 1973 (**G 5/91**, OJ 1992, 617).

(vi) A "decision" by a director on a request for inspection of file. Only the examining division charged with the technical opinion (Art. 25 EPC 1973) or the formalities officer pursuant to the Notice of the DG2 Vice-President (OJ 1984, 317, revised and supplemented in OJ 1989, 178 and OJ 1999, 504) has the competence to decide on a request for inspection of file. Such a 'decision' under appeal is therefore void ab initio and the appeal inadmissible (**J 38/97**; see also **T 382/92**).

(vii) A letter bearing the letterhead of an EPO Directorate-General and signed by an EPO Vice-President, if it is evident from its content that it does not constitute a decision and from its form that it does not emanate from any of the departments listed in Art. 21(1) EPC 1973 (**J 2/93**, OJ 1995, 675).

(viii) The minutes of oral proceedings (**T 838/92**). A correction to minutes of oral proceedings made on the initiative of the opposition division was held not directly appealable in **T 231/99**.

(ix) A communication from a formalities officer primarily dealing with the patentee's request to stay the opposition proceedings and to remit the case to the examination division for a decision on the request for correction under R. 89 EPC 1973 (**T 165/07**).

T 26/88 (OJ 1991, 30), which held that a document stating that the patent was revoked under Art. 102(4) and (5) EPC 1973 did not constitute a decision, was overruled by **G 1/90** (OJ 1991, 275).

7.2.3 Interlocutory decisions

Under Art. 106(2) EPC (formerly Art. 106(3) EPC 1973) a decision which does not terminate proceedings as regards one of the parties (interlocutory decision) can only be appealed together with the final decision, unless the decision allows a separate appeal. Separate appeal is possible against interlocutory decisions regarding admissibility of the opposition (see e.g. **T 10/82**, OJ 1983, 407) or maintenance of a patent in amended form (see e.g. **T 247/85** and **T 89/90**, OJ 1992, 456).

In **T 857/06**, the opposition division had attempted to incorporate the content of its first (non-appealable) interlocutory decision into its second (appealable) interlocutory decision. The board pointed out that matter already decided cannot be decided again at the same instance and so the appellant had to appeal not only the second, but also the first interlocutory decision. Although the first interlocutory decision was not explicitly appealed, the attempt by the opposition division to incorporate its first decision was procedurally incorrect and misleading. The board concluded that, according to the principle of legitimate expectations, the appeal had to be considered as encompassing the first interlocutory decision.

7.2.4 Appeals against decisions of the boards of appeal

It was established by the Enlarged Board in **G 1/97** (OJ 2000, 322) that:

1. In the context of the EPC 1973, the jurisdictional measure to be taken in response to requests based on the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision of a board of appeal having the force of *res judicata* should be the refusal of the requests as inadmissible.
2. The decision on inadmissibility is to be issued by the board of appeal which took the decision forming the subject of the request for revision. The decision may be issued immediately and without further procedural formalities.
3. This jurisdictional measure applies only to requests directed against a decision of a board of appeal bearing a date after that of the present decision.
4. If the Legal Division of the EPO is asked to decide on the entry in the Register of European Patents of a request directed against a decision of a board of appeal, it must refrain from ordering that the entry be made if the request, in whatever form, is based on

the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision of a board of appeal.

These principles have since been followed in several decisions, for example **J 16/98**, **J 3/98** and **T 431/04**.

In **T 846/01** it was explained that at least one of the grounds in the written statement of grounds of appeal must relate to a point which could at least arguably have been decided in the appellant's favour by the instance appealed from but had not been so decided. A favourable decision on the point must also have produced a different outcome. An appeal cannot be an excuse for requesting consideration of points which the instance from which the appeal lies was not entitled to consider.

In the case at issue it was clear that the appellants were not contesting the substance of the opposition division's decision, which dealt with the renumbering of the claims and the adaptation of the description, but were actually trying to reopen the issue of validity which had already been decided in an earlier decision of a board of appeal. Under Art. 106 EPC 1973 and in view of the principle of *res judicata*, this decision was not open to challenge.

A limited judicial review of decisions of the boards of appeal was introduced into the EPC 2000, in Art. 112a EPC. See chapter VII.E.15, petition for review.

7.3. Board competent to hear a case

The responsibilities and composition of boards are laid down in Art. 21 EPC. In **G 2/90** (OJ 1992, 10) the Enlarged Board made it clear that under Art. 21(3)(c) EPC 1973, the Legal Board of Appeal was competent only for appeals against decisions taken by an examining division consisting of fewer than four members and which did not concern refusal of the application or grant. In all other cases, i.e. those covered by Art. 21(3)(a), 21(3)(b) and 21(4) EPC 1973, the technical boards were competent. The provisions of Art. 21(3) and (4) EPC 1973 governing responsibilities and composition were not affected by R. 9(3) EPC 1973.

Art. 21(3)(a) EPC expressly states that appeals against decisions concerning the limitation or revocation of European patent should be heard by the technical boards of appeal.

In **G 3/03** (OJ 2005, 343), the Enlarged Board of Appeal held that in the event of interlocutory revision under Art. 109(1) EPC 1973, the department of first instance whose decision had been appealed was not competent to refuse a request of the appellant for reimbursement of the appeal fee. It was the board of appeal which would have been competent under Art. 21 EPC 1973 to deal with the substantive issues of the appeal if no interlocutory revision had been granted which was competent to decide on the request.

An appeal against a decision of an examining division refusing a request under R. 89 EPC 1973 for correction of the decision to grant was to be decided by a technical

board of appeal (**G 8/95**, OJ 1996, 481, overruling **J 30/94**). (A board, however, has no appellate competence, in inter partes opposition appeal proceedings, to review the decision on correction of the grant decision taken in ex parte examination proceedings under R. 89 EPC 1973, since that decision does not form the subject of the appeal proceedings before it; see **T 79/07**, deviating from **T 268/02**).

According to **T 1382/08**, as regards the question of responsibility under Art. 21(3) EPC 1973, if the impugned decision is contradictory or unclear it is to be seen in the light of the legal consequences noted vis-à-vis the applicant or the impression given to the public as to its legal nature.

An appeal against the decision of the examining division refusing a request for corrections under R. 88 EPC 1973 filed after grant of the patent, on the other hand, is to be decided by the Legal Board of Appeal. The appeal concerned the preliminary question of whether a request under R. 88 EPC 1973 could be made after grant. This was purely a question of law, and did not concern the refusal of a European patent application or the grant of a European patent. It was also consistent with **G 8/95**, as answering the preliminary question did not involve any consideration of the text with which the patent should be granted (**J 42/92**).

7.4. Entitlement to appeal

7.4.1 Formal aspects

Under Art. 107, first sentence, EPC, an EPO decision can be appealed only by a party to the proceedings which gave rise to it. This Article remains unchanged in English. Minor editorial amendments were made in the French and German versions.

An appeal filed in the name of the representative instead of the party adversely affected by the decision impugned was rejected as inadmissible in **J 1/92**.

In **T 340/92** the appellant was a company which had obviously been named in the notice of appeal by mistake, instead of a subsidiary, which was the real opponent. The actual appellant was the only party adversely affected by refusal of the opposition, and was readily identifiable through its representative, who was named in the appeal dossier. The board held that this deficiency could be remedied under R. 65(2) EPC 1973. See also **T 875/06**.

However, if the notice of appeal was filed by an adversely affected party, but the grounds of appeal were filed by a different company which was not a party to the opposition proceedings, let alone a party adversely affected by the outcome of those proceedings, the appeal could not be held admissible. No provision having been made in the Implementing Regulations pursuant to Art. 133(3), last sentence, EPC 1973 the EPC 1973 did not allow the representation of one legal person by the employee of another economically related legal person, who could not therefore file the grounds of appeal on the other's behalf (**T 298/97**, OJ 2002, 83).

In the absence of any clear indication to the contrary, a professional representative who was authorised to act for a party adversely affected by a decision and then filed an appeal against this decision had to be presumed to be acting on behalf of the very same party that he acted for in the first instance proceedings, and not on behalf of someone else not entitled to appeal (**T 920/97**).

In **G 3/99** (OJ 2002, 347), the Enlarged Board of Appeal held that where the opposing party consisted of a plurality of persons, an appeal had to be filed by the common representative under R. 100 EPC 1973. Where the appeal was filed by a non-entitled person, the board of appeal was to consider it not to be duly signed and consequently invite the common representative to sign it within a given time limit. The non-entitled person who filed the appeal should be informed of this invitation. If the previous common representative was no longer participating in the proceedings, a new common representative should be determined pursuant to R. 100 EPC 1973.

In order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it had to be clear throughout the procedure who belonged to the group of common opponents or common appellants. If either a common opponent or appellant (including the common representative) intended to withdraw from the proceedings, the EPO had to be notified accordingly by the common representative or by a new common representative determined under R. 100(1) EPC 1973 in order for the withdrawal to take effect.

A company that has gone into receivership can no longer validly file an appeal; only the insolvency administrator can do so on its behalf. In **T 693/05**, the insolvency administrator had authorised the representative to file an appeal, which was held admissible. In **T 1324/06**, the authorised representative of a company which had previously been declared bankrupt filed an appeal on behalf of the company. Relying on R. 101(6) EPC 1973 and R. 152(8) EPC, under which the authorised representative shall be deemed to be authorised until the termination of his authorisation has been communicated to the EPO, the board held the appeal admissible, no such notification having been received from the insolvency administrator or representative.

Concerning the entitlement to appeal of a transferee of a patent, see chapter VII.C.5.2, party status as proprietor.

7.4.2 Party adversely affected

Under Art. 107 EPC (unchanged only in the English version), any party to proceedings adversely affected by a decision may appeal. According to **T 234/86** (OJ 1989, 79) a party is adversely affected if the decision does not accede to his main requests or to auxiliary requests preceding the allowed auxiliary request (see also **T 392/91**). This is not the case if the patent proprietor withdraws his main request or preceding auxiliary requests and agrees with the allowed auxiliary request (**T 506/91**, **T 528/93**, **T 613/97**, **T 54/00** and **T 434/00**). In these cases the patent had been maintained in amended form by the opposition division (for more details about the relationship between main and auxiliary requests, see also chapter VI.G.3, main and auxiliary requests). To establish

whether a party has been adversely affected, it is necessary not only to compare his objective with the substance of the decision but also to check that he was thus affected at the time the contested decision was delivered and the appeal filed (see **T 244/85**, OJ 1988, 216). An appeal is inadmissible where the appellant is seeking only to amend not the decision itself but the reasons for it (**T 84/02**) or the sole aim is to settle a point of law not relevant to the case (**J 7/00**), although here the board did decide to rule on the issue (see also **T 1790/08**). Abandoning claims to have a prompt decision in order to be in a position to appeal also results in the appeal being inadmissible where the patentee's requests were actually granted (**T 848/00**).

In **T 298/97** (OJ 2002, 83), the board held that where the notice of appeal is filed by an adversely affected party but the grounds of appeal are filed by a natural or legal person who, although having economic connections with that adversely affected party, is not itself that party, the appeal cannot be held admissible.

a) Patent applicant

In **J 12/83** (OJ 1985, 6) the board found that an applicant for a European patent might be "adversely affected" within the meaning of Art. 107 EPC 1973 by a decision to grant the patent, if the patent was granted with a text not approved by him under Art. 97(2)(a) EPC 1973 and R. 51(4) EPC 1973. In **J 12/85** (OJ 1986, 155) the board held that he could be "adversely affected" within the meaning of Art. 107 EPC 1973 only if the grant decision was inconsistent with what he had specifically requested (see also **T 114/82** and **T 115/82**, both OJ 1983, 323 and **T 1/92**, OJ 1993, 685). **J 5/79** (OJ 1980, 71) ruled that an applicant whose priority right was found to have lapsed because he failed to file the priority documents was no longer adversely affected if re-established in his rights before the application was published.

An applicant was 'adversely affected' and thus able to file an appeal where the examining division had rectified its decision but refused to grant reimbursement of the appeal fee (**J 32/95**, OJ 1999, 713).

The grounds forming the basis of a decision on rectification should not be interpreted to mean only the legal basis of the decision, but also the factual reasons supporting the legal basis. An applicant adversely affected by the factual basis was thus considered adversely affected in **T 142/96**.

b) Patent proprietor

In **T 73/88** (OJ 1992, 557) the board ruled that if a patentee's request that his patent be maintained was upheld by a decision of the opposition division, he could not appeal against adverse reasoning in the decision (here, regarding his claim to priority) because he was not adversely affected by it within the meaning of Art. 107 EPC 1973.

In **T 457/89**, by analogy with **G 1/88** (OJ 1989, 189), the board took the view that the appellant (patentee) was adversely affected by the decision revoking his patent, despite failing to comment on a communication within the time specified in an opposition

division's invitation under Art. 101(2) EPC 1973 and R. 58(1) to (3) EPC 1973. For, according to **G 1/88**, wherever non-compliance could lead to loss of rights, the EPC 1973 always expressly indicated this and Art. 101(2) EPC 1973 made no provision for any loss of rights.

One of the principles representing the fundamental value of legal procedural certainty was that a party was not to be regarded as adversely affected within the meaning of Art. 107 EPC 1973 by a decision which granted his final request. A request under R. 88 EPC 1973 for correction of a document as the sole reason for the appeal was inadmissible. (**T 824/00**, OJ 2004, 5). In this case the proprietor had requested correction under R. 88 EPC 1973 of his letter withdrawing all requests (see also **T 961/00** and **J 17/04**). In the latter decision the board found that although the notice of appeal only referred to a correction of the decision under appeal under R. 88 and 89 EPC 1973, he made therewith (implicitly) the allegation that the decision under appeal incorrectly limited the regional scope of the patent and that this decision should be set aside. The board was therefore satisfied that the appellant had sufficiently claimed to be adversely affected and the appeal was admissible. In **T 537/05** the appellant was held adversely affected by the decision under appeal granting the patent in an amended form on the basis of the appellant's main request, because this request was not submitted until after the opposition division had 'decided' that the subject-matter did not meet the requirements of Art. 56 EPC 1973. Giving the wording its true meaning, the opposition division had thus revoked the patent, its actions after the decision were *ultra vires*, and the patent proprietor thus adversely affected and entitled to appeal.

The argument that the discovery of a prior art disclosure in national proceedings meant that the patent proprietor had subsequently become adversely affected was rejected in **T 591/05** - by granting the patent the department of first instance had acceded to the then valid request of the appellant. Furthermore, the suspensive effect of the appeal was a direct consequence of, and was subordinate to the appeal itself (Art. 106(1) EPC 1973) and, consequently, no circumstance directly arising from the suspensive effect of the appeal could be invoked in support of the admissibility of the appeal itself.

In **T 332/06** the patent proprietor's appeal was admissible at the time it was filed but became inadmissible when the statement of grounds was received. In the latter, the patent proprietor only contested that portion of the decision relating to the claims for the contracting state DE. The claims for DE, recognised as allowable by the opposition division in its interlocutory decision, were, however, identical to the corresponding claims according to the patent proprietor's main request, which was only rejected with respect to the remaining contracting states. The patent proprietor was therefore not adversely affected with respect to DE.

According to **T 1351/06**, a subsidiary request is only valid if the main request or higher-ranking subsidiary requests are not granted. Under Art. 113(2) EPC 1973, the EPO was bound by the applicant's requests. In the case in point, the main request had not been withdrawn and therefore remained pending. Consequently, the decision to grant a patent on the basis of the subsidiary request was contrary to Art. 113(2) EPC 1973. The appellant had therefore been adversely affected under Art. 107 EPC 1973.

c) Opponent

(i) Rule 82(1) EPC

Under R. 82(1) EPC (previously R. 58(4) EPC 1973), before the opposition division decides to maintain the patent as amended, it shall inform the parties of the text in which it intends to maintain the patent and shall invite them to file their observations within two months if they disapprove of that text.

The application of the previous, differently worded, rule by the department of first instance and also in many appeal proceedings led to a referral to the Enlarged Board in **T 271/85** (OJ 1988, 341). In **T 244/85**, for example, the board had held that silence in respect of a communication within the meaning of R. 58(4) EPC 1973 was to be interpreted as a sign of agreement to maintenance of the patent in the proposed form; an appeal by an opponent who had not notified his disagreement to maintenance of the patent as amended within the time limit under R. 58(4) EPC 1973 was inadmissible, because he could not claim to have been adversely affected. The point of law referred to the Enlarged Board was: "Is the appeal of an opponent admissible in a case where, following notification of the communication pursuant to R. 58(4) EPC 1973, he fails to make any observations within one month if he disapproves of the text in which it is intended to maintain the patent?" (The time limit is now two months.)

The Enlarged Board found in **G 1/88** (OJ 1989, 189) that the fact that an opponent had failed, within the time allowed, to make any observations on the text despite an invitation to do so under R. 58(4) EPC 1973 did not render his appeal inadmissible.

It reasoned that to regard silence as betokening consent would be tantamount to withdrawal of the opposition with consequent surrender of the right to appeal. Surrender of a right could not, however, be simply presumed. Deeming silence to be equivalent to surrender would also be inconsistent with the logic of how the Convention operated, since it would be at odds with its basic drafting philosophy and with the way in which it dealt with the loss of rights. Where the legal consequence of an omission was to be a loss of rights, this was expressly stated. It also had to be remembered that under Art. 164(2) EPC 1973 the Implementing Regulations had always to be interpreted in the light of the Convention.

Consequently, the interpretation of the Implementing Regulations which corresponded most closely to the principles of the Convention prevailed. It was a principle of the Convention, however, that parties' rights were safeguarded by the possibility of appeal to at least one higher-ranking tribunal. The Implementing Regulations should therefore be construed in such a way that R. 58(4) EPC 1973 was not allowed to interfere with the right of appeal under Art. 106 and 107 EPC 1973. The teleological interpretation, that is to say interpretation in the light of the sense and purpose of the procedure under R. 58(4) EPC 1973, lead to the same goal.

In **T 156/90** the opponent had stated that he would have no objection to maintenance of the patent if the claims were amended in a specified way. The patent proprietor

amended the claims accordingly. However, the opponent appealed against the interlocutory decision maintaining the patent as thus amended, arguing that the circumstances had changed and he was no longer bound by his consent. The appeal was dismissed as inadmissible.

In **T 266/92**, on the other hand, the opponent had declared in opposition proceedings that he would withdraw his request for oral proceedings if the patentee agreed to an amended wording of the patent, as indeed he did. The opposition division maintained the patent in amended form. The opponent appealed, requesting that the patent be revoked. The patentee took the view that the opponent had not been adversely affected because by withdrawing his request for oral proceedings he had implicitly approved the wording of the patent. The board of appeal disagreed, holding that withdrawal of a request for oral proceedings did not in itself imply withdrawal of any other existing request. There might be reasons other than consent - such as a wish to save costs or obtain a quicker decision - for a party who originally asked for oral proceedings to drop his request. Accordingly, the board concluded that the appellant was adversely affected within the meaning of Art. 107 EPC 1973, and was entitled to appeal.

In **T 299/89** the board considered the extent of entitlement to appeal of an opponent who in his opposition had requested only partial revocation but in his appeal wanted the whole patent revoked. It decided that this was determined by the scope of the original request made in the opposition. The opponent was only adversely affected within the meaning of Art. 107 EPC 1973 to the extent that this request was not granted, and he could not on appeal file a wider request.

In **T 833/90** the board held that an appeal should be considered admissible if it was not clear or ascertainable whether the opponent (appellant) had agreed to maintenance of the patent. This was followed in **T 616/08**.

(ii) General

An opponent is not adversely affected by obiter dicta reasons given in a revocation decision and favourable to the patent proprietor, and which it is appropriate for the opposition division to include to obviate remittal in the event of revocation being reversed on appeal (**T 473/98**, OJ 2001, 231).

In **T 273/90** the board concluded that legal uncertainty arising from inadequate adjustment of the description to amended claims constituted sufficient grievance under Art. 107 EPC 1973, as the commercial interests of the appellant (opponent) could be adversely affected (likewise **T 996/92**).

In **T 1178/04** (OJ 2008, 80) the board found the appeal filed by the opponent admissible even where the validity of the opponent's status was challenged following a disputed transfer, as a person was a party to proceedings for the purposes of Art. 107 EPC 1973 even if his entitlement to take part in such proceedings was brought into question. A decision that he was not entitled to take part in the proceedings would have the effect

that he was no longer entitled to take part in the proceedings, but not that he had never been a party.

7.5. Form and time limit of appeal

Notification of the case number and the responsible board of appeal by the registry did not constitute a decision under R. 69(2) EPC 1973 recognising that an appeal was pending (**T 371/92**, OJ 1995, 324; see also **T 1100/97** and **T 266/97**). See now R. 112 EPC.

7.5.1 Electronic filing of appeal

Under Art. 108 EPC 1973, notice of appeal had to be filed in **writing** within two months after the date of notification of the decision under appeal. Thus an appeal filed via electronic means (epoline[®]), not being "in writing" was rejected as inadmissible in **T 781/04** and **T 991/04**, referring to the EPO Notice dated 9.12.2003 concerning the My epoline[®] portal. Under Art. 108 EPC, the requirement 'in writing' has been deleted - in view of the future use of electronic means of communication, it was considered useful to avoid references to 'in writing' or 'in written form' and leave such regulation to the Implementing Regulations. Art. 108 EPC now states that the notice of appeal shall be filed in accordance with the Implementing Regulations. Referring to **T 781/04**, **T 991/04** and **T 514/05**, the board in **T 765/08** stated that documents purporting to be documents filed subsequently for the purposes of R. 2(1) EPC (here the notice of appeal) must be deemed not to have been received if they are filed by technical means not approved by the President of the EPO (here, electronically transmitted).

According to the Decision of the President of the European Patent Office dated 26 February 2009 concerning the electronic filing of documents, (OJ 2009, 182) ("2009 Decision"), documents in proceedings under the EPC may now be filed with the EPO in electronic form as from 5.03.2009.

The board in **T 1090/08** granted re-establishment of rights to an appellant in a decision dated subsequent to the entry into of force of the 2009 Decision, where the appellant had filed the statement of grounds of appeal via epoline[®] prior to the entry into force of the 2009 Decision and therefore inadmissibly.

In **T 1427/09** the notice of appeal and statement of grounds were filed in due time but the electronic signatures were not issued to a person authorised to act in the proceedings, in contravention of Art. 8(2) of the 2009 Decision, which is silent on the legal consequences of non-compliance. The board held that the principle that the signature of an unauthorised person should be treated like a missing signature, as set out in **T 665/89**, should apply not only to handwritten signatures, but also to electronic signatures. The electronic filing of a document in appeal proceedings accompanied by the electronic signature of an unauthorised person should therefore be treated under R. 50(3) EPC like the filing of an unsigned document per mail or telefax in the same proceedings.

7.5.2 Form and content of notice of appeal

R. 99(1) EPC defines the content of the notice of appeal to be filed within the period specified in Art. 108 EPC, taking up the requirements mentioned in Rule 64(a) and (b) EPC 1973. Under R. 99(1) EPC the notice of appeal shall contain, under R. 99(1)(a) EPC, the name and address of the appellant, under R. 99(1)(b) EPC an indication of the decision impugned and under R. 99(1)(c) EPC, a request defining the subject of the appeal.

However, under R. 64(b) EPC 1973, the appellant already had to include in the notice of appeal a statement identifying the extent to which amendment of the impugned decision was requested. This rarely presented a problem in appeals filed by an opponent; as a rule, an opponent would request that the decision impugned be set aside and the patent revoked (partially or in its entirety). However, where the appellant is the patent proprietor, the amended claims are nearly always filed with the statement of grounds of appeal, and it is only then that the precise nature of the requested amendment of the decision impugned becomes apparent. Consequently, this requirement has been moved to R. 99(2) EPC, which defines the content of the statement of grounds of appeal; before, this had been left to board of appeal case law under Art. 108, third sentence, EPC 1973.

a) Rule 64(a) EPC 1973 (see Rule 99(1)(a) EPC)

In decision **T 483/90** the board held that the appellants were sufficiently identified if, in the notice of appeal, their name was incorrectly given and their address was missing but the number of the contested patent and the name and address of the professional representative were the same as those cited in previous proceedings and the appellants were referred to as the opponents in those proceedings. In **T 1/97** the board held that the notice of appeal should contain the true name of the appellant. If not, the deficiency could be corrected under R. 65(2) EPC 1973.

In **T 613/91** the appellant's precise address was missing from the notice of appeal, but was known to the parties and the board from the opposition proceedings. The board held that there was sufficient information for identification within the meaning of R. 64(a) EPC 1973. In **T 774/05**, the appeal was rejected as inadmissible, as the appellant's address was not given in the notice of appeal. In accordance with R. 65(2) EPC 1973, the board had invited the appellant to remedy the deficiency within a time limit set by the board, but the appellant failed to do this within the set time limit. The effect of the failure to observe the time limit was clearly set out in R. 65(2) EPC 1973. This rule obliged the board to reject the appeal as inadmissible. The appellant requested an extension of the time limit for remedying the deficiency. However, according to R. 84, last sentence, EPC 1973 such requests had to be filed before the expiry of the time limit in question. Since the legal effects of the failure to meet the time limit became effective immediately after the time limit ran out a retrospectively granted extension was not possible.

In **T 867/91** the notice of appeal designated the patent in suit by its number and the decision under appeal by its date. It also contained the name of the patentee, as well as the name and address of the appellant's representative. It did not contain the address of

the appellant and did not expressly state that the patentee was the appellant. The board held that the requirements of R. 64(a) EPC 1973 had been met since the notice of appeal provided sufficient information to identify the appellant and his address.

Correction of the name of the appellant to substitute a natural or legal person other than the one indicated in the appeal was allowable under R. 65(2) EPC 1973 in conjunction with R. 64(a) EPC 1973, if it was the true intention to file the appeal in the name of the said person and if it could be derived from the information in the appeal, if necessary with the help of other information on file, with a sufficient degree of probability that the appeal should have been filed in the name of that person (**T 97/98**, OJ 2002, 183; see also **T 15/01**, OJ 2006, 153, **T 715/01**, **T 707/04** and **T 875/06**).

An appeal filed by an appellant whose name was changed before the appeal was filed without indicating the change of name met the requirements of R. 64(a) EPC 1973, provided that the appellant was identifiable (**T 157/07**).

b) Rule 64(b) EPC 1973 (see Rule 99(1)(b) and (c) EPC)

See 7.5.2 above for the amendments made to R. 64(b) EPC 1973, now R. 99 EPC. Under R. 64(b) EPC 1973, the notice of appeal had to contain a statement identifying the decision which was impugned and the extent to which amendment or cancellation of the decision was requested. Under Rule 99(1)(b) and (c) EPC, the notice of appeal shall contain an indication of the decision impugned and a request defining the subject of the appeal.

According to **J 16/94**, (OJ 1997, 331), for a notice of appeal to comply with Art. 108, first sentence, EPC 1973 and R. 64(b) EPC 1973, it had to express the definite intention to contest an appealable decision. An appeal filed as a subsidiary request, i.e. conditional on the main request not being allowed by the department of first instance, was therefore inadmissible. This was because there should be legal certainty as to whether or not a decision was contested in view of, firstly, the time limit under Art. 108 EPC 1973, secondly, the further steps to be taken by the department of first instance under Art. 109 EPC 1973, and particularly in view of the suspensive nature of the appeal under Art. 106(1) EPC 1973. This was confirmed by **T 460/95** (OJ 1998, 588).

If the extent to which cancellation of the decision was requested was not expressly stated in the notice of appeal, the board would examine whether the relevant information could be determined from the totality of the appellant's submissions (see **T 7/81**, OJ 1983, 98 and **T 32/81**, OJ 1982, 225; see also **T 932/93** and **T 372/94**).

In **T 85/88** the appellant had filed the notice of appeal in due time. However, the statement identifying the extent to which cancellation of the decision was requested, required by R. 64(b) EPC 1973, was only submitted after expiry of the period for appeal. The board held that the extent of the request made on appeal could be inferred interpreting the notice of appeal in an objective way (see also **T 1/88**).

T 631/91, **T 727/91** and **T 273/92** confirmed the principle that the appeal's scope could be ascertained from the appellant's overall submissions if the request filed in the appeal proceedings did not make this clear. Since no indication was made to the contrary in the appellant's submissions, the board of appeal assumed that he wished to file a request in the appeal proceedings along the same lines as that filed in the opposition proceedings (see also **T 925/91**, OJ 1995, 469 and **T 281/95**).

According to **T 194/90**, this principle also applied where an appellant (patentee) appealed against revocation of his patent by the opposition division but without formally specifying his request. He was then regarded as maintaining unchanged the request made at the opposition stage.

In **T 632/91** the notice of appeal did not explicitly identify the extent to which amendment or cancellation was requested of the decision under appeal, which refused the sole version of the patent application. The board found that the wording "... we hereby file notice of appeal to the decision ..." had to and could only be construed as a request to set aside entirely the decision under appeal and to grant a patent on the basis of the documents of the European patent application to which the decision under appeal referred. The appeal thus fulfilled the requirements of R. 64(b) EPC 1973 and was admissible (see also **T 49/99**).

It was sufficient to establish admissibility of an appeal to put forward requests, accompanied by reasons why the decision under appeal did not meet the requests filed in the grounds of appeal (**T 445/97**).

If the only ruling in an opposition division decision was that the patent was revoked, a statement by the patent proprietor that he was appealing against the decision was invariably tantamount to his stating that he wished and hence requested that the decision be set aside in its entirety, because setting aside had to be unitary. Hence the content of the notice of appeal was what R. 64(b) EPC 1973 demanded as one of its requirements for an admissible appeal, i.e. a statement identifying the extent to which cancellation of the decision was requested (**T 407/02**).

According to **T 420/03**, the extent of the appeal within the meaning of R. 64(b) EPC 1973 had to be clear from the notice of appeal. The statement setting out the grounds of appeal could not in principle be used to complete, or amend, the extent of the appeal defined in the notice of appeal, if this statement was not filed within the two-month appeal period.

According to the board in **T 358/08**, R. 99 EPC has not altered the previous law as to the requirements of either the notice of appeal or the statement of the grounds of appeal as regards the appellant's requests. R. 99(1)(c) EPC is satisfied if the notice of appeal contains a request, which may be implicit, to set aside the decision in whole or, (where appropriate) only as to part. Such a request has the effect of 'defining the subject of the appeal' within the meaning of R. 99(1)(c) EPC. Nor is it necessary in the case of an appeal by an applicant or proprietor for the notice of appeal to contain a request for maintenance of the patent in any particular form. This is something which relates to 'the

extent to which [the decision] is to be amended', and which is therefore a matter for the statement of grounds of appeal under R. 99(2) EPC. This was confirmed in **T 509/07**.

c) Rule 99(3) EPC

R. 99(3) and 41(2)(h) EPC together make it clear that a notice of appeal must be signed by the appellant or his representative, but not that every single document in the notice has to be signed or that the signature has to be appended at a particular place or page. In the case in point, the debit order had been part of the notice of appeal, so the board held that the signature on it fulfilled the EPC requirements in question. The appeal in case **T 783/08** had therefore been validly filed.

7.5.3 Appeal filed within the time limit

In **T 389/86** (OJ 1988, 87) the board stated that an appeal which was filed after pronouncement of a decision in oral proceedings but before notification of the decision duly substantiated in writing complied with the time limit pursuant to Art. 108, first sentence, EPC 1973. See also **T 427/99** and **T 1125/07**.

Where the translation of the notice of appeal in an official language of the EPO was not filed in due time, the notice was deemed not to have been received according to Art. 14(5) EPC 1973 and the appeal not to have been filed (**T 323/87**, OJ 1989, 343; see also **T 126/04**). Where the notice of appeal was filed in a non-official language by a company not entitled to benefit from the provisions of Art. 14(4) EPC 1973 and a translation into an official language was filed on the same day, the notice of appeal was nonetheless deemed not to have been filed. In view of **G 6/91** (OJ 1992, 491), where the translation was filed at the same time as the original, the EPO could not take it as the "official" notice of appeal and ignore the original as superfluous. As further stated in **G 6/91** "a translation cannot become the original; whatever the date on which it is filed it remains a translation, with all ensuing legal consequences, including the possibility of correction to bring it into conformity with the original" (**T 1152/05**).

According to **T 1281/01** the legal fiction that the decision (under appeal) had been delivered on the tenth day following its posting (R. 78(2) EPC 1973) did not apply when it had actually been delivered to a previously authorised representative after she had notified the EPO that the file had been transferred to another representative. Pursuant to R. 82 EPC 1973, the decision under appeal was deemed to have been notified on the date it was received by the authorised representative and the appeal had thus been filed in due time.

Similarly, where an appellant was misled by the EPO into thinking that the decision issued was only a draft, being replaced by a second one, it was sufficient if he filed the appeal within four months of notification of the second written decision (**T 830/03**). Where the opposition division misleadingly issued two decisions, it sufficed if the statement of grounds of appeal was filed within the time limit applicable to the second decision, even if it was outside the time limit for the first decision (**T 993/06**).

7.5.4 Payment of appeal fee

If no written notice of appeal has been filed within the time limit the question has arisen whether merely paying the fee for appeal constitutes a valid means of lodging an appeal. In **T 275/86** the board had held that payment with EPO Form 4212 05.80 should be accepted as such a notice since it contained essentially the same information as was required in a notice of appeal within the meaning of R. 64 EPC 1973. However, the board in **J 19/90** stated that merely paying the fee for appeal did not constitute a valid means of lodging an appeal. This applied even if the object of the payment was indicated as being a "fee for appeal" relating to an identified patent application and the form for payment of fees and costs was used. This was confirmed in **T 371/92** (OJ 1995, 324), **T 445/98** and **T 778/00** (OJ 2001, 554), where the board also added that the failure to indicate the provisions of R. 65 EPC 1973 in the annex to the communication dealing with the possibility of appeal did not make this incomplete or misleading.

T 514/05 (OJ 2006, 526) also confirmed that merely paying the fee for appeal did not constitute a valid means of lodging an appeal. This applied even if the object of the payment was indicated as being a "fee for appeal" relating to an identified patent application and the form for payment of fees and costs was used.

7.6. Statement of grounds of appeal

Under Art. 108 EPC, within four months after the date of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations (see R. 99 EPC). Under R. 64(b) EPC 1973 already in the notice of appeal the appellant had to include a statement identifying the extent to which amendment of the impugned decision was requested. This requirement has now been moved to R. 99(2) EPC, which defines the content of the statement of grounds (see **T 358/08**); up to now this had been left to board of appeal case law under Art. 108, third sentence, EPC 1973, which case law is set out below. The revised Art. 108 EPC is applicable to European patents already granted, applications pending and applications filed on or after the time of the entry into force of the EPC 2000.

7.6.1 General principles

In two early decisions the boards of appeal established the principles applicable to the statement of grounds.

In **T 220/83** (OJ 1986, 249) the board ruled that the grounds for appeal should specify the legal or factual reasons on which the case for setting aside the decision was based. The arguments had to be clearly and concisely presented to enable the board and the other party or parties to understand immediately why the decision was alleged to be incorrect, and on what facts the appellant based his arguments, without first having to make investigations of their own. Whilst passages from the literature setting out the state of the art might - provided sufficiently precise reference was made to them in the grounds of appeal - be considered an integral part of the grounds, they could not by themselves form a sufficient statement of grounds. This principle was expressly

confirmed in many decisions, for example **T 250/89** (OJ 1992, 355), **T 1/88**, **T 145/88** (OJ 1991, 251), **T 102/91**, **T 706/91**, **T 493/95**, **T 283/97**, **T 500/97**, **T 1045/02** and **T 809/06** (see also **T 12/00**, where the case was contrasted with **T 220/83** and found to differ on the facts).

Further to these decisions, in **T 213/85** (OJ 1987, 482) the board stated that grounds sufficient for the admissibility of an appeal had to be analysed in detail vis-à-vis the main reasons given for the contested decision. If an opposition had been dismissed on the grounds of insufficient substantiation and the grounds for appeal merely disputed patentability without elaborating on the admissibility of the opposition, the appeal was inadmissible for lack of adequate substantiation (see also **T 169/89**).

Other decisions added to or applied these principles.

Grounds within the meaning of Art. 108 EPC 1973 could be deemed to be sufficient if new facts were submitted which removed the legal basis from the decision. That also applied where the grounds for opposition were based on new facts and there was no discussion whatsoever of the grounds for the opposition division's decision (**T 252/95**).

In **T 45/92** the appellant disputed the accuracy of the decision of the department of first instance because a mistake had been made when assessing inventive step. The board considered the appeal inadmissible for lack of grounds as the mistake was not very serious and the contested decision had only been based inter alia on this mistake, and the appellant had not discussed other considerations with respect to inventive step.

In **T 3/95** the opposition division had rejected the opposition, which was based on Art. 100(a) EPC 1973. The opponent based his appeal on the argument that the problem was not disclosed and not solved and that the requirements of Art. 83 EPC 1973 were not met. The board found the appeal to be admissible since the second argument, although specifically referring to Art. 83 EPC 1973, related not only to the sufficiency of disclosure but also to inventive step insofar as the problem and solution approach required that the problem to be solved be defined objectively, i.e. in such a way for it to be credible that this problem was solved by the claimed subject-matter.

The fact that the points made in the statement of grounds of appeal did not go beyond those made before the opposition division did not detract from the admissibility of an appeal. A requirement that new arguments be submitted to render an appeal admissible would have implied that the appealed decision must have been correct. Nor did the appeal need to have a strong prospect of success. Moreover, the subsequent withdrawal of a relevant objection already substantiated in the statement of grounds of appeal could not retrospectively detract from the admissibility of the appeal as filed (**T 644/97**). Irrelevancy and lack of cogency might lead to an unsuccessful outcome of the appeal, but did not of themselves render it inadmissible (**T 65/96**). However, merely referring to one's own first-instance submissions could not normally replace an explicit account of the legal and factual reasons for the appeal. Only exceptionally did the case law allow substantiation to take that form. References to earlier submissions, even when taken together with the contested decision, did not as a rule clearly indicate which grounds of

the decision were regarded as mistaken, and why. The board and the opposing party could not then consider the merits of the appeal without making investigations of their own (**T 349/00**; see also **T 165/00**). Where the statement of grounds was filed within the time limit but concerned an entirely different case, the appeal was held inadmissible (**T 335/06**, although restitutio was granted).

According to **T 263/05** (OJ 2008, 329), Art. 10a(2) RPBA 2003 required a party wishing to argue that a decision under appeal should be upheld for a reason additional to the reason(s) already relied on by the opposition division, must, set out its complete case in respect of this additional reason, together with all facts, arguments and evidence relied upon.

The admissibility of an appeal can only be assessed as a whole (**T 382/96**). There is no support in the EPC for a notion of 'partial admissibility' of an appeal (**T 774/97**). The board in **T 509/07** thus found it immaterial for the purposes of the admissibility of the appeal whether or not sufficient grounds relating to the main request had been submitted, where the first auxiliary request clearly complied with the admissibility requirements of Art. 108, third sentence, EPC - where these requirements are fulfilled at least in respect of one request, the appeal as a whole will be admissible. However, it is a different question whether a request in relation to which the admissibility requirements of Art 108, third sentence, EPC are not met is admitted into the appeal proceedings. In **T 382/96** and **T 509/07**, such unsubstantiated requests were not admitted. See also **T 1763/06**.

7.6.2 Exceptions to these principles

In some cases, boards have considered appeals to be admissible even if their grounds did not meet the requirements described above. The case law of the boards of appeal was reviewed in **T 922/05** and much of it found to take a relatively lenient position. However, excessive leniency towards one party would rightly be perceived as an injustice towards the other. The board was of the opinion that submissions of a party which only made it possible for a board to **infer** a line of argumentation did not fulfil the requirements of either the "clear reasons" or the "**express** specification of facts and arguments" as prescribed by the RPBA.

a) Appeal does not give detailed reasons

In **J 22/86** (OJ 1987, 280) the board made it clear that where the written statement did not contain such full reasons, the requirement for admissibility might be regarded as satisfied if it was immediately apparent upon reading the decision under appeal and the written statement that the decision should be set aside.

In **T 1/88** the board considered that the criteria of **T 220/83** and **T 213/85** were satisfied by a statement of grounds in which it was merely argued by the appellant that a document, which allegedly showed that the process of the patent in suit was obvious, had not been properly evaluated. The question of inventive step, on the lack of which the

contested decision had been partly based, was not dealt with in detail. See also **T 1345/04**.

In **T 925/91** (OJ 1995, 469) the board held that if the opposition division had considered the merits of a case but nevertheless rejected the opposition as inadmissible, and if the appellant had only dealt with the substantive arguments in his statement of grounds for appeal, the grounds for appeal were not adequately defined (see **T 213/85**, **T 169/89** and **T 534/89**). However, since the action of the opposition division was erroneous and misleading (its decision having examined the substance of the opposition although considering it inadmissible), the principle of good faith (**G 5/88**, OJ 1991, 137) dictated that the appeal should nevertheless be held to be admissible.

In **T 574/91** the appellant merely argued that the opposition division "had missed the point", without discussing the reasons for the decision. The board considered this statement of grounds admissible, even though it did not discuss any of the arguments in the contested decision and the sole argument put forward bore no connection with the decision. In the absence of such specific objections on the part of the appellant, the appeal in this case was limited to a review of the grounds for revocation of the patent.

In **T 961/93** the board took the view that the opponent's appeal was sufficiently substantiated if the sole ground for the appeal was that the patent proprietor had submitted a request for the patent to be revoked (see also **T 459/88**, OJ 1990, 425).

In **T 898/96** an applicant did not approve the text of the patent (R. 51(4) EPC 1973), but requested grant with an amended text. The examining division refused the application. On appeal the applicant stated that the appeal was "substantiated by the fact that the grant of the patent is now requested in the form that was previously allowed (see case **T 139/87**, OJ 1990, 69)." The appeal was held admissible.

In **T 934/02** the board decided that an appeal may be substantiated by filing amended claims which deprive the contested decision of its basis even though it does not state any specific reasons why the contested decision is wrong. It would therefore be unnecessary, for the purpose of adequately substantiating an appeal, to file grounds in support of a version of a claim that the appellant (patent proprietor) no longer defends in the appeal proceedings. The board referred to the established case law of the boards according to which an appeal is sufficiently substantiated even if it does not give the reasons why the decision is contested, provided two criteria are met: (i) the subject of the proceedings has changed, e.g. due to the filing of a new set of amended claims together with the statement of grounds; and (ii) the reasons for the decision are no longer relevant in view of the change in the subject of the proceedings. In **T 1276/05**, the board noted that the lack of a need for explanation was based on the specific situation of the case before it, wherein - unusually - the offered amendments self-evidently overcame the grounds for the decision and the appeal was thus admissible.

- b) Appeal is based only on facts which existed already at the time the first instance proceedings took place but which were not put forward during the proceedings (fresh case)

In **T 611/90** (OJ 1993, 50) the statement of grounds developed an entirely fresh case on lack of novelty based on a public prior use first put forward in the appeal stage and did not discuss the reasons upon which the contested decision was based. The board considered the appeal to be admissible because the fresh reasons presented, although unconnected with those in the decision under appeal, were still within the same opposition ground (see also **T 938/91**, **T 3/92**, **T 219/92**, **T 229/92**, **T 847/93**, **T 708/95** and **T 191/96**).

An appeal unconnected with the reasons given in the appealed decision (lack of inventive step) and directed only to a new ground for opposition (lack of novelty) based on a new document is contrary to the principles laid down in decisions **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), according to which an appeal should be within the same legal and factual framework as the opposition proceedings. It is tantamount to a new opposition and is thus inadmissible (**T 1007/95**, OJ 1999, 733).

- c) Appeal is based only on evidence first introduced with the appeal even if it already existed and was known at the time the first instance proceedings took place

In **T 389/95** an appeal was filed on existing grounds for opposition but based solely on new evidence introduced in the grounds of appeal. The board found the appeal to be admissible because the issue of new factual framework was one of fact to be determined objectively as part of the substantive examination of the appeal. Opinion **G 10/91** allowed even a fresh legal ground for opposition to be considered in appeal proceedings if the patentee approved and it followed from this, that an appeal based solely on such a ground was not ipso facto inadmissible; by the same token an appeal based on the same legal ground, albeit on a completely fresh factual framework, might be admissible. See also **T 932/99**. According to **T 1029/05**, it was the consistent jurisdiction of the boards of appeal that an appeal was not to be considered inadmissible merely because it was based on evidence submitted for the first time with the grounds for appeal. See also **T 1082/05**.

- d) Appeal is only based on new requests

The board of appeal held in **T 729/90** that an appeal could be admissible if, despite its not being clear from the statement of grounds why the contested decision was incorrect, claims were put forward in auxiliary requests which overcame the objections of the department of first instance (see also **T 105/87** and **T 563/91**; for the question of whether the appellants are adversely affected see chapter VII.E.7.4.2, party adversely affected).

An appeal requesting maintenance in full of the patent in suit, yet submitting a new amended claim was found admissible in **T 162/97**. It was clear from the statement of grounds that the appellant considered the reasoning in the decision under appeal no longer applied in view of the amended claim. The statement of grounds also explicitly

indicated a causal link between the amended claim and the reasons given in the decision under appeal. See also **T 1197/03** and **T 642/05**.

However, where an application was refused under Art. 97 EPC 1973 and R. 51(5) EPC 1973, on the grounds that the applicant neither communicated his approval of the text proposed for grant within the period according to R. 51(4) EPC 1973 nor proposed amendments within the meaning of R. 51(5) EPC 1973 within this period, a statement of the grounds of appeal which dealt only with the issues of the admissibility and allowability of new claims filed with the statement was inadmissible (**T 733/98**).

7.6.3 Change of circumstances after delivery of the decision

The above principles could not be applied in cases where the facts changed after the decision had been reached, so that the decision was based on reasons which were no longer valid.

In **J ..87** (OJ 1988, 323) the board considered that the grounds on which the appellant relied, although based on a new fact which it would have been more appropriate to refer to the department of first instance, represented sufficient grounds of appeal, given that if this new fact were confirmed, the contested decision would no longer have any legal basis.

In **J 2/87** (OJ 1988, 330) and **T 195/90** the board took the view that the minimal requirements of Art. 108 EPC 1973 were satisfied when the notice of appeal could be interpreted as containing a request for rectification of the decision concerned on the grounds that, since the conditions enunciated in an earlier communication from the EPO were now fulfilled, the decision was no longer justified.

The circumstances must already have changed by the time of the filing of the statement of the grounds of appeal. In **T 22/88** (OJ 1993, 143), the board held that a written statement announcing only that the appellant would complete an omitted act did not comprise sufficient reasons, and therefore did not constitute a valid statement of the grounds of appeal. According to **T 387/88** it was sufficient to state that the act whose omission formed the basis of the decision had been completed.

7.6.4 Reference to an earlier submission

The boards have often been faced with the question of whether a statement of grounds which referred to submissions made in the first-instance proceedings was sufficient. In principle, a statement of grounds which merely referred generally to previous submissions was not considered sufficient (see **T 254/88**, **T 432/88**, **T 90/90**, **T 154/90**, OJ 1993, 505; **T 287/90**, **T 188/92** and **T 646/92**). The few decisions recognising such submissions as possible grounds for an admissible appeal concerned special cases in which the arguments presented at first instance already adequately addressed the grounds underlying the contested decision. Whether a statement of grounds met the requirements of Art. 108 EPC 1973 could only be decided on a case-by-case basis (**T 165/00**).

Some earlier decisions accepted referral to earlier submissions as sufficient, for example **T 355/86** and **T 140/88**. In **T 725/89** a written submission to the opposition division, commenting on the result of the oral proceedings and received by the opposition division before it sent out its written decision, was used as the statement of the grounds of appeal and was accepted by the board as a valid statement of grounds.

7.6.5 References to other documents

The question also arose as to whether a reference to other documents constituted an adequate statement of grounds.

Where attention was drawn in the statement of grounds to a passage in the description, but no submissions made in support of the allowability of the claim, the statement of grounds was held inadmissible (**T 145/88**, OJ 1991, 251).

However, where the appellants alleged lack of inventive step, merely referring generally to several documents, the statement of grounds was held to be sufficient, as the conclusions which the appellants wished to be drawn from these documents were evident (**T 869/91**). In **T 100/04**, reference in the statement of grounds to a letter submitted earlier was allowed, even though the letter was referred to with the wrong date, as the error was immediately obvious.

According to **T 624/04**, the duty to attach copies of papers referred to in the statement of grounds of appeal, as imposed by the original version of Art. 10a(2), third sentence, RPBA 2003, did not constitute a requirement for the admissibility of an appeal. From the entry into force of the amended version of that provision, i.e. from 1 January 2005, copies of such papers were deemed to have been filed.

8. Parallel proceedings

The board in **T 18/09** stressed that, in the case of parallel proceedings before a national court and the boards of appeal, parties should inform both tribunals of the position as early as possible and ask the appropriate tribunal for acceleration in order to avoid duplication of proceedings. Whether acceleration is requested by one party, or both or all parties in agreement, or by a national court, all parties must accept a strict procedural framework including short time limits. It must also be understood that acceleration can have no effect on the equal treatment of all parties and cannot confer any advantage on any one party.

9. Conclusion of the decision-making process

9.1. Closure of the substantive debate

The EPC does not prescribe when the substantive debate should be regarded as closed. Particularly if oral proceedings take place but end without a decision being delivered, it has often had to be decided whether or not subsequently filed documents should be

taken into consideration. A distinction needs to be made between the following situations:

- (i) the board does not announce its decision at the end of the oral proceedings, but reserves the right to deliver its decision subsequently in writing, but without explicitly stating that the debate is closed;
- (ii) the board declares at the end of the oral proceedings that the debate is closed and announces that the decision will follow in writing.

In the first case, the boards have generally found that submissions filed after the oral proceedings were out of time and could be considered only if they were relevant (Art. 114(2) EPC 1973). See, for example, **T 456/90** and **T 253/92**.

In the second case, two solutions have been adopted by the boards. One - adopted in **T 762/90** - consists of stating under "Summary of facts and submissions" that a document was filed after closure of the debate and that the board would not consider it. Under this option, the document was automatically excluded from the file. This solution was also adopted in **T 411/91**.

The other solution - adopted in **T 595/90** (OJ 1994, 695) - is to rule that submissions filed after closure of the debate could not be taken into account unless the board decided to reopen the debate. Under this option the submission had by implication to be examined.

In **T 1629/06**, the day before the oral proceedings, the appellant announced its intention not to attend the oral proceedings and requested, without reasons, that the procedure be continued in writing. The board dismissed the request.

9.2. Decision taken as the file stands

In **T 784/91** the board took the view that if in ex parte proceedings the appellant indicated that he did not wish to comment on the case, this could be construed as signifying agreement to a decision being taken on the case as the file stood.

9.3. Proceedings after delivery of the decision

In **T 843/91** (OJ 1994, 818) it was stated that once a decision had been taken the board was no longer empowered or competent to take any further action apart from drafting the written decision (see also **T 296/93**, OJ 1995, 627, where the board disregarded statements filed after the announcement of the decision, and **T 515/94**). In **T 304/92** the respondent's request to file new claims after the chairman had announced the board's decision was rejected, but recorded (with the response) in the summary of facts.

However, in **T 212/88** (OJ 1992, 28) a request for apportionment of costs submitted after the substantive decision had been announced at the end of the oral proceedings had been, exceptionally, admitted. Although the practice of the boards was that all requests by parties, including any request as to costs, should be made before any decision was

announced in oral proceedings, this practice had not been published and so there was no reason why parties or their representatives should have been aware of it. In **T 598/92** an error in a claim was corrected at the request of the appellant one day after the decision was delivered at the end of oral proceedings.

9.4. Interlocutory decisions of a board

The finding that an appeal is admissible may be given in an interlocutory decision. Art. 110(1) EPC and R. 101 EPC show that the boards have to examine whether an appeal is admissible before considering its merits. An interlocutory decision might be appropriate where the points of law concerning admissibility are of general significance and require a speedy decision (see **T 152/82**, OJ 1984, 301; and also **T 109/86** of 20.7.1987).

The boards have also issued interlocutory decisions on re-establishment in respect of the time limits for appeal (**T 315/87** of 14.2.1989 and **T 369/91**, OJ 1993, 561), on the admissibility of an opposition (**T 152/95** of 3.7.1996), and to inform the public rapidly (pending the final decision) that a mention of grant in the European Patent Bulletin was incorrect because of the appeal's suspensive effect (**J 28/94**, OJ 1995, 742). Referral of a point of law to the Enlarged Board is also an interlocutory decision.

10. Remittal to the department of first instance

10.1. General

Under Art. 111(1) EPC, (which remains unchanged apart from a minor editorial amendment in French), the board of appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed.

10.2. Remittal following filing or late submission of relevant new document

10.2.1 General

If a new citation (such as an anticipatory document) is filed during opposition appeal proceedings, the question arises whether the case is to be remitted to the department of first instance. In board of appeal case law (see **T 258/84**, OJ 1987, 119; **T 273/84**, OJ 1986, 346; **T 215/88**, **T 611/90**, OJ 1993, 50; **T 621/90**, **T 166/91**, **T 223/95**), the prevailing view is that, if a document filed for the first time in opposition appeal proceedings is relevant enough to be taken into consideration, the case should as a rule be remitted under Art. 111(1) EPC 1973 to the department of first instance so that the document can be examined at two levels of jurisdiction and the patent proprietor is not deprived of the possibility of subsequent review. However, it is established board of appeal practice that where the board comes to the conclusion that the document is not such as to prejudice the maintenance of the patent, the board may itself examine and decide the matter under Art. 111(1) EPC 1973 (**T 326/87**, OJ 1992, 522; **T 416/87**, OJ 1990, 415; **T 626/88**, **T 457/92**, **T 527/93**, **T 97/90**, OJ 1993, 719).

In **T 1913/06** documents filed with the opponent/appellant's grounds of appeal were admitted into the proceedings and the respondent's request for remittal refused, taking into consideration the imperative of procedural efficiency and the public interest in a streamlined and efficient procedure. The patent was revoked on the basis of the admitted documents. See also **T 1007/05**.

Similarly in ex parte appeal proceedings, if a document is relied upon for the first time during the appeal proceedings and it is admitted because it is relevant, the case has often been remitted to the department of first instance (see e.g. **T 28/81**, **T 147/84**, **T 170/86**, **T 198/87**, **T 205/87**).

In **T 1070/96** the board stated that even though as a rule, a case should be remitted to the department of first instance, if a new document is so relevant that it has considerable influence on the decision to be taken, a remittal is not appropriate if the board is able to deduce from the reasoning of the decision under appeal how the opposition division would have decided had it known of the late-filed document.

In **T 111/98** the board held that the amendment of the claims in response to the citation of a new document during appeal proceedings was not as such a sufficient reason to remit the case to the department of first instance. Remittal remained at the discretion of the board.

In **T 611/00** the appellant relied on the same grounds of opposition as it had at first instance, but it based its appeal on completely new evidence. The board held that in order to admit this new evidence it had to balance two demands of public interest, that of procedural fairness and that of preventing unwarranted monopolies. If the board found that the documents should be taken into account, it had to ensure that the respondent received fair procedural treatment in the further conduct of the case. Therefore the request for the case to be remitted to the department of first instance had to be allowed.

In **T 736/01** the board stated that since it was not the function of an appeal to examine and decide upon a fresh case resulting from the newly submitted and admitted prior art (see **T 26/88**, OJ 1991, 30; **T 611/90**), it would exercise its discretion under Art. 111(1) EPC 1973 and remit the case to the opposition division.

In **T 361/03** a document submitted by the appellant (opponent) one month before the oral proceedings fundamentally altered the factual framework of the case under appeal. The board admitted the document but held remittal justified. This had the twofold purpose of allowing this fresh case to be examined at two levels of jurisdiction and of giving the respondent a reasonable opportunity to consider possible fallback amendments and possible evidence that could be produced in defence of such amended requests.

In **T 991/01** the examining division sent the appellant a computer-generated translation of a Japanese patent application after the oral proceedings before it, and no copy was kept in the file, so that the board of appeal was unaware of its existence until the appellant referred to it in the oral proceedings before the board. The case was remitted.

The appropriateness of remittal to the department of first instance is a matter for decision by the boards of appeal, which assess each case on its merits.

10.2.2 Patent in jeopardy

In **T 326/87** (OJ 1992, 522) the board added that remittal to the department of first instance is particularly desirable if the new citation puts the maintenance of the patent at risk: where this is not the case, the board itself may decide on the matter, as for example in **T 253/85**, **T 49/89**, **T 565/89** and **T 881/91**.

In **T 638/89** the board of appeal followed this line of argument in remitting the case to the opposition division because a document cited for the first time in the statement of grounds for appeal was highly relevant and should therefore be admitted into the proceedings.

That remittal is not automatic where the patent is at risk is shown by **T 1060/96**. Here the respondent had had one year to challenge consideration of a document submitted by the appellant (opponent) during the appeal procedure and one year prior to oral proceedings. Moreover, the document was technically very simple and merely reinforced the teaching of known documents. The board refused the respondent's request for remittal and revoked the patent.

10.2.3 New facts

In **T 125/93**, where a highly relevant document was filed by the patentee shortly before the date appointed for oral proceedings, the board admitted it into the proceedings pursuant to Art. 114(1) EPC 1973, which had the concomitant effect of altering the factual framework of the case under appeal compared with that upon which the decision under appeal had been based. The legal consequence of such a shift in the framework being well settled, and there being no "special reasons" of the kind referred to by the Enlarged Board in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), the board referred the case back to the opposition division for further prosecution.

In **T 611/90** (OJ 1993, 50) the appellants (opponents) presented an entirely fresh case - based on public prior use instead of the previously-cited ground of prior publication - in their statement of grounds for appeal. The board explained that it may, subject to the circumstances, be inappropriate for an appeal board to deal itself with the allowability of such an appeal, raising as it does a case quite different from that on which the contested decision is based. The public's and the parties' interest in having the proceedings speedily concluded may then be overridden by the requirement that appeal proceedings should not become a mere continuation of first-instance proceedings. To ensure fairness to both parties, the board remitted the case to the opposition division. It admitted the late-filed material into the proceedings but decided that the party responsible for the late submission should bear all the additional costs arising from it (see also **T 847/93**).

In **T 97/90** the board referred to **T 611/90** and confirmed that if fresh evidence, arguments or other matter filed late in the appeal proceedings raised a case substantially

different from that on which the contested decision was based, the case should be remitted to the department of first instance where this was demanded by fairness to both parties. However, this did not imply that all cases in which a new ground of objection was raised late in the appeal must be remitted to the department of first instance. On the contrary, this should only be done if the admission of the new ground into the appeal proceedings would lead to revocation of the patent.

In **T 852/90** the board of appeal acceded to a request from the appellants (opponents) for permission to introduce fresh evidence at the start of oral proceedings. The board confirmed that where a case on appeal turned out to be different from - or dissimilar to - the case decided by the department of first instance, it should be remitted to that department, pursuant to Art. 111(1) EPC 1973. In the case in point, however, the late-filed evidence amounted to no more than an amplification - albeit a significant one - of the case already canvassed before the opposition division. The board therefore decided that there was no need to remit the case.

In **T 402/01** of 21.2.2005 it was held that a patent proprietor had no automatic right of remittal after the citation of a new document with the grounds of appeal, even if there was a change in factual framework, at least in cases where the document was filed in reaction to amendment of the claim, providing that both parties' right to a fair hearing (Art. 113(1) EPC 1973) was not jeopardised.

10.3. Remittal following substantial amendment to claims in the appeal proceedings

The amendment of claims during an appeal from a decision to refuse a European patent application is a matter of discretion under R. 137(3), last sentence, EPC (unchanged from the previous R. 86(3), last sentence, EPC 1973).

According to **T 63/86** (OJ 1988, 224), where substantial amendments to the claims are proposed on appeal, which require substantial further examination, the case should be remitted to the examining division. In this way, the applicant's right to appeal to a department of second instance is maintained, both in relation to the exercise of discretion under (the then) R. 86(3) EPC 1973, and in relation to the formal and substantive allowability of the amended claims. Several boards of appeal have applied this case law in their decisions; e.g. **T 200/86**, **T 296/86**, **T 341/86**, **T 98/88**, **T 423/88**, **T 501/88**, **T 47/90** (OJ 1991, 486), **T 184/91**, **T 919/91**, **T 599/92**, **T 1032/92**, **T 1067/92**, **T 96/93** and **T 186/93**.

In **T 746/91** the board applied the principles laid down in **T 63/86** and remitted the case to the opposition division for it to examine and decide whether discretion should be exercised in favour of the appellant, and if so, whether the claims complied with the Convention provisions. The board took this view in the particular circumstances because the opposition proceedings had themselves been comparatively brief and had not involved the holding of oral proceedings. It had thus adhered to the principle whereby it should be established swiftly whether or not a patent can be maintained. Moreover, the

amended claims had been filed with the statement of grounds, i.e. at the earliest possible stage in the appeal proceedings.

In **T 462/94** the board stated that where in the appeal an entirely new situation had been created by the amendments made, the parties should be given the opportunity to defend their claims or submissions before two instances. The case was remitted to the department of first instance for further prosecution.

In **T 125/94** the board remitted the case to the department of first instance because the amended claims had not only substantially changed the factual framework of the contested decision, but could also require a search in an additional classification unit to determine the closest prior art.

According to the board in **T 1201/00**, if a case is likely to have to be remitted to the opposition division for it to assess the unexamined issue of inventive step, a new auxiliary request first submitted during oral proceedings before the board designed to overcome an objection of lack of novelty compared with a cited document may exceptionally be admitted and also remitted to the opposition division for final novelty examination against that document if none of the requests that took precedence can be granted for lack of novelty. The need for the department of first instance to assess inventive step against all the cited prior art means that novelty examination against one cited document would not entail a significant delay in the opposition proceedings.

Exercising its powers of discretion under Art. 111(1) EPC 1973, the board decided to admit the new auxiliary request and remit the case to the opposition division for a further decision on the issue. Any short delay that arose from novelty examination against a single document would be largely negligible in comparison with the unavoidable need to assess inventive step against all the cited prior art.

However, the amendment of the claims in response to the citation of a new document during appeal proceedings is not as such a sufficient reason to remit the case to the department of first instance (**T 111/98**). Following this decision, the board in **T 98/00** did not remit the case despite the appellant's request to do so, finding that it would make no sense if the boards were ipso facto obliged to remit the case whenever new matter was raised in appeal proceedings, irrespective of the nature of such matter.

In **T 908/07**, the board held that a late-filed claim admitted in the exercise of the board's discretion mainly because the board and the opponent could be clearly expected to deal with the issues raised without adjournment of the oral proceedings, should not normally be remitted to the department of first-instance for examination in respect of the grounds for opposition on which the first instance decision was based.

In **T 1300/06** the board recalled that, in accordance with **G 9/91** (OJ 1993, 408), in cases where Art. 100(c) EPC 1973 was not an original ground of opposition and the opposition division did not consider it necessary to use its discretion to introduce it into the opposition proceedings, the consideration of this Article for the granted claims at appeal stage was possible only with the patentee's consent. This, however, did not prevent the

board from examining anew the formal requirements of the Convention in respect of any other request containing amendments and filed in order to overcome original grounds of opposition. The fact that objections raised under these articles - and the arguments submitted therefor - might also have been relevant to the granted claims could not prevent the board from considering them in the context of the new amended request, since each request had to be considered on its own. The case was therefore remitted.

10.4. Remittal following a substantial procedural violation

Remittal to the department of first instance is normally also ordered where a substantial procedural violation occurred in the first instance proceedings (**T 125/91**, **T 135/96** and **T 1065/99**), even where the violation affects only one of two opponents (**T 125/91**). This is required by Art. 10 RPBA 1980, which provides that a board shall remit the case to the department of first instance if a fundamental deficiency is apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise (see e.g. **T 135/96**). If the composition of the opposition division was contrary to Art. 19(2) EPC 1973, the parties should be given the opportunity to comment before the board decided on the remittal of the case (**T 838/02**). Where the decision of the opposition division contained obvious mistakes, causing the decision under appeal to be contradictory and legally obscure such that it was unclear whether the appellant was adversely affected, this constituted a substantial procedural violation and the board remitted the case to the department of first instance for further prosecution (**T 616/08**). In **T 1077/06**, the board could not identify a legal basis in the EPC from which it could be concluded that a party, appealing against a decision of a department of first instance, which had been taken in violation of its right to be heard, had retrospectively abandoned its right to be heard before the department of first instance when it did not appear at oral proceedings before the department of second instance.

Remittal is, however, not appropriate in all cases:

Where the board was able, in ex parte proceedings, to decide in the appellant's favour, remittal was not considered necessary (**T 749/02**). The ensuing delay of a final decision in the case was not considered a special reason in **T 48/00**. Infringement proceedings before the German courts did not constitute a special reason in **T 914/98**, where the board held that the fundamental right of the appellants to a fair hearing before the opposition division had to outweigh any advantage that might accrue to the respondents by having the board deal fully with the case rather than remit it.

In **T 679/97**, despite a substantial procedural violation by the opposition division, the board decided not to remit, in view of the interest of the parties in having the case finally decided.

In **T 274/88** the board agreed that where an irregularity has been remedied during appeal proceedings, the matter should still normally be remitted to the department of first instance. However, in this particular case, which was ex parte, the board did not remit because, after correction, the subject-matter of the application was patentable, the appellants had expressly waived their right to have the issues considered at two

instances, and the examining division had already indicated that it was favourably disposed on the question of patentability.

10.5. Introduction of new arguments and amendment of the description

If no new documents are introduced, but merely arguments presented from a different point of view, or if the claims are maintained on the basis of an auxiliary request which the department of first instance has already indicated that it would be prepared to accept, then the desideratum of keeping the procedure as short as possible requires that there should be no remittal (**T 5/89**, OJ 1992, 348; **T 392/89** of 3.7.1990 and **T 137/90**).

The board in **T 1913/06** made it clear that a case should not be remitted to the department of first instance for consideration of submissions made at the oral proceedings which the board or the other party could not reasonably be expected to deal with without adjournment of the oral proceedings and which had not been admitted under Art. 13(3) RPBA).

Remittal to the department of first instance to bring the description into line with amended claims should be avoided if at all possible for reasons of procedural economy, and although Art. 111(1) EPC 1973 permits it (**T 977/94**).

10.6. Exercise of discretion to remit

There is no absolute right to have an issue decided upon by two instances. According to **T 83/97** it is not mandatory for the appellate instance to remit every time a fresh case is raised before it, i.e. the right to two instances might not in each and every procedural situation be an absolute right of the parties concerned. (In fact, the matter was remitted as the board found that it would have been a violation of Art. 113 EPC 1973 to have given a final decision on all outstanding substantive matters against the requests of the parties, who had had no advance warning of such a procedural possibility, and in view of the long-standing practice of the boards of appeal).

Similarly, in **T 249/93** the board held that remittal lay within the discretion of the board. Where remittal might mean that a final decision was not reached until after the expiry of the patent, the board would be inclined to decide the issue itself, unless there were strong reasons for not doing so.

Nor does Art. 32 TRIPS limit the board's discretion concerning remittal. In **T 557/94** the board held that Art. 32 TRIPS (which provides for the judicial review of any decision to revoke a patent) did not oblige the reviewing instance to remit the case to the department of first instance, where the department of first instance did not revoke the patent and the reviewing instance intended to deviate from the decision of the first instance. Art. 111 EPC 1973 empowered the board to decide on the merits of the case without restriction and it would be alien to at least the majority of legal systems in the EPC contracting states to limit the power of the reviewing instance in such a way that - dependent upon the "result" of the decision under attack - it would be bound to remit the

case to the department of first instance. Nor could it be assumed that the states negotiating TRIPS intended the introduction of such a limitation.

In the interests of overall procedural economy and effectiveness, the board in **T 473/98** (OJ 2001, 231) also found it entirely appropriate and desirable that an opposition division should include in the reasons for a revocation decision pursuant to Art. 102(1) EPC 1973 employing the standard decision formula, by way of obiter dicta, findings which could obviate a remittal in the event of the revocation being reversed on appeal. See also **T 915/98**. In **T 275/99** the board stated that, from a purely procedural point of view, no objection could be made to the fact that the examining division had left open the issue of inventive step in the appealed decision, and the case was remitted.

Although both the appellant and the respondents wished the board to make a final decision rather than remit the case to the opposition division, the board in **T 869/98** refused, pointing out that it is not normally the function of the appeal board to consider and decide upon questions which were raised for the first time during the appeal proceedings. As there had been no assessment of inventive step at all during the written appeal proceedings, the board exercised its discretion under Art. 111(1) EPC 1973 and referred the case back to the opposition division.

In **T 887/98**, on the other hand, the board held that remittal was not justified: the appellant (patent applicant) had indeed been able to put forward his arguments in proceedings at both first and second instance, and had been given plenty of time to study a document D2 before the oral proceedings. Furthermore, the examining division had found another document to be prejudicial to inventive step, so introducing D2 into the proceedings before it would not affect its decision. For these reasons, plus considerations of procedural economy, the board refused the appellant's request for remittal.

In **T 265/05**, the board explained that, when exercising its discretion under Art. 111(1) EPC 1973 either to decide or to remit the case, the board should take account of its particular circumstances and the parties' wishes (here the parties requested the board to decide the case). Given that the opposition division would have had to carry out any further examination of its own motion without the participation of the respondents, the only compelling reason the board could see for not allowing the request immediately itself would be a situation of *prima facie* lack of patentability based on the available information, or a situation of fundamental uncertainty because of lack of information. As this was not the case, the board chose to exercise its discretion under Art. 111(1) EPC 1973 to decide the case itself.

11. Binding effect

11.1. General principles

Under Art. 111(2) EPC the EPO department of first instance is bound by the *ratio decidendi* of the board of appeal if the case is remitted to the department whose decision was appealed in so far as the facts are the same.

The problem of being bound by an earlier board of appeal decision where a case is remitted also arises in connection with a subsequent appeal against the ensuing decision.

The boards of appeal take the view that a binding effect also exists in this case (see, for example, **T 21/89**, **T 78/89**, **T 55/90**, **T 757/91**, **T 113/92**, **T 1063/92** and **T 153/93**), often on the basis that board of appeal decisions are final and without appeal, so that no EPO body - not even boards of appeal - can take a new decision on facts which have already been decided. In **T 690/91** the argument was that the same binding effect applied to any subsequent appeal proceedings since, according to Art. 111(1) EPC 1973, the board might exercise the same power as was within the competence of the department which was responsible for the decision appealed. Art. 111(1) EPC remains unchanged. The principle of *res judicata* also applied in the case of a divisional application when a decision on the same subject matter had been taken by a board of appeal in the case of the parent application (**T 51/08**). Thus, subject matter on which a final decision had been taken by a board of appeal in the parent application could not be pursued in the divisional application. Furthermore, if the statement setting out the grounds of appeal in a case did not go beyond submitting and arguing for a set of claims which constituted such subject matter, the appeal was not sufficiently substantiated.

There were no provisions in the EPC 1973 allowing an appeal against a decision of a board of appeal. Decisions of the boards of appeal were final, as a decision can only be contested where it is expressly provided for under statute. When the first board of appeal delivered its decision, the content and text of the patent claims became *res judicata* and could no longer be amended in proceedings before the EPO (**T 843/91**, OJ 1994, 818; see also **T 153/93**). Under the EPC 2000, the Enlarged Board of Appeal has been given competence to decide on petitions for review under Art. 112a EPC, in order to make possible a limited judicial review. Thus decisions of the boards of appeal can now be contested, but only on limited grounds (see chapter VII.E.15, petition for review).

The fact that the boards of appeal are courts was established in **G 1/86** (OJ 1987, 447, point 14 of the reasons, German and French versions - the board held that the English translation, "act as courts", was inaccurate).

The ratio decidendi of a decision under Art. 111(2) EPC 1973 is the ground or the reason for making it - in other words, the point in a case which determines the outcome of the judgment (**T 934/91**, OJ 1994, 184). It is not contained in the order but in the section "Reasons for the Decision" and it is thus of no importance for its binding effect that a particular matter is not mentioned in the order (**T 436/95**).

"*Res judicata*" means a matter finally settled by a court of competent jurisdiction, rendering that matter conclusive as to the rights of the parties and their privies, such a final judgment constituting an absolute bar to a subsequent legal action involving the same claim, demand or cause of action, and the same parties or their privies (**T 934/91**, OJ 1994, 184). However, a board of appeal decision has the binding effect referred to in Art. 111(2) EPC only if the case is remitted to the department of first instance. A board of appeal decision in another case is not binding on the department of first instance (see

T 288/92; and also **J 27/94**, OJ 1995, 831). Nor is a decision by a board of appeal on an appeal from an examining division decision binding in subsequent opposition proceedings or on appeals therefrom, having regard both to the EPC and to the principle of *res judicata* (**T 167/93**, OJ 1997, 229). The binding effect is also not restricted to cases where the composition of the board remained unchanged (**T 436/95**). Following **T 167/93**, the board in **T 1099/06** pointed out that opposition proceedings are separate and distinct from examination proceedings and are characterised by the nature of the public interest. The legislative and procedural framework has quite clearly been designed to allow the public interest in challenging granted patents by opposition to take priority over any considerations of certainty or apparent consistency. The board pointed out that to the extent this principle is recognised in the law of the EPC, it is of extremely narrow scope and must meet the six criteria set out in **T 167/93** (OJ 1997, 229) - the issue must have been (a) judicially determined; (b) in a final manner, (c) by a tribunal of competent jurisdiction; (d) where the issues of fact are the same; (e) the parties (or successors in title) are the same; and (f) the legal capacities of the parties are the same. Thus a decision in earlier examination appeal proceedings could not be *res judicata* in subsequent opposition appeal proceedings, the criteria (c), (e) and (f) not being satisfied.

Where the board, in the decision remitting the case to the department of first instance, is silent on the question of the adaptation of the description, this does not necessarily imply that no adaptation is required, but merely that the matter was not considered or decided. The point is therefore not *res judicata* and so can be raised in a subsequent appeal (**T 636/97**).

11.2. Type of remittal

The legal effects of Art. 111(2) EPC differ in scope according to the type of remittal. Only minor editorial amendments have been made to Art. 111(2) EPC in the English and French versions.

11.2.1 Remittal only for adaptation of the description

In **T 757/91** the board decided that if, after the case was remitted, the only issue still outstanding was the adaptation of the description to the amended claims which were held valid in the first appeal proceedings, that issue was the only one which could be considered in further appeal proceedings. When the first board of appeal delivered its decision, the content and the text of the patent claims became *res judicata* and could no longer be amended in proceedings before the EPO (see also **T 55/90**, **T 843/91**, OJ 1994, 832 and **T 113/92**).

Remittal for the description to be amended does not render it possible for an opponent to challenge substantive patentability again by appealing the opposition division's decision after remittal, where a final decision has been taken on this and the scope of the patent (**T 1063/92**).

On remittal the board had made no mention of any adaptation of the description that might be necessary. The patentee proposed amendments to the description which were

accepted by the opposition division. The opponent appealed against this decision, challenging the novelty and clarity of the claims as already decided upon by the board of appeal. Following **T 843/91** (OJ 1994, 832), the board in **T 153/93** found that all findings of fact that were a *conditio sine qua non* of the finally binding parts of the decision were *res judicata* with the result that new facts, evidence or arguments seeking to cast doubt upon these facts could not be considered either by the opposition division or the board of appeal.

11.2.2 Remittal for the continuation of proceedings

Where a board of appeal issued a decision rejecting certain claimed subject-matter as not allowable and remitted the case for further prosecution in accordance with an auxiliary request, under Art. 111(2) EPC 1973, the examination for allowability of the rejected claimed subject-matter could not be re-opened, either by the examining division during its further prosecution of the case, or by the board of appeal in any subsequent appeal proceedings (**T 79/89**, OJ 1992, 283; see also **T 21/89**).

A board was bound in the second of two successive *ex parte* appeal proceedings by the *ratio decidendi* of the decision in the first appeal proceedings where the facts remained the same. It was to be assumed that this was the case where there was no connection between a feature amended during the second proceedings and findings of the first board of appeal playing a key role in the decision (**T 690/91**).

Under Art. 111(2) EPC 1973, if a board of appeal remitted a case for further prosecution to the department whose decision was appealed, that department was bound by the *ratio decidendi* of the board in so far as the facts were the same. After grant, however, the opposition division was in no way legally bound by the previous decision of the board, on an appeal from the examining division, even in so far as the facts were the same, although it should not deviate from a previous decision of a board of appeal on such a point, unless there appeared to be very clear reasons for doing so (**T 26/93**).

In the opposition proceedings following the remittal for continuation of the proceedings, an amendment of the patent claims could change the actual basis of an appeal decision. In such a case the binding effect of Art. 111(2) EPC 1973 no longer applied. This differed from the situation where the case was remitted for adaptation of the description - here the previous instance was bound by the *ratio decidendi* of the board's decision, and the decision on the patentability of the claims was final, even if the facts had changed (**T 27/94**).

Art. 111(2) EPC 1973 stated unambiguously that the department of first instance and the board of appeal which was again concerned with the case were bound by the *ratio decidendi* of the remitting decision only "in so far as the facts are the same". The opposition division was thus not bound by the first decision if new claims were submitted which were not in conflict with the *ratio decidendi* of the decision. The situation was different if the board had dismissed the decision under appeal and remitted the case to the department of first instance with the order to maintain a patent with claims whose wording had been defined by the board. In such a case the department of first instance

was not entitled to admit amended claims, since they were part of the *res judicata* of the decision of the board (**T 609/94**).

In **T 255/92** the case was remitted by the board itself "for further prosecution". The board stated, for the avoidance of doubt, that according to Art. 111(2) EPC 1973 the examining division was bound by the current decision only to the extent that it had been decided that the subject-matter of claim 1 as amended during the oral proceedings before the examining division on 15.10.1991 involved an inventive step over the prior art considered in the current decision (see also **T 366/92**).

See also **T 720/93** for the extent to which a board considered itself bound by an earlier board of appeal decision in the same case. Although the claim pending before the board represented different facts from in the first proceedings since it was a different type of claim and contained a number of different features, the board found some findings of the first decision binding for the second proceedings.

12. Termination of appeal proceedings

Under the EPC it is possible to withdraw a patent application, opposition or appeal. Decision **J 19/82** (OJ 1984, 6) ruled that partial withdrawal is also possible. The consequences of such a withdrawal for pending appeal proceedings are considered below.

12.1. Withdrawal of the appeal

In the course of the revision of the EPC, Art. 114 EPC remained unchanged except for a minor editorial amendment in the German version.

In **G 7/91** and **G 8/91** (OJ 1993, 346 and 356) the Enlarged Board of Appeal ruled that as far as the substantive issues settled by the contested decision at first instance were concerned, appeal proceedings - whether *ex parte* or *inter partes* - were terminated when the sole appellant withdrew his appeal. The Enlarged Board found that the provision of Art. 114(1) EPC 1973 did not allow for continuation of the proceedings once the appeal had been withdrawn. This was evident from the legislative rationale of the Convention. If Art. 114(1) EPC 1973 applied to all withdrawal situations, then the R. 60(2) EPC 1973 exception for oppositions would be superfluous. Nor was withdrawal of the appeal covered by "relief sought" within the meaning of Art. 114(1), second part of sentence, EPC 1973 to which the EPO would not be restricted in examining the facts; it constituted a procedural act not requiring the consent of the relevant board (point 8 of the reasons). The appeal procedure was that proper to an administrative court, so any exception from general procedural principles such as the "principle of party disposition" had to be supported by much weightier grounds than in administrative proceedings. Neither Art. 114(1) EPC 1973 nor the interests of the general public or the respondent constituted arguments against this interpretation. Art. 114(1) EPC 1973 was restricted to the examination of the facts. The interests of the general public were primarily safeguarded by the opposition system. It could be assumed that the patent did not disturb those who had not filed an opposition, so there was no need to continue the

appeal proceedings in order to safeguard their interests. Nor were the respondents' interests any more in need of protection if they had not themselves filed an appeal, as was explained in detail in **G 2/91** (OJ 1992, 206). Finally, the Enlarged Board pointed out that when the sole appellant withdrew his appeal, the suspensive effect of the appeal lapsed and the opposition division's decision thus became final as regards the substantive issue.

A statement of withdrawal of appeal made by the (sole) appellant after the final decision of the board has been announced at oral proceedings does not relieve the board of its duty to issue and notify to the appellant the decision in writing setting out the reasons for the decision in order to conclude the decision-taking procedure triggered by the announcement of the final decision at the oral proceedings, which had already become effective under **G 12/91** (OJ 1994, 285) (**T 1033/04**).

If the sole appellant says he has withdrawn his appeal, but the parties are in dispute as to whether he did so admissibly, then the board is empowered to rule on that issue (**T 659/92**, OJ 1995, 519).

After withdrawal of an appeal it is still permissible to decide on ancillary questions (**T 85/84**). Thus in **T 21/82** (OJ 1982, 256), **J 12/86** (OJ 1988, 83), **T 41/82** (OJ 1982, 256) and **T 773/91**, the board of appeal dealt with requests for reimbursement of the appeal fee filed after withdrawal of the appeal, and in **T 117/86** (OJ 1989, 401), **T 323/89** (OJ 1992, 169), **T 614/89** and **T 765/89** with requests for apportionment of costs.

According to **T 195/93**, the fact that the appellant withdrew his appeal after an intervention was filed could not immediately lead to termination of the proceedings. The board had to consider the admissibility of the intervention (see also chapter VII.C.3, intervention).

Partial withdrawal of an appeal by the sole appellant (opponent) following an allowable limitation of the patent's subject-matter under Art. 123 EPC 1973 during appeal proceedings deprived the board of its discretionary power to examine the substantive merits of the remaining, limited subject-matter. The patent had to therefore be granted in its amended form (**T 6/92** and **T 304/99**). In **T 127/05** the board recalled that an opponent who was the sole appellant had the possibility of withdrawing his appeal if he found that the outcome would be disadvantageous to himself. In **G 7/91** and **G 8/91** (OJ 1993, 346 and 356) the Enlarged Board of Appeal ruled that as far as the substantive issues settled by the decision at first instance were concerned, appeal proceedings were terminated when the sole appellant withdrew his appeal. It followed that an opponent who was the sole appellant could, if he so wished, force the non-appealing patent proprietor to "live with" a deficiency which he had introduced. A patent proprietor who filed an appeal could prevent himself from being placed in such a situation. The board also did not agree that decision **G 1/99** (OJ 2001, 381) restricted amendment to a response to an objection first raised in appeal proceedings.

The mere fact that a representative had filed a notice of appeal before taking note of the appellant's adverse instruction did not justify a correction to the effect that no appeal had been filed. The request amounted to a withdrawal of the appeal with retrospective effect, which was not provided for in the Convention (**T 309/03**, OJ 2004, 91).

A notice of abandonment of the patent was held to be tantamount to withdrawing the appeal in **T 1003/01**. In **T 60/00**, however, the appellant's statement that it had decided not to pursue the appeal was not regarded as unambiguous withdrawal of the appeal, derived from the principles laid down in earlier case law: effective withdrawal does not depend on the term "withdrawal" being used (**J 7/87**, OJ 1988, 422); a request for withdrawal should only be accepted without question if it is completely unqualified and unambiguous (**J 11/80**, OJ 1981, 141); and where any doubt as to a party's intent exists, the declaration made can be construed as a withdrawal only if the related subsequent facts confirm that such is the party's true intent (**J 11/87**, OJ 1988, 367).

A conditional withdrawal of the appeal is not possible (**T 502/02**). When an appellant has clearly withdrawn his appeal, the appeal proceedings can be closed without a reasoned written decision, even if the appellant has appended to his declaration of withdrawal an obviously non-allowable request for a refund of the appeal fee (**T 1142/04**).

13. Interlocutory revision

Under Art. 109(1) EPC, which remains unchanged, except for a minor editorial amendment in the French version, in **ex-parte** proceedings the department whose decision is contested must rectify its decision if it considers the appeal to be admissible and well-founded. Inter-partes proceedings are excluded from rectification. However, this does not prevent the department of first instance rectifying its decision where it erroneously revokes, on grounds of non-compliance, a patent it had decided to maintain in amended form (see **T 168/03**). On expiry of the three-month period under Art. 109(2) EPC 1973, the department of first instance whose decision is contested ceases to be responsible for the matter. Rectification of the decision is then no longer possible (**T 778/06**).

13.1. General

In case **T 139/87** (OJ 1990, 68) the board of appeal made it clear that an appeal by an applicant for a European patent was to be considered well-founded within the meaning of Art. 109(1) EPC 1973 if the main request of the appeal included amendments which clearly met the objections on which the refusal of the application had been based as indicated by the examining division. In such a case, the department that issued the contested decision **must** rectify the decision. Irregularities other than those that gave rise to the contested decision do not preclude rectification of the decision (see also **T 47/90**, OJ 1991, 486; **T 690/90**, **T 1042/92**, **T 1097/92**, **T 219/93**, **T 647/93**, OJ 1995, 132; **T 648/94**, **T 180/95**, **T 794/95**). However, where the examining division considers that interlocutory revision will only be possible on condition several objections are overcome and these objections are unrelated to the refusal and clearly have no link at all to the decision under appeal, such an approach has no legal basis (**T 615/95**).

In **T 473/91** (OJ 1993, 630) the board made it clear that the admissibility question under Art. 109 EPC 1973 fell under the jurisdiction of the department of first instance only when this question could be decided immediately on the basis of the appeal submissions themselves. Consequently, the appellate instance had exclusive jurisdiction over a request for restitutio in integrum into a time limit relating to the appeal itself.

In **T 919/95** the appellant was of the opinion that an interlocutory revision had to result in the appeal being allowed. A 'cassatory' revision that merely set aside the contested decision and resumed the suspended proceedings was not compatible with the Convention. The interlocutory revision had to be a 'reformatory' revision, i.e. one that conferred on the appellant something that the contested decision deprived him of. The board stated that the requirements of Art. 109 EPC 1973 were met if the reason for the contested decision were removed as a result of an admissible appeal; once the contested decision had been set aside the requested decision could be taken, or the proceedings could be resumed, since further examination was required of new grounds or facts. The latter did not rule out a subsequent refusal. The purpose of interlocutory revision was to speed up the procedure. If an examining division rectified a decision under Art. 109 EPC 1973 merely in order to grant a patent according to an auxiliary request, even though the applicant insisted on his main request, the procedure was not thereby accelerated but slowed down and this would constitute a substantial procedural violation (see also **T 142/96** under chapter VII.E.13.3, interlocutory revision).

13.2. Reimbursement of appeal fee

In the course of the revision of the EPC, Art. 109 EPC was subject to minor editorial amendments in the English and French versions only. R. 67 EPC 1973 is now to be found in R. 103 EPC in amended form. R. 103(2) EPC provides that the department whose decision is impugned shall order the reimbursement if it revises its decision and considers reimbursement equitable by reason of a substantial procedural violation. In all other cases, matters of reimbursement shall be decided by the board of appeal. This codifies the case law of the Legal Board of Appeal (see **J 32/95** (OJ 1999, 713) below).

Decision **J 32/95** (OJ 1999, 713) held that under R. 67, second sentence, EPC 1973 the department of first instance, in the event of interlocutory revision under Art. 109 EPC 1973, could order reimbursement of the appeal fee, but could not refuse it, and that the power to refuse reimbursement of the fee resided exclusively with the board of appeal. Under Art. 109(1) EPC 1973, first sentence, the department whose decision was contested was obliged to rectify its decision if it considered the appeal to be admissible and well-founded; it did not then have the power to remit the appeal to a board of appeal. If, given this situation, the department did not consider the request for reimbursement of the appeal fee to be well-founded, it had to grant interlocutory revision and to remit the request for reimbursement of the appeal fee to the board of appeal for a decision.

According to **T 1222/04** the grant of interlocutory revision constituted a necessary, but not sufficient, prerequisite for the department of first instance to allow a request for the reimbursement of appeal fees under R. 67 EPC 1973.

However, as regards the composition of the board of appeal competent to deal with such a request, decision **J 32/95** is silent. In **G 3/03** (OJ 2005, 344), the Enlarged Board of Appeal held that in the event of interlocutory revision under Art. 109(1) EPC 1973, the department of first instance whose decision had been appealed was not competent to refuse a request of the appellant for reimbursement of the appeal fee. The board of appeal which would have been competent under Art. 21 EPC 1973 to deal with the substantive issues of the appeal if no interlocutory revision had been granted was competent to decide on the request.

Once interlocutory revision had been granted, the appeal was *res judicata*. In the absence of a pending appeal, any request for reimbursement of the appeal fee filed after the decision to grant interlocutory revision would be considered inadmissible, irrespective of whether the decision was taken by the examining division or the board of appeal as the body competent to consider the appeal (**T 242/05**).

Under Art. 109(2) EPC 1973 a case had to be remitted to the boards of appeal without delay and without comments as to its merits if the decision under appeal was not rectified within a specified time after receipt of the statement of grounds of the appeal. Therefore, if further separate issues - such as the reimbursement of the appeal fee - arose out of the appeal, the department in charge of the case was obliged under Art. 109(2) EPC 1973 to take a separate decision on rectification before the end of this time limit as soon as it realised that a decision on any further issue could not be taken within that period (**T 939/95**, OJ 1998, 481). The time limit is currently three months.

Under R. 103(1)(b) EPC, the appeal fee shall be reimbursed if the appeal is withdrawn before the filing of the statement of grounds and before the period for filing that statement has expired. This is intended to go some way towards compensating for the lack of a cross-appeal facility - appeals filed as a precaution in case the other party appeals may be withdrawn if the other party does not file an appeal.

13.3. Substantial procedural violation

In the course of the revision of the EPC, the text of Art. 113 EPC was subject to only minor editorial amendments in the English version.

Any infringement of Art. 113(2) EPC 1973, even as the result of a mistaken interpretation of a request, had, in principle, to be considered to be a substantial procedural violation. In any case, such violation occurred when the examining division did not make use of the possibility of granting interlocutory revision under Art. 109 EPC 1973, after the mistake had been pointed out in the grounds of appeal (**T 647/93**, OJ 1995, 132; see also **T 685/98**, OJ 1999, 346).

Before the department of first instance can review the admissibility and merits of a validly filed appeal, it must have available the documents stipulated in Art. 108 EPC. In **T 41/97**, the examining division decided not to rectify its decision **before** receiving the statement of grounds of appeal and before the time limit for filing it had expired. This was held to be a procedural violation. This decision was confirmed in **T 1891/07**. In neither case did the

board order reimbursement of the appeal fee, as the violation could not have been causative in filing the appeal, since it occurred after the notice of appeal had been filed.

According to **T 691/91**, Art. 109 EPC 1973 provided for two legally viable alternatives: to maintain or to annul the decision which was appealed. In the case at issue, the examining division had chosen a third way; maintaining the earlier decision by issuing a decision on rectification. This alternative was not covered by the provisions of Art. 109 EPC 1973.

In **T 142/96** the practice of re-opening examination after rectification was held to be contrary to the principle of procedural economy underlying Art. 109 EPC 1973 and so constituted a substantial procedural violation.

