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of the Boards of Appeal
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FOREWORD

Over a period of more than fourteen years (the first decision of a Board of Appeal of the EPO was reached on 1 March 1979 (J 2/78, OJ 1979, 283)) a substantial body of case law on the European Patent Convention has developed. The Boards of Appeal have decided on questions of substantive patent law and procedural law in more than 5000 cases. Thirty decisions or opinions of the Enlarged Board of Appeal have clarified legal points of fundamental importance in order to ensure a uniform application of the law.

The Boards of Appeal have contributed to the development of European patent law by their decisions. A glance at the case law shows that they endeavoured to help give inventions appropriate protection as well as to do justice to the demand for legal certainty and speedy processing of proceedings.

Since 1987 a report summarising the important decisions of the Boards of Appeal of the EPO has been published as a special edition of the Official Journal. These reports were intended to draw attention to new developments and make access to the current case law of the Boards of Appeal easier. Six of these reports have now been produced. Thus there is sufficient reason to summarise, reorganise and condense the extensive material, in order to highlight the major strands of the interpretation of the EPC by the Boards of Appeal.

The Legal Research Group of Directorate – General 3 has revised the Case Law Reports from 1987 to 1992 and now included leading earlier decisions. Some important decisions from the first half of 1993 could also be taken into account.

I would like to thank all colleagues at the EPO who helped to complete this report, particularly the members of the Legal Research Group of Directorate – General 3 and the translators, whose active support rendered possible the simultaneous publication in the three official languages of our Organisation.

May this report give all those who have an interest in the European patent system an insight into important areas of patent law. I hope that patent applicants and their representatives in particular, but also colleagues of the EPO will find this publication useful.

Paolo Gori

Chairman of the Enlarged Board of Appeal

Vice-President of the EPO

Reader's Guide

1. List of Abbreviations

Art.	Article of the European Patent Convention
Budapest Treaty	Budapest Treaty on the International Recognition of the Deposit of Micro-organisms
Contracting States	Contracting States to the European Patent Convention
EC	European Community
EPC	European Patent Convention
EPI	European Patent Institute (Institute of Professional Representatives before the EPO)
EPO	European Patent Office
Guidelines	Guidelines for Examination in the EPO
IPEA	International Preliminary Examination Authority
ISA	International Search Authority
OJ	Official Journal of the EPO
Paris Convention	Paris Convention for the Protection of Industrial Property
PCT	Patent Co-operation Treaty
R.	Rule of the Implementing Regulations to the Convention on the Grant of European Patents
RFees	Rules relating to Fees
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organisation

2. Citations

a) Articles and Rules of the EPC are cited without adding "EPC" unless the context requires (e.g. Art. 114).

b) The Official Journal of the EPO is cited as OJ with year of publication and page (e.g. OJ 1993, 408).

c) 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 Annexes 1, 2 and 3 the bibliographic data of all cited decisions (i.e. reference number, the Board which took the decision, the date of the decision, and – where applicable – the citation in the OJ) are listed.

d) The citation "**Case Law Report 19..**" refers to the case law of the Boards of Appeal of the EPO in the year 19.. (for example, EPO Board of Appeal Case Law in 1992, published as a supplement to the Official Journal of the EPO in 1993).

3. Notes on the case numbers of Board of Appeal decisions

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

- G Decisions of the Enlarged Board of Appeal
- J Decisions of the Legal Board of Appeal
- T Decisions of a Technical Board of Appeal
- W Decisions of a Technical Board of Appeal in protest cases under R. 40.2 PCT
- D Decisions of the Disciplinary Board of Appeal.

The number before the oblique is a **serial number** which is allocated in numerical order on receipt of the appeals in Directorate-General 3 of the EPO (Boards of Appeal); the last two numbers of the case number refer to the **year of receipt** of the appeal by Directorate-General 3.

I. PATENTABILITY

European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.

A. Patentable inventions

Art. 52(2) contains a non-exhaustive list of things which shall not be regarded as inventions. It will be noted that the exclusions on this list are all either abstract (e.g. discoveries, scientific theories etc.) or non-technical (e.g. aesthetic creations or presentations of information). Art. 52(4) provides that methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application.

1. Technical nature of invention

An invention must have a technical character or, in other words, must provide a technical contribution to the art. In particular, this requirement is not met if the patent application or the patent relates to mathematical methods, rules and methods for performing mental acts or doing business, presentation of information or computer programs **as such** (see Art. 52(2), (3)).

1.1 Computer-related inventions

The non-patentability of computer programs **as such** does not preclude the patenting of computer-related inventions. However, the real **technical contribution** to the state of the art which the subject-matter claimed (which may also be defined by a mix of technical and non-technical features), considered as a whole, adds to the known art should be ascertained.

Decision **T 208/84** (OJ 1987, 14) set out the principles governing the patentability of computer-related inventions. 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**. 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**.

The next leading case, 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 makes use of both technical and non-technical means, the use of non-technical means does not detract from the technical character of the overall teaching. The EPC 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 relates to a computer program as such. If the invention defined in the claim uses technical means, its patentability is not ruled out by Art. 52(2)(c) and (3) EPC and it can be protected if it meets the requirements of Art. 52 to 57 EPC.

In decision **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 are not concerned with the nature of the data and the way in which a particular application program operates on them, is to be regarded as solving a problem which is essentially technical. The control program is therefore comparable to the conventional operating programs required for any computer to co-ordinate its internal basic functions and thereby permit the running of a number of programs for specific applications. Such an invention is to be regarded as solving a problem which is essentially technical and thus an invention within the meaning of Art. 52(1).

In decision **T 158/88** (OJ 1991, 566) the Board stated that a method for the display of characters (e.g. Arabic characters) in a particular preset shape chosen from several possible character shapes did not in essence describe a technical method of operating a data-processing system and its visual display unit, but an idea for a program.