In **T 704/05** the board found that the examining division could have set its decision aside by way of interlocutory decision pursuant to Art. 109(1) EPC 1973. However, given that the examining division was expressly precluded from giving its reasons for not granting interlocutory revision, it was not open to the board to criticise this omission. The mandatory but necessarily silent judgment made pursuant to Art. 109(1) EPC 1973 as to whether an appeal refuted the reasons for a refusal was not an exercise of discretion and ipso facto left no room for an inquiry as to whether discretion had been properly exercised. The board was aware that a number of decisions of the boards of appeal had taken a different view on this point - to the extent of sometimes castigating such omission as a substantial procedural violation - but respectfully suggested that these decisions had not given sufficient weight to the implications of the silence imposed on the examining division by Art. 109(2) EPC 1973.

A decision to grant interlocutory revision, once validly taken and irrespective of whether the department of first instance was correct in considering the appeal to be admissible and well-founded, could not be set aside by the examining division, let alone by a formalities officer (**T 303/05**).

14. Referral to the Enlarged Board of Appeal

Under Art. 112(1) EPC it is within the discretion of the boards of appeal to refer a case to the Enlarged Board of Appeal if this appears necessary for ensuring uniform application of the law or if a point of law of fundamental importance arises (under the EPC 1973, 'an important point of law'). It was made clear in **T 184/91** that only questions on a specific point, not entire cases, can be referred to the Enlarged Board of Appeal.

In **G 3/99** (OJ 2002, 347) the Enlarged Board of Appeal confirmed what had already been stated in decision **G 8/92** (not published in the OJ), namely that, even if the Enlarged Board considered as a matter of principle that, for a referral to be admissible, the appeal had to be admissible, this did not apply if the referral itself concerned the admissibility of the appeal. Without this exception, in cases like the one before the board, the boards would be denied the opportunity to refer questions on important points of law concerning the admissibility of an appeal. This would have contradicted Art. 112(1)(a) EPC 1973 where no restrictions of that kind appear.

In the interlocutory decision of the Enlarged Board of Appeal **G 3/08** dated 16 October 2009 the Enlarged Board noted that in referral cases under Art. 112 EPC members of the public who file *amicus curiae* briefs did not have the status of a party. They were not entitled to file requests but only to submit their personal view of the case since an *amicus curiae* was not a party to the referral proceedings any request was inadmissible under Art. 24(3) EPC. However, pursuant to Art. 4(1) RPEBA (OJ 2007, 304), the procedure of Art. 24(4) EPC was also to be applied, and under this provision the submissions of a third party were taken as information on the basis of which the Board could *ex officio* look at the alleged grounds of objection or suspicion of partiality.

The following decisions concern mainly those cases in which the request for referral was refused, since the others have already been dealt with elsewhere.

14.1. Ensuring uniform application of the law

In principle, the boards always refuse requests for referral where there is no contradictory case law and they see no reason for departing from earlier decisions (see e.g. **T 170/83**, OJ 1984, 605; **T 162/85**, **T 58/87**, **T 5/89**, **T 315/89**, **T 37/90**, **T 323/90**, **T 688/90**, **T 506/91**, **J 47/92**, OJ 1995, 180; **T 473/92**, **T 952/92** and **T 702/93**).

There is in principle no contradiction where a different application of the same rule is justified by different circumstances (**T 143/91**).

According to **T 373/87** there is no contradictory case law where a single, unconfirmed decision departs from the case law established by several decisions.

The board in **T 154/04** (OJ 2008, 46) found that a decision deviating from an opinion given in another decision of a board of appeal, a diverging opinion expressed in decisions of different boards, or a deviation from some national jurisprudence -- for example, from the UK case law of the Court of Appeal to which the appellant referred in support of its case -- are not per se valid reasons for referral under Art. 112(1)(a) EPC 1973 (see also Art. 15 RPBA 2003).

The legal system of the Convention allowed for the evolution of the case law and left it to the discretion of the boards whether to give reasons in any decision deviating from other decisions or to refer a point of law to the Enlarged Board. The President of the EPO could intervene under Art. 112(1)(b) EPC 1973, in particular if the legal situation became unclear for first instance proceedings.

In the interest of the harmonisation of national and international rules of law, the boards of appeal will take into consideration decisions and opinions given by national courts in interpreting the law (see **G 5/83**, OJ 1985, 64). Nevertheless, in the proceedings before the EPO, such considerations do not exonerate a board of appeal from its duty as an independent judicial body to interpret and apply the EPC and to decide in last instance in patent granting matters. In addition, despite harmonised legal regulations, it is not self-evident that their interpretation is also harmonised among different national courts, let alone courts of different contracting states, so that the boards of appeal would be at a

loss as to which interpretation to follow if they did not exercise their own independent judgment.

14.2. Important points of law

In the course of the revision of the EPC, the English wording of Art. 112(1), first sentence, EPC, has been amended. The French and German remain the same.

The board took the view in **T 601/92** that in certain cases there was no general interest in clarifying points of law; such points were consequently not important. Nor is the lack of case law on a particular issue sufficient reason to refer a question (see **T 998/99**).

A purely theoretical interest in clarifying points of law is no justification for referral (**T 835/90**), nor, according to **T 118/89**, should hypothetical points be referred. Any question referred must, moreover, be of a legal nature and not just a question of fact. The board in **T 373/87** and **T 939/92** took the same view. Nor may technical questions be referred, according to the board's ruling in **T 181/82** (OJ 1984, 401), in which the appellants requested referral of the question whether a skilled person would readily understand the technical content of a prior art document on the strength of his own knowledge (see also **T 219/83**, OJ 1986, 211 and **T 82/93**, OJ 1996, 274). In **T 972/91** the board ruled that questions to which no general answer is possible cannot be referred. In this particular case the appellant had requested referral to the Enlarged Board of Appeal of the question how a patent claim was to be interpreted and understood in view of the content of the technical teaching. A request for referral must be refused if a decision can be reached on the basis of grounds other than those to which the proposed question is related. For a referral to be admissible, an answer to the question must be necessary in order for the referring board to be able to decide on the appeal (**T 520/01**).

The boards have not referred questions where they were of the opinion that the requirement on which the question was based had not been fulfilled (e.g. in **T 727/89**, where the question presupposed that the claim was not novel and the board took the view that it was; see also **T 162/90** and **T 921/91**).

Where a board intends to rule in favour of the party requesting referral to the Enlarged Board of Appeal, it refuses the request on principle (see **T 461/88**, OJ 1993, 295; **T 301/87**, OJ 1990, 335; **T 648/88**, **T 180/92** and **T 469/92**).

According to **T 26/88** (OJ 1991, 30) there is no important point of law to be clarified where the legal situation on which a question is based has changed in the interim and the question is therefore unlikely to arise again very often.

According to **T 247/85** the question of how permission to appeal against an interlocutory decision should be presented did not involve an important point of law.

Even where a question involving an important point of law has arisen, the boards have not referred it if they could resolve it themselves without any doubt (see **J 5/81**, OJ 1982, 155; **T 198/88**, OJ 1991, 254; **T 579/88** and **T 708/90**) or if the question was

not relevant for deciding the specific case (see e.g. **J 7/90**, OJ 1993, 133; **J 16/90**, OJ 1992, 260; **J 14/91**, OJ 1993, 479; **T 72/89**, **T 583/89**, **T 676/90**, **T 297/91**, **T 485/91** and **T 860/91**).

In **T 82/93** (OJ 1996, 274) no referral was permitted since the question had already been decided by the Enlarged Board of Appeal. In **T 297/88** the board dealt in detail with the question of when it was possible to refer a question which had already been decided by the Enlarged Board. It took the view that, in principle, any answer by the Enlarged Board on a point of law could be called into question if the Enlarged Board's arguments in the contested decision were so weak that doubts as to the correctness of the decision per se were unavoidable. This was also the case where the arguments were based on a false premise so that for this reason there were doubts about the conclusion drawn. A decision could also be questioned where the premise was correct, the arguments were conclusive and therefore the conclusion was necessarily also correct, but legal or technical developments occurring in the interim made it seem desirable in the public interest to have the question reviewed again by the Enlarged Board.

In **T 208/88** of 20.7.1988 a question was referred, even though it was already pending before the Enlarged Board in other proceedings, because new aspects had emerged in this case which were useful for the decision. A referral was also made in **J 15/90**, although the question was already pending, as the board wished to give the Enlarged Board the opportunity to consider another type of case which might be affected by its answer. In **T 803/93** (OJ 1996, 204) the board referred the question whether a person other than an authorised representative could appear before a board in technical cases, thus complementing the question already pending before the Enlarged Board whether this was possible in legal cases. In **T 184/91** a question already pending was referred again in order to give the parties to the proceedings the opportunity to present their case to the Enlarged Board.

A board may only refer questions of law to the Enlarged Board of Appeal "during proceedings on a case" and before it has decided on the issues in the appeal in relation to which such questions of law are considered to arise. Points of law having the force of res judicata, cannot be referred to the Enlarged Board of Appeal (**T 79/89**, OJ 1992, 283). According to **G 8/92** (not published in the OJ), a referral is only possible if the appeal is admissible, unless the referral concerns a legal point arising in connection with the admissibility of the appeal.

14.3. Suspension of first-instance proceedings following referral to Enlarged Board

Where a decision of the examining division depended entirely on the outcome of proceedings before the Enlarged Board of Appeal on a legal question or point of law raised under Art. 112 EPC 1973 - and this was known to the examining division - the further examination of the application had to be suspended until the matter had been decided by the Enlarged Board of Appeal. Failure to do so amounted to a substantial procedural violation under R. 67 EPC 1973 (**T 166/84**, OJ 1984, 489). R. 103(1)(a) EPC now takes up the text of R. 67 EPC 1973, first sentence.

15. Petition for review under Article 112a EPC

15.1. General

In order to make possible a limited judicial review of decisions of the boards of appeal, the Enlarged Board of Appeal has been given the competence to decide on petitions for review under Art. 112a EPC. A petition for review may only be based on the grounds defined in the EPC. These are, firstly, fundamental procedural defects which occurred in appeal proceedings and, secondly, the existence of a criminal act which may have had an impact on a decision (Art. 112a(2) EPC).

Fundamental procedural defects are, in the first instance, those defined in Art. 112a(2)(a) to (c) EPC, that is, a breach of Art. 24 EPC governing exclusion of and objection to members of a board of appeal; the participation of persons not appointed as a member of the boards of appeal; fundamental violation of Art. 113 EPC. In **R 12/09** of 3.12.2009, the request to exclude members of the Enlarged Board of Appeal under Art. 24 EPC was rejected as inadmissible - the members were alleged necessarily to have a personal interest due to their capacity as members of a technical board or the Legal Board of Appeal such that the suspicion of partiality necessarily arose.

In addition, Art. 112a(2)(d) EPC opens up the possibility of using the Implementing Regulations to define further fundamental procedural defects on which a petition for review might be based. R. 104(a) and (b) EPC provide that a petition may also be based on a fundamental procedural defect arising from either a failure to arrange for the holding of oral proceedings requested by a party, or a failure to decide on a request relevant for the board's decision.

The examples in Art. 112a(2)(a) to (c) EPC and particularly the wording of Art. 112a(2)(d) EPC make it clear that only **fundamental** (but not minor) **procedural defects** can be the basis for a petition for review. R. 106 EPC further provides that a petition for review is admissible only if the defect was objected to during appeal proceedings and the objection rejected by the board of appeal, unless the objection could not have been raised during appeal proceedings.

According to the case law, Art. 112a EPC provides an exceptional means of redress, which provisions have to be applied strictly. Thus, it is not the purpose of Art. 112a EPC that a case be decided upon by a department of third instance, but rather it provides the right for a judicial review founded on a limited number of grounds that have been exhaustively defined by the legislator (Art. 112a(2) EPC in conjunction with R. 104 EPC) (**R 1/08**). Nor do the Enlarged Board's review powers provide for a general examination of whether the board which took the contested decision duly observed the rules of procedure applicable at the appeal stage. They are confined to examining fundamental violations of rules of procedure as defined in the EPC to which the petitioner has objected. The Enlarged Board is obviously entitled to examine the purported violation of a rule of procedure with a view to ascertaining whether it entailed a fundamental violation of Art. 113 EPC within the meaning of Art. 112a(2)(c) EPC (**R 2/08**). Furthermore, as can be clearly derived from the legislative history of the provisions on petitions for review,

under no circumstances can the petition for review be a means to review the correct application of substantive law (**R 2/08**, **R 9/08**, **R 8/09** and **R 13/09**).

15.2. Transitional provisions

The decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November provides that "Article 112a shall apply to decisions of the Boards of Appeal taken as from the date of its entry into force". Following **G 12/91** (OJ 1994, 285), the Enlarged Board in **R 5/08** interpreted 'taken' to be the date a decision given orally is pronounced, not the date of notification. A petition based on a decision dated prior to, yet not notified to the parties until after entry into force of the EPC 2000, had therefore to be rejected as inadmissible.

15.3. Obligation to raise objections in accordance with Rule 106 EPC

Under R. 106 EPC, a petition under Art.112a(2), (a) to (d) EPC, is only admissible where an objection in respect of the procedural defect was raised during appeal proceedings and dismissed by the board of appeal, except where such objection could not be raised during the appeal proceedings. The petitioner is unable to raise any objection regarding procedural defects where the written decision is alleged to be based on grounds and arguments of which the patent proprietor was not aware. At that time, the debates were closed and the petitioner was no longer entitled to file any submissions or objections. The provision of R. 106 EPC in fine therefore applies (**R 1/08**). See also **R 9/08**.

Similarly, in **R 2/08**, the contested decision having been taken on the basis of a written procedure, without prior communication from the board of appeal, the exception provided for at the end of R. 106 EPC appeared to apply, the appellant having been unable to ascertain the grounds on which the board of appeal would be basing its decision other than from the content of the written decision itself.

In **R 10/08**, the petitioner had wished to submit a new auxiliary request, allegedly during the announcement of the decision at the oral proceedings, but the board had declared itself formally bound by its final decision as announced. The petitioner was given the benefit of the second alternative of R. 106 EPC.

The Enlarged Board in **R 3/08**, however, found that the requirement of R. 106 EPC had clearly not been met by the petitioner in two of his three objections. The first concerned the board's refusal to postpone oral proceedings to allow the petitioner's representative of choice to attend. The petitioner's reaction to the refusal had been to appoint another representative, and no objections were raised at the time to the board's communication not to postpone the oral proceedings. This objection was therefore held inadmissible. The second objection considered inadmissible concerned the petitioner's claim that he had not been given sufficient time to prepare a further auxiliary request in the oral proceedings. Again, the petitioner had raised no objection under R. 106 EPC.

In **R 4/08**, the Enlarged Board of Appeal made it clear that raising an objection pursuant to R. 106 EPC is a procedural act and, except where such objection could not be raised

during the appeal proceedings, a precondition for access to an extraordinary legal remedy against final decisions of the boards of appeal. Its validity depends upon compliance with two criteria; firstly, that the objection is expressed in such a form that the board of appeal is able to recognise immediately and without doubt that an objection pursuant to R. 106 EPC is intended; and, secondly, the objection must be specific, that is indicate unambiguously which particular defect of those listed in Art. 112a(2) (a) to (c) and R. 104 EPC it intends to rely on. Only if a party's statement complies, both as to form and content, with these criteria, does it qualify as an objection pursuant to R. 106 EPC. Referring to **R 4/08**, the Enlarged Board in **R 7/08** found the petition clearly inadmissible, as the petitioner had failed to raise a procedural objection to the introduction of allegedly new aspects of insufficiency of disclosure at the oral proceedings and to the board's refusal to admit two documents. See also **R 6/09**. In **R 8/08** too, the Enlarged Board stressed that an objection under R. 106 EPC must be expressly described as such, and cannot be formulated prematurely and without specifying the alleged fundamental procedural defect within the meaning of Art. 112a EPC.

15.4. Contents of the petition for review in accordance with Rule 107 EPC

R. 107 EPC corresponds to the similar provisions requiring substantiation of an opposition or an appeal, and in view of the exceptional nature of the remedy offered by the petition procedure, the burden it imposes on a petitioner can be no less than the equivalent burden placed by those provisions on opponents and appellants. Thus the contents of a petition must be sufficient for the petitioner's case to be properly understood on an objective basis and must be so presented as to enable the Enlarged Board (and any other parties) to understand immediately why the decision in question suffers from a fundamental procedural defect which can be the subject of an objection under the provisions on review (**R 5/08**, where the petition was held inadmissible). However, R. 107 EPC does not specifically require requests to be submitted. The only requirement which can be derived from the wording of R. 107(2) EPC is that the petition must make it clear that the petitioner wants the decision of the board of appeal to be set aside.

15.5. Procedure in dealing with petitions for review in accordance with Rule 109 EPC

In **R 5/08**, the Enlarged Board of Appeal clarified the position for potential parties in other possible petition proceedings, in particular with regard to the two distinct stages provided for in Art. 112a EPC and R. 109 EPC. R. 109(1) EPC provides that, "In proceedings under Art. 112a EPC, the provisions relating to the proceedings before the Boards of Appeal shall apply, unless otherwise provided". As regards the procedure for the first stage of petition proceedings, there are indeed such measures "otherwise provided" namely R. 109(2) and (3) EPC. The effect of these is that parties other than the petitioner are not to be involved in the first stage of petition proceedings, and so long as they are not involved they have no right to be heard. The travaux préparatoires stress the need for a quick screening process to be conducted by a three-member panel of the Enlarged Board in order to reject petitions which clearly cannot succeed. The legislator intended to

benefit parties other than the petitioners by not requiring them to take any steps in response to a petition until the Enlarged Board was satisfied that it was not to be rejected as clearly inadmissible or unallowable. Non-petitioner parties, although not summoned, could nonetheless attend oral proceedings, which are public.

15.6. Fundamental violation of Article 113 EPC

In all the cases **R 1/08**, **R 2/08**, **R 3/08**, **R 4/08**, **R 9/08**, **R 10/08**, **R 11/08**, **R 3/09** and **R 7/09** the petition was based on the grounds that a fundamental violation of Art. 113 EPC had occurred (Art. 112a(2)(c) EPC).

In **R 1/08**, the Enlarged Board stated that to succeed under this head a petitioner had to establish firstly that the decision under review was based on an assessment or on reasoning relating to grounds or evidence which the adversely affected party was not aware of and had no opportunity to comment upon, and secondly that a causal link existed between this procedural defect and the final decision, otherwise the alleged defect could not be considered decisive and hence not fundamental. The petitioner had failed to establish either of these. Firstly, the reasoning given by the board of appeal in respect of the auxiliary request was directly related to the arguments put forward in writing by the proprietor-respondent, and hence was based on "grounds or evidence" on which it had had the opportunity to comment. Furthermore, no provision of the EPC required a board of appeal to provide a party with all foreseeable arguments in favour of or against a request in advance (see **G 6/95**, OJ 1996, 649; confirmed in **R 13/09**). See also **R 11/08** and **R 6/09**, which, citing **R 1/08**, confirmed the need for a causal link.

In **R 2/08**, the petitioner maintained that the board of appeal had violated his right to be heard over the grounds on which the contested decision was based, in particular by ruling out his novelty objection. In the decision for which review was sought, the board of appeal had ruled out the novelty objection because it was a fresh ground for opposition first introduced with the notice of appeal and had to be ruled out for lack of the respondent's approval. Citing appeal board case law (e.g. **T 105/94**), with regard to the opposition procedure the Enlarged Board ruled in particular that a ground for opposition not substantiated in the notice of opposition could not be deemed to have been validly introduced into the proceedings simply because the appellant had crossed the relevant box on the opposition form. Moreover, if a new document in support of a novelty objection was submitted for the first time at the appeal stage, this in itself constituted a fresh ground for opposition within the meaning of **G 10/91** (OJ 1993, 420) and **G 7/95** (OJ 1996, 626) and could not be regarded as a mere addition of arguments to a ground for opposition which was already in the proceedings. Hence the submission of a new document in support of an alleged lack of novelty only at the appeal stage clearly did constitute a fresh ground for opposition and, despite the crossing of the relevant box, could not be regarded as merely adding arguments, as the appellant wrongly maintained. The appeal board's decision was fully in keeping with appeal board case law on the handling of fresh grounds for opposition at the appeal stage. The Enlarged Board also stated that a party expecting a board of appeal to rule in its favour had a duty to take an active part in the proceedings. See also **R 4/08**.

In **R 3/08** the petitioner alleged that his right to be heard had been breached in that an employee of his had not been allowed to make submissions in English at the oral proceedings (the language of proceedings being German). The Enlarged Board disagreed. The employee had to be considered an accompanying person within the meaning of **G 4/95** (OJ 1996, 412). According to this decision, oral submissions could not be made as of right, but only with the permission of and at the discretion of the EPO. Moreover, the petitioner's representative had himself cancelled his own request for translation into German, albeit before it was known the employee would be attending, by which time the period of time for requesting translation had already lapsed. The employee's submissions could have been presented by the professional representative in German. Thus the board's decision neither constituted a misuse of its discretion nor unduly restricted the petitioner's right to be heard.

In **R 9/08** the petitioner based its case on the allegation that the board had taken into account the whole disclosure of a document, only part of which had been in the proceedings and on which the petitioner had therefore not been able to comment. It was alleged that this document had been decisive for the board's finding. This argument had to fail, as it would require the Enlarged Board to examine whether or not the substantive conclusions arrived at by the board were justified. There was no indication in the reasons for the decision that in order to arrive at its conclusions the board had had recourse to passages of the document other than the one reproduced and expressly referred to by the board of appeal. The Enlarged Board found the petition clearly unallowable.

In **R 10/08**, the petitioner alleged that the chairman of the board had infringed Art. 15(5) RPBA 2007 by not stating the final requests of the parties before declaring the debate closed. This had prevented the petitioner from filing a further request, as he believed that the debate could not be closed prior to the chairman stating the final requests of the parties. The Enlarged Board pointed out that an infringement of Art. 15(5) RPBA 2007 could only become relevant in so far as it involved a fundamental violation of Art. 113 EPC or a fundamental procedural defect under Art. 112a(2)(d) EPC in combination with R. 104(b) EPC. The Enlarged Board found that the petitioner had had sufficient opportunity to comment on the grounds and evidence on which the board's decision was based, and that the board's decision was based on the debate and referred to the debated requests. As far as a possible fundamental violation of Art. 113(2) EPC was concerned, reference was made to **G 7/93** (OJ 1994, 775), according to which this provision did not give any right to an applicant in the sense that the EPO was bound to consider a request for amendment put forward by the applicant. The effect of the provision was merely to forbid the EPO from considering and deciding upon any text of an application other than that submitted to it or agreed by the applicant or proprietor. There being no evidence that the petitioner indicated any wish to file further requests, the board decided upon a text submitted to it by the proprietor. The petition was rejected as clearly unallowable.

In **R 3/09**, the petitioner was not claiming that the board had taken its decision on the basis of a text not agreed by the appellant – which would have been a clear direct breach of Art. 113(2) EPC – but that it had given it a "distorted" meaning. The Enlarged Board stated that discrepancies between a board's provisional opinion as expressed in a

communication preparing oral proceedings and its analysis in its final decision did not constitute a fundamental procedural defect in the absence of other verifiable circumstances showing that it was impossible for the parties to comment on the points mentioned as requiring discussion. The allegation of "distortion" was in fact a criticism that the decision's reasoning was unsound. But that would mean scrutinising the decision's application of substantive law – which went beyond the Enlarged Board's remit in review proceedings.

See also **R 8/09** and **R 13/09**.

In **R 7/09** the petition was allowed, as the EPO was not able to establish delivery of the opponent's (appellant's) statement of grounds of appeal to the respondent (patentee and subsequent petitioner). The petitioner had therefore been unaware of the grounds on which the decision of the board of appeal revoking his patent was based and a fundamental violation of Art. 113(1) EPC had occurred. The fact that the statement of grounds became readily available to the public and, thus, also to the petitioner by way of electronic file inspection had no bearing on the right of parties to proceedings before the EPO, including appeal proceedings, to be individually and specifically informed by the Office as prescribed in the EPC. The parties had to be able to rely on the Office complying with the relevant provisions of the EPC and, at least for the purposes of Art. 113(1) EPC, they and their representatives had no duty to monitor the proceedings themselves by regularly inspecting the electronic file.

15.7. Any other fundamental procedural defect

In **R 1/08** the petition also alleged a fundamental procedural defect under Art. 112a(2)d) EPC, namely the lack of reasoning with respect to an auxiliary request in the decision for which review was sought. The Enlarged Board of Appeal left open the question whether Art. 112a(2) EPC or R. 104 EPC provided at all for the possibility of a review based on this point of law and noted only that the petitioner had acknowledged that the decision under review was reasoned. The Enlarged Board did not enter into a review of the merits of the decision i.e. the substantive assessments of inventiveness, as this belonged to the final and exclusive competence of the board of appeal. It was sufficient that the board of appeal had decided on all valid requests and not "infra petita" and that it had given reasons. The petition for review was therefore not allowable.

In **R 10/08** the alleged fundamental procedural defect was that the board decided on the appeal without deciding on a request relevant to that decision (R. 104(b) EPC). The Enlarged Board referred to **G 12/91** (OJ 1994, 285), according to which the moment a decision is announced is not the last moment at which parties may still make submissions - this must be done at an earlier point in the proceedings to allow the decision-making department time to deliberate and then to issue its decision based on the parties' submissions. The parties have to expect that, unless the debate is reopened, a decision can be given after deliberation. Thus the last point in time for the petitioner to intervene would have been the moment at which the chairman declared the debate closed for deliberation. He should then have requested that the debate be re-opened if he intended to file a further request. The petition was rejected as clearly unallowable.

The Enlarged Board confirmed in **R 11/08** that a board of appeal may reject a request for lack of specific definition and for being conditional upon the board assisting the party.

16. Filing of amended claims in appeal proceedings

16.1. Introduction

16.1.1 General principles

It is settled case law of the boards of appeal that new requests containing amended claims may exceptionally be admitted in appeal proceedings. In their decisions, the boards have repeatedly cited R. 86(3) EPC 1973 (now: R. 137(3) EPC) and, with respect to opposition appeals, R. 57a EPC 1973 (now: R. 80 EPC), which, under R. 66(1) EPC 1973 (now: R. 100(1) EPC), are applicable *mutatis mutandis* in appeal proceedings. Moreover, the Rules of Procedure of the Boards of Appeal (RPBA), which were thoroughly revised in 2003, contain detailed provisions placing the admission of subsequent amendments at the boards' discretion.

It already became apparent in early decisions that the boards do admit amended requests or auxiliary requests in appeal proceedings because they are serious attempts at overcoming objections, or if their late filing can be justified and admitting them does not involve the board or the other party, as the case may be, in an examination which would significantly delay the proceedings. However, requests filed shortly before or during oral proceedings, in particular, may be refused if they are not clearly allowable (**T 95/83**, OJ 1985, 75; **T 153/85**, OJ 1988, 1; **T 406/86**, OJ 1989, 302; **T 295/87**, OJ 1990, 470; **T 381/87**, OJ 1990, 213; **T 831/92**).

In other decisions too, the boards have observed that, when exercising their discretion, they must weigh up all the circumstances of the case. The later the claims are submitted, the stricter the criteria to be applied. The subject-matter of the new claims should not diverge considerably from the claims already filed, in particular they should not contain subject matter which has not previously been claimed. The new claims should be clearly allowable in the sense that they do not introduce new objections under the EPC and overcome all outstanding objections under the EPC (**T 1126/97**, **T 52/99**, **T 468/99**, **T 397/01**, **T 411/02**, **T 81/03**, **T 989/03**, **T 515/06**).

New requests may exceptionally be admitted for reasons of procedural economy, even where not filed until a very late stage (e.g. during the oral proceedings), if the amendments are justified, e.g. where filed in response to objections or comments which were not part contained in the decision under appeal but were raised in writing during the appeal proceedings and moreover do not extend the scope of discussion as determined by the decision under appeal and the statement of grounds of appeal (**T 1126/97**, **T 52/99**, **T 468/99**, **T 397/01**, **T 846/04**, **T 1109/05**).

16.1.2 Rules of Procedure of the Boards of Appeal (RPBA)

The RPBA were thoroughly revised in 2003, in particular with regard to late submissions. The admissibility of subsequent amendments to a party's submissions (whether they be facts, evidence or requests) was expressly rendered a matter for the board's discretion (see, for a comprehensive account, CA/133/02). When the RPBA were revised again in 2007, the provisions on subsequent amendments were retained, albeit renumbered.

The provisions of the RPBA governing the admissibility of late requests essentially codify the boards' settled case law on this point (**T 87/05**). Art. 12 and Art. 13 RPBA 2007 (not amended, formerly Art. 10a and Art. 10b RPBA 2003, entry into force on 1 May 2003) are essentially aimed at concentrating the parties' submissions at an early stage of the proceedings, to ensure that the case is as complete as possible when it is processed. In particular, amendments which would lead to an adjournment of the oral proceedings should not be admitted.

Under Art. 12(2) RPBA 2007, the statement of grounds of appeal and the reply must contain a party's complete case and should, *inter alia*, specify expressly all the facts, arguments and evidence relied on. Under Art. 13(1) RPBA 2007, the boards have discretion to admit and consider any amendment to a party's case after it has filed its grounds of appeal or reply. This discretion must be exercised in view of, *inter alia*, the complexity of the new subject-matter, the current state of the proceedings and the need for procedural economy. Art. 13(3) RPBA 2007 adds that amendments sought to be made after oral proceedings have been arranged may not be admitted "if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings".

Art. 13(1) RPBA 2007 thus governs the implications of an initially incomplete case and the admission of later amendments. Art. 12(4) RPBA 2007 expressly refers to the boards' power to exclude requests which could have been filed in the first-instance proceedings.

It is settled case law that, in addition to the factors set out in Art. 13 RPBA 2007, matters which may be relevant for the exercise of discretion to admit a new request at a late stage of the proceedings include the request's prospects of success and the question whether its content converges with and expands on facts already discussed or shifts the focus to facts not discussed in the proceedings (**T 1474/06**).

16.2. Inter partes appeals

16.2.1 Principles

In the context of the late filing of amended claims, several decisions refer to the principles developed by the Enlarged Board of Appeal in relation to the inter partes appeal procedure provided for in the EPC, according to which such an appeal primarily serves the parties' right to a review of the first-instance decision in proceedings of a judicial nature. In **G 9/91** and **G 10/91** (OJ 1993, 408, 420) in particular, it was held that

the purpose of the inter partes appeal procedure is mainly to give the losing party an opportunity to challenge the decision against it and to obtain a judicial ruling on whether a first-instance decision is correct. The appeal proceedings are thus largely determined by the factual and legal scope of the preceding opposition proceedings. It is settled case law that an appellant patentee who has lost before the opposition division thus has the right to have the rejected requests reconsidered by the appeal board or to file new requests at a timely stage of the appeal proceedings, in particular together with the statement of grounds of appeal or the reply. However, if the patentee wants other (further) requests to be considered, the admission of these requests is a matter for the board's discretion, and not a matter of right (**T 840/93**, OJ 1996, 335; **T 427/99**, **T 50/02**, **T 455/03**, **T 651/03**, **T 240/04**, **T 339/06**). It can be directly inferred from the above that the parties have only limited scope to amend the subject of the dispute in second-instance proceedings, and this principle is reflected in Art. 12(4) RPBA 2007. The appeal proceedings are not about bringing an entirely fresh case (**T 356/08**).

Accordingly, when faced with a request not filed by the patentee until the appeal proceedings, the board must consider to what extent it is compatible with the judicial nature of the inter partes appeal procedure.

16.2.2 Requests not examined by the opposition division

Art. 12(4) RPBA 2007 provides that the board may refuse to consider submissions excluded by the first-instance department as belated. It similarly makes clear that new submissions are unlikely to be considered if they ought to have been presented in the first-instance proceedings (**T 339/06**, **T 416/07**).

With regard to the proper exercise of discretion in deciding whether to admit requests filed by the appellant patentee which were not submitted before the opposition division, it is the boards' settled case law that the crucial questions to be considered are whether or not the amended claims of those requests are clearly allowable, whether they give rise to new objections, whether or not there is proper justification for their late filing (so as to forestall tactical abuse) and whether the board can deal with them without undue procedural delay (**T 153/85**, ABl. 1988, 1; **T 206/93**, **T 396/97**, **T 196/00**, **T 50/02**, **T 455/03**, **T 1333/05**).

It was already decided in **T 95/83** (OJ 1985, 75) it was decided that an amendment not submitted in good time before oral proceedings in appeal proceedings should only be considered on their merits where there is some clear justification both for the amendment and for its late submission (see also **T 153/85**, OJ 1988, 1). In **T 840/93** (OJ 1996, 335), the board held further that, to file an appeal not only trying to reverse the decision on one of the requests actually considered by the opposition division, but also on the basis of new requests raising issues not considered by the opposition division, ran counter to the purpose of appeal proceedings. The only justification for admitting late-filed requests was that the patentee would otherwise be deprived of any opportunity of still obtaining a patent. Where the "last-chance argument" did not apply, the board had to confine itself to its appellate role and decide only on requests which had already been considered by the opposition division (see also **T 25/91**, **T 356/08**).

The patentee must file appropriately amended requests in good time, i.e. together with the reply to the statement of grounds of appeal, especially where the amendments are occasioned by objections already raised in the first-instance proceedings (**T 735/00**, **T 792/04**). The amended claims must not give rise to circumstances relevant for the assessment of patentability which are so new that the other party cannot reasonably be expected to address them without the proceedings being unduly prolonged (**T 651/03**).

In **T 240/04**, the board refused to consider the third auxiliary request because the appellant could have submitted it before the opposition division. Indeed, it even ought to have done so because the amended independent claim concerned a technical problem which was only remotely related to the original one and presented facts not previously examined. The appellant therefore had to expect that the board would be unable to decide the matter. To admit a new request in those circumstances would practically give patentees the opportunity to compel a remittal to the department of first instance as they pleased, which would not only put the opponent at a disadvantage but would also run counter to the principle of procedural economy.

In **T 933/04**, the appellant's main request was derived from the patent as granted. This granted version had not, however, been the subject of the opposition division's decision. It had indicated that the patent as granted (now the main request) was not novel, with the result that it had not been pursued. The board refused to admit the main request because the appellant ought not to have withdrawn it from the proceedings if it had intended to pursue it.

In **T 339/06**, the patent granted comprised several independent claims in the same category. The board found that the new request might force it to give in the appeal proceedings a first ruling concerning only subject-matter relating to a fundamentally different embodiment from those which had been the subject of the opposition division's decision. Thus, in particular, the admissibility of a request first submitted in appeal proceedings and relating solely to an independent claim which, although within the scope of the opposition, had not been considered in the first-instance decision had to be decided on in the light of whether it could also have been submitted earlier.

T 64/02 concerned the question whether auxiliary requests could be examined at all in appeal proceedings where the lack of examination by the opposition division did not constitute a procedural error. It found that, where the appellant's sole request was for maintenance of the patent according to an auxiliary request refused as belated by the opposition division, a board could dismiss the appeal without examining the request's allowability, if it took the view that the refusal to admit was justified.

16.2.3 Dependent claims

In **T 1060/04**, the amended claim 1 resulted from a combination of claim 1 as granted and features of a number of dependent claims as granted. The appellant patentee had submitted the relevant claims to the board during the oral proceedings. On the question whether the patentability of the dependent claims had to be examined, the board held, inter alia, that the fact that an opposition directed to the subject-matter of an independent

claim also implicitly covered subject-matter defined in claims dependent on the independent claim (see **G 9/91**, OJ 1993, 408, point 11 of the reasons) did not necessarily mean that the parties and the board had to be prepared to assess the allowability and patentability of amended independent claims as granted, including the subject-matter of claims dependent on them, at any time during the proceedings (see also **T 794/94**).

In **T 565/07** the appellant had filed multiple sets of claims ten days before oral proceedings. Claim 1 of the fourth auxiliary request contained claim 1 of the main request and, in addition, the features of a dependent claim. However, it went in a completely different direction from the second and third auxiliary requests. The board ruled that although patentees too should be able in principle, under R. 80 EPC, to limit a patent's subject-matter by including the features of a dependent claim in response to objections that the granted independent claim was not patentable, if they exercised that right repeatedly in a variety of directions – e.g. by filing requests in parallel or in sequence – the board would end up having to decide in which of several versions the patent was to be maintained. That would be at odds with Art. 113(2) EPC, which required the board to decide upon "the text submitted to it ... by the applicant". In other words, it was up to the patentee to decide the text for further prosecution and also one or more sets of claims which in any event had to be in line with that decision and thus its chosen direction of limitation (see also **T 382/96** and **T 446/00**) – especially if, as in this case, the additional change of direction occurred only in an auxiliary request filed just ten days before oral proceedings.

16.3. State of proceedings

16.3.1 General

It is the established jurisprudence of the boards of appeal that the appeal procedure is designed to ensure that the proceedings are as brief and concentrated as possible and ready for decision at the conclusion of oral proceedings, if scheduled. Therefore, amendments to the claims shall be filed at the earliest possible moment and the board may disregard amended claims, if they are not submitted in good time prior to oral proceedings. This principle is set out in the RPBA (**T 214/05**, **T 382/05**). Under Art. 12(2) RPBA 2007, the statement of grounds of appeal and the reply must contain the party's complete case. In addition to all facts, arguments and evidence, they should include all requests (**T 764/03**). Under Art. 15(6) RPBA 2007, the case should be ready for decision at the conclusion of the oral proceedings before the board, unless there are special reasons to prevent this.

Both the timing of the filing of amended claims or auxiliary requests and the difficulty entailed in examining them are important criteria for deciding whether they can be admitted to the proceedings (**T 397/01**): the later the requests are filed, the less likely they are to be held admissible (**T 942/05**); and the more complex the issues raised by amendments and the later those amendments are filed, the greater the risk that the remaining time is insufficient to consider them properly (**T 81/03**).

16.3.2 Amendments after arrangement of the oral proceedings

Under Art. 13(3) RPBA 2007, amendments made after oral proceedings have been arranged cannot be admitted if they raise issues which the board or the other party or parties cannot reasonably be expected to address without an adjournment of the oral proceedings.

The general interest in efficient conduct of the appeal procedure is an important factor to be considered where it is sought to introduce evidence or requests into the proceedings after arrangement of the oral hearing. Depending on the circumstances, new submissions or requests may be disregarded if an adjournment is required before the proceedings can be closed (**T 764/03**).

In **T 133/04**, auxiliary requests were filed after the oral proceedings had been arranged and during those proceedings. The board held that, since no new objections had been raised during the appeal proceedings, there was no manifest need to submit new requests after filing the statement of grounds of appeal. Nor had the appellant provided satisfactory evidence that the late-filed requests were apt to take better account of the reasons for the decision than those filed with the statement of grounds of appeal (see also **T 50/98**).

In **T 476/03** the Board noted that the auxiliary requests were filed 3 days before the one month time limit in advance of the oral proceedings. These requests were thus filed in due time within the time limit as set out in the communication of the Board. Consequently, these auxiliary requests were not considered to be late filed.

In **T 81/03**, the board found that requests filed shortly before the minimum deadline set by it in the summons to the oral proceedings had to be regarded as belated where they contained points which could only be dealt with properly in an additional written phase.

Moreover, in **T 253/06**, the board held that it was permissible under Art. 13(3) RPBA 2007 to regard as belated auxiliary requests filed after oral proceedings had been arranged but within the prescribed period, if those requests were not substantiated, i.e. not accompanied by reasons explaining why the amendments had been made and how they were intended to overcome the objections raised in the course of the proceedings. In such cases, neither the board nor the other parties to the proceedings could reasonably be expected to consider these points, especially if there were a large number of requests and the features of the claims raised new aspects. The board cited **T 888/02**, in which it was found that, having regard to Art. 125 EPC 1973, the need to treat all the parties fairly precluded the admission of such requests.

Similarly, in **T 1443/05**, the board refused to admit the auxiliary request under Art. 13(3) RPBA 2007 because, as a result of its late filing, the question whether it met the requirements of Art. 123(3) EPC 1973 could not be answered without adjourning the oral proceedings (see also **T 1026/03**, **T 1305/05**, **T 455/06**).

16.3.3 Filing of requests during the oral proceedings

a) General

The board of appeals have developed several criteria in exercising its discretionary power to admit amended claims submitted for the first time during oral proceedings without any legally relevant excuse for the lateness. Claims which are clearly not allowable will not normally be admitted.

Moreover, R. 116 EPC (R. 71a(2) EPC 1973, not amended) and Art. 13(3) RPBA 2007 have considerably restricted the scope for admitting in opposition appeal proceedings new requests first filed by the patentee in oral proceedings despite specification of a deadline for filing such requests in the summons notice. Such auxiliary requests could be refused as belated under R. 71a EPC 1973, unless they had to be admitted on the grounds that the subject of the proceedings has changed (**T 1105/98**, **T 494/04**).

In **T 1105/98** the auxiliary request was not submitted until the start of oral proceedings before the board. The board took the view that such a request could be refused as late-filed under R. 71a(2) EPC 1973 (now R. 116 EPC), unless it was to be admitted because the subject of the proceedings had changed. Discretion under R. 71a(2) EPC 1973 could be exercised only if no such change had occurred. In doing so, the board had to make sure that the amended claims fulfilled the formal requirements and appeared likely to succeed, bearing in mind the time needed to ascertain this but also the right to be heard. These conditions were not fulfilled if a further search was needed, so that either the oral proceedings had to be postponed or the matter remitted to the department of first instance for further prosecution. The board in **T 681/02** adopted the view taken in **T 1105/98**, where the board had held that, if the said request was intended as a response to the board's preliminary opinion in preparation for the oral proceedings, it could have been submitted prior to the time limit specified in that opinion, that is to say, up to one month before the oral proceedings. Claim 1 according to the auxiliary request differed from Claim 1 as granted by virtue of an additionally incorporated feature. The general assumption therefore had to be made that this feature had not yet been searched.

In **T 831/92**, the board held that it was contrary to the principle of procedural fairness to file an auxiliary request in opposition proceedings during oral proceedings before a board of appeal because it was difficult for an opponent to deal with a request not submitted in good time before the oral proceedings (**T 1333/05**). In **T 667/04** the board stated that admitting the request could have led to a postponement of the oral proceedings and thus unacceptably delayed the conclusion of the appeal procedure. Since no exceptional circumstances were put forward excusing the late filing of this request, to have admitted it would have run counter to the principle of procedural fairness (see also **T 233/05**).

In **T 406/86** (OJ 1989, 302), the patentee proposed amendments at a stage of the appeal proceedings at which the examination of the appeal under Art. 110 EPC 1973 had practically been completed and a decision had already been drafted. The board held that admitting the amendments would slow down the proceedings and possibly affect the

rights of third parties. It conceded that a different conclusion might have to be reached in exceptional circumstances, e.g. if the amended text had been obviously allowable (see also **T 304/92**).

In **T 206/93** the appellant requested a further opportunity to file new claims, if the late-filed and not clearly allowable ones on file were not accepted after discussion. The board took the view that this was an auxiliary request which did not, however, specify the claims to be discussed. To have admitted it would have posed undue difficulties for the respondents in dealing properly with the new claims, and a possible adjournment would have led to an unacceptable delay in the proceedings. In **T 231/95**, auxiliary request 2 was not filed until the end of the oral proceedings on the ground that the need for a further restriction of the claimed subject-matter had only become apparent during the oral proceedings. However, the board found that the discussion in the oral proceedings had essentially been limited to the objections already raised in the preceding written proceedings and that no surprising new aspects had been raised which could have left the respondent facing new circumstances (see also **T 710/99**, **T 107/05**). Similarly, in **T 1194/02**, the debate in the oral proceedings had essentially been limited to the objections already raised during the written procedure and no unexpected matters creating new circumstances had arisen. Accordingly, the requests which had not been filed until the end of the oral proceedings were refused as belated.

During the oral proceedings in **T 14/02**, the respondent (patentee) requested the board's leave to file additional requests in order to limit the claimed subject-matter. The board refused the request on two grounds: firstly, the need for a new request had already been apparent before the oral proceedings since the board had already issued a communication containing a negative provisional opinion setting out why the main request did not appear to be inventive; secondly, the proposed subject-matter of the new requests would have required the other party to perform another search and might have resulted in a remittal.

In the ex parte case **T 1273/04** the board stated that claims which are clearly not allowable will not normally be admitted. However, if the claims pass this first low and straightforward threshold, they should be admitted if:

- (i) the amendments are clearly permissible under provisions of the EPC explicitly or implicitly governing amendment of the application,
- (ii) the newly defined subject-matter represents a convergent development of the subject-matter which has been the subject of the examination and appeal procedure to date and
- (iii) the subject-matter of the amended claims is clearly new.

Thus, the general principle is that in order to be admissible, an amended claim belatedly filed in oral proceedings must be clearly allowable by virtue of a clearly permissible amendment (**T 1311/05**).

In **T 1067/03** (inter partes), the board admitted an auxiliary request first filed during the oral proceedings. It regarded the clarifications in the auxiliary request as a response to the preceding discussion in the oral proceedings. Moreover, the amendment was not so complex that it would have made it impossible to reach a definitive decision in the oral proceedings.

b) Absence of the applicant from oral proceedings

Under Art. 15(3) and (6) RPBA 2007, the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned; that party may then be treated as relying only on its written case. It must also ensure that each case is ready for decision at the conclusion of the oral proceeding. The explanatory notes to Art. 15(3) RPBA state that this provision does not contradict the principle of the right to be heard pursuant to Art. 113(1) EPC since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity.

In **T 979/02**, the appellants confirmed that they would not be attending the oral proceedings two days before they were scheduled to begin. In the afternoon of the same day, they filed an amended set of claims as a "single main request". The board found that, for reasons of procedural economy, it had no choice but to decide on the admissibility of the request on the basis of whether the request documents were clearly admissible *prima facie*. It concluded that, *prima facie*, both the description and the claims taken alone revealed a number of formal deficiencies.

In **T 602/03** the board held that by filing amended claims shortly (about one month) before the oral proceedings and subsequently not attending these proceedings, the appellant must expect a decision based on objections which might arise against such claims in his absence. After amendment of the claims leading in essence to a version discussed at a previous stage of the procedure, nothing stood in the way of a decision being taken based on the objections and facts previously discussed, even if the decision was taken in oral proceedings held in the absence of the appellant and the amendment was filed in response to the summons to said oral proceedings (**T 78/05**, **T 942/05**).

In **T 1704/06** the appellant was not represented at the hearing. In view of the requirements of Art. 113(1) EPC, the Board had to consider at the oral proceedings whether it was in a position to decide on this claim, which contained subject-matter not previously present in an independent claim. In the situation where an appellant submits new claims after oral proceedings have been arranged but does not attend these proceedings, a board has a number of different options. It can continue the examination in writing, remit the case, grant a patent, or reject the claims as inadmissible. But it can also refuse the new claims for substantive reasons, specifically lack of inventive step, even if the claims have not been discussed before and were filed in good time before the oral proceedings. This will in particular be the case if an examination of these substantive requirements is to be expected in the light of the prevailing legal and factual situation.

In **T 1867/07** the board concurred with this view and added that a duly summoned party who by its own volition is absent at oral proceedings cannot be in a more advantageous position than this party would have been, had it been present. In the case at issue, the appellant had to expect a discussion on the formal and substantive issues of his newly filed set of claims during oral proceedings. The voluntary absence of the appellant cannot be a reason for the board not to raise issues it could have and would have raised had the appellant been present, and to decide accordingly.

c) Absence of opponent from oral proceedings

In **T 470/04**, the appellant patentee filed an amended set of 15 claims during the oral proceedings, which were not attended by the respondent/opponent. Since the amended set of claims was based on a combination of claims already on file, had been filed as a response to objections raised by the board during the oral proceedings, did not modify the main point of discussion defined by the decision under appeal and by the statement of the grounds of appeal, i.e. lack of inventive step, and could be easily dealt with by the board at the oral proceedings, the board concluded that the requests were admissible under the circumstances. Moreover, it was not obliged to delay its decision by reason only of the absence from the oral proceedings of the duly summoned respondent, who could be treated as relying only on its written case.

16.4. Criteria for consideration of amended claims

Although the belated filing of claim request is inherently fraught with the risk that they be disregarded, the situation is, nonetheless, rather frequently encountered. Accordingly, there are many decisions by the boards of appeal which define the circumstances which may arise, and the criteria which should be fulfilled, to justify the admission of these requests (**T 516/06**).

16.4.1 Clear allowability of amended claims

The factors to be examined in deciding whether a late-filed request is admissible include whether the subject-matter of the new claim is so clear and straightforward that it can be understood and allowed without further discussion. Claims are clearly allowable if the board can quickly ascertain that they do not give rise to new objections and overcome all outstanding objections under the EPC (**T 51/90**, **T 270/90**, OJ 1993, 725; **T 955/91**, **T 655/93**, **T 862/00**, **T 922/03**, **T 1004/01**). This means, first, that there must at least be no doubt that the late-filed requests meet the formal requirements (**T 1785/07**) and, second, that they constitute a promising attempt to counter the objection raised (**T 1859/06**).

In **T 482/89** (OJ 1992, 646), **T 543/89**, **T 297/91** and **T 252/92**, the boards admitted claims first submitted either at the beginning of or during the oral proceedings because they were clearly allowable.

In **T 87/05**, the board found that the general principle of procedural economy (see Art. 13(1) and (3) RPBA 2007) required that amended claims be clearly allowable, i.e. at

least meet the formal requirements of the EPC and not give rise to objections not yet already raised, so that their patentability could be assessed by the other parties and by the board at an advanced stage of the proceedings without giving rise to any difficulty or delay.

In **T 1004/01**, 12 auxiliary requests were submitted in response to the communication issued by the board preparing the oral proceedings and within the one-month period prescribed. The amendments to the claims related solely to a narrower definition of features and values which were so clear and straightforward that a person skilled in the art could easily understand them. It was not unusual, the board found, for several auxiliary requests to be submitted in appeal proceedings, since they were the patentee's last opportunity to have the patent maintained. The patentee's conduct therefore could not be regarded as abusive.

16.4.2 Response to objections

In general, the boards admit amendments filed in response to comments and objections made by the rapporteur or the other party. However, undesirable procedural delays should be avoided (see **T 38/89**, **T 459/91**, **T 933/91**, **T 1059/92**, **T 69/94**, **T 648/96**).

Amended claims may be admitted into the proceedings if the introduced amendments are properly justified, e.g. have been filed as a response to objections or comments which were not part of the decision under appeal but have been raised in writing during the appeal proceedings (**T 397/01**).

In **T 626/90**, the board decided to admit both sets of claims submitted by the respondent in the oral proceedings. In its view, the new versions of the claims were bona fide attempts to overcome the objections raised by the appellants in connection with the question of inventive step of the claimed process, and there was no question of the appellants having been unfairly taken by surprise, because the amendments in both requests were nothing more than a limitation of the claimed subject-matter to preferred embodiments of the invention as described in the patent in suit (**T 1097/99**).

In **T 610/94**, the appellant filed a new set of claims during the oral proceedings. It argued that it had limited claim 1 in view of the prior art in D 12 which had only been cited shortly before the oral proceedings and that the new claims were a response to the deficiencies identified by the board in the annex to the summons to oral proceedings. The board decided to admit the new claims and resume the oral proceedings after an adjournment of an hour and a half. In its decision, it found that the respondent ought to have expected an amended limited claim because it itself had not cited D 12 until shortly before the oral proceedings.

In **T 794/94**, the board recognised that patents in the field of genetic engineering sometimes gave rise to exceptional problems which made it difficult to formulate a suitable request and therefore amounted to exceptional circumstances justifying late submission of requests designed to meet objections which had already been considered at length. However, there was no right to file an endless succession of new requests in

substitution for requests found inadmissible or unallowable by the board. If it could quickly be checked that requests met the requirements of Art. 123 and Art. 84 EPC 1973 and were necessary to overcome a ground for opposition, the chances of their being accepted even at a very late stage were much improved. It was therefore advisable to put forward not just a clean copy of the claims, but also a copy of the claims as granted showing precisely by what verbal additions and deletions the claims of the new request were derived from the claims as granted. In addition, for each amendment, all passages in the original description which were relied on as providing a fair basis for that amendment should be given, as should the ground of opposition the amendment served to avoid.

In **T 1148/97**, the board took the view that late-filed claims could still be admitted if the amendments to the wording of the claims limited the scope of the subject-matter claimed to such an extent that revocation of the patent could be avoided and maintenance of the patent as amended ordered after swiftly conducted proceedings (**T 710/99**, **T 30/03**).

In **T 300/04**, the filing of the first auxiliary request at the oral proceedings did not raise any new issue but was clearly aimed at overcoming the previous inconsistency objection, the only difference being that in the course of the oral proceedings the respondent's objection turned out to be a plausible attack under Art. 84 EPC 1973 rather than a hypothetical one under Art. 83 EPC 1973. The board therefore considered the appellant's late response (first auxiliary request) to be justified. The filing of the first auxiliary request did not create any surprising or complex situation to the other party, and the board was still able to come to a decision at the oral proceedings.

In **T 1400/04** the late filed claims constituted reactions to objections made by the board and they were convergent clarifications of the claims which had been filed with the statement of grounds of appeal. Since in ex parte proceedings only the board had to deal with the amended case and adjournment of the oral proceedings was not necessary in view of appropriate amendments which rather reduced the complexity of the case, the board decided to admit the late filed amendments.

In **T 385/06** the patent proprietor filed amendments before the final date set in the board's communication. In the judgment of the board, these amendments might be seen as a response to the board's observations relating to two grounds for opposition. Hence these amendments were allowable under R. 80 EPC, since they were occasioned by grounds for opposition invoked by the opponents. They were thus filed pursuant to directions of the board and related to the case under appeal. Since the amendments were filed two months before the oral proceedings and since the patent proprietor specified in detail the passages of the patent specification, essentially dependent claims, on which these amendments were based, the board considered that the parties and the board could reasonably be expected to deal with the amendments without adjournment of the oral proceedings.

In **T 1254/06**, the board, when exercising its discretion, took into account the complicated procedural situation in which the appellant was. The sets of claims in the main request and auxiliary requests 1 and 2 were not the subject of the decision under appeal and had

first been filed by the appellant in the statement of grounds of appeal at the beginning of the second appeal proceedings. In its first decision to refuse, which had been the subject of the first appeal proceedings, the examining division had considered the main request, which differed only negligibly from the main request now at issue, to be incompatible with R. 86(4) EPC 1973 and refused it without a substantive examination. The appellant subsequently filed a divisional application. However, after the board's ruling on the first appeal had made clear that it considered the examination division's objection to be unfounded, the appellant had resumed prosecution of the claims in the main request and auxiliary requests 1 and 2 as part of the parent application.

16.4.3 Exercise of discretion

In **T 577/97**, the board referred to its discretion to admit amended claims at any stage of the appeal proceedings. In exercising its discretion in this case, it found that it was not required to use the test of "clear allowability" generally applied in the case law. Decisions not to admit auxiliary requests ought, in principle, to be limited to exceptional cases in which the filing of the auxiliary requests could be said to amount to an abuse of procedural rights. In **T 681/02**, the board observed that, in the specific case underlying the decision in **T 577/97**, the auxiliary request had contained a single amendment in the form of a new claim which corresponded to a granted claim with a further restriction. It could therefore be assumed that the subject-matter of the auxiliary request had been searched, so that, in contrast to the case now in hand, it could be examined definitively in the oral proceedings. Moreover, the boards had frequently refused to consider late-filed claims where these were not clearly allowable (**T 446/00**).

In some decisions, the boards cite **T 577/97** in relation to their discretion to accept amended claims at any stage of the appeal proceedings. In **T 1124/04** the board was confronted at a very late stage in the oral proceedings with the filing of further auxiliary requests. According to the appellant, the necessity of further restricting the claimed subject-matter had become apparent during the oral proceedings, in particular because the board considered D2 as the closest prior art. In line with **T 577/97**, the board held that it has at least the discretion to accept amended claims even at a late stage of the appeal proceedings, thus also during the oral proceedings. Of course, it has to be ascertained that the procedural fairness is not jeopardized by the admission of such late filed claims (**T 952/99**, **T 360/01**, **T 500/01**, **T 872/01**, **T 45/03**, **T 696/04**).

In **T 240/94**, the late filing had been unavoidable due to a combination of circumstances, including the relatively short notice given by the board in its summons to oral proceedings, the fact that the annex to the summons contained an unexpected negative assessment of one of the technical advantages of the invention put forward by the appellant, the difficulties of communication over the Christmas period and the unavailability of the client's technical expert. The board decided to admit the new request even though it had taken the respondents by surprise. It therefore had to give the respondents' representatives time to consult their clients and prepare an appropriate response. For those reasons, the board decided at the oral proceedings to continue the proceedings in writing in so far as they concerned the auxiliary request.

In **T 1449/05** the board stated that the discretion to permit amendment of a party's case pursuant to Art. 10b(1) or (3) RPBA 2003 may be exercised against a proprietor who seeks to resile at a late stage in the opposition appeal procedure from a previous long-standing acknowledgement or persistent tacit admission of prior art. Admitting this resilement would require in all fairness the adjournment of the oral proceedings to allow the appellant opponent to search for adequate evidence. This could have been done at an earlier stage of the proceedings.

16.5. Criteria for refusal to consider amended claims

16.5.1 Complexity of the amended claims

In accordance with the case law, the boards refuse to consider late-filed auxiliary requests on the ground that they are inadmissible where they are directed to subject-matter which *prima facie* is not allowable. The subject-matter must be so clear and straightforward that it can be easily understood and regarded as allowable (**T 51/90**; **T 270/90**, OJ 1993, 725; **T 482/89**, OJ 1992, 646; **T 252/92**; **T 1202/02**).

In **T 92/93**, the alternative set of claims contained new claims with subject-matter not previously claimed. In the board's view, the claims were not clearly allowable in the sense that the board could quickly ascertain that they did not give rise to new objections and overcame all outstanding objections under the Convention (similarly: **T 631/92**, **T 655/93**, **T 401/95**, **T 50/02**).

In **T 70/04**, the board refused to admit an auxiliary request for maintenance of the patent in a further amended form, citing *inter alia* Art. 10b(3) RPBA 2003. With respect to the admissibility of this auxiliary request, the board found that, although the amendment indicated was a combination of two claims, it was quite extensive and raised new issues which had not yet been considered in the opposition or appeal proceedings, mainly because of a greatly increased number of variables compared to claim 1 as maintained. Had it admitted the request, the board would have been obliged either to remit the case to the opposition division, so as to prevent the losing party from being deprived of an instance, or to arrange for further oral proceedings.

In order to justify the late filing of the amended claim during oral proceeding in **T 708/05** the appellant stated he was faced with an unexpected situation because the board took the opposite position on novelty from the Opposition Division. The board held that the fact that a board of appeal reverses a conclusion reached in a decision at first instance is a matter which a party must always be prepared for. In the present circumstances the introduction of a disclaimer to establish novelty at this late stage, a proposal which had previously been on the table but which had been abandoned in the meantime by the appellant, is not conduct which warrants the exercise of the board's discretion in the appellant's favour. Such erratic conduct is at variance with the purpose of fair and duly structured appeal proceedings, which should be conducted so as to avoid it being left to the other party/parties to guess how they should organise their defence. Furthermore, the subject matter of this new request would still give rise to several objections and would therefore not amount to clearly allowable subject-matter.

16.5.2 Change of subject-matter

In **T 1273/04**, the board held that an amended claim belatedly filed in oral proceedings could only be admitted if it was clearly allowable by virtue of a clearly permissible amendment. However, this principle had to be tempered in examination appeal proceedings by having regard to the extent to which the application had been examined. Applying this to the case in hand, the board found that claim 1 of the main request had been amended in a clearly permissible manner. However, the amendment had shifted the subject-matter claimed in a divergent manner which would require a new study of the prior art and potentially even review of the search in order to assess novelty. The main request was therefore refused.

In **T 651/03**, the board found that claim 1 of the first auxiliary request had been amended in such a way that its category had been changed from a product claim to a use claim. The board concluded that this change extended the patent protection and therefore ran counter to Art. 123(3) EPC 1973. The late-filed request was therefore clearly non-allowable.

16.5.3 Need for additional search

In **T 14/02**, intended requests as suggested by the respondent in the oral proceedings would not just have involved a minor change in the wording of claim 1 but rather major limitations of the claim which in all likelihood would have required a new search by the appellant and could have caused a remittal to the first instance (see also **T 51/90**, **T 270/90**, OJ 1993, 725; **T 25/91**). In **T 48/91**, the board refused the amended claims as inadmissible because they contained additional features the impact of which was either unclear or impossible to assess without further investigations such as carrying out proper comparison tests (see also **T 234/92**, in which a feature from the description was introduced to claim 1, so that an additional search might have been required, and **T 1105/98**, in which an additional search was needed).

If an additional search is needed to assess the lack of patentability asserted as the ground for opposition, so that either the oral proceedings must be adjourned or the case must be remitted to the first-instance department for further prosecution, it is unreasonable to expect the other parties to accept this (**T 494/04**).

In ex parte case **T 979/07**, the board said that admitting a set of claims filed only in oral proceedings and necessitating an additional search because it shifted the claimed invention to other technical matter would de facto give applicants in appeal proceedings carte blanche to get oral proceedings postponed or the whole examination procedure reopened. That would be at odds with the requisite procedural economy (see also **T 407/05**, **T 1123/05** and **T 764/07**).

16.5.4 Principle of procedural economy

Under Art. 13(1) RPBA 2007, the board must exercise its discretion in view of the need for procedural economy. Requests filed very late (i.e. during the oral proceedings) will

therefore be admitted only if they are *prima facie* allowable. The admission of new requests at a very late procedural stage (shortly before the oral proceedings) is only in keeping with the principle of procedural economy if the requests are not unsuitable from the outset to overcome the doubts as to the allowability of the claims (**T 978/05**, **T 1731/06**, **T 33/07**, **T 321/07**).

In **T 1790/06**, in exercising its discretion the board also took account of the conduct of the respondent (patentee) during the oral proceedings. A party's obligations included taking care not to act in a manner detrimental to the efficient conduct of oral proceedings. At such proceedings, it should not for example submit requests willy-nilly, withdraw them and then resubmit them later. That was unacceptable, for both the board and other parties. Specifically, considerations of procedural economy required that they be given reasonable time to consider any new requests filed, in particular without postponing the oral proceedings.

In **T 796/02**, the board held that it amounted to an abuse of procedure to withdraw a request with broader claims in appeal proceedings in order to prevent the board from taking a negative decision on it, but then re-introduce those broader claims before the opposition division, after a remittal of the case for further prosecution on the basis of much more limited claims was obtained. As the case in issue showed, the overall length of further opposition and possibly further appeal proceedings after remittal was likely to severely impair the legitimate interests of the other party or parties and of the general public in having some degree of legal certainty about the existence and scope of the European patent within a reasonable time span. The re-introduction of both the main and the first auxiliary requests therefore amounted to an abuse of procedure, so that they could not be considered by the board.

In **T 516/06** the board stated that there is no right to file an endless succession of new requests in substitution for requests found inadmissible or unallowable by the board. Proceedings must come to an end some time. If the contrary was true, oral proceedings could easily be misused, in particular in *ex parte* proceedings, to test the board's opinion as to what subject matter might be patentable and to tailor claims accordingly. In such cases, while not "holding the pen", the board would nonetheless be the ghost-writer of what was ultimately claimed.

16.5.5 Amended claims not admitted with divisional applications pending

In **T 840/93** (OJ 1996, 335) the board held that in the light of **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), special attention must be given to late-filed requests at the appeal stage when divisional applications are still pending. If the distinction between the subject-matter of the divisional applications was unclear and some of them were still pending before the department of first instance, it was inappropriate to admit, during oral proceedings at the appeal stage after opposition, new requests which are neither immediately allowable nor *bona fide* attempts to overcome objections raised.

In **T 28/92** the claims were not obviously allowable and the alternative of admitting the requests, but referring the matter back to the department of first instance for further

examination, was not acceptable, particularly as there were still pending divisional applications of the application on which the patent in suit was based. The board would not wish to increase the number of proceedings in which much the same subject-matter was already being considered by various instances of the EPO.

16.6. Reinstating broader claims in appeal proceedings

16.6.1 General

The limitation of claims may represent attempts to respond to objections by the EPO or an opponent without necessarily involving any immediate intentions of substantive abandonment. In this case the question arises of whether the applicant or patent proprietor can reinstate broader claims which had been proposed at an earlier stage of the proceedings.

16.6.2 Ex parte proceedings

In **T 12/81** (OJ 1982, 296), the application had been refused. In their statement of grounds of appeal the applicants requested that claim 5 be deleted. During the oral proceedings, however, the applicants requested that this claim be reinstated in the application. The board refused this request on the grounds that allowing such a late request contravened the ratio legis of R. 86(3) EPC 1973 in conjunction with R. 66(1) EPC 1973, which was to prevent proceedings becoming unduly prolonged.

In **T 1282/05**, on being summoned to oral proceedings the appellants had filed new requests, the claims in the amended requests relating to matter not previously claimed or discussed in the appeal proceedings. The independent claims in these requests were worded far more broadly than the matter previously claimed in the appeal proceedings and essentially constituted a return to the original claim 1. The board found that the amendments could not be regarded as a response to objections in the summons, nor had the appellants given any reasons for them. Moreover, the statement of grounds gave no indication that such a return towards the originally claimed matter was intended. Hence the appellants' actions constituted an infringement of Art. 12(2) RPBA 2007. Furthermore, comparable requests could have been submitted before the department of first instance.

16.6.3 Inter partes proceedings

The boards have consistently ruled that a proprietor who has defended his patent to only a limited extent in opposition proceedings is not prohibited a priori (i.e. except in specific cases where the reformatio in peius prohibition applies or there has been abuse of procedure) from returning to a broader version of his patent, including the granted version, in subsequent appeal proceedings. According to these rulings, intervening limitations of the patent do not imply any express abandonment of parts of it but are to be regarded merely as attempts to word the patent so as to delimit it against objections (see inter alia **T 123/85**, OJ 1989, 336; **T 296/87**, OJ 1990, 195; **T 900/94**; **T 699/00**; **T 880/01**; **T 794/02**; **T 934/02**; **T 1018/02**; **T 1276/05**).

The right in principle to reactivate earlier claims is refused if it appears to constitute an abuse of procedure, as was the case in **T 331/89**. In this case the board saw a procedural abuse when the request was filed as late as the oral proceedings and from its content was not immediately allowable.

According to **G 9/92** and **G 4/93** (OJ 1994, 875), in opposition appeal proceedings the extent to which the patent proprietor is entitled to make amendments depends on the result of the first instance proceedings and on whether the patent proprietor himself filed an admissible appeal or is merely the respondent (the view taken in e.g. **T 576/89**, OJ 1993, 543; **T 770/89** and **T 217/90** is thus no longer applicable):

The following scenarios must be considered:

(i) Where the patent proprietor is appealing against the revocation of his patent, he is entitled to revert to a more broadly worded version of the patent, and in particular the one as granted, even if he had filed a restricted version at the commencement of appeal proceedings (**T 89/85**; **T 296/87**, OJ 1990, 195; **T 373/96**, **T 65/97** and **T 564/98**). According to **T 386/04** an appellant-proprietor, whose patent has been revoked, is entitled to seek maintenance of the patent as granted even though its main request before the opposition division had only been the maintenance of the patent in a more limited form. This long standing principle is not contradicted by decisions **T 528/93** or **T 840/93** (OJ 1996, 335), which are concerned with new claims raising new issues, and is not contrary to the statement by the Enlarged Board of Appeal in decision **G 9/91** (OJ 1993, 408) concerning the purpose of an appeal (see also **T 1276/05**).

Should opposition appeal proceedings reveal that the claims as amended during opposition proceedings are in breach of Art. 123(3) EPC 1973, the patent proprietor and appellant must be allowed to abandon this version (**T 828/93**).

(ii) Where the **opposition is rejected** and the patent maintained as granted, the respondent (patent proprietor) can revert to the version as granted, provided he has first proposed restrictions during the appeal proceedings (**T 705/91**).

(iii) Where the patent is **maintained as amended**, the **patent proprietor**, who did not himself file an **admissible appeal**, may, according to **G 9/92** and **G 4/93** (OJ 1994, 875), in principle only defend the patent in the form in which it was maintained by the opposition division in its decision. He may not revert to the version of the patent as granted (see also **T 369/91**, OJ 1993, 561). Any amendments he proposes in the appeal proceedings may be rejected by the board if they are neither appropriate nor necessary, which is the case if the amendments do not arise from the appeal (see, for example, **T 266/92** of 17.10.1994). According to **T 752/93** of 16.7.1996, however, an amendment made in the course of appeal proceedings to the version as amended by the opposition division which is appropriate and necessary may not merely restrict this version; it may also extend it - even in cases where the patent proprietor has not filed an appeal. For the limits set on the respondent (patentee) to make amendments see **G 1/99** (OJ 2001, 381; see also chapter VII.E.6, extent of scrutiny).

iv) If, however, where the patent is maintained in amended form, the **patent proprietor** is himself the **appellant**, he may in appeal proceedings pursue claims which are broader than those held to be allowable by the opposition division.

In **T 168/99** the board admitted the main request into the proceedings although it had previously been withdrawn and had not been considered by the opposition division. According to the board, an action taken in opposition proceedings by the patent proprietor before the opposition division had issued any comments on the relevance of the grounds for opposition, should *prima facie* be considered as a mere proposal directed to the opponent made with a view to reaching an early agreement. The wording of the withdrawal ("[revised claims] to replace all the claims at present on file") neither stated nor implied that the subject-matter was being abandoned. In **T 528/93** the board took the view that a request filed during oral proceedings before the opposition division and then withdrawn at the same proceedings, without having been assessed by the opposition division, and hence not the subject of the contested decision, was not the subject of the appeal, because the appellant was not adversely affected by such a decision with respect to that request. Exercising its discretion, the board did not therefore admit this request into the appeal proceedings (see also **T 506/91**).

16.7. Circumstances extraneous to proceedings

16.7.1 Introduction

In some cases, the parties justify the amendment of claims with circumstances extraneous to the proceedings. The boards have refused to accept the following justifications: **T 160/89** (heavy workload); **T 148/92** (doubts as to the definitive embodiment of the invention; appellant's frequent need to travel); **T 626/90** (lack of timely instructions), **T 583/93** (OJ 1996, 496; lack of communication between the patentee and the licensee); and **T 575/94** (new instructions).

In **T 764/03**, the only reason given by the appellant for the failure to introduce the auxiliary requests at an earlier stage of the proceedings was that the patentee had taken so long to reach a decision on the patent content which it considered useful to prosecute from a competition point of view. The board observed that only the rules and the circumstances of the appeal proceedings in question could be considered when determining at what stage of appeal proceedings requests had to be filed, when they had to be regarded as belated and what the legal consequences of such belatedness were. Circumstances extraneous to the proceedings, such as e.g. licensing negotiations with competitors or infringement proceedings were not factors which could be taken into account in assessing when in the appeal proceedings requests affecting the patent's content had to be filed, unless they were put forward as grounds for a request for accelerated handling of a case.

16.7.2 Change of party or representative

In **T 408/91**, the new patentee's representative filed amended claims when the oral proceedings were opened. The board found that, since ownership of the patent had been

transferred long after the date on which the grounds of appeal were filed and since the claims according to the new request appeared to be a genuine attempt to meet the grounds on which the patent was revoked by the opposition division, the late filing seemed justified in this case.

In **T 830/90**, the board refused to accept a change of representative as justification for the late filing of the requests. The same view was taken by the board in **T 382/97**, in which it held that the mere change of a representative was not a valid ground justifying the late filing of requests since it was an arbitrary move by the relevant party by which it could influence which procedural actions had to be considered as belated and which as timely. It was evident that such a situation would be contrary to any reasonable procedural conduct. Only if the change of representative was necessitated by proven exceptional and extraordinary circumstances might the board come to different conclusions.

In **T 1032/96**, the board held that the late transfer of the case to the representative owing to the illness of a colleague was not sufficient justification for the failure to submit the set of claims until just three days before the date of the oral proceedings. The claims were deemed to be late.

In **T 1282/05**, the board held, *inter alia*, that a withdrawal of the representative did not justify the late return to broader subject-matter which had not yet been discussed in the appeal proceedings because the board had to assume that all actions of the former representative had been performed in consultation with and with the approval of the appellant, to whom they therefore had to be imputed.

17. Reimbursement of appeal fees

Under the EPC 2000, R. 103 EPC has replaced R. 67 EPC 1973 as the basic provision dealing with the reimbursement of appeal fees. That part of R. 67 EPC 1973 providing that the reimbursement of appeal fees should be ordered in the event of interlocutory revision or where the board of appeal deems an appeal allowable, if such reimbursement is **equitable** by reason of a **substantial procedural violation** has been transferred to R. 103(1)(a) EPC.

Furthermore, R. 103(1)(b) EPC goes some way towards compensating for the lack of a cross-appeal facility. Appeals filed as a precaution – in case the other party appeals – can be withdrawn if the other party does not file an appeal, at an early stage of the proceedings, during the period between the expiry of the respective periods for filing the notice of appeal and filing the statement of grounds of appeal, i.e. before any great expense or effort on the part of the parties or the EPO. New R. 103(2) EPC governs the competence of the department of first instance and of the board of appeal in the matter of the reimbursement of the appeal fee and codifies the case law of the Legal Board of Appeal (**J 32/95**, OJ 1999, 713).

This chapter essentially reports on developments resulting from decisions given while R. 67 EPC 1973 still applied. For the rules formally applicable to patent applications

pending on the date of entry into force of the EPC 2000, see **J 10/07** (OJ 2008, 567), **T 2052/08** and also for example **T 1039/04**, **T 1544/06**, **T 1006/04**, **T 630/08**, **T 616/08**.

17.1. General issues

In **T 939/95** (OJ 1998, 481), the board found that the clause starting "if such reimbursement", read in its context, refers both to interlocutory revisions and appeals. This means that for each of these stages it is a prerequisite that a substantial procedural violation has occurred and that reimbursement is found equitable in the discretion of the deciding body.

In certain cases the boards will, even in the absence of a request to this effect, examine whether the reimbursement of the appeal fee is equitable by reason of a substantial procedural violation (**J 7/82**, OJ 1982, 391; **T 271/85** of 22.3.1989; **T 346/88**, **T 598/88** and **T 484/90**, OJ 1993, 448). They do not, however, have the power to reimburse the appeal fee if the conditions of R. 67 EPC 1973 are not met (**T 41/82**, OJ 1982, 256).

It also has to be borne in mind that R. 67 EPC 1973 applies only to a procedural violation by the first instance department whose decision is under appeal. Thus, in **T 469/92** the alleged procedural violation was not an act of the opposition division, whose decision was the subject of the appeal, but instead that of the examining division. Even if such an act were in breach of the procedural requirements of the Convention, a board of appeal would not have the power to order reimbursement.

If an appeal is **inadmissible** or withdrawn the EPC 1973 does **not** provide for reimbursement of the appeal fee (**T 372/99**, **T 543/99**, **T 1216/04**, **T 752/05**, **T 1375/05**). On the other hand, reimbursement of the appeal fee is ordered if an appeal is **deemed not to have been filed** because the appeal fee was not paid in due time in accordance with Art. 108, second sentence, EPC 1973. In this case, since the purpose of the fee cannot be achieved, the fee must be repaid without the board of appeal having to make any specific order to that effect (**J 21/80**, OJ 1981, 101; **J 16/82**, OJ 1983, 262; **T 324/90**, OJ 1993, 33 and **T 239/92**; for the distinction between the existence and admissibility of an appeal, see e.g. **T 445/98**, **T 460/95**; see also **T 778/00**, OJ 2001, 554). In **T 1192/07**, the request for re-establishment was refused. As a result, the appeal was deemed not filed because the appeal fee had not been paid in time. Therefore, the appeal fee had to be refunded (**T 257/07**, **T 1465/08**).

In **T 791/06** the intervention of appellant III was considered, by the board, to be an admissible intervention in opposition appeal proceedings, and so only the required opposition fee needed to be paid, as established by **G 3/04**. Hence there was no legal basis for retaining the appeal fee, which in any case had been paid as a precaution. The board therefore concluded that the appeal fee paid by the intervener should be reimbursed.

In **T 323/87** (OJ 1989, 343) the translation of the notice of appeal had not been filed in due time. The board held that, pursuant to Art. 14(5) EPC 1973, the notice of appeal was deemed not to have been filed, and ordered reimbursement of the appeal fee. More

recently it was also decided in **T 1152/05** that, since the appeal of the patent proprietor was deemed not to have been filed, it followed that the appeal fee was paid without reason and had to be reimbursed. In **T 126/04**, on the other hand, the board decided that failure to file a translation of the notice of appeal in due time meant that the appeal was inadmissible.

In **T 308/05** the board ruled that the appeal fee was to be reimbursed even though the appeal had been withdrawn. In exceptional cases it was possible - outside the scope of R. 67 EPC 1973 - to consider refunding the appeal fee for reasons of equity. A refund had been ordered, for instance, in cases where the principle of the protection of legitimate expectations had been violated (**J 30/94**, **J 38/97**). The fact that in the case in point the EPO had been found to have breached the principle of the protection of legitimate expectations, and that the consequence had been the filing of an appeal which was objectively superfluous, made it necessary for reasons of equity to refund the appeal fee paid by the appellant.

The appeal fee cannot be refunded on the basis that no statement of grounds was filed, or it was filed too late (**T 13/82**, OJ 1983, 411; **T 324/90**, OJ 1993, 33). This also applies where the grounds of appeal have deliberately not been filed in order to make the appeal inadmissible (**T 89/84**, OJ 1984, 562), or where the appeal, after due filing of the notice of appeal and payment of the appeal fee, is withdrawn before expiry of the period for filing the grounds of appeal (**J 12/86**, OJ 1988, 83). In **T 773/91** the sole appellant had withdrawn his appeal before the board had started to examine it. The board decided that the appeal fee could not be reimbursed, since the appeal had been validly filed.

In **J 15/01** the board ruled that the fact that an appeal was against a communication, as opposed to a decision under Art. 106(1) EPC 1973, did not justify refunding the appeal fee. If - as in the case before it - the board concluded that there had not been an appealable decision under Art. 106(1) EPC 1973, this made the appeal inadmissible but did not mean it had never existed, the requirements under Art. 108 EPC 1973 having been met. The appeal fee could not therefore be refunded.

17.2. Allowability of the appeal

R. 103 EPC stipulates as a precondition for reimbursement that the appeal must be allowable. It is clear from the wording and purpose of the provision that "allowable" is to be understood to mean that the board of appeal, in substance at least, "follows" the relief sought by the appellants, in other words allows their requests (**J 37/89**, OJ 1993, 201). In **J 18/84** (OJ 1987, 215) the Legal Board of Appeal ordered the reimbursement of the appeal fee, saying the fact that the appeal was allowed only in part was no impediment to a refund (see also **T 129/01** and **T 604/01**).

17.3. Fairness

A number of decisions have discussed the term "equitable" within the meaning of R. 67 EPC 1973 (R. 103 EPC).

17.3.1 Reimbursement held to be equitable

In **J 30/94** the board referred to the principle of fair procedure and held that after the withdrawal of an appeal, reimbursement of the appeal fee could **exceptionally** be ordered, if the appeal had not been remitted to the board of appeal within a reasonable time after the first-instance decision not to allow it. In the case at issue, the appeal was only referred to the board of appeal seven years after its filing.

In **T 1198/97** and **T 1101/92** the board observed that there was a causal link between the violation of the appellant's right to be heard and the necessity to appeal; thus reimbursement of the appeal fee was equitable.

In **T 552/97** the board interpreted R. 67 EPC 1973, looking in particular at the English text, as meaning that, where several appeals have been filed, each appellant's appeal fee may be reimbursed if such reimbursement is equitable. In the case in point, the board ordered that the patent proprietors' appeal fees as well as those of opponent 2 be reimbursed.

In **J 38/97** the board took the view that the appellant, having requested an appealable decision, could legitimately expect the impugned decision to be issued by the competent department and not by a person lacking legal authority. In accordance with the principle of good faith governing relations between the EPO and applicants, it was equitable in these circumstances to order the reimbursement of the appeal fee.

In **T 281/03** dated 17 May 2006 the board held that reimbursement of the appeal fee was equitable despite the fact that the appellant had continuously delayed his case on inventive step until the last possible moment. The board noted that delaying detailed substantiation of the ground of inventive step raised in the notice of opposition until the last moment of opposition proceedings should be avoided if possible, since it created an unexpected situation for the other parties and the opposition division. However, in the special case where an inventive step argument was based on the same document as the novelty argument, and the novelty of the features in question could not be answered with a simple yes or no, but depended on how the document was interpreted as a whole, it might be difficult, if not impossible, for an opponent to argue lack of inventive step without a precise statement of how the document was understood, and the features actually found to be different by the opposition division.

17.3.2 Reimbursement held not to be equitable

The boards have advanced a variety of reasons for deciding that a reimbursement of the appeal fee was not equitable. These include the following: (i) the conduct of the appellant was such as to render reimbursement of the appeal fee inequitable, (ii) the substantial procedural violation had not been sufficiently closely linked to the need to pay the appeal fee, and (iii) the substantial procedural violation had not been the determining factor in the decision under review or the appeal decision.

In **J 22/85** (OJ 1987, 455) the board did not consider a reimbursement of the appeal fee to be justified because the appellant had failed to provide the Receiving Section with the evidence subsequently submitted in the appeal proceedings.

In **J 4/09**, the board said that, as a rule, an applicant could be regarded as behaving inequitably if it made no use of opportunities to participate in the initial proceedings. In this case, it had not reacted to the Receiving Section's communication; only in its statement of grounds for appeal had it drawn attention to an obvious inconsistency.

In **J 18/96** (OJ 1998, 403) the Receiving Section had failed to observe the provisions concerning examination on filing. The proceedings were therefore marred by a procedural violation. Although the appeal was allowed on the ground, *inter alia*, of a procedural violation, the reimbursement of the appeal fee was not equitable because the appellants themselves had contributed to the failure of the proceedings before the Receiving Section.

In **T 167/96** the impugned decision did not meet the minimum requirements for a reasoned decision. Although there was no doubt that this lack of reasoning amounted to a substantial procedural violation, the board did not consider that a refund of the appeal fee was equitable. Indeed, it was clear from the file history that the proprietor had been afforded a very considerable period of time by the department of first instance to file appropriate amendments, but had not replied. It then filed on appeal a set of amendments which, it believed, overcame the outstanding objections. In the judgment of the board the appellant had availed himself of the appeal procedure to file necessary amendments which the opposition division had sought in vain over a period of years to elicit from him. The decision was set aside and the case remitted to the department of first instance pursuant to Art. 10 RPBA 1980 (see also **T 908/91**).

In **T 1216/02** the search division had sent a supplementary European search report to the applicant (appellant) with a wrong citation which was deceptively similar to the correct one. The examining division had refused the application because of the applicant's "incomprehensible" response to its second communication. The appellant had requested that the examination procedure be resumed to enable him to replace his response with a response based on the right document. The board held that, albeit for reasons outside the knowledge and control of the examining division, the refusal decision had been based on evidence on which the applicant had not had an opportunity - viewed objectively - to present his comments. This constituted an objective substantial procedural violation within the meaning of R. 67 EPC 1973. However, the board did not deem reimbursement of the appeal fee equitable, because the appellant should have facilitated further substantive examination in the event of remittal or interlocutory revision by including in his statement of grounds of appeal a substantive response to the examining division's communication, based on the document which, at the time when the appeal was filed, he had known to be correct.

In **T 893/90** the contested decision to refuse the application on the grounds of lack of novelty was based primarily on document 1, on which, in contrast to document 2, the appellant had had adequate opportunity to put forward comments. The board stated that

the decision under appeal had been fully reasoned, and that the procedural violation as regards the reliance on document 2 was thus not sufficiently closely linked to the need to pay an appeal fee for it to be equitable to reimburse the fee (for a case where the appellant had no choice but to appeal on other issues unaffected by a procedural irregularity, see **T 4/98**, OJ 2002, 139.)

In **T 41/97**, a refund was not equitable because the procedural error (refusal of interlocutory revision prior to receipt of the statement of grounds of appeal and before the expiry of the period for filing it) was not the reason the appeal had been filed.

In **T 601/92** the opposition division had not commented, either in a communication or in its decision, on auxiliary request (5) submitted by the patent proprietor in good time before the decision was issued. Because auxiliary request (2), which had been submitted in the appeal proceedings and which preceded auxiliary request (5), was allowed, the board did not see any reason, despite the procedural violation, to reimburse the appeal fee, as this would not have been equitable.

In **T 219/93** the board remitted the case to the department of first instance since it clearly called for revision under Art. 109 EPC 1973. The contested decision had also been inadequately reasoned on one point within the meaning of R. 68(2) EPC 1973. Nevertheless, the board decided not to reimburse the appeal fee because the refusal had been made principally on other grounds, and the board did not consider the procedural violation to be so substantial within the meaning of R. 67 EPC 1973 that the reimbursement would be equitable.

17.4. Substantial procedural violation

Set out below are cases concerning the definition of a "substantial procedural violation", as well as cases falling within the main categories of cases where substantial procedural violations have been alleged and/or occurred.

17.4.1 Definition

According to R. 67 EPC 1973 (R. 103 EPC) it is a precondition for reimbursement of the appeal fee that a substantial procedural violation has taken place. A "substantial procedural violation" is an objective deficiency affecting the entire proceedings (**J 7/83**, OJ 1984, 211). According to **J 6/79** (OJ 1980, 225), the expression "substantial procedural violation" was to be understood, in principle, as meaning that the rules of procedure had not been applied in the manner prescribed by the Convention. However, the giving of incorrect information by the EPO about the rules of procedure, which, if followed by the applicant, could lead to the same consequences as the incorrect application of those rules, could also be considered as lying within the scope of a "procedural violation". In **T 12/03** the board stated that a substantial procedural violation is an objective deficiency in the procedure in the sense that the rules of procedure have not been applied in the manner prescribed by the Convention. In **T 1875/07** the board stated that a substantial procedural violation can only be committed by one of the departments charged with the procedure mentioned in Art. 15 EPC 1973 but not by the

President acting under Art. 10 EPC 1973. Therefore, the mere non-disclosure to the public of the details of a system for performance evaluation used in the EPO cannot amount to a substantial procedural violation.

In **T 2321/08**, the examining division violated the procedure foreseen in Art. 94(3) and R. 71(1) EPC 2000. This procedural violation was substantial because its immediate consequence was the refusal of the application.

In **J 14/99**, as in **J 15/99**, **J 21/98** (OJ 2000, 406), **J 22/98** and **J 6/99**, it was decided that a procedural violation which had not played any part in the decision could not be considered substantial.

In **T 5/81** (OJ 1982, 249) it was stated that an alleged violation affecting a part of the decision other than its ratio decidendi cannot be a substantial violation within the meaning of R. 67 EPC 1973.

In **T 712/97** the board held that the opposition division had actually considered the respondent's experimental report, but had not relied on it in a way adverse to the appellant. Therefore, the refusal to admit the appellant's experimental report into the proceedings, while a violation of the appellant's right to present comments on the respondent's experimental report, had no influence on the decision reached by the opposition division. As the refusal had no substantive effect on the outcome of the proceedings, it did not amount to a substantial procedural violation.

In **T 682/91** the board of appeal emphasised that a procedural violation which did not adversely affect anyone could not be considered substantial. The seriousness of a procedural violation derived from its adverse effects.

17.4.2 Request for oral proceedings

The refusal of a request for oral proceedings usually amounts to a breach of the right to be heard, and as such, a violation justifying the reimbursement of the appeal fee (**T 283/88**, **T 598/88**, **T 668/89**, **T 663/90**, **T 766/90**, **T 795/91**, **T 35/92**, **T 686/92**, **T 556/95**, **T 647/99**). See also the specific case **T 902/04** (quoting **T 394/03**) in chapter VII.E.5.2, appeal procedure.

According to **T 405/96**, there was a substantial procedural violation justifying the reimbursement of the appeal fee where, despite a request by the appellants, no oral proceedings had been convened. This applied if receipt of the request by the EPO was proven by the appellants' producing a duly stamped acknowledgment of receipt, even if the department of first instance was unaware of the request since it had gone missing within the Office. The board implied that the fact that the department of first instance could not be held responsible for the loss was irrelevant. The same applied to the failure by the opposition division, because of an oversight, to hold oral proceedings in response to a clear request by the appellants (**T 671/95**).

Failure to summon the parties to oral proceedings was considered to be a substantial procedural violation in **T 209/88** and **T 93/88** (see also **J 16/02**). In **T 560/88** the board of appeal held that there was a substantial procedural violation where a clear auxiliary request by the appellant for oral proceedings had not been granted (see also **T 543/92**).

In **T 19/87** (OJ 1988, 268), however, the board held that the finding - albeit wrong - that there had been no request for oral proceedings was not a procedural violation within the meaning of R. 67 EPC 1973. Furthermore, failure to seek clarification from the appellant as to whether oral proceedings were being requested did not constitute a breach of any procedure.

In **T 1183/02** (OJ 2003, 404) the board held that a response to a summons to oral proceedings before the examining division which contained good-faith responsive amendments and arguments did not stay the summons. Hence omitting to confirm that the summons remained valid did not constitute a substantial procedural violation within the meaning of R. 67 EPC 1973.

In **T 182/90** (OJ 1994, 641), **T 119/91**, **T 523/91**, **T 366/92** and **T 397/94** the boards of appeal stated that it was **not** a substantial procedural violation within the meaning of R. 67 EPC 1973 if a request to be called back by or have an interview with the primary examiner was ignored. It was a matter for the examiner's discretion to decide whether to conduct such informal discussions in accordance with the Guidelines, bearing in mind the particular circumstances of the case (see also **T 300/89**, OJ 1991, 480).

17.4.3 Right to be heard

In **J 14/82** (OJ 1983, 121), **T 197/88** (OJ 1989, 412), **T 716/89** (OJ 1992, 132), **T 197/91**, **T 640/91** (OJ 1994, 918), **T 734/91**, **T 880/91**, **T 392/92**, **T 892/92** (OJ 1994, 664), **T 951/92** (OJ 1996, 53), **T 1045/92**, **T 1101/92**, **T 220/93**, **T 479/94**, **T 778/98**, **T 594/00** and **T 1039/00**, reimbursement of the fee for appeal was ordered because the principle of the right to be heard enshrined in Art. 113(1) EPC 1973 (Art. 113(1) EPC) had been infringed, particularly as there had been a lack of opportunity to present comments on the grounds for the contested decision.

In **T 18/81** (OJ 1985, 166) the board of appeal stated that the right to be heard had been infringed when a decision to refuse an application was based essentially on documents which, though supplied by the applicant in support of his case, had been used against him to produce an effect on which he had not had an opportunity to make observations.

In **J 7/82** (OJ 1982, 391) the Legal Board of Appeal ordered reimbursement of the appeal fee because the appealed decision had not taken account of any of the arguments put forward by the appellant and had been based on a ground on which he had not had an opportunity to present his comments. In this connection it was held in **T 197/88** (OJ 1989, 412) that causing one of the parties to be taken by surprise amounted to a substantial procedural violation.

In case **T 246/08**, the board pointed out substantial procedural violations. To safeguard a party's right to be heard pursuant to Art. 113(1) EPC a decision must show that all potentially refutative arguments adduced by a party were actually refutable. As stated in **T 763/04** "it is not sufficient to observe Art. 113(1) EPC merely formally by granting the Applicant the procedural possibility for presenting comments." The board judged therefore in case **T 246/08** that the failure to take into due account a potentially refutative argument of the applicant when deciding the case deprived the applicant of its right to be heard in contravention of Art. 113(1) EPC and amounted to a substantial procedural violation. The applicant could expect that the opportunity to comment pursuant to Art. 113(1) EPC was not a mere formality, but a genuine opportunity to voice its arguments and have them heard. Otherwise the invitation to submit further arguments would be nugatory. Furthermore in this case the board stated that a refusal to allow amendment made in advance of any amendment being submitted could not be a reasonable exercise of discretion pursuant to R. 137(3) EPC (former R. 86(3) EPC 1973) and was ipso facto a substantial procedural violation.

In **T 783/89** the parties were given only ten minutes to consider a new version of the main claim at the oral proceedings. The board held that this way of proceeding caught the appellants by surprise and thus amounted to a substantial procedural violation.

Issuing a communication under R. 51(4) EPC 1973 in which amendments were proposed which the applicant could not reasonably be expected to accept without further discussion constituted a substantial procedural violation (**T 121/06**).

In **T 543/92** and **T 89/94** the opposition division overlooked amended claims presented in a submission. Reimbursement of the appeal fee was ordered.

The board of appeal in **T 740/94** held that the failure of the opposition division to deal with an objection under Art. 100(b) EPC 1973 against an amended claim in its decision to maintain the patent in amended form clearly constituted a substantial procedural violation (see **G 10/91**, OJ 1993, 420, point 19 of the reasons).

In **T 666/90** the failure to clarify matters with regard to requests in oral proceedings before the opposition division was deemed to be a substantial procedural violation.

In **T 666/90**, **T 543/92**, **T 647/93** (OJ 1995, 132) and **T 89/94**, reimbursement of the appeal fee was ordered because there had been an infringement of the provision in Art. 113(2) EPC 1973 that the EPO must consider and decide upon the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent (see also **T 898/96** and chapter VI.B.4 concerning Art. 113(2) EPC).

In **T 960/94** the composition of the opposition division had changed between the decision announced orally and the written decision. The board decided that issuing the written decision on behalf of an opposition division whose first member was not present at the oral proceedings amounted to a substantial procedural violation of both Art. 113(1) and 116 EPC 1973, as it had been issued on behalf of a first member before whom the parties had been given no opportunity to present their comments at oral proceedings.

The written decision was to be set aside. The appeal fees of both appellants were reimbursed.

In **T 611/01** the board decided that a substantial procedural violation was occasioned by the examining division holding out to the appellants the prospect of a further opportunity to file arguments before any decision would be issued. In the event, the appellants were denied that right and the decision was issued without a further opportunity to file arguments. The case was remitted to the department of first instance to be conducted by a differently composed examining division (regarding a false impression raised concerning amended claims, see also **T 309/94**).

The board in case **T 1982/07** said that it is fundamental to the principle of fair trial that in the examination an applicant, when confronted with new prior art documents, is not only given the right to be heard, but also the right to react thereto by amending the claims in order to overcome the prior art references. In the case at issue, both the examining division and the applicant took the view that the newly introduced document D3 was highly relevant prior art likely to prejudice the patentability of the application. When being confronted with such a highly relevant document, it would have been necessary to give the applicant the opportunity to amend the claims, if need be by introducing features of the description. It was therefore erroneous of the examining division to exercise its discretion under R. 86(3) EPC 1973 (now R. 137(3) EPC) in the way it did, as this did not allow the applicant to react appropriately, but rather tied its hands to an extent that was neither mandated by procedural efficiency nor justified in the light of the prior art documents cited. The examining division thus exercised its discretion in an unduly restrictive manner, thereby committing a substantial procedural violation. Against this background, it would have been incumbent on the examining division to rectify the decision pursuant to Art. 109(1) EPC, but this was not done. The board ordered the remittal to an examining division that had not previously dealt with this case.

In **T 281/03** dated 17 May 2006 the board held that a substantial procedural violation had occurred in proceedings before the opposition division where the opponent/appellant had wanted to comment on inventive step if novelty was established, but the issue of inventive step was not discussed at the oral proceedings and the opposition division, after deliberating and announcing its decision on novelty, immediately announced the decision to reject the oppositions. The fact that the opponent/appellant could have commented on inventive step earlier was not relevant.

In the following cases **no reimbursement** of the appeal fee was ordered:

In **T 451/06** the appellant/opponent submitted that, at the beginning of the oral proceedings before the opposition division, it had stated clearly that it had a main request for revocation of the patent based on lack of inventive step over D1 alone, and a subsidiary request based on lack of inventive step over D1 in combination with one or more of documents D2, D3, D4, D5 and D7. It noted that, having heard it on the main request, the opposition division interrupted the oral proceedings for deliberation and decided to reject the opposition without inviting it to present its arguments in support of the subsidiary request. In the appellant/opponent's view, this situation was analogous to

that underlying decision **T 281/03**, in which the board had found that the opposition division had committed a procedural violation by announcing the decision to reject the opposition after discussing novelty but not inventive step. The board observed that the minutes of the oral proceedings before the opposition division showed that, after asking the parties to present their requests, the chairman had announced that the issue to be discussed was "the inventiveness of the subject-matter of claim 1 of the attacked patent with respect to the prior art". The chairman had thus mentioned only the ground of opposition of lack of inventive step and not referred to substantiation. This could not, however, be interpreted as imposing on the extent of the discussion any limitation other than that in respect of the ground of opposition. The chairman's invitation to present all the objections in respect of inventive step had in effect been an invitation to the opponent to present both its "main and auxiliary requests". With regard to the appellant/opponent's argument that, having only heard the opponent's arguments in respect of D1, the opposition division ought to have invited it to present its "auxiliary" case based on D1 and the documents D2, D3, D4, D5 and D7, as previously announced, the board found that there was no duty on the opposition division to invite it to do so, because, following the chairman's initial statement that the issue to be discussed was lack of inventive step, it was the opponent's exclusive responsibility to substantiate its ground of opposition. The board distinguished the present situation from that in decision **T 281/03**; in the case underlying **T 281/03**, the opposition division had failed to give the opponent an opportunity to comment on lack of inventive step, thereby depriving the opponent of any possibility of substantiating a ground of opposition (see **G 1/95**). By contrast, in the case in point, the opponent had been given the opportunity to substantiate the ground of opposition of lack of inventive step. Accordingly, the reasoning of **T 281/03** could not be applied by analogy to this case.

In **T 33/93** the appellant argued that the decision under appeal was based on a substantial procedural violation, since it cited for the first time a board of appeal decision on which the appellant had been given no opportunity to present comments. The board stated that the citation of the decision in support of the refusal was not a fresh ground or piece of evidence within the meaning of Art. 113(1) EPC 1973, but a mere repetition of arguments, since it only confirmed the position duly brought to the appellant's attention. In **T 990/91** the board held that, since there was no need for the examining division to put the new argument in question forward in its decision in order to refuse the application, the lack of opportunity to reply to it could not be considered to be a procedural violation.

In **T 238/94** the board considered that, although the decision indeed contained no direct reference to the appellants' submissions concerning lack of inventive step, the opposition division had considered in its decision the disclosures of all the documents cited by the appellants and respondents, and also the possible combinations of their teachings. Thus, in the board's view, the appellants' submissions had actually been taken into account, albeit indirectly, in the process of arriving at the contested decision (see also **T 1004/96**).

In **T 725/05** the board examined whether or not a party to inter partes proceedings can be adversely affected by an obiter dictum contained in a decision of an Opposition Division. The board referred to **T 473/98** (OJ 2001, 231) where it was decided this was

not the case and that moreover the inclusion of an obiter dictum was appropriate for an Opposition Division as it may obviate the need for remittal. It stated that the Opposition Division by adding an obiter dictum at the end of the appealed decision had not made a substantial procedural mistake.

In **T 1098/07** the board stated that failure to consider evidence will normally constitute a substantial procedural violation in that it deprives a party of basic rights enshrined in Art. 117(1) and Art. 113(1) EPC. In the board's opinion, certain factors may nevertheless mitigate the severity of the violation. Thus, whether or not a failure of the decision to expressly mention material offered by a party in support of its case constitutes a substantial procedural violation will depend on the (prima facie) significance and evidential value of such material. Here the questions to be asked are: what facts is it intended to prove, how relevant is it to these facts and how likely is it that it will prove them?

Some other cases involved **witnesses**:

In **T 269/00** the board held that not calling to oral proceedings a witness who had been offered by one party to confirm a fact did not amount to a substantial procedural violation. The board distinguished the facts of the case from **T 142/97**, where an opposition division's refusal to consider evidence filed in due time (e.g. witness testimony or inspection) had been held to infringe a party's fundamental right to a free choice of evidence and the right to be heard. In **T 142/97** the board had judged that the opposition division had violated the opponent's right to be heard under Art. 113(1) EPC 1973 by not hearing the witness offered in connection with a prior use that had been adequately substantiated in the notice of opposition. According to the board the case before it differed because the ground of prior use was not adequately substantiated during the opposition period, but completed piecemeal during the opposition proceedings. The case thus related to the question of whether the opposition division had correctly exercised its discretion under Art. 114(2) EPC 1973 in not admitting late-filed evidence.

In **T 959/00** the opposition division had not replied to the opponent's offer to hear a witness with respect to the alleged prior use. The board held that the opposition division's failure to hear the witness and the absence in the decision under appeal of any reference to a reason why it had not been necessary to hear the witness amounted to a fundamental procedural violation.

In the more recent case **T 716/06**, the board conceded that there was normally no need to hear a witness, but held that, where an opponent requested that a witness be heard on an alleged public prior use and on the disclosure of a certain feature by this prior use, the competent department of the EPO as a rule had to grant this request before deciding that the alleged public prior use was neither established nor constituted a novelty - destroying state of the art because it did not disclose the feature in question. For more on hearing witnesses on alleged prior use, see also **T 1100/07**.

In **T 909/03** the board held that it was not necessary for a party to be given a copy of the minuted testimony before questioning a witness appearing for the other party. During the

oral proceedings the party had been given sufficient opportunity to comment on the testimony of the witness, even though the written minutes of the hearing were not available to the parties. No substantial procedural violation had thus occurred.

17.4.4 Inadequate reasons given in the decision at first instance

In several decisions the failure to provide adequate reasoning in a decision in accordance with R. 68(2) EPC 1973 (now R. 111(2) EPC - substance unchanged) was considered a substantial procedural violation justifying the reimbursement of the fee for appeal (**T 493/88**, OJ 1991, 380; **T 522/90**, **T 360/91** and **T 392/91**, **T 142/95**, **T 648/96**, **T 278/00**, **T 1016/00**, **T 604/01**, **T 362/02**, **T 749/02**, **T 427/03**, **T 571/03**). In **T 292/90** it was stated that the reasons given should enable the appellant and the board to understand whether the decision was justified or not (see also **T 52/90**) and in **T 740/93** the board held that reasoned decisions should contain at least some reasoning on the crucial points of dispute in a line of argumentation in so far as this was not immediately apparent from the reasons given, in order to give the party concerned a fair idea of why his submissions were not considered convincing (see also **T 921/94**).

In **T 850/95** (OJ 1997, 152) the board observed that the form used to refuse the correction of errors in a decision (R. 89 EPC 1973) contained pre-printed reasons of a very general nature and did not seem to provide for the possibility of adding more specific reasons taking account of the special circumstances of the case. However, a correctly reasoned decision would have given the appeal proceedings a more detailed factual basis and assisted the appellant as well as the board. The board held that it was the examining division's obligation to give substantive reasons for the decision on the request for correction, dealing with the specific facts of the case (see also **T 897/03**). The board therefore decided that the appeal fee should be reimbursed.

In **T 1356/05** and **T 1360/05** the board held that a request for a decision on the state of the file was not to be construed as a waiver of the right to a fully reasoned first-instance decision.

In case **T 1182/05** the examining division, in response to the appellant's request "to render a decision on the record", had refused the application using EPO form 2061 for a so-called "decision on the state of the file". The decision of the examining division however does not contain any specific reasons, but merely referred to the communications (including the annex to the summons) issued before the appellant's reply. The board quoted decisions **T 861/02**, **T 897/03**, **T 276/04** and **T 1309/05** concerning R. 68(2) EPC 1973 when a decision form refers to several communications. The board further stated that the applicant's request "to render a decision on the record" was not to be construed as a waiver of the right to a fully reasoned first-instance decision. The board in **T 1182/05** came to the conclusion that a decision in a standard form, simply referring to the previous communications for its grounds and to the request of the applicant for such a decision, was not appropriate in the case before it. Reimbursement of the appeal fee was ordered.

In **T 859/97** the board took the view that it was sufficient for the examining division, when deciding to refuse a European patent application under Art. 97(1) EPC 1973, to state one ground only which in their opinion would prejudice the grant of a European patent. In the case in point, the examining division was unable to grant a patent because it had concluded that the subject-matter of claim 7 was not new. Consequently, it was under no obligation to comment on the patentability of claims 1 to 6. The requirements of R. 67 EPC 1973 were thus not met.

In **T 177/98**, where a large number of documents and arguments were brought forward, the opposition division did not consider all the arguments as highly important and therefore did not discuss them all in their written decision. The board held that the instances of the EPO have no obligation to consider the parties' arguments in detail or to give an opinion on every combination of prior art made during the proceedings. It was the task of each decision-taking body to grasp the relevant arguments and to reply to them. However, the more material was provided, with corresponding arguments, the more likely it might be that a choice was made as to the importance of the arguments. This was a question of discretion.

In **T 107/05** the appellant II/opponent II requested reimbursement of the appeal fee on the grounds of two alleged procedural violations. As to the second ground of complaint, appellant II accepted that the opposition division's decision as a whole was reasoned, but argued that the opposition division had simply ignored its arguments as regards E5 which had been made in its written submissions. The board noted that the relevant passage of the appealed decision was incorrect in that it stated "Concerning document E5 it is noted that the opponent II has not supplied any arguments relating to novelty and inventive step", which led the board to conclude that the opposition division overlooked the above-mentioned submissions. The board made a distinction between an opposition division ignoring the arguments of a party to an extent which infringes the right to be heard, and merely failing to consider in detail all the arguments of the parties and give an opinion on every piece of prior art. The board saw no objection to an opposition division omitting details which were not relevant for the decision. The board noted that in the present case - unlike in decision **T 135/96** cited by appellant II - the opposition division stated that it had considered E5 "acting of its own motion" and had assessed within its power of discretion that it was not relevant - an analysis which was confirmed in the present proceedings. It appeared that E5 had not in fact been discussed by the parties during oral proceedings before the opposition division and therefore appeared of less importance. The lack of consideration of the opponent's arguments on this document had thus not been conclusive for the outcome of the appealed decision. The mistake made by the opposition division could be regarded as a procedural violation but in this particular case not as a substantial one. The requirement of R. 67 EPC 1973 for reimbursement of the appeal fee that a substantial procedural violation has taken place was not met.

The board held in **T 1366/05** that the opposition division's decision was not "reasoned" within the meaning of R. 68(2) EPC 1973, since the opposition division had merely summarised the submissions of the opponent in respect of novelty generally and had simply made a statement of the conclusion reached by the opposition division without

indicating relevant passages of the documents cited, specific features disclosed therein and considerations why those features were disclosed in combination resulting necessarily in the conclusion of lack of novelty of the subject-matter claimed. This failure amounted to a substantial procedural violation.

In **T 755/96** (OJ 2000, 174) the decision not to consider the two requests filed one day before the oral proceedings was based only on the ground that they had been filed too late under R. 71a EPC 1973. In the board's judgment, this ground for not accepting the two requests could not be considered an adequate reason in support of the exercise of the examining division's discretion but rather constituted a mere reference to the power given to the examining division by the said rule. The board concluded that the decision under appeal was not reasoned in accordance with R. 68(2) EPC 1973.

In **T 75/91** the board stated that the impugned decision enabled the reader to follow a line of argument for refusing the application. Whether these reasons were convincing and had to be accepted by the board or not was another question and had nothing to do with a substantial procedural violation. In **T 856/91** the board held that R. 68(2) EPC 1973 had been sufficiently complied with as long as some reasons were given, even if incomplete and inadequate. The request for reimbursement was therefore rejected (see also **T 735/90**, **T 153/89**, **T 647/93**, OJ 1995, 132).

In **T 1065/99** the board stated that when an International Preliminary Examination Report (IPER) drawn up by the EPO under the PCT was relied on by the examining division, such reliance should not be presented to applicants in such a manner as to suggest that the examining division had not given objective consideration to the patentability requirements of the Convention. In this case, the IPER had been adopted by the examining division as the only basis for its opinion that the application did not meet the requirements of the Convention. The board came to the conclusion that there were three objections - concerning irrelevance, clarity and sufficiency - which were only obliquely touched upon in the IPER, and thus in the communication under R. 51(2) EPC 1973. Therefore, the party had had no opportunity to contest those objections. The board ordered the reimbursement of the appeal fee for the violations of Art. 113(1) EPC 1973.

In **T 1382/08** the board held that the logical structure of a decision under appeal implied that the order as such had to be clear and unambiguous. Disregarding this condition based on R. 68(2) EPC 1973 was a substantial procedural violation justifying reimbursement of the appeal fee.

17.4.5 Error of judgment by a department of first instance

A number of decisions discussed whether an error of judgment by a department of first instance could be regarded as a substantial procedural violation justifying reimbursement of the appeal fee (**T 19/87**, OJ 1988, 268; **T 863/93**; **T 107/05**; **T 1078/07**).

Normally there is no procedural violation justifying reimbursement of the appeal fee if the wrong procedure is adopted in a situation where the EPC does not lay down clearly what

procedure is to be followed and the case law has not yet established any settled practice (**T 234/86**, OJ 1989, 79).

This principle was extended in a later decision (**T 208/88**, OJ 1992, 22) in which it was held that taking a different line from an as yet isolated appeal decision - as opposed to established board of appeal case law - could not be regarded as a substantial procedural violation. The fact that the board had come to a different conclusion from the department of first instance did not by itself mean that the latter had committed a substantial procedural violation (**T 87/88**, OJ 1993, 430; **T 538/89**, **T 182/92**). In **T 208/00** the board considered that the department of first instance had to be granted a certain degree of latitude in exercising its power of discretion, which in this case it had not overstepped in a clearly inappropriate manner. It stated that it was not equitable to reimburse the appeal fee, especially as under the established case law of the boards of appeal not even "a gross error of judgment" by the department of first instance was regarded as justifying such reimbursement.

In decision **T 875/98** the board noted that the Convention did not contain any rule of procedure which imposed on an opposition division an obligation to abide, in its decision concerning a certain case, by a decision in a different case. It held that a single decision issued by an opposition division did not establish a "case law" which had to be adhered to in another opposition case even if the subject-matter of the two respective cases was closely related.

In **T 367/91** the board stated that to base a decision only on a wrong assessment of prior art and/or the claimed invention had to be regarded as a substantive error, not a procedural violation (see also **T 144/94** and **T 12/03**).

In **T 687/05** the board held that the fact that the decision under appeal was based on an incorrect interpretation of Art. 100(c) EPC 1973, due to its reasoning being based on examination of the requirements under Art. 76(1) EPC 1973 with respect to the parent application, did not constitute a "procedural" violation, but was simply an error in the application of the law. Thus, the requirements of R. 67 EPC 1973 for reimbursement of the appeal fee were not fulfilled, at least for this reason.

In **T 17/97**, the appellant's request for reimbursement of the appeal fee was based on the fact that the opposition division had disregarded document (5) pursuant to Art. 114(2) EPC 1973 and R. 71a(1) EPC 1973. In the board's judgment this was caused by an erroneous assessment of the relevance of document (5). Such a misinterpretation, by its very nature, did not constitute a procedural violation within the meaning of R. 67 EPC 1973.

It does not amount to a procedural violation if the examining division wrongly finds that a claim is not sufficiently clear to comply with the requirements of Art. 84 EPC 1973, even where there has been a possible error of judgment and failure to seek clarification from the appellant (**T 680/89**).

The misinterpretation of a document does not constitute a procedural violation (**T 1049/92**, **T 162/82**, OJ 1987, 533). In **T 588/92** the board pointed out that a different opinion on the specialist knowledge to be applied when interpreting the technical content did not amount to a procedural violation. Even a gross error of judgment on the part of the examining division does not justify reimbursement of the appeal fee (**T 860/93**, OJ 1995, 47). Misinterpretation of a letter to the EPO department concerned constitutes an error of judgment and not a substantial procedural violation (**T 621/91**).

The examining division's failure to follow a procedure set out in the Guidelines is not in itself a substantial procedural violation unless it also constitutes a violation of a rule or principle of procedure governed by an Article of the Convention or one of the Implementing Regulations. This is because the Guidelines are not legally binding (**T 42/84**, OJ 1988, 251; **T 51/94**, **J 24/96**, OJ 2001, 434).

In **J 9/05** and **J 18/05** the board had to decide on the Examining Division's decisions that R. 69(1) EPC 1973 communications were deemed to have been duly delivered to the addressees on the tenth day following its posting. The board held in each case that whilst the examining division had evaluated the evidence as to the postal delivery incorrectly, this amounted to an error of judgment only and could not be characterised as a procedural non-compliance, which was a prerequisite for the application of R. 67 EPC 1973.

In **T 248/00** the board decided that, where a late submission was not admitted, an irregularity had taken place if the department had exercised its discretion incorrectly, that is to say on the basis of irrelevant or arbitrary considerations. The board held that, even if the non-admission might ultimately prove to be incorrect, such application of the law did not amount to a substantial procedural violation. The issue was, rather, whether the opposition division's discretion had been incorrectly exercised in not admitting a late-filed request.

17.4.6 Miscellaneous other cases

(a) Cases where substantial procedural violations occurred

(i) Cases concerning the decision-making process and the effect of decisions

In **J 5/81** (OJ 1982, 155) it was held that there was a substantial procedural violation where the Receiving Section had ignored the **suspensive effect** of an appeal in contravention of Art. 106(1) EPC 1973.

T 227/95 related to a situation where a decision was taken by a board to remit the case to the department of first instance (opposition division) for further prosecution and not, as assumed by the division, with instructions to maintain the patent. The fact that the opposition division had not carried out the board's order amounted to a substantial procedural violation with regard to Art. 111 EPC 1973. The case was remitted again to the department of first instance, and the appeal fee was reimbursed.

In **T 425/97** the board decided that any substantive deviation, as in the case before it, of the decision notified in writing from that given orally at the oral proceedings amounted to a procedural violation.

In **T 225/96** the board ruled that to issue the parties with a draft decision not approved by all opposition division members present at the oral proceedings was a substantial procedural violation.

In **T 883/07** the board held that the examining division's failure to examine the auxiliary requests independently of the main request, which main request did not correspond to the application as originally filed, amounted to a substantial procedural violation within the meaning of R. 67 EPC 1973. In examining the first auxiliary request the examining division had erred in comparing it with the main request. In fact, in examining an amended application, which was what an "auxiliary claim request" was, the comparison to be made for examining permissibility of the amendment for the purposes of Art. 123(2) EPC and R. 86 EPC 1973 was with the **application as originally filed** - in this case at the PCT receiving Office and as published pursuant to R. 48 PCT - which formed the basis for the international search report. This was more than a terminological inexactitude, since in the case at issue the claims had been **amended** on entry into the regional phase, these amended claims constituting the main claim request as refused in the decision under appeal. Considering further the erroneous unity reasoning of the examining division, it appeared to the board necessary to emphasise that the requirement of unity of invention applied only to the (then valid) European application and did not apply to any relationship between successive claim requests, since only one of these claim requests could form the patent application. The requirement of unity of invention required that different inventions **within the same claim request** be linked by a single general inventive concept, without regard to whether they were claimed in separate claims or as alternatives within a single claim. The purpose of auxiliary claim requests was to speed up the proceedings before the department dealing with the application or the patent. These claim requests, however, did not coexist in parallel, but formed a stack which had to be considered – each one independently of all the others - in the sequence indicated by the applicant or patent proprietor.

In **T 231/85** (OJ 1989, 74) the board held that failure to take the applicant's requests into account as **a result of a delay within the EPO** (in this case six weeks) constituted a substantial procedural violation (see also **T 598/88**). In **T 205/89**, owing to a mistake by a formalities officer, a request for an extension of the time for submitting comments in opposition proceedings never reached the opposition division, which therefore took its decision without considering the argument presented in the subsequently filed submission.

In **T 804/94** the board ruled that there had been a substantial procedural violation as the opposition division had issued a decision rejecting the opposition before **expiry of the four-month period** it had set for responding to its communication.

In **T 991/02** an opposition division decision was set aside for lack of a legal basis. The opposition division's application of a new rule, not yet in force in this case, constituted a substantial procedural violation.

In **T 1178/04** a procedural violation within the meaning of R. 67 EPC 1973 had occurred, in that the requests relating to the patentability of the claimed invention were made in the oral proceedings before the opposition division by a party to whom the opposition had been purportedly but invalidly transferred. These requests were inadmissible.

The board of appeal ordered reimbursement of the appeal fee in **T 382/92** because the **composition of the opposition division** had not complied with the requirements of Art. 19(2) EPC 1973. The chairman and one member of the opposition division had already been members of the examining division which had decided on the application leading to the patent concerned (see also **T 939/91**, **T 960/94** above and **T 825/08**). A substantial procedural violation was also deemed to have occurred if the decision had been taken **by a formalities officer who was not competent to decide** (**J 10/82**, OJ 1983, 94; **T 114/82**, OJ 1983, 323; **T 790/93**, **T 749/02**).

In **T 211/05**, the board took the view that for a person to take part in a decision when not entitled to do so, resulting in failure to comply with the principle that the power to examine a patent application must not only be exercised personally but also be seen – by both the applicant and the public – to be exercised personally, constituted a substantial procedural violation, in particular because it deprived the applicant of his right to be heard by the full examining division.

In **T 900/02** the board stated that a suspicion of partiality must inevitably arise if a member of an opposition division, or any other first instance body, first solicits and then accepts employment with a firm in which a partner or other employee is conducting a case pending before that member, even if it occurred after oral proceedings had been held. This amounted to a substantial procedural violation. The board also found that the extreme length of the delay - three years and seven months - between oral proceedings and the issue of a written decision amounted to a substantial procedural violation. The case was remitted to the department of first instance.

Although it was not found that there had been any substantial procedural violation, **T 585/06** is also of interest in connection with the suspicion of partiality. In this case, the appellant/opponent considered that there was a concern that the presence of a former member of the boards of appeal at the oral proceedings before the opposition division and eventually referred to as a consultant led to partiality of the opposition division. He requested reimbursement of the appeal fee. The board stated that the former member did not act as an authorised representative but only as consultant of the patent proprietor. He did not address the opposition division, not even under the control of the representative of the respondent. This amounted to an important difference to the facts underlying case **G 2/94**. In the case at issue, the former member only gave hints by whispering to the authorised representative, who was absolutely free to accept them or not, but he did not make any intervention of his own motion. The appellant's representative accepted at the beginning of the oral proceedings that the former member

would sit beside the representative of the respondent and assist him. Even during the oral proceedings no objection was made to his presence. The former member was obviously not a member of the public as he did not sit at the back of the room. No substantiated reasons of partiality of the opposition division were submitted by the appellant. The request for the reimbursement of the appeal fee was refused.

(ii) Cases concerning documentation and communications passing between the EPO and the parties

In **J 3/87** (OJ 1989, 3) it was stated that if an EPO communication was not as clear and unambiguous as it ought to be, and led a reasonable recipient into error, that amounted to a substantial procedural violation, even if the **ambiguity of the communication** was partly due to an unfortunate provision of the law. In **J 17/92** the appellants complained that the examining division had used the wrong form for its communication, namely a form threatening that the application would be refused if a response was not filed. The examining division agreed that the form was wrong, but failed to withdraw it. The board considered that this failure to withdraw the wrong form, and then to withdraw the threatened sanction of a possible refusal of the application, amounted to a substantial procedural violation. It ordered the reimbursement of the appeal fee as being equitable under R. 67 EPC 1973.

In **T 362/02** the opposition division had revoked the patent for the sole reason that the appellant had not replied to a communication under Art. 101(2) EPC 1973 inviting him to file observations. The board found that this decision was a substantial procedural violation because the EPC did not provide any sanction for a party's failure to reply to a communication under Art. 101(2) EPC 1973. Further, revocation of a patent for mere failure to reply to a communication was contrary to the clear intention of the law, which required a proprietor to agree to the form in which a patent was granted or amended and to use clear and unambiguous words if he wished to abandon a patent.

The Legal Board of Appeal stated in **J 17/04** that R. 85a(1) EPC 1973 not only provided for a period of grace for the applicant i.e. a further possibility to pay designation fees within an extended time limit, but also imposed a duty on the EPO to issue a warning to him. This duty was to be regarded as so essential that a final decision could not be taken without such a reminder having been sent. Failure to issue the reminder pursuant to R. 85a(1) EPC 1973 constituted a substantial procedural violation unless the applicant had validly renounced the right to be notified. The board noted that the issuance of the reminder was not a "courtesy service" offered by the EPO, but an act prescribed by the Implementing Regulations (however, see **J 32/97** below).

In **J 10/07** (OJ 2008, 567), the board found that, although the Receiving Section was not to be blamed for issuing a communication under R. 43(2) EPC 1973, as the drawings could not have been in the file on that date, it should not have issued the notification of 10 November 2004 under R. 43(3) EPC 1973. Instead, a communication pursuant to R. 43(1) EPC 1973 should have been issued. This amounted to a substantial procedural violation. If the Receiving Section had followed the legally correct procedure, an appeal would not have been necessary.

(b) Cases where no substantial procedural violation occurred

In **J 3/91** (OJ 1994, 365) the Legal Board of Appeal refused a request for reimbursement of the appeal fee, stating that the **wrong transcription of a Japanese priority date** could not be considered a procedural violation. The Receiving Section was not obliged by procedural law to inform the applicant that the "Showa" year had been transcribed into the equivalent date in the Christian era. Such transcriptions were a routine matter familiar to practitioners dealing with industrial property rights.

In **T 291/93** it was held that a simple reference by the appellant to an inadequate search of the prior art could not be taken as sufficiently supporting an allegation that a substantial procedural violation had occurred. Moreover, remarks on substantive matters in a decision rejecting the opposition as inadmissible had no legal effect. Even if misleading, they did not represent a substantial procedural violation justifying the reimbursement of the appeal fee (**T 925/91**, OJ 1995, 469; see also **T 1051/92**).

In **J 20/96** the EPO had waited one year and three months before requesting the appointment of a professional representative and nearly another year before asking for the appellant's new address. Although conceding that the Receiving Section had been slow to request the appointment of a professional representative, the Legal Board ruled that this was not a substantial procedural violation because such appointments were a matter for the appellant; similarly, it was also up to him or his representative to provide his address.

In **J 32/97** the appellant argued that a procedural violation occurred when the appellant's international representative was not sent a copy of the communications pursuant to R. 85a(1) and 85b EPC 1973, a new procedure applicable only to international applications with publication date on or after 31.10.1996. The board rejected this view. The new procedure was a courtesy service not required by the EPC (however, see **J 17/04** above). The board was also not prepared to accept as a ground for appeal the allegation that the different procedures for notifying documents to persons with residence in the Contracting States and those residing outside contravened Art. 2(1) of the Paris Convention (national treatment). The complaint of unfair treatment in view of Art. 4 of the TRIPS Agreement (most-favoured-nation treatment) was likewise rejected by the board.

In **T 642/97**, a party alleged that the minutes were incomplete or wrong since essential submissions were not reflected in the file. The board held that the party could request the opposition division to correct the minutes to preserve its rights (**T 231/99**). In the absence of such a request, the allegation of a substantial procedural violation could not be justified (**T 99/08**).

In **T 980/06**, the contested decision had regarded original claim 5 as patentable, whereas in the sole previous communication the examining division had taken a negative view. In such circumstances, a second communication would have been useful. However, its absence was not a "substantial" procedural violation.

In **T 343/08** the board stated that there is no general duty for an examining division to provide feedback on an applicant's reply to a summons to oral proceedings, in advance of such oral proceedings.

17.5. Interlocutory revision

Pursuant to Art. 109 EPC a department whose decision is contested must rectify its decision if it considers the appeal admissible and well founded. This applies in ex parte cases only. Apart from a change in wording, Art. 109 EPC was not amended when the EPC 2000 entered into force (see also chapter VII.E.13, appeal procedure).

R. 67 EPC 1973 (like the new R. 103 EPC) also provided for reimbursement of the appeal fee in the case of interlocutory revision. However, the reimbursement of appeal fees was not an automatic consequence of interlocutory revision. The proper interpretation of R. 67 EPC 1973 was that, in the case of interlocutory revision, there also had to have been a **substantial procedural violation** (see **T 79/91**, **T 536/92**). In **T 939/95** (OJ 1998, 481), the board's interpretation of R. 67 EPC 1973 was that the words "if such reimbursement" read in their context referred to both interlocutory revision and appeals. This meant that for each of these stages it was a prerequisite that a substantial procedural violation had occurred **and** that reimbursement was found **equitable** in the discretion of the deciding body, be it the examining division or the board.

In **G 3/03** the Enlarged Board of Appeal ruled as follows on the questions referred to it by the Legal Board of Appeal in **J 12/01**. In the event of interlocutory revision under Art. 109(1) EPC 1973, the department of the first instance whose decision had been appealed was not competent to refuse a request from the appellant for reimbursement of the appeal fee. The board of appeal which would have been competent under Art. 21 EPC 1973 to deal with the substantive issues of the appeal if no interlocutory revision had been granted was competent to decide on the request. For recent examples where **G 3/03** applies, see **T 1379/05**, **T 1315/04**, **T 245/05** above and also **T 1863/07**, in which the board, having set out the conditions for application of Art. 96(2) EPC 1973, ultimately held that, in the circumstances of the case, the appeals fee had to be reimbursed, because the application had been refused immediately without the applicant's having received any prior warning.

In **T 21/02** an appeal had been fully dealt with by interlocutory revision by the department of first instance and was thus no longer pending when a request for reimbursement of the appeal fee was submitted. The board held that the facts of the case differed from those underlying decisions **G 3/03** (OJ 2005, 344) and **J 32/95** (OJ 1999, 733) and that in the case before it, the request had been submitted in the absence of a pending appeal and hence could not constitute an ancillary issue to be dealt with in appeal proceedings. The board was thus not empowered to decide on the request for reimbursement of the appeal fee.

In the absence of a pending appeal, any request for reimbursement of the appeal fee filed after the decision to grant interlocutory revision will be considered inadmissible,

regardless of whether the decision was taken by the examining division or the board of appeal as the body competent to consider the appeal (**T 242/05**).

In **T 647/93** (OJ 1995, 132) it was pointed out that when the examining division did not make use of the possibility of granting interlocutory revision after the **mistake** had been pointed out in the grounds of appeal, this was normally deemed to constitute a procedural violation (see also **T 808/94**, **T 861/03** and **T 1113/06**). In **T 183/95** interlocutory revision was not granted under Art. 109 EPC 1973 and the appeal was remitted to the board. The board in this case pointed out that interlocutory revision could be granted at the discretion of the department of first instance when it was considering whether the appeal was "well founded". In this case, the remittal of the appeal could not be said to have been manifestly wrong from the procedural point of view.

As pointed out in **T 691/91**, the circumstances under which Art. 109 EPC 1973 empowered the examining division to rectify to decisions were narrowly circumscribed. This Article provided for only two legally viable alternatives; maintaining the contested decision and remitting the case to the boards of appeal or setting aside the decision and either granting the patent or, as the case may be, re-opening examination. In the case at issue, the examining division had chosen a third way; maintaining the earlier decision by issuing a decision on rectification. The way in which the examining division proceeded resulted in the appellant's having to file a second appeal against the decision on rectification. The board ordered reimbursement of the second appeal fee because the decision on rectification was *ultra vires*, and reimbursement of the first appeal fee because a violation of the right to be heard had occurred during the examination proceedings (see also **T 252/91**).

In **T 794/95** the board took the view that, under the circumstances of the case, the examining division should have rectified its decision under Art. 109(1) EPC 1973 and proceeded to the interlocutory revision expressly requested. The board did not, however, consider it equitable to order the reimbursement of the appeal fee, since the examination procedure up to the decision under appeal was not tainted with any failure and the necessity for the appellant to file an appeal emerged exclusively from the substance of the decision, not because of any procedural shortcomings up to this stage and equally not from the later incorrect handling of the appeal by the examining division (i.e. the failure to rectify its decision).

In **T 898/96** the board took the view that, as soon as the applicant approved in the notice of appeal the text of the application as specified previously in a communication under R. 51(4) EPC 1973, there was no reason why the patent should not have been granted, even if the applicant did not approve this text before filing the appeal. Thus the decision of the examining division to refuse the application having regard to Art. 113(2) EPC 1973 should have been rectified by way of interlocutory revision. The failure to rectify such a decision in this way was a substantial procedural violation. However, the board did not consider the refund of the appeal fee to be equitable, for the very reason that the applicant did not approve this text of the application until he filed an appeal.

In **T 685/98** (OJ 1999, 346) the board explained that the provisions of Art. 109(1) EPC 1973 were tailor-made to enable the examining division to rectify expeditiously procedural irregularities of the kind which occurred in this case. However, it appeared that the examining division had either failed to recognise that its decision to refuse when no reply within the meaning of Art. 96(3) EPC 1973 had been received was *ultra vires* or, despite this recognition, did not appreciate that it was mandatory in those circumstances to apply the said provisions and set its own purported decision aside. The pragmatic criterion of reasonable likelihood that the reopened procedure would lead to a patent being granted was not applicable where procedural rights were at issue as in the present case. In addition, the precipitate decision of the examining division contravened Art. 113(1) EPC 1973. Fundamental legal rights may not be subordinated to considerations of administrative efficiency.

Accordingly the board took this opportunity to stress the fact that where a fundamental procedural right had manifestly been violated in a refusal pursuant to Art. 97(1) EPC 1973, or in the foregoing examination procedure, a further substantial procedural violation occurred if the examining division failed to grant interlocutory revision on appeal (following **T 647/93**, OJ 1995, 132), since such a right had to be safeguarded irrespective of the substantive merits of the case.

VIII. PROCEEDINGS BEFORE THE DISCIPLINARY BOARD OF APPEAL

1. Introduction

Representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO (Art. 134(1) EPC). Any natural person who is a national of a contracting state, has his place of business or employment in a contracting state and has passed the European qualifying examination may be entered on the list (Art. 134(2) EPC). Under Art. 134(8) EPC (cf. Art. 134(7) EPC 1973), legal practitioners from the contracting states are also entitled to act as representatives, subject to the conditions specified therein.

Art. 134a EPC, introduced under the EPC 2000, incorporates the substance of former Art. 134(8) EPC 1973 and anchors in the Convention the existence of the Institute of Professional Representatives before the EPO ("*epi*").

For further information on representation before the EPO, see Chapter VI.I, representation. For more details of the changes introduced by the EPC 2000, see also OJ SE 4 and 5/2007.

All persons on the list of professional representatives must be members of the *epi* (Art. 134a(2) EPC; see also Art. 5(1) of the Regulation on the Establishment of an Institute of Professional Representatives before the EPO, OJ 1997, 350; for amendments to the Regulation, see OJ 2002, 429, OJ 2004, 361 and OJ 2007, 12), and are subject to the Regulation on Discipline for Professional Representatives (RDR, OJ 1978, 91; as amended: OJ 2008, 14), adopted by the Administrative Council of the European Patent Organisation, and to the Code of Conduct of the Institute of Professional Representatives before the EPO (OJ 2003, 523), adopted by the *epi*.

The first instance bodies which rule on infringements of the rules of professional conduct are the *epi* Disciplinary Committee and the EPO Disciplinary Board (Art. 5 RDR; see also Additional Rules of Procedure of the Disciplinary Committee and of the Disciplinary Board, OJ 1980, 176, and 177 and 183, respectively; for amendments see OJ 2007, 552). The Disciplinary Board of Appeal (DBA) hears appeals against decisions of the *epi* Disciplinary Committee and the EPO Disciplinary Board (Art. 5, 8 RDR; see also Additional Rules of Procedure of the Disciplinary Board of Appeal, OJ 1980, 176 and 188; for amendments, see OJ 2007, 548; consolidated version: Supplement to OJ 1/2010, 50).

The European qualifying examination (EQE), referred to in Art. 134(2)(c) EPC, is governed in particular by the Regulation on the European qualifying examination for professional representatives before the EPO (REE, OJ 2009, 9, also Supplement 2 to OJ 3/2010, 2), which entered into force on 1.1.2009, and by its Implementing provisions (IPREE, Supplement to OJ 5/2009, 20; as amended: Supplement 2 to OJ 3/2010, 20).

These provisions replace the REE 1994, (last published: Supplement to OJ 12/2008, 1), and the REE 1994 Implementing provisions (IPREE 1994, Supplement to OJ 12/2008, 15). The content of the former Instructions (Instructions concerning the qualifications required for enrolment for the EQE, Supplement to OJ 12/2008, 19; Instructions to candidates concerning the conduct of the examination, Supplement to OJ 12/2008, 24; Instructions to candidates for preparing their answers, Supplement to OJ 12/2008, 29; and Instructions to invigilators, Supplement to OJ 12/2008, 35) has been largely incorporated into the IPREE and the current Instructions to candidates concerning the conduct of the EQE (Supplement 2 to OJ 3/2010).

A number of substantive changes have been introduced by the REE which entered into force on 1.1.2009 and its IPREE. These include first the creation of a Supervisory Board (Art. 1(6), 2, 3 REE), which is responsible for adopting the IPREE (Art. 3(7) REE), and the introduction of a pre-examination from 2012 (Art. 1(7), 11(7) REE, R. 10 IPREE). Other modifications are: simplification of the enrolment requirements in respect of academic qualifications and professional experience (Art. 11 REE, R. 11 to 15 IPREE); replacement of the rules on modular sitting by the option to take one or more papers at one sitting (Art. 15 REE); extension of the compensation system to all candidates (Art. 14 REE, R. 6 IPREE); streamlining of the appeal procedure (Art. 24 REE).

Under Art. 24 REE (cf. Art. 27 REE 1994), the DBA hears appeals against decisions of the EQE Examination Board and Secretariat.

Appeals against Examination Board and Secretariat decisions which were decided by the DBA under earlier provisions are referred to below if considered still relevant. For more detailed information on the old rules and related DBA decisions, see the previous (5th) edition of the Case Law of the Boards of Appeal.

2. European qualifying examination

As stated, only persons who have passed the EQE may be entered on the list of professional representatives (Art. 134(2)(c) EPC).

2.1. Formalities and conditions for enrolment

In **D 4/08** the board confirmed the Examination Secretariat's strict application of the published closing date for enrolment for the EQE, stressing its importance for the timely and orderly preparation of the examination. According to **D 7/08**, it was the candidate's responsibility to file the complete application, including the enrolment form and all necessary supporting evidence, by the closing date (see also **D 12/08**, **D 15/09**).

To qualify for registration and enrolment, candidates must normally possess a university-level scientific or technical qualification, i.e. a bachelor's degree or equivalent academic degree awarded at the end of a full-time course of a minimum of three years, with at least 80% of the course hours having been devoted to scientific and/or technical subjects (Art. 11(1)(a) REE, R. 11 to 14 IPREE). The qualifying subjects include biology,

biochemistry, construction technology, electricity, electronics, information technology, mathematics, mechanics, medicine, pharmacology and physics (R. 13 IPREE).

For decisions relating to the REE 1994 and its Instructions concerning the qualifications required for enrolment for the EQE, see **D 15/04**, **D 17/04**, **D 18/04** and **D 8/04**, reported in the Case Law of the Boards of Appeal, 5th edition, and also **D 5/08**, **D 10/08**.

A further requirement for enrolment is that a candidate must normally have worked full-time for at least three years in the field of European patent applications and European patents in a contracting state, as set out in Art. 11(2) to (5) REE and R. 15 IPREE. The cases set out below, which were decided under the former provisions, remain relevant.

According to **D 4/86** (OJ 1988, 26), for the condition stipulated in Art. 7(1)(b)(i) REE 1977, as amended, to be met, the trainee must have completed his training period under conditions likely to ensure that he has actually assisted a professional representative by constantly taking part in activities pertaining to patent application procedures of which the representative is in fact in charge.

D 14/93 (OJ 1997, 561) ruled that the training period could not be served with a legal practitioner whose name did not appear on the list of professional representatives, even if the said practitioner was a patent attorney under national law (see Art. 134(7) EPC 1973, see now Art. 134(8) EPC). The appellant argued that for Art. 7 REE 1991 not to allow the training period to be served under a legal practitioner's supervision infringed the principle enshrined in Art. 134(7) EPC 1973 of equal treatment of legal practitioners and professional representatives (Art. 134(1) EPC 1973). The board took a different view: the activities referred to in Art. 7(1)(b) REE 1991 presupposed the scientific or technical knowledge required with a view to activities pertaining to European patent applications and patents; persons training EQE candidates needed to possess such knowledge, and legal practitioners did not normally do so.

D 25/96 (OJ 1998, 45) ruled that the period of professional activity required for the EQE enrolment could not be served with a self-employed German patent agent who was not on the list of professional representatives.

In **D 16/04** the board confirmed the practice of the Examination Secretariat of allowing only periods of professional activity completed after the required degree was obtained as not being in conflict with Art. 10 REE 1994. Art. 10(1) REE 1994 mentioned the requirement of possessing a university-level scientific or technical or equivalent qualification first, followed by a reference to the conditions set out in paragraph 2, i.e. the three-year full-time training period to be completed by the date of the examination. The ordinary meaning to be given to this grammatical order reflected the common understanding that studies normally precede practical training. Furthermore the required length of the training period was a consequence of the candidate's technical or scientific degree acquired before starting the training period rather than vice versa. See also **D 6/08**.

This is now a requirement under Art. 11(3) REE, which, in conjunction with R. 15(2) IPREE, also specifies how periods of professional activity may be aggregated to make up a full-time training period.

Art. 11(2)(b) REE allows candidates who at the date of the examination have performed full-time the duties of an examiner at the EPO for at least four years to enrol for the EQE without having previously worked in accordance with Art. 11(2)(a) REE.

In **D 19/04** the appellant, an examiner of many years' standing at the German Patent and Trade Mark Office, had cited the corresponding Art. 10(2)(b) REE 1994 when submitting his candidature for the 2005 examination without providing evidence that he had worked in accordance with Art. 10(2)(a) REE 1994. The board pointed out that the Secretariat had been right in not applying that provision to the appellant in his capacity as an examiner at the German Office. Art. 10(2)(b) REE 1994 related to EPO examiners, who in view of their professional experience could be assumed to have a comprehensive knowledge of the European patent grant procedure. The professional experience of long-serving examiners in national offices could not be equated with that of EPO examiners. The board found that, given the different professional circumstances of EPO examiners and those in national offices, the means represented by the provision were in reasonable proportion to the end it served.

According to R. 16(2) IPREE, the period of professional activity under Art. 11(2)(a) REE may be reduced by up to one year if a candidate has been a patent examiner at the EPO or the national patent office of a contracting state. R. 16(1) IPREE allows for a reduction of the period defined in Art. 11(2) REE for candidates who have successfully completed specialised studies of at least one academic year in the field of industrial property.

2.2. Examination conditions

In **D 2/95** the DBA found against an appellant alleging discrimination; the fact that certain other candidates had been allowed to use normal as opposed to copy paper for the examination was not in breach of the provisions governing its conduct. Some candidates might find copy paper more awkward, but others might well prefer it. Nor did other arguments along similar lines - e.g. that too little time was allowed for the papers, or that candidates whose mother tongue was not an EPO official language were at a disadvantage and should therefore be given more time than the others - convince the DBA that the relevant provisions had been infringed (**D 11/00**).

In **D 1/94** (OJ 1996, 468) the board did however rule that a translation error might constitute a violation of Art. 11(3) REE 1991 (cf. Art. 12(3) REE, R. 5 IPREE), since this provision assumed that the translation from the language selected by the candidate into one of the EPO official languages was totally correct. In its decision, the Examination Board therefore had to give reasons why the translation errors had not been found to be serious.

In **D 14/95** the appellant's arguments centred on an alleged infringement of the principle of equal treatment. It had been infringed because he, as a specialist in biochemistry, had

been placed at a disadvantage in Paper C (taken from mechanical engineering) compared with a specialist in that field. The board found against any breach of equal treatment; the appellant's position was no different from that of any other candidate whose specialist field did not happen to be used in the paper as set. True, the examination procedure did in effect involve a certain "inequality". The Examination Board set a limited number of papers, and therefore had to make a choice amongst the different technical fields. So there would always be candidates who happened to be more specialised than others in the particular field selected. This however was inherent in any general examination, and thus did not constitute arbitrary unequal treatment. Furthermore, Paper C was less concerned with testing specialist technical knowledge than the ability to draft a notice of opposition to a European patent.

In **D 9/96** a candidate again alleged unequal treatment, this time in connection with the language rules under Art. 15 REE 1994 (cf. Art. 12 REE). The board conceded that not all candidates were treated equally since not all of them received examination papers in their mother tongue. However, it had to be taken into account in this context that the differentiation referred to above was a direct consequence of the linguistic regime of the EPC 1973 itself. According to Art. 14(1) EPC 1973 the official languages of the EPO were English, French and German. Each professional representative was inevitably confronted with documents and notifications in one of the three official languages of the EPO. Thus, any professional representative had to be expected, in the public interest and the interest of his clients, to understand at least one of the official languages of the EPO and to be able to work on documents and notifications drafted in this language.

The background to several appeals (**D 10/97**, **D 15/97**, **D 17/97** and **D 5/97**) against Examination Board decisions failing candidates in Paper D of the 1996 EQE was that some (but not all) of the copies of the paper given to candidates did not contain Question 11. The Examination Board therefore automatically gave all candidates full marks for Question 11. On this point the DBA reaffirmed **D 14/95**, which had stated that equal treatment did not have to be absolute, provided the nature and extent of any unequal treatment was justifiable in the circumstances. It would be wrong in law, however, if the examination conditions put certain candidates at a disadvantage for no good reason. The Examination Board had compensated the affected candidates in a way which appeared entirely appropriate given the circumstances. This necessarily involved a certain unequal treatment, which however was limited in its extent and acceptable in this special situation. In particular, it ensured that no candidate was worse off than if his answer had been marked objectively. So, in the DBA's view, the way in which the Examination Board had corrected the error was appropriate to the circumstances and did not constitute unlawfully unequal treatment.

2.3. Marking the answer papers

Art. 6(2)(c) REE requires the Examination Board to give the members of the examination committees instructions for marking candidates' answers consistently (cf. Art. 16 REE 1994).

Under Art. 8(1)(d) and (e) REE, the examination committees mark the answer papers, each paper being marked by two committee members (examiners) separately (cf. Art. 8(b) REE 1994).

In **D 4/99** the appellant's complaint concerned the fact that the two examiners had marked Paper D differently. The board stated that the appellant's starting point that in case of non-identical marks only one value could be the correct one was irreconcilable with the fact that marking was an individual assessment of the candidate's work. Rather, more or less strict standards were possible and different aspects might be considered essential or less important even within the general instructions to the examiner for marking the papers contained in the Implementing provisions to the REE 1994. Examiners must have some latitude of evaluation when awarding marks and individual examiners might arrive at different marks, both results being justifiable. Therefore, differences in marking did not violate the REE 1994 and its implementing regulations (**D 5/94**, **D 6/98**). In order to safeguard the principle of equal treatment, harmonisation of marking was provided for in the marking sheets. If the marking was different, the two examiners might revise their marks on the basis of a discussion between them, or papers might be marked by further examiners before the examination committee as a whole recommended a grade for the paper to the Examination Board. This meant that the committee recommended the grade, and the Examination Board adopted it or otherwise, in full knowledge of the different marks awarded by the two examiners. This system ensured uniformity of marking as required by Art. 16 REE 1994.

In **D 6/99** the DBA confirmed that small differences in marking did not, as such, violate the REE 1994 and its implementing regulations. They were an unavoidable consequence of the provision, in Art. 8(b) REE 1994, that each answer was marked separately by two examiners. The board was not aware of any provision supporting the appellant's submission that in such cases only the better mark awarded in each category of the paper should be counted.

In **D 10/02** (OJ 2003, 275) it was noted that neither the REE 1994 nor its Implementing provisions regulated the procedure to follow in the exceptional cases where a committee was unable to agree on the marking; nor did they provide for calling in a third or fourth examiner. The DBA pointed out that those were the very cases in which an express provision was needed in order for a candidate to satisfy himself that his paper had not been marked arbitrarily or the procedure influenced by irrelevant circumstances. Hence the appointment of a third examiner without any basis in the REE 1994 or its Implementing provisions had to be deemed a substantial procedural violation.

In **D 3/04** the appellant had complained about unsuitable conditions during the examination. The appealed decision, however, did not show that the appellant's complaint had been taken into consideration by the Examination Board. In the view of the DBA, where the Examination Board found the circumstances referred to in a complaint not to justify the allocation of additional marks, brief reasons should be given explaining why this was so.

In **D 7/05** (OJ 2007, 378) the DBA deemed that details of the marking include sufficient sub-division of the maximum achievable mark and the candidate's overall mark into sub-marks, and an indication of the substantive and legal issues for which those sub-marks were awarded. In producing schedules of marks there had to be a trade-off between their purpose of ensuring uniform marking (Art. 16 REE 1994) and the need also to allow for fair marking of answers which deviated from the scheme but were at least reasonable and competently substantiated. The schedules therefore had to leave some room for manoeuvre and - merely - be sufficiently detailed to constitute details of the marking within the meaning of R. 6(1) IPREE 1994 (cf. now R. 4(1) IPREE) allowing candidates to verify, on the basis of the documents published or made accessible, whether the marking of their answers infringed marking principles the respect of which was subject to review by the DBA. See also decisions **D 3/03**, **D 11/07** and **D 23/08**.

2.4. Grades / passing the examination

To pass the examination, a candidate must have passed each paper or obtained the minimum grades as specified in the IPREE (Art. 14(1) REE, R. 6(1), (3) and (4) IPREE). The possibility of being awarded the grade "Compensable fail" in an individual paper (R. 6(3)(c) IPREE) is no longer restricted to first sitters. If, despite this compensatory measure, a candidate fails the examination, he must resit those papers which he did not pass (Art. 16(1) REE). Borderline case assessments of candidates' fitness to practise as professional representatives before the EPO are therefore not possible under the REE and IPREE. For earlier decisions relating to this point see the corresponding section 2.4 entitled Borderline cases, of the previous (5th) edition of the Case Law of the Boards of Appeal and also **D 23/08**.

2.5. Substantiation of EQE decisions

At issue in **D 12/97** (OJ 1999, 566) was whether EQE Examination Board decisions informing candidates that they have failed the examination have to be reasoned. The DBA pointed out that this was not required by the REE 1994.

The board also found the appellant's constitutional arguments - that substantiation of such decisions was a generally recognised principle of procedural law within the meaning of Art. 125 EPC 1973 - to be unfounded. For this to be so, it had to be shown that substantiation of such decisions was required in the EPC contracting states.

In **D 3/03** the board of appeal confirmed its case law (**D 12/97**, OJ 1999, 566), whereby the REE 1994 neither required EQE decisions to be reasoned nor made reference to R. 68(2) EPC 1973 (cf. now R. 111(2) EPC), which therefore did not apply. The Guidelines for Examination were likewise not applicable for the same reasons. The REE and its Implementing provisions were *lex specialis* for the EPC. In other words, unless they expressly referred to the EPC, then only they and not the EPC applied. The subsidiary nature of these provisions was justified by the fact that they governed a particular matter unrelated to the EPC *stricto sensu*, since their purpose was to establish whether a candidate was considered fit to practise as a professional representative before the EPO. With regard to the review by the courts of decisions concerning the

European qualifying examination for professional representatives before the EPO, the Federal German Constitutional Court had also held that the obligation to give reasons for examination decisions cannot be regarded as an expression of the structural elements of any protection of basic rights intended by the Basic Law (see decision 2 BvR 2368/99 of 4 April 2001).

This case law was again confirmed by the DBA in **D 7/05** (OJ 2007, 378). In its extensive reasoning the Board also held that, apart from the fact that the marking sheets under R. 6(1) IPREE 1994 already had a decision substantiation function, the extent to which the principles of rule-of-law process also demanded individual substantiation of examination decisions could not be assessed without consideration of the extent of the Board's powers of review under Art. 27(1) REE 1994. The absence of an obligation to provide individual substantiation was to be seen in connection with the fact that Examination Board decisions in EQE proceedings were subject to only limited judicial review (as to this see also 2.6.1 and 2.6.3 below).

2.6. Appeals against decisions of the Examination Board and the Examination Secretariat

2.6.1 Competence of the board of appeal

Under Art. 24(1) REE (cf. Art. 27(1) REE 1994), an appeal lies from decisions of the Examination Board and the Secretariat only on grounds of infringement of the Regulation or of any provision relating to its application.

However, the board of appeal has only very limited scope for reviewing the legal validity of implementing provisions drawn up by the Administrative Council or, in the case of delegation, by the relevant subsidiary body.

In **D 3/89** (OJ 1991, 257) the board of appeal stated in justification of the limited scope of the examination that the relevant bodies had discretionary powers in drawing up such provisions. As long as the legislative organ and subsidiary bodies had not misused their discretionary powers, the DBA could apply the provisions concerning examinations only to the case in point (see also **D 1/81**, OJ 1982, 250; **D 5/89**, OJ 1991, 210; **D 14/96**, **D 11/99** and **D 7/05**, OJ 2007, 378).

2.6.2 Time limit for appeal / rectification of decisions

The notice of appeal, to be filed within one month from notification of the contested decision, must already include the statement setting out the grounds (cf. Art. 24(2) REE). Under Art. 24(3) REE, if the Examination Board or the Secretariat considers the appeal to be admissible and well-founded it must rectify its decision and order reimbursement of the appeal fee. If the appeal is not allowed within two months from notification of the decision, it is remitted to the DBA. The procedure according to Art. 27 REE 1994, which was the subject of the following two decisions, has therefore been streamlined.

In **D 38/05** of 17.1.2007 and **D 4/06** the DBA found that the provision for rectification of decisions of the Examination Board was modelled on Art. 109(1) EPC and designed to serve the same purpose in comparable situations. The aim, in either case, was that the department of first instance be able to set aside a decision of its own if it found an appeal against that decision, filed by the (sole) party, to be (admissible and) allowable. This was a quick and simple way of cancelling flawed decisions. Art. 27(3) REE 1994 (analogous to Art. 109(1) EPC) provided that the department whose decision was contested - in this case, the Examination Board - must rectify its decision if it considered the relevant requirements to be fulfilled. This also meant that the Examination Board was obliged to assess carefully whether or not these requirements were met before deciding to grant or refuse rectification and, in the latter case, referring the matter to the board of appeal. The two month time limit for considering the appeal and deciding whether it must be allowed therefore only started to run on receipt of the statement of grounds for appeal, even though this was not expressly provided in Art. 27(3) REE 1994 - in contrast to Art. 109(2) EPC. See, however, the current provisions of Art. 24(2) and (3) REE, referred to in the previous paragraph.

2.6.3 Objective review of the marks awarded

In accordance with the DBA's consistent case law (in particular **D 1/92**, OJ 1993, 357, **D 6/92**, OJ 1993, 361, and **D 7/05**, OJ 2007, 378), decisions of the Examination Board may in principle only be reviewed for the purposes of establishing that they do not infringe the REE, the provisions relating to its application or higher-ranking law. In **D 1/92** and **D 6/92**, the DBA therefore concluded that its functions did **not** include reconsidering the examination procedure **on its merits**. Accordingly, the Examination Board's value judgment concerning the number of marks that an examination paper deserved was not subject to review by the board. Only if the appellant could show that the contested decision was based on serious and obvious mistakes could the board take this into account. The alleged mistake must be so obvious that it could be established without re-opening the entire marking procedure, for instance if an examiner was alleged to have based his evaluation on a technically or legally incorrect premise on which the contested decision rested. Any further claims regarding alleged defects in the assessment of candidates' work fell outside the DBA's jurisdiction, since value judgments were not subject to judicial review. These findings were confirmed in **D 7/05** (OJ 2007, 378). See also **D 9/00**, **D 7/01**, **D 11/01**, **D 16/02**, **D 6/04**, **D 14/08** and **D 23/08**.

In **D 6/98**, the DBA added that these conditions were in line with those for correcting errors under R. 89 EPC 1973 (cf. now R. 140 EPC), particularly in the case of errors of transcription or calculation in the marking. Under Art. 27(1) REE 1994 (cf. Art. 24(1) REE), the DBA was not empowered to reopen the assessment procedure (**D 15/97**). The DBA was not intended to be a department of second instance empowered to examine whether the marks awarded for a candidate's examination were justified on their merits or correct, and thus to superimpose its own value judgment on that of the Examination Board (**D 20/96** and **D 6/02**).

In **D 13/02** the board stated that obvious mistakes as referred to above were those which could be identified without a re-evaluation of the examination paper. That would be the

case, for instance, if one and the same paper had been marked **very** differently by the two examiners, since the marking discrepancy alone would indicate an infringement of the principle of uniform marking, irrespective of the level of the marks awarded. Another example of an obvious mistake would be a question whose wording was ambiguous or incomprehensible. That would be clear straight away, without any reference to marks awarded, from the meaning that common sense would ascribe to the wording of the question concerned.

D 17/05 cited **D 13/02** to point out that the existence of a mistake within the meaning of **D 1/92** could not be deduced from a comparison of the candidate's answer with another answer. The board also cited the statement that the disclosure of marking instructions which may have been used by the examiner was not required for a decision on an appeal and that under the established case law no other entitlement existed to any such disclosure.

In **D 3/00** (OJ 2003, 365) the appellant claimed that for each question in paper D, parts 1 and 2, he should have been awarded the highest number of marks awarded by one of the two examiners who had marked his paper. In **D 12/00**, too, the appellant claimed among other things that the higher number of marks should count. Also, any discrepancy between the markings of each examiner showed gross disregard for the principle of uniformity within the meaning of Art. 16 REE 1994 (Art. 6(2)(c) REE, English text, now provides for consistency of marking). The board confirmed its established case law, adding that differences of opinion over the number of marks to be awarded for a given answer were a reflection of value judgments which were not, in principle, subject to judicial review. It had also already been explained in **D 4/99** that the marking of examination papers was an individual assessment and that, within the general instructions to the examiners for marking the papers (see the REE 1994 Implementing provisions), more or less strict standards were possible and different aspects might be considered essential or less important. Hence it was consistent with the ratio legis of Art. 8(b) REE 1994 (cf. Art. 8(1)(e) REE) that the examiners had some (limited) latitude of evaluation when awarding marks and might therefore arrive at different marks, both results being justifiable (**D 5/94** and **D 6/98**). The fact that two independent examiners had arrived at different marks was not per se a violation of the applicable provisions (**D 12/00**). In **D 3/00** the board drew attention to the fact that, with regard to the evaluation of the merits of a candidate's answer in an examination paper, a candidate was not per se entitled to claim the highest mark awarded by one of the examiners for each answer to a sub-question or sub-element whenever the two examiners who marked the paper in accordance with Art. 8(b) REE 1994 differed in their marking.

D 6/07 and **D 7/07** were among a number of appeal decisions concerning the marking of paper C of the 2007 examination. A large number of candidates had taken as the starting point for their attack on the claims a document which the examination committee did not consider to represent the closest prior art and had been awarded no points in this regard. The Examination Board took the view that, in keeping with long-standing practice, some credit should be given for properly drafted problem and solution approaches even where the wrong starting document for assessing inventive step had been used. Given the lateness of the proceedings and the impossibility of re-marking all the papers, it decided,

as an exceptional measure, that the fairest option would be to award ten additional points (being the maximum number possible) to all candidates having sat the paper. The DBA held first that the awarding of no points by the examination committee infringed the requirements of R. 4(2) and (3) IPREE 1994: the "fit to practise" criterion required the examiners in marking the individual parts of a candidate's answers not to disregard their merit in the context of the whole answer paper (**D 3/00**, OJ 2003, 365) and the need to allow for the fair marking of answers which, although deviating from the marking scheme, were nonetheless reasonable and competently substantiated (**D 7/05**, OJ 2007, 378). The board further ruled that, under Art. 7(3) REE 1994, it fell to the Examination Board to award the grades "pass", "fail", or "compensable fail" and formally to decide whether the whole examination had been passed or not. Its powers did not extend to the preceding marking of candidates' individual papers on a scale of zero to 100, and therefore the alteration of the marks awarded by the examination committee (in accordance with Art. 8(b) REE 1994 and R. 4(1) IPREE 1994) by the blanket addition of ten marks per paper had been *ultra vires*. The abstract awarding of marks without regard to the "fit to practise" criterion of R. 4 IPREE 1994 in the individual candidates' examination papers infringed the principle of objectivity as well as Art. 8(b) REE 1994 and R. 4 IPREE 1994. In conclusion the DBA ordered a new marking of paper C of each appellant in accordance with R. 4 IPREE 1994, with the ten additional points already awarded to be retained by the appellant.

2.6.4 Legitimate interest

According to the established case law, a candidate who appealed against failing the EQE but resat and passed it before the appeal had been decided still retained a legitimate interest in pursuing the appeal. This was confirmed in **D 3/98**. Any other view would amount to denying him recourse to the law; legitimate interest would then depend on how long proceedings took. However, appellants could exert little influence over that, and should therefore not have to suffer the consequences. Whether there was a legitimate interest was to be determined with reference to the date the proceedings were initiated (in this case, on the day the appeal was filed).

2.6.5 Duties of the Examination Board

In several decisions, the DBA pointed out that, under point 7 of the former Instructions to candidates (OJ 1995, 145) and point 7 of the former Instructions to invigilators (OJ 1995, 153), a timely and formally correct complaint about the conduct of the examination was to be submitted to the Examination Board, which was then supposed to issue a provisional opinion, together with an invitation to comment. Failure to do so put it in breach of generally recognised principles of procedural law (Art. 125 EPC), notably the right to be heard (Art. 113(1) EPC; see **D 17/96**, **D 2/97**, **D 2/99** and **D 3/99**). See now R. 19(3) and (4) IPREE.

3. Disciplinary matters

The Regulation on Discipline for Professional Representatives (RDR) of 21.10.1977 (OJ 1978, 91), adopted by the Administrative Council in accordance with Art. 134(8)(c)

EPC 1973 and amended by AC Decision of 14.12.2007 in accordance with Art. 134a(1)(c) EPC (OJ 2008, 14), contains not only provisions on general professional obligations, professional secrecy and conduct towards clients but also provisions relating to the disciplinary bodies responsible for imposing disciplinary measures (see also Additional Rules of Procedure of the Disciplinary Committee and of the Disciplinary Board, OJ 1980, 176, and 177 and 183, respectively; for amendments see OJ 2007, 552; Additional Rules of Procedure of the Disciplinary Board of Appeal, OJ 1980, 176 and 188, and consolidated version, Supplement to OJ 1/2010, 50).

3.1. Disciplinary measures

According to **D 5/86** (OJ 1989, 210), an infringement of the rules of professional conduct must be established to the satisfaction of the disciplinary body before it can impose a disciplinary measure. Absolute certainty is not required, but a degree of probability which in human experience verges on certainty. A disciplinary measure cannot be imposed if there is reasonable doubt as to whether the infringement has occurred.

In **D 11/91** (OJ 1995, 721) the EPO Disciplinary Board had ordered the deletion of the appellant from the list of professional representatives for an indefinite period. In his appeal, the appellant contested the disciplinary measure and held that the procedure before the DBA did not comply with the provisions of the European Convention for the Protection of Human Rights, in particular because the DBA had been established not by national law but by the Administrative Council of the EPO, the disciplinary bodies did not constitute an independent court, the DBA was not a national authority, and its decisions could not be referred to a higher court of appeal.

The DBA decided that the European Convention for the Protection of Human Rights contained provisions which expressed general principles of law common to the member states of the EPO. As such these provisions should be considered part of the legal system of this Organisation and should be observed by all its departments. This therefore applied to Art. 13, which guaranteed the protection by the judiciary of the rights of the individual. The "national authority" mentioned in this article was clearly meant to be understood as a competent authority in accordance with the law of the state concerned. However, in ratifying the Munich Convention, the contracting states accepted a transfer of prerogatives whereby professional representatives before the EPO became subject to the same set of professional regulations, controlled by a central body whose decisions were open to effective remedy before a body of second instance whose independence was guaranteed by the rules governing its composition. The drafting of these regulations and the establishment of these bodies was thus consistent with general principles of law, in particular those enshrined in the European Convention for the Protection of Human Rights.

The board took the view that, in order to ensure that the penalty was proportionate to the seriousness of the charges and that the maxim whereby penalties should not be arbitrary but fixed or predetermined was respected, Art. 4(1)(e) RDR should be understood as meaning "for a period not defined by the text", that is for a discretionary period to be

decided by the competent disciplinary body. In its decision, the latter should fix the said period and give reasons for its choice.

In **D 20/99** (OJ 2002, 19), appellant X filed an appeal against the EPO Disciplinary Board's decision to issue him with a reprimand. The DBA, reviewing the penalty imposed in respect of the first charge only, held that X's actions, for which he had been prosecuted in France, were in breach of Art. 1(1) and (2) RDR. It was clear that D had been involved in drawing up European patent applications in consultancy L, owned by the appellant, while being paid by company P. However, it was evident from the file that this contractual arrangement had never been the subject of invoicing.

That gave an advantage to consultancy L by cutting the cost of drawing up patent applications. As it inevitably entailed unfair distortion of competition in relation to other European patent attorneys, this was an undue advantage. The board concluded that the misuse of corporate assets was tantamount to unfair competition in relation to fellow European patent attorneys and thus represented a breach of the rules of professional conduct governing representatives before the EPO.

3.2. Appealability of decisions in disciplinary matters

In **D 15/95** (OJ 1998, 297) the board ruled that a Disciplinary Committee decision dismissing a complaint was a decision in the legal sense only as regards the persons referred to in Art. 8(2) RDR, and only they could appeal against it. Thus the person who made the complaint had no right of appeal. Review on appeal was limited to safeguarding the rights of the "accused", i.e. the "professional representative concerned" within the meaning of the RDR (see also **D 1/98**). In **D 28/97** and **D 24/99** the DBA added that the purpose of disciplinary proceedings was not for individuals to pursue their interests vis-à-vis others (although these might be affected in individual cases) but rather to serve the public interest in orderly and proper exercise of professional representation before the EPO. Any claims by individuals arising from a representative's infringement of the rules of professional conduct were exclusively a matter for the competent (civil) courts (see also **D 25/05**).

4. Code of Professional Conduct

The general principles are laid down in the current version published in OJ 2003, 523. Point 1(a) of the Code refers in turn, as regards the general requirements for *epi* members, to the RDR (OJ 1978, 91, also OJ 2008, 14).

4.1. General professional obligations

In **D 16/95** the board ruled that, although drafting and filing translations and paying fees in the national phase in a contracting state were not directly related to grant, opposition or appeal proceedings, such activities were still covered by Art. 1 RDR. They were, after all, activities in connection with a European patent (see Art. 65 and 141 EPC 1973) and as such part of a professional representative's job. Regarding them as covered by Art. 1 RDR was also justified by the fact that it was difficult for outsiders (e.g. persons

commissioned to translate patent specifications) to distinguish between those of a representative's activities which were directly related to grant, opposition or appeal proceedings and those which were not. Since national-phase-related activities were thus covered by Art. 1 RDR, reprehensible conduct in connection with them constituted a breach of a representative's general professional obligations under that provision (see also **D 25/05**).

4.2. Professional secrecy

In **D 11/91** (OJ 1994, 401), the appellant had requested the removal of various documents placed on file by the complainant. The appellant argued that his request was justified because, inter alia, their inclusion contravened the rule of confidentiality to which professional representatives were subject. The documents were items of correspondence between the complainant and the disciplinary bodies and correspondence pertaining to an opposition case.

The board decided that the professional secrecy referred to in Art. 2 RDR set limits on the disciplinary bodies' powers of investigation and on the obligation under Art. 18 RDR for a professional representative before the EPO to supply all relevant information. However, the mere obligation of confidentiality deriving from the principle enshrined in Part I RDR could not be invoked to resist a request under Art. 18 RDR.

4.3. Advertising

The adoption of the Code of Conduct (current version, OJ 2003, 523) entailed the rescindment of the ban contained in point 2(b)(1) on the comparison of the professional services of a member with those of another member, as laid down in the version published in OJ 1999, 537.

The original advertising ban had already been replaced in the previous version (OJ 1999, 537) by the new provision point 2(a), which states that advertising is generally permitted provided that it is true and objective.

5. Appeals against decisions of the Disciplinary Board of Appeal

In **D 5/82** (OJ 1983, 175) the DBA already noted that it has no power to refer questions to the Enlarged Board of Appeal. In **D 7/05** of 2.1.2007 and **D 2/06** of 31.8.2006 the DBA had to consider requests seeking a review of its final decisions. The board stated that decisions of the boards of appeal and the DBA became final when issued, and were no longer subject to appeal, nor could they be set aside by the board itself. It refused the requests as inadmissible, with reference to the principles set out by the Enlarged Board of Appeal in **G 1/97** (OJ 2000, 322), according to which the decision on inadmissibility is to be issued by the board of appeal which took the decision forming the subject of the request for revision. The decision on the request could be issued immediately and without further procedural formalities.

IX. THE EPO ACTING AS A PCT AUTHORITY

Pursuant to Art. 150(2) EPC, international applications filed under the PCT may be the subject of proceedings before the EPO. In such proceedings, the provisions of the PCT and its Regulations apply, supplemented by the provisions of the EPC. In case of conflict, the provisions of the PCT and its Regulations prevail.

An applicant may file an international application for which the EPO is a designated Office (and optionally an elected Office). Such an application, once it has been accorded an international filing date, is equivalent to a regular European application and is generally referred to as a Euro-PCT application (Art. 153(2) EPC). Once the Euro-PCT application enters the regional phase before the EPO the appeal procedures provided for under the EPC supplement the provisions of the PCT (**J 20/89**, OJ 1991, 375).

A. Competence of the boards of appeal in protest proceedings under the PCT

Prior to the entry into force of the EPC 2000 the boards of appeal were responsible for deciding in cases of lack of unity of invention on protests against additional search or examination fees charged by the EPO acting as International Searching Authority (ISA) or International Preliminary Examining Authority (IPEA), respectively (Art. 154(3) and 155(3) EPC 1973). The boards acted as department of second instance, because the justification for the invitation to pay additional fees was reviewed by a review panel before the applicant was required to pay a fee to have the protest examined by a board of appeal.

With the entry into force of the EPC 2000 in December 2007, the protest procedure has been simplified. Art. 154(3) and Art. 155(3) EPC 1973 have been deleted and the boards are thus no longer responsible for deciding on protests against additional fees charged by the EPO in cases of lack of unity. Protests are reviewed only once by a so-called review body (R. 40 and 68 PCT which entered into force on 1.4.2005).

The deletion of Art. 154(3) and 155(3) EPC 1973 applies to all international applications filed on or after 13.12.2007. With regard to international applications filed before that date and pending on 13.12.2007, Art. 154(3) and 155(3) EPC 1973 continue to apply.

The case law of the boards of appeal on the protest procedure can be found in the 5th edition of this book.

1. The transition to the simplified protest procedure

Provisions to facilitate the simplified protest procedure were already made to the Regulations under the PCT with effect from 1.4.2005. R. 40 and 68 PCT were amended so that there was no longer a requirement to carry out a review of the justification for the invitation to pay additional fees before requiring that the applicant pay a fee for the examination of the protest. Only the review body examines the protest.

The changes to the EPC which entered into force in December 2007 corresponded to those made to the Regulations under the PCT which entered into force on 1.4.2005. The EPO dealt with the procedure to be applied between those dates by way of a Notice. According to the Notice from the EPO dated 1.3.2005 concerning the protest procedure under the PCT (OJ 2005, 226), prior to the entry into force of the EPC 2000 the EPO continued to subject any invitation to pay additional fees to an internal review, prior to submission of the protest to the board of appeal. This review was in the nature of a service from the EPO.

In **W 26/06** the board questioned the status of the interim protest procedure established under the Notice from the EPO dated 1 March 2005. Decision **W 26/06** concerned a protest filed under R. 40.2(c) PCT as in force from 1 April 2005 (new R. 40 PCT) against an invitation to pay additional search fees. The board held that the difference in the point of time for the entry into force of the amended regulations of the PCT and of the EPC resulted in a situation of conflict between the amended regulations under the PCT and some provisions of the EPC and the corresponding regulations and/or notices from the EPO. In the board's view, the amended provisions of the PCT and Art. 150(2) EPC 1973 (prevalence of PCT over EPC in case of conflict) did not leave room for a further review carried out on a voluntary basis as a service from the EPO (see also **W 1/06**).

In **W 20/06**, by contrast, the board held that there was no conflict between R. 40.2(c) PCT as in force from 1.4.2005 and Art. 154(3) EPC 1973 and that Art. 150(2), third sentence, EPC 1973 did not apply. The board did not see any differences in the former and actual requirements under the PCT which could in any respect result in a conflict with Art. 154(3) EPC 1973, because each board of appeal, being an organisational part of the EPO, constituted a review body within the framework of the EPO as ISA in compliance with R. 40.2(c), second sentence, PCT, having the competence to decide fully on the protest. The board held that only the boards of appeal were given the powers required for the review body in the then valid R. 40.2(c), second sentence, PCT. An internal preliminary review could be performed prior to submission of the protest to the board of appeal (see also **W 22/06**, **W 2/07** and **W 6/07**). In **W 18/06** the board noted that, in the light of the EPO's Notice of 1.3.2005, an applicant could assume that the procedure followed by the EPO acting as International Searching Authority would lead to a review of the protest by the board of appeal.

B. The EPO as designated or elected Office

Where the EPO is a "designated Office" or an "elected Office" for an international application under the PCT, the application is equivalent to a regular European application (Euro-PCT application). In the case of Euro-PCT applications the provisions of the PCT apply in addition to those of the EPC, and where there is conflict between them, the provisions of the PCT prevail.

The case law concerning the EPO acting as designated or elected Office focuses on two areas. One concerns the competence of the EPO, in particular in the context of other institutions involved in the process of international applications. The other deals with corrections of the Euro-PCT applications, in particular correction of designation of states.

Some decisions concern both areas. The case law concerned predominantly with the competence of the EPO is summarised below, the case law concerned predominantly with corrections is summarised in Chapter VII.A.5.3 (Preliminary and formalities examination, subchapter Correction of designation of states in Euro-PCT applications). A further important issue concerns the language of the proceedings in relation to which the Legal Board of Appeal made a referral to the Enlarged Board of Appeal. The referral and the decision of the Enlarged Board of Appeal are summarised further below (see Chapter IX.B.3).

1. Changes of procedure introduced with the revision of the EPC

In the course of the revision of the EPC the consequences of non-fulfilment of certain requirements on entry into the European phase have been changed. Pursuant to R. 108(3) EPC 1973 the applicant could remedy the non-fulfilment of certain requirements by completing the omitted act and paying a surcharge within due time. With the entry into force of the EPC 2000, this remedy became unavailable. Instead, the remedy is now further processing (R. 160 EPC).

A further procedural change concerns the payment of supplementary search fees in case of non-unity. Under the provisions of the EPC 1973 the applicant was able to pay, on entry into the European phase, additional search fees for inventions not searched in the PCT phase (R. 112 EPC 1973). Under the new provisions, the applicant has to pay for the supplementary search which is always performed unless the EPO was the International Searching Authority, but can no longer pay for additional searches in respect of inventions that were not searched during the international phase (R. 164 EPC). With regard to such inventions divisional applications can be filed after entry into the European phase.

Changes affecting the designation of states are described in chapter VII.A. (Preliminary and formalities examination).

2. The competence of the EPO acting as designated or elected Office

The decisions below consider the application of the EPC 1973.

In **J 26/87** (OJ 1989, 329) the board held that if, on the proper interpretation of the request for grant of an international application, an applicant has designated an EPO contracting state for which the PCT is in force on the filing date of the international application, the EPO is bound by the provisions of Art. 153 EPC 1973 to act as the designated Office for that contracting state, even if the international application has been published by the International Bureau without mentioning that contracting state as a designated state.

In **J 7/93** the International Bureau did not inform the EPO of its election (in the demand for international preliminary examination) within the 21-month time limit under R. 104b(1) EPC 1973 (version valid prior to 1.3.2000). At the end of this period the EPO therefore issued a communication pursuant to R. 85a EPC 1973 requesting payment of

the fees to be paid under R. 104b EPC 1973, unaware that the extended time limit of 31 months under Chapter II PCT was applicable. However, the fees were not paid within the 31-month time limit and a request for re-establishment of rights was filed with the EPO. In the meantime, the EPO had issued a notification pursuant to R. 69(1) EPC 1973 indicating that the application was deemed to be withdrawn. This notification again referred to the 21-month time limit, the EPO still being unaware of its election. The Receiving Section went on to reject the request for re-establishment on the ground that re-establishment was excluded under Art. 122(5) EPC 1973 in respect of the time limits for paying fees pursuant to R. 104b(1)(b) (c) EPC 1973 (following **G 3/91**, OJ 1993, 8). The board held that the communication pursuant to R. 85a EPC 1973 and the notification pursuant to R. 69(1) EPC 1973 were legally non-existent because they could not be based on any provision in the EPC or the PCT. Thus, the reasons for which the party had refrained from acting upon them were irrelevant as the communications could have no legal effect to the party's detriment. Further, according to R. 85a EPC 1973, the fees could still be paid with a surcharge within a period of grace of one month of notification of the failure to observe the time limit. As no such communication had been sent and the party had paid the fees and the surcharge, the proceedings for re-establishment were not necessary. The fact that the EPO continued the proceedings, and finally refused re-establishment of rights, without taking into account the fact that these proceedings were unnecessary from the very beginning amounted to a substantial procedural violation.

A decision of an **examining division** of 5.6.1984 (OJ 1984, 565) pursuant to Art. 153(2) EPC 1973 in conjunction with Art. 25 PCT and Art. 24(2) PCT concerned the authority of a designated Office under Art. 24(2) PCT to maintain the effect of an international application. The applicant had missed the time limit for filing the representative's authorisation set by the Japanese Patent Office acting as receiving Office.

The EPO, acting as designated Office, excused the non-observance of time limits which had been set by the receiving Office for the correction of formal deficiencies in accordance with Art. 14(1)(b) PCT in conjunction with R. 26.2 PCT (Art. 24(2) and 48(2)(a) PCT). The examining division found that the time limit under R. 26.2 PCT was comparable to time limits set by the EPO under Art. 121 EPC 1973 and granted re-establishment of rights according to Art. 122 EPC 1973 in respect of the time limit under Art. 121(2) EPC 1973.

In **J 3/94** the applicant **designated**, in an international application, a European patent under the heading "Regional Patent" and five contracting states to the PCT, including the EPC contracting states Germany and the United Kingdom, under the heading "National Patent". However, in the demand for international preliminary examination, which was filed with the EPO in its capacity as IPEA, only the five PCT member states were **elected**; under the heading "Regional Patent" there was no cross indicating that the EPO was also elected. The applicant subsequently submitted that the failure to elect the EPO had resulted from a mistake when the demand for international preliminary examination was filed. He argued, however, that the time limit under R. 104b EPC 1973 (as in force prior to 1.3.2000) had actually been observed because the election of contracting states to the EPC under the heading "National Patent" (GB and DE) also had the consequence

that the EPO became an elected Office even if no cross was placed in the box for indicating a European patent. The applicant submitted that his actions were sufficient to cause the EPO to be deemed an elected Office by operation of law.

The board pointed out that Art. 31(4)(a), last sentence, PCT, stipulated that an election could relate only to contracting states already designated under Art. 4 PCT. With regard to a state providing for national and regional patents, this meant that an election concerning the national grant procedure was only possible if there was a designation indicating that the applicant wished to obtain a national patent. Likewise, an election concerning the regional grant procedure was only possible if there was a designation indicating that the applicant wished to obtain a regional patent. Since each type of election had effects on different grant proceedings, it appeared that the declaration to use the results of the international preliminary examination in national grant proceedings was different from the declaration to use them in European grant proceedings. The board found that the correspondence of designations and elections, as laid down in Art. 31(4)(a), last sentence, PCT, applied two principles: first, an election could not cover a designation which had not been made when the application was filed and, second, it was up to the applicant for which office he intended to use the results of the international preliminary examination. The validity of the election had to be decided by the authorities concerned during the international phase in order to give effect to the election and had to be assessed on a uniform basis by those authorities. This was apparently in agreement with consistent practice under the PCT. The EPO as designated or elected Office is fully competent to interpret applications appointing it to act in these capacities. Accordingly, the Office is not bound by the interpretation of the receiving Office or of the International Bureau (**J 26/87**, OJ 1989, 329; **J 19/93**).

In **J 4/94** the board had to consider whether the EPO was competent to interpret the applicant's demand for international preliminary examination differently from the United Kingdom Patent Office acting as IPEA. The board conceded that the demand was addressed to the IPEA, which was the competent body to deal with it. However, the board referred to **J 26/87** (OJ 1989, 329), in which it had been decided that the interpretation of the request for grant form by the receiving Office and the International Bureau was not binding on the EPO in its function as designated Office. The valid designation put the matter within the competence of the EPO as designated Office (Art. 2(xiii) PCT and Art. 153(1) EPC 1973). In deciding on the present case, the board deviated from the interpretation by the IPEA. It found that there was a defect in the demand, which the applicant should have been invited under R. 60 PCT to correct. It held that a clear deviation by the IPEA from the intention expressed in the demand was not binding on the EPO. It was, therefore, possible for the EPO to regard itself as a validly elected Office. The consequence of this was that under R. 104b(1) EPC 1973 (as in force prior to 1.3.2000) the time limit of 31 months applied.

3. Language of the proceedings

In **J 8/07** (OJ 2009, 216), an international patent application under the PCT had been filed and published in French. On entry into the European phase before the EPO, the

applicant had attached an English translation of the international application, and requested that the language of the future proceedings should be English.

If that request were refused, its auxiliary request was that the EPO should use English in all written proceedings and decisions. The first-instance department issued a decision refusing both requests. The applicant appealed against that decision.

The Legal Board of Appeal referred questions to the Enlarged Board of Appeal which the latter answered in case **G 4/08**. It ruled that if an international patent application has been filed and published under the PCT in an EPO official language it is not possible, on entry into the European phase, to file a translation of the application into one of the two others which would then become the language of the proceedings. Neither the EPC 1973 nor the EPC 2000 can be interpreted as allowing that. Nor is there any conflict between EPC and PCT provisions.

On the second question, the Enlarged Board decided that EPO departments cannot use, in written proceedings on a European patent application or an international application in the regional phase, an EPO official language other than the language of proceedings used for the application under Art. 14(3) EPC.

X. INSTITUTIONAL MATTERS

1. Administrative Agreement with the German Patent Office

The Presidents of the German Patent Office (GPO) and the EPO entered into an Administrative Agreement on 29.6.1981 concerning the filing of documents and payments (OJ 1981, 381). According to Art. 1 of this Agreement, documents and payments filed with the GPO, but addressed to or intended for the EPO, are treated as if they had been received by the EPO on the day of actual receipt by the GPO.

In **G 5/88**, **G 7/88** and **G 8/88** (OJ 1991, 137) the Enlarged Board of Appeal considered the validity of this Administrative Agreement. The board reached the conclusion that the power of the President of the EPO to enter into such agreements could not be derived from Art. 5(3) EPC 1973, which stated that he represented the European Patent Organisation; the President's capacity to represent the European Patent Organisation was merely one of his functions. The extent of the President's power to enter into agreements was rather to be derived from other provisions of the EPC 1973, in this case Art. 10(2)(a) EPC 1973, according to which the President had to take all necessary steps to ensure the functioning of the EPO.

It was held that an agreement concerning the treatment of misdirected documents involved a necessary step to ensure the functioning of the EPO for the following reason: the misdirection of papers led to the risk of loss of rights, as a result of failure to meet a time limit, caused by the late receipt of documents. The Administrative Agreement between the EPO and GPO was therefore found to be valid to the extent that the possibility of confusion regarding the filing offices of both Offices actually existed; this potential for confusion existed in Munich.

However, as far as the EPO sub-office in Berlin was concerned, there was no basis for such a regulation until 1.7.1989. Before this date the sub-office in Berlin was not a filing office, nor was a letter-box installed. As far as documents and payments which reached the EPO via the GPO's office in Berlin were concerned, the Administrative Agreement was invalid. However, the Enlarged Board of Appeal applied the principle of good faith in favour of the opponent, who had filed a notice of opposition against a European patent via the Berlin office of the GPO, relying on the Agreement published in the Official Journal.

The same danger of confusion has existed in Berlin as in Munich since the opening of the EPO's Berlin filing office on 1.7.1989. On 13.10.1989, the Administrative Agreement between the Presidents of the two patent offices was adapted to the new situation (see OJ 1991, 187).

In **T 485/89** (OJ 1993, 214), the board held that a notice of opposition filed by fax at the GPO in Munich on the last day of the opposition period and forwarded to the EPO the next day was admissible; the opposition fee had already been paid some days earlier. Oppositions filed within the prescribed time by fax at the GPO in Munich while intended for the EPO were covered by the Administrative Agreement of 29.6.1981 and should be

treated by the EPO as if it had received them directly, irrespective of whether or not they had been wrongly delivered.

2. Power under Article 23(4) EPC to amend the RPBA

The Rules of Procedure of the Boards of Appeal and the Enlarged Board of Appeal shall be adopted in accordance with the Implementing Regulations. They shall be subject to the approval of the Administrative Council (Art. 23(4) EPC) (see also OJ 2007, 536 and OJ 2007, 303).

In 1994, in accordance with Art. 33(1)(b) EPC 1973, the Administrative Council amended R. 71 EPC 1973 by adding further provisions to R. 71a EPC 1973, inter alia to the effect that a communication must be issued by the EPO at the same time as a summons to oral proceedings is issued (OJ 1995, 409). In contrast to this requirement of R. 71a(1) EPC 1973, Art. 11(2) RPBA 1980 leaves it to the discretion of the boards of appeal whether or not to send a communication with such a summons. In **G 6/95** (OJ 1996, 649) the Enlarged Board held that R. 71a(1) EPC 1973 did not apply to the boards of appeal. This interpretation of R. 71a(1) EPC 1973 with regard to the boards was based on the consideration that Art. 23(4) and 33(1)(b) EPC 1973 provided two distinct and separate sources of legislative competence or power.