A computer program does not become part of a technical operating method if the teaching claimed is confined to changing data and does 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 conclusion that where the data to be processed according to a claimed method represents neither operating parameters nor a device, nor has a physical or technical effect on the way the device works, and no technical problem is solved by the claimed method, the invention defined in the claim does not make use of any technical means and in accordance with Art. 52(2)(c) and (3) EPC cannot be regarded as a patentable invention within the meaning of Art. 52(1) EPC.

1.2 Word processing

Decision **T 115/85** (OJ 1990, 30) related to 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 may occur in the input-output device of a word-processing system which also includes a keyboard, a display and a memory.

The Board observed that giving visual indications automatically about conditions prevailing in an apparatus or a system is basically a technical problem. The application proposed a solution to such a 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** (see also I.A. 1.1): 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 does not follow from this that conversely a computer program can 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) and (3).

In decision **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). 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 does not import any technical considerations and can 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 decision **T 38/86** (OJ 1990, 384) the Board of Appeal first of all had to assess the patentability of a method for automatically detecting and replacing linguistic expressions which exceeded a predetermined understandability level 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); the schemes, rules and methods used in performing such mental acts are not inventions within the meaning of Art. 52(1). 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, may, having regard to Art. 52(3), render such a method a technical process or method and therefore an invention within the meaning of Art. 52(1). Since patentability is excluded only to the extent to which the patent application relates to excluded subject-matter or activities as such, it appears to be the intention of the EPC to permit patenting in those cases in which the invention involves 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. In the case of a claim for an apparatus (here, a word-processing system) for carrying out a method which does not specify any technical features beyond those already comprised in a claim pertaining to said method and furthermore does 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 does not contribute anything

more to the art than the method; in spite of the fact that the claim is formulated in a different category, in such cases, if the method is excluded from patentability, so is 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).

In its decision **T 65/86** the Board of Appeal applied the same case law to the subject-matter of a claim relating to a method for automatically detecting and correcting contextual homophone errors in a text document. The Board was of the opinion that detection and correction of homophone errors by a person involves purely mental acts which are not an invention within the meaning of Art. 52(2)(c). In this case, the method claimed did not appear to involve an inventive step; the implementation of the technical means to be used involved no more than the straightforward application of conventional techniques and therefore had to be considered obvious to a person skilled in the technical art; the overall effect of the method claimed was that the signals representing one linguistic expression were replaced with signals representing another linguistic expression; the signals differed only in that they represented different linguistic expressions, which were purely abstract expressions without any technical significance; the overall effect of the method was thus non-technical (see **T 107/87**, Case Law Report 1991, p. 12).

The patentability of computer-related inventions was again considered in decision **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 falls into the category of schemes, rules and methods for performing mental acts which under Art. 52(2)(c) and (3) are 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 – does not import any technical considerations, even if those steps are described as functions or functional means to be implemented with the aid of conventional computer hardware elements.

In **T 110/90** 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 are characteristic of the word-processing system in which they occur in that they are characteristic of the technical internal working of that system. Such control items therefore represent technical features of the word-processing system in which they occur.

Consequently, transforming control items which represent technical features belonging to one word-processing system into those belonging to another word-processing system constitutes a method of a technical nature.

If a method of transforming text represented as digital data – whereby a source document, cast in a first editable form including a plurality of input control items, is transformed into a target document, cast in a second editable form including a plurality of output control items compatible therewith – is implemented by an appropriately programmed computer, the steps in that method represent the algorithm on which the computer program is based rather than a computer program as such and the program must be considered to be the technical means for carrying out the (technical) method (following decision **T 208/84**, OJ 1987, 14).

1.3 Presentation of information

In decision **T 163/85** (OJ 1990, 379), regarding a colour television signal characterised by technical features of the system in which it occurs, 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, may fall under the exclusion of Art. 52(2)(d) and (3), but not a TV signal defined in terms which inherently comprise the technical features of the TV system in which it occurs; as the list of exclusions from patentability summed up in Art. 52(2) in conjunction with Art. 52(3) is not exhaustive in view of the phrase “in particular” in the first line of paragraph 2, the exclusion might arguably be generalised to subject-matter which is essentially abstract in character, non-physical and therefore not characterised by technical features within the meaning of R. 29(1).

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 does not constitute a technical feature indicating that an object or device is entirely or partly covered by that colour; however, the Board did not rule out the possibility that this does not hold in all circumstances. The feature taken by itself may not seem to reveal any technical aspect, but its technical or non-technical character could be decided by the effect it brings 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)) 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).

In decision **T 603/89** (OJ 1992, 230) the invention consisted of an apparatus for and a method of learning how to play a keyboard instrument, with numbers corresponding to notes on a sheet of music appearing on the keys too. The technical feature claimed was the marking of the keys. Patentability was ruled out by Art. 52(2)(c) and (d). Since the key markings were merely known technical features, the contribution made by the claimed invention to realising 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.

1.4 Lack of technical character in general

As already stressed in previous decisions, an invention must be technical in character, i.e. it must solve a technical problem to be patentable under Art. 52 EPC.

In **T 854/90** the Board of Appeal ruled that a method for operating an electronic self-service machine (e.g. a cash dispenser) which could be accessed using any machine-readable card 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 were the methods for doing business as such.

In **T 636/88** Claim 1 was for a method of bagging material transported in bulk by ship; a weighing and bagging apparatus was mounted on the quayside which could be shipped in standard containers and was used to unload and bag the material before moving to the next port. The Board took the view that the method claimed clearly did have a technical character, involving as it did the use of technical equipment (bagging apparatus) to achieve a technical end (production of sealed, weighted bags of the material in question). It also necessitated the use of bagging apparatus which had no counterpart in the prior art.