The Enlarged Board pointed out that Art. 23(4) EPC 1973 states that the RPBA "shall be adopted in accordance with the provisions of the Implementing Regulations". In the view of the Enlarged Board this was clearly directed to the mechanism set out in R. 11 EPC 1973, which states that the authority referred to in R. 10(2) EPC 1973 (the "Presidium") "shall adopt" the RPBA. The Enlarged Board concluded that the power under Art. 23(4) EPC 1973 to amend the RPBA belonged to the Praesidium of the boards of appeal, subject to the approval of the Administrative Council. Considered in the light of the principle of judicial independence, which Art. 23(3) EPC 1973 embodied, the mechanism for adopting the RPBA through the Praesidium of the Boards of Appeal pursuant to Art. 23(4) EPC 1973 acquired its full value and showed that the above principle extended to the procedure which was either preparatory to or otherwise related to the making of such decisions.

The Enlarged Board further stated that, according to Art. 33(1)(b) EPC 1973, the Administrative Council was competent to amend the Implementing Regulations. There were obviously limits to the exercise of its powers, however. The Administrative Council was not entitled to amend the Implementing Regulations in such a way that the effect of an amended rule would be in conflict with the EPC 1973 itself (Art. 164(2) EPC 1973). The Enlarged Board held that, according to the proper interpretation of R. 71a(1) EPC 1973, its mandatory procedural requirements were applicable to the first-instance departments of the EPO, but were not applicable to the boards of appeal. If R. 71a(1) EPC 1973 were to be interpreted as applying to all departments of the EPO, including the boards of appeal, its effect would be directly contradictory to and in conflict with the effect of Art. 11(2) RPBA 1980, which was adopted pursuant to Art. 23(4) EPC 1973 as the emanation of the independence of the boards of appeal. However, the Administrative Council must be presumed to know the limits of its own power. It was

therefore reasonable to assume that the Administrative Council did not intend to amend R. 71 EPC 1973 so as to provide a conflict with a Rule of Procedure of the Boards of Appeal which it had itself previously approved.

3. Extension Ordinances on the extension of European patents

In **J 14/00** (OJ 2002, 432) the board observed that the Agreement with the Republic of Slovenia extending the protection conferred by European patents (Extension Agreement), including the associated Extension Ordinance (EO) (OJ 1994, 75) which came into force on 1.3.1994, was based on the Patent Cooperation Agreement between the European Patent Organisation and the Republic of Slovenia, which came into force on 1.9.1993. This agreement was an international treaty of the kind which the President of the EPO is authorised by the Administrative Council to conclude with the Council's approval (Art. 33(4) EPC 1973), in order to carry out the functions assigned to him under the EPC 1973. This agreement served the interests not only of applicants, providing as it did a simple route to patent protection in the Republic of Slovenia, but also those of the Republic of Slovenia, enabling it to offer patent protection for its territory simply by extending the effects of European and Euro-PCT applications and patents.

The Legal Board of Appeal decided on the admissibility of an appeal directed against a letter issued by an EPO formalities officer applying the Extension Ordinance. The board held that, in the case at issue, admissibility was rather precluded by the fact that, according to the exhaustive provision in Art. 106(1) EPC 1973, only those decisions of the EPO may be contested which are taken, within the framework of their duties under the EPC 1973, by the departments listed therein. This was not, however, the case for decisions taken by the EPO when carrying out its obligations under the Extension Agreement, including the EO (OJ 1994, 75).

The Legal Board found that there was nothing in the structure or legal nature of the EO to support the appealability of the letter issued by an EPO formalities officer. The board held that the extension procedure under the EO generates legal effects exclusively on the basis of Slovenian national law. The EO did not include the assignment of sovereign rights to the EPO. It held that the provisions of the EPC 1973 and its Implementing Regulations do not apply unless otherwise provided in the EO. The EO thus made it absolutely clear that its references to provisions of the EPC 1973 are exhaustive and thus that there could be no corresponding application of other provisions, including those of Art. 106 EPC 1973 et seq. on the appeals procedure.

Nor could the appellant invoke the principle of good faith to obtain legal recourse to the EPO's boards of appeal. The board stated that this principle is one of the fundamental principles of European patent law. However, as far as the extension procedure was concerned, the EPO was not acting within the framework of the EPC 1973. In its introduction to the EO, the EPO expressly stated that the EO was based on Slovenian national law only (OJ 1994, 75) and that the extension procedure and its effects were governed solely by Slovenian law (OJ 1994, 80).

In **J 9/04** the board also commented on the structure or legal nature of the EO. It noted that, as a bilateral ordinance, the EOs essentially deal - exhaustively and strictly separately from the Convention - with matters pertaining to the integration of extended European applications and protective rights into the respective national law and their relationship to national applications and rights based on the law on industrial property of the extension states (see, for Slovenia, BIfPMZ 1993, 303 - German periodical). This includes, in particular, the conferral of the same effects on extended applications and patents as on national ones, the obligation to provide the national patent offices with a translation of the claims into the respective language, the national authentic text of extended applications and patents, their prior-art effect with respect to national applications and patents, and, finally, simultaneous protection. According to the board, none of these provisions give rise to any obligations on the part of the EPO. Under the EOs, the EPO merely undertakes vis-à-vis the national patent authorities to assist with the administrative tasks associated with the extension of European patents, namely receiving requests for extension, levying extension fees and, after deducting an amount to cover its expenses, forwarding the remaining amount to the national patent offices.

It was also stated that it was clear from their provisions that the EOs were governed by the principle of minimal intervention in the sovereign rights of the extension states. The Convention, on the other hand, was based inter alia on the delegation of national sovereign rights to the EPO, on the participation and the controlling function of the Administrative Council in the administration of the EPO, and on the division of renewal fees between the EPO and the contracting states involved.

The board observed that the EO did not afford any of the rights and obligations associated with accession to the Convention. Contrary to the appellant's assertion, it thus did not set up a jus tertii for services rendered by the EPO in fulfilment of its obligations under the EO either. As a result there was no right of recourse to the boards of appeal in respect of extensions of patent applications and patents to the extension states. Instead, in cases such as the one at issue, it was the respective national jurisdiction which was responsible. For example, Art. 6(2) of the Slovenian Law provides for appeal proceedings against decisions of the Slovenian Patent Office (see also **J 2/05**).

4. Referrals to the Court of Justice of the European Communities under the EC Treaty - legal status of the EPO boards of appeal

In **T 276/99** the board noted that under the EC Treaty referrals to the Court of Justice of the European Communities were governed by Art. 234 (jurisdiction of the Court of Justice to give preliminary rulings). The board pointed out that, prima facie, as the EPO boards of appeal were not a court or tribunal of an EU Member State, they did not have the status to refer a question to the Court of Justice of the European Union. Further, the question that this board had to decide did not fall under Art. 234 EC Treaty.

The board noted that the appellant seemed to have misunderstood the comments of the German Constitutional Court ("Bundesverfassungsgericht", BverfG, decision of 4.4.2001, 2 BvR 2368/99, published in GRUR 2001, 728 - 730 - German periodical). The

board pointed out that the delegation referred to there was the delegation of powers to the EPO directly by the EPC contracting states who were also members of the EU, and not any delegation from the EU itself. There was also delegation of powers by the non-EU contracting states. Since the European Patent Organisation was not part of the European Union institutions, and since the delegation of powers by the non-EU contracting states was to the EPO but not to the European Union or its institutions, there was no obvious basis for referring a question to the Court of Justice of the European Communities from an EPO board of appeal.

TABLE OF CASES

In the table of cases, the bibliographic data of all cited decisions are listed according to the reference number, giving details of the relevant board and the date of the decision. Board of appeal decisions published in the OJ include a reference to the year and page number of publication.

Decisions of the Disciplinary Board

D	1/81	04.02.82	1982, 258	938
D	5/82	15.12.82	1983, 175	944
D	6/82	24.02.83	1983, 337	510
D	8/82	24.02.83	1983, 378	616
D	4/86	08.06.87	1988, 26	933
D	5/86	29.02.88	1989, 210	564, 942
D	3/89	05.03.89	1991, 257	938
D	5/89	22.05.89	1991, 218	938
D	11/91	14.09.94	1995, 721	942, 944
D	1/92	30.07.92	1993, 357	939, 940
D	6/92	13.05.92	1993, 361	939
D	14/93	05.06.96	1997, 561	572, 576, 933
D	1/94	17.05.95	1996, 468	934
D	5/94	15.11.95		936, 940
D	2/95	22.04.96		934
D	14/95	19.12.95		934, 935
D	15/95	09.06.97	1998, 297	943
D	16/95	29.03.98		943
D	9/96	09.03.98		935
D	14/96	21.01.97		938
D	17/96	03.12.96		941
D	20/96	22.07.98		939
D	25/96	17.03.97	1998, 45	933
D	2/97	16.03.98		941
D	5/97	08.12.98		935
D	10/97	08.12.98		935
D	12/97	25.06.98		937
D	15/97	08.12.98		935, 939
D	17/97	08.12.98		935
D	28/97	04.09.98		943
D	1/98	21.07.98		943
D	3/98	05.11.01		941
D	6/98	20.04.99		936, 939, 940
D	2/99	07.09.00		941
D	3/99	29.09.00		941

D	4/99	29.06.00		936, 940
D	6/99	06.07.01		936
D	11/99	17.11.99		938
D	20/99	06.03.01	2002, 19	943
D	24/99	14.05.01		943
D	3/00	03.05.02	2003, 365	940, 941
D	9/00	12.12.00		939
D	11/00	09.05.01		934
D	12/00	27.03.02		940
D	7/01	07.11.02		939
D	11/01	04.07.02		939
D	6/02	02.10.02		939
D	10/02	11.11.02	2003, 275	936
D	13/02	11.11.02		939, 940
D	16/02	16.07.03		939
D	3/03	23.04.04		937
D	3/04	05.07.05		936
D	6/04	30.08.04		939
D	8/04	23.08.04		933
D	15/04	14.02.05		933
D	16/04	18.02.05		933
D	17/04	11.02.05		933
D	18/04	28.01.05		933
D	19/04	28.02.05		934
D	7/05	17.07.06	2007, 378	937-939, 941
D	7/05	02.01.07		944
D	17/05	19.07.05		940
D	25/05	15.11.06		943, 944
D	38/05	17.01.07		939
D	2/06	31.08.06		944
D	4/06	29.11.06		939
D	6/07	28.08.08		940
D	7/07	17.09.08		940
D	11/07	14.05.09		937
D	4/08	18.12.08		932
D	5/08	15.01.09		933
D	6/08	30.12.08		933
D	7/08	02.02.09		932
D	10/08	15.01.09		933
D	12/08	02.02.09		932
D	14/08	23.07.09		939
D	23/08	03.06.09		937, 939
D	15/09	19.02.10		932

Decisions and opinions of the Enlarged Board of Appeal on referrals

G	1/83	05.12.84	1985, 60	50, 139, 140
G	5/83	05.12.84	1985, 64	50, 54, 55, 134, 136-141, 143-153, 155, 156, 160, 228, 363, 506, 638, 879
G	6/83	05.12.84	1985, 67	50, 139, 140
G	1/84	24.07.85	1985, 299	436, 437, 763, 766, 767, 801, 805
G	1/86	24.06.87	1987, 447	492, 493, 509, 822, 826, 827, 870
G	1/88	27.01.89	1990, 469	542, 679, 813, 820, 845-847
G	2/88	11.12.89	1990, 93	3, 12, 99, 104, 116, 150, 153-160, 251, 289, 356, 357, 361, 363
G	4/88	24.04.89	1989, 480	728-731, 734, 735
G	5/88	16.11.90	1991, 137	425, 436, 857, 951
G	6/88	11.12.89	1990, 114	150, 153, 156-158, 160
G	7/88	16.11.90	1991, 137	425, 951
G	8/88	16.11.90	1991, 137	425, 951
G	1/89	02.05.90	1991, 155	297, 299, 302, 303, 308, 309, 313
G	2/89	02.05.90	1991, 166	297, 299, 302, 303
G	3/89	19.11.92	1993, 117	370, 373, 545, 648
G	1/90	05.03.91	1991, 275	496, 739, 819, 841
G	2/90	04.08.91	1992, 10	842
G	1/91	09.12.91	1992, 253	172, 273, 301, 669, 803, 804
G	2/91	29.11.91	1992, 206	822, 826, 827, 874
G	3/91	07.09.92	1993, 8	436, 483, 504, 505, 948
G	4/91	03.11.92	1993, 707	689, 720, 721
G	5/91	05.05.92	1992, 617	594, 597, 598, 840
G	6/91	06.03.92	1992, 491	625-628, 853
G	7/91	05.11.92	1993, 478	726, 764, 822, 873, 874
G	8/91	05.11.92	1993, 346	726, 764, 822, 873, 874

G	9/91	31.03.93	1993, 408	90, 539, 544, 565, 607, 608, 610, 703, 704, 710, 724-726, 764, 779, 785-788, 793, 794, 796, 801, 807, 809, 822, 826-828, 830, 832, 834, 835, 837, 858, 864, 866, 889, 892, 903, 905
G	10/91	31.03.93	1993, 420	703, 726, 742, 764, 779, 785, 786, 788-796, 815, 822, 827, 828, 830, 835, 837, 858, 864, 885, 889, 903, 915
G	11/91	19.11.92	1993, 125	315, 370, 545, 648
G	12/91	17.12.93	1994, 285	603, 604, 689, 692, 698, 729, 874, 883, 887
G	1/92	18.12.92	1993, 277	69, 71, 75, 99, 100, 103, 104
G	2/92	06.07.93	1993, 591	312, 313, 668, 669, 696
G	3/92	13.06.94	1994, 607	388, 634, 644
G	4/92	29.10.93	1994, 149	444, 447-450, 716, 750
G	5/92	27.09.93	1994, 22	504
G	6/92	27.09.93	1994, 25	504
G	8/92	05.03.93		878, 881
G	9/92	14.07.94	1994, 875	437, 787, 799, 819, 822, 826-831, 905
G	10/92	28.04.94	1994, 633	389, 390, 435, 538, 690
G	1/93	02.02.94	1994, 541	327-331, 355, 357, 366-369, 382
G	2/93	21.12.94	1995, 275	243, 245
G	3/93	16.08.94	1995, 18	397, 401, 420, 421
G	4/93	14.07.94	1995, 875	437, 787, 799, 822, 826, 828-831, 905
G	5/93	18.01.94	1994, 447	436, 504
G	7/93	13.05.94	1994, 775	358, 455, 470, 623, 665, 686, 688, 689, 691, 692, 728, 798, 838, 886
G	8/93	13.06.94	1994, 887	718, 822, 836
G	9/93	06.07.94	1994, 891	436, 437, 766, 767

G	10/93	30.11.94	1995, 172	681, 690, 835
G	1/94	11.05.94	1994, 787	721, 821
G	2/94	19.02.96	1996, 401	584, 585, 588, 925
G	1/95	19.07.96	1996, 615	3, 774, 782, 789, 790, 792, 917
G	2/95	14.05.96	1996, 555	315, 371, 649
G	4/95	19.02.96	1996, 412	584-590, 886
G	6/95	24.07.96	1996, 649	469, 472, 885, 952
G	7/95	19.07.96	1996, 626	789-791, 815, 885
G	8/95	16.04.96	1996, 481	618-621, 843
G	1/97	10.12.99	2000, 322	619, 841, 944
G	2/97	12.11.98	1999, 123	425, 428, 430, 433
G	3/97	21.01.99	1999, 245	562, 730, 765-767, 771
G	4/97	21.01.99	1999, 270	562, 765-767
G	1/98	20.12.99	2000, 111	36, 37, 41-44, 48, 54, 639
G	2/98	31.05.01	2001, 413	383, 397, 400-402, 404, 407, 410-413, 418, 422, 423
G	3/98	12.07.00	2001, 62	69, 639
G	4/98	27.11.00	2001, 131	391, 393, 394, 653
G	1/99	02.04.01	2001, 381	822, 829-832, 874, 905
G	2/99	12.07.00	2001, 83	69, 639
G	3/99	18.02.02	2002, 347	538, 578, 769-771, 844, 878
G	1/02	22.01.03	2003, 165	784
G	2/02	26.04.04	2004, 483	397, 640
G	3/02	26.04.04	2004, 483	397, 640
G	1/03	08.04.04	2004, 413	54, 208, 262-265, 319, 331-338, 341, 368, 402, 436
G	2/03	08.04.04	2004, 448	54, 208, 262-265, 331, 332, 337, 338, 402
G	3/03	28.01.05	2005, 344	842, 877, 928
G	1/04	16.12.05	2006, 334	8, 36, 37, 50-53, 60-63, 258
G	2/04	25.05.05	2005, 549	733-735
G	3/04	22.08.05	2006, 118	720, 721, 908
G	1/05	07.12.06	2007, 362	594, 601, 602
G	1/05	28.06.07	2008, 271	375-379, 381, 384, 386, 387, 679
G	1/06	28.06.07	2008, 307	376, 378-381, 384, 386
G	2/06	25.11.08	2009, 306	42

G	3/06	terminated	377
G	1/07	15.02.10	2011, *** 50-55, 57, 59, 61, 338, 639
G	2/07	pending	46
G	1/08	pending	46
G	2/08	15.06.09	2010, *** 602
G	2/08	19.02.10	2010, *** 137, 138, 143, 145, 149, 151, 156, 437
G	3/08	16.10.09	603, 879
G	3/08	12.05.10	2011, *** XXXVII, 17, 20, 23, 24, 189
G	4/08	16.02.10	2010, *** 950
G	1/09	pending	388

Decisions of the Legal Board of Appeal

J	1/78 - 3.1.01	02.03.79	1979, 285	572
J	5/79 - 3.1.01	17.01.80	1980, 71	529, 631, 845
J	6/79 - 3.1.01	13.06.80	1980, 225	912
J	1/80 - 3.1.01	17.07.80	1980, 289	492, 532, 654
J	3/80 - 3.1.01	31.01.80	1980, 92	493
J	5/80 - 3.1.01	07.07.81	1981, 343	517, 524
J	7/80 - 3.1.01	11.03.81	1981, 137	626, 651
J	8/80 - 3.1.01	18.07.80	1980, 293	651, 655, 656
J	11/80 - 3.1.01	25.03.81	1981, 141	693, 696, 875
J	12/80 - 3.1.01	26.03.81	1981, 143	655
J	15/80 - 3.1.01	11.06.81	1981, 213	397, 398
J	19/80 - 3.1.01	03.02.81	1981, 65	648
J	21/80 - 3.1.01	26.02.81	1981, 101	908
J	3/81 - 3.1.01	07.12.81	1982, 100	653, 655
J	5/81 - 3.1.01	09.12.81	1982, 155	65, 629, 658, 880, 923
J	7/81 - 3.1.01	21.12.81		484
J	8/81 - 3.1.01	30.11.81	1982, 10	605, 839
J	10/81 - 3.1.01	05.05.82		573
J	1/82 - 3.1.01	07.04.82	1982, 293	649
J	3/82 - 3.1.01	16.02.83	1983, 171	655
J	4/82 - 3.1.01	21.07.82	1982, 385	655, 656
J	7/82 - 3.1.01	23.07.82	1982, 391	438, 497, 499, 532, 615, 908, 914
J	8/82 - 3.1.01	08.11.83	1984, 155	638, 643, 650
J	9/82 - 3.1.01	26.11.82	1983, 57	478
J	10/82 - 3.1.01	21.12.82	1983, 94	925
J	12/82 - 3.1.01	11.03.83	1983, 221	504, 659
J	14/82 - 3.1.01	19.01.83	1983, 121	655, 656, 914
J	16/82 - 3.1.01	02.03.83	1983, 262	524, 527, 908

Table of cases

J 18/82 - 3.1.01	18.05.83	1983, 441	504	J 2/87 - 3.1.01	20.07.87	1988, 330	425, 500, 859
J 19/82 - 3.1.01	28.07.83	1984, 6	873	J 3/87 - 3.1.01	02.12.87	1989, 3	425, 926
J 23/82 - 3.1.01	28.01.83	1983, 127	535	J 4/87 - 3.1.01	02.06.87	1988, 172	480, 622, 647
J 24/82 - 3.1.01	03.08.84	1984, 467	696	J 5/87 - 3.1.01	06.03.87	1987, 295	291, 292
J 25/82 - 3.1.01	03.08.84	1984, 467	696	J 7/87 - 3.1.01	28.10.87	1988, 422	693, 875
J 26/82 - 3.1.01	03.08.84	1984, 467	696	J 8/87 - 3.1.01	30.11.87	1989, 19	245
J 3/83 - 3.1.01	02.11.83		491	J 10/87 - 3.1.01	11.02.88	1989, 323	693, 694
J 7/83 - 3.1.01	02.12.83	1984, 211	489, 912	J 11/87 - 3.1.01	26.11.87	1988, 367	693, 875
J 8/83 - 3.1.01	13.02.85	1985, 102	660, 661	J 14/87 - 3.1.01	20.05.87	1988, 295	699
J 9/83 - 3.1.01	13.02.85		660, 661	J 19/87 - 3.1.01	21.03.88		398
J 12/83 - 3.1.01	09.11.84	1985, 6	682, 845	J 20/87 - 3.1.01	30.07.87	1989, 67	454, 622
J 13/83 - 3.1.01	03.12.84		840	J 23/87 - 3.1.01	09.11.87		510, 518
J 9/84 - 3.1.01	30.04.85	1985, 233	291	J 26/87 - 3.1.01	25.03.88	1989, 329	839, 947, 949
J 10/84 - 3.1.01	29.11.84	1985, 71	425, 660	J 27/87 - 3.1.01	03.03.88		629
J 12/84 - 3.1.01	25.01.85	1985, 108	434, 525	J 3/88 - 3.1.01	19.07.88		521, 523, 525
J 13/84 - 3.1.01	16.11.84	1985, 34	695	J 4/88 - 3.1.01	23.09.88	1989, 483	628
J 18/84 - 3.1.01	31.07.86	1987, 215	909	J 11/88 - 3.1.01	30.08.88	1989, 433	481, 545
J 19/84 - 3.1.01	12.11.84	1991, 473	451	J 12/88 - 3.1.01	07.11.88		579
J 21/84 - 3.1.01	29.11.85	1986, 75	653, 655	J 13/88 - 3.1.01	23.09.88		478
J 4/85 - 3.1.01	28.02.86	1986, 205	370, 650, 651, 836	J 15/88 - 3.1.01	20.07.89	1990, 445	292, 696
J 11/85 - 3.1.01	23.10.85	1986, 1	536	J 16/88 - 3.1.01	18.08.89		292
J 12/85 - 3.1.01	07.02.86	1986, 155	621, 839, 840, 845	J 22/88 - 3.1.01	28.04.89	1990, 244	508
J 13/85 - 3.1.01	25.08.86		375	J 23/88 - 3.1.01	25.04.89		485, 488
J 15/85 - 3.1.01	10.07.86	1986, 395	695, 806	J 25/88 - 3.1.01	31.10.88	1989, 486	394
J 20/85 - 3.1.01	14.05.86	1987, 102	438, 549, 571, 826	J 27/88 - 3.1.01	05.07.89		496, 497, 510
J 21/85 - 3.1.01	29.01.86	1986, 117	649	J 29/88 - 3.1.01	18.08.89		292
J 22/85 - 3.1.01	23.07.86	1987, 455	911	J 1/89 - 3.1.01	01.02.90	1992, 17	425, 434
J 2/86 - 3.1.01	21.10.86	1987, 362	508, 510, 512	J 5/89 - 3.1.01	09.06.89		426
J 3/86 - 3.1.01	21.10.86	1987, 362	510, 512	J 9/89 - 3.1.01	11.10.89		508
J 6/86 - 3.1.01	28.01.87	1988, 124	693	J 11/89 - 3.1.01	26.10.89		431, 655, 656
J 9/86 - 3.1.01	17.03.87		494, 496, 497, 510, 514, 516	J 17/89 - 3.1.01	09.01.90		496
J 11/86 - 3.1.01	06.08.86		503, 504	J 19/89 - 3.1.01	02.08.90	1991, 425	573, 575, 576
J 12/86 - 3.1.01	06.02.87	1988, 83	874, 909	J 20/89 - 3.1.01	27.11.89	1991, 375	945
J 14/86 - 3.1.01	28.04.87	1988, 85	478	J 25/89 - 3.1.01	19.03.90		292
J 15/86 - 3.1.01	09.10.87	1988, 417	693	J 26/89 - 3.1.01	19.03.90		292
J 16/86 - 3.1.01	01.12.86		500	J 27/89 - 3.1.01	19.03.90		292
J 18/86 - 3.1.01	27.04.87	1988, 165	647	J 28/89 - 3.1.01	19.03.90		292
J 22/86 - 3.1.01	07.02.87	1987, 280	494, 856	J 31/89 - 3.1.01	31.10.89		508, 521
J 25/86 - 3.1.01	14.11.86	1987, 475	539, 651	J 33/89 - 3.1.01	11.12.89	1991, 288	650
J 28/86 - 3.1.01	13.04.87	1988, 85	538, 574	J 34/89 - 3.1.01	30.01.90		292
J 29/86 - 3.1.01	12.06.87	1988, 84	496, 497, 590	J 37/89 - 3.1.01	24.07.91	1993, 201	485, 909
J 32/86 - 3.1.01	16.02.87		574	J 39/89 - 3.1.01	22.05.91		635
J 34/86 - 3.1.01	15.03.88		387	J 42/89 - 3.1.01	30.10.91		521
				J 3/90 - 3.1.01	30.04.90	1991, 550	438, 481, 826
				J 6/90 - 3.1.01	22.10.92	1993, 714	500
				J 7/90 - 3.1.01	07.08.91	1993, 133	491, 655, 657, 881

J 9/90 - 3.1.01 08.04.92	489, 530	J 34/92 - 3.1.01 23.08.94	434, 500, 503, 590
J 13/90 - 3.1.01 10.12.92 1994, 456	430-432, 503, 511, 520	J 35/92 - 3.1.01 17.03.94	577
J 15/90 - 3.1.01 28.11.94	432, 881	J 36/92 - 3.1.01 20.05.94	390
J 16/90 - 3.1.01 06.03.91 1992, 260	881	J 38/92 - 3.1.01 16.03.95	632, 633, 761
J 18/90 - 3.1.01 22.03.91 1992, 511	824	J 39/92 - 3.1.01 16.03.95	632, 633
J 19/90 - 3.1.01 30.04.92	854	J 41/92 - 3.1.01 27.10.93 1995, 93	430, 503, 512, 515
J 27/90 - 3.1.01 11.07.91 1993, 422	496-498, 520	J 42/92 - 3.1.01 28.02.97	370, 625, 699, 843
J 31/90 - 3.1.01 10.07.92	512, 514, 526	J 43/92 - 3.1.01 28.11.95	591, 605
J 32/90 - 3.1.01 10.07.92	512	J 44/92 - 3.1.01 29.11.96	531
J 33/90 - 3.1.01 10.07.92	514, 521, 524	J 47/92 - 3.1.01 21.10.93 1995, 180	485, 879
J 1/91 - 3.1.01 25.08.94 1993, 281	644	J 48/92 - 3.1.01 29.11.96	531
J 3/91 - 3.1.01 01.12.92 1994, 365	651, 655, 656, 927	J 49/92 - 3.1.01 29.05.95	486, 536
J 4/91 - 3.1.01 22.10.91 1992, 402	482, 639	J 1/93 - 3.1.01 17.05.94	481
J 5/91 - 3.1.01 29.04.92 1993, 657	483	J 2/93 - 3.1.01 07.02.94 1995, 675	840
J 6/91 - 3.1.01 01.12.92 1994, 349	655-657	J 3/93 - 3.1.01 22.02.94	517
J 9/91 - 3.1.01 01.12.92	655	J 7/93 - 3.1.01 23.08.93	532, 947
J 10/91 - 3.1.01 11.12.92	567	J 8/93 - 3.1.01 19.03.97	567
J 11/91 - 3.1.01 05.08.92 1994, 28	435, 436	J 9/93 - 3.1.01 26.04.95	436
J 14/91 - 3.1.01 06.11.91 1993, 479	467, 629, 881	J 10/93 - 3.1.01 14.06.96 1997, 91	494, 632
J 17/91 - 3.1.01 17.09.92 1994, 225	631	J 11/93 - 3.1.01 06.02.96	580
J 19/91 - 3.1.01 17.09.92	631	J 16/93 - 3.1.01 20.06.95	497, 498, 517, 519
J 1/92 - 3.1.01 15.07.92	843	J 18/93 - 3.1.01 02.09.94 1997, 326	651
J 2/92 - 3.1.01 01.12.92 1994, 375	651, 655, 656	J 19/93 - 3.1.01 15.12.97	949
J 7/92 - 3.1.01 17.02.94	590	J 2/94 - 3.1.01 21.06.95	433
J 11/92 - 3.1.01 12.01.94 1995, 25	657	J 3/94 - 3.1.01 28.03.95	948
J 12/92 - 3.1.01 30.04.93	504	J 4/94 - 3.1.01 24.03.95	949
J 13/92 - 3.1.01 18.10.93	839	J 5/94 - 3.1.01 28.09.94	496, 507, 512, 515, 518
J 15/92 - 3.1.01 25.05.93	426	J 7/94 - 3.1.01 18.01.95 1995, 817	657
J 16/92 - 3.1.01 25.04.94	485, 520	J 8/94 - 3.1.01 07.12.95 1997, 17	504
J 17/92 - 3.1.01 22.11.96	697, 926	J 9/94 - 3.1.01 18.01.96	489
J 18/92 - 3.1.01 18.12.92	573	J 10/94 - 3.1.01 18.01.96	489
J 19/92 - 3.1.01 11.10.93	635	J 11/94 - 3.1.01 17.11.94 1995, 596	538, 583, 584, 588, 682
J 21/92 - 3.1.01 16.03.95	511	J 12/94 - 3.1.01 16.02.96	433, 503
J 22/92 - 3.1.01 13.12.94	499, 517, 531	J 13/94 - 3.1.01 04.10.96	682, 683
J 23/92 - 3.1.01 17.12.93	512	J 14/94 - 3.1.01 15.12.94 1995, 825	434, 590
J 24/92 - 3.1.01 16.03.95	511	J 16/94 - 3.1.01 10.06.96 1997, 331	538, 851
J 25/92 - 3.1.01 29.09.93	427, 659	J 21/94 - 3.1.01 12.04.95 1996, 16	649
J 26/92 - 3.1.01 23.08.94	516, 524, 526	J 22/94 - 3.1.01 19.06.95	635
J 27/92 - 3.1.01 20.05.94 1995, 288	434, 435, 537	J 25/94 - 3.1.01 14.03.96	504
J 28/92 - 3.1.01 11.05.94	510, 522		
J 30/92 - 3.1.01 18.12.92	573		
J 31/92 - 3.1.01 18.12.92	573		
J 32/92 - 3.1.01 18.12.92	573		
J 33/92 - 3.1.01 18.12.92	573		

Table of cases

J	27/94 - 3.1.01	27.02.95	1995, 831	390, 426, 427, 435, 538, 682, 683, 871	J	17/97 - 3.1.01	14.02.02	394, 652
J	28/94 - 3.1.01	07.12.94	1995, 742	633, 822, 825, 862	J	18/97 - 3.1.01	14.02.02	394, 652
J	29/94 - 3.1.01	10.03.97	1998, 147	504, 658, 678, 823	J	22/97 - 3.1.01	10.11.99	497
J	30/94 - 3.1.01	09.10.95		621, 843, 909, 910	J	27/97 - 3.1.01	26.10.98	637
J	8/95 - 3.1.01	04.11.96		502, 641	J	29/97 - 3.1.01	14.06.99	429
J	11/95 - 3.1.01	27.11.97		629	J	32/97 - 3.1.01	20.07.98	637, 926, 927
J	12/95 - 3.1.01	20.03.96		538	J	35/97 - 3.1.01	07.06.00	636
J	14/95 - 3.1.01	20.08.97		426	J	36/97 - 3.1.01	25.05.99	633, 634
J	15/95 - 3.1.01	20.08.97		426	J	38/97 - 3.1.01	22.06.99	425, 840, 909, 910
J	16/95 - 3.1.01	20.08.97		426	J	2/98 - 3.1.01	27.11.02	487
J	17/95 - 3.1.01	20.08.97		426	J	3/98 - 3.1.01	25.09.00	842
J	22/95 - 3.1.01	04.07.97	1998, 569	393, 653	J	5/98 - 3.1.01	07.04.00	483
J	24/95 - 3.1.01	20.08.97		426	J	6/98 - 3.1.01	17.10.00	500
J	25/95 - 3.1.01	20.08.97		426, 435	J	11/98 - 3.1.01	15.06.00	489, 508
J	26/95 - 3.1.01	13.10.98	1999, 668	489, 500, 502, 632, 736	J	12/98 - 3.1.01	08.10.02	500
J	27/95 - 3.1.01	09.04.97		576, 577	J	13/98 - 3.1.01	06.04.01	536
J	29/95 - 3.1.01	30.01.96	1996, 489	682, 683	J	15/98 - 3.1.01	31.10.00	2001, 183 626, 646
J	32/95 - 3.1.01	24.03.99	1999, 713	845, 876, 877, 907, 928	J	16/98 - 3.1.01	20.12.00	842
J	33/95 - 3.1.01	18.12.95		633, 825	J	17/98 - 3.1.01	20.9.99	2000, 399 428, 581, 635
J	4/96 - 3.1.01	15.04.97		430	J	18/98 - 3.1.01	16.01.04	501, 507, 524
J	7/96 - 3.1.01	20.01.98	1999, 443	390, 633, 698, 699	J	21/98 - 3.1.01	25.10.99	2000, 406 627, 658, 913
J	8/96 - 3.1.01	20.01.98		634	J	22/98 - 3.1.01	25.10.99	627, 913
J	9/96 - 3.1.01	21.11.97		637	J	4/99 - 3.1.01	21.03.02	388
J	10/96 - 3.1.01	15.07.98		577	J	5/99 - 3.1.01	06.04.00	487
J	16/96 - 3.1.01	14.07.97	1998, 347	583, 641	J	6/99 - 3.1.01	25.10.99	627, 913
J	17/96 - 3.1.01	03.12.96		651	J	7/99 - 3.1.01	17.05.00	487, 497
J	18/96 - 3.1.01	01.10.97	1998, 403	426, 645, 646, 911	J	9/99 - 3.1.01	10.10.03	2004, 309 580
J	19/96 - 3.1.01	23.04.99		394, 535	J	10/99 - 3.1.01	20.12.99	499
J	20/96 - 3.1.01	28.09.98		927	J	14/99 - 3.1.01	25.10.99	627, 913
J	21/96 - 3.1.01	06.05.98		388, 491	J	15/99 - 3.1.01	25.10.99	627, 913
J	23/96 - 3.1.01	28.08.97		494	J	16/99 - 3.1.01	03.09.01	621
J	24/96 - 3.1.01	27.04.01	2001, 434	300, 923	J	17/99 - 3.1.01	04.07.00	653
J	25/96 - 3.1.01	11.04.00		523, 527	J	18/99 - 3.1.01	01.10.02	575, 576
J	27/96 - 3.1.01	16.12.98		653	J	20/99 - 3.1.01	08.05.00	606
J	29/96 - 3.1.01	03.09.97	1998, 582	390	J	3/00 - 3.1.01	20.12.01	431
J	31/96 - 3.1.01	25.11.97		651	J	4/00 - 3.1.01	21.03.02	659
J	4/97 - 3.1.01	09.07.97		693	J	6/00 - 3.1.01	22.11.02	538
J	7/97 - 3.1.01	11.12.97		433, 647	J	7/00 - 3.1.01	12.07.02	634, 845
					J	8/00 - 3.1.01	13.03.02	437
					J	12/00 - 3.1.01	24.01.02	632
					J	14/00 - 3.1.01	10.05.01	2002, 432 953
					J	20/00 - 3.1.01	24.09.01	483
					J	2/01 - 3.1.01	04.02.04	2005, 88 386, 387, 638
					J	3/01 - 3.1.01	17.06.02	654
					J	5/01 - 3.1.01	28.11.01	643, 650
					J	9/01 - 3.1.01	19.11.01	626

J	10/01 - 3.1.01	15.10.02		388, 390, 491	J	17/04 - 3.1.01	09.04.05		427, 846, 926, 927
J	12/01 - 3.1.01	26.03.03	2003, 431	928	J	18/04 - 3.1.01	04.05.05	2006, 560	388, 492
J	15/01 - 3.1.01	15.11.01		909	J	19/04 - 3.1.01	14.07.05		497, 519
J	18/01 - 3.1.01	02.05.02		628	J	1/05 - 3.1.01	30.09.05		394
J	25/01 - 3.1.01	13.02.03		654	J	2/05 - 3.1.01	01.03.05		839, 954
J	27/01 - 3.1.01	11.03.04		496, 497, 518	J	6/05 - 3.1.01	17.10.05		626
J	2/02 - 3.1.01	09.07.02		509, 510, 518	J	9/05 - 3.1.01	21.12.06		563, 923
J	4/02 - 3.1.01	28.10.05		491	J	13/05 - 3.1.01	03.08.06		480, 481, 647
J	5/02 - 3.1.01	30.07.02		429	J	18/05 - 3.1.01	21.12.06		563, 923
J	6/02 - 3.1.01	13.05.04		657, 699	J	19/05 - 3.1.01	24.11.06		501, 502
J	10/02 - 3.1.01	22.02.05		633-635	J	20/05 - 3.1.01	06.09.07		387
J	13/02 - 3.1.01	26.06.03		650	J	3/06 - 3.1.01	17.12.07	2009, 170	648
J	15/02 - 3.1.01	24.11.03		483	J	7/06 - 3.1.01	26.04.07		694
J	16/02 - 3.1.01	10.02.04		914	J	9/06 - 3.1.01	24.11.07		634
J	1/03 - 3.1.01	06.10.04		505, 521	J	11/06 - 3.1.01	18.04.07		511, 520
J	4/03 - 3.1.01	09.09.04		465, 467, 538, 694	J	15/06 - 3.1.01	30.11.07		633
J	6/03 - 3.1.01	29.09.04		634	J	18/06 - 3.1.01	30.11.07		633
J	11/03 - 3.1.01	14.04.05		497, 499, 515	J	1/07 - 3.1.01	25.07.07		510, 516, 520, 528
J	12/03 - 3.1.01	26.09.05		631	J	4/07 - 3.1.01	07.07.08		511, 520, 523
J	13/03 - 3.1.01	23.02.04		425, 505	J	5/07 - 3.1.01	26.02.08		391, 679
J	14/03 - 3.1.01	20.08.04		481	J	6/07 - 3.1.01	10.12.07		518
J	17/03 - 3.1.01	18.06.04		454, 517	J	7/07 - 3.1.01	12.12.07		479, 533
J	18/03 - 3.1.01	03.09.04		496	J	8/07 - 3.1.01	08.12.08	2009, 216	949
J	19/03 - 3.1.01	11.03.05		694	J	9/07 - 3.1.01	30.06.08		397, 503, 642
J	22/03 - 3.1.01	22.06.04		646	J	10/07 - 3.1.01	31.03.08	2008, 567	838, 839, 908, 926
J	23/03 - 3.1.01	13.07.04		370, 699	J	12/07 - 3.1.01	15.04.08		479
J	24/03 - 3.1.01	17.02.04	2004, 544	388, 491	J	13/07 - 3.1.01	10.07.08		516
J	25/03 - 3.1.01	27.04.05	2006, 395	631, 694	J	14/07 - 3.1.01	02.04.09		537
J	28/03 - 3.1.01	04.10.04	2005, 597	390, 823	J	2/08 - 3.1.01	27.05.09	2010, 100	388, 389, 431
J	33/03 - 3.1.01	16.11.04		635	J	3/08 - 3.1.01	02.10.08		524
J	35/03 - 3.1.01	04.05.04		500	J	5/08 - 3.1.01	09.07.09		389
J	36/03 - 3.1.01	22.02.05		627	J	6/08 - 3.1.01	27.05.09		427, 500
J	37/03 - 3.1.01	15.03.06		694	J	16/08 - 3.1.01	31.08.09		657
J	38/03 - 3.1.01	15.03.06		694	J	1/09 - 3.1.01	06.10.09		537
J	40/03 - 3.1.01	18.08.04		393	J	4/09 - 3.1.01	28.07.09		911
J	1/04 - 3.1.01	20.12.06		571, 581	Decisions of the Enlarged Board of Appeal on petitions for review				
J	3/04 - 3.1.01	20.09.05		492					
J	5/04 - 3.1.01	29.11.05		504, 636					
J	7/04 - 3.1.01	09.11.04		390					
J	9/04 - 3.1.01	01.03.05		839, 954					
J	10/04 - 3.1.01	05.07.04		557	R	1/08	15.07.08		882, 883, 885, 887
J	13/04 - 3.1.01	23.12.04		478, 647	R	2/08	11.09.08		882, 883, 885
J	14/04 - 3.1.01	17.03.05		631, 694	R	3/08	25.09.08		588, 883, 885, 886
J	15/04 - 3.1.01	30.05.06		601	R	4/08	20.03.09		883-885
J	16/04 - 3.1.01	28.04.05		438	R	5/08	05.02.09		883, 884

Table of cases

R	7/08	22.06.09	884
R	8/08	19.05.09	475, 884
R	9/08	21.01.09	883, 885, 886
R	10/08	13.03.09	883, 885-887
R	11/08	06.04.09	885, 888
R	3/09	03.04.09	885, 886
R	6/09	03.06.09	884, 885
R	7/09	22.07.09	885, 887
R	8/09	23.09.09	883, 887
R	12/09	03.12.09	882
R	13/09	22.10.09	883, 885, 887
R	14/09	22.12.09	475

Decisions of the technical boards of appeal

1980

T	1/80 - 3.3.01	06.04.81	1981, 206	163, 170, 202
T	2/80 - 3.3.01	05.06.81	1981, 431	252, 286
T	4/80 - 3.3.01	07.09.81	1982, 149	252, 263, 337
T	6/80 - 3.3.02	13.05.81	1981, 434	97

1981

T	1/81 - 3.2.02	04.05.81	1981, 439	211
T	2/81 - 3.3.01	01.07.82	1982, 394	350, 564
T	5/81 - 3.2.02	04.03.82	1982, 249	170, 176, 663, 679, 840, 913
T	6/81 - 3.2.02	17.09.81	1982, 183	275
T	7/81 - 3.3.01	14.12.82	1983, 98	851
T	9/81 - 3.3.01	25.01.83	1983, 372	135
T	12/81 - 3.3.01	09.02.82	1982, 296	64, 101, 102, 111, 118-121, 127, 128, 904
T	15/81 - 3.4.01	28.07.81	1982, 2	205
T	18/81 - 3.3.01	01.03.85	1985, 166	439, 826, 914
T	19/81 - 3.2.02	29.07.81	1982, 51	214
T	20/81 - 3.3.01	10.02.82	1982, 217	163, 170, 171, 221
T	21/81 - 3.5.01	10.09.82	1983, 15	200, 219
T	24/81 - 3.3.01	13.10.82	1983, 133	163, 164, 170, 176, 202, 213, 215
T	26/81 - 3.2.02	28.10.81	1982, 211	170

T	28/81 - 3.3.01	11.06.85	863	
T	32/81 - 3.2.01	05.03.82	1982, 225	181, 198, 851

1982

T	10/82 - 3.3.01	15.03.83	1983, 407	742, 754, 768, 841
T	11/82 - 3.5.01	15.04.83	1983, 479	345, 346, 680
T	13/82 - 3.5.01	03.03.83	1983, 411	501, 558, 909
T	21/82 - 3.2.01	30.11.83		874
T	22/82 - 3.3.01	22.06.82	1982, 341	204
T	32/82 - 3.5.01	14.03.84	1984, 354	248, 257, 258, 451, 684
T	36/82 - 3.5.01	25.10.82	1983, 269	208, 209
T	37/82 - 3.5.01	29.07.83	1984, 71	199, 346
T	39/82 - 3.2.02	30.07.82	1982, 419	206, 207
T	41/82 - 3.3.01	30.03.82	1982, 256	874, 908
T	43/82 - 3.3.01	16.04.04		134
T	52/82 - 3.2.01	18.03.83	1983, 416	345
T	53/82 - 3.3.01	28.06.82		350
T	54/82 - 3.3.01	16.05.83	1983, 446	318
T	57/82 - 3.3.01	29.04.82	1982, 306	295
T	60/82 - 3.2.01	25.10.83		214
T	62/82 - 3.4.01	23.06.83		215
T	65/82 - 3.3.01	20.04.83	1983, 327	204, 205, 210
T	79/82 - 3.5.01	06.10.83		216
T	84/82 - 3.3.01	18.03.83	1983, 451	661, 662
T	94/82 - 3.2.01	22.07.83	1984, 75	245, 252, 255
T	109/82 - 3.5.01	15.05.84	1984, 473	205, 217
T	110/82 - 3.3.01	08.03.83	1983, 274	295
T	113/82 - 3.2.01	22.06.83	1984, 10	219
T	114/82 - 3.3.01	01.03.83	1983, 323	845, 925
T	115/82 - 3.3.01	01.03.83	1983, 323	845
T	119/82 - 3.3.01	12.12.83	1984, 217	157, 199, 200, 210, 214, 305
T	123/82 - 3.3.01	30.08.85		64
T	128/82 - 3.3.01	12.01.84	1984, 164	134, 639
T	130/82 - 3.2.01	26.08.83	1984, 172	536
T	146/82 - 3.5.01	29.05.85	1985, 267	633-635
T	150/82 - 3.3.01	07.02.84	1984, 309	256, 257, 288, 290
T	152/82 - 3.3.01	05.09.83	1984, 301	534, 862
T	161/82 - 3.5.01	26.06.84	1984, 551	106, 107, 661, 664, 811
T	162/82 - 3.5.01	20.06.87	1987, 533	274, 623, 661, 923
T	172/82 - 3.4.01	19.05.83	1983, 493	343

T 181/82 - 3.3.01	28.02.84	1984, 401	121, 122, 124, 127, 162, 171, 219, 221, 880
T 184/82 - 3.3.01	04.01.84	1984, 261	172, 173
T 191/82 - 3.2.01	16.04.85	1985, 189	496, 497, 499, 524, 525
T 192/82 - 3.3.01	22.03.84	1984, 415	200, 220

1983

T 2/83 - 3.3.01	15.03.84	1984, 265	170, 177, 197, 205, 210, 305
T 4/83 - 3.3.01	16.03.83	1983, 498	111, 207
T 6/83 - 3.5.01	06.10.88	1990, 5	24
T 13/83 - 3.3.01	13.04.84	1984, 428	342
T 14/83 - 3.3.01	07.06.83	1984, 105	229, 236
T 17/83 - 3.3.01	20.09.83	1984, 307	534
T 20/83 - 3.3.01	17.03.83	1983, 419	220, 664
T 36/83 - 3.3.01	14.05.85	1986, 295	59, 134, 160, 223
T 43/83 - 3.5.01	11.12.85		665
T 49/83 - 3.3.01	26.07.83	1984, 112	37, 43
T 66/83 - 3.5.01	06.06.89		663
T 69/83 - 3.3.01	05.04.84	1984, 357	215, 219
T 84/83 - 3.2.01	29.09.83		74
T 95/83 - 3.2.01	09.10.84	1985, 75	888, 890
T 104/83 - 3.3.01	09.05.84		214
T 115/83 - 3.3.01	08.11.83		257
T 130/83 - 3.3.01	05.07.84		512
T 140/83 - 3.2.01	24.10.83		295
T 144/83 - 3.3.01	27.03.86	1986, 301	36, 55, 57-59, 223, 225
T 160/83 - 3.2.01	19.03.84		361
T 164/83 - 3.3.02	17.07.86	1987, 149	162, 222
T 169/83 - 3.2.01	25.03.85	1985, 193	100, 173, 229, 338, 340, 403
T 170/83 - 3.3.01	12.09.84	1984, 605	534, 628, 757, 879
T 173/83 - 3.5.01	10.10.89	1987, 465	69, 78
T 188/83 - 3.3.01	30.07.84	1984, 555	265
T 201/83 - 3.3.01	09.05.84	1984, 481	319-322, 350, 355, 408
T 202/83 - 3.3.01	06.03.84		229, 294
T 204/83 - 3.3.01	24.06.85	1985, 310	100
T 205/83 - 3.3.01	25.06.85	1985, 363	288, 289, 358, 418, 566
T 206/83 - 3.3.01	26.03.86	1987, 5	66, 67, 107, 230, 566

T 211/83 - 3.2.01	18.05.84	1986, 328	231, 345
T 219/83 - 3.3.01	26.11.85	1986, 211	288, 562, 565, 812, 880
T 220/83 - 3.3.01	14.01.86	1986, 249	854-856

1984

T 6/84 - 3.3.01	21.02.85	1985, 238	230, 341
T 13/84 - 3.5.01	15.05.86	1986, 253	173, 274, 275, 318
T 32/84 - 3.5.01	06.08.85	1986, 9	229
T 38/84 - 3.3.01	05.04.84	1984, 368	209
T 42/84 - 3.4.01	23.03.87	1988, 251	606, 623, 923
T 51/84 - 3.5.01	19.03.86	1986, 226	28
T 57/84 - 3.3.01	12.08.86	1987, 53	207, 208
T 73/84 - 3.2.01	26.04.85	1985, 241	451, 738, 739, 833
T 81/84 - 3.3.02	15.05.87	1988, 207	55, 56
T 85/84 - 3.4.01	14.01.86		757, 874
T 87/84 - 3.2.01	06.02.86		268
T 89/84 - 3.2.01	03.07.84	1984, 562	836, 909
T 90/84 - 3.3.01	02.04.85		177
T 92/84 - 3.4.01	05.03.87		268
T 94/84 - 3.3.01	20.06.86	1986, 337	439, 826
T 106/84 - 3.2.01	25.02.85	1985, 132	219
T 122/84 - 3.3.01	29.07.86	1987, 177	700
T 124/84 - 3.3.01	16.01.86		171
T 136/84 - 3.3.01	06.03.85		268
T 142/84 - 3.2.01	08.07.86	1987, 112	206
T 147/84 - 3.2.01	04.03.87		863
T 156/84 - 3.4.01	09.04.87	1988, 372	700-702, 718, 723-725, 786
T 163/84 - 3.3.02	21.08.86	1987, 301	204
T 165/84 - 3.2.02	29.01.87		252
T 166/84 - 3.3.01	22.08.84	1984, 489	881
T 167/84 - 3.2.02	20.01.87	1987, 369	99, 205, 755, 761
T 170/84 - 3.2.01	07.07.86	1986, 400	274
T 171/84 - 3.3.01	24.10.85	1986, 95	67, 230
T 175/84 - 3.5.01	22.09.87	1989, 71	198
T 176/84 - 3.2.01	22.11.85	1986, 50	184, 185
T 178/84 - 3.5.01	07.12.87	1989, 157	299, 311, 312, 696
T 184/84 - 3.3.01	04.04.86		402, 418
T 185/84 - 3.2.01	08.04.86	1986, 373	812
T 186/84 - 3.3.01	18.12.85	1986, 79	738, 833
T 192/84 - 3.4.01	09.11.84	1985, 39	530
T 193/84 - 3.3.01	22.01.85		86

Table of cases

T 194/84 - 3.4.01	22.09.88	1990, 59	347	T 115/85 - 3.5.01	05.09.88	1990, 30	18, 30, 34
T 195/84 - 3.2.01	10.10.85	1986, 121	184, 185, 205, 446	T 116/85 - 3.3.01	14.10.87	1989, 13	50, 57, 223
T 198/84 - 3.3.01	28.02.85	1985, 209	64, 111, 121, 127, 133	T 121/85 - 3.5.01	14.03.89		4, 32
T 208/84 - 3.5.01	15.07.86	1987, 14	12-14, 16, 18, 29, 30, 33	T 123/85 - 3.3.02	23.02.88	1989, 336	247, 739, 799, 833, 904
T 215/84 - 3.3.01	10.09.84		161	T 124/85 - 3.2.01	14.12.87		247, 269
T 225/84 - 3.2.01	16.07.86		205	T 127/85 - 3.3.02	01.02.88	1989, 271	246, 804
T 237/84 - 3.5.01	31.07.86	1987, 309	257	T 133/85 - 3.2.01	25.08.87	1988, 441	275, 352, 354
T 249/84 - 3.2.01	21.01.85		729	T 139/85 - 3.3.01	23.12.86		252, 266
T 258/84 - 3.2.01	18.07.86	1987, 119	702, 862	T 144/85 - 3.2.01	25.06.87		199
T 264/84 - 3.4.01	07.04.88		738	T 149/85 - 3.3.01	14.01.86	1986, 103	627
T 269/84 - 3.4.01	07.04.87		274	T 152/85 - 3.2.01	28.05.86	1987, 191	772, 773
T 270/84 - 3.3.01	01.09.87		217	T 153/85 - 3.3.01	11.12.86	1988, 1	109, 541, 833, 888, 890
T 271/84 - 3.3.01	18.03.86	1987, 405	217, 343, 369	T 155/85 - 3.3.02	28.07.87	1988, 87	175, 200, 208, 209
T 273/84 - 3.3.01	21.03.86	1986, 346	862	T 157/85 - 3.2.01	12.05.86		738
T 279/84 - 3.3.02	29.06.87		289, 566	T 162/85 - 3.2.02	20.05.87		879
T 287/84 - 3.4.01	11.06.85	1985, 333	496, 501, 509, 510	T 163/85 - 3.5.01	14.03.89	1990, 379	16, 20, 21, 32, 33, 35
T 288/84 - 3.3.01	07.02.86	1986, 128	231	T 168/85 - 3.4.01	27.04.87		274
1985				T 171/85 - 3.2.01	30.07.86	1987, 160	686, 687
T 17/85 - 3.3.01	06.06.86	1986, 406	127, 128	T 172/85 - 3.3.01	19.04.88		715
T 22/85 - 3.5.01	05.10.88	1990, 12	1, 2, 11, 12, 19, 30, 31	T 213/85 - 3.3.01	16.12.86	1987, 482	855-857
T 25/85 - 3.3.01	18.12.85	1986, 81	768, 772	T 219/85 - 3.2.01	14.07.86	1986, 376	232
T 26/85 - 3.5.01	20.09.88	1990, 22	108, 129, 130	T 222/85 - 3.3.02	21.01.87	1988, 128	605, 606, 776, 780, 784, 840
T 32/85 - 3.3.01	05.06.86		230, 236	T 226/85 - 3.3.02	17.03.87	1988, 336	229, 230, 236
T 35/85 - 3.3.02	16.12.86		221	T 229/85 - 3.3.01	27.10.86	1987, 237	171, 219
T 37/85 - 3.2.01	13.01.87	1988, 86	197	T 231/85 - 3.3.01	08.12.86	1989, 74	153, 154, 924
T 48/85 - 3.3.02	18.11.86		236	T 235/85 - 3.3.01	22.11.88		677
T 49/85 - 3.3.02	13.11.86		715	T 244/85 - 3.3.02	23.01.87	1988, 216	845, 847
T 52/85 - 3.5.01	16.03.89		21	T 247/85 - 3.2.01	16.09.86		841, 880
T 61/85 - 3.3.02	03.09.87		358, 409, 410	T 248/85 - 3.3.01	21.01.86	1986, 261	111, 163, 202, 288
T 64/85 - 3.4.01	19.01.88		806	T 251/85 - 3.3.02	19.05.87		288
T 66/85 - 3.5.01	09.12.87	1989, 167	352	T 253/85 - 3.3.02	10.02.87		864
T 68/85 - 3.3.01	27.11.86	1987, 228	252, 253, 266, 278	T 260/85 - 3.5.01	09.12.87	1989, 105	315, 352
T 69/85 - 3.4.01	02.04.87		156	T 271/85 - 3.3.01	22.03.89	1988, 341	847, 908
T 73/85 - 3.3.01	14.01.88		209	T 291/85 - 3.3.01	23.07.87	1988, 302	109
T 80/85 - 3.3.02	12.03.87		337	T 292/85 - 3.3.02	27.01.88	1989, 275	232, 234, 240, 241, 246, 266
T 89/85 - 3.2.01	07.12.87		905	T 293/85 - 3.3.02	27.01.88		266
T 98/85 - 3.3.01	01.09.87		363	1986			
T 99/85 - 3.4.01	23.10.86	1987, 413	171, 274	T 6/86 - 3.3.01	23.12.87		782
T 105/85 - 3.3.01	05.02.87		524, 527	T 7/86 - 3.3.01	16.09.87	1988, 381	121, 122, 177
T 110/85 - 3.2.02	26.11.87	1987, 157	524				

T 9/86 - 3.3.01	06.11.86	1988, 12	219	T 263/86 - 3.4.01	08.12.87	208
T 10/86 - 3.4.01	01.09.88		231	T 275/86 - 3.3.01	03.10.90	854
T 16/86 - 3.2.02	04.02.88	1989, 415	361	T 278/86 - 3.2.02	17.02.87	274
T 17/86 - 3.2.01	26.10.87	1989, 297	319, 327, 355	T 281/86 - 3.3.02	27.01.88	1989, 202
T 19/86 - 3.3.01	15.10.87	1989, 25	55, 144	T 283/86 - 3.3.02	17.03.89	244
T 23/86 - 3.4.01	25.08.86	1987, 316	282, 283, 805	T 287/86 - 3.4.01	28.03.88	161
T 26/86 - 3.4.01	21.05.87	1988, 19	9, 10, 16, 25, 33, 188	T 290/86 - 3.3.01	13.11.90	1992, 414
T 27/86 - 3.2.01	11.02.87		510			55, 57, 58, 101, 146, 149, 150
T 38/86 - 3.5.01	14.02.89	1990, 384	4, 5, 27, 28, 31-33	T 293/86 - 3.3.02	05.07.88	679
T 48/86 - 3.4.01	12.01.88		214	T 296/86 - 3.3.02	08.06.89	681, 865
T 49/86 - 3.2.02	17.09.87		755, 760	T 297/86 - 3.2.01	29.09.89	742
T 55/86 - 3.2.01	15.03.88		213	T 299/86 - 3.3.02	23.09.87	1988, 88
T 57/86 - 3.3.01	19.05.88		182			234, 239, 266, 455, 456, 678
T 58/86 - 3.2.01	26.04.89		385	T 300/86 - 3.5.01	28.08.89	77, 83
T 63/86 - 3.2.01	10.08.87	1988, 224	681, 865	T 303/86 - 3.3.01	08.11.88	102, 756
T 69/86 - 3.2.01	15.09.87		558, 563	T 305/86 - 3.2.01	22.11.88	756
T 71/86 - 3.2.02	18.01.88		702	T 307/86 - 3.3.02	02.05.88	236
T 73/86 - 3.2.02	07.12.88		86, 727	T 313/86 - 3.3.01	12.01.88	263
T 95/86 - 3.5.01	23.10.90		4, 32	T 317/86 - 3.2.01	15.04.88	1989, 378
T 109/86 - 3.5.01	20.07.87		537, 862	T 322/86 - 3.3.01	11.02.88	171
T 113/86 - 3.3.01	28.10.87		561, 805	T 329/86 - 3.2.01	02.02.89	782
T 114/86 - 3.4.01	29.10.86	1987, 485	111	T 336/86 - 3.3.01	28.09.88	746
T 117/86 - 3.3.01	01.08.88	1989, 401	546, 701, 719, 741-743, 761, 762, 874	T 341/86 - 3.2.01	19.10.87	681, 865
T 120/86 - 3.2.02	12.07.88		274	T 345/86 - 3.3.02	17.10.89	565
T 135/86 - 3.5.01	19.06.89		719	T 347/86 - 3.3.02	28.01.88	681
T 137/86 - 3.4.01	08.02.88		274	T 349/86 - 3.2.01	29.04.88	1988, 345
T 162/86 - 3.3.02	07.07.87	1988, 452	173	T 355/86 - 3.2.02	14.04.87	860
T 166/86 - 3.3.02	25.09.86	1987, 372	666, 686	T 362/86 - 3.5.01	19.12.88	719
T 170/86 - 3.5.01	02.03.89		863	T 365/86 - 3.2.02	26.01.89	219
T 175/86 - 3.3.02	06.11.90		805	T 378/86 - 3.2.02	21.10.87	1988, 386
T 177/86 - 3.2.01	09.12.87		355	T 385/86 - 3.4.01	25.09.87	1988, 308
T 186/86 - 3.5.01	05.12.89		30	T 389/86 - 3.2.01	31.03.87	1988, 87
T 194/86 - 3.2.01	17.05.88		782	T 390/86 - 3.3.01	17.11.87	1989, 30
T 197/86 - 3.3.02	04.02.88	1989, 371	221			591-593, 605, 615, 820
T 200/86 - 3.3.02	29.09.87		294, 865	T 398/86 - 3.2.01	16.03.87	679
T 222/86 - 3.4.01	22.09.87		182	T 406/86 - 3.3.01	02.03.88	1989, 302
T 234/86 - 3.4.01	23.11.87	1989, 79	541, 543, 607, 685, 777, 844, 922			103, 543, 607, 805, 812, 888, 894
T 237/86 - 3.2.01	11.06.87	1988, 261	738	T 416/86 - 3.4.01	29.10.87	1989, 309
T 243/86 - 3.2.01	09.12.86		558, 563	T 420/86 - 3.3.02	12.01.89	358, 363
T 246/86 - 3.4.01	11.01.88	1989, 199	315	T 424/86 - 3.3.01	11.08.88	101
T 254/86 - 3.3.02	05.11.87	1989, 115	166, 208	T 427/86 - 3.2.04	08.07.88	120
				T 433/86 - 3.3.01	11.12.87	263
				1987		
				T 4/87 - 3.2.01	19.05.88	274

Table of cases

T 9/87 - 3.3.01	18.08.88	1989, 438	785, 816	T 181/87 - 3.3.02	29.08.89	234, 244
T 11/87 - 3.3.01	14.04.88		524	T 193/87 - 3.2.01	13.06.91	1993, 207
T 16/87 - 3.4.01	24.07.90	1992, 212	282, 283, 402, 565, 806	T 198/87 - 3.3.02	21.06.88	863
T 19/87 - 3.4.01	16.04.87	1988, 268	453-456, 677, 678, 914, 921	T 205/87 - 3.2.02	14.06.88	863
T 28/87 - 3.2.01	29.04.88	1989, 383	186	T 213/87 - 3.2.02	08.07.90	201
T 29/87 - 3.3.02	19.09.90		219	T 219/87 - 3.3.01	11.03.88	177
T 35/87 - 3.3.02	27.04.87	1988, 134	296	T 230/87 - 3.4.01	15.12.88	247
T 38/87 - 3.4.01	30.06.88		209	T 239/87 - 3.3.02	11.02.88	245
T 44/87 - 3.2.01	23.05.89		219	T 243/87 - 3.3.02	30.08.89	592, 616
T 51/87 - 3.3.02	08.12.88	1991, 177	66, 67, 230, 727	T 245/87 - 3.4.01	25.09.87	1989, 171
T 54/87 - 3.4.01	10.10.88		209	T 256/87 - 3.3.02	26.07.88	234, 236, 237, 248, 249
T 56/87 - 3.4.01	20.09.88	1990, 188	100, 110, 199	T 261/87 - 3.3.01	16.12.86	201
T 58/87 - 3.2.02	24.11.88		879	T 262/87 - 3.5.01	06.04.89	215
T 59/87 - 3.3.01	26.04.88	1988, 347	153	T 266/87 - 3.2.01	30.05.90	786
T 59/87 - 3.3.01	14.08.90	1991, 561	99, 154, 207	T 269/87 - 3.3.02	24.01.89	257, 404
T 62/87 - 3.3.01	08.04.88		69	T 293/87 - 3.3.01	23.02.89	86, 565
T 65/87 - 3.2.02	18.09.90		199	T 295/87 - 3.3.01	06.12.88	1990, 470
T 77/87 - 3.3.01	16.03.89	1990, 280	105, 106	T 296/87 - 3.3.01	30.08.88	1990, 195
T 81/87 - 3.3.02	24.01.89	1990, 250	232, 402, 404, 414-416	T 301/87 - 3.3.02	16.02.89	1990, 335
T 85/87 - 3.3.01	21.07.88		122			232, 239, 246, 317, 397, 404, 414, 421, 807, 880
T 88/87 - 3.2.02	18.04.89		268, 457	T 302/87 - 3.3.02	30.01.90	208
T 89/87 - 3.2.02	20.12.89		106	T 305/87 - 3.2.02	01.09.89	1991, 429
T 99/87 - 3.2.01	18.10.88		757	T 315/87 - 3.2.01	14.02.89	219, 485, 487, 530, 862
T 101/87 - 3.2.01	25.01.90		701, 714, 741, 742	T 320/87 - 3.3.02	10.11.88	1990, 71
T 105/87 - 3.3.01	25.02.88		858			36, 43, 46, 47, 290
T 124/87 - 3.3.01	09.08.88	1989, 491	102, 109, 122, 123, 566	T 321/87 - 3.3.01	26.01.89	214
T 128/87 - 3.2.01	03.06.88	1989, 406	493, 558, 563, 571	T 322/87 - 3.3.03	25.04.90	266
T 133/87 - 3.4.01	23.06.88		833	T 323/87 - 3.3.02	24.03.88	1989, 343
T 139/87 - 3.2.01	09.01.89	1990, 68	857, 875			493, 628, 774, 853, 908
T 141/87 - 3.4.01	29.09.88		181, 182, 199	T 326/87 - 3.3.03	28.08.90	1992, 522
T 145/87 - 3.2.01	28.02.90		339			702, 703, 742, 744, 761, 862, 864
T 148/87 - 3.3.02	24.11.89		290	T 327/87 - 3.2.01	12.01.90	282, 283, 285
T 154/87 - 3.2.01	29.06.89		220	T 328/87 - 3.2.01	04.04.91	1992, 701
T 155/87 - 3.2.01	07.02.90		717			726, 782, 784, 836
T 162/87 - 3.5.01	08.06.89		86, 554	T 330/87 - 3.3.01	24.02.88	219
T 166/87 - 3.3.01	16.05.88		510, 514, 515	T 331/87 - 3.2.02	06.07.89	1991, 22
T 170/87 - 3.3.01	05.07.88	1989, 441	263, 265, 339, 340	T 332/87 - 3.3.01	23.11.90	96, 110, 266, 554
T 172/87 - 3.2.01	12.01.89		247	T 350/87 - 3.4.01	15.06.89	219
T 179/87 - 3.2.02	16.01.90		229	T 362/87 - 3.3.01	13.12.90	828

T 365/87 - 3.3.02	14.09.89	186	T 106/88 - 3.3.02	15.11.88	245
T 373/87 - 3.2.04	21.01.92	719, 763, 879, 880	T 117/88 - 3.2.02	09.10.90	680
T 381/87 - 3.3.01	10.11.88	1990, 213	T 118/88 - 3.5.01	14.11.89	318
		69, 86, 89, 558, 565, 888	T 119/88 - 3.5.01	25.04.89	1990, 395
T 383/87 - 3.3.02	26.04.89	455, 756	T 120/88 - 3.2.03	25.09.90	198
T 387/87 - 3.2.02	14.09.89	198	T 124/88 - 3.5.02	19.12.90	546, 554
T 397/87 - 3.3.01	31.01.89	187	T 129/88 - 3.3.03	10.02.92	1993, 598
T 409/87 - 3.4.01	03.05.88	677			719, 783, 836
T 410/87 - 3.4.01	13.07.89	209, 215	T 134/88 - 3.3.01	18.12.89	778, 779
T 415/87 - 3.3.01	27.06.88	738	T 136/88 - 3.2.02	11.10.89	355
T 416/87 - 3.3.01	29.06.89	1990, 415	T 140/88 - 3.4.01	13.02.90	860
		284, 546, 741-743, 761, 862	T 145/88 - 3.2.01	27.10.89	1991, 251
T 417/87 - 3.2.01	17.08.89	372	T 153/88 - 3.3.03	09.01.91	74
T 433/87 - 3.3.01	17.08.89	455, 457	T 155/88 - 3.3.01	14.07.89	543, 607, 799
T 434/87 - 3.2.02	05.09.89	288	T 158/88 - 3.4.01	12.12.89	1991, 566
T 438/87 - 3.2.01	09.05.89	772	T 162/88 - 3.2.02	09.07.90	679
T 453/87 - 3.3.01	18.05.89	777	T 171/88 - 3.2.02	07.05.90	288
T 454/87 - 3.4.01	02.08.89	185	T 182/88 - 3.3.01	03.11.88	1990, 287
T 459/87 - 3.3.01	18.11.88	565			622, 665, 666, 686, 838
T 460/87 - 3.3.01	20.06.89	182	T 185/88 - 3.3.01	22.06.89	1990, 451
			T 192/88 - 3.3.01	20.07.89	786
			T 194/88 - 3.2.02	30.11.92	739, 740
			T 197/88 - 3.3.02	02.08.88	1989, 412
			T 198/88 - 3.3.01	03.08.89	1991, 254
					717, 763, 764, 880
			T 204/88 - 3.2.01	03.04.90	554
			T 208/88 - 3.3.01	20.07.88	1992, 22
					102, 107, 153, 154, 881, 922
			T 209/88 - 3.2.01	20.12.89	444, 914
			T 212/88 - 3.3.01	08.05.90	1992, 28
					230, 232, 234, 407, 539, 617, 742, 760, 861
			T 215/88 - 3.3.01	09.10.90	862
			T 223/88 - 3.5.01	06.07.90	516
			T 225/88 - 3.3.01	10.08.90	799
			T 226/88 - 3.4.01	11.10.89	219
			T 227/88 - 3.3.02	15.12.88	1990, 292
			T 238/88 - 3.3.03	25.04.91	1992, 709
					232, 259, 282, 285
			T 241/88 - 3.2.01	20.02.90	100
			T 245/88 - 3.2.01	12.03.91	74, 86, 102
			T 251/88 - 3.3.01	14.11.89	592, 593
			T 254/88 - 3.3.01	10.10.89	859
			T 261/88 - 3.5.02	28.03.91	1992, 627
			T 261/88 - 3.5.02	16.02.93	596, 598
			T 265/88 - 3.4.01	07.11.89	317
			T 271/88 - 3.3.02	06.06.89	257

1988

Table of cases

T 274/88 - 3.2.01 06.06.89	867	T 508/88 - 3.4.01 20.07.89	219
T 279/88 - 3.3.01 25.01.90	763, 777	T 514/88 - 3.2.02 10.10.89 1992, 570	347, 370, 382
T 283/88 - 3.3.02 26.11.90	454-457, 678, 913	T 522/88 - 3.3.01 19.12.89	494, 532
T 293/88 - 3.2.02 23.03.90 1992, 220	816	T 523/88 - 3.2.01 26.02.91	338
T 295/88 - 3.3.01 12.06.89	182	T 525/88 - 3.2.01 15.11.90	745, 757
T 297/88 - 3.3.01 05.12.89	881	T 527/88 - 3.2.01 11.12.90	347, 382
T 309/88 - 3.3.01 28.02.90	512, 525	T 531/88 - 3.2.03 08.01.91	681
T 310/88 - 3.3.03 23.07.90	108	T 532/88 - 3.3.01 16.05.90	205
T 312/88 - 3.3.01 29.01.91	237	T 536/88 - 3.2.01 14.01.91 1992, 638	717
T 315/88 - 3.4.01 11.10.89	198	T 544/88 - 3.4.01 17.04.89 1990, 429	299
T 317/88 - 3.3.01 13.06.91	162	T 547/88 - 3.2.02 19.11.93	459, 566
T 329/88 - 3.2.05 22.06.93	739	T 550/88 - 3.3.01 27.03.90 1992, 117	68, 781, 798
T 330/88 - 3.2.01 22.03.90	444, 707, 745	T 560/88 - 3.2.01 19.02.90	454, 914
T 344/88 - 3.3.03 16.05.91	459, 773	T 572/88 - 3.3.01 27.02.91	98
T 346/88 - 3.3.01 24.04.89	908	T 574/88 - 3.3.01 06.12.89	164
T 358/88 - 3.3.02 21.09.90	247	T 579/88 - 3.5.01 19.04.90	880
T 361/88 - 3.2.01 21.06.90	266	T 580/88 - 3.4.01 25.01.90	230
T 365/88 - 3.3.02 05.08.91	371	T 582/88 - 3.3.02 17.05.90	154, 746
T 371/88 - 3.2.01 29.05.90 1992, 157	344, 360, 369	T 584/88 - 3.3.01 03.04.89	59
T 383/88 - 3.3.01 01.12.92	348, 373, 383, 561, 564	T 586/88 - 3.2.04 22.11.91 1993, 313	603
T 387/88 - 3.4.01 28.11.88	859	T 591/88 - 3.5.01 12.12.89	751
T 390/88 - 3.3.02 20.02.90	103, 222	T 598/88 - 3.3.01 07.08.89	454, 908, 913, 924
T 392/88 - 3.3.01 06.03.90	214	T 601/88 - 3.3.03 14.03.91	214
T 401/88 - 3.4.01 28.02.89 1990, 297	370	T 609/88 - 3.3.03 10.07.90	686
T 415/88 - 3.2.01 06.06.90	534	T 619/88 - 3.3.03 01.03.90	363
T 416/88 - 3.5.01 31.05.90	282, 285	T 626/88 - 3.2.02 16.05.90	862
T 423/88 - 3.2.01 20.11.90	865	T 627/88 - 3.3.03 04.07.90	554
T 424/88 - 3.4.01 11.05.89	813	T 632/88 - 3.2.02 21.11.89	751
T 426/88 - 3.2.02 09.11.90 1992, 427	186	T 635/88 - 3.2.03 28.02.92 1993, 608	766, 768
T 429/88 - 3.2.03 25.09.90	274	T 636/88 - 3.2.01 12.03.92	27
T 432/88 - 3.5.01 15.06.89	859	T 640/88 - 3.3.03 14.12.90	371
T 444/88 - 3.3.03 09.05.90	69	T 648/88 - 3.3.01 23.11.89 1991, 292	204, 880
T 446/88 - 3.2.02 28.11.90	205	1989	
T 451/88 - 3.2.01 15.01.90	100	T 2/89 - 3.3.02 03.07.89 1991, 51	776, 777
T 459/88 - 3.3.01 13.02.89 1990, 425	738, 857	T 5/89 - 3.4.02 06.07.90 1992, 348	543, 607, 868, 879
T 461/88 - 3.2.03 17.04.91 1993, 295	102, 758, 880	T 11/89 - 3.3.01 06.12.90	264
T 465/88 - 3.2.03 19.03.90	338	T 14/89 - 3.3.02 12.06.89 1990, 432	430, 502, 503, 510, 520
T 466/88 - 3.3.02 12.02.91	209	T 16/89 - 3.3.02 24.01.90	397
T 472/88 - 3.3.03 10.10.90	806, 807	T 21/89 - 3.3.01 27.06.90	870, 872
T 475/88 - 3.3.01 23.11.89	230, 237, 730	T 22/89 - 3.3.01 26.06.90	811
T 484/88 - 3.3.01 01.02.89	541, 543, 608, 685	T 38/89 - 3.3.03 21.08.90	898
T 493/88 - 3.4.01 13.12.89 1991, 380	609, 786, 919	T 40/89 - 3.3.03 05.05.93	221
T 500/88 - 3.4.02 12.07.90	215	T 49/89 - 3.4.01 10.07.90	361, 864
T 501/88 - 3.2.02 30.11.89	681, 865		

T 60/89 - 3.3.02	31.08.90	1992, 268	178, 183, 186, 229, 232, 836	T 264/89 - 3.2.01	25.02.92	282, 285
T 65/89 - 3.2.04	05.12.90		274	T 268/89 - 3.2.02	06.02.92	1994, 50 170
T 72/89 - 3.2.05	04.06.92		881	T 275/89 - 3.2.01	03.05.90	1992, 126 464, 752, 811, 814
T 73/89 - 3.5.01	07.08.89		514	T 279/89 - 3.3.03	03.07.91	127, 129, 130
T 76/89 - 3.3.02	10.10.89		666, 686	T 288/89 - 3.2.04	15.01.92	325
T 78/89 - 3.4.01	23.01.90		870	T 291/89 - 3.3.02	14.05.91	717
T 79/89 - 3.2.01	09.07.90	1992, 283	541, 542, 690, 872, 881	T 294/89 - 3.4.01	25.10.90	199
T 89/89 - 3.4.02	27.03.90		282, 806	T 299/89 - 3.3.03	31.01.91	848
T 93/89 - 3.3.03	15.11.90	1992, 718	69, 782	T 300/89 - 3.3.01	11.04.90	1991, 480 289, 661, 662, 665, 676, 914
T 96/89 - 3.2.03	17.01.91		361	T 315/89 - 3.2.01	11.09.90	879
T 99/89 - 3.2.01	05.03.91		182	T 317/89 - 3.2.03	10.07.91	681
T 110/89 - 3.2.01	25.02.91		706	T 323/89 - 3.3.02	24.09.90	1992, 169 546, 719, 741, 742, 761, 762, 874
T 112/89 - 3.2.04	04.10.90		519	T 324/89 - 3.3.02	13.06.91	805
T 115/89 - 3.2.02	24.07.90		175	T 331/89 - 3.3.03	13.02.92	905
T 118/89 - 3.2.03	19.09.90		347, 880	T 338/89 - 3.2.03	10.12.90	724
T 121/89 - 3.2.03	25.06.91		282-284	T 344/89 - 3.3.02	19.12.91	174
T 122/89 - 3.4.01	05.02.91		247	T 345/89 - 3.4.01	27.05.91	275
T 125/89 - 3.2.03	10.01.91		455, 756	T 365/89 - 3.3.01	10.04.91	101, 170
T 130/89 - 3.2.02	07.02.90	1991, 514	198, 201	T 366/89 - 3.2.02	12.02.92	201
T 150/89 - 3.2.02	29.04.91		619	T 381/89 - 3.2.03	22.02.93	719
T 153/89 - 3.3.01	17.11.92		609, 680, 921	T 386/89 - 3.2.01	24.03.92	174
T 158/89 - 3.3.02	20.11.90		372	T 387/89 - 3.4.01	18.02.91	1992, 583 717, 763
T 160/89 - 3.4.01	13.11.90		906	T 388/89 - 3.3.01	26.02.91	197
T 164/89 - 3.4.02	03.04.90		703	T 392/89 - 3.2.01	03.07.90	786, 868
T 169/89 - 3.3.03	23.10.90		855, 857	T 396/89 - 3.3.03	08.08.91	475, 560, 833
T 176/89 - 3.3.03	27.06.90		165	T 397/89 - 3.2.03	08.03.91	318
T 182/89 - 3.3.01	14.12.89	1991, 391	232, 234, 250, 558, 565, 763, 776, 781, 836	T 402/89 - 3.3.01	12.08.91	363
T 183/89 - 3.2.01	30.07.90		622	T 404/89 - 3.2.01	09.04.91	760
T 184/89 - 3.3.02	25.02.92		171	T 411/89 - 3.3.02	20.12.90	291
T 194/89 - 3.5.02	04.12.90		282, 285	T 418/89 - 3.3.02	08.01.91	1993, 20 244, 266
T 200/89 - 3.3.01	07.12.89	1992, 46	370	T 423/89 - 3.3.01	10.06.92	291, 363
T 205/89 - 3.2.02	21.08.91		924	T 424/89 - 3.2.01	22.08.91	219
T 210/89 - 3.5.01	20.10.89	1991, 433	493	T 426/89 - 3.4.01	28.06.90	1992, 172 261, 364, 365
T 213/89 - 3.5.01	10.04.90		573	T 430/89 - 3.3.01	17.07.91	282, 285, 705, 715
T 227/89 - 3.3.03	25.09.91		173, 220	T 435/89 - 3.3.02	10.06.92	229, 276
T 228/89 - 3.2.01	25.11.91		680	T 448/89 - 3.4.01	30.10.90	1992, 361 780
T 231/89 - 3.3.02	14.06.91	1993, 13	366, 367	T 451/89 - 3.2.04	01.04.93	549, 572
T 232/89 - 3.2.03	03.12.91		782	T 454/89 - 3.5.01	11.03.91	286
T 237/89 - 3.2.03	02.05.91		701	T 457/89 - 3.2.04	21.03.91	845
T 243/89 - 3.2.02	02.07.91		318, 661	T 472/89 - 3.2.03	25.06.91	282, 285
T 249/89 - 3.2.02	15.07.91		295	T 476/89 - 3.2.01	10.09.91	282, 283
T 250/89 - 3.2.01	06.11.90	1992, 355	509, 855			
T 253/89 - 3.2.04	07.02.91		680			

Table of cases

T 482/89 - 3.5.02	11.12.90	1992, 646	76, 546, 552, 554, 783, 897, 901	T 631/89 - 3.2.02	10.04.92	214
T 484/89 - 3.2.03	08.12.92		445, 717, 719	T 638/89 - 3.4.02	09.11.90	746, 864
T 485/89 - 3.2.02	14.08.91	1993, 214	951	T 641/89 - 3.3.01	24.09.91	168
T 487/89 - 3.3.03	17.07.91		245, 268	T 665/89 - 3.2.03	17.07.91	539, 540, 574, 578, 770, 849
T 488/89 - 3.2.01	21.06.91		371	T 666/89 - 3.3.01	10.09.91	1993, 495 97, 101, 123, 129-131
T 495/89 - 3.3.02	09.01.91		244	T 668/89 - 3.3.03	19.06.90	456, 678, 913
T 496/89 - 3.3.01	21.02.91		705	T 673/89 - 3.2.01	08.09.92	317, 360, 368
T 500/89 - 3.3.01	26.03.91		114, 209	T 680/89 - 3.4.02	08.05.90	922
T 506/89 - 3.2.01	12.07.90		757	T 682/89 - 3.5.01	17.08.93	810, 811
T 507/89 - 3.3.03	31.01.91		751	T 695/89 - 3.2.02	09.09.91	1993, 152 764
T 516/89 - 3.3.02	19.12.90	1992, 436	630	T 702/89 - 3.2.01	26.03.92	1994, 472 493
T 519/89 - 3.3.03	05.05.92		214	T 707/89 - 3.3.01	15.04.91	266
T 523/89 - 3.2.01	01.08.90		161, 760	T 708/89 - 3.3.01	22.03.93	86
T 528/89 - 3.5.02	17.09.90		219	T 715/89 - 3.5.01	16.03.90	501
T 534/89 - 3.2.02	02.02.93	1994, 464	704, 706, 709, 710, 745, 822, 857	T 716/89 - 3.3.02	22.02.90	1992, 132 826, 914
T 538/89 - 3.2.01	02.01.91		782, 811, 922	T 721/89 - 3.2.01	08.11.91	237
T 543/89 - 3.2.01	29.06.90		897	T 725/89 - 3.3.02	20.05.92	554, 860
T 544/89 - 3.2.03	27.06.91		282, 284, 719	T 727/89 - 3.2.04	13.03.91	880
T 551/89 - 3.4.01	20.03.90		220	T 732/89 - 3.3.03	07.10.92	173, 220
T 552/89 - 3.4.01	27.08.91		201	T 735/89 - 3.5.02	09.01.92	274
T 560/89 - 3.3.02	24.04.91	1992, 725	185, 702	T 737/89 - 3.2.04	07.12.92	745
T 561/89 - 3.2.04	29.04.91		713, 715, 813	T 743/89 - 3.3.03	27.01.92	72, 86, 570
T 563/89 - 3.2.01	03.09.91		288, 730	T 754/89 - 3.2.03	24.04.91	214, 782
T 564/89 - 3.3.01	10.02.93		163, 173, 176, 177	T 760/89 - 3.2.02	06.09.93	1994, 797 552, 630
T 565/89 - 3.2.03	26.09.90		282, 283, 805, 864	T 762/89 - 3.2.01	28.09.92	739
T 568/89 - 3.4.01	10.01.90		664	T 763/89 - 3.3.01	10.07.91	98, 133
T 571/89 - 3.2.02	22.05.90		350	T 765/89 - 3.2.01	08.07.93	742, 746, 757, 760, 874
T 576/89 - 3.3.03	29.04.92	1993, 543	905	T 767/89 - 3.2.03	16.04.91	185
T 580/89 - 3.3.03	29.08.91	1993, 218	726	T 770/89 - 3.2.03	16.10.91	905
T 583/89 - 3.2.02	02.12.92		881	T 772/89 - 3.3.02	18.10.91	66, 67, 230
T 588/89 - 3.2.03	15.01.92		717	T 774/89 - 3.3.02	02.06.92	56, 59, 216
T 589/89 - 3.3.03	05.02.92		700	T 780/89 - 3.3.02	12.08.91	1993, 440 57
T 595/89 - 3.2.01	10.07.91		554	T 783/89 - 3.4.02	19.02.91	445, 915
T 596/89 - 3.4.01	15.12.92		741, 742	T 784/89 - 3.4.02	06.11.90	1992, 438 319
T 603/89 - 3.4.01	03.07.90	1992, 230	4, 8, 9, 29	T 789/89 - 3.2.01	11.01.93	1994, 482 539, 719, 760
T 604/89 - 3.4.02	14.01.92	1992, 240	181	1990		
T 606/89 - 3.3.01	18.09.90		164	T 3/90 - 3.4.01	24.04.91	1992, 737 457, 459
T 611/89 - 3.3.01	10.10.91		231	T 5/90 - 3.3.03	27.11.92	364
T 614/89 - 3.2.03	11.06.92		468, 756, 758, 874	T 12/90 - 3.3.01	23.08.90	101, 122
T 622/89 - 3.3.03	17.09.92		742	T 19/90 - 3.3.02	03.10.90	1990, 476 36, 37, 39, 44, 45, 48, 225, 232, 234, 241, 250, 416

T 30/90 - 3.3.03	13.06.91		510, 512	T 217/90 - 3.3.01	21.11.91		799, 905
T 34/90 - 3.3.01	15.10.91	1992, 454	507, 539, 607, 822, 824, 828	T 219/90 - 3.3.01	08.05.91		217
T 37/90 - 3.2.02	01.10.92		363, 879	T 229/90 - 3.3.01	10.10.91		703
T 47/90 - 3.3.01	20.02.90	1991, 486	681, 865, 875	T 231/90 - 3.2.04	25.03.93		548, 745
T 50/90 - 3.2.02	14.05.91		283, 805	T 233/90 - 3.3.02	08.07.92		94, 109
T 51/90 - 3.4.01	08.08.91		897, 901, 902	T 234/90 - 3.2.01	22.07.92		717
T 52/90 - 3.3.01	08.01.92		609, 919	T 270/90 - 3.3.03	21.03.91	1993, 725	89, 558, 565, 569, 705, 709, 897, 901, 902
T 54/90 - 3.3.03	16.06.93		363	T 273/90 - 3.3.01	10.06.91		848
T 55/90 - 3.2.01	05.05.92		870, 871	T 277/90 - 3.2.03	12.03.92		185
T 60/90 - 3.3.03	11.12.92		343, 353	T 282/90 - 3.3.02	14.01.93		166
T 61/90 - 3.2.03	22.06.93		177	T 287/90 - 3.2.01	25.09.91		859
T 65/90 - 3.2.02	05.03.92		198	T 288/90 - 3.3.03	01.12.92		110
T 68/90 - 3.5.02	28.11.91		738	T 290/90 - 3.4.01	09.10.90	1992, 368	537, 627, 818
T 74/90 - 3.2.01	01.10.91		64, 215	T 292/90 - 3.3.02	16.11.92		609, 919
T 75/90 - 3.2.04	03.05.93		363, 812	T 294/90 - 3.2.04	28.01.92		198
T 78/90 - 3.2.01	07.12.93		782	T 297/90 - 3.2.04	03.12.91		245, 268
T 82/90 - 3.3.02	23.07.92		86, 229	T 300/90 - 3.3.02	16.04.91		717
T 87/90 - 3.2.02	26.09.91		78, 102	T 301/90 - 3.4.01	23.07.90		207
T 89/90 - 3.5.01	27.11.90	1992, 456	680, 821, 841	T 303/90 - 3.3.02	04.02.92		161
T 90/90 - 3.2.03	25.06.92		859	T 308/90 - 3.2.01	03.09.91		229, 338
T 95/90 - 3.3.01	30.10.92		199	T 314/90 - 3.3.03	15.11.91		546, 548
T 97/90 - 3.3.01	13.11.91	1993, 719	703, 742, 862, 864	T 315/90 - 3.4.02	18.03.91		496-498
T 110/90 - 3.5.01	15.04.93	1994, 557	16, 32, 33	T 317/90 - 3.3.03	23.04.92		801
T 114/90 - 3.3.01	26.02.92		69	T 323/90 - 3.2.04	04.06.92		417, 879
T 116/90 - 3.3.01	18.12.91		617	T 324/90 - 3.3.03	13.03.91	1993, 33	502, 507, 512, 515, 517, 908, 909
T 130/90 - 3.3.02	28.02.91		290	T 332/90 - 3.4.01	08.10.91		206, 209
T 132/90 - 3.2.03	21.02.94		399, 421	T 338/90 - 3.3.03	21.10.93		750
T 137/90 - 3.3.01	26.04.91		868	T 345/90 - 3.2.04	26.02.92		198
T 144/90 - 3.2.02	03.12.91		199	T 347/90 - 3.2.04	19.02.93		738
T 154/90 - 3.2.04	19.12.91	1993, 505	754, 762, 859	T 358/90 - 3.2.03	27.01.92		185
T 156/90 - 3.2.01	09.09.91		847	T 362/90 - 3.2.01	13.10.92		34
T 157/90 - 3.3.02	12.09.91		318	T 363/90 - 3.2.02	25.02.92		102, 554
T 162/90 - 3.2.03	07.05.92		880	T 366/90 - 3.3.01	17.06.92		130
T 166/90 - 3.2.02	11.08.92		367, 368	T 367/90 - 3.4.01	03.06.92	1992, 529	626
T 172/90 - 3.3.02	06.06.91		222	T 372/90 - 3.2.04	20.05.94		338
T 176/90 - 3.3.01	30.08.91		379	T 375/90 - 3.2.02	21.05.92		686
T 182/90 - 3.2.02	30.07.93	1994, 641	51-53, 677, 914	T 376/90 - 3.3.03	08.09.93	1994, 906	786, 819
T 190/90 - 3.2.04	16.01.92		810	T 385/90 - 3.2.03	28.02.92		626
T 191/90 - 3.3.03	30.10.91		363	T 390/90 - 3.3.01	15.12.92	1994, 808	724
T 194/90 - 3.3.01	27.11.92		719, 852	T 394/90 - 3.2.01	20.03.91		219
T 195/90 - 3.4.02	20.06.90		859	T 398/90 - 3.2.04	27.10.92		77
T 204/90 - 3.2.02	30.07.91		266	T 400/90 - 3.4.02	03.07.91		417
T 210/90 - 3.2.04	25.05.93		813	T 401/90 - 3.3.02	04.02.92		161
T 211/90 - 3.2.05	01.07.93		709, 710				