In **T 222/89** the Board found that where the sole characterising feature lacks causal significance for achieving the invention claimed, it does not constitute patentable technical teaching. The Board thus followed **T 192/82** (OJ 1984, 415) which had ruled that the amending feature must not only characterise the invention, i.e. distinguish it from the prior art, but also – if the invention consists of altering known subject-matter to enhance its known effect – make a causal contribution to improving that effect. In the claim for optimising the design of a piston drive, the Board considered the sole characterising feature not to be a technical feature which caused the improvement but rather a description of the desired configuration in geometric terms since the optimisation would require design ideas other than the teaching as per the claim.

2. Medical methods

2.1 Therapeutic methods

Art. 52(4) not only excludes methods of surgery from patentability but also “methods for treatment of the human or animal body by ... therapy”.

2.1.1 Definition

The Boards have clarified the meaning of the term “therapy” in several decisions. The first definition of the term was given in **T 144/83** (OJ 1986, 301). According to that 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.

In decision **T 81/84** (OJ 1988, 207) the Board confirmed that irrespective of the origin of pain, discomfort or incapacity (in this case menstrual discomfort), its relief, by the administration of an appropriate agent, is to be construed as therapy or therapeutic use within the meaning of Art. 52(4).

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).

According to decision **T 774/89** the purpose of therapy is 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 takes as its starting point a normal state (to be defined).

2.1.2 Characterising features of a therapeutic method

In **T 245/87** (OJ 1989, 171) the Board ruled that a method does not fall under the scope of the first sentence of Art. 52(4) if there is no functional relationship, and hence no physical causality, between operations effected using a therapeutic apparatus and the therapeutic effect produced on the organism by that apparatus.

The circumstances under which a method is used have no bearing on its therapeutic status. In **T 116/85** (OJ 1989, 13) the Board took the view that a claimed method is excluded from patentability within the meaning of Art. 52(4), if it renders the therapeutic treatment of animals necessary, even though the therapeutic treatment of animals is commonly an aspect of agriculture and agricultural methods in general are potentially patentable subject-matter. 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 is an industrial activity and when carried out by a veterinarian is a therapeutic treatment not patentable under Art. 52(4).

In **T 426/89** (OJ 1992, 172) the Board was of the opinion that an actual operating method for a pacemaker for arresting a tachycardia is necessarily a method for treating the human (or animal) body by therapy using a pacemaker, and is not patentable. However, if the claim refers to steps which do not define a method of treatment but rather, in functional terms, the structural features of a pacemaker, then the claim does not define a method but rather an apparatus (pacemaker) in terms of the functions of its components. Thus, Art. 52(4) does not prejudice the patentability of the subject-matter of the claim.

According to **T 780/89** (OJ 1993, 440) the successful secondary industrial application of a therapeutic treatment does not render it patentable. The claim in question related to a method of general immuno-stimulation 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.

2.1.3 Patentability of products with both therapeutic and non-therapeutic indications

A patent can be granted for the non-therapeutic use of a substance whose action is not solely therapeutic, provided that there is a clear distinction between the therapeutic and the non-therapeutic application. Here, the wording of the claim is crucial.

In **T 36/83** (OJ 1986, 295) 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 may also incidentally involve a medical treatment.

In the above-mentioned decision **T 144/83** the Board had 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 fact that a chemical substance had both these effects did not render the cosmetic treatment unpatentable, as the cosmetic treatment was distinguishable from the therapeutic effect.

In **T 290/86** (OJ 1992, 414), the Board took the view that whether or not a claimed invention is excluded from patentability under Art. 52(4) depends in particular on the wording of the claim in question. If the claimed use of a chemical product has always inevitably a therapeutic effect as well as a cosmetic effect the invention as claimed is necessarily defining a treatment of the human body by therapy and is not patentable.

In **T 774/89**, cited above, 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 into the claim of the term "non-therapeutic" served as a disclaimer, excluding the therapeutic effects of the medication.

2.2 Diagnostic methods

Under Art. 52(4) diagnostic methods are also excluded from patentability.

Decision **T 385/86** (OJ 1988, 308) examined exhaustively the circumstances under which exclusion from patentability is possible. The Board based its conclusions on two principles of interpretation of Art. 52(4). Art. 52(4), first sentence, represents an exception to the general obligation to patent inventions. It is therefore to be construed restrictively. Its purpose is to ensure that the doctor and veterinarian are not hampered in the exercise of their healing skills. In accordance with the first principle the only diagnostic methods to be excluded from patent protection are those providing results which immediately enable a decision to be taken on a particular line of medical treatment, i.e. methods containing all the steps required to make a medical diagnosis. In accordance with the second principle a method in which an interaction occurs with the human or animal body is susceptible of industrial application if it can be used with the desired result by a skilled person without medical knowledge or abilities.

The Board followed the same approach in **T 83/87** and **T 400/87**

B. Exceptions to patentability

1. Introduction

Several decisions have dealt with the exceptions to patentability and the problems of interpretation caused by Art. 53(a) and (b).

Decision **T 49/83** (OJ 1984, 112) sets out the general principle that "No general exclusion of inventions in the sphere of animate nature can be inferred from the EPC", and, in particular, Art. 52(1), Art. 53(b), R. 28 and R. 28a. However, decision **T 19/90** (OJ 1990, 476) states that there are sometimes "compelling reasons to consider the implications of Art. 53(a) in relation to the question of patentability". Another general

principle established by the Board of Appeal is that Art. 53(b) is an exception for certain kinds of inventions to the general rule under Art. 52(1) and any such exception must be narrowly construed (decisions **T 19/90** and **T 320/87**).

2. Patentability of plants

In decision **T 320/87** (OJ 1990, 71), the appellant had submitted claims relating to processes for rapidly developing hybrids and commercially producing hybrid seeds in general, together with product claims deriving from those processes, which were not submitted until the appeal proceedings. The Board first turned its attention to the concept of “essentially biological” processes; unlike the Examining Division, it was of the opinion that whether or not a (non-microbiological) process is to be considered “essentially biological” within the meaning of Art. 53(b) has 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. It further held that the necessity for human intervention alone is not a sufficient criterion for its not being “essentially biological”, as human interference may only mean that the process is not a “purely biological” process, without contributing anything beyond the trivial level, and it is further not a matter simply of whether such intervention is of a quantitative or qualitative character.

On the question of whether the products claimed were plant varieties, the Board adopted the case law established in decision **T 49/83** (OJ 1984, 112) and concluded that the hybrid seed (in question) and plants from such seed, lacking stability in some trait of the whole generation population, could not be classified as plant varieties within the meaning of Art. 53(b).

3. Patentability of animals

Decision **T 19/90** (OJ 1990, 476) aroused interest not only among those directly associated with patent law. The patent application was for a transgenic mouse which, as a result of the introduced gene, showed increased susceptibility to carcinogenic substances. The Board of Appeal ruled that the exception to patentability for animal varieties (“Tierarten” / “races animales”) under Art. 53(b), first half-sentence, has to be construed narrowly and applies to certain categories of animals but not to animals as such. Thus, product protection can in principle be granted for animals. To ascertain the object and purpose of the law (“ratio legis”) it is not merely a matter of the legislators’ intention at the time when the law was adopted, but also of their presumed intention in the light of changes in circumstances which have taken place since then. The Board also had no objection to a product claim for an animal containing the gene if it has been introduced into the animal itself or one of its ancestors. It is then a product-by-process claim which defines the product, irrespective of the process it refers to. The Board of Appeal thereby took an opposing view to that of the Examining Division which had ruled out protection of subsequent generations of transgenic animals on the ground that the claim was for a combination of a patentable process concerning the first generation and an essentially biological, and hence non-patentable, breeding process concerning the following generations.

The Board also held that an animal can enjoy protection as a product of a microbiological process. Contrary to the Examining Division’s view, the bar to patenting under Art. 53(b), first half-sentence, does not extend to the products of a microbiological process.

4. Inventions contrary to “ordre public”

Decision **T 19/90** is the only Board of Appeal decision dealing with Art. 53(a). While the Examining Division had argued that patent law is not the right legislative tool for regulating problems arising in connection with the genetic manipulation of animals, the Board was of the opinion that precisely in such cases there are compelling reasons to consider whether the publication or exploitation of the invention would be contrary to “ordre public” or morality (Art. 53(a)). Remitting the case to the Examining Division for further examination of this aspect, the Board invited it to weigh the animal’s suffering and the possible risks to the environment against the invention’s usefulness to mankind. In its decision (OJ 1992, 588) the Examining Division finally granted the patent, having carefully examined the risks and advantages of the claimed invention. Oppositions have since been filed.

C. Novelty

1. Disclosed content of prior publications

1.1 General remarks

1.1.1 Examination for novelty

In examining for novelty, the subject-matter of the application or patent as defined in the claims must be compared with the entire disclosure of the prior publication or of the whole content of an earlier European patent application (insofar as it designates the same Contracting States). A cited document destroys novelty if the claimed subject matter can be derived directly and unambiguously from it; features which are only implicitly disclosed in the cited document may nevertheless destroy novelty.

1.1.2 Equivalents

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 (**T 517/90**). This narrow concept of novelty, which excludes equivalents, is of particular importance for the application of Art. 54(3). In **T 167/84** (OJ 1987, 369) this is commented on as follows: conflicting applications within the meaning of Art. 54(3) are included in the state of the art solely from the point of view of novelty, but are considered in the light of their “whole contents”. In order to mitigate the harsh effects of the “whole contents approach”, its application is confined to novelty (see Art. 56, second sentence). Further, in order to reduce the risk of “self-collision”, it has always been considered justified to adopt a strict approach to novelty. For this reason C-IV, 7.2 of the Guidelines expressly states 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 considered that the “whole contents” of an earlier document do not also comprise features which are equivalents of features in the later document.

1.1:3 Entire disclosure of a prior art document

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 done by a person skilled in the art, and that it was not justified arbitrarily to isolate parts of the document in order to derive from it 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 electrons of a transmission ion chamber, in such a way that they partially lie 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.

In **T 500/89** it could also only be seen from the disclosure of the prior art document considered in its entirety that it did not destroy 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 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 method 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.

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 prior document did not destroy novelty because the latter did not contain a sufficiently clear teaching for that conclusion to be reached. The skilled person, by following the document’s teaching, is led in a direction clearly pointing him away from the claimed subject-matter because it states that the composition obtained does not comprise a component contained in the claimed compound. The subject-matter is new even if by reproducing the examples described in the 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 decision **T 305/87** (OJ 1991, 429) the Board considered it useful 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 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 is not permissible to combine separate items belonging to different embodiments described in one and the same document merely because they are disclosed in that one document, unless, of course, such combination has been specifically suggested therein. The two shears known from the catalogue were therefore definitely two separate entities forming two independent bases for comparison which should 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.

1.1.4 Relevant point in time

In considering the disclosure of a cited prior art document it is necessary to decide how the man skilled in the art at the application date or priority date respectively would have interpreted it. **T 74/90** illustrates how this principle is to be applied. The subject-matter of the patent was a double-seam closure between the body and base or lid of a metal can containing, for example, beer or perishable foodstuffs. The state of the art taught that to protect a double seam of this kind against microbial re-infection, or to enable it to withstand high internal pressure, it must be sealed with a sealing compound. The patent proprietor's claim was for a double seam offering the required seal without the aid of sealing material. Novelty was viewed as problematical as the document describing the closest prior art did not expressly mention the use of sealing material. Contrary to the Opposition Division the Board of Appeal took the view that the cited document did not destroy novelty. The Board pointed out that in the present instance, a report prepared by an expert witness, which had been requested by the EPO on behalf of the applicant, confirmed that the view of experts in the field on the priority date of the disputed patent was that the use of sealing material was essential, given the stringent requirements such a seal must meet. Because a reader skilled in the art would consider the prior publication in the light of his specialist knowledge, he would exclude theoretical interpretations from the outset, if his knowledge and experience led him to regard their implementation as impracticable, as would be the case, for example, if it seemed unlikely to prove a technical success. Because the invention had laid to rest the long-held prejudice that the application of sealing material to the seam was necessary to provide an effective seal in a metal can containing perishable foodstuffs or to withstand high internal pressure, the requirement laid down in Art. 56 was also held to have been met.