Table of cases

T 404/90 - 3.4.02	16.12.93		201	T 650/90 - 3.2.02	23.07.93		215
T 409/90 - 3.4.01	29.01.91	1993, 40	209, 403, 409	T 654/90 - 3.3.01	08.05.91		230
T 424/90 - 3.4.01	11.12.91		182	T 656/90 - 3.4.01	13.11.91		166
T 441/90 - 3.3.03	15.09.92		458	T 663/90 - 3.3.01	13.08.91		453-455, 457, 913
T 443/90 - 3.2.03	16.09.92		186, 742	T 664/90 - 3.2.02	09.07.91		288
T 446/90 - 3.3.02	14.07.93		267	T 665/90 - 3.3.02	23.09.92		251
T 449/90 - 3.3.02	05.12.91		234, 247, 415	T 666/90 - 3.3.02	28.02.94		452, 607, 915
T 453/90 - 3.2.03	26.01.93		261	T 669/90 - 3.4.01	14.08.91	1992, 739	810, 811
T 456/90 - 3.5.02	25.11.91		861	T 675/90 - 3.3.01	24.06.92	1994, 58	691, 692
T 469/90 - 3.4.01	06.02.91		173	T 676/90 - 3.2.04	14.07.93		339, 881
T 470/90 - 3.3.01	19.05.92		208	T 678/90 - 3.2.03	27.04.92		719
T 472/90 - 3.3.02	10.02.93		746	T 685/90 - 3.2.02	30.01.92		317, 347
T 483/90 - 3.2.03	14.10.92		850	T 686/90 - 3.2.03	21.06.93		15
T 484/90 - 3.2.01	21.10.91	1993, 448	444, 908	T 688/90 - 3.2.04	26.10.92		879
T 490/90 - 3.4.02	12.03.91		292, 697	T 689/90 - 3.4.01	21.01.92	1993, 616	341
T 493/90 - 3.3.02	10.12.91		288, 371	T 690/90 - 3.2.03	15.05.92		875
T 496/90 - 3.2.01	10.12.92		353	T 692/90 - 3.2.02	28.09.93		459
T 503/90 - 3.3.03	13.10.93		742	T 695/90 - 3.2.01	31.03.92		214
T 513/90 - 3.2.02	19.12.91	1994, 154	211	T 705/90 - 3.2.01	15.07.91		702, 712, 715, 760
T 517/90 - 3.2.04	13.05.92		99, 205	T 708/90 - 3.2.05	06.11.92		880
T 522/90 - 3.4.02	08.09.93		919	T 711/90 - 3.3.02	15.09.93		281
T 525/90 - 3.3.02	17.06.92		569	T 717/90 - 3.2.01	10.07.91		197
T 530/90 - 3.2.02	23.04.92		173, 318	T 729/90 - 3.3.03	29.10.93		220, 858
T 537/90 - 3.2.02	20.04.93		187	T 735/90 - 3.3.03	02.09.92		921
T 547/90 - 3.5.01	17.01.91		173, 318	T 737/90 - 3.3.01	09.09.93		231
T 553/90 - 3.2.03	15.06.92	1993, 666	632, 736	T 740/90 - 3.3.02	02.10.91		232, 251, 565
T 556/90 - 3.2.02	11.02.93		745, 746	T 752/90 - 3.2.03	08.12.92		266
T 562/90 - 3.2.02	30.10.92		101	T 755/90 - 3.3.03	01.09.92		459, 742
T 565/90 - 3.3.01	15.09.92		111, 130	T 758/90 - 3.3.02	14.07.94		793
T 572/90 - 3.3.02	24.06.92		257	T 760/90 - 3.4.02	24.11.92		286
T 582/90 - 3.2.01	11.12.92		92, 742, 768	T 762/90 - 3.4.02	29.11.91		253, 363, 861
T 590/90 - 3.3.01	24.03.93		207	T 766/90 - 3.3.02	15.07.92		454, 458, 913
T 591/90 - 3.2.01	12.11.91		106	T 768/90 - 3.2.04	14.11.94		199
T 594/90 - 3.2.01	07.06.95		421	T 770/90 - 3.5.01	17.04.91		318
T 595/90 - 3.2.02	24.05.93	1994, 695	210, 211, 861	T 775/90 - 3.4.02	24.06.92		211
T 600/90 - 3.3.01	18.02.92		86, 782	T 776/90 - 3.4.01	28.08.91		760
T 606/90 - 3.2.05	29.01.93		372	T 811/90 - 3.2.04	02.04.92	1993, 728	630, 724, 825
T 611/90 - 3.3.03	21.02.91	1993, 50	702, 703, 742, 744, 761, 858, 862-864	T 815/90 - 3.3.04	20.10.97		244
T 612/90 - 3.3.02	07.12.93		510	T 816/90 - 3.3.02	07.09.93		179, 244, 257
T 614/90 - 3.3.03	25.02.94		459	T 830/90 - 3.2.01	23.07.93	1994, 713	79, 92, 546, 554, 784, 836, 907
T 621/90 - 3.5.01	22.07.91		862	T 833/90 - 3.3.03	19.05.94		848
T 622/90 - 3.4.02	13.11.91		258	T 835/90 - 3.4.02	01.10.92		880
T 626/90 - 3.3.02	02.12.93		174, 898, 906	T 842/90 - 3.2.01	20.08.93		484, 536
T 628/90 - 3.5.01	25.11.91		711				
T 629/90 - 3.5.02	04.04.91	1992, 654	719				

T 850/90 - 3.2.01 10.06.92	275	T 75/91 - 3.2.03 11.01.93	921
T 852/90 - 3.3.01 02.06.92	865	T 79/91 - 3.4.02 21.02.92	270, 663, 928
T 853/90 - 3.5.01 11.09.91	521, 522	T 94/91 - 3.4.02 09.09.91	299, 307
T 854/90 - 3.4.01 19.03.92 1993, 669	11, 12, 27	T 102/91 - 3.5.02 11.10.91	855
T 855/90 - 3.2.03 16.05.95	662	T 106/91 - 3.3.03 10.02.94	173
T 859/90 - 3.3.01 05.11.92	558	T 107/91 - 3.2.05 06.12.93	236
T 869/90 - 3.4.01 15.03.91	512, 531	T 108/91 - 3.2.01 17.09.92 1994, 228	368
T 872/90 - 3.2.01 27.06.91	667, 677, 684	T 109/91 - 3.3.02 15.01.92	558, 569, 570
T 876/90 - 3.5.02 05.12.91	745	T 110/91 - 3.3.01 24.04.92	742
T 877/90 - 3.3.02 28.07.92	76, 77, 782	T 118/91 - 3.2.01 28.07.92	379, 385, 696
T 883/90 - 3.2.04 01.04.93	549, 572	T 119/91 - 3.4.02 28.07.92	914
T 887/90 - 3.2.04 06.10.93	80, 87, 92, 784, 836	T 122/91 - 3.3.02 09.07.91	518
T 888/90 - 3.2.02 01.07.92 1994, 162	276	T 125/91 - 3.2.04 03.02.92	867
T 893/90 - 3.3.02 22.07.93	138, 140, 144, 145, 266, 911	T 126/91 - 3.2.01 12.05.92	229
T 895/90 - 3.2.04 23.09.93	812	T 138/91 - 3.2.01 26.01.93	719
T 896/90 - 3.2.03 22.04.94	833	T 143/91 - 3.2.03 24.09.92	596, 879
T 897/90 - 3.3.02 07.05.91	275	T 148/91 - 3.3.01 01.09.92	247
T 900/90 - 3.2.03 18.05.94	497, 504	T 153/91 - 3.2.01 09.09.93	363
T 901/90 - 3.3.02 23.09.93 1994, 556	96	T 156/91 - 3.3.01 14.01.93	235, 276
T 905/90 - 3.3.01 13.11.92 1994, 306	426, 537, 627	T 158/91 - 3.3.02 30.07.91	240
T 909/90 - 3.5.02 03.06.92	749	T 161/91 - 3.4.01 27.07.93	742
T 910/90 - 3.2.04 14.04.93	170, 171	T 166/91 - 3.2.04 15.06.93	460, 862
T 938/90 - 3.3.03 25.03.92	363, 367	T 176/91 - 3.3.03 08.04.91	247, 524, 700, 729
T 939/90 - 3.3.03 16.12.93	709	T 184/91 - 3.3.02 11.06.93	681, 865, 878, 881
T 952/90 - 3.2.02 23.11.92	282, 283	T 187/91 - 3.4.01 11.03.93 1994, 572	348
T 953/90 - 3.4.01 12.05.92	76, 103, 549	T 196/91 - 3.1.01 05.12.91	739
T 955/90 - 3.4.01 21.11.91	185	T 197/91 - 3.2.04 18.01.93	914
T 958/90 - 3.3.01 04.12.92	158	T 204/91 - 3.3.01 22.06.92	777, 781
T 961/90 - 3.2.01 07.06.95	421	T 205/91 - 3.2.02 16.06.92	64
T 969/90 - 3.4.01 12.05.92	76, 87, 102, 103	T 206/91 - 3.3.02 08.04.92	199
1991		T 209/91 - 3.2.03 23.05.91	10
T 5/91 - 3.2.03 24.06.93	217	T 212/91 - 3.3.02 16.05.95	704
T 10/91 - 3.3.03 08.01.92	367	T 214/91 - 3.2.04 23.06.92	369
T 15/91 - 3.2.05 22.06.93	161	T 221/91 - 3.2.01 08.12.92	81, 87
T 17/91 - 3.2.02 26.08.92	704, 709, 710	T 227/91 - 3.2.02 15.12.92 1994, 491	150, 269
T 24/91 - 3.2.02 05.05.94 1995, 512	56	T 228/91 - 3.2.01 27.08.92	76
T 25/91 - 3.5.01 02.06.92	459, 890, 902	T 234/91 - 3.3.02 25.06.93	187, 219
T 28/91 - 3.3.03 20.12.92	746	T 236/91 - 3.5.01 16.04.93	4, 33
T 47/91 - 3.2.03 30.06.92	186	T 243/91 - 3.2.04 24.07.91	266
T 48/91 - 3.3.02 18.11.93	902	T 244/91 - 3.2.03 01.10.93	186
T 55/91 - 3.3.02 11.07.94	449	T 245/91 - 3.3.03 21.06.94	131
T 60/91 - 3.2.01 05.10.92 1993, 551	723	T 246/91 - 3.3.01 14.09.93	172, 270
T 71/91 - 3.5.01 21.09.93	4, 32	T 247/91 - 3.3.01 30.03.82	101, 128
		T 248/91 - 3.3.02 20.06.91	522
		T 252/91 - 3.2.02 04.04.95	929

Table of cases

T 255/91 - 3.4.02	12.09.91	1993, 318	130, 402	T 441/91 - 3.4.01	18.08.92	110, 421, 782, 836
T 257/91 - 3.4.01	17.11.92		217	T 442/91 - 3.3.02	23.06.94	111, 287
T 258/91 - 3.3.01	19.02.93		122	T 452/91 - 3.3.03	05.07.95	252, 255, 642
T 263/91 - 3.2.01	04.12.92		457	T 453/91 - 3.5.01	31.05.94	6, 29
T 267/91 - 3.3.02	28.04.93		81, 86, 231, 247	T 455/91 - 3.3.02	20.06.94	1995, 684, 180, 183, 184, 212
T 270/91 - 3.2.01	01.12.92		500	T 456/91 - 3.3.03	03.11.93	232, 247, 260, 282, 285
T 285/91 - 3.4.01	15.06.93		199	T 459/91 - 3.2.03	06.06.95	898
T 289/91 - 3.3.01	10.03.93	1994, 649	171, 765, 768	T 462/91 - 3.2.02	05.07.94	76
T 297/91 - 3.2.04	16.06.94		753, 881, 897	T 470/91 - 3.3.01	11.05.92	1993, 680, 296
T 304/91 - 3.2.02	15.12.93		663	T 473/91 - 3.5.01	09.04.92	1993, 630, 495, 624, 876
T 318/91 - 3.5.01	18.08.92		757	T 478/91 - 3.2.01	02.06.93	216, 217
T 322/91 - 3.2.05	14.10.93		738	T 485/91 - 3.2.04	25.04.94	206, 881
T 327/91 - 3.5.01	19.11.93		76, 459, 548, 552, 554	T 487/91 - 3.5.01	22.01.93	236
T 334/91 - 3.2.01	09.02.93		746	T 492/91 - 3.3.01	04.01.94	295
T 349/91 - 3.4.02	10.03.93		243	T 495/91 - 3.3.01	20.07.93	164, 165, 172, 175
T 360/91 - 3.3.03	01.06.93		919	T 497/91 - 3.2.02	30.06.92	402
T 367/91 - 3.5.01	14.12.92		922	T 500/91 - 3.3.02	21.10.92	179, 183
T 369/91 - 3.3.01	15.05.92	1993, 561	130, 511, 799, 862, 905	T 506/91 - 3.3.02	03.04.92	822, 844, 879, 906
T 375/91 - 3.3.03	17.11.94		709	T 508/91 - 3.2.04	28.01.93	115
T 384/91 - 3.4.02	27.09.94	1995, 745	327, 328, 366	T 515/91 - 3.2.03	23.04.93	214
T 388/91 - 3.4.01	12.10.93		266	T 516/91 - 3.3.03	14.01.92	522
T 391/91 - 3.3.02	22.11.93		257, 266, 267	T 518/91 - 3.4.01	29.09.92	98
T 392/91 - 3.2.05	24.06.93		844, 919	T 522/91 - 3.3.03	18.11.93	280
T 393/91 - 3.3.02	12.10.94		260, 330	T 523/91 - 3.3.03	29.03.93	259, 914
T 395/91 - 3.3.04	07.12.95		546	T 525/91 - 3.2.01	25.03.92	511
T 406/91 - 3.3.01	22.10.92		250, 251	T 532/91 - 3.5.01	05.07.93	438, 810, 811
T 407/91 - 3.3.01	15.04.93		199	T 545/91 - 3.5.01	28.04.93	780
T 408/91 - 3.3.02	23.11.93		760, 906	T 548/91 - 3.3.02	07.02.94	203, 232, 247, 250, 768
T 409/91 - 3.3.01	18.03.93	1994, 653	162, 232, 239, 246, 257, 258, 276-278, 558	T 552/91 - 3.3.01	03.03.94	1995, 100, 289, 290, 342
T 410/91 - 3.2.03	13.10.93		199	T 555/91 - 3.3.02	05.05.93	217
T 411/91 - 3.3.02	10.11.93		861	T 561/91 - 3.3.03	05.12.91	1993, 736, 700
T 412/91 - 3.2.02	27.02.96		95, 106	T 563/91 - 3.2.01	01.03.93	858
T 413/91 - 3.3.02	25.06.92		509	T 566/91 - 3.3.02	18.05.94	206, 445
T 415/91 - 3.5.02	13.05.92		353	T 570/91 - 3.2.04	26.11.93	164, 165, 167, 812
T 418/91 - 3.3.02	23.08.94		232, 247, 250	T 574/91 - 3.3.02	13.08.93	857
T 420/91 - 3.2.05	17.03.93		92, 836	T 576/91 - 3.3.02	18.05.93	75
T 435/91 - 3.3.01	09.03.94	1995, 188	162, 232, 238, 246, 276, 278	T 581/91 - 3.3.03	04.08.93	373, 561
T 438/91 - 3.3.04	17.10.94		55, 57	T 582/91 - 3.2.01	11.11.92	325, 402
T 439/91 - 3.2.02	21.07.91		810	T 601/91 - 3.3.01	27.07.93	565
T 440/91 - 3.3.01	22.03.94		173	T 602/91 - 3.3.02	13.09.94	81, 82, 782

T 605/91 - 3.2.03	20.07.93	217	T 759/91 - 3.3.03	18.11.93	280
T 606/91 - 3.2.03	27.07.93	282, 285	T 766/91 - 3.3.02	29.09.93	66, 86, 186
T 613/91 - 3.2.03	05.10.93	850	T 769/91 - 3.2.01	29.03.94	817
T 617/91 - 3.2.02	22.01.97	216	T 770/91 - 3.3.02	29.04.92	548, 571
T 621/91 - 3.2.03	28.09.94	776, 784, 811, 923	T 773/91 - 3.2.05	25.03.92	874, 909
T 622/91 - 3.4.02	01.02.94	66	T 784/91 - 3.5.01	22.09.93	861
T 623/91 - 3.3.01	16.02.93	253, 263, 264	T 785/91 - 3.3.03	05.03.93	543
T 624/91 - 3.2.02	16.06.93	98	T 788/91 - 3.2.04	25.11.94	824
T 628/91 - 3.5.02	14.09.92	353	T 795/91 - 3.5.01	02.11.92	454, 458, 913
T 631/91 - 3.4.01	27.01.93	852	T 796/91 - 3.3.03	27.01.93	261
T 632/91 - 3.3.01	01.02.94	187, 852	T 799/91 - 3.2.01	03.02.94	79
T 634/91 - 3.2.02	31.05.94	79, 784, 836	T 800/91 - 3.3.04	20.07.95	172
T 640/91 - 3.4.01	29.09.93	1994, 918 623, 661, 838, 914	T 810/91 - 3.3.01	04.09.92	266
T 643/91 - 3.3.03	18.09.96	825	T 822/91 - 3.4.02	19.01.93	266
T 645/91 - 3.3.01	13.07.93	109	T 830/91 - 3.3.02	15.09.94	1994, 728 664, 691
T 651/91 - 3.2.01	18.02.93	115	T 833/91 - 3.5.01	16.04.93	4, 23, 24
T 653/91 - 3.4.01	24.09.92	461	T 834/91 - 3.3.03	31.08.93	164
T 656/91 - 3.3.02	27.09.94	222	T 842/91 - 3.2.03	11.05.93	70, 78
T 658/91 - 3.3.01	14.05.93	101, 122	T 843/91 - 3.3.01	17.03.93	1994, 818 590, 598, 861, 870
T 660/91 - 3.4.01	23.07.93	209	T 843/91 - 3.3.01	05.08.93	1994, 832 566, 871, 872
T 674/91 - 3.2.03	30.11.94	547	T 852/91 - 3.3.01	06.06.94	202
T 677/91 - 3.4.01	03.11.92	97, 218	T 856/91 - 3.4.02	08.10.92	608, 921
T 682/91 - 3.4.02	22.09.92	740, 913	T 857/91 - 3.2.03	16.11.93	100, 265
T 685/91 - 3.3.03	05.01.93	709, 745	T 860/91 - 3.3.01	03.08.93	692, 881
T 686/91 - 3.3.01	30.06.94	164, 165	T 862/91 - 3.2.04	17.03.93	215
T 688/91 - 3.5.01	21.04.93	259, 260, 275	T 867/91 - 3.3.01	12.10.93	850
T 690/91 - 3.3.04	10.01.96	870, 872	T 869/91 - 3.5.02	06.08.92	860
T 691/91 - 3.2.02	29.07.92	878, 929	T 875/91 - 3.5.02	10.03.93	745, 746
T 697/91 - 3.3.01	20.04.94	247	T 879/91 - 3.3.03	08.12.93	363
T 699/91 - 3.2.04	21.05.93	217	T 880/91 - 3.4.02	26.04.93	914
T 701/91 - 3.2.02	04.10.93	198	T 881/91 - 3.2.01	04.02.93	864
T 705/91 - 3.4.02	27.04.93	905	T 882/91 - 3.2.01	04.01.93	745
T 706/91 - 3.2.01	15.12.92	824, 855	T 884/91 - 3.4.02	08.02.94	539, 719
T 715/91 - 3.5.01	24.03.92	510, 512, 524-526	T 885/91 - 3.3.02	27.01.94	145
T 716/91 - 3.2.04	15.05.95	437	T 886/91 - 3.3.02	16.06.94	179, 183, 275
T 727/91 - 3.3.01	11.08.93	852	T 891/91 - 3.4.02	16.03.93	185
T 729/91 - 3.2.04	21.11.94	88, 89	T 894/91 - 3.3.01	16.06.92	266
T 731/91 - 3.2.03	03.05.95	172, 510	T 898/91 - 3.3.04	18.07.97	825
T 734/91 - 3.5.01	07.04.92	442, 672, 914	T 904/91 - 3.3.01	18.01.95	109
T 740/91 - 3.3.03	15.12.93	342	T 905/91 - 3.4.02	05.10.93	756
T 741/91 - 3.3.01	22.09.93	172, 705	T 907/91 - 3.2.03	08.10.93	672
T 746/91 - 3.5.01	20.10.93	865	T 908/91 - 3.2.02	16.11.93	663, 911
T 748/91 - 3.2.01	23.08.93	101, 339, 459	T 912/91 - 3.3.02	25.10.94	362, 448
T 757/91 - 3.2.03	10.03.92	870, 871	T 919/91 - 3.4.01	15.02.93	865
			T 921/91 - 3.2.05	09.12.93	880
			T 924/91 - 3.2.04	04.08.93	460

Table of cases

T 925/91 - 3.4.02	26.04.94	1995, 469	776, 784, 852, 857, 927	T 127/92 - 3.2.01	14.12.94	404, 421
T 931/91 - 3.3.03	20.04.93		236, 794	T 128/92 - 3.3.04	30.11.94	75
T 933/91 - 3.5.01	21.06.93		898	T 131/92 - 3.3.03	03.03.94	407
T 934/91 - 3.3.01	04.08.92	1994, 184	762, 840, 870	T 132/92 - 3.3.02	06.08.96	799
T 937/91 - 3.2.05	10.11.94	1996, 25	790	T 133/92 - 3.3.01	18.10.94	122, 123, 448
T 938/91 - 3.2.03	21.09.93		746, 858	T 148/92 - 3.2.03	13.09.94	906
T 939/91 - 3.3.04	05.12.94		592, 593, 925	T 160/92 - 3.4.02	27.01.94	1995, 387, 73, 425, 427, 564, 676, 678
T 942/91 - 3.3.02	09.02.94		109	T 164/92 - 3.5.01	29.04.93	1995, 387, 16, 93, 182
T 951/91 - 3.3.03	10.03.94	1995, 202	596, 701, 704, 705, 725, 728	T 179/92 - 3.4.02	01.03.94	510
T 955/91 - 3.4.01	04.02.93		897	T 180/92 - 3.4.02	29.06.94	880
T 957/91 - 3.3.03	29.09.94		407	T 182/92 - 3.3.03	06.04.93	922
T 958/91 - 3.3.02	25.03.84		78	T 188/92 - 3.3.02	15.12.92	859
T 962/91 - 3.5.02	21.04.93		15	T 189/92 - 3.2.04	07.10.92	186, 727
T 968/91 - 3.3.03	12.01.94		565	T 199/92 - 3.3.01	11.01.94	766, 777
T 972/91 - 3.5.02	12.07.93		880	T 201/92 - 3.3.03	18.07.95	701
T 985/91 - 3.2.04	23.03.94		709	T 202/92 - 3.3.01	19.07.94	448
T 986/91 - 3.2.03	06.11.95		107	T 219/92 - 3.5.01	18.11.93	718, 858
T 988/91 - 3.2.01	29.06.93		782	T 223/92 - 3.3.02	20.07.93	178, 179, 183, 242, 244
T 990/91 - 3.3.01	25.05.92		372, 917	T 227/92 - 3.4.02	01.07.93	582
1992				T 229/92 - 3.2.04	23.08.94	858
T 1/92 - 3.3.02	27.04.92	1993, 685	681, 687, 691, 823, 845	T 230/92 - 3.2.02	16.05.93	565
T 3/92 - 3.2.03	03.06.94		858	T 231/92 - 3.4.02	08.03.94	230
T 6/92 - 3.3.01	26.10.93		874	T 234/92 - 3.2.03	12.01.95	902
T 18/92 - 3.5.02	30.04.93		738	T 238/92 - 3.2.01	13.05.93	701, 715
T 26/92 - 3.2.02	27.01.94		742, 756	T 239/92 - 3.2.05	23.02.95	569, 908
T 27/92 - 3.2.01	25.07.94	1994, 853	721	T 242/92 - 3.3.02	26.05.93	232, 247
T 28/92 - 3.3.02	09.06.94		903	T 248/92 - 3.5.02	31.05.93	446
T 35/92 - 3.2.01	28.10.92		457, 913	T 252/92 - 3.4.02	17.06.93	897, 901
T 42/92 - 3.4.01	29.11.94		97	T 253/92 - 3.5.02	22.10.93	212, 861
T 44/92 - 3.2.02	15.04.94		477	T 255/92 - 3.5.02	09.09.92	873
T 45/92 - 3.3.01	09.11.93		539, 855	T 266/92 - 3.5.01	17.10.94	848, 905
T 62/92 - 3.2.04	20.06.94		287	T 267/92 - 3.3.03	04.06.96	104, 742
T 65/92 - 3.3.02	13.06.93		404, 407	T 272/92 - 3.2.01	16.08.95	100
T 77/92 - 3.2.02	13.10.95		4, 34	T 273/92 - 3.3.03	18.08.93	164, 216, 852
T 81/92 - 3.5.02	05.07.93		746, 756	T 281/92 - 3.4.02	06.11.92	266
T 82/92 - 3.3.02	04.05.94		539, 719	T 288/92 - 3.3.01	18.11.93	348, 871
T 92/92 - 3.2.01	21.09.93		175, 539, 716	T 292/92 - 3.3.02	06.09.96	221
T 104/92 - 3.3.04	06.08.96		212	T 293/92 - 3.3.03	24.08.95	809
T 110/92 - 3.2.03	12.10.94		217	T 297/92 - 3.5.01	06.10.93	626
T 111/92 - 3.5.01	03.08.92		512, 530	T 304/92 - 3.5.01	23.06.93	861, 895
T 112/92 - 3.3.02	04.08.92	1994, 192	207	T 309/92 - 3.2.01	05.01.94	794
T 113/92 - 3.3.01	17.12.92		665, 870, 871	T 315/92 - 3.5.01	27.04.93	706
T 117/92 - 3.2.01	02.12.93		715	T 321/92 - 3.5.02	13.01.93	181
				T 327/92 - 3.3.04	22.04.97	75, 164, 446, 828, 836

T 329/92 - 3.2.01	29.04.93	539, 719	T 503/92 - 3.3.03	17.03.94	247
T 330/92 - 3.2.04	10.02.94	215, 216	T 506/92 - 3.4.01	03.08.95	220
T 334/92 - 3.3.01	23.03.94	169, 172	T 511/92 - 3.2.02	27.05.93	92, 95, 97, 115
T 339/92 - 3.2.05	17.02.95	713	T 514/92 - 3.2.02	21.09.95	1996, 270
T 340/92 - 3.2.01	05.10.94	843	T 526/92 - 3.3.01	25.10.94	319
T 341/92 - 3.3.01	30.08.94	1995, 373	T 527/92 - 3.5.01	24.01.94	610
T 347/92 - 3.3.02	23.09.94	215	T 536/92 - 3.2.04	29.11.93	928
T 359/92 - 3.2.01	25.03.93	402	T 540/92 - 3.3.03	01.03.95	216
T 366/92 - 3.5.02	18.02.93	678, 873, 914	T 541/92 - 3.2.01	25.01.94	80, 87, 766, 782
T 367/92 - 3.3.03	22.08.96	349	T 543/92 - 3.3.03	13.06.94	453, 914, 915
T 371/92 - 3.3.03	02.12.93	1995, 324	T 555/92 - 3.3.02	15.11.95	288
		510, 606, 689, 849, 854	T 570/92 - 3.3.02	22.06.95	140
T 378/92 - 3.2.01	13.01.94	275	T 574/92 - 3.4.01	17.03.95	199
T 382/92 - 3.2.04	26.11.92	592, 840, 925	T 578/92 - 3.4.01	02.02.94	206
T 392/92 - 3.5.02	21.01.93	914	T 585/92 - 3.3.02	09.02.95	1996, 129
T 398/92 - 3.3.02	12.11.96	338	T 588/92 - 3.4.01	18.03.94	69, 569, 570
T 406/92 - 3.3.02	18.01.95	76, 778	T 597/92 - 3.3.01	01.03.95	1996, 135
T 407/92 - 3.2.05	20.07.95	753	T 598/92 - 3.4.01	07.12.93	265, 402
T 410/92 - 3.5.02	20.09.93	200	T 598/92 - 3.4.01	07.12.93	862
T 418/92 - 3.2.03	10.03.92	261	T 599/92 - 3.4.01	25.04.94	665, 865
T 422/92 - 3.4.02	21.02.95	109	T 601/92 - 3.2.04	20.04.95	107, 363, 880, 912
T 426/92 - 3.4.01	03.03.94	220	T 605/92 - 3.2.01	25.04.94	757
T 432/92 - 3.2.01	28.01.94	742, 753	T 612/92 - 3.3.04	28.02.96	233, 240-242
T 434/92 - 3.3.03	28.11.95	264	T 627/92 - 3.5.02	30.03.93	719
T 436/92 - 3.3.02	20.03.95	69	T 630/92 - 3.3.02	22.02.94	206
T 439/92 - 3.2.04	16.05.94	164, 165, 167, 282, 283, 287	T 631/92 - 3.3.03	11.05.95	130, 901
T 441/92 - 3.5.01	10.03.95	376, 382, 383, 679	T 637/92 - 3.2.02	21.11.95	161
T 446/92 - 3.3.01	28.03.95	813	T 645/92 - 3.3.01	12.04.94	163, 176
T 447/92 - 3.5.02	07.07.93	65, 108	T 646/92 - 3.3.02	13.09.94	859
T 453/92 - 3.3.01	20.12.94	214	T 649/92 - 3.3.04	28.09.99	767
T 455/92 - 3.2.04	05.10.93	255, 269	T 653/92 - 3.3.03	11.06.96	264, 265
T 457/92 - 3.5.01	26.09.94	862	T 654/92 - 3.5.01	03.05.94	66
T 461/92 - 3.4.02	05.07.94	214	T 656/92 - 3.3.01	04.05.95	350
T 465/92 - 3.2.02	14.10.94	1996, 32	T 657/92 - 3.3.04	06.09.94	110
T 469/92 - 3.2.02	09.09.94	402, 403, 880, 908	T 659/92 - 3.2.02	24.10.94	1995, 519
T 472/92 - 3.3.03	20.11.96	1998, 161	T 667/92 - 3.3.02	10.03.94	502, 510, 528, 529, 726
		83, 86, 89, 90, 103, 558, 564	T 675/92 - 3.4.01	10.11.93	185
T 473/92 - 3.5.01	10.03.95	477, 879	T 684/92 - 3.2.01	25.07.95	721
T 482/92 - 3.3.01	23.01.97	164	T 686/92 - 3.5.01	28.10.93	458, 913
T 484/92 - 3.3.03	30.12.93	247, 277	T 694/92 - 3.3.04	08.05.96	1997, 408
T 492/92 - 3.3.01	18.01.96	234, 237			178, 180, 186, 203, 230, 233, 240-242, 257
T 494/92 - 3.3.03	13.06.93	460	T 697/92 - 3.2.02	15.06.94	205
T 501/92 - 3.4.01	01.06.95	1996, 261	T 703/92 - 3.2.04	14.09.95	635, 636
		448, 539, 822, 828			

Table of cases

T 705/92 - 3.4.01	08.11.94	742	T 910/92 - 3.4.02	17.05.95	695
T 710/92 - 3.3.03	11.10.95	265	T 917/92 - 3.3.01	06.05.93	247
T 712/92 - 3.3.04	19.06.95	217, 219	T 918/92 - 3.2.02	08.12.94	756
T 714/92 - 3.2.04	18.09.92	591	T 920/92 - 3.4.02	19.10.95	231
T 715/92 - 3.3.02	10.02.94	799	T 923/92 - 3.3.04	08.11.95	1996, 564
T 720/92 - 3.3.03	31.05.94	267			404, 410-412
T 737/92 - 3.3.03	12.06.95	785, 789, 833	T 930/92 - 3.4.01	19.10.94	1996, 191
T 739/92 - 3.3.03	16.07.96	83	T 931/92 - 3.3.03	10.08.93	96
T 741/92 - 3.2.02	21.06.94	207	T 933/92 - 3.4.01	06.12.93	1994, 740
T 745/92 - 3.4.01	08.06.94	201	T 939/92 - 3.3.01	12.09.95	1996, 309
T 753/92 - 3.2.03	04.04.95	760, 763			162, 177, 187,
T 758/92 - 3.2.01	20.05.94	343			200, 203, 213,
T 766/92 - 3.4.01	14.05.96	220			253, 276, 278,
T 769/92 - 3.5.01	31.05.94	1995, 525	T 943/92 - 3.2.04	10.04.95	558, 671, 880
		4, 5, 21,	T 951/92 - 3.4.01	15.02.95	214, 215
		23-25, 27, 188	T 951/92 - 3.4.01	15.02.95	1996, 53
T 771/92 - 3.3.01	19.07.95	448			438, 672, 815,
T 782/92 - 3.2.01	22.06.94	81, 86, 89,			914
		558	T 952/92 - 3.4.01	17.08.94	1995, 755
T 785/92 - 3.3.02	14.12.95	269	T 955/92 - 3.3.02	26.09.95	100, 103, 879
T 790/92 - 3.5.01	29.10.93	34	T 957/92 - 3.3.01	21.12.93	372
T 792/92 - 3.4.01	29.11.93	540	T 957/92 - 3.3.01	21.12.93	171, 216
T 793/92 - 3.2.04	16.07.93	661	T 958/92 - 3.2.02	18.12.95	719
T 795/92 - 3.3.02	23.04.96	374	T 964/92 - 3.3.01	23.08.94	169
T 798/92 - 3.4.01	28.07.94	206	T 965/92 - 3.3.02	08.08.95	64
T 802/92 - 3.4.01	22.07.94	1995, 379	T 968/92 - 3.2.03	28.07.94	833
T 804/92 - 3.5.02	08.09.93	1994, 862	T 969/92 - 3.2.02	31.03.95	93
T 812/92 - 3.2.01	21.11.95	218	T 971/92 - 3.3.01	07.09.94	206
T 820/92 - 3.3.02	11.01.94	1995, 113	T 973/92 - 3.2.01	06.12.93	739
T 831/92 - 3.4.01	13.12.94	888, 894	T 986/92 - 3.2.01	28.09.94	216
T 832/92 - 3.5.01	23.06.94	817	T 996/92 - 3.3.01	23.03.93	848
T 838/92 - 3.2.01	10.01.95	475, 546, 552,	T 1000/92 - 3.3.01	11.05.94	169
		554, 569, 752,	T 1002/92 - 3.4.01	06.07.94	1995, 605
		825, 840			27, 703, 704,
T 856/92 - 3.4.02	08.02.95	448, 829			710, 712, 713,
T 861/92 - 3.3.02	01.02.93	293, 305			742, 782, 796
T 867/92 - 3.5.02	13.04.94	1995, 126	T 1011/92 - 3.2.03	16.09.94	721
T 870/92 - 3.2.05	08.08.97	731, 736, 772	T 1014/92 - 3.3.01	10.01.95	217
T 879/92 - 3.5.01	16.03.94	457, 458	T 1019/92 - 3.2.01	09.06.94	704, 706, 776,
T 881/92 - 3.3.03	22.04.96	172			786
T 882/92 - 3.3.03	22.04.96	172	T 1032/92 - 3.4.01	23.08.94	865
T 884/92 - 3.3.03	22.04.96	172	T 1037/92 - 3.4.01	29.08.96	186
T 887/92 - 3.5.01	19.04.94	34	T 1042/92 - 3.2.04	28.10.93	875
T 890/92 - 3.2.01	12.07.94	448	T 1045/92 - 3.3.03	21.10.93	281, 914
T 892/92 - 3.3.01	24.06.93	1994, 664	T 1048/92 - 3.3.01	05.12.94	124
		442, 460, 817,	T 1049/92 - 3.2.03	10.11.94	923
		914	T 1050/92 - 3.2.02	20.11.95	414
T 896/92 - 3.2.01	28.04.94	100, 760	T 1051/92 - 3.2.01	26.04.94	927
T 897/92 - 3.2.04	21.03.95	164	T 1054/92 - 3.2.02	20.06.96	82, 87, 405,
					558

T 1055/92 - 3.5.01	31.03.94	1995, 214	248, 257, 276, 277	T 169/93 - 3.3.01	10.07.96	830
T 1059/92 - 3.5.01	21.09.93		898	T 186/93 - 3.2.04	22.05.95	865
T 1063/92 - 3.3.03	15.10.93		870, 871	T 187/93 - 3.3.04	05.03.97	178, 230, 233, 241
T 1066/92 - 3.3.02	05.07.95		787, 796	T 191/93 - 3.4.02	07.06.94	339
T 1067/92 - 3.4.01	16.07.94		865	T 193/93 - 3.5.01	06.08.93	677
T 1072/92 - 3.2.03	28.06.94		214	T 195/93 - 3.3.04	04.05.95	723, 874
T 1077/92 - 3.2.02	05.12.95		216	T 203/93 - 3.4.01	01.09.94	177, 216
T 1085/92 - 3.5.02	10.11.94		77, 78	T 204/93 - 3.5.01	29.10.93	16, 23, 24, 223
T 1096/92 - 3.3.03	16.05.94		207	T 206/93 - 3.3.03	30.10.96	890, 895
T 1097/92 - 3.3.03	27.09.93		875	T 210/93 - 3.3.03	12.07.94	157, 158
T 1101/92 - 3.3.02	13.06.96		910, 914	T 219/93 - 3.3.03	16.09.93	875, 912
T 1105/92 - 3.2.04	21.01.94		167	T 220/93 - 3.3.03	30.11.93	914
1993				T 225/93 - 3.3.03	13.05.97	234, 237, 247, 249
T 26/93 - 3.5.02	16.12.94		872	T 229/93 - 3.3.01	21.02.97	664
T 28/93 - 3.2.03	07.07.94		765, 782	T 233/93 - 3.2.05	28.10.96	211, 825, 833
T 33/93 - 3.3.01	05.05.93		439, 680, 917	T 234/93 - 3.3.04	15.05.97	66, 187
T 39/93 - 3.3.03	14.02.96	1997, 134	173, 180, 469, 549	T 238/93 - 3.2.02	10.05.94	207
T 51/93 - 3.3.04	08.06.94		138, 145, 149	T 240/93 - 3.4.01	17.10.94	221
T 55/93 - 3.2.02	15.03.95		197	T 249/93 - 3.3.03	27.05.98	868
T 59/93 - 3.5.01	20.04.94		14, 28	T 252/93 - 3.2.02	07.02.95	784, 836
T 63/93 - 3.2.02	28.07.93		663	T 254/93 - 3.3.02	14.05.97	1998, 285 150, 160
T 68/93 - 3.3.01	24.01.95		101	T 255/93 - 3.4.01	27.09.94	704
T 71/93 - 3.4.02	01.06.93		98	T 263/93 - 3.3.01	12.01.94	813, 814, 817
T 74/93 - 3.3.01	09.11.94	1995, 712	56, 227, 228	T 265/93 - 3.3.02	22.09.93	539
T 81/93 - 3.2.04	12.04.95		543, 607	T 276/93 - 3.3.03	15.09.95	1996, 330 469
T 82/93 - 3.4.01	15.05.95	1996, 274	9, 54, 365, 880, 881	T 279/93 - 3.3.01	12.12.96	159, 228, 363
T 83/93 - 3.4.01	02.04.97		743, 762	T 286/93 - 3.3.01	22.11.96	209
T 85/93 - 3.4.01	17.10.96	1998, 183	714	T 291/93 - 3.2.05	22.06.95	927
T 89/93 - 3.2.01	16.05.94		663	T 292/93 - 3.2.05	13.02.97	76, 79
T 92/93 - 3.4.01	31.07.95		901	T 296/93 - 3.3.04	28.07.94	1995, 627 89, 178, 402, 404, 414, 415, 558, 722, 861
T 96/93 - 3.2.04	23.01.95		865	T 298/93 - 3.3.01	19.12.96	164
T 105/93 - 3.3.01	22.05.95		438, 815	T 306/93 - 3.3.02	30.07.96	742, 760
T 124/93 - 3.3.02	10.08.95		426	T 311/93 - 3.3.01	16.01.97	283, 401
T 125/93 - 3.3.03	04.12.96		760, 864	T 321/93 - 3.2.04	15.03.95	828
T 134/93 - 3.4.02	16.11.95		214	T 322/93 - 3.3.03	02.04.97	232, 276
T 141/93 - 3.3.03	15.03.96		116	T 325/93 - 3.3.03	11.09.97	165
T 149/93 - 3.3.02	23.03.95		177	T 326/93 - 3.5.01	29.11.94	86, 558
T 150/93 - 3.2.04	06.03.95		711	T 333/93 - 3.4.01	10.03.97	290
T 152/93 - 3.3.01	21.03.95		171, 214	T 339/93 - 3.3.04	18.04.96	768
T 153/93 - 3.3.01	21.02.94		870, 872	T 350/93 - 3.4.02	20.01.94	270, 274
T 157/93 - 3.2.03	25.07.95		275	T 351/93 - 3.2.03	01.03.95	214, 218
T 165/93 - 3.2.01	12.07.94		811	T 352/93 - 3.3.01	04.04.95	119
T 167/93 - 3.3.01	03.05.96	1997, 229	871			

Table of cases

T 356/93 - 3.3.04	21.02.95	1995, 545	36, 37, 39, 44, 46, 48, 49	T 599/93 - 3.4.01	04.10.96	35
T 365/93 - 3.2.05	27.07.95		78	T 601/93 - 3.3.01	13.09.94	518
T 374/93 - 3.3.01	04.03.97		353	T 605/93 - 3.5.01	20.01.95	315
T 375/93 - 3.2.03	02.09.94		173	T 607/93 - 3.4.02	14.02.96	105
T 377/93 - 3.2.05	29.10.93		510	T 616/93 - 3.2.04	27.06.95	169
T 378/93 - 3.4.01	06.12.95		187	T 623/93 - 3.5.02	19.10.95	66, 796
T 380/93 - 3.3.03	10.02.94		164, 172	T 630/93 - 3.5.01	27.10.93	257, 258, 260
T 381/93 - 3.5.01	12.08.94		497, 510, 517, 528	T 647/93 - 3.5.02	06.04.94	1995, 132
T 382/93 - 3.3.01	19.09.96		565			451, 608, 623, 684, 875, 877, 915, 921, 929, 930
T 404/93 - 3.5.02	28.09.94		65	T 653/93 - 3.3.01	21.10.96	131
T 410/93 - 3.3.03	16.07.96		165	T 655/93 - 3.2.03	25.10.94	209, 897, 901
T 412/93 - 3.3.04	21.11.94		180, 183, 230, 242-244, 253	T 656/93 - 3.2.02	12.03.96	197
T 419/93 - 3.3.03	19.07.95		172	T 659/93 - 3.3.03	07.09.94	232, 276, 278
T 420/93 - 3.4.01	03.06.97		717	T 660/93 - 3.4.02	19.07.96	130
T 422/93 - 3.3.01	21.09.95	1997, 24	171, 182	T 666/93 - 3.2.03	13.12.94	197
T 430/93 - 3.2.02	17.06.97		813	T 669/93 - 3.2.03	13.02.95	402
T 431/93 - 3.2.01	17.11.94		220	T 690/93 - 3.3.02	11.10.94	430
T 433/93 - 3.4.01	06.12.96	1997, 509	596, 597, 793, 815, 816	T 702/93 - 3.4.01	10.02.94	293, 879
T 441/93 - 3.3.04	27.03.96		183, 184, 414, 422	T 703/93 - 3.4.01	17.12.96	220
T 443/93 - 3.5.02	22.03.95		546, 786	T 713/93 - 3.2.02	12.02.96	197
T 463/93 - 3.4.02	19.02.96		719	T 714/93 - 3.2.01	20.11.95	739
T 467/93 - 3.2.04	13.06.95		721	T 719/93 - 3.4.02	22.09.94	741, 742
T 469/93 - 3.4.02	09.06.94		511	T 720/93 - 3.4.02	19.09.95	873
T 471/93 - 3.2.03	05.12.95		721	T 723/93 - 3.3.04	12.07.96	275
T 473/93 - 3.3.02	01.02.94		557	T 726/93 - 3.2.05	01.07.94	1995, 478
T 487/93 - 3.3.04	06.02.96		673	T 731/93 - 3.3.01	01.12.94	458
T 493/93 - 3.3.04	30.01.97		367	T 739/93 - 3.2.03	06.04.95	96
T 505/93 - 3.2.02	10.11.95		836	T 740/93 - 3.2.04	10.01.96	609, 612, 919
T 516/93 - 3.3.02	02.04.97		661	T 748/93 - 3.3.03	19.04.94	493
T 527/93 - 3.2.02	20.01.95		862	T 752/93 - 3.2.04	16.07.96	799, 830, 905
T 528/93 - 3.4.01	23.10.96		834, 844, 905, 906	T 767/93 - 3.3.04	13.11.96	415
T 540/93 - 3.2.04	08.02.94		206	T 790/93 - 3.5.02	15.07.94	925
T 549/93 - 3.2.05	02.02.94		393	T 793/93 - 3.3.03	27.09.95	98, 560
T 556/93 - 3.3.03	19.02.97		276	T 795/93 - 3.3.01	29.10.96	162-164, 176, 216, 549
T 582/93 - 3.5.01	23.06.94		93	T 798/93 - 3.2.01	20.06.96	1997, 363
T 583/93 - 3.3.03	04.01.96	1996, 496	203, 276, 354, 906			548, 719, 766, 768
T 588/93 - 3.3.02	31.01.96		175, 250	T 803/93 - 3.4.01	19.07.95	1996, 204
T 589/93 - 3.2.01	15.06.94	1995, 387	677, 678			584, 881
T 590/93 - 3.3.01	10.05.94	1995, 337	766, 768	T 805/93 - 3.3.03	20.02.97	250
T 597/93 - 3.2.02	17.02.97		198	T 813/93 - 3.3.01	17.10.94	172
				T 815/93 - 3.3.03	19.06.96	116
				T 817/93 - 3.4.02	30.11.94	816
				T 818/93 - 3.2.02	02.04.96	81, 85, 173, 205, 206, 229, 338

T 822/93 - 3.3.02	23.05.95	508	T 1052/93 - 3.3.01	10.01.96	405
T 823/93 - 3.2.04	18.10.96	79	T 1056/93 - 3.2.01	16.01.96	402
T 825/93 - 3.4.01	14.01.97	182	T 1062/93 - 3.3.02	30.04.97	174
T 828/93 - 3.4.02	07.05.96	421, 905	T 1072/93 - 3.3.03	18.09.97	826
T 829/93 - 3.4.02	24.05.96	801	T 1074/93 - 3.3.04	15.12.98	175
T 840/93 - 3.3.02	11.07.95	1996, 335	T 1076/93 - 3.4.02	16.02.95	80, 84
		834, 890, 903, 905	T 1077/93 - 3.3.02	30.05.96	57, 58
T 847/93 - 3.4.02	31.01.95	711, 742, 748, 858, 864	T 1082/93 - 3.3.03	14.11.97	414
T 848/93 - 3.4.01	03.02.98	156	1994		
T 860/93 - 3.3.03	29.12.93	1995, 47	T 2/94 - 3.4.01	04.02.98	182
		247, 269, 270, 282, 285, 286, 923	T 20/94 - 3.3.01	04.11.98	291, 364
T 861/93 - 3.3.03	29.04.94	716	T 27/94 - 3.2.01	14.05.96	872
T 863/93 - 3.5.01	17.02.94	921	T 34/94 - 3.4.02	22.03.94	86, 784, 836
T 866/93 - 3.3.01	08.09.97	109	T 45/94 - 3.2.01	02.11.94	536
T 870/93 - 3.4.01	18.02.98	456	T 51/94 - 3.5.02	08.06.94	623, 923
T 884/93 - 3.3.03	05.09.96	286	T 61/94 - 3.5.01	12.10.95	257, 258, 277
T 885/93 - 3.3.03	15.02.96	469	T 63/94 - 3.3.04	18.01.95	180
T 889/93 - 3.5.02	10.02.95	345	T 68/94 - 3.3.04	11.08.99	446
T 915/93 - 3.3.04	22.04.94	180	T 69/94 - 3.3.02	18.06.96	169, 898
T 919/93 - 3.3.04	18.11.98	415, 416	T 77/94 - 3.2.03	28.04.98	88
T 926/93 - 3.4.01	01.10.96	1997, 447	T 86/94 - 3.3.03	08.07.97	837
		787	T 89/94 - 3.3.03	05.07.94	453, 915
T 928/93 - 3.4.02	23.01.97	100, 791	T 97/94 - 3.3.03	15.07.97	1998, 467
T 932/93 - 3.2.01	31.01.95	851			90, 469, 472, 559, 715
T 937/93 - 3.2.04	04.03.97	546, 554	T 98/94 - 3.3.02	13.07.05	337
T 943/93 - 3.4.01	03.08.94	94	T 105/94 - 3.2.02	29.07.97	885
T 951/93 - 3.3.04	17.09.97	726, 728	T 118/94 - 3.4.01	12.02.98	209
T 954/93 - 3.3.03	06.02.97	462, 570	T 125/94 - 3.3.02	29.05.96	866
T 956/93 - 3.2.04	17.11.94	510	T 134/94 - 3.3.02	12.11.96	414
T 961/93 - 3.2.04	14.01.94	857	T 135/94 - 3.5.01	12.06.95	206
T 970/93 - 3.2.01	15.03.96	398, 548, 553, 559, 742	T 143/94 - 3.3.02	06.10.95	1996, 430
T 972/93 - 3.4.02	16.06.94	656			140, 149
T 973/93 - 3.4.02	15.06.94	656	T 144/94 - 3.3.06	12.10.99	922
T 977/93 - 3.3.04	30.03.99	99	T 164/94 - 3.3.01	11.11.96	220
T 986/93 - 3.2.01	25.04.95	1996, 215	T 189/94 - 3.2.01	12.01.95	353
		794, 838	T 190/94 - 3.5.01	26.10.95	20
T 988/93 - 3.4.01	04.07.96	782	T 200/94 - 3.3.01	23.10.97	177, 564
T 989/93 - 3.3.01	16.04.97	164, 165, 203	T 207/94 - 3.3.04	08.04.97	1999, 273
T 999/93 - 3.4.02	09.03.95	616, 687			178, 180, 183, 415
T 1016/93 - 3.2.01	23.03.95	703, 742, 743	T 209/94 - 3.3.03	11.10.96	128
T 1022/93 - 3.3.01	05.10.95	755	T 212/94 - 3.5.02	11.10.96	14
T 1027/93 - 3.4.02	11.11.94	200	T 223/94 - 3.2.04	16.02.96	197, 199
T 1039/93 - 3.5.02	08.02.96	345	T 226/94 - 3.4.01	20.03.96	199
T 1040/93 - 3.2.04	16.05.95	164, 167	T 238/94 - 3.2.01	11.06.97	917
T 1049/93 - 3.3.01	03.08.99	448	T 239/94 - 3.5.01	15.09.95	109
T 1050/93 - 3.3.03	07.11.96	263	T 240/94 - 3.5.01	04.12.96	900
			T 259/94 - 3.3.01	11.08.98	714

Table of cases

T 270/94 - 3.3.01	22.01.98	765, 815	T 520/94 - 3.4.01	07.07.94	673		
T 284/94 - 3.4.01	25.11.98	1999, 464	324	T 522/94 - 3.2.05	22.09.97	1998, 421	765, 781
T 286/94 - 3.2.01	22.06.95	702	T 529/94 - 3.3.02	09.10.97	459, 666		
T 295/94 - 3.2.04	26.07.94	216	T 530/94 - 3.3.10	20.04.98	260		
T 301/94 - 3.3.02	28.11.96	76, 104, 546	T 533/94 - 3.3.01	23.03.95	779		
T 305/94 - 3.3.03	20.06.96	709	T 534/94 - 3.3.01	23.03.95	779		
T 309/94 - 3.3.03	19.03.97	673, 916	T 542/94 - 3.2.01	07.05.96	383		
T 311/94 - 3.3.01	28.06.94	680	T 544/94 - 3.3.02	22.01.97	207, 751		
T 312/94 - 3.4.01	04.09.97	93, 96, 116	T 552/94 - 3.3.01	04.12.98	414		
T 323/94 - 3.2.04	26.09.96	832	T 557/94 - 3.2.05	12.12.96	639, 868		
T 324/94 - 3.4.01	07.05.96	198, 200	T 561/94 - 3.3.01	06.12.96	221		
T 332/94 - 3.3.01	18.02.98	278	T 575/94 - 3.2.01	11.07.96	546, 552, 906		
T 334/94 - 3.3.03	25.09.97	585, 586	T 586/94 - 3.3.06	29.09.99	249		
T 341/94 - 3.3.02	13.07.95	214	T 590/94 - 3.3.03	03.05.96	64, 187, 341,		
T 348/94 - 3.2.02	21.10.98	74, 560			721, 765, 772		
T 356/94 - 3.2.01	30.06.95	444, 709	T 609/94 - 3.4.02	27.02.97	873		
T 363/94 - 3.2.03	22.11.95	198	T 610/94 - 3.4.02	20.06.96	898		
T 372/94 - 3.3.01	14.08.96	851	T 619/94 - 3.2.02	12.12.95	210		
T 373/94 - 3.3.02	31.07.98	168, 186, 217	T 620/94 - 3.5.02	13.06.95	402, 422		
T 382/94 - 3.4.02	17.04.97	1998, 24	315, 316, 646	T 631/94 - 3.2.05	28.03.95	1996, 67	604, 720
T 385/94 - 3.3.04	24.06.97	162	T 635/94 - 3.2.03	25.04.95	531		
T 386/94 - 3.3.04	11.01.96	1996, 658	179, 240	T 641/94 - 3.2.01	01.02.96	750	
T 387/94 - 3.3.04	07.03.97	183	T 645/94 - 3.3.05	22.10.97	213		
T 397/94 - 3.4.02	05.04.95	914	T 648/94 - 3.3.01	26.10.94	875		
T 401/94 - 3.3.03	18.08.94	120	T 667/94 - 3.3.02	16.10.97	569, 570		
T 405/94 - 3.4.02	12.07.95	441	T 668/94 - 3.3.01	20.10.98	203		
T 406/94 - 3.3.05	17.12.97	128	T 671/94 - 3.3.01	11.06.96	187		
T 412/94 - 3.3.01	05.06.96	221	T 673/94 - 3.3.02	07.05.98	337		
T 414/94 - 3.4.02	14.05.98	448	T 676/94 - 3.2.01	06.02.96	67, 230		
T 426/94 - 3.3.02	22.05.96	264	T 681/94 - 3.2.01	18.06.96	220		
T 432/94 - 3.3.01	19.06.97	837	T 687/94 - 3.2.02	23.04.96	173, 198		
T 455/94 - 3.2.04	10.12.96	177	T 697/94 - 3.4.01	28.04.97	216		
T 462/94 - 3.5.01	10.01.96	866	T 698/94 - 3.3.03	17.02.97	610		
T 464/94 - 3.3.04	21.05.97	94, 95, 416,	T 712/94 - 3.2.03	14.11.96	746		
		560, 566	T 715/94 - 3.4.02	13.11.97	837		
T 467/94 - 3.3.01	04.11.99	203	T 731/94 - 3.2.01	15.02.96	198		
T 469/94 - 3.3.02	01.07.97	56, 60, 155	T 740/94 - 3.2.03	09.05.96	808, 915		
T 479/94 - 3.5.01	31.07.95	914	T 750/94 - 3.4.01	01.04.97	1998, 32	86, 89, 90,	
T 486/94 - 3.2.03	10.03.97	742				554, 558, 569,	
T 488/94 - 3.4.02	02.07.97	541, 543				673	
T 490/94 - 3.4.02	11.12.97	266	T 751/94 - 3.4.03	12.05.99	130		
T 498/94 - 3.3.04	22.06.98	244	T 752/94 - 3.3.01	24.05.00	257		
T 501/94 - 3.5.02	10.07.96	1997, 376	717	T 772/94 - 3.5.01	20.03.96	164	
T 503/94 - 3.2.04	11.10.95	710	T 780/94 - 3.5.01	24.10.96	175		
T 510/94 - 3.3.04	21.04.98	243	T 792/94 - 3.2.05	11.10.00	317		
T 513/94 - 3.3.04	23.04.98	243	T 794/94 - 3.3.04	17.09.98	801, 892, 898		
T 515/94 - 3.3.04	29.10.97	861	T 796/94 - 3.5.02	27.11.95	657		

T 804/94 - 3.2.01	10.07.95		398, 442, 924	T 78/95 - 3.3.04	27.09.96		719
T 808/94 - 3.4.02	26.01.95		453, 460, 678, 929	T 86/95 - 3.2.02	09.09.97		74
T 817/94 - 3.2.04	30.07.96		167, 212	T 104/95 - 3.3.04	16.09.97		201
T 825/94 - 3.3.01	25.02.00		140, 276	T 111/95 - 3.3.02	13.03.96		467, 468
T 826/94 - 3.4.02	30.11.95		111	T 112/95 - 3.2.01	19.02.98		327
T 828/94 - 3.5.01	18.10.96		516, 527	T 114/95 - 3.2.01	08.04.97		787
T 833/94 - 3.5.01	20.08.98		566, 740	T 121/95 - 3.4.01	03.02.98		673, 685
T 840/94 - 3.3.01	26.03.96	1996, 680	496, 498	T 134/95 - 3.2.01	22.10.96		362
T 848/94 - 3.3.03	03.06.97		86, 90, 220, 559	T 136/95 - 3.2.01	25.02.97	1998, 480	403
T 853/94 - 3.3.02	02.11.98		140	T 138/95 - 3.3.04	12.10.99		140
T 856/94 - 3.3.04	05.06.97		180	T 142/95 - 3.2.03	04.05.98		919
T 859/94 - 3.3.06	21.09.99		321, 348	T 144/95 - 3.2.04	26.02.99		721, 722
T 861/94 - 3.2.02	19.09.95		430	T 151/95 - 3.3.02	18.06.98		289
T 871/94 - 3.2.04	24.10.96		167	T 152/95 - 3.5.02	03.07.96		776, 862
T 873/94 - 3.4.01	10.07.96	1997, 456	355, 382	T 154/95 - 3.2.01	27.01.98		796
T 882/94 - 3.3.03	07.08.97		220	T 156/95 - 3.3.01	30.03.98		203
T 892/94 - 3.3.02	19.01.99	2000, 1	159, 160, 449	T 165/95 - 3.5.02	07.07.97		739
T 900/94 - 3.3.02	09.09.98		833, 904	T 172/95 - 3.3.03	05.03.98		406
T 905/94 - 3.2.03	11.06.96		555, 557	T 180/95 - 3.3.01	02.12.96		875
T 912/94 - 3.4.01	06.05.97		171, 199	T 181/95 - 3.5.02	12.09.96		274, 275
T 913/94 - 3.3.02	27.02.98		210	T 183/95 - 3.5.01	25.06.96		929
T 917/94 - 3.3.06	28.10.99		111, 349	T 187/95 - 3.4.02	03.02.97		438, 672
T 918/94 - 3.3.04	06.07.95		727	T 188/95 - 3.3.02	04.12.97		439
T 921/94 - 3.3.01	30.10.98		439, 919	T 189/95 - 3.3.02	29.02.00		160
T 922/94 - 3.3.03	30.10.97		792, 807	T 193/95 - 3.4.01	26.11.98		414, 416
T 929/94 - 3.4.01	07.07.98		569, 729	T 211/95 - 3.5.02	09.07.97		375, 379
T 930/94 - 3.3.01	15.10.97		162, 203	T 223/95 - 3.5.02	04.03.97		789, 862
T 949/94 - 3.5.02	24.03.95		495, 496, 526, 624	T 227/95 - 3.5.01	11.4.96		610, 923
T 953/94 - 3.5.01	15.07.96		14, 223	T 231/95 - 3.2.01	04.06.96		895
T 958/94 - 3.3.02	30.09.96	1997, 241	139	T 236/95 - 3.2.01	16.07.96		353
T 960/94 - 3.3.04	13.09.00		593, 915, 925	T 240/95 - 3.3.06	06.07.99		130
T 977/94 - 3.2.01	18.12.97		279, 868	T 241/95 - 3.3.02	14.06.00	2001, 103	57, 152, 267
1995				T 252/95 - 3.3.02	21.08.98		711, 855
T 3/95 - 3.2.04	24.09.97		776, 855	T 253/95 - 3.3.03	17.12.97		826
T 7/95 - 3.5.01	23.07.96		812	T 272/95 - 3.3.04	15.04.99	1999, 590	40, 769
T 9/95 - 3.2.03	09.04.97		742	T 274/95 - 3.4.01	02.02.96	1997, 99	789, 795
T 27/95 - 3.2.03	25.06.96		792	T 277/95 - 3.3.04	16.04.99		405
T 32/95 - 3.5.02	28.10.96		565	T 280/95 - 3.5.02	23.10.96		177
T 35/95 - 3.2.04	01.10.96		167	T 281/95 - 3.5.02	24.09.96		852
T 68/95 - 3.3.01	23.09.97		172	T 289/95 - 3.2.01	04.03.97		382
T 70/95 - 3.3.04	12.01.99		166	T 301/95 - 3.2.05	27.06.97	1997, 519	767
T 72/95 - 3.3.05	18.03.98		191, 199, 200	T 301/95 - 3.2.05	28.03.00		727
T 73/95 - 3.3.03	18.03.99		219	T 317/95 - 3.3.02	26.02.99		147
				T 321/95 - 3.4.02	06.11.96		429
				T 322/95 - 3.3.03	10.08.99		216, 702
				T 325/95 - 3.4.02	18.11.97		356
				T 337/95 - 3.3.01	30.01.96	1996, 628	252

Table of cases

T 338/95 - 3.3.01	30.01.96	252	T 632/95 - 3.2.03	22.10.96	567
T 343/95 - 3.3.04	17.11.97	425, 429, 558	T 639/95 - 3.3.04	21.01.98	240, 242
T 349/95 - 3.2.04	14.02.97	219	T 665/95 - 3.2.03	01.03.99	554
T 353/95 - 3.3.02	25.07.00	825	T 670/95 - 3.3.05	09.06.98	731, 732
T 364/95 - 3.2.04	20.11.96	402	T 671/95 - 3.3.03	15.01.96	913
T 373/95 - 3.3.02	06.12.96	101	T 681/95 - 3.4.02	02.11.95	510
T 389/95 - 3.5.02	15.10.97	701, 858	T 693/95 - 3.2.03	23.10.00	455, 464, 750
T 396/95 - 3.3.02	17.09.96	353	T 706/95 - 3.3.05	22.05.00	160
T 401/95 - 3.3.01	28.01.99	828, 901	T 708/95 - 3.4.02	16.12.96	858
T 402/95 - 3.4.01	06.10.99	182	T 715/95 - 3.3.06	19.12.00	762
T 434/95 - 3.2.03	17.06.97	198, 749, 750	T 717/95 - 3.2.04	23.04.98	742
T 436/95 - 3.4.02	29.09.00	870, 871	T 727/95 - 3.3.04	21.05.99	2001, 1
T 442/95 - 3.3.04	26.09.96	667	T 736/95 - 3.3.04	09.10.00	2001, 191
T 446/95 - 3.2.02	23.03.99	720, 723, 724	T 737/95 - 3.2.03	21.11.97	397
T 460/95 - 3.5.01	20.10.97	1998, 587	T 738/95 - 3.2.03	19.09.07	360
		425, 430, 431,	T 739/95 - 3.2.04	26.06.97	167
		522, 523, 851,	T 749/95 - 3.4.02	16.07.97	290
		908	T 752/95 - 3.2.03	22.06.99	782
T 463/95 - 3.5.02	29.01.97	800	T 767/95 - 3.3.04	05.09.00	120
T 476/95 - 3.2.01	20.06.96	593	T 772/95 - 3.2.01	30.09.97	758
T 480/95 - 3.4.02	05.11.96	81	T 786/95 - 3.2.04	13.10.97	779
T 481/95 - 3.4.02	15.05.97	834	T 789/95 - 3.4.02	13.03.97	810
T 482/95 - 3.3.03	28.08.95	276	T 792/95 - 3.2.01	05.08.97	805
T 487/95 - 3.2.04	07.08.97	165, 167	T 794/95 - 3.4.02	07.07.97	875, 929
T 493/95 - 3.2.04	22.10.96	500, 521, 855	T 795/95 - 3.2.01	06.10.98	360
T 494/95 - 3.2.04	30.06.97	814	T 798/95 - 3.3.01	06.12.95	605, 692
T 506/95 - 3.5.02	05.02.97	164	T 804/95 - 3.3.01	04.12.97	531
T 530/95 - 3.3.04	10.06.97	183	T 809/95 - 3.2.01	29.04.97	76, 82, 412,
T 531/95 - 3.2.01	26.08.97	214, 215			413
T 532/95 - 3.3.01	04.03.99	701	T 838/95 - 3.3.02	09.12.99	186
T 543/95 - 3.2.03	10.11.97	72, 545, 546	T 839/95 - 3.3.05	23.06.98	543, 680, 728
T 556/95 - 3.5.01	08.08.96	1997, 205	T 841/95 - 3.4.02	13.06.96	261
T 558/95 - 3.2.01	10.02.97	398, 547, 548,	T 849/95 - 3.2.02	15.12.98	752
		718, 816	T 850/95 - 3.3.02	12.07.96	1997, 152
T 576/95 - 3.2.03	15.04.97	170	T 860/95 - 3.3.05	27.10.99	269, 270
T 582/95 - 3.2.01	28.01.97	811, 813	T 870/95 - 3.4.02	14.07.98	111, 116
T 583/95 - 3.2.03	22.12.97	828	T 881/95 - 3.2.01	25.06.97	235, 467
T 585/95 - 3.2.01	10.12.96	746	T 897/95 - 3.4.03	22.02.00	198
T 589/95 - 3.3.03	05.11.98	199	T 900/95 - 3.5.02	05.11.97	214
T 592/95 - 3.4.01	09.09.98	290	T 901/95 - 3.5.02	29.10.98	87
T 600/95 - 3.3.01	28.11.96	93	T 908/95 - 3.2.01	21.07.97	728
T 609/95 - 3.3.02	27.08.98	343	T 917/95 - 3.2.04	01.08.01	452, 461
T 610/95 - 3.3.02	21.07.99	97, 206, 801,	T 919/95 - 3.2.02	16.01.97	876
		802	T 923/95 - 3.2.02	12.11.96	425, 432
T 611/95 - 3.2.05	13.07.99	70	T 931/95 - 3.5.01	08.09.00	2001, 441
T 615/95 - 3.3.01	16.12.97	321, 611, 875			1, 2, 4-6, 10,
T 616/95 - 3.3.06	17.02.99	276			12, 25-27,
T 628/95 - 3.4.01	13.05.96	597			188-191

T 938/95 - 3.2.01 06.03.97	325	T 239/96 - 3.5.01 23.10.98	832
T 939/95 - 3.5.01 23.01.98 1998, 481	877, 908, 928	T 243/96 - 3.2.02 25.05.98	74
T 960/95 - 3.3.03 31.03.99	220, 539, 765, 774	T 262/96 - 3.3.05 25.08.99	112
T 971/95 - 3.4.03 15.09.00	164	T 276/96 - 3.4.02 17.06.97	363
T 980/95 - 3.3.03 18.02.98	275	T 284/96 - 3.3.01 20.07.99	171, 214
T 989/95 - 3.3.04 06.05.99	268	T 296/96 - 3.3.01 12.01.00	318, 432, 441
T 994/95 - 3.3.04 18.02.99	239	T 319/96 - 3.2.03 11.12.98	312, 669
T 1002/95 - 3.2.01 10.02.98	830	T 339/96 - 3.5.02 21.10.98	173
T 1007/95 - 3.3.03 17.11.98 1999, 733	858	T 349/96 - 3.2.05 22.09.98	187
1996		T 366/96 - 3.3.06 17.02.00	121
T 24/96 - 3.2.04 04.03.99	801	T 367/96 - 3.4.02 03.12.97	619, 807
T 29/96 - 3.2.04 16.09.97	747, 754	T 373/96 - 3.2.02 25.05.00	905
T 37/96 - 3.3.06 07.02.00	70, 72	T 379/96 - 3.3.02 13.01.99	185
T 43/96 - 3.5.02 05.07.96	524	T 382/96 - 3.3.03 07.07.99	540, 838, 856, 892
T 48/96 - 3.5.01 25.08.98	88, 555	T 395/96 - 3.3.06 11.06.99	209
T 59/96 - 3.3.01 07.04.99	164, 165	T 405/96 - 3.2.01 08.11.96	913
T 64/96 - 3.2.01 30.09.97	328	T 410/96 - 3.5.01 25.07.97	260
T 65/96 - 3.3.03 18.03.98	132, 855	T 429/96 - 3.3.04 31.05.01	231
T 79/96 - 3.3.05 20.10.98	111	T 431/96 - 3.3.04 23.02.99	244
T 80/96 - 3.3.02 16.06.99 2000, 50	113, 228	T 452/96 - 3.3.02 05.04.00	214, 469
T 92/96 - 3.5.02 12.09.97	673	T 458/96 - 3.4.02 07.10.98	282, 283
T 107/96 - 3.2.05 25.11.98	418	T 475/96 - 3.3.03 15.06.99	702
T 113/96 - 3.2.04 19.12.97	714, 716	T 476/96 - 3.3.03 29.04.99	469
T 115/96 - 3.2.04 25.02.97	199	T 477/96 - 3.4.03 25.07.00	188
T 120/96 - 3.2.03 06.02.97	442, 817	T 481/96 - 3.4.02 16.09.96	738
T 135/96 - 3.2.01 20.01.97	610, 867, 920	T 488/96 - 3.3.01 07.12.99	257
T 142/96 - 3.2.02 14.04.99	845, 876, 878	T 503/96 - 3.5.02 12.01.99	808
T 158/96 - 3.3.02 28.10.98	93, 151	T 505/96 - 3.5.01 15.12.98	212
T 161/96 - 3.3.04 03.11.97 1999, 331	425, 430, 433, 624	T 522/96 - 3.2.01 07.05.98	350
T 165/96 - 3.3.06 30.05.00	70, 77	T 528/96 - 3.5.01 18.11.98	455, 456
T 167/96 - 3.5.02 16.05.97	911	T 532/96 - 3.3.03 13.07.99	140
T 169/96 - 3.3.01 30.07.96	294, 310, 541, 542, 685	T 541/96 - 3.4.01 07.03.01	224, 251
T 173/96 - 3.3.02 16.01.98	263	T 542/96 - 3.3.02 11.05.00	149
T 181/96 - 3.4.02 12.02.97	266	T 549/96 - 3.3.01 09.03.99	451, 542, 543
T 191/96 - 3.2.01 02.04.98	858	T 556/96 - 3.2.02 24.03.00	755
T 194/96 - 3.3.02 10.10.96	458	T 561/96 - 3.4.02 16.01.97	232
T 218/96 - 3.2.03 15.09.98	209	T 574/96 - 3.3.01 30.07.99	254
T 223/96 - 3.3.04 29.01.99	288	T 608/96 - 3.3.01 11.07.00	107
T 225/96 - 3.2.03 03.04.98	616, 924	T 610/96 - 3.5.02 10.11.98	129
T 233/96 - 3.3.02 04.05.00	144	T 624/96 - 3.4.02 06.02.97	495, 521
T 234/96 - 3.2.05 04.12.97	187, 211	T 626/96 - 3.2.01 10.01.97	216, 218
T 237/96 - 3.4.02 22.04.98	451, 665, 685, 688, 838	T 637/96 - 3.2.04 27.11.97	830
		T 643/96 - 3.3.01 14.10.96	202, 203, 421, 440
		T 648/96 - 3.5.02 16.03.98	799, 808, 898, 919

Table of cases

T 656/96 - 3.2.03	21.06.99	815	T 1037/96 - 3.2.04	04.06.98	799
T 674/96 - 3.3.02	29.04.99	237, 801	T 1046/96 - 3.3.04	19.01.98	373
T 686/96 - 3.3.05	06.05.99	112	T 1051/96 - 3.3.04	13.07.99	681
T 697/96 - 3.3.02	07.10.99	205	T 1054/96 - 3.3.04	13.10.97	1998, 511
T 708/96 - 3.5.01	14.11.97	165	T 1060/96 - 3.2.03	26.01.99	864
T 711/96 - 3.2.04	17.06.98	198	T 1062/96 - 3.3.01	11.12.97	510, 526
T 717/96 - 3.2.04	10.07.97	199	T 1066/96 - 3.4.02	08.07.99	688
T 718/96 - 3.2.01	30.06.98	224	T 1069/96 - 3.2.01	10.05.00	777
T 730/96 - 3.3.01	19.10.99	163, 164, 222	T 1070/96 - 3.2.02	13.01.00	794, 863
T 737/96 - 3.3.04	09.03.00	180	T 1073/96 - 3.3.02	01.09.99	160
T 740/96 - 3.2.06	26.10.00	111, 287	T 1105/96 - 3.4.01	09.07.97	1998, 249
T 742/96 - 3.2.05	09.06.97	1997, 533			541, 542, 544, 666
T 750/96 - 3.4.03	27.11.01	266	T 1109/96 - 3.3.03	18.02.99	313
T 755/96 - 3.3.01	06.08.99	2000, 174			
T 785/96 - 3.3.03	18.04.00	715			
T 789/96 - 3.4.01	23.08.01	2002, 364			
T 791/96 - 3.3.04	15.11.99	183			
T 809/96 - 3.2.05	20.07.01	739			
T 811/96 - 3.3.06	09.03.00	321			
T 819/96 - 3.3.01	02.02.99	221, 475			
T 821/96 - 3.3.01	25.04.01	441			
T 823/96 - 3.3.01	28.01.97	115, 349, 350, 410			
T 850/96 - 3.2.03	14.01.98	539, 579			
T 855/96 - 3.3.05	10.11.99	713, 837			
T 867/96 - 3.3.02	21.06.00	619			
T 869/96 - 3.2.03	10.11.98	197			
T 870/96 - 3.4.02	16.07.98	166, 167			
T 886/96 - 3.2.06	06.07.01	721			
T 890/96 - 3.3.06	09.09.99	560			
T 898/96 - 3.4.01	10.01.97	857, 915, 929			
T 936/96 - 3.3.05	11.06.99	220			
T 946/96 - 3.3.01	23.06.97	673			
T 947/96 - 3.4.03	07.12.99	350			
T 953/96 - 3.3.02	25.06.97	392			
T 957/96 - 3.3.01	28.01.97	307			
T 961/96 - 3.3.01	10.02.00	168			
T 986/96 - 3.4.01	10.08.00	171, 182			
T 989/96 - 3.2.06	05.07.01	721			
T 990/96 - 3.3.01	12.02.98	1998, 489			
T 1003/96 - 3.2.03	06.02.01	565			
T 1004/96 - 3.2.04	17.10.97	917			
T 1008/96 - 3.2.03	25.06.03	398			
T 1018/96 - 3.2.03	28.10.98	197			
T 1028/96 - 3.2.01	15.09.99	2000, 475			
T 1029/96 - 3.3.01	21.08.01	88			
T 1032/96 - 3.3.03	26.05.00	907			
1997					
T 1/97 - 3.2.01	30.03.99	850			
T 10/97 - 3.4.02	07.10.99	330			
T 15/97 - 3.3.01	08.11.00	199			
T 17/97 - 3.3.01	14.11.00	922			
T 19/97 - 3.3.04	31.07.01	731, 732, 736			
T 25/97 - 3.2.01	19.07.00	206			
T 27/97 - 3.5.01	30.05.00	30, 191, 193			
T 36/97 - 3.2.03	23.10.01	516			
T 37/97 - 3.3.05	22.11.99	464			
T 40/97 - 3.2.01	01.12.98	318			
T 41/97 - 3.2.01	15.04.98	877, 912			
T 43/97 - 3.4.01	10.10.01	206			
T 56/97 - 3.3.02	30.08.01	145, 147			
T 59/97 - 3.2.04	24.07.98	288			
T 63/97 - 3.2.04	01.12.97	176			
T 65/97 - 3.2.04	15.06.00	905			
T 66/97 - 3.4.02	09.01.98	166			
T 77/97 - 3.3.01	03.07.97	401, 409			
T 83/97 - 3.3.04	16.03.99	868			
T 100/97 - 3.2.05	16.06.00	558			
T 103/97 - 3.4.02	06.11.98	812			
T 106/97 - 3.2.03	16.09.99	713			
T 123/97 - 3.2.01	10.09.98	216			
T 142/97 - 3.4.01	02.12.99	2000, 358			
T 153/97 - 3.3.02	02.12.98	169			
T 157/97 - 3.3.05	18.03.98	191, 199			
T 158/97 - 3.3.05	04.04.00	191, 199			
T 162/97 - 3.2.04	30.06.99	858			
T 167/97 - 3.2.02	16.11.98	1999, 488			
T 170/97 - 3.2.04	23.02.98	176			
T 176/97 - 3.3.05	18.03.98	191, 199			
T 186/97 - 3.4.02	15.09.97	510			

T 188/97 - 3.3.04	08.02.01		404, 414, 723	T 550/97 - 3.5.01	21.09.99		215
T 191/97 - 3.3.03	03.02.99		221	T 552/97 - 3.5.02	04.11.97		452, 539, 910
T 202/97 - 3.5.02	10.02.99		83	T 568/97 - 3.3.02	21.02.02		266, 278
T 212/97 - 3.5.02	08.06.99		474, 475, 555, 618, 775, 782	T 577/97 - 3.3.05	05.04.00		900
T 223/97 - 3.2.01	03.11.98		802	T 584/97 - 3.3.02	05.12.01		145, 148
T 227/97 - 3.3.04	09.10.98	1999, 495	245, 505	T 586/97 - 3.3.01	14.09.00		252, 253, 268, 276, 277
T 231/97 - 3.3.01	21.03.00		202, 219	T 594/97 - 3.2.04	12.10.01		832
T 255/97 - 3.3.05	12.05.00		216	T 596/97 - 3.2.04	10.06.98		270
T 258/97 - 3.5.01	08.02.02		193	T 598/97 - 3.4.02	10.08.98		727
T 265/97 - 3.4.01	04.05.01		266	T 611/97 - 3.5.02	19.05.99		86
T 266/97 - 3.2.03	22.06.98		849	T 613/97 - 3.3.01	26.05.98		844
T 270/97 - 3.3.02	20.12.99		114	T 623/97 - 3.5.01	11.04.02		213
T 276/97 - 3.5.02	26.02.99		382	T 631/97 - 3.4.03	17.02.00	2001, 13	313, 669
T 283/97 - 3.5.01	19.10.00		855	T 633/97 - 3.4.02	19.07.00		83, 700, 707, 708
T 287/97 - 3.3.03	12.09.00		282, 285, 286	T 636/97 - 3.3.04	26.03.98		240, 871
T 291/97 - 3.3.04	08.05.01		562	T 641/97 - 3.3.01	17.10.00		203
T 298/97 - 3.3.06	28.05.01	2002, 83	458, 731, 843, 845	T 642/97 - 3.3.07	15.02.01		474, 475, 927
T 299/97 - 3.3.06	06.06.01		247	T 644/97 - 3.3.03	22.04.99		165, 166, 172, 855
T 313/97 - 3.3.01	17.02.00		171	T 647/97 - 3.3.02	01.02.01		406
T 315/97 - 3.4.02	17.12.98	1999, 554	831	T 649/97 - 3.2.05	08.12.00		269, 270
T 323/97 - 3.3.06	17.09.01	2002, 476	263	T 652/97 - 3.2.03	16.06.99		610, 611
T 325/97 - 3.3.02	10.02.00		168, 171	T 659/97 - 3.3.05	22.08.01		322
T 355/97 - 3.3.01	05.07.00		171, 202, 222, 566	T 666/97 - 3.3.03	01.10.99		358
T 378/97 - 3.3.06	06.06.00		247, 249	T 679/97 - 3.2.03	04.01.99		867
T 382/97 - 3.3.06	28.09.00		799, 907	T 686/97 - 3.3.03	12.05.98		516
T 385/97 - 3.3.02	11.10.00		439, 837	T 701/97 - 3.3.05	23.08.01		382, 383
T 392/97 - 3.2.01	20.04.99		467, 722, 723	T 710/97 - 3.4.02	25.10.00		165
T 396/97 - 3.3.02	15.11.00		890	T 712/97 - 3.3.01	27.01.00		470, 913
T 409/97 - 3.2.04	25.11.98		280	T 713/97 - 3.3.01	18.02.98		168
T 425/97 - 3.3.02	08.05.98		453, 607, 618, 924	T 714/97 - 3.3.03	27.06.00		162
T 426/97 - 3.3.05	14.12.99		714	T 743/97 - 3.3.04	26.07.00		239
T 438/97 - 3.2.03	09.02.99		187	T 747/97 - 3.3.03	01.02.00		172
T 443/97 - 3.2.04	17.09.99		668	T 774/97 - 3.2.04	17.11.98		811, 838, 856
T 445/97 - 3.3.01	01.04.98		799, 852	T 777/97 - 3.2.02	16.03.98		616, 625
T 450/97 - 3.3.02	05.02.98	1999, 67	345	T 784/97 - 3.2.03	16.06.00		354
T 465/97 - 3.3.07	14.03.01		250	T 792/97 - 3.3.03	09.09.99		165
T 475/97 - 3.2.05	18.10.01		827	T 793/97 - 3.3.01	01.03.00		168, 215
T 479/97 - 3.3.04	06.09.01		404, 405	T 799/97 - 3.2.03	04.07.01		730
T 497/97 - 3.2.02	25.07.97		339	T 802/97 - 3.4.02	24.07.98		662, 674, 675
T 500/97 - 3.2.02	15.01.01		855	T 805/97 - 3.2.04	13.01.00		206
T 517/97 - 3.2.05	25.10.99	2000, 515	721	T 818/97 - 3.2.03	26.05.99		230
T 524/97 - 3.3.01	16.05.00		220	T 838/97 - 3.3.04	14.11.00		76, 83
T 541/97 - 3.2.04	21.04.99		245, 252, 255	T 859/97 - 3.4.03	02.03.01		920
				T 861/97 - 3.4.02	22.06.99		543

Table of cases

T 864/97 - 3.5.01	14.06.00	702	T 1180/97 - 3.2.01	19.10.99	765, 787
T 885/97 - 3.2.04	03.12.98	177	T 1191/97 - 3.2.04	10.04.00	554
T 887/97 - 3.3.02	28.11.00	344	T 1194/97 - 3.5.02	15.03.00	2000, 525, 19, 21, 35, 193
T 899/97 - 3.3.05	28.11.01	586	T 1198/97 - 3.3.05	05.03.01	445, 475, 823, 910
T 903/97 - 3.4.02	31.01.01	408	T 1203/97 - 3.2.03	09.05.00	164, 165
T 904/97 - 3.4.02	21.10.99	379	T 1208/97 - 3.3.04	03.11.00	111, 282, 284, 285
T 906/97 - 3.4.02	10.06.99	318, 340	T 1212/97 - 3.3.04	14.05.01	73
T 909/97 - 3.3.07	13.06.02	408	T 1213/97 - 3.5.02	16.11.01	740
T 919/97 - 3.3.01	29.01.98	86	T 1221/97 - 3.4.02	13.10.98	382
T 920/97 - 3.3.04	19.12.00	844	1998		
T 931/97 - 3.2.06	08.01.01	744	T 4/98 - 3.3.02	09.08.01	2002, 139, 141, 912
T 935/97 - 3.5.01	04.02.99	2, 16, 18, 21, 188	T 26/98 - 3.4.01	30.04.02	180, 186
T 937/97 - 3.5.01	28.10.98	623	T 27/98 - 3.4.01	07.05.99	531
T 948/97 - 3.4.01	09.01.02	401	T 45/98 - 3.2.02	06.06.00	762
T 950/97 - 3.4.03	26.03.02	260, 290	T 50/98 - 3.3.06	13.06.02	893
T 951/97 - 3.4.01	05.12.97	1998, 440, 444, 471, 541, 607, 666	T 51/98 - 3.3.01	24.07.01	205
T 967/97 - 3.5.01	25.10.01	163	T 70/98 - 3.3.06	15.11.01	450
T 970/97 - 3.3.05	20.09.00	216	T 71/98 - 3.3.05	21.12.99	214
T 976/97 - 3.3.03	16.08.00	451, 543, 632	T 74/98 - 3.3.03	19.10.00	113
T 986/97 - 3.2.04	25.02.00	257	T 80/98 - 3.2.04	26.09.00	385
T 994/97 - 3.3.06	24.08.01	832	T 91/98 - 3.3.04	29.05.01	91, 178, 555
T 998/97 - 3.3.02	11.07.01	250	T 97/98 - 3.3.05	21.05.01	2002, 183, 851
T 1046/97 - 3.3.01	02.12.99	124	T 111/98 - 3.3.05	10.07.01	863, 866
T 1051/97 - 3.3.02	19.05.98	171	T 128/98 - 3.2.04	15.03.00	794
T 1067/97 - 3.4.02	04.10.00	321, 324, 325	T 135/98 - 3.3.02	20.11.02	706
T 1070/97 - 3.3.05	04.03.99	531	T 149/98 - 3.3.04	15.01.03	260
T 1074/97 - 3.3.01	20.03.03	290	T 177/98 - 3.2.04	09.11.99	920
T 1100/97 - 3.2.05	08.05.98	849	T 191/98 - 3.2.06	04.03.03	449
T 1116/97 - 3.2.04	26.10.99	794	T 201/98 - 3.5.01	27.07.99	441, 662
T 1126/97 - 3.4.01	13.12.01	888	T 203/98 - 3.5.01	27.07.99	257, 258
T 1129/97 - 3.3.01	26.10.00	2001, 273, 254, 286	T 209/98 - 3.3.01	26.06.01	203
T 1137/97 - 3.3.04	14.10.02	71, 732, 748	T 210/98 - 3.3.03	19.12.00	756
T 1148/97 - 3.2.01	09.12.99	899	T 226/98 - 3.3.01	07.02.01	254
T 1149/97 - 3.4.02	07.05.99	2000, 259, 356, 357, 369, 797, 806	T 228/98 - 3.3.03	04.04.01	352
T 1164/97 - 3.3.02	22.03.01	288	T 238/98 - 3.3.05	07.05.03	288
T 1165/97 - 3.2.06	15.02.00	228	T 241/98 - 3.2.04	22.03.99	598
T 1167/97 - 3.2.01	17.11.99	257	T 245/98 - 3.3.02	11.10.01	249
T 1171/97 - 3.5.01	17.09.99	747	T 247/98 - 3.3.05	17.06.99	564, 568, 635, 637
T 1173/97 - 3.5.01	01.07.98	1999, 609, XXXVII, 2, 4, 5, 16-18, 20, 21, 24, 35, 188, 640	T 249/98 - 3.2.01	11.01.00	782
T 1177/97 - 3.5.01	09.07.02	21, 23, 190, 193, 195	T 254/98 - 3.2.06	26.09.00	564
			T 268/98 - 3.3.05	16.05.01	211
			T 274/98 - 3.3.01	05.02.02	254

T 287/98 - 3.3.06	05.12.00	316	T 728/98 - 3.3.01	12.05.00	2001, 319	125, 252, 253,
T 319/98 - 3.3.01	19.02.02	160				255, 269, 270,
T 338/98 - 3.4.02	02.03.99	520				289, 353
T 342/98 - 3.3.04	20.11.01	404, 708	T 733/98 - 3.4.03	14.12.99		523, 859
T 376/98 - 3.2.01	09.03.99	445	T 740/98 - 3.3.01	09.11.04		436
T 400/98 - 3.3.06	19.09.02	172, 212	T 748/98 - 3.3.04	23.05.01		288
T 406/98 - 3.2.03	26.09.00	197	T 777/98 - 3.3.07	30.03.01	2001, 509	529
T 411/98 - 3.2.04	11.01.00	92	T 778/98 - 3.3.03	07.08.00		438, 914
T 414/98 - 3.2.04	30.11.99	176, 177, 199	T 828/98 - 3.2.04	28.03.00		772
T 425/98 - 3.3.01	12.03.02	254	T 862/98 - 3.4.02	17.08.99		446, 594
T 428/98 - 3.3.05	23.02.01	2001, 494	T 869/98 - 3.3.06	09.05.00		869
		425, 427, 497,	T 872/98 - 3.2.01	26.10.99		215
		499, 510, 514,	T 875/98 - 3.3.03	26.10.01		922
		516, 553	T 877/98 - 3.2.03	05.10.00		70
T 432/98 - 3.3.02	28.11.01	212	T 881/98 - 3.4.01	23.05.00		522
T 437/98 - 3.3.08	29.01.03	252, 255, 280	T 887/98 - 3.2.04	19.07.00		869
T 438/98 - 3.3.03	12.10.00	369	T 892/98 - 3.5.01	23.03.00		702
T 439/98 - 3.3.06	17.10.02	247, 249	T 910/98 - 3.2.02	30.10.01		156, 158
T 445/98 - 3.2.01	10.07.00	433, 854, 908	T 911/98 - 3.5.01	09.04.03		213
T 464/98 - 3.3.05	12.09.00	167	T 914/98 - 3.2.01	22.09.00		814, 867
T 471/98 - 3.4.01	02.07.02	199	T 915/98 - 3.5.01	17.05.00		869
T 473/98 - 3.5.02	05.09.00	2001, 231	T 925/98 - 3.2.03	13.03.01		350
		611, 848, 869,	T 927/98 - 3.2.04	09.07.99		782
		917	T 928/98 - 3.2.06	08.11.00		475, 476
T 474/98 - 3.2.03	10.05.01	29	T 939/98 - 3.3.03	17.01.02		269
T 480/98 - 3.2.04	28.04.99	253, 264	T 942/98 - 3.3.01	13.02.01		204, 321
T 484/98 - 3.3.04	13.09.99	266	T 954/98 - 3.5.01	09.12.99		479, 599, 600
T 502/98 - 3.3.06	07.06.02	701, 713	T 959/98 - 3.3.06	22.10.02		117
T 515/98 - 3.2.04	14.09.99	105	T 960/98 - 3.3.07	09.04.03		247, 249
T 517/98 - 3.3.05	17.01.02	2003, 385	T 962/98 - 3.3.01	15.01.04		327, 351
T 534/98 - 3.2.03	01.07.99	777, 779	T 965/98 - 3.3.04	26.08.99		618
T 541/98 - 3.5.01	10.02.00	717	T 985/98 - 3.2.04	21.10.04		220
T 552/98 - 3.3.03	07.11.00	715	T 1001/98 - 3.4.02	10.09.03		66
T 564/98 - 3.2.01	06.06.00	905	T 1012/98 - 3.3.03	27.06.01		254
T 587/98 - 3.5.02	12.05.00	2000, 497	T 1017/98 - 3.2.06	18.06.01		261
T 590/98 - 3.3.02	30.04.03	832	T 1020/98 - 3.3.01	27.06.03	2003, 533	254, 271
T 598/98 - 3.3.05	16.10.01	740	T 1022/98 - 3.3.05	10.11.99		442
T 619/98 - 3.5.01	23.04.99	116	T 1041/98 - 3.2.02	22.10.01		269, 270
T 621/98 - 3.5.01	18.06.99	586, 587	T 1043/98 - 3.2.01	11.05.00		187, 188
T 656/98 - 3.3.04	18.05.01	583, 736, 737	T 1053/98 - 3.5.01	22.10.99		194
T 685/98 - 3.5.02	21.09.98	1999, 346	T 1055/98 - 3.3.05	04.04.01		246
		877, 930	T 1056/98 - 3.2.01	02.02.00		817
T 687/98 - 3.3.03	11.01.01	276	T 1059/98 - 3.2.01	19.02.02		760
T 690/98 - 3.2.01	22.06.99	726, 836	T 1062/98 - 3.2.06	17.01.02		234
T 693/98 - 3.2.01	25.04.02	792	T 1097/98 - 3.2.01	02.02.00		776
T 713/98 - 3.3.03	17.01.02	246, 248	T 1105/98 - 3.2.01	19.09.00		471, 472, 894,
T 717/98 - 3.3.06	04.11.02	282-284				902
T 718/98 - 3.3.06	26.11.02	700, 706				