1.1.5 Implicit disclosure and inventive step

In the decisions **T 572/88** and **T 763/89** the Boards warned against using the concept of "implicit prior description" – which is relevant to the evaluation of inventive step –

in assessing novelty. A fair assessment of an invention's patentability called for a clear distinction between novelty and inventive step. In decision **T 763/89** (see also I.C. 4.2), 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.

1.1.6 Reproducible disclosure

The Boards of Appeal will only assume that a prior art document destroys novelty if the subject-matter in question is disclosed in a way that allows others to reproduce it. Accordingly in **T 206/83** (OJ 1987, 5), relating to anticipation of a chemical compound, the Board stated that a compound defined by its chemical structure can only be regarded as being disclosed in a particular document if it has been "made available to the public" in the sense of Art. 54(2). In the field of chemistry this requirement is, for instance, satisfied if a reproducible method is described in the same document. This need for an enabling disclosure is also in conformity with the principle expressed in Art. 83 for patent applications which must, accordingly, "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 disclosure are, therefore, identical in all these instances.

For selection inventions (see I.C. 4.2) the requirement of a reproducible disclosure also plays a significant role. In case **T 26/85** (OJ 1990, 22) the Board pointed out that anything comprised in the state of the art can only be regarded as having been made available to the public insofar as the information given to the person skilled in the art is sufficient to enable him to practise the technical teaching which is 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. According to the above-mentioned conclusion, the Board considered that a realistic approach in assessing the novelty of the invention under examination over the prior art in a case where overlapping ranges of a certain parameter exist 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 can be fairly assumed that this would be the case, it must be concluded that no novelty exists. 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 that range under a certain value and the range of overlaps was under this value; therefore the claimed range was considered novel.

1.2 Mistakes in a disclosure

One cannot rely on a mistake in a prior art document as destroying the patentability of later claimed subject-matter. 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 is the primary source of what has been made available as a technical teaching. When there is a substantial inconsistency between the original document and its abstract, it is clearly the disclosure of the original document that must prevail; the disclosure in the original document provides the strongest evidence as to what has been made available to the skilled man; when it is clear from related contemporaneously available evidence that the literal disclosure of a document is erroneous and does not represent the intended technical reality, such an erroneous disclosure should not be considered as part of the state of the art.

In **T 591/90** a prior document again contained mistakes. The Board distinguished **T 77/87** because this decision referred to 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.

1.3 Combination of documents

The combination of different elements of the state of the art is generally not permissible when considering novelty. Only in certain situations will the Boards of Appeal make an exception to this rule. In this sense, in **T 233/90**, the Board took the view that only the actual content of a prior document as it would have been understood by a skilled person on its filing or priority date could destroy novelty. Where a document according to Art. 54(3) 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.

Likewise, in one particular case where there was a specific reference in one prior document to a second prior document, when construing the first document (i.e. determining its meaning to the skilled man) the presence of such a specific reference may necessitate that part or all of the disclosure of the second document be considered as part of the disclosure of the first document (**T 153/85**, OJ 1988, 1).

However, where a prior document provides detailed information on the development of the state of the art mentioned only in very general terms without any indication of references, it is not permissible, when assessing whether there is novelty, to combine the general information with the specific detailed information mentioned in the prior document solely in order to explain such development, unless the skilled person would have inferred such a combination from the prior document (**T 291/85**, OJ 1988, 302).

A combination of different elements from the state of the art was also not considered legitimate in **T 305/87** (see I.C. 1.1.3).

2. Availability to the public

2.1 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.

This was the opinion in **T 482/89** (OJ 1992, 646), where the Board held that a single sale is sufficient to render the article sold available to the public within the meaning of Art. 54(2) provided the buyer is not bound by an obligation to maintain secrecy. It is not necessary to prove that others also had knowledge of the relevant article. In the opinion of the Board this is also the case when the article was sold to a man not skilled in the art (likewise **T 953/90** and **T 969/90**).

On the other hand, in **T 300/86**, the Board took the view that the fact that the report of the invention was passed to a large, but limited, circle of persons does not of itself make the document available to the public if all the recipients of the document were bound to secrecy, and there has been nothing to indicate that the recipients broke their pledge of secrecy.

If recipients are not bound to secrecy the document is made available to the public even if, as in **T 877/90**, only a limited circle of persons is concerned. The Board held that an oral disclosure is 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. Even where only certain persons are invited to participate, the oral disclosure of the meeting is freely available to the public, if the participants are not subject to a secrecy agreement. The word “public” in Art. 54(2) refers not to the man in the street: 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.

2.2 The notion of “making available”

According to Board of Appeal case law the theoretical possibility of having access to information renders it available to the public.

In **T 381/87** (OJ 1990, 213) the Board took the view that if a document in a library “would have been available to anyone who requested to see it” on a particular day, such fact is sufficient to establish that the document was “made available to the public” on that day: it is not necessary as a matter of law that any member of the public would have been actually aware that the document was available on that day, or that any member of the public had actually taken note of it.

Interpreting the notion of availability in even wider terms, the Board ruled in **T 444/88** that the mere possibility of the public having inspected a document before the priority date of the patent concerned suffices to render the document available within the meaning of Art. 54(2). It is immaterial whether a member of the public was aware of this possibility or whether he actually took note of the document. The question whether a document has been made available depends on the possibility of inspection, not on whether it was actually inspected by a third party.

In the field of chemistry the Board took the view that the criterion of availability was only satisfied if, in addition to the possibility of having access to a product, there was also a specific reason for analysing it (see **T 93/89**, OJ 1992, 718, and **T 270/90**). This ruling was recently overturned by **G 1/92** (OJ 1993, 277). The Enlarged Board held that the chemical composition of a product belongs to the state of the art when the product as such is available to the public and can be analysed and reproduced by the skilled person irrespective of whether or not particular reasons could be identified for analysing the composition. It also held that the same principle applied *mutatis mutandis* to any other product.

However the skilled person must be able to analyse the product without undue burden. In **T 461/88** (OJ 1993, 295) the Board ruled that a control program stored on a microchip has not been made available to the public if the analysis of the program would require an expenditure of effort on a scale which can only be reckoned in man-years and if, for economic reasons, it is highly improbable that the sole purchaser of the machine controlled by the program has carried out such an analysis (see also the similar ruling in **T 969/90**).

2.3 Prior use and recognisability

For a product to be made available, it must be disclosed in a form which offers the possibility of recognising the invention's essential features. This issue is particularly crucial in cases involving disclosure by prior public use.

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.

This principle was applied also in **T 245/88**. Two vaporisers had been installed inside the fence of a shipyard. As far as the opportunity to view these vaporisers from outside the fence of the shipyard area 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 thereof and the problem to be solved thereby. The Board was not satisfied that a skilled person would have taken notice of the claimed spacing ratio amongst a great number of dimensions and dimensions ratios which can be derived from a multi-tube vaporiser.

The Board took the same line in the above-mentioned case **T 461/88**, where the control system, which accorded exactly with all the features of the contested patent claim, was fitted to a printing press which had been exhibited at trade fairs before the priority date of the patent. The control system had not been made available to the public because the public had no possibility of recognising the system's features.

In case **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 to develop it further.

2.4 Issues of proof

2.4.1 Degree of substantiation (“Glaubhaftmachung”)

In decisions **T 381/87** (OJ 1990, 213), **T 743/89** and **T 82/90** the Board took the view that the balance of probabilities is a sufficient yardstick of substantiation.

2.4.2 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**, **T 245/88**, **T 82/90**).

In **T 743/89**, however, the Board applied the principle of *prima facie* evidence. Here, it had been proven 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.

2.4.3 Points requiring proof

In numerous decisions (see, for example **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 600/90**, **T 877/90**, **T 441/91**) the Boards have ruled on which points require proof in cases where oral disclosure or disclosure by prior public use is alleged: i.e. the date on which the disclosure occurred, exactly what was disclosed, and the circumstances surrounding the disclosure.

3. Chemical inventions and selection inventions

3.1 Novelty of chemical compounds and groups of compounds

T 12/81 (OJ 1982, 296) is a decision of fundamental importance as far as novelty in the field of chemistry is concerned and 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 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. The Board summarised 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 – is disclosed in a novelty-destroying manner if it proves 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 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 present subject-matter does not involve a selection of that kind in an area which, although marked out by the state of the art, is 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 combination between starting substances and process variants, however, is quite a different matter from a combination of two starting substances and thus not comparable. At its simplest, if the starting substances are 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 involves a true substantive modification of the first starting substance, since in every combination it is supplemented by a different fragment of the second starting substance to become a different end product. Each end product is thus the result of two variable parameters.

However, combining a given starting substance from a list of such substances with one of the methods of preparation given does not result in a real substance alteration of the starting substance but only an “identical” alteration. In this case, e.g., no matter which of the processes described in detail is used, the end product is always the particular starting substance’s hydrogenation product, which differs from the starting substance itself only in that it contains two additional hydrogen atoms. The process parameter is 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 is not the result of two variable parameters.

This concept of what a prior publication discloses was taken up by the Board in **T 181/82** (OJ 1984, 401). This decision confirmed that the products of processes which are the inevitable result of a prior description of the starting materials and the process applied thereto belonged to the state of the art. This was true even if one of the two reactants manifests itself as a chemical entity (C1 alkyl bromide) from a group of generically defined compounds (C1 – C4 alkyl bromides). The Board had taken the view that the description of the reaction of a certain starting material with C1 – C4 alkyl bromides disclosed only this product substituted by C1 methyls and was not ready to recognise the disclosure of the butyl substitutes on the grounds that four isomers of this radical exist.

In **T 7/86** (OJ 1988, 381) the Board also based its reasoning on **T 12/81**. The principle that a substance resulting from the reaction of a specific pair from two lists can nevertheless be regarded as new is applicable not only for starting substances in chemical reactions but also for polysubstituted chemical substances where the individual substituents have to be selected from two or more lists of some length, such as in the present case.

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

According to decision **T 296/87** (OJ 1990, 195), the description of racemates does not anticipate the novelty of the spatial configurations contained in them; racemates are 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 may occur in a **plurality** of conceivable spatial configurations (D and L enantiomers) but the latter are not by themselves revealed thereby in an individualised form. That methods exist to separate the enantiomer into racemates is something that should only be considered with respect to inventive step.

The case law on the novelty of generically defined compounds and particular examples of these has recently been 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 is a particular compound, whereas the prior art discloses a family of compounds defined by a general structural formula including this particular compound but not describing it explicitly, the invention has to be considered novel (see **T 7/86**).

(b) If, with the same prior art, the subject-matter of the invention is a second family of compounds partially covering the first, the invention is 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 deals with the problem of assessing the novelty of a class of compounds defined with 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 specifically described example 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 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 as also 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 lack novelty.

Similarly in **T 12/90**, the Board decided that the disclosure in a prior document likely to affect the novelty of a claim is not necessarily limited to the specific working examples but also comprises any reproducible technical teaching described in the document. It concluded that the invention lacked novelty.