Table of cases

T 1130/98 - 3.2.01	12.07.99	536	T 473/99 - 3.2.05	22.10.02	799	
			T 478/99 - 3.2.04	07.12.00	79, 731	
1999			T 481/99 - 3.2.06	21.06.02	710	
T 5/99 - 3.2.01	16.05.00	246	T 484/99 - 3.3.03	25.07.00	471	
T 35/99 - 3.2.02	29.09.99	2000, 447	51, 53	T 485/99 - 3.3.02	29.04.04	145, 148
T 37/99 - 3.4.02	09.11.00	806	T 491/99 - 3.2.01	24.10.00	109	
T 42/99 - 3.4.01	21.01.04	753	T 494/99 - 3.3.02	19.02.03	222	
T 49/99 - 3.5.01	05.03.02	286, 852	T 543/99 - 3.3.06	24.10.00	908	
T 50/99 - 3.2.04	09.10.02	630	T 553/99 - 3.2.01	21.02.01	369	
T 52/99 - 3.3.02	22.08.00	888	T 588/99 - 3.3.06	27.03.03	212	
T 60/99 - 3.2.04	26.04.01	94	T 592/99 - 3.3.02	01.08.02	330	
T 71/99 - 3.4.02	20.06.01	549	T 596/99 - 3.3.03	05.12.01	565	
T 76/99 - 3.4.02	09.10.01	832	T 598/99 - 3.4.03	17.12.02	829	
T 79/99 - 3.3.02	03.12.99	479	T 605/99 - 3.2.06	25.04.02	702	
T 91/99 - 3.3.02	24.01.03	750, 754	T 609/99 - 3.5.02	13.11.01	713	
T 119/99 - 3.3.06	25.05.00	638	T 613/99 - 3.2.01	30.08.99	668	
T 131/99 - 3.4.02	19.07.01	421	T 620/99 - 3.3.04	08.05.03	288, 765	
T 151/99 - 3.5.01	24.10.01	85, 560	T 647/99 - 3.3.02	04.04.00	913	
T 168/99 - 3.5.01	12.12.00	806, 906	T 652/99 - 3.2.06	22.02.01	717	
T 172/99 - 3.3.03	07.03.02	232, 233	T 653/99 - 3.3.04	18.09.02	775	
T 190/99 - 3.2.04	06.03.01	280, 344, 358	T 663/99 - 3.2.01	06.02.01	442	
T 194/99 - 3.4.01	07.05.04	255	T 668/99 - 3.2.03	14.09.04	762, 763	
T 201/99 - 3.3.06	10.09.04	264, 336, 407	T 686/99 - 3.3.01	22.01.03	350	
T 231/99 - 3.2.04	31.08.99	475, 840, 927	T 688/99 - 3.3.03	11.07.01	383	
T 240/99 - 3.2.03	12.12.02	832	T 702/99 - 3.3.02	03.12.03	222, 556	
T 241/99 - 3.5.02	06.12.01	89, 783	T 710/99 - 3.4.03	11.02.03	895, 899	
T 263/99 - 3.2.02	20.06.00	164, 165	T 711/99 - 3.3.07	21.10.03	2004, 550	730
T 264/99 - 3.2.01	14.11.00	82, 340	T 717/99 - 3.3.03	18.11.04	334	
T 274/99 - 3.3.06	16.05.01	714	T 724/99 - 3.3.02	24.10.01	832	
T 275/99 - 3.3.02	25.07.00	674, 869	T 736/99 - 3.5.02	20.06.02	714, 716	
T 276/99 - 3.5.01	26.09.01	231, 954	T 744/99 - 3.5.01	15.01.02	404, 410	
T 304/99 - 3.2.01	07.05.01	874	T 758/99 - 3.5.01	25.01.01	761	
T 308/99 - 3.3.02	02.06.03	212	T 809/99 - 3.2.06	22.10.02	832	
T 314/99 - 3.3.03	21.06.01	71, 172, 555, 725	T 832/99 - 3.2.05	17.09.04	497, 527	
T 317/99 - 3.3.02	06.02.02	276	T 877/99 - 3.3.01	31.07.01	214, 252	
T 320/99 - 3.4.03	26.09.02	541	T 898/99 - 3.2.06	05.11.02	475	
T 323/99 - 3.3.01	17.10.01	214	T 919/99 - 3.3.04	07.04.03	151	
T 329/99 - 3.3.06	05.04.01	350	T 930/99 - 3.2.07	01.08.02	237, 247, 249	
T 363/99 - 3.3.02	19.04.04	253	T 932/99 - 3.3.07	03.08.04	284, 858	
T 372/99 - 3.2.05	17.11.00	908	T 934/99 - 3.2.02	18.04.01	777	
T 410/99 - 3.3.06	20.01.03	95	T 945/99 - 3.3.02	17.12.04	285	
T 413/99 - 3.3.06	21.02.02	247	T 947/99 - 3.3.02	27.11.03	75, 711	
T 427/99 - 3.3.01	15.11.01	853, 890	T 952/99 - 3.3.03	10.12.02	160, 261, 900	
T 433/99 - 3.2.02	24.11.00	270	T 957/99 - 3.2.06	12.12.02	476	
T 438/99 - 3.5.02	24.01.02	373	T 966/99 - 3.2.06	03.12.02	476, 608	
T 468/99 - 3.3.06	16.05.03	476, 701, 888	T 971/99 - 3.3.04	19.04.00	531	
			T 998/99 - 3.3.02	15.09.03	2005, 229	399, 880

T 1001/99 - 3.2.03	27.06.02	4, 10	T 263/00 - 3.2.03	25.05.00	765, 839, 840
T 1008/99 - 3.4.02	04.05.00	371, 382, 394	T 264/00 - 3.2.04	28.05.01	630
T 1019/99 - 3.5.01	16.06.04	168, 171	T 268/00 - 3.3.01	16.12.03	203, 675
T 1022/99 - 3.2.01	10.04.01	76, 783	T 269/00 - 3.5.01	16.03.05	918
T 1049/99 - 3.3.02	09.11.04	101, 156, 158, 333	T 270/00 - 3.5.01	18.09.01	534
T 1050/99 - 3.3.08	25.01.05	334, 336, 337	T 278/00 - 3.3.01	11.02.03	2003, 546
T 1062/99 - 3.2.01	04.05.00	784, 840	T 285/00 - 3.3.06	22.10.04	264, 334, 336
T 1065/99 - 3.3.02	19.09.01	867, 921	T 289/00 - 3.2.03	20.06.01	403
T 1080/99 - 3.5.01	31.10.01	2002, 568	T 328/00 - 3.4.02	17.09.02	71
T 1086/99 - 3.3.02	10.11.04	334	T 335/00 - 3.2.06	08.10.02	773
T 1097/99 - 3.3.04	28.05.03	898	T 336/00 - 3.2.06	08.10.02	773
T 1101/99 - 3.3.07	10.04.01	629	T 338/00 - 3.3.08	06.11.02	12
2000			T 349/00 - 3.5.01	05.04.01	856
T 4/00 - 3.2.06	17.01.03	96	T 375/00 - 3.2.07	07.05.02	439, 547
T 9/00 - 3.3.02	18.12.01	2002, 275	T 380/00 - 3.4.02	07.05.02	710
T 12/00 - 3.4.02	07.11.02	559, 855	T 395/00 - 3.3.04	22.04.04	201
T 13/00 - 3.3.02	27.06.03	408	T 402/00 - 3.3.01	05.05.04	375, 382
T 36/00 - 3.3.08	02.10.03	240	T 405/00 - 3.3.06	14.10.04	281
T 41/00 - 3.4.02	19.12.01	727, 729	T 416/00 - 3.3.07	24.01.06	744
T 43/00 - 3.3.02	09.05.03	398	T 426/00 - 3.2.04	20.10.04	264
T 48/00 - 3.3.02	12.06.02	867	T 427/00 - 3.2.04	10.05.01	115
T 54/00 - 3.5.02	19.12.00	844	T 434/00 - 3.3.02	29.06.01	844
T 55/00 - 3.5.01	10.10.00	620	T 446/00 - 3.3.02	03.07.03	539, 706, 892, 900
T 60/00 - 3.4.01	03.07.03	875	T 479/00 - 3.3.05	15.02.02	169
T 65/00 - 3.3.07	10.10.01	775, 779	T 481/00 - 3.3.02	13.08.04	704
T 74/00 - 3.4.02	15.03.05	556, 731	T 485/00 - 3.3.05	22.09.04	234
T 97/00 - 3.3.01	25.09.03	566	T 499/00 - 3.3.06	28.01.03	250, 570
T 98/00 - 3.3.01	18.03.03	642, 866	T 500/00 - 3.3.07	17.06.04	332, 426, 436
T 100/00 - 3.3.03	07.03.03	126, 127	T 508/00 - 3.2.07	29.06.04	711
T 101/00 - 3.3.03	03.07.03	795	T 515/00 - 3.2.05	25.06.03	234, 403, 413
T 111/00 - 3.3.04	14.02.02	179	T 521/00 - 3.2.03	10.04.03	779
T 112/00 - 3.4.02	26.06.02	126	T 523/00 - 3.2.03	10.07.03	286
T 113/00 - 3.5.02	17.09.02	170	T 532/00 - 3.3.09	01.06.05	174
T 120/00 - 3.3.04	18.02.03	708	T 552/00 - 3.3.04	30.10.03	280
T 134/00 - 3.3.06	05.09.03	174, 265	T 555/00 - 3.2.05	11.03.03	376
T 140/00 - 3.3.01	27.06.02	717	T 558/00 - 3.5.01	18.02.04	163, 213
T 141/00 - 3.3.05	30.09.02	258	T 561/00 - 3.3.05	17.07.02	382
T 165/00 - 3.2.01	30.11.00	856, 859	T 594/00 - 3.3.04	06.05.04	914
T 188/00 - 3.4.03	05.05.03	300	T 611/00 - 3.3.06	18.09.01	863
T 196/00 - 3.3.01	11.07.02	890	T 619/00 - 3.4.02	11.09.03	247, 249
T 204/00 - 3.4.02	13.11.02	560	T 631/00 - 2.4.02	05.05.04	163
T 208/00 - 3.2.01	06.10.00	922	T 641/00 - 3.5.01	26.09.02	2003, 352
T 244/00 - 3.5.01	15.11.01	29, 34, 195			6, 8, 22, 170, 180, 184, 188, 190, 191, 194, 196
T 248/00 - 3.3.07	17.02.04	923	T 643/00 - 3.5.01	16.10.03	29, 35, 193
T 250/00 - 3.3.06	24.03.03	282, 285			

Table of cases

T 659/00 - 3.5.02 01.07.03	211	T 1023/00 - 3.4.03 17.09.03	251
T 660/00 - 3.4.02 17.04.02	209	T 1029/00 - 3.3.02 29.05.01	429, 534
T 664/00 - 3.3.02 28.11.02	465	T 1030/00 - 3.3.01 22.07.03	71
T 665/00 - 3.3.07 13.04.05	89, 423	T 1031/00 - 3.3.02 23.05.02	136
T 687/00 - 3.3.07 05.10.04	254	T 1038/00 - 3.3.04 26.03.02	722
T 692/00 - 3.3.06 13.05.03	461	T 1039/00 - 3.2.04 15.01.01	438, 914
T 699/00 - 3.3.07 25.04.05	833, 904	T 1048/00 - 3.2.03 18.06.03	454
T 706/00 - 3.2.03 15.05.03	450, 451	T 1050/00 - 3.5.01 07.08.03	708
T 708/00 - 3.5.01 05.12.03 2004, 160	669, 670	T 1074/00 - 3.3.04 13.05.04	252, 268
T 714/00 - 3.3.03 06.08.02	321, 324	T 1076/00 - 3.3.04 05.08.03	140, 276, 713
T 725/00 - 3.2.04 16.06.04	452	T 1084/00 - 3.3.08 11.04.03	255, 280
T 727/00 - 3.3.06 22.06.01	321	T 1102/00 - 3.3.08 01.06.04	183, 334, 335, 337
T 735/00 - 3.3.04 23.03.04	891	T 1164/00 - 3.3.06 02.09.03	816
T 740/00 - 3.2.06 10.10.01	475	T 1172/00 - 3.5.02 05.09.01	516
T 747/00 - 3.3.01 01.03.05	264, 336	T 1173/00 - 3.5.02 05.06.03 2004, 16	235
T 751/00 - 3.3.08 21.05.03	250	T 1176/00 - 3.5.02 23.07.03	391
T 778/00 - 3.2.04 06.07.01 2001, 554	428, 433, 854, 908	T 1177/00 - 3.5.02 24.07.03	391
T 786/00 - 3.3.03 19.12.01	125, 126	T 1188/00 - 3.3.03 30.04.03	174, 203
T 792/00 - 3.3.04 02.07.02	233, 236, 240, 250, 567	T 1195/00 - 3.2.02 24.05.04	211
T 818/00 - 3.3.06 18.07.03	410	T 1201/00 - 3.2.01 07.11.02	866
T 824/00 - 3.5.02 24.03.03 2004, 5	392, 846	2001	
T 835/00 - 3.3.03 07.11.02	165	T 10/01 - 3.3.08 09.03.05	264, 336
T 848/00 - 3.3.02 13.11.02	539, 543, 845	T 14/01 - 3.3.06 03.11.04	333
T 860/00 - 3.3.06 28.09.04	315, 349	T 15/01 - 3.3.04 17.06.04 2006, 153	397, 400, 737, 798, 851
T 862/00 - 3.5.03 29.04.04	897	T 30/01 - 3.4.02 29.06.04	409
T 866/00 - 3.3.01 30.09.03	235	T 31/01 - 3.4.02 23.05.03	110
T 915/00 - 3.4.02 19.06.02	214	T 34/01 - 3.2.01 18.02.03	701
T 920/00 - 3.2.06 16.06.03	280	T 55/01 - 3.5.01 11.02.03	88
T 923/00 - 3.3.02 01.08.06	402	T 56/01 - 3.5.01 21.01.04	271, 273
T 926/00 - 3.3.02 26.02.04	212	T 83/01 - 3.3.02 10.08.04	233
T 931/00 - 3.3.05 19.05.03	329	T 125/01 - 3.5.01 11.12.02	20
T 937/00 - 3.4.02 12.06.03	749, 803	T 129/01 - 3.2.06 25.06.03	909
T 943/00 - 3.3.03 31.07.03	247-249	T 131/01 - 3.2.01 18.07.02 2003, 115	469, 716, 717, 791
T 946/00 - 3.3.01 24.11.04	172	T 133/01 - 3.3.01 30.09.03	221
T 952/00 - 3.2.03 27.11.02	758	T 134/01 - 3.3.01 27.01.05	334
T 959/00 - 3.3.03 21.01.05	918	T 135/01 - 3.5.02 21.01.04	790
T 961/00 - 3.3.05 09.12.02	539, 544, 846	T 136/01 - 3.4.03 30.11.05	408
T 966/00 - 3.3.03 06.03.03	160	T 151/01 - 3.3.02 09.02.06	268
T 968/00 - 3.3.08 19.04.05	265	T 193/01 - 3.4.02 04.06.04	252, 255, 269, 270
T 970/00 - 3.4.02 15.09.04	163, 176	T 211/01 - 3.3.06 01.12.03	166
T 979/00 - 3.3.03 20.03.03	165	T 214/01 - 3.5.01 07.03.03	469, 712
T 984/00 - 3.3.04 18.06.02	241	T 230/01 - 3.3.02 26.04.05	106
T 986/00 - 3.5.02 25.02.03 2003, 554	450		
T 994/00 - 3.5.03 05.05.04	704		
T 1016/00 - 3.2.07 12.04.02	919		

T 231/01 - 3.2.06	05.09.01	88	T 669/01 - 3.3.04	22.05.02	151
T 236/01 - 3.3.08	15.09.05	337	T 681/01 - 3.3.07	28.11.06	82, 285
T 260/01 - 3.2.03	22.01.02	257, 258	T 694/01 - 3.3.04	04.07.02	2003, 250 721, 722
T 283/01 - 3.3.05	03.09.02	513	T 708/01 - 3.5.03	17.03.05	740
T 295/01 - 3.3.04	07.09.01	2002, 251 784	T 713/01 - 3.3.03	07.10.03	566
T 311/01 - 3.2.03	04.11.01	547	T 715/01 - 3.3.04	24.09.02	851
T 314/01 - 3.5.01	18.12.03	493	T 716/01 - 3.3.08	10.11.04	243
T 320/01 - 3.3.01	12.03.04	203	T 736/01 - 3.3.09	04.08.05	863
T 344/01 - 3.3.02	15.03.05	247	T 749/01 - 3.2.05	23.08.02	739
T 351/01 - 3.3.08	02.07.03	241, 411, 412	T 785/01 - 3.2.01	30.09.03	510, 516
T 360/01 - 3.3.03	21.10.03	900	T 788/01 - 3.3.03	13.06.03	408, 410
T 373/01 - 3.5.03	14.10.04	285	T 794/01 - 3.3.03	28.08.03	220
T 377/01 - 3.5.01	14.10.03	670	T 796/01 - 3.3.05	09.01.06	257
T 379/01 - 3.5.01	24.03.04	630	T 803/01 - 3.3.03	09.09.03	126, 127, 211, 289
T 380/01 - 3.3.06	28.05.04	280	T 811/01 - 3.3.04	06.08.04	240
T 386/01 - 3.4.02	24.07.03	738	T 836/01 - 3.3.04	07.10.03	144, 146
T 387/01 - 3.2.06	13.01.04	237, 247, 248	T 846/01 - 3.5.01	17.09.02	842
T 393/01 - 3.3.02	13.07.04	212	T 866/01 - 3.3.02	11.05.05	36, 770
T 396/01 - 3.5.01	25.05.04	285	T 872/01 - 3.3.03	14.07.04	900
T 397/01 - 3.3.06	14.12.04	888, 892, 898	T 880/01 - 3.5.01	09.06.05	799, 904
T 402/01 - 3.5.01	21.02.05	865	T 881/01 - 3.3.04	19.03.04	285
T 423/01 - 3.3.04	25.03.04	408	T 906/01 - 3.2.02	28.09.04	85
T 433/01 - 3.3.03	04.06.03	320	T 913/01 - 3.3.06	11.10.04	82
T 459/01 - 3.2.06	06.11.03	476	T 914/01 - 3.3.03	02.12.03	233
T 475/01 - 3.3.08	15.06.04	40, 43, 587	T 918/01 - 3.3.04	06.10.04	179
T 486/01 - 3.3.04	03.09.03	145, 151	T 933/01 - 3.2.06	28.06.04	290
T 493/01 - 3.3.08	04.06.03	184	T 942/01 - 3.3.06	12.08.04	369
T 500/01 - 3.3.04	12.11.03	280, 282, 283, 317, 900	T 948/01 - 3.3.01	08.04.04	168, 180
T 508/01 - 3.5.02	09.10.01	613	T 991/01 - 3.4.02	14.10.03	863
T 514/01 - 3.2.07	11.09.03	744, 760	T 1001/01 - 3.3.02	11.10.07	151, 327
T 520/01 - 3.2.07	29.10.03	793, 795, 880	T 1003/01 - 3.2.01	08.12.03	875
T 545/01 - 3.2.01	16.09.03	269	T 1004/01 - 3.3.07	01.09.04	327, 330, 897, 898
T 554/01 - 3.3.09	20.10.05	747	T 1011/01 - 3.5.01	16.11.04	229
T 561/01 - 3.5.01	30.06.06	736	T 1034/01 - 3.4.03	29.01.04	716
T 579/01 - 3.3.04	30.06.04	359, 361	T 1037/01 - 3.3.04	12.08.04	710
T 584/01 - 3.3.02	21.04.05	334	T 1052/01 - 3.2.01	01.07.03	359
T 591/01 - 3.3.02	16.03.05	827	T 1056/01 - 3.2.02	04.06.03	398, 417, 562
T 594/01 - 3.3.01	30.03.04	130	T 1064/01 - 3.3.01	25.03.04	203
T 604/01 - 3.5.03	12.08.04	716, 909, 919	T 1069/01 - 3.2.01	12.08.02	257
T 611/01 - 3.3.02	23.08.04	597, 916	T 1081/01 - 3.3.01	27.09.04	76-78
T 622/01 - 3.2.02	08.05.02	516	T 1092/01 - 3.3.04	26.04.05	156
T 643/01 - 3.4.03	07.07.04	576	T 1098/01 - 3.3.02	13.04.05	833
T 650/01 - 3.4.01	14.10.04	164	T 1122/01 - 3.4.02	06.05.04	473
T 652/01 - 3.4.02	12.09.02	100	T 1146/01 - 3.3.03	02.09.04	322, 334
T 655/01 - 3.4.03	25.05.03	451, 738	T 1156/01 - 3.3.09	21.06.05	256, 257
T 657/01 - 3.3.03	24.06.03	369			

Table of cases

T 1157/01 - 3.3.06	01.09.04	542, 572	T 283/02 - 3.2.04	09.04.03	718, 724, 728, 729
T 1158/01 - 3.4.02	13.07.04	2005, 110			
T 1174/01 - 3.2.03	12.12.02	452	T 287/02 - 3.2.03	03.09.04	275
T 1182/01 - 3.3.03	14.06.05	701, 704, 707, 744	T 288/02 - 3.4.03	22.04.04	290
			T 295/02 - 3.3.03	01.12.03	266, 279
T 1186/01 - 3.3.07	19.07.06	266	T 302/02 - 3.3.04	12.03.04	201, 587
T 1200/01 - 3.5.02	06.11.02	563, 568	T 315/02 - 3.2.02	12.09.03	72
T 1206/01 - 3.3.01	23.09.04	346, 350, 365	T 326/02 - 3.3.03	11.05.04	160
T 1212/01 - 3.3.02	03.02.05	164, 214, 215, 218	T 343/02 - 3.5.01	20.01.03	537
			T 357/02 - 3.3.03	30.07.04	174
T 1228/01 - 3.3.04	23.04.03	317, 404	T 362/02 - 3.3.02	26.06.02	919, 926
T 1235/01 - 3.4.01	26.02.04	704	T 369/02 - 3.3.07	07.07.05	221
T 1239/01 - 3.3.01	07.01.04	204	T 374/02 - 3.2.07	13.10.05	546
T 1250/01 - 3.3.05	14.05.03	236	T 378/02 - 3.3.04	12.10.05	269
T 1277/01 - 3.3.09	25.11.04	199	T 396/02 - 3.3.07	02.08.05	249
T 1281/01 - 3.5.02	23.01.03	635, 853	T 401/02 - 3.5.01	15.01.04	472
T 1285/01 - 3.3.01	06.07.04	168	T 407/02 - 3.4.03	12.11.03	833, 852
T 1288/01 - 3.3.03	26.03.04	232	T 408/02 - 3.5.01	07.04.05	756
			T 411/02 - 3.3.04	07.11.06	361, 888
2002			T 412/02 - 3.3.03	16.06.04	256, 287
T 6/02 - 3.3.07	03.02.05	216	T 413/02 - 3.5.01	05.05.04	731, 732
T 14/02 - 3.2.07	05.11.03	895, 902	T 435/02 - 3.2.01	01.04.04	752
T 21/02 - 3.3.01	20.02.06	928	T 436/02 - 3.3.05	25.06.04	739
T 23/02 - 3.3.03	19.07.05	316	T 441/02 - 3.3.03	19.05.04	211
T 30/02 - 3.3.08	09.10.06	411, 412	T 442/02 - 3.3.01	26.10.04	199
T 36/02 - 3.3.10	20.03.06	833	T 454/02 - 3.3.10	08.02.06	717
T 50/02 - 3.3.01	29.06.04	890, 901	T 457/02 - 3.3.09	16.11.05	280
T 64/02 - 3.2.06	19.01.05	471, 891	T 475/02 - 3.3.07	21.12.06	384
T 67/02 - 3.3.02	14.05.04	264	T 482/02 - 3.5.01	09.02.05	770
T 68/02 - 3.2.07	24.06.04	475	T 496/02 - 3.3.03	11.01.05	165, 221
T 70/02 - 3.2.04	15.03.02	608	T 497/02 - 3.3.04	27.05.04	675
T 84/02 - 3.2.06	27.09.02	845	T 499/02 - 3.3.07	24.06.05	266
T 107/02 - 3.3.06	15.06.05	212	T 502/02 - 3.5.01	17.01.03	875
T 109/02 - 3.2.02	20.01.05	461	T 506/02 - 3.3.08	18.01.05	334
T 127/02 - 3.3.08	16.09.03	276	T 511/02 - 3.2.03	17.02.04	781
T 133/02 - 3.5.01	27.09.05	272	T 552/02 - 3.2.04	15.10.03	506
T 143/02 - 3.2.05	08.01.04	237	T 553/02 - 3.3.06	14.07.04	10, 117
T 149/02 - 3.4.03	25.07.03	829	T 556/02 - 3.2.04	19.02.03	282, 283
T 161/02 - 3.3.08	13.09.04	264	T 558/02 - 3.2.04	23.07.03	512
T 174/02 - 3.4.01	25.11.04	269	T 563/02 - 3.3.06	31.05.05	247
T 181/02 - 3.2.04	13.10.03	461, 802	T 564/02 - 3.3.03	30.09.04	289
T 226/02 - 3.2.07	13.07.04	621	T 569/02 - 3.2.07	02.06.04	709
T 241/02 - 3.2.07	24.09.04	357	T 574/02 - 3.3.09	26.04.05	701, 742
T 250/02 - 3.3.04	28.04.05	361, 408	T 576/02 - 3.2.04	27.03.03	413
T 252/02 - 3.2.06	07.12.04	237, 247, 248	T 587/02 - 3.5.01	12.09.02	439, 674
T 268/02 - 3.3.02	31.01.03	843	T 609/02 - 3.3.08	27.10.04	237
T 269/02 - 3.3.02	20.07.05	758	T 611/02 - 3.2.06	09.11.04	237, 247, 248

T 619/02 - 3.4.02	22.03.06	2007, 63	1, 2, 5-7, 190, 192	T 970/02 - 3.2.06	25.10.04	335
T 643/02 - 3.2.04	16.09.04		379	T 977/02 - 3.5.02	16.06.04	160
T 646/02 - 3.2.03	21.09.04		834	T 979/02 - 3.4.02	08.10.03	450, 896
T 653/02 - 3.3.03	09.07.04		834	T 982/02 - 3.3.03	11.05.05	704
T 668/02 - 3.3.01	08.03.05		221	T 988/02 - 3.3.03	30.10.03	256, 271
T 671/02 - 3.3.06	10.08.04		518	T 991/02 - 3.2.01	26.09.03	925
T 677/02 - 3.2.05	22.04.04		517	T 992/02 - 3.3.01	22.11.05	256, 287
T 681/02 - 3.4.02	05.06.03		472, 894, 900	T 1001/02 - 3.2.03	06.07.04	191
T 684/02 - 3.3.03	12.10.07		157, 158, 806	T 1018/02 - 3.5.01	09.12.03	282, 285, 315, 833, 904
T 696/02 - 3.4.02	02.11.04		457, 825	T 1023/02 - 3.3.04	19.05.07	235, 280-283
T 703/02 - 3.5.02	29.04.05		265	T 1024/02 - 3.2.05	12.05.04	512
T 713/02 - 3.3.01	12.04.05	2006, 267	605, 657, 839, 840	T 1028/02 - 3.2.04	07.12.04	208, 265
T 720/02 - 3.4.02	23.09.04		376, 379	T 1033/02 - 3.3.10	26.04.06	247
T 749/02 - 3.4.03	20.01.04		867, 919, 925	T 1045/02 - 3.5.02	13.11.03	855
T 750/02 - 3.2.01	27.05.04		360	T 1063/02 - 3.5.02	16.06.04	475
T 767/02 - 3.4.03	01.06.05		173	T 1067/02 - 3.3.08	30.11.04	322
T 779/02 - 3.4.02	24.11.04		215	T 1081/02 - 3.5.01	13.01.04	428, 442, 689
T 794/02 - 3.2.03	07.06.05		799, 833, 904	T 1090/02 - 3.3.04	30.09.04	160
T 796/02 - 3.3.08	01.04.04		903	T 1091/02 - 3.3.04	23.07.04	2005, 14 731, 733
T 797/02 - 3.4.02	23.09.04		376, 379	T 1121/02 - 3.2.04	24.11.03	190, 193
T 799/02 - 3.2.04	27.07.04		171	T 1147/02 - 3.3.04	31.05.06	567
T 833/02 - 3.3.01	16.11.04		168	T 1151/02 - 3.2.02	04.11.03	286
T 838/02 - 3.3.07	29.01.03		593, 867	T 1175/02 - 3.3.07	16.03.05	211
T 844/02 - 3.2.01	06.02.04		257	T 1183/02 - 3.5.02	17.02.03	2003, 404 914
T 845/02 - 3.2.02	07.06.05		173, 174	T 1194/02 - 3.2.06	19.11.04	895
T 853/02 - 3.2.04	26.11.04		808	T 1197/02 - 3.2.02	12.07.06	63
T 861/02 - 3.5.01	25.06.04		612, 919	T 1202/02 - 3.2.07	09.12.04	901
T 864/02 - 3.3.06	19.05.05		827	T 1212/02 - 3.4.02	12.04.05	587
T 888/02 - 3.2.05	12.08.04		893	T 1216/02 - 3.5.02	24.02.03	911
T 889/02 - 3.3.04	22.03.05		178	2003		
T 890/02 - 3.3.08	10.10.04	2005, 497	66, 250	T 3/03 - 3.3.06	19.10.04	325
T 900/02 - 3.3.08	28.04.04		593, 597, 925	T 12/03 - 3.2.05	03.02.04	912, 922
T 910/02 - 3.4.03	22.06.04		457	T 25/03 - 3.2.06	08.02.05	324, 327
T 914/02 - 3.4.01	12.07.05		2, 5-7, 12, 22, 188, 189, 258	T 30/03 - 3.2.06	12.05.05	899
T 922/02 - 3.2.03	10.03.04		442	T 39/03 - 3.4.02	26.08.05	2006, 362 376, 377
T 924/02 - 3.3.01	04.11.04		203	T 45/03 - 3.3.03	19.01.05	900
T 929/02 - 3.4.02	09.12.04		205	T 60/03 - 3.2.03	13.07.05	354
T 934/02 - 3.2.01	29.04.04		799, 833, 857, 904	T 61/03 - 3.3.04	12.04.05	286
T 948/02 - 3.3.03	05.04.05		322	T 64/03 - 3.3.03	01.02.05	286
T 951/02 - 3.4.03	09.11.04		195	T 81/03 - 3.5.01	12.02.04	356, 888, 892, 893
T 953/02 - 3.3.03	08.06.05		727	T 86/03 - 3.3.06	28.06.04	717
T 963/02 - 3.4.03	29.09.04		611	T 90/03 - 3.3.08	17.03.05	379
T 966/02 - 3.2.04	01.12.04		443, 769	T 131/03 - 3.4.02	22.12.04	569
				T 152/03 - 3.2.02	22.04.04	85

Table of cases

T 157/03 - 3.3.04	04.01.05	239, 708	T 404/03 - 3.5.01	12.07.06	327, 346
T 163/03 - 3.2.06	05.02.07	84	T 407/03 - 3.2.02	15.11.05	82
T 168/03 - 3.3.02	07.03.03	875	T 412/03 - 3.3.01	16.06.05	286
T 172/03 - 3.5.01	27.11.03	6, 23, 163, 164, 184, 190	T 420/03 - 3.2.04	10.05.05	763, 852
T 175/03 - 3.3.03	03.11.05	402	T 423/03 - 3.3.03	10.10.03	375, 382
T 190/03 - 3.5.01	18.03.05	2006, 502	T 424/03 - 3.5.01	23.02.06	19, 20, 188, 189, 193
T 190/03 - 3.5.01	29.03.06	213	T 427/03 - 3.3.02	13.10.04	919
T 207/03 - 3.3.10	08.03.07	742	T 431/03 - 3.3.03	03.05.06	282
T 208/03 - 3.2.05	20.04.05	247	T 455/03 - 3.3.01	05.07.05	890
T 217/03 - 3.3.06	02.03.05	333	T 466/03 - 3.5.02	21.09.04	428
T 225/03 - 3.2.01	22.06.07	550	T 476/03 - 3.2.07	30.09.04	893
T 234/03 - 3.3.01	18.05.06	117, 221, 222	T 492/03 - 3.3.08	11.03.05	445
T 237/03 - 3.4.02	09.11.0	702	T 494/03 - 3.3.08	18.05.05	408
T 255/03 - 3.2.04	31.08.04	167	T 503/03 - 3.3.04	29.11.05	735
T 258/03 - 3.5.01	21.04.04	2004, 575	T 507/03 - 3.5.02	07.10.05	747
		1, 2, 4-6, 8, 20, 22, 26, 28, 189, 190, 193	T 525/03 - 3.4.02	27.09.05	272
T 261/03 - 3.3.03	24.11.05	731, 732	T 531/03 - 3.4.03	17.03.05	188, 190, 191
T 265/03 - 3.3.02	27.04.07	614	T 537/03 - 3.2.03	10.11.05	408
T 267/03 - 3.4.02	28.09.05	72, 712	T 542/03 - 3.3.04	14.07.05	178
T 274/03 - 3.2.01	08.07.04	670	T 548/03 - 3.2.03	28.03.06	166
T 281/03 - 3.x.0x	18.03.05	595	T 571/03 - 3.5.01	22.03.06	919
T 281/03 - 3.x.0x	30.03.06	600	T 572/03 - 3.x.0x	18.03.05	599
T 281/03 - 3.5.01	17.05.06	443, 910, 916, 917	T 599/03 - 3.3.03	06.09.05	165
T 283/03 - 3.x.0x	18.03.05	599	T 602/03 - 3.5.01	25.04.06	896
T 285/03 - 3.4.03	10.05.05	335	T 621/03 - 3.3.09	23.05.06	255
T 307/03 - 3.3.07	03.07.07	2009, 418	T 637/03 - 3.5.01	21.07.05	276
T 309/03 - 3.3.07	30.07.03	2004, 91	T 651/03 - 3.3.10	10.05.07	890, 891, 902
T 315/03 - 3.3.08	06.07.04	2006, 15	T 653/03 - 3.2.04	08.04.05	322
		36, 38, 39, 44, 46, 771	T 658/03 - 3.3.03	07.10.04	316
T 318/03 - 3.5.03	12.07.05	196	T 659/03 - 3.2.01	04.10.04	271
T 323/03 - 3.3.06	26.11.04	163, 175	T 664/03 - 3.3.09	20.10.04	370
T 324/03 - 3.2.06	08.09.05	553	T 668/03 - 3.2.04	06.12.07	756
T 335/03 - 3.4.02	26.07.05	368	T 671/03 - 3.2.04	20.07.06	704, 707, 744
T 339/03 - 3.3.10	11.11.05	168	T 674/03 - 3.2.03	19.12.05	758
T 353/03 - 3.4.02	25.08.03	669	T 719/03 - 3.2.03	14.10.04	527, 528
T 354/03 - 3.3.01	07.12.04	168	T 731/03 - 3.3.01	28.07.05	346
T 355/03 - 3.3.01	30.10.03	453, 538	T 745/03 - 3.4.02	22.09.05	540, 541
T 361/03 - 3.4.03	21.06.05	863	T 749/03 - 3.4.02	15.09.05	280, 344, 360
T 373/03 - 3.4.01	02.09.05	91	T 759/03 - 3.3.04	17.08.06	179
T 378/03 - 3.3.01	04.07.06	221	T 764/03 - 3.4.03	10.02.05	892, 893, 906
T 382/03 - 3.5.01	20.07.04	582	T 772/03 - 3.5.03	22.04.04	468
T 383/03 - 3.2.02	01.10.04	2005, 159	T 803/03 - 3.3.03	21.04.04	574
T 384/03 - 3.3.02	17.01.06	149	T 806/03 - 3.3.03	13.09.06	384
T 394/03 - 3.4.02	04.03.05	289, 827, 913	T 808/03 - 3.5.02	12.02.04	495, 513, 516, 624
			T 813/03 - 3.5.02	07.01.04	257

T 818/03 - 3.4.03	06.07.05	258		T 1241/03 - 3.3.04	01.09.05	178, 240, 280,
T 826/03 - 3.4.01	16.03.07	87				322
T 830/03 - 3.5.02	21.09.04	428, 606, 689,		T 1247/03 - 3.3.03	03.05.05	289
		853				
T 843/03 - 3.3.04	25.10.04	416		2004		
T 849/03 - 3.5.03	19.08.04	442		T 4/04 - 3.2.03	25.04.06	719
T 853/03 - 3.3.01	12.10.05	203		T 5/04 - 3.2.02	17.01.06	52
T 859/03 - 3.3.06	06.07.05	164, 280		T 20/04 - 3.3.08	16.03.05	414
T 861/03 - 3.3.02	28.11.03	929		T 23/04 - 3.3.03	05.04.06	830
T 874/03 - 3.2.04	28.06.05	704, 745		T 24/04 - 3.2.03	01.07.05	497
T 882/03 - 3.3.09	11.04.06	247, 248		T 32/04 - 3.2.03	27.10.05	499
T 883/03 - 3.3.04	07.09.05	215		T 49/04 - 3.4.03	18.10.05	29
T 897/03 - 3.3.08	16.03.04	611, 612, 919		T 56/04 - 3.4.03	21.09.05	286, 287
T 900/03 - 3.2.01	18.10.05	719		T 70/04 - 3.2.07	25.08.06	901
T 909/03 - 3.2.05	01.02.05	918		T 72/04 - 3.3.06	23.03.06	250
T 910/03 - 3.2.05	07.07.05	402		T 89/04 - 3.5.04	05.07.07	587
T 922/03 - 3.2.01	11.05.05	897		T 95/04 - 3.4.03	29.09.04	456
T 928/03 - 3.5.01	02.06.06	196		T 100/04 - 3.3.03	17.05.06	860
T 956/03 - 3.3.08	19.07.06	732		T 111/04 - 3.2.07	28.06.06	717
T 958/03 - 3.5.01	17.01.07	196		T 125/04 - 3.5.01	10.05.05	29, 34
T 975/03 - 3.3.04	24.07.07	358		T 126/04 - 3.2.01	29.06.04	628, 853, 909
T 984/03 - 3.3.10	25.07.08	221		T 127/04 - 3.5.03	11.10.06	255
T 989/03 - 3.3.02	23.10.07	888		T 133/04 - 3.3.03	26.04.06	893
T 1000/03 - 3.5.02	03.08.05	450		T 143/04 - 3.2.02	12.09.06	63
T 1002/03 - 3.5.04	17.01.07	662		T 154/04 - 3.5.01	15.11.06	2008, 46
T 1006/03 - 3.3.03	08.11.05	373				1-4, 8, 11, 64,
T 1012/03 - 3.3.05	01.12.06	472, 645				116, 117, 170,
T 1020/03 - 3.3.04	29.10.04	2007, 204	141, 146, 148,	T 162/04 - 3.3.09	28.03.07	759
			151, 276	T 165/04 - 3.5.01	13.05.05	512
T 1026/03 - 3.5.04	25.01.08	375, 893		T 166/04 - 3.5.01	18.07.07	327, 441
T 1027/03 - 3.2.01	10.01.05	457, 704		T 169/04 - 3.2.03	09.06.05	701
T 1063/03 - 3.3.04	16.12.04	499		T 170/04 - 3.2.03	01.07.05	496, 497
T 1067/03 - 3.5.01	04.05.05	465, 896		T 172/04 - 3.2.06	13.12.05	636, 637
T 1102/03 - 3.5.01	28.05.08	465, 466		T 188/04 - 3.3.04	31.05.05	297, 301
T 1110/03 - 3.5.02	04.10.04	2005, 302	473, 474, 553	T 201/04 - 3.3.03	29.06.05	739
T 1121/03 - 3.3.10	20.04.06	232		T 221/04 - 3.2.03	05.05.04	512, 524
T 1165/03 - 3.3.08	03.05.07	772, 774		T 235/04 - 3.3.10	29.06.06	174
T 1172/03 - 3.2.02	04.05.05	53, 57		T 240/04 - 3.5.01	13.12.07	890, 891
T 1173/03 - 3.3.01	29.06.06	266		T 242/04 - 3.3.06	13.06.06	748
T 1184/03 - 3.5.02	23.06.05	392		T 276/04 - 3.3.08	24.06.04	612, 919
T 1197/03 - 3.3.01	14.06.05	859		T 292/04 - 3.3.04	17.10.05	155
T 1198/03 - 3.3.02	23.01.07	532		T 300/04 - 3.5.01	21.04.05	279, 899
T 1200/03 - 3.3.07	15.06.05	161		T 306/04 - 3.5.01	02.03.07	6
T 1213/03 - 3.3.06	24.05.05	171, 222		T 311/04 - 3.2.01	09.10.07	327
T 1236/03 - 3.3.03	08.03.06	206		T 313/04 - 3.2.01	19.12.06	548
T 1239/03 - 3.3.03	02.11.06	323, 324, 373		T 326/04 - 3.3.06	12.12.06	236
				T 328/04 - 3.3.04	27.11.07	245

Table of cases

T 341/04 - 3.2.05	26.05.06	231	T 911/04 - 3.2.02	10.02.05	453
T 352/04 - 3.3.07	11.10.07	365	T 927/04 - 3.3.03	10.05.06	701, 704, 712, 715
T 386/04 - 3.2.03	09.01.07	834, 905	T 933/04 - 3.3.07	06.12.07	891
T 388/04 - 3.5.02	22.03.06	2007, 16	T 934/04 - 3.4.01	17.06.05	160
T 431/04 - 3.3.08	13.09.04	842	T 936/04 - 3.3.07	24.04.08	386
T 440/04 - 3.3.05	26.11.08	337	T 937/04 - 3.3.06	21.02.06	750
T 441/04 - 3.2.07	07.05.08	559	T 956/04 - 3.3.07	17.01.08	288, 289
T 449/04 - 3.2.02	25.02.06	418	T 986/04 - 3.2.07	14.11.06	794
T 452/04 - 3.3.03	12.01.06	247-249	T 991/04 - 3.3.05	22.11.05	433, 642, 849
T 453/04 - 3.3.03	01.02.07	556, 570	T 998/04 - 3.3.01	13.03.07	565
T 470/04 - 3.3.06	12.06.07	897	T 1006/04 - 3.3.07	09.01.09	908
T 474/04 - 3.3.07	30.06.05	2006, 129	T 1033/04 - 3.4.02	21.09.06	874
		553	T 1039/04 - 3.3.01	04.09.08	908
T 479/04 - 3.3.03	20.10.05	598	T 1040/04 - 3.2.03	23.03.06	2006, 597
T 489/04 - 3.5.02	08.09.05	511	T 1044/04 - 3.5.04	29.01.07	708
T 494/04 - 3.4.01	25.09.07	472, 894, 902	T 1057/04 - 3.3.10	14.03.07	174
T 505/04 - 3.3.08	07.10.05	282, 285	T 1060/04 - 3.4.02	29.11.07	891
T 509/04 - 3.3.04	05.07.05	149	T 1064/04 - 3.3.07	27.06.08	689
T 514/04 - 3.3.09	12.09.06	791	T 1105/04 - 3.3.09	24.04.08	285, 714
T 522/04 - 3.3.08	28.05.09	42	T 1123/04 - 3.4.02	25.08.06	613
T 550/04 - 3.3.01	02.04.08	476	T 1124/04 - 3.3.03	17.01.07	900
T 583/04 - 3.4.03	06.06.06	613	T 1142/04 - 3.4.02	04.03.05	875
T 593/04 - 3.2.07	20.10.05	736	T 1154/04 - 3.3.08	21.04.05	438, 439
T 604/04 - 3.3.08	16.03.06	239	T 1161/04 - 3.5.01	06.12.06	14
T 624/04 - 3.4.02	08.11.06	469, 712, 860	T 1177/04 - 3.2.02	14.03.06	716
T 627/04 - 3.3.08	15.09.05	278	T 1178/04 - 3.3.09	27.02.07	2008, 80
T 667/04 - 3.3.09	23.01.07	894			735, 829, 848, 925
T 696/04 - 3.3.03	15.09.05	900	T 1181/04 - 3.3.06	31.01.05	2005, 312
T 707/04 - 3.5.02	04.04.06	851	T 1191/04 - 3.5.01	22.11.07	230
T 711/04 - 3.4.03	12.07.05	801, 834	T 1212/04 - 3.4.02	12.07.06	192, 464
T 717/04 - 3.2.04	28.02.07	573	T 1216/04 - 3.2.04	22.04.05	908
T 738/04 - 3.4.01	11.12.08	90	T 1218/04 - 3.2.06	16.03.06	780
T 762/04 - 3.3.10	15.11.07	565	T 1222/04 - 3.5.01	12.04.06	876
T 763/04 - 3.2.04	22.06.07	440, 615, 915	T 1242/04 - 3.5.01	20.10.06	2007, 421
T 781/04 - 3.5.03	30.11.05	433, 849	T 1255/04 - 3.3.01	16.03.05	2005, 424
T 792/04 - 3.3.10	20.11.07	891	T 1260/04 - 3.2.02	22.03.07	515
T 799/04 - 3.3.06	29.06.05	252	T 1262/04 - 3.3.04	07.03.07	239
T 812/04 - 3.5.01	18.11.05	498, 636	T 1273/04 - 3.4.03	16.11.07	895, 902
T 846/04 - 3.4.01	04.07.07	888	T 1279/04 - 3.4.03	25.09.07	282
T 864/04 - 3.3.09	03.04.07	779	T 1284/04 - 3.5.01	07.03.07	194
T 868/04 - 3.3.10	10.05.06	337	T 1306/04 - 3.3.08	08.12.05	175
T 870/04 - 3.3.08	11.05.05	225-227, 239	T 1315/04 - 3.2.07	18.04.05	928
T 887/04 - 3.2.01	14.11.06	723	T 1316/04 - 3.3.03	25.11.05	247
T 899/04 - 3.5.04	02.04.08	410	T 1319/04 - 3.3.02	22.04.08	2009, 36
T 902/04 - 3.4.02	07.06.06	827, 913			145
T 903/04 - 3.3.06	12.09.06	165	T 1321/04 - 3.2.04	28.02.05	282, 283
T 908/04 - 3.3.03	15.02.06	256, 287	T 1329/04 - 3.3.08	28.06.05	175, 176, 239

T 1336/04 - 3.3.08	09.03.06	175, 176	T 233/05 - 3.5.04	09.01.09	894
T 1341/04 - 3.3.09	10.05.07	831	T 242/05 - 3.2.03	20.09.06	877, 929
T 1345/04 - 3.3.10	17.01.08	857	T 245/05 - 3.2.06	25.05.05	928
T 1351/04 - 3.5.01	18.04.07	23	T 248/05 - 3.3.08	25.04.06	759
T 1355/04 - 3.5.04	07.11.08	835	T 250/05 - 3.3.02	04.03.08	369
T 1366/04 - 3.3.10	16.04.08	838	T 255/05 - 3.3.08	18.10.05	452, 686
T 1374/04 - 3.3.08	07.04.06	2007, 313	T 259/05 - 3.3.10	26.03.09	174
T 1380/04 - 3.2.06	26.09.06	715, 830	T 263/05 - 3.2.06	28.06.07	2008, 329
T 1382/04 - 3.5.01	30.07.09	460			273, 475, 476,
T 1400/04 - 3.5.04	28.02.08	899			802, 804, 836,
T 1408/04 - 3.2.06	17.11.06	168, 280,	T 265/05 - 3.5.01	18.01.08	856
		324-326	T 297/05 - 3.3.08	02.02.06	379, 869
T 1409/04 - 3.5.04	14.06.07	567	T 303/05 - 3.5.03	08.06.06	276
T 1416/04 - 3.2.06	14.12.06	803	T 308/05 - 3.5.03	27.02.06	878
T 1418/04 - 3.2.05	22.11.07	280	T 309/05 - 3.5.03	27.10.06	909
			T 313/05 - 3.3.04	06.07.06	196
2005			T 316/05 - 3.3.10	19.12.07	89
T 1/05 - 3.3.03	20.04.07	804	T 323/05 - 3.3.01	09.08.07	611
T 5/05 - 3.3.01	09.11.05	400, 419	T 339/05 - 3.3.01	10.04.08	798
T 6/05 - 3.3.10	09.10.07	733	T 340/05 - 3.2.01	06.06.07	238
T 21/05 - 3.3.04	13.07.06	241	T 369/05 - 3.3.10	27.06.07	719
T 29/05 - 3.3.08	13.03.06	255, 260, 268	T 373/05 - 3.2.07	27.03.07	232
T 62/05 - 3.3.03	14.11.06	398	T 382/05 - 3.3.06	18.12.06	474
T 63/05 - 3.5.02	26.04.06	613	T 383/05 - 3.5.02	01.08.07	892
T 65/05 - 3.3.05	17.04.08	749, 751	T 407/05 - 3.4.02	03.07.08	754
T 70/05 - 3.3.08	07.02.06	410-412	T 425/05 - 3.3.02	23.05.06	902
T 78/05 - 3.5.05	10.01.08	896	T 427/05 - 3.2.03	12.06.07	579, 734
T 80/05 - 3.3.04	19.11.08	412	T 433/05 - 3.3.04	14.06.07	463
T 83/05 - 3.3.04	22.05.07	2007, 644	T 452/05 - 3.2.04	30.08.06	175, 237, 239
T 87/05 - 3.3.10	04.09.07	837, 889, 897	T 461/05 - 3.4.03	10.07.07	115, 722
T 94/05 - 3.2.04	12.07.07	276, 278	T 464/05 - 3.2.06	14.05.07	324, 326
T 97/05 - 3.3.03	31.05.07	323	T 466/05 - 3.3.03	19.12.06	237, 247
T 98/05 - 3.4.03	08.11.07	327	T 471/05 - 3.4.02	06.02.07	247-249
T 99/05 - 3.3.03	29.08.06	754	T 490/05 - 3.4.03	21.08.07	6
T 107/05 - 3.5.03	12.06.07	895, 920, 921	T 514/05 - 3.4.03	08.09.05	755, 757
T 123/05 - 3.5.02	24.05.07	749, 750	T 515/05 - 3.3.09	02.08.07	849, 854
T 127/05 - 3.2.01	31.08.06	874	T 537/05 - 3.3.03	29.03.07	440
T 142/05 - 3.2.01	13.06.06	359	T 555/05 - 3.3.03	24.05.07	846
T 151/05 - 3.2.04	22.11.07	704, 707, 708	T 570/05 - 3.3.05	07.03.08	253, 256
T 179/05 - 3.3.03	30.11.06	233	T 580/05 - 3.3.04	06.03.08	320
T 184/05 - 3.2.07	05.02.08	320	T 591/05 - 3.4.02	11.05.06	370
T 188/05 - 3.2.05	18.06.07	705, 708	T 619/05 - 3.5.01	28.02.08	392, 823, 846
T 190/05 - 3.2.01	23.07.08	782	T 629/05 - 3.5.01	06.07.07	351
T 211/05 - 3.5.04	30.07.09	925	T 633/05 - 3.5.02	28.03.07	230
T 214/05 - 3.3.06	19.01.07	892	T 641/05 - 3.3.08	09.11.06	745
T 223/05 - 3.3.01	24.04.07	111, 282, 285,	T 642/05 - 3.3.10	20.03.07	226, 239
		837	T 651/05 - 3.3.06	17.05.06	859
					255

Table of cases

T 666/05 - 3.3.04	13.11.08	412	T 1109/05 - 3.2.06	10.04.08	888
T 687/05 - 3.2.06	28.09.07	377, 378, 922	T 1119/05 - 3.3.03	08.01.08	838
T 688/05 - 3.5.01	19.09.07	190, 194	T 1120/05 - 3.2.04	21.02.08	340
T 693/05 - 3.4.02	06.03.07	844	T 1123/05 - 3.2.04	28.10.08	902
T 700/05 - 3.3.07	18.09.08	628	T 1127/05 - 3.3.04	15.01.08	137, 142, 152
T 704/05 - 3.4.03	31.07.07	878	T 1131/05 - 3.3.03	19.02.08	210
T 708/05 - 3.3.09	14.02.07	113, 131, 901	T 1152/05 - 3.3.03	08.04.08	430, 627, 853, 909
T 710/05 - 3.3.08	22.02.07	175	T 1170/05 - 3.5.02	27.10.06	616
T 725/05 - 3.3.04	14.10.09	917	T 1180/05 - 3.2.02	02.08.07	368
T 736/05 - 3.3.03	28.06.07	795	T 1182/05 - 3.2.01	19.02.08	607, 612, 919
T 739/05 - 3.3.06	03.11.05	437	T 1186/05 - 3.3.09	06.12.07	113
T 743/05 - 3.2.07	12.10.06	510, 637	T 1187/05 - 3.2.06	12.07.07	738
T 752/05 - 3.5.01	31.01.06	908	T 1210/05 - 3.3.01	24.01.08	561, 571
T 760/05 - 3.2.07	03.06.08	708	T 1213/05 - 3.3.04	27.09.07	41, 411, 708, 799
T 774/05 - 3.2.07	08.11.07	477, 589, 765, 768, 793, 850	T 1216/05 - 3.2.04	10.06.08	201
T 780/05 - 3.3.09	25.06.08	557	T 1217/05 - 3.2.04	08.05.07	276
T 788/05 - 3.2.02	08.05.07	334, 419	T 1220/05 - 3.5.03	08.05.07	543
T 795/05 - 3.3.03	13.12.07	337	T 1227/05 - 3.5.01	13.12.06	2007, 574
T 798/05 - 3.2.02	30.07.07	471, 796	T 1237/05 - 3.2.03	15.03.07	22, 23, 188
T 804/05 - 3.2.03	16.10.07	72	T 1267/05 - 3.2.07	21.06.07	760, 763
T 824/05 - 3.3.03	28.09.07	166, 175	T 1276/05 - 3.2.07	07.02.08	716
T 856/05 - 3.4.03	26.07.07	680			833, 857, 904, 905
T 876/05 - 3.4.01	07.11.07	327, 713	T 1279/05 - 3.4.02	15.07.08	778
T 894/05 - 3.3.10	11.11.08	322	T 1282/05 - 3.5.05	20.05.08	904, 907
T 895/05 - 3.2.02	24.01.08	272	T 1286/05 - 3.3.02	01.04.08	141
T 898/05 - 3.3.08	07.07.06	225-227, 239	T 1305/05 - 3.5.02	25.06.08	893
T 903/05 - 3.3.04	30.08.07	410, 416	T 1309/05 - 3.4.02	10.10.06	612, 613, 919
T 906/05 - 3.3.08	25.01.07	280	T 1311/05 - 3.4.03	11.12.07	895
T 912/05 - 3.5.02	15.04.08	192	T 1314/05 - 3.4.01	15.04.08	143
T 916/05 - 3.5.02	10.05.07	759	T 1333/05 - 3.3.05	18.06.08	890, 894
T 922/05 - 3.2.04	07.03.07	856	T 1356/05 - 3.4.03	16.02.06	612, 919
T 930/05 - 3.5.01	10.11.06	1, 6	T 1360/05 - 3.4.03	16.02.06	612, 919
T 942/05 - 3.3.02	13.03.08	892, 896	T 1366/05 - 3.3.10	18.10.07	614, 920
T 954/05 - 3.3.02	03.05.07	238	T 1375/05 - 3.3.04	10.01.06	908
T 972/05 - 3.3.05	17.03.09	426	T 1378/05 - 3.4.03	09.10.07	582
T 978/05 - 3.3.09	15.07.08	903	T 1379/05 - 3.3.08	20.02.06	928
T 1007/05 - 3.5.04	18.06.09	863	T 1387/05 - 3.5.04	24.04.08	380
T 1008/05 - 3.3.03	17.01.08	709	T 1394/05 - 3.3.05	04.04.08	799
T 1018/05 - 3.2.06	25.09.07	246, 268	T 1401/05 - 3.4.02	20.09.06	477, 512, 515, 520
T 1029/05 - 3.3.03	12.03.08	701, 707, 858	T 1404/05 - 3.3.07	24.05.07	247, 255, 282
T 1046/05 - 3.5.02	20.02.08	261	T 1409/05 - 3.4.03	30.03.06	2007, 113
T 1048/05 - 3.3.04	05.12.07	276	T 1417/05 - 3.5.05	04.12.08	376, 378
T 1053/05 - 3.3.04	22.02.07	792	T 1433/05 - 3.2.04	28.11.07	206
T 1054/05 - 3.5.01	28.05.08	197			282
T 1082/05 - 3.3.01	26.09.07	858	T 1439/05 - 3.4.01	19.08.08	453, 541, 685
T 1093/05 - 3.5.01	13.06.07	2008, 430			
		619, 689			

T 1443/05 - 3.3.01	04.07.08	407, 423, 893	T 332/06 - 3.4.02	20.02.08	846
T 1449/05 - 3.4.03	26.09.06	901	T 333/06 - 3.2.06	13.03.07	748
T 1459/05 - 3.2.03	21.02.08	807	T 335/06 - 3.2.02	07.12.07	492, 526, 856
T 1464/05 - 3.4.02	14.05.09	82, 164, 181, 344	T 339/06 - 3.2.01	05.12.07	703, 890, 891
T 1466/05 - 3.3.08	27.07.07	240, 243	T 341/06 - 3.2.01	31.01.08	380
T 1482/05 - 3.2.04	08.02.08	457	T 353/06 - 3.2.05	16.07.08	777
T 1505/05 - 3.5.01	25.07.08	8	T 364/06 - 3.3.04	22.03.07	240, 241
T 1514/05 - 3.3.09	01.07.09	213	T 385/06 - 3.5.04	06.03.08	899
T 1537/05 - 3.2.04	23.11.07	280	T 404/06 - 3.4.02	17.04.08	266
T 1538/05 - 3.2.04	28.08.06	12	T 405/06 - 3.3.08	06.12.07	280
T 1557/05 - 3.4.03	04.05.07	704, 708	T 406/06 - 3.3.04	16.01.08	137, 143
T 1559/05 - 3.4.02	15.11.07	335, 337	T 421/06 - 3.5.01	14.12.06	23
T 1561/05 - 3.2.03	17.10.06	506, 528, 531, 623	T 426/06 - 3.3.10	24.01.08	736
T 1578/05 - 3.5.03	26.04.07	675	T 438/06 - 3.2.04	16.12.08	211
T 1586/05 - 3.3.03	06.02.08	247, 248	T 439/06 - 3.5.01	31.01.07	2007, 491 528, 531
2006			T 451/06 - 3.2.06	04.10.07	916
T 3/06 - 3.4.01	03.05.07	767	T 455/06 - 3.2.06	02.09.08	893
T 33/06 - 3.3.06	18.09.07	656	T 462/06 - 3.3.01	01.07.09	471
T 53/06 - 3.4.02	21.02.08	476, 750	T 477/06 - 3.5.01	20.02.09	417
T 63/06 - 3.2.04	24.06.08	250, 570	T 482/06 - 3.5.02	18.05.06	543
T 104/06 - 3.2.05	20.07.07	776	T 493/06 - 3.3.08	18.09.07	398, 562
T 106/06 - 3.3.04	21.06.07	308	T 495/06 - 3.4.03	04.11.08	352
T 121/06 - 3.5.01	25.01.07	274, 688, 689, 915	T 515/06 - 3.3.04	18.01.07	888
T 123/06 - 3.3.10	10.01.08	238	T 516/06 - 3.3.08	23.05.07	897, 903
T 133/06 - 3.3.09	29.05.08	469, 741, 746, 761	T 555/06 - 3.2.01	22.11.07	474
T 142/06 - 3.3.03	11.03.08	126	T 580/06 - 3.4.01	01.07.08	512, 568, 637
T 148/06 - 3.2.04	08.01.08	540	T 585/06 - 3.4.02	29.07.08	589, 925
T 170/06 - 3.2.04	04.03.08	220	T 601/06 - 3.5.05	05.05.09	466
T 190/06 - 3.3.09	18.11.08	751	T 606/06 - 3.2.03	23.04.08	315
T 211/06 - 3.3.07	25.04.07	167	T 635/06 - 3.3.10	02.07.07	791
T 221/06 - 3.4.02	24.07.08	540	T 671/06 - 3.4.03	02.08.07	272
T 229/06 - 3.2.02	09.12.08	76	T 673/06 - 3.3.01	01.04.09	448
T 250/06 - 3.3.08	11.10.07	406, 412	T 678/06 - 3.3.06	10.10.07	810
T 252/06 - 3.4.02	06.05.08	218	T 690/06 - 3.5.01	24.04.07	671
T 253/06 - 3.2.05	24.06.08	893	T 704/06 - 3.3.08	15.03.07	716
T 267/06 - 3.2.07	13.04.07	550	T 716/06 - 3.2.04	17.06.08	551, 918
T 286/06 - 3.3.06	09.11.07	264	T 750/06 - 3.5.02	08.03.07	614
T 289/06 - 3.5.03	17.12.07	739	T 765/06 - 3.2.03	11.12.06	429, 471
T 300/06 - 3.2.06	13.11.07	327	T 778/06 - 3.2.04	20.09.06	875
T 307/06 - 3.3.01	16.09.08	255	T 791/06 - 3.2.07	30.09.08	720, 908
T 309/06 - 3.3.08	25.10.07	241	T 809/06 - 3.5.01	27.06.07	855
T 321/06 - 3.4.01	05.03.08	413	T 824/06 - 3.3.09	09.12.08	352
			T 850/06 - 3.2.07	13.02.08	212
			T 857/06 - 3.3.04	05.06.08	477, 841
			T 859/06 - 3.3.03	21.05.08	247, 249
			T 860/06 - 3.3.06	02.10.07	93, 96
			T 869/06 - 3.5.05	05.06.09	466

Table of cases

T 875/06 - 3.2.01	12.03.08	714, 843, 851	T 1526/06 - 3.3.04	11.07.08	451, 738
T 876/06 - 3.3.09	08.05.07	320	T 1543/06 - 3.2.04	29.06.07	2, 3, 8, 189
T 884/06 - 3.3.08	07.11.07	241	T 1544/06 - 3.2.01	14.04.08	908
T 911/06 - 3.2.06	23.05.07	327, 544	T 1556/06 - 3.2.06	24.06.08	474
T 931/06 - 3.4.01	21.11.08	704	T 1562/06 - 3.5.02	22.09.09	400
T 971/06 - 3.3.08	21.03.07	533, 683, 689	T 1599/06 - 3.3.04	13.09.07	137, 142, 178, 281
T 980/06 - 3.5.01	26.05.09	927	T 1600/06 - 3.5.03	10.10.08	704
T 985/06 - 3.3.06	16.07.08	350	T 1629/06 - 3.3.06	16.01.08	861
T 993/06 - 3.3.06	21.11.07	853	T 1664/06 - 3.2.01	07.02.08	100
T 1020/06 - 3.x.xx	28.11.08	601	T 1704/06 - 3.5.01	14.12.07	450, 461, 896
T 1026/06 - 3.5.01	26.09.07	496, 509	T 1706/06 - 3.2.01	04.03.08	587
T 1030/06 - 3.5.01	17.12.08	181	T 1709/06 - 3.5.03	30.05.08	440, 612
T 1053/06 - 3.4.02	01.07.08	463, 466	T 1731/06 - 3.2.06	23.09.08	903
T 1063/06 - 3.3.10	03.02.09	2009, 516	T 1757/06 - 3.2.03	18.11.08	707
T 1074/06 - 3.3.04	09.08.07	146, 236	T 1763/06 - 3.4.02	15.09.09	856
T 1077/06 - 3.3.04	19.02.09	867	T 1771/06 - 3.3.08	07.02.08	280
T 1081/06 - 3.3.03	10.10.08	583	T 1772/06 - 3.3.08	16.10.07	315, 346
T 1088/06 - 3.2.05	20.04.07	379	T 1785/06 - 3.4.01	02.06.08	251
T 1095/06 - 3.3.07	07.05.08	519	T 1790/06 - 3.3.08	09.12.08	903
T 1099/06 - 3.3.08	30.01.08	871	T 1808/06 - 3.3.09	14.02.08	279, 283
T 1107/06 - 3.3.04	03.12.08	337, 349, 350	T 1855/06 - 3.3.07	18.06.09	159
T 1113/06 - 3.2.02	17.02.09	929	T 1859/06 - 3.2.06	26.02.08	897
T 1134/06 - 3.2.04	16.01.07	91, 92, 560	T 1873/06 - 3.5.01	13.09.07	835
T 1140/06 - 3.3.03	13.05.09	238	T 1875/06 - 3.3.04	08.01.08	92, 561
T 1154/06 - 3.2.03	09.12.08	578	T 1886/06 - 3.3.06	23.10.09	237
T 1165/06 - 3.3.08	19.07.07	239	T 1898/06 - 3.3.01	12.08.09	256
T 1167/06 - 3.3.05	26.07.07	746	T 1903/06 - 3.4.01	27.05.09	450
T 1183/06 - 3.2.07	06.05.09	217	T 1913/06 - 3.2.04	30.09.08	863, 868
T 1188/06 - 3.3.08	18.10.07	241	T 1923/06 - 3.2.04	24.04.09	464
T 1194/06 - 3.3.01	06.08.09	829			
T 1204/06 - 3.3.01	08.04.08	280			
T 1207/06 - 3.4.02	07.05.08	588	2007		
T 1208/06 - 3.2.02	03.07.08	586	T 8/07 - 3.3.03	07.05.09	336
T 1242/06 - 3.3.04	04.04.08	46, 47	T 33/07 - 3.2.06	17.07.08	903
T 1250/06 - 3.2.06	16.10.07	327	T 46/07 - 3.2.04	26.06.07	533
T 1254/06 - 3.5.03	08.03.07	391, 899	T 61/07 - 3.2.07	19.08.08	476
T 1269/06 - 3.4.02	20.09.07	329, 347	T 69/07 - 3.2.07	10.03.09	462, 750
T 1271/06 - 3.2.06	15.04.08	781	T 79/07 - 3.2.01	24.06.08	843
T 1300/06 - 3.3.08	08.04.08	866	T 82/07 - 3.5.04	23.01.08	565
T 1324/06 - 3.2.04	14.07.08	580, 844	T 114/07 - 3.2.06	09.12.08	778
T 1351/06 - 3.5.04	10.06.08	453, 542, 846	T 131/07 - 3.3.09	24.03.09	477
T 1396/06 - 3.3.04	31.05.07	175, 178	T 150/07 - 3.3.06	27.10.09	355
T 1407/06 - 3.3.06	09.12.08	327, 346	T 157/07 - 3.5.05	24.04.08	851
T 1452/06 - 3.3.08	10.05.07	226, 239	T 165/07 - 3.5.03	23.11.07	605, 841
T 1474/06 - 3.4.01	10.01.08	889	T 212/07 - 3.2.03	18.11.09	751
T 1505/06 - 3.2.07	18.09.07	466	T 257/07 - 3.2.04	13.03.08	507, 516, 908
T 1510/06 - 3.2.04	25.09.08	82			

T 261/07 - 3.3.08	27.09.07	496, 502, 507, 508, 513, 637	T 1266/07 - 3.5.03	26.11.09	473
T 273/07 - 3.2.02	08.01.09	752	T 1309/07 - 3.2.04	23.06.09	78
T 314/07 - 3.3.10	16.04.09	352	T 1374/07 - 3.3.02	13.01.09	321, 354, 355
T 321/07 - 3.2.06	23.10.08	903	T 1391/07 - 3.4.02	07.11.08	386
T 330/07 - 3.2.04	20.01.09	201	T 1395/07 - 3.3.10	07.07.09	282
T 336/07 - 3.2.04	11.10.07	189, 195	T 1465/07 - 3.4.02	09.05.08	510, 512, 526, 531
T 355/07 - 3.2.05	28.11.08	72	T 1500/07 - 3.2.04	06.05.08	381
T 382/07 - 3.3.04	26.09.08	336, 370, 399	T 1501/07 - 3.2.04	06.05.08	381
T 385/07 - 3.3.04	05.10.07	94, 142, 151	T 1502/07 - 3.2.04	06.05.08	381
T 390/07 - 3.3.08	20.11.08	551, 713, 728	T 1511/07 - 3.3.09	31.07.09	321
T 416/07 - 3.3.04	27.03.08	890	T 1515/07 - 3.5.01	03.07.08	671
T 473/07 - 3.5.01	30.11.07	514, 528	T 1557/07 - 3.4.01	09.07.08	442
T 509/07 - 3.5.04	30.09.09	194, 838, 853, 856	T 1774/07 - 3.3.06	23.09.09	708
T 520/07 - 3.2.01	18.02.09	588	T 1785/07 - 3.2.06	21.10.08	897
T 534/07 - 3.3.08	25.11.08	580	T 1863/07 - 3.2.02	11.01.08	928
T 546/07 - 3.2.04	14.02.08	93, 96	T 1865/07 - 3.2.04	29.01.09	582
T 565/07 - 3.2.03	10.09.09	892	T 1867/07 - 3.2.04	14.10.08	897
T 608/07 - 3.3.03	27.04.09	249	T 1875/07 - 3.5.01	05.11.08	912
T 656/07 - 3.2.02	06.05.09	807	T 1891/07 - 3.2.01	13.03.09	877
T 659/07 - 3.2.04	28.05.09	829	T 1982/07 - 3.3.08	26.02.08	665, 916
T 764/07 - 3.5.03	14.05.09	902	T 2049/07 - 3.2.07	08.09.09	285
T 773/07 - 3.3.10	06.11.08	534	2008		
T 775/07 - 3.2.04	07.04.09	353	T 51/08 - 3.5.05	07.05.09	391, 870
T 788/07 - 3.3.04	07.01.08	43	T 99/08 - 3.2.03	20.02.09	927
T 815/07 - 3.2.06	15.07.08	233, 238	T 235/08 - 3.3.07	08.04.09	448
T 824/07 - 3.3.03	05.10.07	174	T 246/08 - 3.4.03	14.08.08	615, 663, 667, 685, 915
T 883/07 - 3.4.03	22.11.07	924	T 343/08 - 3.4.02	07.01.09	469, 928
T 908/07 - 3.2.04	16.05.08	866	T 356/08 - 3.2.04	07.07.09	890
T 919/07 - 3.3.01	13.01.09	588	T 358/08 - 3.2.06	09.07.09	852, 854
T 926/07 - 3.2.04	14.05.08	469, 716, 717	T 378/08 - 3.2.06	24.11.09	588
T 937/07 - 3.3.05	28.08.09	475	T 384/08 - 3.3.04	26.06.09	734
T 979/07 - 3.4.02	15.10.09	902	T 426/08 - 3.4.02	01.12.08	778
T 1041/07 - 3.3.10	01.10.09	351	T 428/08 - 3.2.01	09.10.08	732, 736
T 1042/07 - 3.4.01	22.08.08	458	T 463/08 - 3.2.04	20.11.08	382
T 1072/07 - 3.2.07	19.12.08	213	T 493/08 - 3.4.02	29.09.09	370, 496, 518, 522
T 1078/07 - 3.2.02	18.09.09	921	T 508/08 - 3.3.08	08.10.09	475
T 1079/07 - 3.4.01	13.05.09	750	T 567/08 - 3.2.04	28.09.09	369
T 1098/07 - 3.2.04	26.02.09	918	T 616/08 - 3.3.04	23.03.09	839, 848, 867, 908
T 1100/07 - 3.2.03	25.07.08	552, 918	T 630/08 - 3.2.06	05.11.08	908
T 1125/07 - 3.3.10	07.10.09	349, 853	T 765/08 - 3.4.03	04.02.09	849
T 1179/07 - 3.3.03	10.03.09	158	T 783/08 - 3.3.03	15.07.09	853
T 1192/07 - 3.3.05	29.05.09	908	T 825/08 - 3.2.01	08.05.09	925
T 1225/07 - 3.3.06	29.05.09	246			
T 1232/07 - 3.4.03	27.09.07	272			
T 1237/07 - 3.5.05	12.02.08	441, 675			

Table of cases

T	871/08 - 3.3.05	23.02.09		534		W	26/90 - 3.2.02	09.11.90		295	
T	1090/08 - 3.3.08	30.03.09		849		W	36/90 - 3.3.01	04.12.90		313	
T	1382/08 - 3.4.01	30.03.09		824, 843, 921		W	38/90 - 3.2.02	13.03.91		305	
T	1465/08 - 3.5.03	27.07.09		501, 908		W	39/90 - 3.4.02	12.02.91		297	
T	1790/08 - 3.2.08	29.07.09		845		W	48/90 - 3.3.01	22.04.91		306	
T	1997/08 - 3.2.04	01.07.09		440		W	50/90 - 3.3.02	06.05.91		306	
T	2052/08 - 3.3.04	03.02.09		838, 908		W	59/90 - 3.3.01	21.06.91		301, 302	
T	2056/08 - 3.2.04	15.01.09		478		W	5/91 - 3.3.02	10.09.91		294	
T	2170/08 - 3.2.07	27.01.09		397		W	6/91 - 3.3.01	03.04.92		301, 302	
T	2321/08 - 3.5.02	11.05.09		344, 913		W	8/91 - 3.2.02	26.02.92		295	
2009						W	14/91 - 3.2.04	03.06.91		301	
T	18/09 - 3.3.08	21.10.09		225, 860		W	16/91 - 3.3.02	25.11.91		303	
T	114/09 - 3.2.03	12.05.09		454		W	17/91 - 3.3.02	08.08.91		301	
T	1427/09 - 3.5.05	17.11.09		540, 849		W	21/91 - 3.3.02	19.02.92		303	
PCT Protests						W	22/91 - 3.2.02	10.02.92		306	
						W	23/91 - 3.3.02	08.09.92		294, 303	
						W	28/91 - 3.3.02	27.02.92		294	
						W	31/91 - 3.3.02	20.12.91		306	
W	7/85 - 3.3.02	05.06.87	1988, 211	296		W	35/91 - 3.3.01	28.09.92		296, 309	
W	3/87 - 3.4.01	30.09.87		295		W	43/91 - 3.3.03	09.04.92		303	
W	4/87 - 3.2.02	02.10.87	1988, 425	505, 506		W	50/91 - 3.2.03	20.07.92		297	
W	2/88 - 3.5.01	10.04.89		295		W	52/91 - 3.3.02	19.10.92		297	
W	3/88 - 3.3.01	08.11.88	1990, 126	293, 297		W	54/91 - 3.2.01	28.01.92		295	
W	29/88 - 3.3.01	28.11.88		293, 294		W	5/92 - 3.5.01	28.02.92		293	
W	31/88 - 3.3.01	09.11.88	1990, 134	302		W	10/92 - 3.3.02	30.10.92		303	
W	32/88 - 3.4.01	28.11.88	1990, 138	294		W	22/92 - 3.3.02	16.11.92		297	
W	35/88 - 3.5.01	07.06.89		297		W	29/92 - 3.2.02	19.10.93		306	
W	44/88 - 3.4.01	31.05.89	1990, 140	297		W	32/92 - 3.2.02	15.10.92	1994, 239	305, 307	
W	3/89 - 3.3.01	11.04.89		293		W	33/92 - 3.3.01	12.08.92		297	
W	7/89 - 3.3.01	15.12.89		302		W	34/92 - 3.2.02	23.11.93		306	
W	11/89 - 3.3.02	09.10.89	1993, 225	301		W	38/92 - 3.3.02	22.10.93		307	
W	12/89 - 3.3.01	29.06.89	1990, 152	302		W	40/92 - 3.5.01	01.03.93		294	
W	13/89 - 3.3.02	12.07.90		294		W	45/92 - 3.2.02	15.10.93		306	
W	14/89 - 3.3.01	26.01.90		301		W	52/92 - 3.3.02	02.04.93		297	
W	16/89 - 3.4.01	29.11.89		294		W	3/93 - 3.3.01	21.10.93	1994, 931	495, 505	
W	17/89 - 3.2.02	02.03.91		303, 306		W	4/93 - 3.3.01	05.11.93	1994, 939	300	
W	19/89 - 3.3.01	14.11.91		304, 313		W	8/93 - 3.2.04	24.03.94		306	
W	21/89 - 3.4.02	13.06.91		299		W	9/93 - 3.3.01	14.07.94		307	
W	27/89 - 3.2.02	21.08.90		303		W	1/94 - 3.3.01	29.07.94		309	
W	30/89 - 3.3.02	07.06.90		295		W	3/94 - 3.3.01	15.12.94	1995, 775	309	
W	32/89 - 3.4.02	07.08.90		295		W	8/94 - 3.3.03	21.11.94		301	
W	6/90 - 3.2.02	19.12.90	1991, 438	297, 303, 304, 306, 307		W	2/95 - 3.4.01	18.10.95		307, 308	
W	18/90 - 3.2.01	17.08.90		303		W	6/95 - 3.3.01	16.07.96		309	
W	19/90 - 3.2.01	02.10.90		303		W	1/96 - 3.3.04	22.05.96		297	
W	24/90 - 3.2.01	05.10.90		303		W	4/96 - 3.3.02	20.12.96	1997, 552	310	
						W	6/96 - 3.3.01	15.04.97		310	
						W	1/97 - 3.3.04	15.11.97	1999, 33	303	

W	6/97 - 3.3.01	18.09.97	297, 301, 306, 310	W	1/06 - 3.3.08	04.01.07	946
W	6/98 - 3.4.02	17.12.98	295	W	18/06 - 3.3.04	05.03.07	946
W	11/99 - 3.3.05	20.10.99	2000, 186 307, 308	W	20/06 - 3.3.04	03.04.07	946
W	18/01 - 3.5.02	23.01.02	308	W	22/06 - 3.2.02	15.03.07	946
W	9/02 - 3.2.03	23.09.02	302	W	26/06 - 3.3.08	28.02.07	946
W	9/03 - 3.5.03	22.12.03	305	W	2/07 - 3.3.04	23.02.07	946
W	17/03 - 3.5.01	20.09.04	302, 303	W	6/07 - 3.4.01	17.07.07	946
W	21/04 - 3.2.07	25.05.07	302				

INDEX OF CITED PROVISIONS

1. European Patent Convention

EPC 2000 – articles

Art. 14 EPC	626	Art. 54(3) EPC	64, 65, 162, 262, 337, 397
Art. 14(2) EPC	625, 626, 645	Art. 54(4) EPC	64, 133-135, 137, 142, 145, 146, 262
Art. 14(3) EPC	950	Art. 54(5) EPC	64, 137, 141-143, 145-147, 152
Art. 14(4) EPC	430, 431, 625-628	Art. 55 EPC	68
Art. 16 EPC	645, 650	Art. 56 EPC	162, 213
Art. 18 EPC	650	Art. 57 EPC	57, 223, 225, 251, 262, 737
Art. 19(2) EPC	591	Art. 60(1) EPC	651
Art. 20 EPC	632	Art. 60(3) EPC	638, 651
Art. 21 EPC	632, 842	Art. 61 EPC	643, 651
Art. 21(2) EPC	632	Art. 61(1) EPC	633
Art. 21(3)(a) EPC	842	Art. 64 EPC	251, 764
Art. 21(3)(b) EPC	842	Art. 64(2) EPC	158, 287
Art. 23(4) EPC	952	Art. 68 EPC	737, 738
Art. 24 EPC	882	Art. 69 EPC	247, 251, 281, 282
Art. 24(1) EPC	594	Art. 69(1) EPC	279, 282, 283
Art. 24(3) EPC	594, 602, 879	Art. 72 EPC	631
Art. 24(4) EPC	602, 879	Art. 75 EPC	647
Art. 51(3) EPC	393	Art. 75(1)(b) EPC	647
Art. 52 EPC	1, 4, 12, 251, 262, 737	Art. 76 EPC	375
Art. 52(1) EPC	1, 2, 8, 11, 63, 64, 192, 223, 790	Art. 76(1) EPC	375, 380-382, 384
Art. 52(2) EPC	XXXVII, 1, 8, 10, 11, 16, 18, 20	Art. 76(2) EPC	393, 653
Art. 52(2)(c) EPC	17, 189	Art. 78 EPC	646
Art. 52(3) EPC	1, 10, 11, 16-18, 20, 189	Art. 78(1) EPC	685
Art. 52(4) EPC	60	Art. 78(2) EPC	646
Art. 53 EPC	36	Art. 79 EPC	652
Art. 53(a) EPC	36, 42, 50	Art. 79(1) EPC	491
Art. 53(b) EPC	36, 42, 44, 45, 47, 48, 50	Art. 79(2) EPC	535, 652
Art. 53(c) EPC	36, 37, 49-62, 64, 133, 134, 140-142, 145, 146, 259	Art. 79(3) EPC	652
Art. 54 EPC	64, 68, 656	Art. 80 EPC	645, 648, 651
Art. 54(1) EPC	64	Art. 82 EPC	292, 293, 296, 299, 304, 389
Art. 54(2) EPC	64, 72, 76, 162, 262, 397, 560, 569, 783	Art. 83 EPC	225, 229, 232, 234, 235, 237, 238, 241, 243, 245-247, 255, 277, 805
		Art. 84 EPC	229, 245-247, 251, 254, 257, 275-277, 279, 281, 283, 285, 737, 798, 805, 807, 808, 835
		Art. 87 EPC	397, 400, 414, 640
		Art. 87(1) EPC	397, 407, 417, 490, 496, 503

Index of cited provisions

Art. 87(2) EPC	397	Art. 105a(2) EPC	737
Art. 87(4) EPC	417	Art. 105b(3) EPC	737
Art. 89 EPC	397	Art. 105c EPC	631, 737
Art. 90 EPC	645, 648	Art. 106 EPC	821, 839
Art. 90(1) EPC	645	Art. 106(1) EPC	632, 822, 839
Art. 90(3) EPC	645	Art. 106(2) EPC	543, 819, 821, 841
Art. 90(4) EPC	645	Art. 107 EPC	393, 825, 826, 839, 843, 844
Art. 90(5) EPC	645	Art. 108 EPC	478, 838, 839, 849, 850, 854, 856, 877
Art. 92(1) EPC	671	Art. 109 EPC	839, 876, 928
Art. 93 EPC	64	Art. 109(1) EPC	875, 916, 939
Art. 93(1) EPC	629, 658	Art. 109(2) EPC	939
Art. 93(1)(b) EPC	655	Art. 110 EPC	839
Art. 94 EPC	658	Art. 110(1) EPC	862
Art. 94(1) EPC	658	Art. 111 EPC	821, 827, 839
Art. 94(2) EPC	658, 660	Art. 111(1) EPC	92, 862, 870
Art. 94(3) EPC	392, 541, 661, 663, 913	Art. 111(2) EPC	869-871
Art. 94(4) EPC	392, 485, 678	Art. 112 EPC	879
Art. 96(2) EPC	650	Art. 112(1) EPC	878, 880
Art. 97 EPC	633	Art. 112(1)(b) EPC	XXXVII, 17
Art. 97(1) EPC	542	Art. 112a EPC	625, 631, 842, 870, 882, 884
Art. 97(2) EPC	679, 680	Art. 112a(2) EPC	882, 887
Art. 97(3) EPC	697, 699	Art. 112a(2)(a) EPC	882-884
Art. 98 EPC	698	Art. 112a(2)(c) EPC	882, 884, 885
Art. 99 EPC	764, 769	Art. 112a(2)(d) EPC	882, 883, 886, 887
Art. 99(1) EPC	725, 765, 767, 769	Art. 112a(4) EPC	490, 496
Art. 99(3) EPC	586, 765, 793, 825	Art. 113 EPC	438, 810, 811, 814, 877, 882, 885, 886
Art. 100 EPC	721, 738, 764, 765, 774, 797, 798, 802, 804	Art. 113(1) EPC	438, 440, 441, 444, 445, 550, 551, 661, 672, 811, 813, 815, 887, 896, 914, 915, 918, 941
Art. 100(a) EPC	397	Art. 113(2) EPC	451, 541, 542, 684, 738, 886, 892, 915
Art. 100(b) EPC	233, 247	Art. 114 EPC	92, 725, 786, 801, 827, 836, 873
Art. 100(c) EPC	376	Art. 114(1) EPC	444, 700, 725, 726, 783, 786-789, 836
Art. 101 EPC	764, 785, 788, 801	Art. 114(2) EPC	700, 716, 725
Art. 101(1) EPC	444, 777, 788, 810-813, 815	Art. 115 EPC	723-726, 728, 729, 786, 801, 826
Art. 101(2) EPC	806, 811, 820	Art. 115(1) EPC	726
Art. 101(3)(a) EPC	301, 792, 805, 806, 808, 820	Art. 116 EPC	454
Art. 102 EPC	801	Art. 116(1) EPC	444, 453, 458
Art. 104 EPC	476, 741		
Art. 104(1) EPC	476, 740, 741, 762		
Art. 104(2) EPC	741, 762		
Art. 104(3) EPC	741		
Art. 105 EPC	719, 722, 825		
Art. 105(2) EPC	719		
Art. 105a EPC	625, 631, 737, 739		

Art. 116(2) EPC	454	Art. 134a EPC	931
Art. 116(3) EPC	473	Art. 134a(1)(c) EPC	942
Art. 116(4) EPC	473, 477	Art. 134a(2) EPC	931
Art. 117 EPC	545, 549	Art. 150(2) EPC	945
Art. 117(1) EPC	545, 547, 550, 741, 918	Art. 153(2) EPC	628, 945
Art. 117(1)(g) EPC	547	Art. 153(3) EPC	65, 66
Art. 117(2) EPC	545	Art. 153(4) EPC	66
Art. 118 EPC	638	Art. 153(5) EPC	65, 66
Art. 120 EPC	663	Art. 177 EPC	641
Art. 121 EPC	482, 484, 485, 490, 533, 535, 636, 646, 653	EPC 1973 – articles	
Art. 121(1) EPC	484	Art. 1 EPC 1973	642, 643
Art. 121(4) EPC	484, 504	Art. 2(2) EPC 1973	486, 643
Art. 122 EPC	492	Art. 5(3) EPC 1973	951
Art. 122(1) EPC	490-492, 507	Art. 10 EPC 1973	913
Art. 122(2) EPC	507	Art. 10(1) EPC 1973	473
Art. 122(3) EPC	490	Art. 10(2)(a) EPC 1973	473, 951
Art. 122(4) EPC	490, 503, 504	Art. 10(2)(b) EPC 1973	473
Art. 122(5) EPC	490, 529	Art. 14 EPC 1973	626-628, 646
Art. 123 EPC	661	Art. 14(1) EPC 1973	316, 626, 646, 935
Art. 123(1) EPC	315, 661, 665	Art. 14(2) EPC 1973	316, 537, 625-628, 646
Art. 123(2) EPC	262, 283, 315, 320, 321, 324, 336, 337, 340, 344, 350-352, 366, 369, 370, 381, 382, 384, 737, 802, 924	Art. 14(4) EPC 1973	537, 625, 627, 628, 774, 853
Art. 123(3) EPC	315, 355, 358, 366, 369, 737, 797, 802	Art. 14(5) EPC 1973	628, 774, 853, 908
Art. 125 EPC	941	Art. 15 EPC 1973	594, 912
Art. 127 EPC	631	Art. 16 EPC 1973	643, 649, 650
Art. 128 EPC	629	Art. 18 EPC 1973	643, 650
Art. 128(2) EPC	629	Art. 18(1) EPC 1973	643
Art. 128(4) EPC	630	Art. 18(2) EPC 1973	678
Art. 128(5) EPC	629	Art. 19 EPC 1973	591
Art. 133 EPC	571, 572	Art. 19(2) EPC 1973	592, 593, 596, 867, 925
Art. 133(1) EPC	572	Art. 20 EPC 1973	632
Art. 133(2) EPC	572	Art. 20(1) EPC 1973	494
Art. 134 EPC	571, 572	Art. 21 EPC 1973	351, 842, 877, 928
Art. 134(1) EPC	572, 574, 575, 931	Art. 21(1) EPC 1973	621, 760, 840
Art. 134(2) EPC	572, 931	Art. 21(3) EPC 1973	842, 843
Art. 134(2)(c) EPC	931, 932	Art. 21(3)(a) EPC 1973	621
Art. 134(3) EPC	572, 573	Art. 21(3)(b) EPC 1973	621
Art. 134(4) EPC	575	Art. 21(3)(c) EPC 1973	842
Art. 134(8) EPC	574-576, 931, 933	Art. 21(4) EPC 1973	842
		Art. 23(3) EPC 1973	641, 952
		Art. 23(4) EPC 1973	469, 952
		Art. 24 EPC 1973	594, 596, 599
		Art. 24(1) EPC 1973	596, 599, 601

Index of cited provisions

Art. 24(2) EPC 1973	594, 595, 601	Art. 54 EPC 1973	68, 77, 106, 111, 123, 125, 151, 153, 154, 158, 164, 186, 190, 194, 328, 348, 560, 562, 614, 775, 789, 790
Art. 24(3) EPC 1973	594, 595, 598, 599, 601, 602	Art. 54(1) EPC 1973	4, 12, 101, 116, 150, 153, 159, 194, 779, 781
Art. 24(4) EPC 1973	599	Art. 54(2) EPC 1973	12, 64, 66, 71-73, 75-77, 80, 83-85, 87, 88, 91, 95, 97, 100, 101, 106, 116, 122, 129, 153, 154, 164, 168, 169, 181, 190, 332, 334, 336, 417, 419, 420, 553, 657, 779, 782
Art. 25 EPC 1973	840	Art. 54(3) EPC 1973	64-66, 68, 94, 95, 99, 317, 332, 334, 336, 407, 411, 417, 419, 420, 656, 781
Art. 33 EPC 1973	640	Art. 54(4) EPC 1973	50, 64, 65, 317, 332, 334, 417
Art. 33(1)(b) EPC 1973	952	Art. 54(5) EPC 1973	64, 133-137, 141, 142, 145, 150
Art. 33(4) EPC 1973	953	Art. 55(a) EPC 1973	562
Art. 52 EPC 1973	2, 6, 9, 13, 123, 188, 193, 264, 328, 332, 664, 775, 790	Art. 55(1) EPC 1973	69, 639
Art. 52(1) EPC 1973	1-11, 21, 22, 25-28, 31, 44, 158, 173, 188, 189, 192, 223, 224, 228, 288, 697, 775, 789, 790	Art. 55(1)(a) EPC 1973	69, 562
Art. 52(2) EPC 1973	1-13, 16, 18, 19, 21, 25, 26, 30, 31, 33, 35, 188-190, 192, 194, 223, 224, 640, 670, 775, 789, 790	Art. 56 EPC 1973	4, 65, 99, 162, 172, 175, 177, 181, 182, 186, 188, 190, 203, 240, 328, 611, 775, 779, 846
Art. 52(2)(a) EPC 1973	12, 14, 28	Art. 57 EPC 1973	4, 7, 9, 56, 57, 140, 188, 223-228, 264, 332, 775, 789, 790
Art. 52(2)(b) EPC 1973	15, 196	Art. 60 EPC 1973	385
Art. 52(2)(c) EPC 1973	5, 7, 9, 11, 14, 16, 18, 22, 24-26, 28-33, 189, 196, 223	Art. 60(3) EPC 1973	489, 530, 638
Art. 52(2)(d) EPC 1973	15, 29, 33-35	Art. 61 EPC 1973	386, 644, 651
Art. 52(3) EPC 1973	1-16, 18, 19, 21, 22, 24-33, 35, 188, 189, 223, 640, 670	Art. 61(1) EPC 1973	634, 643, 644
Art. 52(4) EPC 1973	8, 9, 36, 37, 50-54, 56-64, 133, 134, 138, 140, 141, 143, 145, 147, 148, 151, 155, 160, 161, 228, 259, 365, 775, 789	Art. 61(1)(b) EPC 1973	388, 644
Art. 53 EPC 1973	41, 775, 789	Art. 64 EPC 1973	111
Art. 53(a) EPC 1973	36-41	Art. 64(1) EPC 1973	362, 698, 825
Art. 53(b) EPC 1973	9, 36-38, 43-49, 54, 639	Art. 64(2) EPC 1973	43, 156, 287, 288, 291, 362, 364
		Art. 65 EPC 1973	943