3.2 Selection of sub-ranges and overlapping of ranges defined by parameters

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**: 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 preferred part of the known range (as illustrated for instance in the examples given in the prior art);
- c) the selected sub-range should not be an arbitrarily chosen specimen from the prior art, i.e. not merely one way of carrying out the prior teaching, but must provide a new invention (purposive selection).

With reference to the third criterion, the Board in **T 198/84** was of the opinion that this view of novelty really entails more than just a formal delimitation vis-à-vis the state of the art. It would be delimited 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 is not the case, if the effect of the selection, e.g. the substantial improvement in yield, may be believed to occur 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 the sub-range singled out of a larger range is new not by virtue of a newly discovered effect occurring within it, but must be new per se. An effect of this kind is not therefore a prerequisite for novelty; in view of the technical disparity, however, it

permits the inference that what is involved is 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) 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 cannot be regarded as novel, at least in cases where the values in the examples given in the citation lie just outside the claimed range and teach the skilled person that it is possible to use the whole of this range.

The three postulates for the novelty of a selected sub-range are based on the premise that novelty is an absolute concept: therefore it is 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).

Decision **T 26/85** (see I.C. 1.1.6) uses this concept to derive the principle that the state of the art only destroys novelty insofar as it discloses to the man skilled in the art a reproducible technical teaching. Developing this concept the decision suggests as a specific test of “making available to the public a technical teaching”, that the question be asked 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 he would do so, it must be concluded that no novelty exists. This formulation of the question was adopted inter alia in **T 666/89** (OJ 1993, 495), **T 255/91** (OJ 1993, 318), **T 279/89** and **T 369/91**.

In decision **T 666/89** 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) 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** (Case Law Report 1992, p. 19) and **T 565/90** (Case Law Report 1992, p. 20).

In decision **T 427/86**, the Board considered a case where 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. In this case, the prior document in fact 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 given of metal constituents and in the list of promoters in this document the number of possible combinations gave rise to 36 different catalytic systems. The invention claimed aimed at improving the operation of the catalytic system. It comprised the selection of a very small number of alternatives (1 and 2 respectively) from the list of metal constituents and from the 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 is for patent purposes a selection and can be regarded as new, insofar as the wide range of possibilities has not been disclosed to the public. The Board added furthermore that in view of the earlier decision **T 198/84** (see I.C. 3.2), 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.

T 763/89 was concerned with a selection from a generically defined group. 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 destroying its 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 gave this ruling in the context of previous case law on selection inventions involving chemical substances. This had laid down 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. This was the case here, even though the distinction was based solely on numerical values. Unlike consecutive numerical ranges, numerical values quoted in connection with a multilayer material, for which only whole-number values could be considered, served to characterise objects which were clearly defined and could be distinguished from homologues. That also clearly distinguished this selection situation from one with consecutive numerical ranges: provided that substance or product inventions were clearly defined, the requirement that they be sufficiently different from specifically disclosed matter did not apply.

4. Novelty of use

4.1 Introduction

Methods for the surgical or therapeutical treatment of the human or animal body and diagnostic methods practised on the human or animal body ("medical methods") shall not be regarded as inventions susceptible of industrial application (Art. 52(4), first sentence). For the first medical use of a known substance, Art. 54(5) provides a particular form of claim (purpose-related product claim). See *inter alia* decisions **T 43/82** and **T 128/82** (OJ 1984, 164) with regard to the breadth of such claims.

The form of claims to be used for a second or further medical use has also already been considered. In decisions **G 5/83** (OJ 1985, 64), **G 1/83** (OJ 1985, 60) and **G 6/83** (OJ 1985, 67) on the patentability of a second medical use of a substance, the Enlarged Board of Appeal 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 is not patentable under Art. 52(4). However, it allowed claims of the type "use of substance X for the manufacture of a medicament for therapeutic application Y". The Enlarged Board derived the novelty of such claims from their sole new feature, that is the new pharmaceutical use of that known substance. It emphasised that this special approach to derivation of novelty can only be applied to claims on the use of substances or compositions in a method referred to in Art. 52(4).

Two subsequent referrals to the Enlarged Board raised the more general issue of novelty of a second non-medical use which is not connected with the specific problems of use claims in the medical field.

4.2 Second (further) non-medical use

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 is known cannot preclude the novelty of a hitherto unknown use of that substance, even if the new use does 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 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 is novel under Art. 54 having regard to a prior publication which discloses the use of that compound for a different non-medical purpose, so that the only novel feature in the claims is the purpose for which the compound is 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**).

In the respective 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** which concerned the issue of the second medical use of a substance. However, in this previous decision the exclusion from patentability of therapeutic and diagnostic methods caused the Enlarged Board to allow only that special type of claim mentioned above in the introduction. These specific difficulties did not arise in the non-medical field; there the question was of a general nature, being primarily concerned with the question of interpretation of Art. 54(1) and (2). In **G 2/88** and **G 6/88**, therefore, it was pointed out that a claimed invention lacks novelty unless it includes at least one essential technical feature which distinguishes it from the state of the art. Then deciding upon the novelty of a claim, a basic initial consideration was therefore to construe the claim in order to determine the technical features.

The Enlarged Board took the view that the proper interpretation of a claim whose wording clearly defines a new use of a known compound will normally be such that the attaining of a new technical effect which underlies the new use is a technical feature of a claimed invention. Thus with such a claim, where the particular technical effect which underlies such use is described in the patent, the proper interpretation of the claim will require that a functional feature should be implied into the claim, as a technical feature; for example, that the compound actually achieves 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 (which was known as growth regulator) as fungicide implicitly included a functional technical feature, namely that the said substance when used in accordance with the described means of realisation in fact achieves the effect (i.e. performs 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”; it should be interpreted (in appropriate cases) as also including as a technical feature the function of achieving this purpose (because this is the technical result). When determining novelty the decisive question of what has been made available to the public is one of fact in each case. A line must be drawn between what was in fact made available and what remained hidden or otherwise had not been made available. In this connection the distinction between lack of novelty and lack of inventive step should also be emphasised: information equivalent to a claimed invention may be “made available” (lack of novelty), or may not have been made available but obvious (novel, but lack of inventive

step), or not made available and not obvious (novel and inventive). Thus, in particular, what is hidden may still be obvious.