Art. 65(3) EPC 1973	687	Art. 84 EPC 1973	61, 62, 162, 228,
Art. 66 EPC 1973	643		237, 240, 246-250,
Art. 67(4) EPC 1973	393, 394, 653		253, 254, 256-261,
Art. 68 EPC 1973	738, 739, 764		263-271, 273,
Art. 69 EPC 1973	111, 234, 279, 282,		275-279, 282, 283,
	284-286, 356, 361,		286, 292, 317, 332,
	805, 806, 834		352, 356, 364, 779,
Art. 69(1) EPC 1973	282, 284, 286, 356,		805-808, 835, 899,
	357, 360, 361, 364,		922
	642, 806	Art. 86 EPC 1973	490
Art. 70(2) EPC 1973	316	Art. 86(2) EPC 1973	482, 483
Art. 72 EPC 1973	398	Art. 86(3) EPC 1973	508
Art. 74 EPC 1973	486	Art. 87 EPC 1973	272, 402, 415, 478,
Art. 75 EPC 1973	627, 658		640
Art. 75(1)(b) EPC 1973	647	Art. 87(1) EPC 1973	398-402, 409, 410,
Art. 76 EPC 1973	371, 378, 379, 387		414, 417-420, 422,
Art. 76(1) EPC 1973	375-384, 387, 400,		503
	922	Art. 87(3) EPC 1973	403
Art. 76(2) EPC 1973	393, 394	Art. 87(4) EPC 1973	400, 401, 417-419,
Art. 76(3) EPC 1973	389, 390		562
Art. 77(5) EPC 1973	493	Art. 87(5) EPC 1973	641
Art. 78(1)(a) EPC 1973	674	Art. 88 EPC 1973	400, 401
Art. 78(1)(c) EPC 1973	685	Art. 88(1) EPC 1973	420
Art. 78(2) EPC 1973	393, 478, 647	Art. 88(2) EPC 1973	400, 409, 420-422
Art. 78(3) EPC 1973	680	Art. 88(3) EPC 1973	400, 421-423
Art. 79(1) EPC 1973	491	Art. 88(4) EPC 1973	402-404, 409, 421
Art. 79(2) EPC 1973	393, 535, 652, 653	Art. 89 EPC 1973	398
Art. 80 EPC 1973	426, 626, 645, 646,	Art. 90 EPC 1973	650
	648	Art. 90(3) EPC 1973	503, 628
Art. 80(c) EPC 1973	651	Art. 91 EPC 1973	316, 645, 650
Art. 80(d) EPC 1973	316, 626, 646	Art. 91(2) EPC 1973	492, 503
Art. 82 EPC 1973	172, 273, 292, 293,	Art. 91(4) EPC 1973	394, 503
	295, 296, 299, 301,	Art. 91(5) EPC 1973	487, 645
	305, 308, 310, 312,	Art. 92 EPC 1973	299, 627, 659
	611, 681	Art. 93 EPC 1973	658
Art. 83 EPC 1973	37, 103, 108, 162,	Art. 93(1) EPC 1973	348, 629
	186, 224, 225,	Art. 94 EPC 1973	658, 659
	229-240, 242,	Art. 94(1) EPC 1973	627, 650, 658, 659
	244-250, 276, 277,	Art. 94(2) EPC 1973	489, 504, 627, 658,
	416, 440, 779, 816,		659
	855, 899	Art. 94(3) EPC 1973	659
		Art. 96 EPC 1973	441, 658, 675, 676,
			681
		Art. 96(1) EPC 1973	643, 649, 650, 660

Index of cited provisions

Art. 96(2) EPC 1973	391, 439, 441, 442, 494, 541, 542, 615, 661-665, 673, 676, 678, 688-690, 692, 840, 928	Art. 102(2) EPC 1973	806
Art. 96(3) EPC 1973	392, 442, 443, 485, 660, 663, 678, 679, 930	Art. 102(3) EPC 1973	301, 785, 788, 792, 801, 805-808, 820
Art. 97 EPC 1973	620, 680, 859	Art. 102(3)(a) EPC 1973	820
Art. 97(1) EPC 1973	312, 444, 451, 542, 650, 669, 674, 679, 680, 683, 688, 920, 930	Art. 102(3)(b) EPC 1973	820
Art. 97(2) EPC 1973	533, 633, 650, 687, 698	Art. 102(4) EPC 1973	496, 818, 819, 841
Art. 97(2)(a) EPC 1973	682, 683, 689, 845	Art. 102(5) EPC 1973	496, 819, 841
Art. 97(4) EPC 1973	370, 625, 633, 697-699	Art. 104 EPC 1973	748
Art. 97(6) EPC 1973	697	Art. 104(1) EPC 1973	461, 741, 748-750, 754, 755, 763
Art. 98 EPC 1973	620, 698	Art. 104(2) EPC 1973	761, 762
Art. 99 EPC 1973	720, 721, 769, 775	Art. 105 EPC 1973	720-723
Art. 99(1) EPC 1973	493, 563, 698, 710, 726, 766, 768, 770-773, 776, 780, 781, 784-786	Art. 105(1) EPC 1973	722
Art. 99(4) EPC 1973	587, 765, 793	Art. 106 EPC 1973	605, 606, 842, 847, 953
Art. 100 EPC 1973	569, 570, 721, 764, 767, 775, 787-789, 797, 798, 805-807, 830	Art. 106(1) EPC 1973	606, 632, 634, 663, 818, 823, 846, 851, 909, 923, 953
Art. 100(a) EPC 1973	440, 769, 775, 782, 789-791, 816, 855	Art. 106(3) EPC 1973	485, 542, 543, 680, 819, 821, 840, 841
Art. 100(b) EPC 1973	225, 233, 255, 276, 440, 774, 779, 781, 789, 792, 795, 915	Art. 106(4) EPC 1973	762, 763
Art. 100(c) EPC 1973	329, 330, 354, 367, 379, 743, 774, 789, 792, 794, 866, 922	Art. 107 EPC 1973	391, 587, 608, 682, 721, 760, 825-828, 831, 833, 839, 845-848
Art. 101 EPC 1973	592, 785, 788	Art. 108 EPC 1973	428, 432, 433, 493, 495, 501, 509, 518, 522, 523, 531, 534, 605, 606, 708, 714, 716, 720, 736, 747, 837, 849-851, 853-855, 859, 908, 909
Art. 101(1) EPC 1973	777, 788, 801	Art. 109 EPC 1973	389, 451, 495, 603, 685, 851, 876-878, 912, 929
Art. 101(2) EPC 1973	444, 788, 801, 810-813, 815, 846, 926	Art. 109(1) EPC 1973	495, 624, 842, 875-878, 928-930
Art. 102 EPC 1973	592, 764, 785, 788	Art. 109(2) EPC 1973	875, 877, 878
Art. 102(1) EPC 1973	330, 611, 785, 788, 801, 805, 806, 820, 869	Art. 110 EPC 1973	614, 828, 894
		Art. 110(1) EPC 1973	726
		Art. 110(2) EPC 1973	428, 541, 658, 823, 827
		Art. 110(3) EPC 1973	658, 678, 823, 827
		Art. 111 EPC 1973	828, 839, 868, 923

Art. 111(1) EPC 1973	142, 454, 484, 494, 639, 690, 703, 718, 738, 748, 762, 862, 863, 865, 866, 868-870	Art. 117 EPC 1973	547-549, 590
Art. 111(2) EPC 1973	690, 870, 872, 873	Art. 117(1) EPC 1973	398, 545-548, 553
Art. 112 EPC 1973	881	Art. 117(1)(c) EPC 1973	548
Art. 112(1)(a) EPC 1973	878, 879	Art. 117(1)(d) EPC 1973	546
Art. 112(1)(b) EPC 1973	60, 819, 879	Art. 117(1)(g) EPC 1973	548
Art. 113 EPC 1973	446, 447, 507, 673, 816, 868	Art. 117(2) EPC 1973	545
Art. 113(1) EPC 1973	438-446, 448, 449, 455, 506, 541, 551, 553, 585, 613-615, 662-664, 666, 669, 672-676, 678, 679, 688, 709, 762, 811, 813-817, 865, 914, 915, 917, 918, 921, 930	Art. 117(6) EPC 1973	545
Art. 113(2) EPC 1973	450-453, 541-543, 608, 683-687, 689, 820, 846, 877, 915, 929	Art. 118 EPC 1973	638, 643
Art. 114 EPC 1973	708, 719, 783, 788, 805	Art. 119 EPC 1973	637
Art. 114(1) EPC 1973	445, 471, 481, 702, 703, 714, 716, 717, 724, 726, 769, 783, 787, 788, 790, 792, 815, 822, 828, 836, 837, 864, 873	Art. 120 EPC 1973	479, 480
Art. 114(2) EPC 1973	467, 470, 474, 701-703, 705-710, 712-714, 716, 725, 742, 794, 796, 816, 836, 861, 918, 922	Art. 120(a) EPC 1973	482
Art. 115 EPC 1973	692, 724-728, 788, 791, 826	Art. 120(b) EPC 1973	479
Art. 115(1) EPC 1973	725, 726	Art. 121 EPC 1973	485, 948
Art. 115(2) EPC 1973	723, 726	Art. 121(1) EPC 1973	484
Art. 116 EPC 1973	444, 455, 456, 458, 472, 473, 584, 676-678, 915	Art. 121(2) EPC 1973	392, 485, 504, 948
Art. 116(1) EPC 1973	455, 458-460, 677, 753, 817	Art. 122 EPC 1973	388, 429, 491, 492, 494, 502, 504-506, 508, 510, 514, 517, 528, 530, 531, 654, 948
Art. 116(2) EPC 1973	454	Art. 122(1) EPC 1973	491, 492, 517, 519, 523, 530-532
		Art. 122(2) EPC 1973	427, 432, 434, 487, 495, 496, 499-503, 507, 530, 533
		Art. 122(3) EPC 1973	501, 502, 507, 558
		Art. 122(4) EPC 1973	494, 495, 624
		Art. 122(5) EPC 1973	503-505, 654, 948
		Art. 122(6) EPC 1973	505, 529, 531, 694
		Art. 123 EPC 1973	316, 367, 370, 470, 564, 642, 804, 806, 821, 874, 899
		Art. 123(2) EPC 1973	148, 173, 208, 230, 263, 265, 272, 290, 315-320, 322-327, 329-334, 338, 341-355, 357-359, 361, 366-371, 373, 374, 376, 377, 381-383, 401, 402, 408, 649, 697, 758, 759, 792, 800, 808, 830, 835

Art. 123(3) EPC 1973	287, 291, 330, 343, 344, 354, 356-370, 447, 561, 642, 800, 806, 808, 831, 832, 893, 902, 905
Art. 125 EPC 1973	385, 467, 493, 566, 597, 672, 893, 937
Art. 127 EPC 1973	529, 631
Art. 128 EPC 1973	629
Art. 128(2) EPC 1973	467, 629
Art. 128(4) EPC 1973	72, 630
Art. 129(a) EPC 1973	529
Art. 133 EPC 1973	581, 584, 589
Art. 133(2) EPC 1973	488, 573, 574
Art. 133(3) EPC 1973	574, 587, 843
Art. 133(4) EPC 1973	578, 770
Art. 134 EPC 1973	488, 574, 581, 582, 587, 589, 768
Art. 134(1) EPC 1973	521, 574, 577, 583, 933
Art. 134(2) EPC 1973	576
Art. 134(4) EPC 1973	575
Art. 134(7) EPC 1973	574-577, 583, 931, 933
Art. 134(8) EPC 1973	931
Art. 134(8)(c) EPC 1973	942
Art. 138 EPC 1973	765
Art. 138(1) EPC 1973	68
Art. 138(1)(a) EPC 1973	68
Art. 139 EPC 1973	68
Art. 139(2) EPC 1973	68
Art. 141 EPC 1973	943
Art. 150(2) EPC 1973	946
Art. 150(3) EPC 1973	425
Art. 153 EPC 1973	947
Art. 153(1) EPC 1973	949
Art. 153(2) EPC 1973	948
Art. 154(3) EPC 1973	292, 945, 946
Art. 155(3) EPC 1973	292, 945
Art. 158(1) EPC 1973	66
Art. 158(2) EPC 1973	65, 66, 518
Art. 158(3) EPC 1973	65
Art. 163 EPC 1973	571-573
Art. 163(1) EPC 1973	573
Art. 163(5) EPC 1973	573
Art. 163(6) EPC 1973	573

Art. 164(2) EPC 1973	41, 480, 533, 628, 642, 847, 952
Art. 167(2) EPC 1973	692
Art. 167(2)(a) EPC 1973	798
Art. 172 EPC 1973	640
Art. 177(1) EPC 1973	45, 502, 641

2. Implementing Regulations to the EPC

EPC 2000 – rules

R. 2(1) EPC	480, 849
R. 3 EPC	769
R. 3(1) EPC	628, 824
R. 3(3) EPC	723, 727
R. 4(1) EPC	476, 824
R. 6(1) EPC	645
R. 6(3) EPC	625
R. 10 EPC	650
R. 11(3) EPC	784
R. 14 EPC	387, 633
R. 14(1) EPC	633, 635
R. 14(3) EPC	635
R. 16 EPC	643
R. 17 EPC	643
R. 22 EPC	631, 736
R. 22(1) EPC	632, 729, 732
R. 22(2) EPC	732
R. 22(3) EPC	386, 530, 729, 731, 737
R. 25 EPC	375
R. 26 EPC	36, 38
R. 26(2)(c) EPC	772
R. 26(4) EPC	42
R. 26(4)(c) EPC	43
R. 26(6) EPC	49
R. 27(b) EPC	44
R. 28 EPC	39
R. 28(c) EPC	41, 42
R. 29 EPC	36, 38
R. 29(2) EPC	41
R. 30 EPC	243
R. 31 EPC	243, 244
R. 31(1) EPC	244
R. 31(1)(a) EPC	243
R. 32 EPC	243
R. 33 EPC	243

R. 34 EPC	243	R. 57a EPC	797, 802
R. 35 EPC	647	R. 58 EPC	484, 645
R. 36 EPC	375, 387	R. 59 EPC	484, 491
R. 36(1) EPC	387, 388, 538	R. 63 EPC	671, 835
R. 36(2) EPC	387, 389	R. 64(1) EPC	299, 311, 696
R. 36(3) EPC	393	R. 64(2) EPC	299, 300
R. 36(4) EPC	393	R. 67(1) EPC	658
R. 38 EPC	478, 490, 646, 647	R. 68(1) EPC	658
R. 38(3) EPC	629	R. 70 EPC	658, 660
R. 39 EPC	535, 652, 653	R. 70(1) EPC	490, 627, 658, 660
R. 39(1) EPC	490	R. 70(2) EPC	660
R. 39(2) EPC	394, 653	R. 70(3) EPC	490, 660
R. 40 EPC	645	R. 71 EPC	686, 697
R. 40(1) EPC	648	R. 71(1) EPC	661, 913
R. 40(1)(b) EPC	651	R. 71(2) EPC	74, 541, 663
R. 40(1)(c) EPC	646	R. 71(3) EPC	538, 540, 681-683, 686, 691
R. 41(2)(c) EPC	772	R. 71(4) EPC	686
R. 41(2)(h) EPC	853	R. 71(5) EPC	540, 690, 691, 728
R. 42(1)(b) EPC	263, 345	R. 71(7) EPC	682
R. 42(1)(c) EPC	163, 170, 299	R. 73(1) EPC	698
R. 42(1)(e) EPC	232	R. 75 EPC	764, 769
R. 42(1)(f) EPC	225	R. 76 EPC	765, 767-769, 775
R. 43 EPC	251, 257, 270, 275	R. 76(2)(a) EPC	562, 767, 770, 772, 776
R. 43(1) EPC	251, 263, 273	R. 76(2)(b) EPC	773, 776
R. 43(2) EPC	271, 273, 803, 804	R. 76(2)(c) EPC	773, 775, 776, 778-783, 785, 786, 788, 791, 792, 794, 807
R. 43(3) EPC	229, 261	R. 76(c) EPC	627, 725, 776, 777, 832
R. 44 EPC	292, 296	R. 77 EPC	775
R. 44(1) EPC	293, 309	R. 77(1) EPC	765, 767, 770, 773, 774, 776, 784, 786
R. 44(2) EPC	309	R. 77(2) EPC	770, 773
R. 45 EPC	291	R. 79(1) EPC	765, 784, 799, 812
R. 45(2) EPC	490	R. 79(2) EPC	765, 816
R. 45(3) EPC	696	R. 79(3) EPC	810-812, 814
R. 49 EPC	700	R. 80 EPC	797-800, 802, 803, 888, 892, 899
R. 49(10) EPC	700	R. 81(3) EPC	805, 811
R. 50(3) EPC	539, 770, 774, 849	R. 82 EPC	792, 801, 805, 806, 808, 820
R. 51(1) EPC	483	R. 82(1) EPC	540, 812, 820, 847
R. 51(2) EPC	482	R. 82(2) EPC	540, 543, 819-821
R. 52(2) EPC	654	R. 82(3) EPC	818, 819
R. 52(3) EPC	654		
R. 52(4) EPC	655		
R. 53 EPC	654		
R. 53(1) EPC	562		
R. 55 EPC	645		
R. 55(a) EPC	776		
R. 56 EPC	647-649		
R. 56(1) EPC	427, 647		
R. 56(3) EPC	648		

Index of cited provisions

R. 84(1) EPC	739	R. 111 EPC	593, 605-607, 615, 619
R. 84(2) EPC	718, 729, 809	R. 111(1) EPC	605, 813
R. 86 EPC	539, 772, 774	R. 111(2) EPC	74, 605, 607-615, 919, 937
R. 86(3) EPC	665	R. 112 EPC	849
R. 87 EPC	797	R. 112(1) EPC	499, 563, 590, 591, 646, 653, 818, 819
R. 88 EPC	741	R. 112(2) EPC	394, 590, 591, 624, 646, 818
R. 88(1) EPC	761	R. 113 EPC	605, 606, 615
R. 88(3) EPC	761	R. 113(2) EPC	617
R. 89 EPC	720, 764	R. 114 EPC	724, 727
R. 89(1) EPC	722	R. 114(1) EPC	723
R. 91 EPC	737	R. 114(2) EPC	723
R. 93(1) EPC	737	R. 115(1) EPC	467
R. 93(2) EPC	737	R. 115(2) EPC	447, 461
R. 95(2) EPC	737	R. 116 EPC	469, 471, 472, 716, 799, 894
R. 97(1) EPC	762	R. 117 EPC	546
R. 99 EPC	821, 838, 851, 852, 854	R. 118 EPC	545, 741
R. 99(1) EPC	850	R. 120 EPC	545, 741
R. 99(1)(a) EPC	850	R. 124 EPC	474, 476, 539
R. 99(1)(b) EPC	850, 851	R. 124(1) EPC	476
R. 99(1)(c) EPC	850-852	R. 125(2)(b) EPC	568
R. 99(2) EPC	824, 850, 853, 854	R. 125(4) EPC	568, 636
R. 99(3) EPC	853	R. 126(2) EPC	499, 563, 568, 637
R. 100 EPC	658, 827	R. 127 EPC	637
R. 100(1) EPC	541, 788, 789, 792, 805, 821, 888	R. 130(1) EPC	635
R. 100(2) EPC	428, 460, 658, 823	R. 131 EPC	478
R. 100(3) EPC	460, 658, 823	R. 131(1) EPC	483
R. 101 EPC	642, 747, 785, 862	R. 132 EPC	469, 478, 479, 533, 813
R. 101(1) EPC	628	R. 132(2) EPC	479, 663
R. 103 EPC	384, 541, 821, 826, 839, 876, 907, 909, 912, 928	R. 134 EPC	480, 530
R. 103(1)(a) EPC	671, 881, 907	R. 134(2) EPC	480
R. 103(1)(b) EPC	877, 907	R. 134(5) EPC	480, 481
R. 103(2) EPC	876, 907	R. 135 EPC	646
R. 104 EPC	882, 884, 887	R. 135(1) EPC	392
R. 104(a) EPC	882	R. 135(2) EPC	484
R. 104(b) EPC	882, 886, 887	R. 136 EPC	490, 495, 501
R. 106 EPC	882-884	R. 136(1) EPC	490, 495, 496, 499, 501, 503, 530
R. 107 EPC	884	R. 136(2) EPC	501, 558
R. 107(2) EPC	884	R. 136(3) EPC	490, 503, 504
R. 109 EPC	884	R. 136(4) EPC	494
R. 109(1) EPC	884	R. 137 EPC	623, 728
R. 109(2) EPC	884		
R. 109(3) EPC	884		

R. 137(1) EPC	660	R. 11 EPC 1973	952
R. 137(2) EPC	660	R. 13 EPC 1973	387, 633-635, 825
R. 137(3) EPC	541, 664, 665, 667, 681, 686, 799, 865, 888, 915, 916	R. 13(1) EPC 1973	633-635, 822
		R. 13(3) EPC 1973	635
R. 137(4) EPC	667	R. 15(2) EPC 1973	653
R. 138 EPC	65, 797, 798	R. 20 EPC 1973	736
R. 139 EPC	369, 370, 394, 545, 619, 622, 625, 648-650, 655, 686, 693, 772, 774	R. 20(1) EPC 1973	631, 632, 729, 732
R. 140 EPC	617-622, 797, 939	R. 20(2) EPC 1973	632, 732
R. 142 EPC	485, 530	R. 20(3) EPC 1973	386, 489, 530, 632, 729, 731, 733, 737
R. 142(1)(a) EPC	485, 486	R. 23a EPC 1973	65, 417, 652
R. 142(1)(b) EPC	488	R. 23b EPC 1973	36, 38
R. 142(1)(c) EPC	485, 486	R. 23b(1) EPC 1973	41
R. 142(4) EPC	485, 489	R. 23b(4) EPC 1973	42
R. 143 EPC	631	R. 23b(4)(c) EPC 1973	43
R. 143(1) EPC	631	R. 23b(5) EPC 1973	45-47
R. 143(1)(n) EPC	529	R. 23b(6) EPC 1973	49
R. 143(1)(r) EPC	529	R. 23c(b) EPC 1973	36, 44, 45
R. 143(1)(u) EPC	529	R. 23d EPC 1973	38, 39
R. 144 EPC	630	R. 23d(c) EPC 1973	41
R. 147 EPC	552	R. 23d(d) EPC 1973	38, 39
R. 150(1) EPC	771-773, 784, 785	R. 23e EPC 1973	36, 38
R. 151 EPC	577, 578	R. 23e(2) EPC 1973	41
R. 152 EPC	579	R. 24 EPC 1973	647
R. 152(6) EPC	579	R. 24(2) EPC 1973	648
R. 152(8) EPC	636, 844	R. 25 EPC 1973	375, 387, 388, 390
R. 152(11) EPC	583	R. 25(1) EPC 1973	376, 387-390, 491, 538, 696
R. 159 EPC	66, 436	R. 25(1)(b) EPC 1973	696
R. 159(1)(c) EPC	490	R. 25(2) EPC 1973	483, 653
R. 159(1)(f) EPC	490	R. 26(2)(c) EPC 1973	772
R. 160 EPC	947	R. 27 EPC 1973	173, 292
R. 163(2) EPC	629	R. 27(1)(b) EPC 1973	263, 344, 345
R. 164 EPC	313, 314, 947	R. 27(1)(c) EPC 1973	163, 170, 190, 299
		R. 27(1)(d) EPC 1973	299
		R. 27(1)(f) EPC 1973	225
		R. 27a EPC 1973	243
		R. 28 EPC 1973	243-245
		R. 28(1)(c) EPC 1973	245
		R. 28(2) EPC 1973	505
		R. 28(2)(a) EPC 1973	245, 505
		R. 28a EPC 1973	243
		R. 29 EPC 1973	251, 258, 270, 275, 292
		R. 29(1) EPC 1973	33, 117, 190, 257, 261, 263, 273, 274, 289, 361
EPC 1973 – rules			
R. 1 EPC 1973	769		
R. 1(1) EPC 1973	628, 824		
R. 2(1) EPC 1973	476, 477, 824		
R. 2(5) EPC 1973	477		
R. 6(1) EPC 1973	628		
R. 6(3) EPC 1973	537, 625, 627		
R. 9(3) EPC 1973	624, 784, 842		
R. 10(2) EPC 1973	952		

Index of cited provisions

R. 29(1)(a) EPC 1973	275	R. 51(4) EPC 1973	274, 387, 389, 390, 452, 491, 509, 523, 538, 540, 542, 617, 619, 620, 675, 682-684, 686-691, 845, 857, 859, 915, 929
R. 29(2) EPC 1973	271-273, 803, 804	R. 51(5) EPC 1973	682, 687, 688, 859
R. 29(2)(a) EPC 1973	272	R. 51(6) EPC 1973	455, 540, 617, 682, 687, 690-692, 728
R. 29(2)(c) EPC 1973	271, 272	R. 51(8) EPC 1973	682
R. 29(3) EPC 1973	229, 257, 261	R. 55 EPC 1973	765, 767-769, 775
R. 29(4) EPC 1973	257, 260, 272	R. 55(a) EPC 1973	562, 767, 770, 772
R. 29(6) EPC 1973	256, 257, 287	R. 55(b) EPC 1973	773, 776
R. 29(7) EPC 1973	257	R. 55(c) EPC 1973	627, 703, 712, 725, 773, 775-783, 785-788, 791, 792, 794, 807, 822, 832, 836
R. 30 EPC 1973	292-294, 310	R. 56 EPC 1973	775
R. 30(1) EPC 1973	292, 307	R. 56(1) EPC 1973	765, 767, 770, 773, 774, 776, 784, 786
R. 30(b) EPC 1973	310	R. 56(2) EPC 1973	770, 773
R. 30(c) EPC 1973	294	R. 57(1) EPC 1973	442, 543, 607, 765, 784, 799, 812, 840
R. 31 EPC 1973	505, 696	R. 57(2) EPC 1973	765, 815
R. 31(1) EPC 1973	291	R. 57(3) EPC 1973	810, 811, 814
R. 31(2) EPC 1973	697	R. 57a EPC 1973	356-358, 797-800, 803, 830, 833, 834, 888
R. 34(1)(c) EPC 1973	299	R. 58(1) EPC 1973	846
R. 35 EPC 1973	700	R. 58(2) EPC 1973	543, 607, 805
R. 35(12) EPC 1973	700	R. 58(3) EPC 1973	811, 846
R. 36 EPC 1973	432	R. 58(4) EPC 1973	540, 718, 812, 813, 820, 847
R. 36(3) EPC 1973	539, 574, 578, 770, 774	R. 58(5) EPC 1973	494, 510, 540, 542, 543, 680, 820, 821
R. 37(1) EPC 1973	482, 483	R. 60 EPC 1973	740
R. 38(2) EPC 1973	655	R. 60(1) EPC 1973	739, 740
R. 38(3) EPC 1973	492, 562, 654	R. 60(2) EPC 1973	718, 729, 809, 873
R. 39 EPC 1973	645	R. 61a EPC 1973	273, 539, 772, 774
R. 41(1) EPC 1973	492	R. 63 EPC 1973	741
R. 43 EPC 1973	316, 648, 649	R. 63(1) EPC 1973	761
R. 43(1) EPC 1973	427, 926	R. 64 EPC 1973	509, 838, 854
R. 43(2) EPC 1973	926	R. 64(a) EPC 1973	850, 851
R. 43(3) EPC 1973	926	R. 64(b) EPC 1973	850-852, 854
R. 44a EPC 1973	670	R. 65 EPC 1973	642, 747, 854
R. 45 EPC 1973	670, 671, 835		
R. 46 EPC 1973	298, 300, 312, 313		
R. 46(1) EPC 1973	299, 300, 311-313, 669, 696		
R. 46(2) EPC 1973	299-301		
R. 48(1) EPC 1973	658		
R. 51 EPC 1973	441, 523, 675, 676, 686		
R. 51(1) EPC 1973	660, 661		
R. 51(2) EPC 1973	443, 541, 615, 661, 678, 679, 921		
R. 51(3) EPC 1973	74, 439, 441, 663, 664, 672, 674, 840		

R. 65(1) EPC 1973	495, 624, 628	R. 78(2) EPC 1973	499, 528, 563, 568, 569, 580, 637, 853
R. 65(2) EPC 1973	642, 843, 850, 851	R. 78(3) EPC 1973	495, 499, 637
R. 66(1) EPC 1973	541, 578, 658, 788, 789, 792, 805, 821, 888, 904	R. 81 EPC 1973	580
R. 66(2) EPC 1973	608	R. 81(1) EPC 1973	498, 635, 636
R. 67 EPC 1973	384, 532, 541, 666, 673, 677, 826, 876, 881, 907-914, 920, 922-926, 928	R. 82 EPC 1973	568, 636, 853
R. 68 EPC 1973	605, 606, 615, 619	R. 83 EPC 1973	478
R. 68(1) EPC 1973	593, 605, 607, 813	R. 83(1) EPC 1973	483
R. 68(2) EPC 1973	74, 470, 475, 593, 605, 607-615, 669, 677, 680, 685, 912, 919-921, 937	R. 83(2) EPC 1973	478
R. 69 EPC 1973	431, 819	R. 83(3) EPC 1973	478
R. 69(1) EPC 1973	427, 434, 479, 485, 497-499, 508, 563, 564, 590, 591, 818, 819, 840, 923, 948	R. 83(4) EPC 1973	478, 482
R. 69(2) EPC 1973	394, 454, 494, 580, 590, 591, 624, 818, 819, 849	R. 83(5) EPC 1973	478
R. 70 EPC 1973	605, 606, 615	R. 84 EPC 1973	469, 478-480, 492, 663, 813, 850
R. 70(2) EPC 1973	617	R. 85 EPC 1973	480
R. 71 EPC 1973	952, 953	R. 85(1) EPC 1973	482
R. 71(1) EPC 1973	467, 722	R. 85(2) EPC 1973	480-482, 530, 647
R. 71(2) EPC 1973	447, 449	R. 85(4) EPC 1973	482
R. 71a EPC 1973	444, 445, 468-472, 712, 716, 717, 799, 800, 894, 921, 952	R. 85(5) EPC 1973	481, 482
R. 71a(1) EPC 1973	445, 469-472, 922, 952	R. 85a EPC 1973	426, 482-484, 504, 533, 535, 581, 653, 947, 948
R. 71a(2) EPC 1973	445, 469, 471, 472, 894	R. 85a(1) EPC 1973	580, 646, 926, 927
R. 72 EPC 1973	546, 590, 624	R. 85a(2) EPC 1973	483
R. 72(1) EPC 1973	546, 590	R. 85b EPC 1973	482, 484, 504, 533, 581, 636, 927
R. 76 EPC 1973	474, 476, 590	R. 86 EPC 1973	455, 924
R. 76(1) EPC 1973	475, 476	R. 86(1) EPC 1973	660
R. 76(3) EPC 1973	539	R. 86(2) EPC 1973	660, 661, 665
R. 77 EPC 1973	637	R. 86(3) EPC 1973	452, 455, 459, 541, 542, 605, 623, 661, 664-667, 673-675, 681, 684-688, 691, 692, 728, 799, 865, 888, 904, 915, 916
R. 77(1) EPC 1973	637	R. 86(4) EPC 1973	667-670, 900
R. 77(2) EPC 1973	637	R. 87 EPC 1973	65, 356, 797, 798
R. 77(2)(d) EPC 1973	568, 637	R. 88 EPC 1973	290, 342, 369-373, 394, 395, 545, 619, 621, 625, 643, 648-656, 686, 687, 693-695, 699, 772, 774, 843, 846
R. 78(1) EPC 1973	637	R. 89 EPC 1973	617-622, 698, 797, 840-843, 846, 919, 939
		R. 90 EPC 1973	485, 486, 489, 530

R. 90(1)(a) EPC 1973	486, 488, 508
R. 90(1)(b) EPC 1973	488, 489, 508, 530
R. 90(1)(c) EPC 1973	486-488
R. 90(2) EPC 1973	490
R. 90(3) EPC 1973	486
R. 90(4) EPC 1973	489, 490
R. 92(1) EPC 1973	631
R. 92(1)(n) EPC 1973	529, 631
R. 92(1)(r) EPC 1973	529, 631
R. 92(1)(u) EPC 1973	529, 631
R. 93 EPC 1973	630
R. 93(d) EPC 1973	630
R. 95a EPC 1973	552
R. 100 EPC 1973	577, 578, 770, 844
R. 100(1) EPC 1973	577, 578, 770, 844
R. 100(2) EPC 1973	577
R. 101 EPC 1973	579
R. 101(1) EPC 1973	576
R. 101(2) EPC 1973	498, 581
R. 101(4) EPC 1973	582
R. 101(6) EPC 1973	636, 844
R. 101(9) EPC 1973	583, 641, 642
R. 104b EPC 1973	436, 948
R. 104b(1) EPC 1973	947, 949
R. 104b(1)(b) EPC 1973	948
R. 104b(1)(b)(iii) EPC 1973	504
R. 104b(1)(c) EPC 1973	948
R. 104b(3) EPC 1973	629
R. 107 EPC 1973	436
R. 107(1) EPC 1973	653
R. 107(2) EPC 1973	537
R. 108(3) EPC 1973	947
R. 111(2) EPC 1973	629
R. 112 EPC 1973	313, 947

3. Rules relating to Fees

Art. 2 RFees	535
Art. 2(3) RFees	652
Art. 5 RFees	533, 534
Art. 5(2) RFees	534
Art. 6(2) RFees	535
Art. 7 RFees	483, 533, 535
Art. 7(1) RFees	536
Art. 7(2) RFees	534, 535
Art. 7(3) RFees	483, 536
Art. 7(4) RFees	479, 483

Art. 8 RFees	483, 536, 537
Art. 8(1) RFees	536
Art. 8(2) RFees	535
Art. 8(3) RFees	483, 484, 536
Art. 8(3)(a) RFees	483
Art. 8(4) RFees	479, 480, 483, 484
Art. 9 RFees	536, 537
Art. 9(2) RFees	535
Art. 10 RFees	622
Art. 10(2) RFees	312
Art. 12(1) RFees	537
Art. 12(2) RFees	537
Art. 14(1) RFees	537

4. Patent Cooperation Treaty (articles and rules)

PCT Articles

Art. 2(xiii) PCT	949
Art. 3(4)(iii) PCT	296
Art. 4 PCT	949
Art. 6 PCT	302
Art. 8(2)(b) PCT	417
Art. 11(1) PCT	431
Art. 14(1)(b) PCT	948
Art. 15(5)(a) PCT	312
Art. 17 PCT	302, 303
Art. 17(3)(a) PCT	297-299, 302, 303, 311, 313, 506
Art. 22(1) PCT	518
Art. 24(2) PCT	948
Art. 25 PCT	948
Art. 27(7) PCT	488
Art. 31(4)(a) PCT	949
Art. 34(3) PCT	308
Art. 34(3)(a) PCT	298
Art. 48(2) PCT	425, 505, 506
Art. 48(2)(a) PCT	505, 948
Art. 49 PCT	488
Art. 56 PCT	298
Art. 56(3)(ii) PCT	298
Chapter II PCT	948

PCT Rules

R. 4.9(b)(ii) PCT	505

R. 13 PCT	292-294, 307, 311	Art. 11 REE	932
R. 13.1 PCT	293, 295-297, 301, 302, 304-309, 313	Art. 11(1)(a) REE	932
R. 13.2 PCT	293, 296, 301, 306-310, 313	Art. 11(2) REE	933, 934
		Art. 11(2)(a) REE	934
R. 13.3 PCT	309	Art. 11(2)(b) REE	934
R. 13.4 PCT	295	Art. 11(3) REE	934
R. 13bis.4 PCT	245, 505	Art. 11(5) REE	933
R. 17.1(b) PCT	656	Art. 11(7) REE	932
R. 26.2 PCT	948	Art. 12 REE	935
R. 33.1(a) PCT	298	Art. 12(3) REE	934
R. 39.1(iii) PCT	668	Art. 14 REE	932
R. 40 PCT	302, 303, 945, 946	Art. 14(1) REE	937
R. 40.1 PCT	506	Art. 15 REE	932, 935
R. 40.2(c) PCT	297, 300, 309, 505, 946	Art. 16 REE	935-937, 940
		Art. 16(1) REE	937
R. 40.2(e) PCT	297, 300	Art. 24 REE	932
R. 40.3 PCT	506	Art. 24(1) REE	938, 939
R. 48 PCT	924	Art. 24(2) REE	938, 939
R. 60 PCT	949	Art. 24(3) REE	938, 939
R. 68 PCT	945	Art. 27 REE	932, 938
R. 68.3(c) PCT	300	Art. 27(1) REE	938, 939
R. 68.3(e) PCT	300	Art. 27(3) REE	939
R. 80 PCT	478	R. 4 IPREE	941
R. 92bis.1 PCT	631	R. 4(1) IPREE	937, 941
		R. 4(2) IPREE	941
		R. 4(3) IPREE	941
		R. 5 IPREE	934
		R. 6 IPREE	932
		R. 6(1) IPREE	937, 938
		R. 6(3) IPREE	937
		R. 6(3)(c) IPREE	937
		R. 6(4) IPREE	937
		R. 10 IPREE	932
		R. 11 IPREE	932
		R. 13 IPREE	933
		R. 14 IPREE	932
		R. 15 IPREE	932, 933
		R. 15(2) IPREE	934
		R. 16(1) IPREE	934
		R. 16(2) IPREE	934
		R. 19(3) IPREE	941
		R. 19(4) IPREE	941
5. Regulation on the European qualifying examination for professional representatives		6. Regulation on discipline for professional representatives	
Art. 1(6) REE	932	Art. 1 RDR	943, 944
Art. 1(7) REE	932		
Art. 2 REE	932		
Art. 3 REE	932		
Art. 3(7) REE	932		
Art. 6(2)(c) REE	935, 940		
Art. 7 REE	933		
Art. 7(1)(b) REE	933		
Art. 7(1)(b)(i) REE	933		
Art. 7(3) REE	941		
Art. 8(1)(d) REE	936		
Art. 8(1)(e) REE	936, 940		
Art. 8(b) REE	936, 940, 941		
Art. 10 REE	933		
Art. 10(1) REE	933		
Art. 10(2)(a) REE	934		
Art. 10(2)(b) REE	934		

Art. 1(1) RDR	943	Art. 11(1) RPBA	450, 468
Art. 1(2) RDR	943	Art. 11(2) RPBA	468, 469, 952
Art. 2 RDR	944	Art. 11(3) RPBA	449-451, 461
Art. 4(1)(e) RDR	942	Art. 11a RPBA	476
Art. 5 RDR	931	Art. 12 RPBA	889
Art. 8 RDR	931	Art. 12(1) RPBA	708, 712, 740
Art. 8(2) RDR	943	Art. 12(2) RPBA	701, 889, 892, 904
Art. 18 RDR	944	Art. 12(4) RPBA	702, 708, 712, 713, 889, 890
7. RPEBA		Art. 13 RPBA	472, 712, 740, 744, 837, 889
Art. 4(1) RPEBA	602, 879	Art. 13(1) RPBA	701, 704, 714, 889, 897, 902
8. RPBA		Art. 13(3) RPBA	463, 702, 708, 868, 889, 893, 894, 897
Art. 3(1) RPBA	601	Art. 15 RPBA	879
Art. 3(2) RPBA	447, 600	Art. 15(1) RPBA	450, 468
Art. 7(1) RPBA	446	Art. 15(2) RPBA	462, 465, 466, 506
Art. 8(1) RPBA	446	Art. 15(3) RPBA	449, 450, 461, 896
Art. 10 RPBA	593, 867, 911	Art. 15(5) RPBA	886
Art. 10a RPBA	889	Art. 15(6) RPBA	892, 896
Art. 10a(1) RPBA	712	Art. 16 RPBA	476
Art. 10a(1)(a) RPBA	708	Art. 16(1) RPBA	740
Art. 10a(2) RPBA	856, 860	Art. 16(1)(c) RPBA	751
Art. 10a(4) RPBA	708, 712, 713	Art. 16(1)(e) RPBA	751
Art. 10b RPBA	744, 889	Art. 19(1) RPBA	477
Art. 10b(1) RPBA	901		
Art. 10b(3) RPBA	463, 464, 704, 708, 901		
Art. 11 RPBA	447		

ANNEXES

1. Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office

Decision of the Administrative Council of 7 December 2006 approving amendments to the Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office, OJ EPO 2007, 303

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention, and in particular Article 23, paragraph 4, thereof,

Having regard to the amendments to the Rules of Procedure of the Enlarged Board of Appeal, adopted on 6 November 2006 under Rule 11, paragraph 2, of the Implementing Regulations to the European Patent Convention,

HAS DECIDED AS FOLLOWS:

The amendments to the Rules of Procedure of the Enlarged Board of Appeal, as shown in the Annex to this decision, are hereby approved.

Done at Munich, 7 December 2006

For the Administrative Council

The Chairman

Roland GROSSENBACHER

ANNEX

DECISION

Amendments to the Rules of Procedure of the Enlarged Board of Appeal OJ EPO 1983, 3 as amended in OJ EPO 1989, 362, OJ EPO 1994, 443 and OJ EPO 2003, 58

In accordance with Rule 11 of the Implementing Regulations to the Convention on the Grant of European Patents, the Enlarged Board of Appeal amends its Rules of Procedure. These amended Rules of Procedure read as follows:

Article 1

Field of application

These Rules of Procedure shall apply in proceedings before the Enlarged Board of Appeal under Article 112 EPC and Article 112a EPC.

Article 2

Business distribution and composition

(1) Before the beginning of each working year the members of the Enlarged Board of Appeal appointed under Article 11, paragraph 3, EPC shall draw up a business distribution scheme. This scheme shall designate the regular members and their alternates in proceedings under Article 112 EPC concerning points of law referred during the year, and the regular members and, as the case may be, their alternates in proceedings under Article 112a EPC concerning petitions filed during the year. The scheme may be amended during the working year.

(2) The Chairman of the Enlarged Board of Appeal shall determine the composition of the Board for each particular case in accordance with the business distribution scheme.

(3) For the examination of a petition under Article 112a EPC conducted in the composition under Rule 109, paragraph 2(b), EPC, two legally qualified members shall supplement the composition specified in Rule 109, paragraph 2(a), EPC.

(4) In proceedings before the Enlarged Board of Appeal under Article 112, paragraph 1(a), EPC at least four of the members shall not have taken part in the proceedings before the Board of Appeal referring the point of law.

(5) Article 24 EPC shall apply to proceedings under Article 112a EPC. The Chairman, appointed under Article 11, paragraph 3, EPC, of the Board against whose decision the petition for review has been filed may not take part in the review proceedings.

(6) The parties shall be informed of the Board's composition as soon as it has been determined or changed.

Article 3

Replacement of members

(1) Members shall be replaced by alternates if they are prevented from participating, particularly as a result of sickness, excessive workload, and commitments which cannot be avoided.

(2) Any member who wishes to be replaced by an alternate shall inform the Chairman of the Board of his unavailability without delay.

(3) The Chairman of the Enlarged Board of Appeal may, in accordance with the business distribution scheme, designate another regular legally qualified member of the Board to act as Chairman in his stead.

Article 4

Exclusion and objection

(1) If the Board has knowledge of a possible reason for exclusion or objection which does not originate from a member himself or from any party to the proceedings, then the procedure of Article 24, paragraph 4, EPC shall be applied.

(2) The member concerned shall be invited to present his comments as to whether there is a reason for exclusion.

(3) Before a decision is taken on the exclusion of the member, there shall be no further proceedings in the case.

Article 5

Rapporteurs

(1) The Chairman of the Board shall for each case designate a member of the Board, or himself, as rapporteur. The Chairman may appoint an additional rapporteur. The rapporteur of the Board as composed under Rule 109, paragraph 2(a), EPC shall generally go on to be the rapporteur for proceedings conducted in the composition under Rule 109, paragraph 2(b), EPC.

(2) If an additional rapporteur is appointed, the steps referred to in paragraphs 3 to 5 shall be taken by the rapporteur and additional rapporteur jointly unless the Chairman directs otherwise.

(3) The rapporteur shall carry out a preliminary study of the case and may prepare communications to the eligible parties subject to the direction of the Chairman of the Board. Communications shall be signed by the rapporteur on behalf of the Board.

(4) The rapporteur shall make the preparations for meetings of the Board and for oral proceedings.

(5) The rapporteur shall draft decisions or opinions.

(6) If a rapporteur or additional rapporteur considers that his knowledge of the language of the proceedings is insufficient for drafting communications or decisions or opinions, he may draft these in one of the other official languages. His drafts shall be translated by the European Patent Office into the language of the proceedings and the translations shall be checked by the rapporteur or by another member of the Board.

Article 6

Registry

(1) A Registry shall be established for the Enlarged Board of Appeal. The Senior Registrar of the Boards of Appeal or the registrars assigned to him for this purpose shall be responsible for the discharge of its functions.

(2) The members of the Enlarged Board of Appeal appointed under Article 11, paragraph 3, EPC may entrust to the Registry tasks which involve no technical or legal difficulties, in particular in relation to arranging for inspection of files, issuing summonses to oral proceedings and notifications and granting requests for further processing of applications.

(3) Minutes of oral proceedings and of the taking of evidence shall be drawn up by the Senior Registrar, a registrar assigned to him for this purpose or such other employee of the Office as the Chairman may designate.

Article 7

Change in the composition of the Board

(1) If the composition of the Board is changed after oral proceedings, the parties eligible to take part in the proceedings shall be informed that, at the request of any party, fresh oral proceedings shall be held before the Board in its new composition. Fresh oral proceedings shall also be held if so requested by the new member and if the other members of the Board have given their agreement.

(2) Paragraph 1 shall not apply to a change in composition under Article 2, paragraph 3. In this event, a request for oral proceedings shall continue to apply even where oral proceedings have already taken place.

(3) Each new member shall be bound to the same extent as the other members by an interim decision which has already been taken.

(4) If, when the Board has already reached a final decision, a member is unable to act, he shall not be replaced by an alternate. If the Chairman is unable to act, the legally qualified member of the Board having the longest service on the Board or, in the case where members have the same length of service, the eldest member shall sign the decision on behalf of the Chairman.

Article 8

Consolidation of proceedings

If two or more points of law with the same or similar subject-matter have been submitted, or two or more petitions to review the same appeal decision, the Board may consider them in consolidated proceedings.

Article 9

EPO President's right to comment

In proceedings under Article 112 EPC the Board may, on its own initiative or at the written, reasoned request of the President of the European Patent Office, invite him to comment in writing or orally on questions of general interest which arise in the course of proceedings pending before it. The parties shall be entitled to submit their observations on the President's comments.

Article 10

Statements by third parties

(1) In the course of proceedings under Article 112 EPC, any written statement concerning the points of law raised in such proceedings which is sent to the Board by a third party may be dealt with as the Board thinks fit.

(2) The Board may announce further provisions concerning such statements in the Official Journal of the European Patent Office if it seems appropriate.

Article 11

Special communications to parties in proceedings under Article 112a EPC

Notwithstanding notifications or communications required under other provisions,

(a) the other parties shall be informed of the receipt of a petition for review and shall receive a copy of the petition, reference being made to Rule 109, paragraph 3, EPC;

(b) the parties shall be informed that a clearly inadmissible or unallowable petition for review has been rejected in oral proceedings;

(c) the parties shall be informed that a petition for review has been forwarded to the Board as composed under Rule 109, paragraph 2(b), EPC.

Article 12

New submissions filed after expiry of the time limit in proceedings under Article 112a EPC

(1) Notwithstanding Rule 109, paragraph 3, EPC the Board may consider new submissions made by the petitioner after expiry of the time limit for filing petitions for review, if this is justified for special reasons.

(2) The same shall apply in proceedings conducted in the composition under Rule 109, paragraph 2(b), EPC to new submissions from the other parties filed subsequently to their reply.

Article 13

Non-binding communications from the Board

If the Board deems it expedient to communicate with the eligible parties regarding a possible appreciation of substantive or legal matters, such communication shall be made in such a way as not to imply that the Board is in any way bound by it.

Article 14

Oral proceedings

(1) If oral proceedings are to take place, the Board shall endeavour to ensure that the eligible parties have provided all relevant information and documents before the hearing.

(2) The Board's communication under Article 13 may draw attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or may contain other observations that may help concentration on essentials during the oral proceedings.

(3) A change of date for oral proceedings may exceptionally be allowed in the Board's discretion following receipt of a written and reasoned request made as far in advance of the appointed date as possible.

(4) The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case.

(5) The Chairman presides over the oral proceedings and ensures their fair, orderly and efficient conduct.

(6) When a case is ready for decision during oral proceedings, the Chairman shall state the final requests of the eligible parties and declare the debate closed. No submissions may be made by the parties after the closure of the debate unless the Board decides to re-open the debate.

(7) The Board shall ensure that each case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary. Before the oral proceedings are closed, the Board's decision or opinion may be announced orally by the Chairman.

Article 15

Attendance of interpreters

If required, the Chairman of the Board shall make arrangements for interpreting during oral proceedings, the taking of evidence or the deliberations of the Board.

Article 16

Deliberation and voting

(1) Only members of the Board shall participate in deliberations; the Chairman may, however, authorise other officers to attend. Deliberations shall be secret.

(2) During the deliberations between members of the Board, the opinion of the rapporteur shall be heard first, followed by that of the additional rapporteur if one has been appointed and, if the rapporteur is not the Chairman, the Chairman's last.

(3) If voting is necessary, votes shall be taken in the same sequence; even if the Chairman is the rapporteur, he shall vote last. Abstentions shall not be permitted.

Article 17

Submission of case by the Board as composed under Rule 109, paragraph 2(a), EPC to the Board as composed under Rule 109, paragraph 2(b), EPC

If, in proceedings under Article 112a EPC, the Board as composed under Rule 109, paragraph 2(a), EPC fails after deliberation to reach the unanimous conclusion that the petition for review should be rejected as clearly inadmissible or unallowable, it shall submit the petition without delay and without comment as to its merit to the Board as composed under Rule 109, paragraph 2(b) EPC for decision.

Article 18

Reasons for the decision or opinion

(1) Subject to Rule 109, paragraph 2(a), EPC the decision or opinion of the Board shall be in accordance with the votes of the majority of its members.

(2) In proceedings under Article 112 EPC, the reasons for such decision or opinion may also indicate the opinions held by a minority of the members if a majority of the members of the Board agrees. Neither the names of the members forming any such minority nor the size of such minority may be indicated.

Article 19

Binding nature of the Rules of Procedure

These Rules of Procedure shall be binding upon the Enlarged Board of Appeal, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the Convention.

Article 20
Entry into force

These Rules of Procedure shall enter into force upon entry into force of the revised text of the European Patent Convention in accordance with Article 8 of the Revision Act.

Done at Munich, 6.11.2006

For the Enlarged Board of Appeal
The Chairman

Peter Messerli

2. Rules of Procedure of the Boards of Appeal of the European Patent Office

Decision of the Administrative Council of 25 October 2007 approving amendments to the Rules of Procedure of the Boards of Appeal of the European Patent Office, OJ EPO 2007, 536

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention, and in particular Article 23, paragraph 4, thereof,

Having regard to the amendments to the Rules of Procedure of the Boards of Appeal, adopted on 12 September 2007 under Rule 10, paragraph 3, of the Implementing Regulations to the European Patent Convention,

Having regard to the opinion of the Committee on Patent Law,

HAS DECIDED AS FOLLOWS:

The amendments to the Rules of Procedure of the Boards of Appeal, as shown in the Annex to this decision, are hereby approved.

Done at Munich, 25 October 2007

For the Administrative Council

The Chairman

Roland GROSSENBACHER

ANNEX

DECISION

Amendments to the Rules of Procedure of the Boards of Appeal, OJ EPO 1983, 7 as amended in OJ EPO 1989, 361, OJ EPO 2000, 316, OJ EPO 2003, 61, OJ EPO 2003, 89 and OJ EPO 2004, 541

In accordance with Rule 10, paragraph 3, of the Implementing Regulations to the European Patent Convention, the Presidium amends the Rules of Procedure of the Boards of Appeal. These amended Rules of Procedure read as follows:

Article 1

Business distribution and composition

(1) The Presidium referred to in Rule 12, paragraph 4, EPC, shall before the beginning of each working year draw up a business distribution scheme for the distribution among the Boards of Appeal of all appeals that may be filed during the year, designating the members who may serve on each Board and their respective alternates. The scheme may be amended during the working year.

(2) The Chairman of each Board of Appeal shall determine the composition of the Board for each particular case in accordance with the business distribution scheme.

Article 2

Replacement of members

(1) Members shall be replaced by alternates if they are prevented from participating, particularly as a result of sickness, excessive workload, and commitments which cannot be avoided.

(2) Any member requesting to be replaced by an alternate shall inform the Chairman of the Board concerned of his unavailability without delay.

(3) The Chairman of the Board may designate another member of the Board to replace him or her as Chairman in a particular appeal in accordance with the business distribution scheme.

Article 3

Exclusion and objection

(1) If a Board has knowledge of a possible reason for exclusion or objection which does not originate from a member himself or from any party to the proceedings, then the procedure of Article 24, paragraph 4, EPC shall be applied.

(2) The member concerned shall be invited to present his comments as to whether there is a reason for exclusion.

(3) Before a decision is taken on the exclusion of the member, there shall be no further proceedings in the case.

Article 4

Procedural compliance

(1) The Chairman shall for each appeal designate a member of the Board or himself to consider the admissibility of the appeal.

(2) The Chairman or a member designated by him shall ensure that the parties comply with these Rules and with directions of the Board and shall propose action to be taken as appropriate.

Article 5

Rapporteurs

(1) The Chairman of each Board shall for each appeal designate a member of his Board, or himself, as rapporteur. If appropriate in the light of the subject-matter of the case, the Chairman may designate an additional rapporteur.

(2) If an additional rapporteur is appointed, the steps referred to in paragraphs 3 to 5 shall be taken by the rapporteur and additional rapporteur jointly unless the Chairman directs otherwise.

(3) The rapporteur shall carry out a preliminary study of the appeal and may prepare communications to the parties subject to the direction of the Chairman of the Board. Communications shall be signed by the rapporteur on behalf of the Board.

(4) The rapporteur shall make the preparations for meetings of the Board and for oral proceedings.

(5) The rapporteur shall draft decisions.

(6) If a rapporteur or additional rapporteur considers that his knowledge of the language of the proceedings is insufficient for drafting communications or decisions, he may draft these in one of the other official languages. His drafts shall be translated by the European Patent Office into the language of the proceedings and the translations shall be checked by the rapporteur or by another member of the Board concerned.

Article 6

Registries

(1) Registries shall be established for the Boards of Appeal. Registrars shall be responsible for the discharge of the functions of the Registries. One of the Registrars shall be designated Senior Registrar.

(2) The Presidium referred to in Rule 12, paragraph 1, EPC may entrust to the Registrars the execution of functions which involve no technical or legal difficulties, in particular in relation to arranging for inspection of files, issuing summonses to oral proceedings and notifications and granting requests for further processing of applications.

(3) The Registrar shall report to the Chairman of the Board concerned on the admissibility of each newly filed appeal.

(4) Minutes of oral proceedings and of the taking of evidence shall be drawn up by the Registrar or such other employee of the Office as the Chairman may designate.

Article 7

Attendance of interpreters

If required, the Chairman of any Board shall make arrangements for interpretation during oral proceedings, the taking of evidence or the deliberations of his Board.

Article 8

Change in the composition of the Board

(1) If the composition of a Board is changed after oral proceedings, the parties to the proceedings shall be informed that, at the request of any party, fresh oral proceedings shall be held before the Board in its new composition. Fresh oral proceedings shall also be held if so requested by the new member and if the other members of the Board concerned have given their agreement.

(2) Each new member shall be bound to the same extent as the other members by an interim decision which has already been taken.

(3) If, when a Board has already reached a final decision, a member is unable to act, he shall not be replaced by an alternate. If the Chairman is unable to act, the member of the Board concerned having the longer or longest service on the Boards of Appeal, or in the case where members have the same length of service, the elder or eldest member, shall sign the decision on behalf of the Chairman.

Article 9

Enlargement of a Board of Appeal

If a Board of Appeal consisting of two technically qualified members and one legally qualified member considers that the nature of the appeal requires that the Board should consist of three technically qualified members and two legally qualified members, the decision to enlarge the Board shall be taken at the earliest possible stage in the examination of that appeal.

Article 10

Consolidation of appeal proceedings

(1) If several appeals are filed from a decision, these appeals shall be considered in the same proceedings.

(2) If appeals are filed from separate decisions and all the appeals are designated to be examined by one Board in a common composition, that Board may deal with those appeals in consolidated proceedings with the consent of the parties.

Article 11

Remission to the department of first instance

A Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

Article 12

Basis of Proceedings

(1) Appeal proceedings shall be based on

(a) the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC;

(b) in cases where there is more than one party, any written reply of the other party or parties to be filed within four months of notification of the grounds of appeal;

(c) any communication sent by the Board and any answer thereto filed pursuant to directions of the Board.

(2) The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on. All documents referred to shall be

(a) attached as annexes insofar as they have not already been filed in the course of the grant, opposition or appeal proceedings or produced by the Office in said proceedings;

(b) filed in any event to the extent that the Board so directs in a particular case.

(3) Subject to Articles 113 and 116 EPC the Board may decide the case at any time after filing of the statement of grounds of appeal or, in cases where there is more than one party, after the expiry of the time limit in (1)(b).

(4) Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance

proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2).

(5) Extension of time limits may exceptionally be allowed in the Board's discretion following receipt of a written and reasoned request.

Article 13

Amendment to a party's case

(1) Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.

(2) Other parties shall be entitled to submit their observations on any amendment not held inadmissible by the Board ex officio.

(3) Amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

Article 14

Interventions

Articles 12 and 13 shall apply mutatis mutandis to interventions commenced while an appeal is pending.

Article 15

Oral Proceedings

(1) If oral proceedings are to take place, the Board may send a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other observations that may help concentration on essentials during the oral proceedings.

(2) A change of date for oral proceedings may exceptionally be allowed in the Board's discretion following receipt of a written and reasoned request made as far in advance of the appointed date as possible.

(3) The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case.

(4) The Chairman presides over the oral proceedings and ensures their fair, orderly and efficient conduct.

(5) When a case is ready for decision during oral proceedings, the Chairman shall state the final requests of the parties and declare the debate closed. No submissions may be made by the parties after the closure of the debate unless the Board decides to re-open the debate.

(6) The Board shall ensure that each case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary. Before the oral proceedings are closed, the decision may be announced orally by the Chairman.

Article 16

Costs

(1) Subject to Article 104, paragraph 1, EPC, the Board may on request order a party to pay some or all of another party's costs which shall, without limiting the Board's discretion, include those incurred by any .

(a) amendment pursuant to Article 13 to a party's case as filed pursuant to Article 12, paragraph 1;

(b) extension of a time limit;

(c) acts or omissions prejudicing the timely and efficient conduct of oral proceedings;

(d) failure to comply with a direction of the Board;

(e) abuse of procedure.

(2) The costs ordered to be paid may be all or part of those incurred by the receiving party and may inter alia be expressed as a percentage or as a specific sum. In the latter event, the Board's decision shall be a final decision for the purposes of Article 104, paragraph 3, EPC. The costs ordered may include costs charged to a party by its professional representative, costs incurred by a party itself whether or not acting through a professional representative, and the costs of witnesses or experts paid by a party but shall be limited to costs necessarily and reasonably incurred.

Article 17

Communications to the parties

(1) In the written phase of proceedings, replies to requests and directions on matters of procedure shall be given by means of communications.

(2) If a Board deems it expedient to communicate with the parties regarding a possible appreciation of substantive or legal matters, such communication shall be made in such a way as not to imply that the Board is in any way bound by it.

Article 18

EPO President's right to comment

The Board may, on its own initiative or at the written, reasoned request of the President of the European Patent Office, invite him to comment in writing or orally on questions of general interest which arise in the course of proceedings pending before it. The parties shall be entitled to submit their observations on the President's comments.

Article 19

Deliberation and voting

(1) If the members of a Board are not all of the same opinion, the Board shall meet to deliberate regarding the decision to be taken. Only members of the Board shall participate in the deliberations; the Chairman may, however, authorise other officers to attend. Deliberations shall be secret.

(2) During the deliberations between members of the Board, the opinion of the rapporteur shall be heard first, followed by that of the additional rapporteur if one has been appointed and, if the rapporteur is not the Chairman, the Chairman's last.

(3) If voting is necessary, votes shall be taken in the same sequence; even if the Chairman is the rapporteur, he shall vote last. Abstentions shall not be permitted.

Article 20

Deviations from an earlier decision of any Board or from the Guidelines

(1) Should a Board consider it necessary to deviate from an interpretation or explanation of the Convention given in an earlier decision of any Board, the grounds for this deviation shall be given, unless such grounds are in accordance with an earlier opinion or decision of the Enlarged Board of Appeal. The President of the European Patent Office shall be informed of the Board's decision.

(2) If, in its decision, a Board gives a different interpretation of the Convention to that provided for in the Guidelines, it shall state the grounds for its action if it considers that this decision will be more readily understood in the light of such grounds.

Article 21

Deviation from an earlier decision or opinion of the Enlarged Board of Appeal I

Should a Board consider it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier opinion or decision of the Enlarged Board of Appeal, the question shall be referred to the Enlarged Board of Appeal.

Article 22

Referral of a question to the Enlarged Board of Appeal

- (1) If a point is to be referred to the Enlarged Board of Appeal, a decision to this effect shall be taken by the Board concerned.
- (2) The decision shall contain the items specified in Rule 102, sub-paragraphs (a), (b), (c), (d) and (f), EPC and the point which the Board refers to the Enlarged Board of Appeal. The context in which the point originated shall also be stated.
- (3) The decision shall be communicated to the parties.

Article 23

Binding nature of the Rules of Procedure

These Rules of Procedure shall be binding upon the Boards of Appeal, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the Convention.

Article 24

Entry into force

These Rules of Procedure shall enter into force upon entry into force of the revised text of the European Patent Convention in accordance with Article 8 of the Revision Act.

Done at Munich on 12 September 2007

For the Presidium

The Chairman

Peter MESSERLI

3. Transitional provisions

Article 7 of the Act revising the EPC of 29 November 2000

Article 7

Transitional provisions

(1) The revised version of the Convention shall apply to all European patent applications filed after its entry into force, as well as to all patents granted in respect of such applications. It shall not apply to European patents already granted at the time of its entry into force, or to European patent applications pending at that time, unless otherwise decided by the Administrative Council of the European Patent Organisation.

(2) The Administrative Council of the European Patent Organisation shall take a decision under paragraph 1 no later than 30 June 2001, by a majority of three quarters of the Contracting States represented and voting. Such decision shall become an integral part of this Revision Act.

Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000

The Administrative Council of the European Patent Organisation, having regard to Article 7, paragraph 2, of the Act revising the European Patent Convention of 29 November 2000 ("Revision Act"), on a proposal from the President of the European Patent Office, having regard to the opinion of the Committee on Patent Law, has decided as follows:

Article 1

In accordance with Article 7, paragraph 1, second sentence, of the Revision Act, the following transitional provisions shall apply to the amended and new provisions of the European Patent Convention specified below:

1. Articles 14(3) to (6), 51, 52, 53, 54(3) and (4), 61, 67, 68 and 69, the Protocol on the Interpretation of Article 69, and Articles 70, 86, 88, 90, 92, 93, 94, 97, 98, 106, 108, 110, 115, 117, 119, 120, 123, 124, 127, 128, 129, 133, 135, 137 and 141 shall apply to European patent applications pending at the time of their entry into force and to European patents already granted at that time. However, Article 54(4) of the version of the Convention in force before that time shall continue to apply to these applications and patents.

2. Articles 65, 99, 101, 103, 104, 105, 105a-c and 138 shall apply to European patents already granted at the time of their entry into force and to European patents granted in respect of European patent applications pending at that time.

3. Article 54(5) shall apply to European patent applications pending at the time of its entry into force, in so far as a decision on the grant of the patent has not yet been taken.

4. Article 112a shall apply to decisions of the Boards of Appeal taken as from the date of its entry into force.

5. Articles 121 and 122 shall apply to European patent applications pending at the time of their entry into force and to European patents already granted at that time, in so far as the time limits for requesting further processing or reestablishment of rights have not yet expired at that time.

6. Articles 150 to 153 shall apply to international applications pending at the time of their entry into force. However, Articles 154(3) and 155(3) of the version of the Convention in force before that time shall continue to apply to these applications.

Article 2

This decision shall enter into force upon the entry into force of the revised text of the Convention in accordance with Article 8 of the Revision Act.

4. Cross-reference list EPC 1973 - EPC 2000

The concordance list compares the thematically corresponding provisions of the current Convention and Implementing Regulations with the Articles and Rules of the EPC 2000.

Article EPC 1973:

Convention on the Grant of European Patents of 5.10.1973, text as amended by the Act revising Article 63 EPC and by decisions of the Administrative Council of 21.12.1978, 13.12.1994, 20.12.1995, 5.12.1995, 10.12.1998 and 27.10.2005

Article EPC 2000:

European Patent Convention 2000 as adopted by decision of the Administrative Council of 28.6.2001

Rule EPC 1973:

Implementing Regulations to the EPC 1973, as last amended by decision of the Administrative Council of 9.12.2004

Rule EPC 2000:

Implementing Regulations to the EPC 2000 as adopted by decision of the Administrative Council of 7.12.2006

elmts:

Only certain elements of the provisions correspond

Article EPC 1973 → Article / Rule EPC 2000

-	Art. 4a
Art. 16 (elmts)	R. 10
Art. 18(1) (elmts)	R. 10
Art. 52(4)	Art. 53(c)
Art. 54(4)	-
Art. 54(5)	Art. 54(4)
-	Art. 54(5)
Art. 61(1) (elmts)	R. 16
Art. 77(elmts)	R. 37
Art. 78(2)	R. 38
Art. 79(2), (3)	R. 39
Art. 80	R. 40
Art. 88(1) (elmts)	R. 53
Art. 91(1) - (3)	Art. 90(3) - (5); R. 57
Art. 91(5)	Art. 90(5); R. 60
Art. 92(2)	R. 65
Art. 93(2)	R. 68
Art. 94(2), (3)	R. 70
Art. 95	-
Art. 96(1)	R. 70
Art. 96(2), (3)	Art. 94(3), (4)
Art. 99(3)	R. 75
Art. 99(4), (5)	Art. 99(3), (4)
Art. 102(1), (2)	Art. 101(2)
Art. 102(3)	Art. 101(3)(a)
Art. 105 (elmts)	R. 89
-	Art. 105a - c
Art. 106(2)	R. 98
Art. 106(4), (5)	R. 97
Art. 110(2), (3)	R. 100(2), (3)
-	Art. 112a
Art. 115 (elmts)	R. 114
Art. 117(2)	R. 119
Art. 117(4) - (6)	R. 120
Art. 121(2), (3)	R. 135
Art. 122(2) - (5)	R. 136
Art. 126	-
Art. 134(8)	Art. 134a
Art. 135(2)	R. 155
Art. 136(1), (2) (elmts)	R. 155
Art. 136(2)	Art. 135(2), (4)
-	Art. 149a
Art. 151(1)	R. 157
Art. 152	R. 157

Art. 153(2)	R. 159
Art. 154	Art. 152
Art. 155	Art. 152
Art. 156	Art. 153(1)
Art. 157(1) - (3)	Art. 153(6), (7)
Art. 158	Art. 153(3) - (5)
Art. 159	-
Art. 160	-
Art. 160(2)	Art. 11(5)
Art. 161	-
Art. 162	-
Art. 163(1) - (4), (6)	Art. 134(3), (4), (7)
Art. 163(5), (7)	-
Art. 167	-

Rule EPC 1973 →**Rule EPC 2000**

-	R. 1
-	R. 2
R. 1	R. 3
R. 2	R. 4
R. 4 (elmts)	R. 36(2)
R. 5	R. 5
R. 6	R. 6
R. 7	R. 7
R. 8	R. 8
-	R. 10
R. 9	R. 11
R. 10	R. 12
R. 11	R. 13
R. 12	R. 9
R. 13(1) - (3), (5)	R. 14
R. 13(4)	R. 78
R. 14	R. 15
-	R. 16
R. 15(1), (2)	R. 17
R. 15(3)	-
R. 16(1), (2)	R. 18
R. 16(3)	R. 78
R. 17	R. 19
R. 18	R. 20
R. 19	R. 21
R. 20	R. 22
R. 21	R. 23
R. 22	R. 24
R. 23	R. 25

R. 23a	-
R. 23b	R. 26
R. 23c	R. 27
R. 23d	R. 28
R. 23e	R. 29
R. 24	R. 35
R. 25	R. 36
R. 26	R. 41
R. 27	R. 42
R. 27a(1), (4)	R. 30
R. 27a(2), (3)	-
R. 28(1), (2)	R. 31
R. 28(4), (5)	R. 32
R. 28(3), (6) - (9)	R. 33
R. 28a	R. 34
R. 29	R. 43
R. 30	R. 44
R. 31	R. 45
R. 32	R. 46
R. 33	R. 47
R. 34	R. 48
R. 35	R. 49
R. 36	R. 50
R. 37	R. 51
R. 38(1), (2), (6)	R. 52
R. 38(3) - (5)	R. 53
R. 38a	R. 54
R. 39	R. 55
R. 40	R. 57
R. 41	R. 57; R. 58
-	R. 59
R. 42	R. 60
R. 43	R. 56
R. 44	R. 61
R. 44a	R. 62
R. 45	R. 63
R. 46	R. 64
-	R. 65
R. 47	R. 66
R. 48	R. 67
R. 49	R. 68
R. 50	R. 69
R. 51(1)	R. 70(2)
R. 51(2) - (11)	R. 71
R. 52	R. 72
R. 53	R. 73
R. 54	R. 74

-	R. 75
R. 55	R. 76
R. 56	R. 77
-	R. 78
R. 57	R. 79
R. 57a	R. 80
R. 58(1) - (3)	R. 81
R. 58(4) - (8)	R. 82
R. 59	R. 83
R. 60	R. 84
R. 61	R. 85
R. 61a	R. 86
R. 62	R. 87
R. 62a	R. 87
R. 63	R. 88
-	R. 89 - 98
R. 64	R. 99
R. 65	R. 101
R. 66(1)	R. 100(1)
R. 66(2)	R. 102
R. 67	R. 103
-	R. 104 - 110
R. 68	R. 111
R. 69	R. 112
R. 70	R. 113
-	R. 114
R. 71	R. 115
R. 71a	R. 116
R. 72(1)	R. 117
R. 72(2)	R. 118
R. 72(3), (4)	R. 119
-	R. 120
R. 73	R. 121
R. 74	R. 122
R. 75	R. 123
R. 76	R. 124
R. 77	R. 125
R. 78	R. 126
-	R. 127
R. 79	R. 128
R. 80	R. 129
R. 81	R. 130
R. 82	R. 125(4)
R. 83	R. 131
R. 84	R. 132
R. 84a	R. 133
R. 85	R. 134

R. 85a	-
R. 85b	-
-	R. 135
-	R. 136
R. 86	R. 137
R. 87	R. 138
R. 88	R. 139
R. 89	R. 140
R. 90	R. 142
R. 91	-
R. 92	R. 143
R. 93	R. 144
R. 94	R. 145
R. 95	R. 146
R. 95a	R. 147
R. 96	-
R. 97	R. 148
R. 98	R. 149
R. 99	R. 150
R. 100	R. 151
R. 101	R. 152
-	R. 153
R. 102	R. 154
-	R. 155
R. 103	R. 156
R. 104	R. 157
R. 105	R. 158
R. 106	-
R. 107	R. 159
R. 108	R. 160
R. 109	R. 161
R. 110	R. 162
R. 111	R. 163
R. 112	R. 164
-	R. 165

**Rule EPC 2000 →
Article or Rule EPC 1973**

R. 1	-
R. 2	-
R. 3	R. 1
R. 4	R. 2
R. 5	R. 5
R. 6	R. 6
R. 7	R. 7
R. 8	R. 8

R. 9	R. 12	R. 56	R. 43
R. 10	Art. 16; Art. 18(1)	R. 57	Art. 91(1); R. 40, 41
R. 11	R. 9	R. 58	Art. 91(1); R. 40, 41
R. 12	R. 10	R. 59	-
R. 13	R. 11	R. 60	R. 42
R. 14	R. 13(1) - (3) , (5)	R. 61	R. 44
R. 15	R. 14	R. 62	R. 44a
R. 16	Art. 61(1)	R. 63	R. 45
R. 17	R. 15(1), (2)	R. 64	R. 46
R. 18	R. 16(1), (2)	R. 65	Art. 92(2)
R. 19	R. 17	R. 66	R. 47
R. 20	R. 18	R. 67	R. 48
R. 21	R. 19	R. 68	Art. 93(2); R. 49
R. 22	R. 20	R. 69	R. 50
R. 23	R. 21	R. 70	Art. 94(2), (3); Art. 96(1); R. 51(1)
R. 24	R. 22	R. 71	R. 51(2) - (11)
R. 25	R. 23	R. 72	R. 52
R. 26	R. 23b	R. 73	R. 53
R. 27	R. 23c	R. 74	R. 54
R. 28	R. 23d	R. 75	Art. 99(3)
R. 29	R. 23e	R. 76	R. 55
R. 30	R. 27a(1), (4)	R. 77	R. 56
R. 31	R. 28(1), (2)	R. 78	R. 13(4); R. 16(3)
R. 32	R. 28(4), (5)	R. 79	R. 57
R. 33	R. 28(3),(6) - (9)	R. 80	R. 57a
R. 34	R. 28a	R. 81	R. 58(1) - (3)
R. 35	R. 24	R. 82	R. 58(4) - (8)
R. 36	R. 4; R. 25	R. 83	R. 59
R. 37	Art. 77	R. 84	R. 60
R. 38	Art. 78(2)	R. 85	R. 61
R. 39	Art. 79(2), (3)	R. 86	R. 61a
R. 40	Art. 80	R. 87	R. 62; R. 62a
R. 41	R. 26	R. 88	R. 63
R. 42	R. 27	R. 89	Art. 105
R. 43	R. 29	R. 90	-
R. 44	R. 30	R. 91	-
R. 45	R. 31	R. 92	-
R. 46	R. 32	R. 93	-
R. 47	R. 33	R. 94	-
R. 48	R. 34	R. 95	-
R. 49	R. 35	R. 96	-
R. 50	R. 36	R. 97	Art. 106(4), (5)
R. 51	R. 37	R. 98	Art. 106(2)
R. 52	R. 38(1), (2), (6)	R. 99	R. 64
R. 53	R. 38(3) - (5)	R. 100	Art. 110(2), (3); R. 66(1)
R. 54	R. 38a		
R. 55	R. 39		

R. 101	R. 65	R. 134	R. 85
R. 102	R. 66(2)	R. 135	Art. 121(2), (3)
R. 103	R. 67	R. 136	Art. 122(2) - (5)
R. 104	-	R. 137	R. 86
R. 105	-	R. 138	R. 87
R. 106	-	R. 139	R. 88
R. 107	-	R. 140	R. 89
R. 108	-	R. 141	Art. 124(1)
R. 109	-	R. 142	R. 90
R. 110	-	R. 143	R. 92
R. 111	R. 68	R. 144	R. 93
R. 112	R. 69	R. 145	R. 94
R. 113	R. 70	R. 146	R. 95
R. 114	Art. 115	R. 147	R. 95a
R. 115	R. 71	R. 148	R. 97
R. 116	R. 71a	R. 149	R. 98
R. 117	R. 72(1)	R. 150	R. 99
R. 118	R. 72(2)	R. 151	R. 100
R. 119	Art. 117(2); R. 72(3), (4)	R. 152	R. 101
R. 120	Art. 117(4) - (6)	R. 153	-
R. 121	R. 73	R. 154	R. 102
R. 122	R. 74	R. 155	Art. 135(2); Art. 136(1), (2)
R. 123	R. 75	R. 156	R. 103
R. 124	R. 76	R. 157	Art. 151(1); Art. 152; R. 104
R. 125	R. 77; R. 82	R. 158	R. 105
R. 126	R. 78	R. 159	Art. 153(2); R. 107
R. 127	-	R. 160	R. 108
R. 128	R. 79	R. 161	R. 109
R. 129	R. 80	R. 162	R. 110
R. 130	R. 81	R. 163	R. 111
R. 131	R. 83	R. 164	R. 112
R. 132	R. 84	R. 165	-
R. 133	R. 84a		

5. General Index

A

A posteriori

unity of invention, 295, 297, 298, 299, 300, 302, 305, 309, 310, 311, 313

A priori

unity of invention, 297, 305

Abstracts of documents

availability to the public, 73
interpretation, 95

Abuse

availability to the public, 68, 69
evident abuse, 68, 69
examination proceedings, 666
late submission, 706, 709, 715, 716
oral proceedings, 455, 461
standard of proof, 651

Abuse of procedure, 469-472, 834

amended claims in appeal proceedings, 900, 903, 905
appeal proceedings, 743
apportionment of costs, 756
examination procedure, 672
opposition proceedings, 766, 767, 768, 804
oral proceedings, 469
reimbursement of appeal fee, 911
rules of procedure of the boards of appeal, 1039

Accelerated processing

pending infringement proceeding, 818

Accidental anticipation

amendments, 332, 333
novelty, 106, 107

Accidental disclosure

state of the art, 106, 107

Accordance of a date of filing

language of the filed documents, 645
preliminary and formalities examination, 645, 647

Additional fees

re-establishment of rights, 525

Adjournment of oral proceeding

opposition proceedings, 722

Administration regimen

second medical use, 140, 145

Administrative agreement, 534, 536, 951

Admissibility of applications for re-establishment of rights, 494-503

Admissibility of evidence, 447, 918

Admissibility of the appeal, 838-860

appeal filed within the time limit, 838-860
appealable decision, 839-842
form and content of notice of appeal, 850
form and time limit of the appeal, 838-860
formal aspects, 843
party adversely affected, 844

Admissibility of the opposition, 765-771

entitlement to file an opposition, 765
filing in due time, 771
formal requirements, 771
identity of the opponent, 772
joint oppositions, 769
means of evidence, 775
multiple oppositions, 765, 768
notice of opposition, 769, 771, 774, 775, 776, 777, 779, 782, 784, 785
opposition by the patent proprietor, 766
opposition fees, 773
opposition period, 776, 778
procedural aspects, 784
straw man, 767
substantiation of the opposition, 774-784
title of the invention, 773

Advertising

representatives, 944

Aesthetic creations, 399

technical inventions, 1, 11, 15

Affidavit, 547, 550, 561

Age of document

inventive step, 214, 216, 217

Aggregation of features

inventive step, 197, 198

Agricultural methods, 223

Aids virus, 234, 415

Alleged advantages, 170

Allocation of responsibilities

interpretation of the EPC, 643

Allowability of the appeal

reimbursement of appeal fees, 907, 909

Alloy composition

availability to the public, 98

Alternative solution to a known problem, 175

Amended claims in appeal proceedings, 888

absence of opponent, 897
absence of the applicant, 896
abuse of procedure, 900, 903, 905
additional search, 902
amendments after arrangement of the oral proceedings, 893
change of party or representative, 906
change of subject-matter, 902
clearly allowable, 890, 895, 897, 901
complexity, 901
delaying the proceedings, 895
dependent claim, 891
divisional application, 903
exercise of discretion, 900
fair procedure, 893, 894
last-chance, 890
oral proceedings, 888, 889, 894
procedural economy, 888, 889, 902
reformatio in peius, 904
reinstatement of broader claims, 904, 905, 906
requests not examined by the opposition division, 890
response to objections, 899
right to be heard, 894

Amendment after completion of the examination procedure, 692**Amendments**

"is it essential" test, 352
absence of relationship among features, 322, 325
abstract, 315
addition of a feature, 327
additional method claim, 318
additional search, 808
admissibility in opposition proceedings, 445
advertising literature, 345
after oral proceedings, 446
ambiguous subject-matter, 339
amended definition, 317
amendment based on errors, 342
apparatus inventions, 362
approximate drawings, 339
arbitrary new links between parameters, 329
average particle diameter, 316
bar on improving one's position, 327
biotechnological inventions, 359

burden of proof, 323, 330
calculation errors, 342
change of claim category, 291, 361-365
clarity, 804
combination, 321
combination of compounds, 322
combination of features, 318, 319
combination of features pertaining to separate embodiments, 318
common general knowledge, 346, 348, 349, 371, 373
conflict, 366
consent in examination proceedings, 666, 673, 688, 690
content of the application as originally filed, 315
cross-references, 341
cut-off point, 356, 357, 358
definition of the claimed product, 358
definition of the content of the application, 339
definitive test, 348
deletion of a feature, 327, 329, 347, 349
deletion of meanings, 321
description, 315, 323
description of the prior art, 344
different sets of claims, 316
direct and unambiguous deducibility, 347
disclaimer, 331-338, 341
disclosure in drawings, 338
divisional applications, 381, 667
drawings, 315, 316
effects of technical feature, 346
elimination of contradictions, 343
equivalents, 317
errors, 342-344
essential features, 330, 341
examination proceedings, 660, 662
examples, 323
exemplified feature, 331
explicit or implicit disclosure, 350
extent of protection, 359, 361, 362, 365
extraction of features, 324
features from drawings, 338
footnote solutions, 368
functional feature, 338, 353
general range, 350
generalisation, 322, 325, 326
generalisation of a feature, 318

- generalisation of the subject-matter of an application, 347
 generalised feature, 359
 generic formula, 321, 330
 generic group of compounds, 322
 graph representing an equation, 338
 implicit disclosure, 315, 317, 328
 implicit feature, 349
 incorrect structural formula, 342
 independent lists, 321
 individual values disclosed in the examples, 319
 inescapable trap, 365
 interaction with other features, 331
 interests of third parties, 327
 intermediate generalisation, 324, 351
 international application, 315
 introduction of an isolated feature, 324
 inventive selection, 327, 330, 331
 isolated steps, 325
 limitation of the protection, 327
 limiting extensions, 367
 limiting feature, 327, 356
 moving features, 361
 multiple selection, 350
 negative feature, 340
 new range, 319, 322, 330, 331
 non-disclosed combinations, 324
 non-inventive selection, 328
 novelty test, 347, 348, 354
 obviousness of the error and the correction, 371
 opposition proceedings, 246, 247, 791, 797-809
 particular combination, 350
 particular technical embodiment, 350
 preamble, 361
 precise figures, 338
 preferred embodiment, 324
 preferred range, 331, 350
 priority, 402
 priority documents, 315
 process of making a product, 364
 product-by-process claim, 358, 364
 production costs, 328
 Protocol on the Interpretation of Article 69 of the Convention, 356, 361
 reference to prior art, 345
 reformulation of the technical problem, 318
 reintroduction of feature deleted, 358
 relationship between Art. 123(2) and (3) EPC, 366-369
 reservoir, 318, 350
 reservoir of features, 340, 357
 schematic drawing, 339
 solution of the conflict between Art. 123(2) and (3) EPC, 368
 standard of proof, 373
 structural feature, 353
 subsequent addition of details, 344-346
 technical contribution, 317, 327
 tests for allowability, 346-355
 time of filing in the opposition proceedings, 799
 translation, 315, 316
 transposition of features, 361
 undisclosed equivalents, 324
 undisclosed negative feature, 341
 unwarranted advantage, 327
 use claim, 362, 363
 value of drawings, 338
 values taken from examples, 322
Amendments after receipt of the European search report, 660
Amendments and disclaimers, 402
Amendments filed before the boards of appeal, 681
Amendments relating to unsearched subject-matter, 667
Amount lacking
 small, 536
Analogy process
 envisageable product, 210
 inventive step, 210
Animal species
 exceptions to patentability, 36, 44
Animal varieties
 exceptions to patentability, 37
Animals
 exceptions to patentability, 37, 44
 medical methods, 57
 non-therapeutic treatment, 154
Appeal fees, 854
 protection of legitimate expectations, 430
 re-establishment of rights, 493
Appeal procedure, 821-930
 admissibility, 838-860
 amended claims, 888-907

- appeal filed within the time limit, 853, 888-907
- appealable decision, 839-842
- arguments under examination, 837
- binding effect of requests, 828
- change of circumstances after delivery of the decision, 859
- closure of substantive debate, 860
- competence of board to hear the case, 842
- conclusion of the decision-making process, 860-862
- consent to new grounds for opposition, 828
- decision taken as the file stands, 861
- devolutive effect, 823, 829
- discretion, 865
- entitlement to appeal, 843-849
- examination of new grounds for opposition, 793
- extent of scrutiny, 822, 827-838
- facts under examination, 836
- fair procedure, 837
- fees payable by intervener, 721
- impartiality, 826, 827, 837
- independent procedure, 824
- interlocutory decisions of a board of appeal, 862
- interlocutory revision, 842, 875-878
- interpretation, 877
- language, 824
- language privilege, 627
- legal character, 821, 835, 890
- notice of appeal, 849, 850
- observations by third parties, 826
- parallel proceedings, 860
- parties to the proceedings, 825, 826, 827
- party adversely affected, 844, 845, 847, 848
- patentability requirements, 835-836
- preliminary opinion of a board of appeal, 748
- principle of equal treatment, 826, 827, 837
- principle of party disposition, 822, 827
- procedural economy, 869, 878
- procedural principles, 825
- procedural statements, 822
- procedure proper to an administrative court, 873
- proceedings after the delivery of a decision, 861
- public interest, 873
- referral to the Enlarged Board of Appeal, 878-881
- reformatio in peius, 828, 829, 830, 831, 832
- reformulation of the technical problem, 173
- remittal, 862-869
- review of first-instance discretionary decisions, 838
- right to have issues considered at two instances, 868
- separate appeal, 841
- silence, 847
- statement of grounds of appeal, 854-860
- subject-matter under examination in opposition appeal proceedings, 832
- substantial procedural violation (see Reimbursement of appeal fees), 877
- suspension of first-instance proceedings following referral, 878, 881
- suspensive effect, 634, 822, 846, 874
- termination, 873-875
- time limits, 853
- withdrawal of appeal, 873-875
- Appealability of decisions in disciplinary matters, 943**
- Appeals against decisions of the Examination Board and the Examination Secretariat, 938-941**
- Applicability of re-establishment of rights, 491-493**
- Application**
 - abandonment of subject-matter, 311
 - giving rise to a right of priority, 312, 397-400
 - publication, 629
- Application as a whole**
 - sufficiency of disclosure, 229, 248, 276, 277
- Application documents**
 - language, 645
 - preliminary and formalities examination, 646-650
- Application filed in or for a state party to the Paris Convention, 397**
- Application of Rule 142 EPC by the EPO of its own motion, 485**
- Applications giving rise to a right of priority, 312, 397-400**
- Appointment of a common professional representative, 577**
- Apportionment of costs, 476-477, 740-763**
 - abuse of procedure, 756
 - equity, 461, 740-763
 - late submission, 742, 743, 745, 746

- non-appearance in oral proceedings, 461, 749, 750, 751
- principle of equal treatment, 760
- prior use, 744
- procedural aspects, 760
- withdrawal of the appeal, 539
- Approval of the text, 451, 538, 542**
- examination proceedings, 684
- Approval of the text by the applicant, 682-684**
- Approved version of the patent**
- main request and auxiliary request, 542
- right to be heard, 450, 451-453, 915
- Area of a shipyard**
- availability to the public, 74, 87
- Arguments**
- late submission, 716
- Arguments under examination, 837**
- Article 83 EPC and support from the description, 245**
- Ascertaining differences (novelty), 109-117**
- Ascertaining novelty, 64, 109-117**
- comparing each individual item, 109
- composition, 113
- difference in wording, 111
- differences in value, 112
- distinguishing features, 111
- functional features, 114
- generic disclosure, 111, 115
- inevitably obtained products, 114
- integral teaching of the document, 101, 110, 128, 131
- product claim with process features, 116
- reference to a second prior document, 109
- Assessing lack of unity on invention, 296-301**
- Assessment of inventive step, 188-213**
- Assessment of lack of unity in examination proceedings, 299-301**
- Assessment of prior uses, 102**
- Assessment of the invention as a whole**
- technical inventions, 9
- Assistants**
- re-establishment of rights, 501, 507, 523
- Auction, 193**
- Authorisation**
- filing, 844
- protection of legitimate expectations, 428
- Authorisation of an association of representatives, 583**
- Authorisations for appointment of a representative, 579-583**
- Auxiliary request**
- oral proceedings, 456, 458, 459, 914
- Availability to the public, 69-85**
- abstract of a Japanese patent document, 74
- abstracts of documents, 73
- abuse, 68, 69
- alloy composition, 98
- area of a shipyard, 74, 87
- availability free of charge, 71
- balance of probabilities, 73, 86, 89, 290
- biological material, 75
- book, 70, 72
- brochure, 72, 86
- burden of proof, 74, 82, 86, 125
- company papers, 70
- company's own staff, 77
- conference, 83
- confidential relations, 79
- congress, 83
- date of publication, 64, 70
- degree of purity, 125
- demonstration, 79, 102
- diploma thesis, 71, 85
- document, 77
- equivalents, 99
- evidence, 73
- exhibition, 68, 102
- file inspection, 70
- fungicide, 154
- general public, 75, 298, 435, 436
- German patent, 70
- growth regulation, 102
- hidden feature, 104
- implicit disclosure, 131, 132
- implicit features, 97
- interaction with outside conditions, 99, 104
- intermediate product, 75, 108
- intrinsic features, 99, 104, 153, 154, 159
- joint venture agreement, 83
- letter, 81
- library, 71, 72
- limited circle of people, 76, 79
- making available for test purposes, 81

man in the street, 76
 market test, 82
 microchip, 102
 mistakes in the disclosure, 105
 nature of the evidence, 86
 obligation of the EPO to examine of its own motion, 92
 operation instructions, 71
 oral disclosure, 74, 77
 patent application, 72
 periodical, 72, 88
 permission to publish a text, 70, 78
 person not skilled in the art, 76, 77
 pharmacological tests, 93
 prima facie evidence, 73, 85, 86
 prior use, 74, 78, 79, 80, 82, 85, 86, 87, 92, 102, 105, 107
 procedural violation, 74
 production process, 75, 125
 prototype, 76, 79, 85
 publication, 70
 publicity notice, 88
 quotations, 80
 repetition of oral disclosures, 74
 report, 70
 sale, 76, 102
 sale for test purposes, 81
 selection inventions, 108, 123
 shipyard, 87
 small-ads newspaper, 70
 standard of proof, 88
 standards working party, 83
 talk, 73, 76
 technical journal, 72
 theoretical possibility, 69, 71
 undue burden, 67, 68, 71, 103, 104
 weapons manufacturer, 81

B

Balance of probabilities

availability to the public, 73, 89
 evidence, 69, 86, 88, 89
 novelty, 94, 290
 protection of legitimate expectations, 429
 sufficiency of disclosure, 250

Bank account

fees, 429, 536

Binding effect

appeal proceedings, 828, 869-873
 remittal for adaptation of the description, 871
 remittal for further prosecution, 872

Binding effect of requests - no reformatio in peius, 828

Binding nature of the Rules of Procedure, 1031, 1041

Biological inventions, 42-49

Biological material, 75

Biological processes

essentially biological processes, 36, 45

Biotechnology

deposit of biological material, 243-245

DNA, 39, 46, 180

exceptions to patentability, 40, 43

expectation of success, 177, 178, 179

reproducibility, 244

research, 178, 183

skilled person, 182, 183, 243

substances, 225

sufficiency of disclosure, 37, 239-245

Board competent to hear a case, 842

Boards of Appeal

former member, 925

Bonus effect

inventive step, 173, 219, 221

Book

availability to the public, 70, 72

Breeding process, 40, 45, 46, 49

library, 43

Broad claims

clarity of claims, 259

inventive step, 203

priority, 403

state of the art, 105

sufficient disclosure, 247

support by the description, 277

Brochure

availability to the public, 72, 86

evidence, 72, 86

Budapest Treaty, 245

Bundle of national patents, 698

Burden of proof, 125, 251, 289, 416, 564-571, 827

amendments, 330
 appeal proceedings, 571
 availability to the public, 74, 82, 86, 87
 disclosure, 569, 571
 ex parte proceedings, 564, 569
 experiments, 570
 inventive step, 174, 222, 566
 knowledge of the skilled person/s, 86
 novelty, 566
 opposition proceedings, 247, 250, 565, 569, 780, 781, 782
 parameters, 569
 postal interruptions, 482
 priority document, 567
 procedural questions, 468, 571
 product-by-process claims, 289
 reproducibility of the invention, 567
 shifting the burden of proof, 569

Business assets

transfer, 729, 731

Business distribution, 1026, 1034

C

Calculation of time limits, 478-484**Categories of claims, 251, 293, 294**

product-by-process claims, 291

Cause of non-compliance

re-establishment of rights, 496, 497, 498, 499

Change of claim category

amendments, 361, 365

Change of composition of examining division, 597**Change of composition of opposition division, 592, 593, 596, 915****Change of composition of the boards of appeal, 600****Change of representative, 710**

re-establishment of rights, 511

Changes after oral proceedings, 446**Characterising portion**

two-part claim, 274, 275

Chemical compounds, 118-127, 238, 306, 309, 310, 311**Chemical inventions, 117-133**

inventive step, 202
 selection inventions, 117-133
 unity of invention, 294, 295, 296

Chemical inventions and selection inventions, 117**Civil court**

disciplinary measures, 943

Claim in two-part form, 274, 275**Claiming the invention disclosed in the earlier application in the subsequent application, 412-414****Claims, 251-292**

change of claim category, 361, 365
 clarity, 250, 251, 252-270, 804
 computer program products, 18
 dependent (see Dependent claim), 801
 device, 28, 251, 276
 form of, 138, 273-275
 function, 277, 281
 independent (see Independent claims), 801
 one-part claim, 274
 technical character of the invention, 12, 20
 two-part claim, 274, 275
 unity of invention, 296, 299, 303
 wording of, 19, 140, 228, 251, 252-261

Claims fees, 291

re-establishment of rights, 504

Claims supported by the description, 275

adaptation of the description to the claims, 279
 apparatus claim, 276
 broad claims, 247, 277
 clarity of claims, 245
 essential feature, 275, 276, 277
 extent of protection, 277
 provisional description, 279
 reproducibility, 276, 278
 sub-combination, 276
 sufficiency of disclosure, 245
 technical contribution, 246, 258, 276
 undue burden, 278

Clarity and completeness of disclosure, 231, 239-243**Clarity of claims, 251, 252-270**

absence of an upper or lower limit, 268
 apparatus claim, 261
 broad claims, 259

categories of claims, 260
characterisation of a product by a parameter, 255
complexity, 254
conciseness of claims, 257, 270
diagnostic methods, 259
disclaimer, 262
essential features, 248, 257
functional features, 246, 266
generally accepted meaning in the relevant art, 253
interpretation of claims, 247
legal certainty, 252, 253, 259
method for measuring a quality, 254, 256
omnibus claims, 257
opposition proceedings, 246, 804
process claim, 258, 261
product claim, 255
reference signs, 257
reference to a patent specification, 253, 264
reference to the description or drawings, 256
relative qualities, 268, 269
support by the description, 245
Swiss-type-claim, 267
trade mark, 253, 264
undue burden, 254, 262, 263, 266, 270
unity of invention, 302
unspecified features, 268
use claim, 261
Closest prior art, 163-170
Closure of the debate
date of decision, 604
Closure of the substantive debate
appeal proceedings, 860
decisions of EPO departments, 603
Code of Professional Conduct, 943-944
advertising, 944
professional obligations, 943
professional secrecy, 944
representatives, 944
Combination inventions
inventive step, 176, 197-199, 206
Combination of documents
inventive step, 165, 201
Combination of features
amendments, 264, 318, 319, 321, 324
inventive step, 199

novelty, 96, 131
Combination of product and process features, 290
Combinations within a prior art document, 96
Commercial success
inventive step, 214, 217
Commercial use
industrial application, 223, 224, 225
Common general knowledge of the skilled person/s, 779
Communication
ambiguous, 425, 926
examination proceedings, 441
oral proceedings, 468
protection of legitimate expectations, 426, 434, 926
right to be heard, 455
Communication pursuant to Article 94(3) EPC and Rule 71(1) EPC
special warning, 662
Communication under Art. 112a EPC, 1029
Communication under Article 11(1) RPBA
oral proceedings, 468
Communication under Article 11(2) RPBA
oral proceedings, 952
Communication under Article 96 EPC
examination proceedings, 442, 494
Communication under Article 96 EPC 1973, 391
Communication under Rule 58(4) EPC
opposition proceedings, 812
Communication under Rule 69(1) EPC, 485, 591
Communication under Rule 69(1) EPC 1973
protection of legitimate expectations, 497
re-establishment of rights, 497, 498, 499, 508
Company papers
availability to the public, 70
Company's own staff
availability to the public, 77
Comparative tests
inventive step, 174, 208, 221
late submission, 705, 706
Comparing each individual item from the prior art, 109
Competence
Legal Board of Appeal, 632

- Competence of the boards of appeal in proceedings under the PCT, 945-946**
- Competence to correct a decision under Rule 89 EPC, 620**
- Completion of the internal decision-making process, 603**
- Complexity**
late submission, 700
- Composition**
industrial application, 227, 228
- Composition for manufacturing a medicament, 145**
essential feature, 294
- Composition of examining division, 591**
- Composition of opposition division, 446, 609, 915, 925**
- Composition of the Board, 1026, 1034, 1036**
- Composition of the competent departments of first instance, 591-594**
- Composition of the product**
ascertaining novelty, 102, 103, 104
- Compounds**
anticipation of certain compounds, 119, 124
functional relationship, 311
structural relationship, 311
unity of invention, 294, 297
- Comptroller**
right to a European Patent, 644
- Computer programs, 18, 19**
exclusion from patentability, 16, 20, 188
industrial application, 223
interpretation, 640
technical character, 5, 9, 20, 30, 188, 191
- Computer-generated presentations**
oral proceedings, 473
- Computer-implemented inventions, 16-25**
technical considerations, 23
technical problem, 5, 22
- Concept of "the same invention"**
priority, 419
- Concept of legal incapacity, 485**
- Conciseness of claims, 251, 270-273**
clarity, 270
independent claims of the same category, 271
method claims, 270
multiple claims, 270
superfluous claim, 271
use claims, 270
- Conclusion of the decision-making process, 860-862**
- Conditions for enrolment, 932**
- Conditions to be met by an application, 229-251**
- Conference**
availability to the public, 83
- Consequences of interruption of proceedings, 489**
- Consequences of non-payment of a further search fee, 311**
- Consolidation of proceedings, 697, 1029, 1037**
- Consultation by telephone, 427, 456, 676**
- Contentious proceedings**
opposition proceedings, 764, 765, 767
- Continuation-in-part-application, 656**
- Contraception, 56, 161, 227**
- Contracting states, 2, 65, 868, 955**
- Contribution approach**
technical character, 4
- Correction**
amendments, 673
competence, 620, 650
evidence, 655
- Correction of decisions**
protection of legitimate expectations, 428
- Correction of deficiencies in the application for re-establishment, 502**
- Correction of designation of states in Euro-PCT applications, 653**
- Correction of errors, 619, 620**
divisional application, 394
technical preparations for the publication of the patent specification, 617
- Correction of errors in decisions, 616, 617-622, 698, 840**
- Correction of errors in filed documents, 650, 687**
- Correction of priority declarations, 654**
- Cosmetic**
industrial application, 223
- Cosmetic treatment**
medical methods, 58, 59, 161
novelty of use, 161

Costs, 476-477

apportionment of costs, 740-763

Could-would approach, 176, 177, 197

Could-would approach and ex post facto analysis, 176

Courtesy services performed by the EPO, 510, 927

protection of legitimate expectations, 434

Credibility of witnesses, 554, 557

Criteria for determining lack of unity, 301-304

Cross-appeal, 832, 836, 877

Cross-references

amendments, 341

Curtailment of notice in the summons

oral proceedings, 467

D

Data processing

computer programs, 9, 20

technical character of the system, 20

Database, 67

Date of decision

EPO departments, 603-605

protection of legitimate expectations, 426

Date of filing

amendments, 604

divisional application, 375

language privilege, 626

preliminary and formalities examination, 645, 651

priority, 397, 400, 404

protection of legitimate expectations, 426

Date of payment, 536

Decision, 679

appealable, 475, 839-842

binding effect, 606, 870

competence to correct a decision, 620, 621

composition of examining division, 591

composition of opposition division, 591, 609, 915

correction of errors, 617-622

date of decision, 603

decision to grant a patent, 617

decision-making process, 603

discretion, 607, 620, 622, 666, 691

entry into force of decisions, 603

errors, 619, 620

errors in decision to grant a patent, 620

errors in patent specification, 617

form of decisions, 604, 839

formalities officer, 604, 606, 620, 621, 624, 925

inadequate reasons, 918

inadequate reasons given in the decision, 609, 615, 911, 919

inconsistency between oral and written decisions, 924

interlocutory decision, 680, 819-821, 841, 880

main and auxiliary requests, 607

minutes of the oral proceedings, 618, 840

missing signature, 617

pre-printed reasons, 919

protection of legitimate expectations, 428, 436

reasons, 295, 607, 917, 920, 921

remittal for adaptation of the description, 871
representation of members of the departments, 591, 592, 593

right to be heard, 674

signatures on a decision, 592, 615

suspected partiality, 594

Decision of the President of the EPO

documents excluded from file inspection, 630

Decision pursuant to Rule 69(2) EPC, 591

Decision taken as the file stands

examination proceedings, 612, 614, 919

Decision to grant a patent, 390

entry into force of a decision, 697

errors, 617, 697

examination proceedings, 691, 697

Decision with the force of res judicata (see Final decision), 842

Decisions of EPO departments, 590-625

right to a decision, 590

written proceedings, 603

Decisions of the Administrative Council

concerning a question of interpretation, 641

Decisions of the opposition division, 818-821

Declarations regarding procedure, 718

appeal proceedings, 822

Deducibility of amendments from the application as filed directly and unambiguously, 347

Deficiencies and mistakes in a disclosure, 105

Defining the state of the art, 64-92

- Definition of common general knowledge, 66**
- Definition of the skilled person, 180-184**
- Definition of the term "invention", 3**
- Degree of purity**
novelty, 125, 126, 289
- Delay within the EPO**
procedural violations, 924
- Delaying the proceedings**
amended claims in appeal proceedings, 895
late submission, 704, 713
- Deliberation, 1031, 1040**
- Delivery of mail, 480**
delay, 480, 529
interruption, 481, 530, 647
re-establishment of rights, 528, 530
- Demonstration**
availability to the public, 79, 102
- Department competent to decide upon the application, 494**
- Dependent claim, 295, 834**
amended claims in appeal proceedings, 891
opposition proceedings, 801
unity of invention, 295
- Deposit of biological material, 243-245**
late submission of deposit number, 245
- Deposit of living material, 243-245**
- Description, 224, 225, 315**
inventive step, 170, 172
unity of invention, 297, 299, 300, 307
- Desideratum**
inventive step, 211
- Design**
inventive step, 200
- Designated office, 298, 302**
EPO, 298, 313, 946-950
- Designation fees, 535**
divisional application, 393
preliminary and formalities examination, 652
re-establishment of rights, 504
time limits, 483
- Designation in Euro-PCT applications**
preliminary and formalities examination, 653
- Designation of a representative**
international application, 636
- Designation of contracting states**
divisional application, 393
- Designation of receiving Offices**
due care, 521
- Designation of states, 652-654**
EPC 2000, 491
preliminary and formalities examination, 652
re-establishment of rights, 491, 509, 654
- Determination of closest prior art in general, 163**
- Determination of the technical problem, 170, 301**
- Determining legal incapacity of the applicant or patent proprietor, 486**
- Determining legal incapacity of the representative, 486**
- Determining the content of the relevant prior art, 92-109**
- Development of the art in a different direction**
inventive step, 215
- Deviation from an earlier decision, 1040**
- Devolutive effect, 606, 829**
appeal proceedings, 823
preliminary and formalities examination, 658
re-establishment of rights, 495
- Diagnosis**
industrial application, 228
- Diagnostic methods, 60-63**
- Dictionaries, 66, 94**
- Diploma thesis**
availability to the public, 85
- Disciplinary Board of Appeal, 931-944**
power of review, 938, 939
- Disciplinary Committee, 943**
- Disciplinary Committee, epi, 931**
- Disciplinary matters, 564, 941-943**
appealability of decisions in disciplinary matters, 943
- Disciplinary measures, 942**
European Convention on Human Rights, 942
- Disclaimer**
accidental anticipation, 262, 332, 333
amendments, 331-338
case law prior to G 1/03, 338
clarity of claims, 262
combination of features arising from different documents, 264
definition, 334, 335

drafting of disclaimers, 263
 excluding non-working embodiments, 262
 inventive step, 208, 265
 law applicable to disclaimers, 331
 medical methods, 60
 novelty, 265
 priority, 402
 protection of legitimate expectations, 333
 restoring novelty, 332, 336
 scope of protection, 335
 undisclosed disclaimer, 335
Disclosure, 224
 availability to the public, 92-109
 clarity and completeness, 231, 239-243
 combination of features, 96, 131
 defective, 167
 disclosure in a prior art document, 92-109, 128, 131
 drawings, 100, 229, 338
 implicit, 97, 98, 120, 121, 131, 132, 410
 in a precise manner, 409
 non-prejudicial (see Non-prejudicial disclosure), 68
 patent specification, 111
 pharmacological tests, 93
 priority, 402
 reproducibility, 107
 state of the art, 64, 65, 92-109, 121, 131
 teaching of examples, 96, 101
Disclosure in drawings, 338
Disclosure in previous application
 priority, 402, 403, 406
Disclosure in the earlier application of the invention claimed in the subsequent application, 401-412
Disclosure in the previous application as a whole, 402
Discoveries
 technical inventions, 1, 11, 12-14
Discovery of a previously unknown property
 second medical use, 150
Discretion
 appeal proceedings, 838, 865, 878, 894
 decisions of EPO departments, 607, 620, 622, 623, 920
 examination proceedings, 661, 666, 675, 681, 686, 688, 921, 922

late submission, 469, 471, 472, 703, 704, 923
 opposition proceedings, 799, 923
 oral proceedings, 453, 454, 455, 457, 458, 952
 reimbursement of appeal fees, 928
 remittal, 868
Discretionary decisions
 review, 623, 838
Dispensing with further search fee, 313
Distinguishing features, 111-117
Division of a divisional application, 376
Divisional application, 375-395
 amended claims in appeal proceedings, 903
 amendments, 381-384, 668, 669
 appeal against decision to grant a patent on the parent application, 823
 correction of errors, 394
 date of filing, 375, 387
 designation fees, 393
 designation of contracting states, 393
 examination proceedings, 538, 668, 669
 filing, 386-391, 491
 inventive step, 169
 parent application, 375, 380, 382, 383, 384, 387, 388, 390, 391, 392, 393
 PCT procedure, 947
 preliminary and formalities examination, 652, 653
 priority, 375
 procedural questions, 391-395
 protection of legitimate expectations, 435
 re-establishment of rights, 491, 492
 sequence of divisionals, 378
 unity of invention, 312, 668
 validity, 376-379
Divisional application in the name of not all the applicants for parent application, 638
Divisional applications, 375
DNA, 39, 40, 46, 180, 405, 407, 408, 415, 422
Documents cited in the patent specification or search report, 717
Dosage regime
 second medical use, 141
Double function
 opposition proceedings, 785
Double patenting, 384
 novelty, 65
Draft decision, 1028, 1035

Drawing, 315, 316

reservoir of features, 340
 unity of invention, 299, 307

Due care, 509-517

applicant, 517
 assistants, 501, 524
 client's true wishes, 520
 designation of receiving Offices, 521
 individual applicant who had no representative, 518
 non-authorised representative, 518, 523
 private mail delivery services, 528
 professional representatives, 517, 518, 519, 521
 re-establishment of rights, 496, 498, 507, 508, 509-517, 530
 substitutes replacing assistants, 527
 technically qualified assistant, 526
 transfer of cases, 520

Duties not entrusted to formalities officers, 624

E

Easily remediable deficiencies

protection of legitimate expectations, 430-434, 502, 503, 591

Effect of non-payment of designation fees, 652**Effective system of staff substitution**

re-establishment of rights, 515, 517

Elected Office

EPO, 946-950

Electronic filing of documents, 539

appeal, 849
 preliminary and formalities examination, 647
 protection of legitimate expectations, 432
 re-establishment of rights, 515

Embodiments of the invention, 7, 232, 240**Enabling disclosure in the priority document, 414****Enantiomers**

novelty, 124

Encyclopaedias, 66, 94**Enlargement of a board of appeal, 1036****Entitlement to appeal, 843-849****Entitlement to file an opposition, 765-771****Entry into force of a decision to grant a**

European patent, 697

Entry into force of decisions, 603**Entry of payment in an account**

fees, 536

Envisageable product

inventive step, 210

Epi, 931**Epilady case**

prior use, 105

EPO acting as PCT authority, 945, 946-950**EPO as designated or elected Office, 945, 946, 947****EPO Disciplinary Board, 931, 942, 943****EPO postal service**

handing over the decision, 442, 604, 720

EPO sub-office

institutional matters, 951

EQE Examination Board, 932, 936, 937, 938-941**Equity**

apportionment of costs, 461, 740-760

fees, 313, 536

oral proceedings, 454, 461, 464

reimbursement of appeal fees, 907, 909-912, 928, 929

Equivalents, 251

amendments, 317, 324

availability to the public, 99

inventive step, 205

state of the art, 99

Error margins and definitions of limits, 407**Error of judgement**

reimbursement of appeal fees, 921

Error of judgement by a department of first instance

reimbursement of appeal fees, 615

Errors, 929

address of the appellant, 850

amendments, 342-344

calculation errors, 342

correction, 371, 851

date of priority, 656

decision to grant a patent, 697

decisions of EPO departments, 617

description, 621

error of transcription, 656

- name of the appellant, 850
- obvious mistakes, 621
- Patent Bulletin, 625, 699
- priority claim, 657
- priority declaration, 655
- Errors in the disclosure, 342-344**
- Errors in the printed version of the European patent specification, 619**
- Erythropoietin, 183**
- Essentially biological processes**
 - exceptions to patentability, 45
- Euro-PCT application, 945, 946**
- language of the proceedings, 949
- European Convention for the Protection of Human Rights, 638, 942**
- European Court of Human Rights, 531**
- European Patent Bulletin, 388, 390, 529, 625, 631, 699, 771**
- European Patent Convention**
 - special agreement, 397, 399, 400
- European Patent Register, 631-632**
 - withdrawal of the application, 631
- European prior rights**
 - state of the art, 65
- European qualifying examination, 931, 932-941**
 - "qualified to practise" criterion, 937, 941
 - academic qualifications, 932, 933
 - appeals, 938-941
 - conditions for enrolment, 932
 - correction of errors in decisions, 939
 - EPO examiner, 934
 - Examination Board, 932, 936, 937, 938-941
 - examination committee, 936
 - examination conditions, 934
 - examination secretariat, 932, 934, 936, 938-941
 - legal practitioner, 933
 - legitimate interest, 941
 - marking, 935, 936
 - marks awarded, 939, 940, 941
 - official languages of the EPO, 935
 - patent attorney under national law, 933
 - principle of equal treatment, 933, 934, 935, 936
 - rectification of decisions, 938
 - right to be heard, 941
 - substantiation of EQE decisions, 937
 - Supervisory Board, 932
 - training period, 933
- European register of patents, 736**
- European Union**
 - institutional matters, 955
- Evaluation of evidence, 552-564**
 - standard of proof, 38, 40, 88, 89
- Evidence, 39, 73, 502, 544-571**
 - abusive conduct, 562
 - admissibility, 545-549, 918
 - affidavits, 547, 550, 561
 - availability to the public, 73
 - balance of probabilities, 88, 89, 558-564
 - burden of proof, 74, 125, 330, 564-571
 - comparative tests, 556
 - confidentiality, 559
 - disclosure, 560
 - evaluation of evidence, 481
 - experimental evidence, 552-556
 - expert, 546
 - hearsay, 555
 - inventive step, 174, 221
 - keeping of evidence, 552
 - late submission, 708, 717
 - oral proceedings, 444, 445, 447, 458, 467
 - prior use, 550, 551, 553, 554, 555, 558, 783
 - priority, 562
 - probative value, 554-558
 - re-establishment of rights, 507, 508
 - right to be heard, 438, 439, 440, 444, 445, 447, 549
 - standard of proof, 558-564
 - statutory declaration, 547
 - sufficiency of disclosure, 250
 - sworn statement, 547, 557
 - taking of evidence, 549, 552-564
 - telephone call, 429
 - unfettered consideration of the evidence, 545, 552
 - unsworn declaration, 547, 550, 562
 - witness, 546, 550, 553, 554, 557
 - witness testimony, 559, 561
- Evidence of inventive step in the field of medicine, 210**
- Evident abuse (see Abuse), 68**
- Examination after remittal for further prosecution, 690**

Examination as to novelty and inventive step, 302**Examination as to relevance**

late submission, 702-704

Examination by the EPO of its own motion, 481, 836

appeal proceedings, 832

opposition proceedings, 783, 832

Examination conditions, 934**Examination fees**

examination proceedings, 659

time limits, 489

Examination of the subject-matter or activities excluded

exclusion from patentability, 4-7

Examination procedure, 658-700

abuse of procedure, 666, 670, 672

amendments, 662, 667, 681, 690

amendments after receipt of the European search report, 660

approval of the text, 682-684, 690

consent to amendments, 666, 673, 688, 691

consolidation of proceedings, 697

decision to grant a patent, 682, 687

discretion, 661, 665, 666, 667, 675, 676, 678, 686, 688, 691, 692, 921, 922

divisional application, 668

errors in the Patent Bulletin, 625, 699

further amendments, 665

further communication under Article 113(1) EPC, 672

informal communications, 676-678

interest of parties, 660, 686, 688, 692, 697, 699

interviews, 456, 677

invitation to file observations, 661, 687

language privilege, 627

legal basis for refusing an application, 684

legal certainty, 682

main request and auxiliary request, 541

national patent law, 692, 698

oral proceedings, 665, 672, 675, 677

priority, 397

procedural declarations, 682

procedural principles, 672

public interest, 699

request for examination, 658-661

res judicata, 698

resumption of substantive examination, 690

right to be heard, 674, 675, 679, 684

substantial procedural violation, 608, 666, 669, 673, 677, 679, 684

substantive examination, 661-681

telephone conversations, 662, 676, 914

unity of invention, 299, 668

unsearched subject-matters, 667

Examiner

protection of legitimate expectations, 429

Examining division, 591

competence, 494, 495

Examples

denial of inventive step, 211-213

legitimate expectations principle, 426

obligation to draw attention to easily remediable deficiencies, 431

state of the art, 101, 128

Exceptions to patentability, 36-63

animal species, 36, 44

animal varieties, 37

animals, 37, 44

breeding process, 36, 40, 43, 45, 46, 49

essentially biological processes, 45

hybrid plants, 43

hybrid seeds, 43

interpretation, 36, 38, 41, 43, 44, 45

inventions contrary to morality, 36, 37

living matter, 37

microbiological processes, 36, 44, 48

norms of the European society and civilisation, 39, 40

ordre public, 36, 37

plant cells, 44, 46

plant varieties, 36, 42, 43, 44, 48, 49

plant variety protection, 43, 48

plants, 39, 42, 46, 48

process patent, 43

processes of genetic engineering, 43, 45, 46, 48

product claim, 10, 45

product-by-process claims, 45

products of a microbiological process, 44, 48

ratio legis, 37

Regulation on Plant Variety Rights, 43, 48

risks to the environment, 39, 40

selective breeding, 40, 43, 46

UPOV Convention, 43, 48

Excluded national prior rights, 68**Exclusion from patentability**

computer programs, 188
industrial application, 50, 223, 224
medical methods, 57, 58, 61, 62, 148
second medical use, 153
technical character of the invention, 1, 2, 4, 5

Exclusion of the members of the Boards of**Appeal, 1027, 1034****Exercise of discretion (see Discretion)**

inadmissible, 622

Exhaustion of priority, 400**Exhibition**

availability to the public, 102
non-prejudicial disclosure, 68

Exhibition priority, 399**Expectation of success in the field of****biotechnology**

inventive step, 177, 178, 179

Expert, 546**Explicit or implicit disclosure of the essential****features in the priority document, 404-406**

**Ex-post-facto analysis, 163, 166, 167,
171-172, 176, 177, 184**

Extension

time limits, 479, 485, 522

Extension agreement, 953**Extension of European patents, 953****Extension of periods, 480**

**Extension of protection conferred by
product-by-process claims, 291**

Extension of time limits ipso jure, 480-482

**Extension Ordinances on the extension of
European patents, 953**

Extension states, 954

**Extent of competence of the Receiving
Section, 649**

Extent of examination

appeal proceedings, 827-838

**Extent of protection, 246, 251, 252, 277, 282,
284**

amendments, 359, 361, 362
claim's wording, 366
interpretation of claims, 94, 287

Extent of scrutiny, 827-838

appeal proceedings, 822

F

Facts

examination, 836

Fair procedure

appeal proceedings, 826, 827, 837, 893, 894
opposition proceedings, 789
right to be heard, 438, 439

Fairness, 909-912**Family of compounds**

state of the art, 122

Fax, 637**Feature**

clarity of claims, 248
deletion, 329
essential, 257, 275, 330, 341
generalisation, 318
missing - priority, 413-414
technical, 6, 191, 193
unspecified, 268

**Features missing with respect to the earlier
application, 413-414**

**Features not contributing to the solution of
the problem, 199**

**Federal German Constitutional Court, 638,
938**

Fee reduction

language privilege, 625, 627
petition for review under Art. 112a EPC, 625

Fee-monitoring system

re-establishment of rights, 511

Fees

administrative agreement, 534, 536
bank account, 429, 536
date of payment, 536
debit orders, 534
entry of payment in an account, 536
equity, 313, 536
payment, 533-535
payment in due time, 908
protection of legitimate expectations, 432, 433,
434

purpose of payment, 535

small amount lacking, 536

**Fees for re-establishment of rights, 496, 530,
532**

Field of medicine

inventive step, 210

Filing and admissibility of the appeal, 838-860**Filing and search fees**

time limits, 647

Filing and substantiation of the application, 501**Filing of amended claims in appeal proceedings, 888-907****Filing of application documents, 646****Filing of priority documents, 654****Filing of the authorisation, 579****Filing office**

institutional matters, 951

Final decision, 593, 604**Financial difficulties**

re-establishment of rights, 508

First application in a Paris Convention country, 417-420**First medical use, 294**

novelty, 133-136

Fixing and postponing the date

oral proceedings, 462-467

Foreseeable disadvantageous or technically non-functional modifications, 200**Forfeiting a right**

oral proceedings, 449, 679

right to be heard, 443

Form and time limit of appeal, 849**Form of decisions, 605-617****Form of the claims, 273-275****Formalities officer**

competence, 494, 621, 624, 629, 784, 925

inspection of files, 629

mistake and reimbursement of appeal fees, 924

opposition proceedings, 629, 784

Formulation of claims under Article 54(5)**EPC**

second medical use, 141

Formulation of claims under EPC 1973, 138**Formulation of technical problem, 169, 170, 171, 182, 190**

technical and non-technical features, 29, 170, 194

Fresh grounds (see Opposition procedure new grounds for opposition), 789, 792**Functional features, 238, 252**

amendments, 353

ascertaining novelty, 114

clarity of claims, 246, 266

generalisation from the particular examples, 267

novelty of use, 150, 154, 156, 159, 160

routine trials, 266, 267

standard test, 268

support by the description, 277, 278

technical character, 5, 30, 32, 35, 232, 267

Functional interdependence

inventive step, 197, 198

Fungicide

novelty of use, 153

Further invitations to pay additional search fees, 313**Further oral proceedings before the same department, 458****Further processing, 484**

loss of rights, 590

re-establishment of rights, 490, 504

time limits, 478-490, 533, 535, 636, 653

G

Gene (see DNA), 40**General authorisations, 580****General professional obligations, 943****General public, 185**

availability to the public, 75, 298, 435, 436, 437

interest of, 263, 464, 655, 657, 935

preliminary and formalities examination, 655

re-establishment of rights, 529

General rules of interpretation, 93**Generic defined group**

state of the art, 133

Generic disclosure

ascertaining novelty, 111, 115

priority, 409, 410

Generic formula

novelty, 118, 119, 122

priority, 422, 423

German patent

availability to the public, 70

Grandfather clause, 571**Grounds for opposition**

agreement of the patent proprietor, 704, 828

intervention, 721

Grounds of appeal, 1037, 1038

Groups of substances

novelty, 118-127

Growth regulation

availability to the public, 102

Guidelines for examination, 10, 162, 176, 180, 205, 397, 435, 612, 662, 670, 677, 686, 765, 808, 810, 813, 914, 937, 1040

amendments, 359

legal status, 623

legally binding, 923

procedural violation, 923

unity of invention, 300, 310, 313

H

Handbook, 186

knowledge of the skilled person/s, 66, 94

Hardware

technical character, 31

Harmonisation, 640, 879

Holiday

re-establishment of rights, 527

Hybrid plants

exceptions to patentability, 43

product-by-process claims, 290

Hybrid seeds

exceptions from patentability, 43

product-by-process claims, 290

I

Identity of invention

enabling disclosure, 414-416

priority, 400-416, 420

Identity of the applicant

preliminary and formalities examination, 651

Illness, 144, 225

oral proceedings, 464

re-establishment of rights, 498, 511, 515, 516, 520, 527

Impact of withdrawal of opposition on proceedings before the EPO, 718-719

Impartiality, 826

appeal proceedings, 826, 827, 837

decisions of EPO departments, 594, 599

employee of the EPO, 596

opposition proceedings, 809

see also Suspected partiality, 594

Implicit disclosure

amendments, 317, 328, 350

Implicit features

availability to the public, 97

priority, 412

state of the art, 97

Implicit features of the technical teaching of the subsequent application, 412

improvement in commercially used process

inventive step, 209

Improvement of a production process for a known product, 168

Improvement of properties

inventive step, 207

Inability to observe a time limit, 508-509

Inadmissible oppositions

right to be heard, 459

Inconsistency between oral and written decision, 924

Incorrect debit orders, 534

Independence

boards of appeal, 469, 952

Independent claims, 832

burden of proof, 273

of the same category, 271

opposition proceedings, 273

unity of invention, 293, 294, 295, 305

Independent cross-check

re-establishment of rights, 516

Indicia in determining industrial applicability, 227-228

Industrial application, 223-227

commercial use, 223, 224, 225

exclusion from patentability, 50, 223, 224

formulation of claims, 228

indication of a profitable use, 225, 226

manufacture of a substance, 225

medical methods, 56

secondary indicia, 227-228

Industrial design

priority, 398

Inevitable result

novelty, 97, 99, 102, 109, 114, 118, 121, 132

Informal communications, 676-678

Information

by telephone, 427

erroneous, 425

protection of legitimate expectations, 425, 427, 430, 435

Infringement of Article 123(2) EPC 1973

technical problem, 173

Infringement proceedings, 867, 868**In-house knowledge**

state of the art, 66, 167

In-house knowledge not published before the priority date, 66**Insolvency, 844**

interruption of proceedings, 488

re-establishment of rights, 530

Inspection of files, 629-630, 840, 1028

availability to the public, 70

confidentiality, 629, 630

exclusion, 630

formalities officer, 629

procedural violation, 630

Institutional matters, 951-956

administrative agreement, 951

Administrative Council, 954

contracting states, 955

Court of Justice of the European Communities, 954

extension agreement, 953

extension of European patents, 953

extension ordinances, 953

extension states, 954

fax, 951

German Constitutional Court, 954

national applications, 954

national law, 954

time limit, 951

Interaction with outside conditions

availability to the public, 99, 104

Interest of third parties (see General public), 660**Interim decision, 1028, 1036****Interlocutory decision, 542, 680, 819-821, 833, 842**

appeal proceedings, 841, 880

opposition proceedings, 442, 819-821

Interlocutory revision, 875-878

re-establishment of rights, 495

reimbursement of appeal fees, 876, 907, 928

Intermediate compound

unity of invention, 307

Intermediate generalisation

amendments, 324

definition, 325, 326

Intermediate products

availability to the public, 75, 108

inventive step, 204, 210

unity of invention, 295, 296

International application

protection of legitimate expectations, 431

state of the art, 65, 297, 298, 301, 304, 305, 310

International Court of Justice, 640**International Preliminary Examining**

Authority (IPEA), 292, 298, 302

unity of invention, 298, 302

International Preliminary Examining Report

right to be heard, 439, 921

International Searching Authority (ISA), 292, 297, 298, 302, 303, 313

unity of invention, 297, 298, 302, 303, 313

Internet disclosure, 91, 561

proof of the date of availability, 91

Interpretation, 306

context of the document as a whole, 93, 101, 110

differences between national legislation and the EPC, 642

EPC, 426, 502, 506, 510, 638-643

EPC 1973, 41, 43, 44, 45

exceptions to patentability, 36, 38, 41, 43, 44, 45

medical methods, 62

re-establishment of rights, 521

Rule 46(1) EPC, 312, 313

unity of invention, 292

Interpretation and application of Rule 71a EPC, 469-472**Interpretation of Article 87 EPC in the light of TRIPS, 640****Interpretation of claims, 112, 279-287**

claim, 140, 153, 279-287

clarity of claims, 247, 285

definition of terms in the description, 283, 284

description, 281

drawings, 281

essential feature, 153

extent of protection conferred by the patent, 94, 287

inconsistent claims, 286

meaning of terms, 280

relevance of Article 69 EPC, 282

technical character, 30

unclear term, 283, 286, 287

Interpretation of requests

appeal proceedings, 877

Interpretation of the state of the art, 93

relevant point in time, 95

Interpreters, 1031, 1036

Interrelation between Article 122 EPC 1973 and Rule 85(2) EPC 1973, 530

Interruption

delivery of mail, 480

Interruption of proceedings, 488

insolvency, 488

re-establishment of rights, 508, 530

time limits, 478-490

Intervention

admissibility, 721-722

appeal proceedings, 721

grounds for opposition, 721

infringer, 720, 723

intervener's rights, 720, 721

opposition proceedings, 719

time limits, 722

withdrawal of the appeal, 721, 874

Interview, 455

examination proceedings, 456, 673, 677

Intrinsic features

availability to the public, 99, 104, 153, 154, 156, 159

state of the art, 99, 104

Introduction of a new claim, relevant document or new argument, 444-446

Inventions

technical considerations, 5

Inventions contrary to morality

exceptions to patentability, 36, 37

opinion polls, 39

standard of proof, 38

transgenic animals, 37

transgenic plants, 39, 40

Inventive character of the single general concept, 306

Inventive step, 162-222

aggregation of features, 197, 198

alleged advantages, 170, 221

alternative solution, 175

analogy process, 210

automation, 211

bioisosterie, 202

bonus effect, 173, 219, 221

broad claims, 203

chemical inventions, 202

choice of one of several obvious solutions, 212

combination invention, 176, 197-199, 206

combination of documents, 165, 201

common general knowledge, 214

comparative tests, 174, 208, 221

could-would approach, 176, 177, 197

date of priority, 214

desideratum, 211

disclaimer, 208

envisageable product, 210

equivalents, 205

every day items, 187, 188

expectation of success in the field of

biotechnology, 177, 178, 179

ex-post-facto analysis, 163, 166, 167, 171-172, 176, 177, 184

features not contributing to the solution of the problem, 199

field of medicine, 210

formulation of the technical problem, 182, 190

functional interdependence, 197, 198

improvement in commercially used process, 209

improvement of properties, 207

intermediate products, 204, 210

knowledge of the skilled person/s, 202

level of knowledge of the skilled person, 180, 186

monopoly, 162

most promising springboard, 166

most promising starting point, 164, 166

neighbouring field, 181, 184, 185

new use of a known measure, 206

obvious new use, 207

old prior art documents, 168

one-way-street situation, 220

oost-published document, 175

optimisation of parameters, 208

partial problems, 172, 197, 198, 201, 219
 problem and solution approach, 165, 166, 167, 170, 173, 176, 182, 189, 195, 202
 problem inventions, 170, 205, 210
 product-by-process claims, 288, 289
 production process for a known product, 168
 purposive selection, 211
 reversal of procedural steps, 211
 routine experiments, 178, 183, 212
 secondary indicia, 184, 213-222
 secondary indicia age of documents, 214, 216, 217
 secondary indicia commercial success, 214, 217
 secondary indicia cost of advertising, 214
 secondary indicia development of the art in a different direction, 215
 secondary indicia licensing, 214
 secondary indicia prejudice in the art, 201, 214
 secondary indicia satisfaction of a long felt need, 214, 217
 secondary indicia simple solution, 219
 secondary indicia surprising effect, 219
 secondary indicia time factor, 216, 217
 several obvious steps, 213
 simple solution, 176, 205
 simplification of complicated technology, 212
 skilled person (see Skilled person), 177, 180-188, 190, 191
 solving a technical problem, 175, 190
 state of the art (see State of the art), 190
 structural similarity, 164, 202
 substitution of materials, 200
 technical and non-technical features, 188-196
 technical character of the invention, 22, 188, 194
 technical disclosure in a prior art document, 199
 technical effect, 164, 171, 172, 174, 175
 technical problem (see Technical problem), 170-176, 192
 technical progress, 162, 170, 171
 technically non-functional modifications, 200
 unity of invention, 298, 299, 302, 306, 307
 Viagra, 215, 218
Invitation to file observations, 443, 661, 687
IPC classification, 201
Is it essential test
 amendments, 352

Issuance of a further communication under Article 113(1) EPC, 672
Issues of proof, 86-92

J

Japanese patent attorney
 re-establishment of rights, 518
Japanese patent document
 abstracts, 74, 95
Joint venture agreement
 availability to the public, 83
Jurisdiction, 625

K

Knowledge of the skilled person/s, 66, 106, 108, 110, 125, 130, 714
 burden of proof, 86
 database, 67
 inventive step, 202
 priority, 400, 402, 403, 406, 408, 410, 413, 415, 417
 sufficiency of disclosure, 234, 235, 237, 240

L

Language
 appeal proceedings, 824
 application documents, 645
 European qualifying examination, 935
 official language of the EPO, 641, 646, 824
Language of the proceedings, 824, 1028, 1035
 Euro-PCT application, 949
Language privilege, 625-628
 appeal proceedings, 627, 628, 824
 date of filing, 626
 examination proceedings, 627
 fee reduction, 625, 627
 filing of patent application, 626
 opposition proceedings, 627
 translation, 628
Lapse of a patent
 continuation of opposition appeal proceedings, 740
 continuation of the opposition proceedings, 739

termination of opposition appeal proceedings, 739

Late filing

claims, 470, 471, 472

documents, 449

new arguments, 463

new evidence, 463

oral proceedings, 444-446

requests, 450, 470, 472, 921

Late submission, 700-718

abuse of procedure, 704, 705, 706, 709, 715, 716, 837

acceleration of the proceedings, 701

admissibility of a fresh ground for opposition, 703

agreement of the patent proprietor, 704

apportionment of costs, 742, 743, 745, 746

arguments, 446, 447, 716

change of representatives, 710, 715

closest prior art, 704, 717

comparative tests, 705, 706, 709

complexity, 700, 705, 707, 708

counter-experiments, 709

delaying the proceedings, 704, 713

discretion, 469, 471, 472, 701, 703, 704, 923

discretion of opposition divisions, 712

estoppel, 706

evidence, 708, 717

examination as to relevance, 702-704, 707, 709

experiments, 705, 715

fairness in the proceedings, 701, 705, 706

justification of late filing, 714

meaning of "late", 701

obligation of the EPO to examine of its own motion, 700, 702, 706, 717

obligation to maintain secrecy, 711

opposition proceedings, 712-713

oral proceedings, 712, 716

procedural economy, 470, 701, 707

proceedings before the boards of appeal, 703

proceedings before the opposition divisions, 703

protection of legitimate expectations, 710

public prior use, 707, 709, 710, 711

re-establishment of rights, 507

relevance of the tests, 709

remittal to the first instance, 862-869

search report, 717, 718

specification of the patent, 717

statement of reasons, 712

subject-matter of the appeal procedure, 703

volenti non fit iniura, 714

Lectures

availability to the public, 73

Legal advice, 697

Nr. 15/84, 523

Nr. 15/98, 543

Nr. 16/85, 591

Nr. 4/80, 666

protection of legitimate expectations, 428

Legal Board of Appeal

competence, 632

Legal capacity, 485

of the applicant/ patent proprietor, 486, 530

of the representative, 486, 488

Legal certainty, 45, 61, 63, 604, 606, 674

examination proceedings, 674, 682

interpretation of claims, 252, 253, 259

notifications, 637

priority, 401

procedural steps, 538

re-establishment of rights, 493, 500

right to be heard, 448

Legal character of appeal procedure, 821

Legal Division

competence, 494

register of legal practitioners, 576

Legal error

re-establishment of rights, 509, 510, 521, 523

Legal incapacity of a representative from outside the contracting states, 488

Legal practitioner

European qualifying examination, 933

Legal practitioners entitled to act as professional representative, 574-577

Legal status of the Guidelines for

Examination in the EPO, 623

Legitimate expectations (see Protection of legitimate expectations)

easily remediable deficiencies, 502, 503

late submission, 710

re-establishment of rights, 522

Letter

availability to the public, 81

Level of knowledge

inventive step, 180, 186
skilled person, 191
sufficiency of disclosure, 232

Licences

registration, 631

Licensing

inventive step, 214

Limitation of the European patent, 737

Limitation of the extent of the protection
priority, 401

Limited circle of people

availability to the public, 76, 79

List of professional representatives, 572, 931, 942**Literature**

technical, 66

Logical chain of reasoning

decision, 609, 610

Loss of rights, 454, 483, 485, 497, 506, 530, 624, 654, 687

re-establishment of rights, 527
right to a decision, 590

Loss of rights as a direct consequence by virtue of the EPC

re-establishment of rights, 492, 590

M

Main and auxiliary requests, 540-544, 607

examination proceedings, 541
opposition proceedings, 543

Maintenance of the patents as amended, 820**Making available for test purposes**

availability to the public, 81

Making good the omitted act, 501**Man in the street**

availability to the public, 76

Manufacture of a substance

industrial application, 225

Market competitor, 415**Market test**

availability to the public, 82

Markush claims

unity of invention, 309

Markush formulae, 118, 271**Mathematical methods**

technical character, 14, 30
technical inventions, 1, 11, 13

Meaning of terms, 280**Measurement error**

clarity of claims, 253

Measuring methods

sufficiency of disclosure, 247

Medical methods, 49-63

animals, 57
contraception, 56
cosmetic treatment, 58, 59
diagnostic methods, 60-63
disclaimer, 60
exceptions to patentability, 50
exclusion from patentability, 57, 58, 61, 62, 147, 148
industrial application, 56
legal fiction, 50
meaning of "therapy", 55
method claims, 58
national law, 56
pain, 55, 56
pregnancy, 55
prophylactic treatment, 55, 57, 59
snoring, 59
therapeutic and non-therapeutic indications, 57, 59
therapeutic effect, 57, 58
therapeutic methods, 55
therapeutic or prophylactic effect, 58
treatment by therapy, 55, 57, 58, 59
veterinary medicine, 50
veterinary practitioners, 50
Medical practitioner, 140, 147, 148, 228
Medicament
novelty of use, 133-161
process for the manufacture of a medicament, 138
second medical use, 136-152
Mental acts
technical character, 24, 27, 32
Method claims, 251
aesthetic creations, 15
clarity of claims, 258, 261
exceptions to patentability, 43
medical methods, 58

novelty of use, 138, 139, 152
technical character, 29
unity of invention, 293, 294, 305, 307, 308
Method for controlling a pension
technical character, 26
Methods applied in the private and personal sphere, 227
Methods for doing business
industrial application, 223
technical character, 27
Methods for performing mental acts
technical inventions, 1, 11, 25, 28
Methods for playing games
technical inventions, 1, 11, 25
Methods of paying, 533
Metric or SI Units, 700
Microbiological processes
exceptions to patentability, 36, 44, 48
Microbiological processes and the products thereof, 48
Microchip
availability to the public, 102
Micro-organisms
exceptions to patentability, 48
sufficiency of disclosure, 240, 242, 243, 244
Minutes, 445, 617, 618, 917
correction, 475, 618, 840
error, 475, 927
oral proceedings, 453, 468, 474, 610, 823, 840, 1028, 1036
right to be heard, 443
statements of parties, 476
witness, 918
Missing drawings, 647, 648
Mistakes in a disclosure, 105, 108
Misunderstanding (giving rise to)
protection of legitimate expectations, 426, 428, 429, 431, 435
Mix of technical and non-technical features
technical inventions, 8, 9, 26, 33
Monitoring time limits
re-establishment of rights, 507, 512, 514
Monopoly
inventive step, 162
Motor vehicle for demonstration
availability to the public, 74
Multiple priorities, 420-423

Multiple priorities for one claim, 421

Multi-step methods

microbiological processes, 49

N

National applications, 954

National court, 467, 538

suspension of proceedings, 634

National decisions

interpretation of the EPC, 642

National deposit of industrial design, 398

National fee

re-establishment of rights, 504

National law, 634, 953, 954

medical methods, 56

re-establishment of rights, 492

right to a European Patent, 644

National offices, 954

National patent law

unity of invention, 298, 299

National prior rights

opposition proceedings, 781, 798

state of the art, 68

Nature of the evidence

availability to the public, 86

Ne ultra petita (see Principle of party disposition), 787

Neighbouring technical field

inventive step, 181, 184, 185

New submission, 1029

New use of a known measure

inventive step, 206

Non-appearance

apportionment of costs, 749

oral proceedings, 447, 451, 457, 461-462, 896, 897

Non-invention, 5, 10-35, 188, 190, 191

Non-prejudicial disclosures, 68

Non-technical features, 116

distinguishing features, 116

novelty, 116

Non-therapeutic treatment, 155, 264

Norms of the European society and civilisation, 39, 40

Notice of opposition, 769, 771, 774, 775, 776, 777, 782, 784, 785

Notifications, 635-638

delivery, 637
 dispute, 637
 fax, 637
 postal despatch, 637
 representatives, 635
 time when the document was despatched, 636

Notion of industrial application, 223-227**Novelty, 63-161**

accidental anticipation, 106, 107
 achieving a higher degree of purity, 125
 alternatives, 115, 120
 broad range, 127
 burden of proof, 86, 125
 chemical compounds and groups of compounds, 118-127
 chemical inventions, 117-133
 combination of features, 96, 131
 compositions of substances, 120, 126, 134
 degree of purity, 125, 289
 examples of how the invention is carried out, 101, 128
 family of substances, 122
 first medical use, 133-136
 functional features, 154, 156, 159, 160
 functional limitation, 128
 generically defined group, 133
 groups of substances, 118-127
 hidden matters, 104, 129
 method claims, 75, 87, 95, 107, 110, 114, 115, 118, 125, 128, 130, 131, 138, 139, 152
 multiple selection, 131
 narrow selection, 127, 129, 131, 133
 overlapping ranges, 108, 118, 122, 123, 129, 132
 parameters of substances, 118, 119, 123, 289
 preferred numerical range, 128
 preparation in the form of a kit-of-parts, 135
 product-by process claims, 288, 289
 purposive selection, 127, 128
 second (further) medical use, 136-152
 second (further) non-medical use, 152-161
 selection of parameter ranges, 118, 127-133
 starting substances, 108, 118, 119, 120, 121, 122, 126
 structural formula, 118, 119, 122
 substances, 122, 134

technical effect, 99, 104, 129, 144, 149, 150, 153, 154, 155, 158, 160
 unambiguous disclosure, 92, 95, 96, 97, 100, 124
 unity of invention, 298, 299, 302
 use claims, 144, 145, 148, 149, 150, 152

Novelty based on the different technical effect

second medical use, 149

Novelty of the therapeutic application

second medical use, 144

Novelty of use, 133-161**Novelty test**

amendments, 347, 348, 354
 priority, 401, 402

O

Obiter dictum, 611**Objection to members of the Boards of Appeal, 1027, 1034****Obligation of the EPO to examine of its own motion**

availability to the public, 92
 late submission, 702, 706, 717
 opposition proceedings, 789

Obligation to draw attention to easily remediable deficiencies, 430-434**Obligation to give notice if not attending oral proceedings, 461****Obligation to maintain secrecy**

burden of proof, 82, 87
 conference, 83
 demonstrating products for presentation purposes, 79
 displaying the invention, 78
 distribution of prospectuses, 78
 express agreement, 78
 joint venture agreement, 83
 making available for test purposes, 81
 market test, 82
 medical field, 85
 paper submitted to obtain an academic degree, 85
 presenting the product in writing, 80
 prototype, 76, 79, 85
 sub-contracting, 79

tacit agreement, 78, 79, 80, 81, 82, 85

Observations by third parties, 723

amendment of patent application, 728

extent of scrutiny, 725

form, 727

interlocutory decisions, 728

late submission, 725

legal position of third party, 727

nature, 726

remittal, 729

substantial procedural violation, 729

time limits, 724

Obvious new use, 207

Obviousness of the error and the correction, 371

Offer of new oral proceedings, 594

Official forms, 516

protection of legitimate expectations, 427, 428, 432, 581

Official language, 1028, 1035

Old prior art documents

inventive step, 168

Omission of acts

re-establishment of rights, 492, 501

Oncogene

exceptions to patentability, 45

sufficiency of disclosure, 37

One-part or two-part claim, 274

One-way-street situation

inventive step, 220

Opinion polls, 39

Opinions held by a minority, 1031

Opponent status

transfer, 729

Opportunity to make comments

examination proceedings, 456, 911

opposition proceedings, 593, 811, 815

right to be heard, 438, 439, 442, 443, 444, 445, 446, 450, 460, 914, 916

Opposition division, 591

composition, 591, 915, 924, 925

Opposition fees, 771, 773

re-establishment of rights, 493

Opposition filed by the patent proprietor, 437, 766

Opposition procedure, 763-821

admissibility of observations, 810

admissibility of straw man, 767

allowability of the opposition, 779, 785-797

amendments, 791, 797-809

burden of proof, 247, 250, 768, 780, 781, 782

communication pursuant to Rule 58(4) EPC, 812

communications of the EPO, 629

contentious proceedings, 764, 765, 767

dependent claim, 801

entitlement to file an opposition, 765-771

evidence, 731, 732, 733, 764, 767, 772, 779, 783, 789, 796, 817

examination by the EPO of its own motion, 783

extent of the opposition, 785, 787

factual framework of the opposition, 788, 796

filing of the opposition, 767

further opportunity to make comments, 811

grounds for opposition, 774, 775, 777, 778, 780, 782, 787

identity of the opponent, 772

impartiality, 809

independent claims, 786, 792, 801, 803

interest of the opponent, 771

interlocutory decisions, 819-821

joint oppositions, 769

language privilege, 627

late submission, 712-713

legal framework, 785-796

main request and auxiliary request, 543

maintenance of the patent as amended, 820

multiple oppositions, 765, 768

new grounds for opposition, 789, 792, 793, 815

notice of opposition, 769, 771, 774, 775, 776, 777, 782, 784, 785

obligation of the EPO to examine of its own motion, 789

observations by the parties, 444

opportunity to make comments, 815

opposition period, 776, 778

principle of party disposition, 764

priority, 397

procedural economy, 783

ratio legis, 301

revocation of patent, 818

right to be heard, 442, 443, 444, 446, 453, 809-817

substantial procedural violation, 609

substantiation of the opposition, 774-784

unity of invention, 301
withdrawal of opposition, 718
Optimisation of parameters
inventive step, 208
Oral disclosure
amended claims, 472
availability to the public, 74, 77
change of representative, 465
ground for postponement, 465
holidays, 465
illness, 466
interpreting costs, 476
late submission, 471
location, 472
minutes, 474
new facts and evidence, 469
non-public, 477
postponement, 464
PowerPoint presentation, 473
procedural economy, 465
reasons for changing the date, 466
unavailability, 464
Oral proceedings, 453-477
abuse, 455, 461
adjournment, 1038
amended claims in appeal proceedings, 889
apportionment of costs, 476
auxiliary request, 456, 458, 459, 914
change in the subject of the proceedings, 471
communication under Article 11(1) RPBA, 468
computer-generated presentations, 473
curtailment of notice in the summons, 467
examination proceedings, 665, 675
fixing or postponing the date for oral proceedings, 462-467
former member, 925
minutes, 453, 468, 474, 610, 618, 823, 840, 1028, 1036
national holiday, 465
non-appearance, 447-451, 457, 461-462, 896, 897
postponement of the date, 462-467
preparation and conduct, 462-472
reasons for changing the date, 463
Receiving Section, 454
reimbursement of appeal fees, 913
remittal, 459, 460

representation, 464
request, 453, 454, 455-460, 463, 913
right to be heard, 441, 444-447, 454, 455, 461, 467
same parties and subject, 458, 459
wording of request, 456-457, 459
Oral proceedings before the Receiving Section, 454
Oral submissions by an accompanying person, 583-589
Oral submissions by former members of the boards of appeal, 588
Oral submissions by qualified patent lawyers of non-EPC contracting states, 589
Ordre public
exceptions to patentability, 36, 37
physical integrity of individuals, 40
standard of proof, 38, 40
transgenic animals, 37, 39
transgenic plants, 39, 40
Outdated technology
state of the art, 168, 169
Overlapping ranges
novelty, 108, 122, 123, 129, 132

P

Pain
medical methods, 55, 56
Parameter ranges
amendments, 319, 322, 330
novelty, 118, 123, 127-133
Parameters
novelty, 119, 123
Parent application
unity of invention, 311
Paris Convention, 227, 397, 399, 640, 927
Partial and multiple priorities, 420-423
Partial priority, 420-423
Partial problems
inventive step, 172, 197, 198, 201, 219
Partiality, 594
Parties to the proceedings
interests of, 825
procedural status in appeal proceedings, 719, 825
right to be heard, 506, 825

rights in appeal proceedings, 825, 826

Party adversely affected, 662, 676, 680, 682, 844

opponent, 847

patent proprietor, 845

Patent attorney

representation, 576

Patent attorney under national law

European qualifying examination, 933

Patent protection

technical inventions, 1-10

Patent register, 841

Patent specification, 773, 778

errors, 617-622

knowledge of the skilled person/s, 66

sufficiency of disclosure, 230

Patentability of animals and animal species, 44

Patentability requirements

separate and independent, 64

Patentability requirements under examination

appeal proceedings, 835-836

ex-parte proceedings, 835

Patentable inventions, 1-35

Payment

fees paid in due time, 533

PCT application, 65, 167

PCT applications as state of the art, 65

PCT International Search and Preliminary Examination Guidelines, 293, 298, 308, 311

PCT procedure, 295, 300, 945

competence of the boards of appeal, 945-946

competence of the EPO, 946, 947, 948, 949

correction of designation of states, 946, 947

divisional application, 947

EPC 2000, 945, 947

further processing, 947

regional phase, 945

PCT search guidelines, 293, 297, 298, 308, 311, 313

Period of grace

fees under Rule 85a EPC, 482

re-establishment of rights, 504

renewal fees, 482

Periodical

availability to the public, 72

Petition for review, 870, 882, 1029, 1031

fee reduction, 625

fundamental procedural defect, 887

fundamental violation of Art. 113 EPC, 885

Pharmaceutical product

industrial application, 228

Pharmacological tests

disclosure, 93

Plant cells

exceptions to patentability, 44, 46

Plant varieties

exceptions to patentability, 36, 42, 43, 44, 48, 49

Plant variety rights

exceptions to patentability, 43, 48

Plants

exceptions to patentability, 39, 42, 46, 48

Plurality of independent claims, 293

Plurality of inventions and further search fees, 311-314

Postal interruptions

burden of proof, 482

Postdating the application

priority, 399

Postponement

apportionment of costs, 753

oral proceedings, 445, 446, 470, 472, 479, 894, 1030

Post-published document

inventive step, 175

Preamble

two-part claim, 274, 275

Prejudice in the art

inventive step, 184, 201, 214

Preliminary and formalities examination, 645-658

accordance of a date of filing, 645, 647, 649, 651

competence of Receiving Section, 645, 649

continuation-in-part application, 656

correction, 648, 649, 650, 651, 653, 655, 657

correction of priority declaration, 654, 656

designation fees, 652

designation in Euro-PCT applications, 653

designation of states, 652-654

devolutive effect, 658

divisional applications, 652, 653

electronic filing of documents, 647

errors, 647, 649, 651, 652, 653
 errors concerning date of priority, 656
 errors concerning priority declaration, 654, 655, 657
 errors in drawings, 649
 fax, 647
 filing of application documents, 646
 filing of priority documents, 654
 identity of the applicant, 651
 interruption in the delivery of mail, 647
 language of application documents, 645
 postal delay, 647
 protection of legitimate expectations, 431
 public interest, 655, 657
 publication of the application, 657, 658

Presentation of information

technical character, 15, 33, 35
 technical inventions, 1, 11

President of the EPO, 1029, 1040

Presidium, 1034, 1036

institutional matters, 952

Presumption

impartiality, 600
 validity, 664

Prima facie evidence, 73, 86, 416, 512

Principle of equal treatment, 455, 473, 809-817

appeal proceedings, 826, 827
 apportionment of costs, 760
 European qualifying examination, 933, 934, 935, 936
 priority, 401
 re-establishment of rights, 493
 right to be heard, 439

Principle of ex officio examination (see

Obligation of the EPO to examine of its own motion), 700, 764

Principle of good faith (see Protection of legitimate expectations), 430, 591, 662, 673, 676, 951, 953

Principle of impartiality (see also Suspected partiality), 594, 597, 599, 809

Principle of legitimate expectations, (see Protection of legitimate expectations)

Principle of party disposition, 723, 787, 822

Principle of proportionality, 530

re-establishment of rights, 526, 531

Principles for the exercise of discretion, 622

Prior claim

prior national rights, 68

Prior use, 423

apportionment of costs, 744
 availability to the public, 74, 78, 79, 80, 82, 85, 86, 87, 102, 105, 107
 composition of the product, 102, 103, 104
 evidence, 86, 87
 ground for opposition, 783
 information content, 102
 late submission, 707, 709, 710, 711
 obligation of the EPO to examine of its own motion, 92
 state of the art, 74, 85, 86, 87, 102, 105, 107
 substantiation, 782

Priority, 397-423

amendments, 402
 applications giving rise to a right of priority, 397-400
 concept of the same invention, 419
 date of filing, 397, 400, 404
 definitions of limits, 407
 different priorities, 421
 differing ranges, 408
 disclosure of essential features in the priority document, 402, 404, 405, 406, 414
 disclosure test under Art. 123(2) EPC, 401, 402, 410
 divisional application, 375, 400
 enabling disclosure in the priority document, 414, 416
 error margins, 407
 examination proceedings, 397
 exhaustion of priority, 400
 exhibition priority, 399
 features missing with respect to the earlier application, 413-414
 generic disclosure, 409, 410
 generic formula, 422, 423
 identity of applicant, 419
 identity of invention, 400-416, 420
 implicit disclosure, 401, 410
 implicit features of the technical teaching, 412
 industrial design, 398-399
 limitation of the extent of protection, 401
 multiple exercise of the right of priority, 399

multiple priorities for one claim, 420-423
novelty test, 401, 402
nucleotide and amino acid sequences, 410
omission of indispensable features, 414
omission of non-essential features, 413
opposition proceedings, 397
partial and multiple priorities, 420-423
postdating the application, 399
previous application, 412-414, 420
priority date, 397, 423
publications during the priority interval, 420
right of the applicant or his successor in title, 398
same invention, 400, 401, 409, 411, 418, 421
selection inventions, 410
skilled person, 403, 408
Snackfood decision, 401, 404
state of the art, 420
sufficiency of disclosure, 415, 418
Swiss patent law, 399
teaching, 406
time limits, 478, 654
utility model, 398

Priority date, 235, 397, 423

inventive step, 214

Priority declaration

errors in preliminary and formalities examination, 654

Priority document, 315, 403, 404-406, 407, 413, 414, 422, 423

disclosure, 404, 409, 413, 414, 415

inspection of files, 629

Priority interval, 422

Priority period

re-establishment of rights, 490

Priority test, 403, 413

Problem and solution approach

inventive step, 162, 163, 165, 166, 167, 170, 173, 176, 182, 189, 195, 202

unity of invention, 294, 301, 303

Problem invention, 170, 205, 210, 305

Procedural economy, 650

amended claims in appeal proceedings, 888, 889, 902

appeal proceedings, 869, 878

examination proceedings, 665

fundamental legal rights, 930

late submission, 470, 701, 707, 837

oral proceedings, 454, 457, 473

re-establishment of rights, 494

remittal, 868

right to be heard, 450

rules of procedure of the boards of appeal, 1038

Procedural principles, 244, 425-644, 868, 878, 930

appeal proceedings, 822, 826, 836

contracting states, 467, 493

oral proceedings, 453

Procedural questions, 391-395, 625-638

burden of proof, 468

Procedural status of the parties, 825-827

Procedural steps, 537-544

abuse of procedure, 540

legal certainty, 538

performed by a person other than the

professional representative, 574

signatures, 539,

substantial procedural violation, 539, 541, 542, 543, 948

Procedural violation, 456, 459, 475, 912-928

appeal proceedings, 867, 877

communication, 915

decision according to the state of the file, 919

decisions of EPO departments, 591, 593, 597, 606, 607, 608, 609, 610, 616, 623, 911

definition, 912

delay within the EPO, 924

draft decision, 924

error of judgment, 914, 921

examination proceedings, 397, 666, 669, 673, 677, 679

exercise of discretion, 916

file inspection, 630

former member of the boards of appeal, 925

guidelines for examination, 923

mistake by a formalities officer, 924

opportunity to make comments, 916

opposition proceedings, 397

party's own responsibility, 917

reasons for the decision, 466

Receiving Section, 454

re-establishment of rights, 494

reimbursement of appeal fees, 907, 912-928

remittal, 923

right to be heard, 438, 440, 446, 451, 452, 453,
470, 610, 676, 810, 914
single ground, 920
witness, 918

Proceedings before the Disciplinary Board of Appeal, 931-944

Proceedings before the EPO, 645-658

Process patent

exceptions to patentability, 43
products obtained directly by the process, 287

Product claim, 251, 252

aesthetic creations, 15
exceptions to patentability, 10, 45
technical character, 29
unity of invention, 293, 294

Product claim with process features

ascertaining novelty, 116

Product claim with purpose characteristics

ascertaining novelty, 161

Product parameters

novelty, 118, 119, 289

Product-by-process claims, 119, 287-291

amendments, 290, 358, 364
antibodies, 290
burden of proof, 289
categories of claim, 45, 291
claimed product cannot be described in any
other way, 290
combination of product and process features,
290
exceptions to patentability, 45
extent of protection, 291
hybrid plants, 290
hybrid seeds, 290
inventive step, 288, 289
novelty, 288, 289
products obtained by the process, 45
requirement that the product must be
patentable, 288

Production process

availability to the public, 75, 125

Production process for a known product

inventive step, 168

Products obtained by the process

directly obtained, 287
implicit disclosure, 97

Products of a microbiological process

exceptions to patentability, 44, 48

Professional representative, 470, 486, 572-574

during the transitional period, 573
rules of procedure of the boards of appeal, 1039

Professional secrecy, 944

Programs for computers

technical inventions, 1, 11

Prophylactic treatment

medical methods, 55, 57, 58, 59

Protection of legitimate expectations, 425-438

ambiguity of the communication, 926
correction of decisions, 428
courtesy services performed by the EPO, 434
decisions of EPO departments, 425, 591, 609
decisions taken by the Enlarged Board of Appeal, 426
doubt, 426
easily remediable deficiencies, 430-434, 591
electronic filing of documents, 432
established practice, 426, 436
Euro-PCT proceedings, 425, 436
examiner, 429
ex-parte proceedings, 425
fees, 430, 432, 433, 434
information, 425, 427, 430
inter-partes proceedings, 425
legal advice, 428
limits of the principle, 428
misunderstanding, 431
official forms, 427
official statements, 426
oral agreement, 429
party's own responsibility, 430, 433
preliminary and formalities examination, 431
re-establishment of rights, 430, 433
reimbursement of appeal fees, 909, 910
requirement of proof, 429
single decision of a board of appeal, 426, 435, 436
sources, 426
transitional period, 437
Protest procedure
EPC 2000, 945
review body, 300, 945, 946

Protocol on the Interpretation of Article 69 of the Convention, 234, 284, 356, 361, 805**Prototype, 76, 79, 85****Provisional opinion**

right to be heard, 446, 816

Public international law, 638**Publication**

availability to the public, 64, 70, 781

mention of the grant, 390, 633, 823

specification of the European patent, 772

Publication of the application

preliminary and formalities examination, 657, 658

Publications during the priority interval, 420**Publicity notice**

availability to the public, 88

Purpose

second (further) non-medical use, 160, 161

Purpose of payment

fees, 535

Purpose-related product claim

novelty, 134, 137

R

Rapporteur, 1027, 1028, 1031, 1035, 1040**Ratio decidendi**

binding effect, 869, 872

decision, 664, 690

Ratio legis

exceptions to patentability, 37

opposition proceedings, 301

Reasonable expectation of success (see**Expectation of success), 178****Reasons for the decision, 607**

right to be heard, 438, 446, 447, 448, 914

Receiving section, 394

competence, 643

oral proceedings, 454

Re-establishment of rights, 454, 490

additional fees, 525

admissibility of application, 494-503

American representative, 497, 517, 523, 525

appeal fees, 493

Article 48(2) a) PCT, 505

assistants, 501, 507, 523

cause of non-compliance, 496, 497, 498, 499

change of representative, 511

claims fees, 504

communication under Rule 69(1) EPC 1973, 497, 498, 499, 508

competence in interlocutory revision, 495

competence of the boards of appeal, 495

deficiencies of request, 502

delivery of mail, 528, 530

designation fees, 504

designation of states, 491, 509, 654

devolutive effect, 495

divisional application, 491, 492

due care, 496, 498, 508, 509, 513, 514, 530

effective system of staff substitution, 512, 515, 517

electronic filing of documents, 515

EPC 2000, 490-491, 495, 504

error of the Office, 533

evidence, 502, 507, 508, 524

fee-monitoring system, 511

fees for re-establishment of rights, 496

financial difficulties, 508

further processing, 490, 504

holiday, 527

illness, 498, 511, 515, 516, 520, 527

independent cross-check, 516, 532

insolvency, 530

interpretation of the EPC, 521

interruption of proceedings, 508, 530

Japanese patent attorney, 518

large firms/companies, 516, 517

late submission, 507

legal certainty, 493, 500

legal error, 509, 510, 521, 523

legal fiction of deemed notification, 499

loss of rights, 492, 527, 590

merit of application, 502, 507-529

monitoring time limits, 507, 512, 514

national basic fee, 504

national law, 492

omission of acts, 492, 501

opposition fees, 493

opposition period, 493

parties to proceedings, 506

PCT time limits excluded, 504, 948

period of grace, 504

petition for review under Art. 112a EPC, 496

- principle of equal treatment, 493
- principle of proportionality, 517, 526, 530-532
- priority period, 490, 496, 503
- procedural economy, 494
- protection of legitimate expectations, 430-434, 436, 502, 522
- protection of the general public, 505
- public interest, 491, 529
- reference in the register of patents, 529
- refund of fee, 532
- renewal fee payment agency, 498
- renewal fees, 498, 508, 511, 519, 520
- representatives, 497, 513
- responsibility of the representative, 527, 528
- right to be heard, 507
- rights of use, 529
- search fees, 504
- small firms/companies, 514, 515
- statement of grounds of appeal, 492, 495, 501, 509, 513, 521
- substantial procedural violation, 494
- supervision of assistants, 513, 514, 524, 526, 528
- system for monitoring time limits, 510, 511, 512, 513, 515, 516, 522, 523
- tactical considerations, 509
- takeover, 511
- time limit for appeal, 493
- time limit for requesting further processing, 504
- time limits, 491, 495-500, 502, 505, 508-509, 514, 521, 876
- time limits excluded, 503-505
- transfer, 499, 632
- Reference to common general knowledge, 403**
- Referral to the Enlarged Board of Appeal, 17, 20, 145, 297, 302, 311, 435, 878-881**
- Rules of procedure of the boards of appeal, 1041
- Referrals to the Court of Justice of the European Communities under the EC Treaty - legal status of the EPO boards of appeal, 954**
- Reformatio in peius**
- amended claims in appeal proceedings, 904
- appeal proceedings, 828, 829, 830, 831, 832
- Reformulation of the technical problem, 171, 172, 194, 195, 318**
- Refusal of a European patent application (Article 97(1) EPC), 679**
- Refusal of oral proceedings, 454**
- Register of legal practitioners, 575**
- authorisation, 576
- competence of Legal Division, 576
- Register of Patents, 631-632**
- Registrar**
- protection of legitimate expectations, 427, 428, 431, 522, 523
- Rules of procedure of the boards of appeal, 1035
- Rules of procedure of the Enlarged Board of appeal, 1028
- Registration of licences, 631**
- Regulation on Plant Variety Rights**
- exceptions to patentability, 43, 48
- Reimbursement of appeal fees, 826, 907-930**
- absence of a request, 908
- allowability of the appeal, 907, 909
- appeal allowed only in part, 909
- competence of Boards of Appeal, 928
- competence of formalities officers, 925
- composition of opposition division, 593
- conditions, 908, 909
- discretion, 928
- distinction between existence and admissibility of an appeal, 908
- draft decision, 924
- equity, 907-912, 929
- error of judgment, 914, 921
- error of judgment by a department of first instance, 615
- examination proceedings, 616
- exercise of discretion, 915, 916
- filing of the request, 928
- formalities officer not entitled, 925
- former member of the boards of appeal, 925
- inadmissibility of the appeal, 908, 909
- incomplete reasons, 921
- interlocutory revision, 876, 907, 928
- legitimate expectations, 909
- missing receipt, 913
- not equitable, 910
- oral proceedings, 913

protection of legitimate expectations, 910
 right to be heard, 454, 914, 929
 statement of grounds of appeal, 909
 substantial procedural violation, 616, 876, 877, 907, 912-928
 suspensive effect, 923
 withdrawal of the appeal, 908, 909, 910

Relationship between Article 123(2) and Article 123(3) EPC, 366-369

Relationship between Articles 83 and 84 EPC, 245-250

Remittal, 744, 817, 862-869, 870, 871, 1037

appeal proceedings, 862, 864 865
 exercise of discretion, 868
 oral proceedings, 459, 460
 resumption of proceedings, 460
 substantial procedural violation, 593, 867, 923

Renewal fees

re-establishment of rights, 498, 508, 511, 519, 520
 time limits, 483, 490

Representation, 571-590

abogado, 575
 applicants not having residence or place of business within a contracting state, 572
 association of representatives, 583
 authorisation, 575, 576, 577, 579-583
 common opponents, 578
 common professional representative, 577-579
 disclosure by a technical expert, 585
 discretion, 577, 584
 distinction between inventor and patent proprietor, 586
 extent of powers, 581
 filing of authorisation, 579
 former members of the boards of appeal, 588
 general authorisation, 580
 grandfather clause, 571
 joint appeals, 578
 joint oppositions, 578
 legal practitioners, 574-577
 list of professional representatives, 572, 574, 575
 multiple opponents, 770
 national law, 576
 national patent office, 575
 official communication to the applicant, 580

oral proceedings, 464, 584
 oral submissions by accompanying person, 583-589
 oral submissions by patent lawyers of non-EPC contracting states, 589
 patent attorney, 576
 person not entitled, 579
 place of business, 577
 procedural steps, 574
 professional representatives, 572-574
 protection of legitimate expectations, 581
 register of legal practitioners, 575
 sub-authorisation, 582
 transitional period, 573

Representatives

advertising, 944
 American, 517
 appointment of a common, 844
 association of, 583
 authorisation, 498, 844
 common professional representative, 844
 common representative, 577
 disciplinary measures (see Disciplinary measures), 943
 disclosure by a technical expert, 585
 extent of powers, 580
 invalid acts, 579
 legal practitioner, 574, 933
 list of professional representatives, 574, 931, 932
 non-EPC contracting states - legal capacity, 488
 notifications, 635
 official communication to the applicant, 580
 procedural steps performed by another person, 573, 574
 re-establishment of rights, 497, 513

Reproducibility, 230, 231

biotechnology, 244
 claims supported by the description, 246, 278
 industrial application, 224
 post-published document, 238
 state of the art, 99, 103, 104, 106, 107, 108
 sufficiency of disclosure, 229, 234, 236, 242, 244, 250
 undue burden, 99, 103, 104, 236, 249

Request

failure to clarify, 426, 452, 459

- further oral proceedings, 458
- mistaken interpretation, 451
- oral proceedings, 453, 454, 455-460, 463, 665, 675, 677, 913
- revocation of patent, 448, 737
- telephone conversations, 471
- Request for examination**
 - examination proceedings, 658-661
- Request for oral proceedings, 455-460**
 - abandonment, 458
 - doubts, 459
 - new citations, 458
 - remittal, 460
 - right to be heard, 444, 675, 677
 - withdrawal of request for oral proceedings, 457
- Res judicata, 619, 722, 842, 870, 877, 881**
 - examination proceedings, 698
- Research**
 - biotechnology, 178, 183, 184
- Reservation under Art. 167(2)(a) EPC, 798**
- Review of first-instance discretionary decisions, 838**
- Review proceedings, 1026**
- Revision Act**
 - EPC, 650
- Revocation of patent, 830**
 - appeal proceedings, 737
 - opposition proceedings, 445, 737, 818
- Revocation proceedings, 493**
- Revolutionary inventions**
 - industrial application, 224
- Right to a decision**
 - decisions of EPO departments, 590
- Right to a European patent, 643, 651**
- Right to be heard, 438-453, 826**
 - amended claims in appeal proceedings, 894
 - clear request, 451
 - composition of opposition division, 446
 - decisions of EPO departments, 610
 - European qualifying examination, 941
 - evidence, 438, 439, 440, 444, 445, 447
 - examination proceedings, 442, 443, 444, 445, 453, 679
 - expiry of a time limit, 442
 - fair procedure, 438, 439
 - final decision, 443
 - forfeiture, 443, 679
 - inadmissible oppositions, 459
 - International Preliminary Examining Report, 439, 921
 - interpretation of requests, 684
 - legal certainty, 448
 - minutes, 443
 - new grounds, 448
 - observations by the parties, 444
 - opportunity to make comments, 438, 439, 442, 443, 444, 445, 446, 450, 460, 914, 916
 - opposition proceedings, 442, 443, 444, 446, 453, 809-817
 - oral proceedings, 441-447, 452, 454, 455, 461, 467
 - order of requests, 452, 453
 - patent in the text agreed to, 450, 451-453, 915
 - principle of equal treatment, 439
 - procedural economy, 450
 - procedural violation, 438, 440, 446, 451, 452, 453, 470, 675, 679, 684
 - provisional opinion in opposition proceedings, 816
 - reasons for the decision, 438, 446, 447, 914
 - re-establishment of rights, 507
 - reimbursement of appeal fees, 454, 914, 929
 - request for oral proceedings, 444
 - single communication, 443
 - timing of decisions, 442, 924
 - witness, 918
 - witness declaration, 439
- Right to oral proceedings, 444, 453-455, 459, 665**
- Rights of parties under Article 107 EPC, 826**
- Rights of use**
 - re-establishment of rights, 529
- Risks to the environment, 39, 40**
- Routine experiments**
 - inventive step, 178, 183, 212
- Rules common to all proceedings before the EPO, 425-438**
- Rules of Procedure of the Boards of Appeal, 595, 1033**
 - amended claims in appeal proceedings, 889
 - institutional matters, 952
 - late submission, 701

Rules of Procedure of the Enlarged Board of**Appeal, 1025**

official language, 1028

Rules relating to fees, 312, 533-537

time limits, 479

S

Sale

availability to the public, 76, 102

Sale for test purposes

availability to the public, 81

Same purpose or effect, 164**Satisfaction of a long felt need, 217**

inventive step, 214, 217

Scientific theories

technical inventions, 1, 11, 12-14

Scope of the claim

support by the description, 277

Search fees

re-establishment of rights, 504

unity of invention, 292, 299, 300, 301, 311-314, 668

Search report, 659, 660, 745

unity of invention, 298, 300, 311, 312

Second (or further) medical use, 136-152, 294

administration regimen, 140, 144, 145

concept of therapeutic application, 141, 144, 145, 148

medical device, 140, 150

mode of administration, 149

novelty, 144

Second (or further) non-medical use, 152-161

Enlarged Board of Appeal, 152

novelty, 152-161

Secondary indicia (see also Inventive step),**184, 201, 213-222**

industrial application, 227-228

Secrecy

inspection of files, 629, 630

non-prejudicial disclosures, 69

Selection from generic disclosure, 409**Selection inventions, 108, 115, 117-133****Selection of most promising starting point, 166****Selection of parameter ranges, 127-133****Selective breeding, 40, 43, 46****Self-collision, 99**

prior European rights, 65

Shipyard

availability to the public, 87

Signature, 539, 774

decisions of EPO departments, 592, 615, 617

on a decision, 615

Silence

oral proceedings, 457

Similarity of the technical problem, 165**Simple solution**

inventive step, 176, 205, 219

Simplification of complicated technology

inventive step, 212

Single general inventive concept

unity of invention, 293, 297, 301, 303, 304-311

Skilled person, 31, 180-184, 251, 306

biotechnology, 182, 183, 243

computer-implemented inventions, 184

inventive step, 163, 177, 180-188, 190, 191, 198, 205, 214

level of knowledge, 66, 186, 191

priority, 403, 408

state of the art, 66, 93, 97, 106

sufficiency of disclosure, 186, 224, 235, 236, 240, 246

team of experts, 180-184, 192

Small amount lacking, 536**Small firms/companies**

re-establishment of rights, 514, 515

Snackfood decision

priority, 401

Software

technical character, 5, 24

Standard of proof

amendments, 373

availability to the public, 88

Standards working party

availability to the public, 83

Starting substances, 108, 118, 119, 120, 121, 122, 126, 128, 295**State of the art**

accidental disclosure, 106, 107

broad claims, 105

combinations within a prior art document, 96

content, 92-109

defining, 64-92

- determination of the closest, 163, 168
- disclosure, 64, 65, 92-109, 121
- drawings, 100
- equivalents, 99
- European prior rights, 65
- examples, 101, 128
- general rules of interpretation, 93
- generically defined group, 133
- implicit features, 97
- in-house knowledge, 66, 167
- international application, 65, 297, 298, 301, 304, 305, 306, 307, 310
- intrinsic features, 99, 104
- inventive step, 163-170
- late submission, 704, 717
- mistakes in a disclosure, 105, 108
- most promising starting point, 165
- national prior rights, 68
- non-prejudicial disclosures, 68
- outdated technology, 168, 169
- overlapping ranges, 108, 129, 132
- PCT applications, 65
- prior use, 74, 85, 86, 87, 92, 102, 105, 107
- priority, 420
- reimbursement of appeal fees, 922
- relevant point in time, 64
- reproducibility, 99, 103, 104, 106, 107
- same purpose, 164, 167
- selection inventions, 108
- similarity of technical problem, 106, 107
- two-part claims, 275
- unambiguous disclosure, 92, 95, 96, 97, 100, 124
- State of the art (see also Availability to the public), 64, 69, 190**
- Statement of purpose**
- second medical use, 150
- Statements by third parties, 1029**
- Statutory declaration, 547**
- Stem cell cultures**
- exceptions from patentability, 41
- Straw man**
- opposition proceedings, 767
- Structural similarity**
- inventive step, 164, 202
- Sub-authorisations, 582**
- Subject-matter under examination**
- opposition appeal proceedings, 832
- Substantial procedural violation (see Procedural violation), 877, 912-928**
- Substantiation of EQE decisions, 937**
- Substantive examination of the application, 661-681**
- Substitution of materials - analogous use, 200**
- Successor in title**
- priority, 398
- Sufficiency of disclosure, 108, 224, 229-251**
- application as a whole, 229, 248, 276, 277
- availability to the public, 231
- balance of probabilities, 250
- biotechnology, 37, 239-245
- broad claims, 233, 247
- chance, 242
- clarity and completeness of disclosure, 239-243
- common general knowledge of the skilled person, 229, 230, 234, 235, 237, 240
- evidence, 224, 250
- examples of the invention, 231, 241, 242, 251
- fundamental scope of the invention, 235, 248, 250
- knowledge of the skilled person, 186, 229-231
- method for measuring, 247
- micro-organisms, 240, 242, 243, 244
- oncogene, 37
- parameters, 247
- patent specifications, 230
- priority, 235, 415, 418
- reference to another document, 230, 231
- relationship between Article 83-84 EPC, 245-250
- relevant parts of the application, 229
- reproducibility, 229, 234, 236, 242, 244, 250
- support by the description, 245
- technical literature, 230
- undue burden, 236, 241, 244
- Summons to oral proceedings, 894, 1028, 1036**
- Supervision**
- assistants, 513, 514, 524, 525
- Surprising effect**
- bonus effect, 219
- inventive step, 219

Surrender of the patent, 739, 833
Suspected partiality, 594-603, 840, 925
Suspension of first-instance proceedings following referral to Enlarged Board, 881
Suspension of the proceedings, 825, 881
Suspensive effect
appeal proceedings, 634, 822
reimbursement of appeal fees, 923
Swiss-type-Claim, 136, 138, 140, 141, 143, 148, 149, 151, 155, 237
Switzerland
patent law, 68
Sworn statement, 547, 557
System for monitoring time limits
re-establishment of rights, 510, 511, 512, 513, 515, 516, 522, 523

T

Takeover of a company
re-establishment of rights, 511
Taking of minutes, 474
Talk
availability to the public, 73, 76
Teaching of examples
availability to the public, 96
Team of experts, 180-184, 192
Technical and non-technical features, 170
computer-implemented inventions, 9
inventive step, 188-196
technical character, 26
technical effect, 191, 192, 193
Technical character of the invention, 223
claims, 12
computer programs, 20, 30
computer-implemented inventions, 188, 191
conditio sine-qua-non, 2
exclusion from patentability, 2, 4, 5
inventive step, 22, 188, 194
non-technical information, 26
presentation of information, 15, 33, 35
technical and non-technical features, 26
technical effect, 5, 10
technical inventions, 3, 7
technical problem, 5, 15
word-processing, 30

Technical contribution, 4, 10, 33, 34, 176, 223, 317, 327-331
addition or deletion of a feature, 327
computer-implemented inventions, 21
inventive step, 162
Technical disclosure in a prior art document, 199
Technical effect
inventive step, 164, 171, 172, 174, 175
novelty, 99, 104, 129, 144, 149, 150, 153, 154, 155, 158, 160
patentable inventions, 20
technical and non-technical features, 8, 191, 192, 193
technical character, 5, 10, 15
Technical expert
oral disclosure, 585, 586
Technical feature
definition, 252
Technical inventions, 1-10
technical character of the invention, 3, 7
technical considerations, 31
word-processing, 30
Technical journal, 187
availability to the public, 72, 88
Technical prejudice, 214
Technical problem, 170-176
alternative solution to a known problem, 175
artificial and technically unrealistic, 172
computer-implemented inventions, 5, 19, 22
determination of the technical problem, 170
formulation, 29, 169, 170, 171, 182, 194
infringement of Article 123(2) EPC 1973, 173
inventive step, 162, 163, 192
methods for doing business, 28
presentation of information, 34
reformulation of the technical problem, 171, 172, 194, 195
similarity of technical problem, 165
technical character, 5, 15
unity of invention, 295, 297, 301, 302, 304, 307, 309
word-processing, 30
Technical progress
inventive step, 162, 170, 171
Technical relationship among inventions, 308

Technical teaching (see Teaching), 246**Technically non-functional modifications**

inventive step, 200

Telefax, 528

protection of legitimate expectations, 433

Telephone conversations

examination proceedings, 614, 618, 673, 676, 914

Termination of appeal proceedings, 873-875**Termination of opposition appeal proceedings, 739**

lapse of a patent, 739

Tests for the assessing allowability of an amendment, 346-355**Textbooks**

sufficiency of disclosure, 186, 230

Therapeutic effect

medical methods, 57, 58, 59

Therapeutic methods

medical methods, 55

Time limit for appeal

non-prejudicial, 428

re-establishment of rights, 493

Time limits, 478-490, 951

application of Rule 142 EPC by the EPO of its own motion, 485

calculation, 478-484, 500, 521, 530

consequences of interruption of proceedings, 489

designation fees, 483

EPC 2000, 479

examination fees, 489

expiry date, 478

extension, 479, 480-482, 485, 522, 1039

fiction of observance of a time limit, 482-484

filing and search fees, 647

further processing, 478-490, 636, 653

interruption in the delivery of mail, 480

interruption of proceedings, 478-490

interruption of proceedings because of insolvency, 488

legal incapacity, 485

national holiday, 483

non-extendable, 441

period of grace, 482-484, 948

postal interruptions outside contracting states, 481

priority, 478, 654

re-establishment of rights, 491, 495-500, 502, 503, 505, 508-509, 514, 521, 876

reimbursement of fees for further processing, 485

renewal fees, 483, 490

Rules of procedure of the boards of appeal, 1038, 1039

Rules relating to fees, 479

start of the time limit, 478, 496

translation, 628

Title of the invention, 773**Trade mark**

clarity of claims, 253

Transfer

European Patent Register, 631

re-establishment of rights, 499, 632

Transfer of opponent status, 729

evidence, 731, 732, 733, 736

trade register, 736

universal succession, 730, 733, 734, 736, 737

validity, 734

Transfer of party status, 736**Transgenic animals, 37, 39, 44, 45****Transgenic plants, 39, 40, 43, 46, 48, 49****Transitional provisions, 483, 484, 1043****Translation, 316, 627, 645, 727, 853**

international application, 315

language privilege, 628

reimbursement of appeal fees, 908

time limits, 628

Travaux préparatoires

EPC, 488, 639

unity of invention, 301

Treatment by therapy

medical methods, 55, 57, 58, 59

TRIPS Agreement, 7, 50, 397, 639-641, 868, 927

Agreement on Trade-related Aspects of Intellectual Property Rights, 639

judicial review of decisions, 639

U

UK Patents Act

right to a European patent, 643, 644

Undue burden

availability to the public, 67, 68, 71, 103, 104
biotechnology, 244
clarity of claims, 254, 262, 263, 266, 270
conciseness of claims, 270
knowledge of the skilled person/s, 67, 68
sufficiency of disclosure, 236, 241, 244
support by the description, 278

Unitary subject matter

manufacturing process and products, 308
screening process and products, 308

Unity in the context of different types of claims, 293**Unity of invention, 292-314**

a posteriori, 295, 297, 298, 299, 300, 302, 305, 309, 310, 313
a priori, 297, 305
administrative instructions under the PCT, 297
chemical inventions, 294, 295, 296
clarity of claims, 302
Committee for Technical Cooperation, 298
dependent claim, 295
divisional application, 312
examination proceedings, 299, 668
functional relationship of compounds, 311
independent claims, 293, 294, 295, 305
intermediate compound, 307
intermediate products, 295, 296
International Preliminary Examining Authority (IPEA), 298, 302
International Searching Authority (ISA), 297, 298, 302, 303, 313
inventive nature, 306
inventive step, 172, 298, 299, 302, 306, 307
Markush claims, 309
national patent law, 298, 299
novelty, 298, 299, 302
opposition proceedings, 301
parent application, 311
problem and solution approach, 294, 301, 303
process claims, 294, 305, 307, 308
product claim, 293, 294
search fees, 292, 297, 299, 300, 301, 311-314
search report, 298, 300, 311, 312, 668
single general inventive concept, 292, 293, 296, 297, 301, 303, 304-311
structural relationship of compounds, 311

technical problem, 295, 297, 301, 302, 304, 306, 307, 309
technical relationships, 293, 296, 297, 302, 303, 305, 306, 307, 308, 309, 310
travaux préparatoires, 301
use claims, 293, 294

Unity of single claims defining alternatives (Markush claims), 309**Unity of the European patent application, 638****Universal succession**

opposition proceedings, 730, 733, 734, 736, 737

UPOV Convention

exceptions to patentability, 43, 48

Use

novelty, 104, 145

Use claims, 251, 261

amendments, 362, 363
industrial application, 228
novelty of use, 144, 148, 149, 150, 152
unity of invention, 293, 294

Utility models

priority, 398, 421

V

Vaporiser

availability to the public, 102

Venire contra factum proprium

protection of legitimate expectations, 427, 434

Veterinary medicine

medical methods, 50

Viagra

inventive step, 215, 218

Vienna Convention on the Law of Treaties, 638, 641, 728**Volenti non fit iniuria**

late submission, 714

W

Withdrawal of request for oral proceedings, 457

apportionment of costs, 753

Withdrawal of the appeal, 873

apportionment of costs, 757
intervention, 874
reimbursement of appeal fees, 908

Withdrawal of the application

search fees, 503

Withdrawal of the opposition, 718-719

appeal proceedings, 718

apportionment of costs, 719, 757

Withdrawal of the opposition during appeal proceedings, 718

Witness, 550, 553, 554, 557

right to be heard, 439, 918

Word-processing

technical character, 30

World Trade Organization (WTO), 640