Under Art. 54(2) the question is not what may have been “inherent” in what was previously made available to the public under the EPC. Under the EPC, the hidden or secret use, because it has not been made available to the public, is not a ground of objection to the validity of a European patent. In this respect, the provisions of the EPC may differ from the previous national laws of some Contracting States, and even from the current national laws of some non-Contracting states. Thus, the question of “inherency” does not arise as such under Art. 54. Any vested right derived from prior use of an invention is 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 may 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). If that technical feature has not been previously made available to the public by any of the means as set out in Art. 54(2) then the claimed invention is novel, even though such technical effect may have inherently taken place in the course of carrying out what has 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.

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. The Board thereby extended the principles set out in decision **G 2/88** for use claims to include process claims.

In decision **T 276/88** the Board confirmed the patentability of a method of applying certain known coatings to objects in order to camouflage them in the infra-red range where the use of the known coating was based on a technical effect, i.e. their infra-red camouflage effect which was to be viewed as a functional technical feature of the claim. The state of the art gave no indication that the infra-red effect of the known coatings was a technical feature already available to the public through known teachings (known use of the coatings) without any need for a specific search.

In **T 958/90** the Board held that a known effect cannot become novel for the sole reason that it is present in the patent to a hitherto unknown extent.

4.3 Second (further) medical use

The Enlarged Board decided on the admissibility and form of claims for second medical use early on. The following case law centered on the distinction between medical and non-medical use.

The Board of Appeal applied the principles of decision **G 5/83** in case **T 19/86** (OJ 1989, 24). 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 can be derived. According to decision **T 19/86** the question of whether a new therapeutic use is 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 present case, the new group of pigs) to be treated. A therapeutic application is incomplete if the subject to be treated is not identified; only a disclosure of both the disease **and** the subject to be treated represents 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 the above-mentioned decision of the Enlarged Board.

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 has 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.

In decision **T 227/91** it was stated that the purpose of a surgical use alone cannot 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 for intercepting a laser beam of substrate means and coating means in the manufacture of a laser surgical instrument. 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 cannot normally impart novelty to an otherwise known article unless the function implies a necessary modification of the article itself.

In decisions **T 303/90** and **T 401/90** the main claims related to a contraceptive composition comprising known pharmaceuticals 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 can the addition of a purpose characteristic render a product claim new, if the product as such is known in other technical fields.

5. Novelty of product-by-process claims

Further information on this subject is to be found in the chapter “Product-by-process claims” in II.B. 6.

D. Inventive step

1. Closest prior art

1.1 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). The “state of the art” for the purposes of considering inventive step is as defined in Art. 54(2); it does not include later published European applications referred to in Art. 54(3).

The method of assessing inventive step which has found favour with the Boards consists of comparing the subject-matter of the application with the state of the art on the date of filing or priority. This comparison on the basis of the closest prior art serves to identify the objective problem solved by the invention.

1.2 Determination of closest prior art

According to **T 606/89** the closest prior art for the purpose of objectively assessing inventive step is generally that which corresponds to a similar use requiring the minimum of structural and functional modifications.

In **T 641/89** the Board ruled that, where the invention related to the improvement of a manufacturing process for a known chemical compound, the only documents to be considered when determining the closest prior art were those which described that compound and its production. Only through comparison with these documents could a skilled person determine whether an improvement in the production of the target compound had been achieved, and hence whether they would have to be taken into consideration in formulating the problem to be solved by the invention.

1.3 Problem and solution

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** 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.

Further comments on this issue are to be found in decision **T 365/89** (see Case Law Report 1991, p. 24).

Identifying the **objective** problem means that the applicant’s subjective ideas con-

cerning the state of the art are irrelevant. It is therefore possible to **reformulate the problem**, provided that the new problem can be deduced from the original application documents.

According to the leading case **T 184/82** (OJ 1984, 261) it was well-established case law that, where a specific problem was identified in the description, the applicant or patentee could be allowed to put forward a modified version of the problem, particularly if the issue of inventiveness had to be considered on an objective basis against new prior art which came closer to the invention than that considered in the original application or granted patent. **T 13/84** (OJ 1986, 253) added that a reformulation of the problem was not precluded by Art. 123(2) if the problem could be deduced by a person skilled in the art from the application as originally filed when seen in the light of the nearest prior art.

In **T 386/89** the disputed patent related to wheels manually adjustable for varying track. Contrary to the teachings of the original disclosure in which the sole emphasis was on the achievement of material savings with respect to the disc, the proprietor of the patent argued during the appeal proceedings that the technical problem solved by the invention was to be seen in the enhancement of the fatigue life of the wheel through arrangement of the lugs in pairs. He admitted that this increase in fatigue life was surprising. In its decision the Board applied the above principles and concluded that the **alleged unexpected effect**, i.e. the improved fatigue life, was not deducible from the application as originally filed. 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 nearest prior art.

The appellant argued in **T 530/90** that the technical problem had been inadmissibly altered from the original one to justify including feature (d) in the claim. Citing **T 13/84** (see above) the Board ruled that reformulating the technical problem in the light of the closest prior art as subsequently established, and then adding feature (d) to Claim 1, was not in breach of the EPC provided the problem as thus clarified and the solution proposed were deducible from the application as a whole in the form originally filed.

1.4 Combination of documents

1.4.1 Partial problems

In **T 315/88** the Board stated that the fact that a line of argument concluding lack of inventive step required three different previous documents to be taken into account could not be interpreted as constituting an indication in favour of the presence of inventive step, at least when the technical problem forming the basis of the subject-matter claimed comprises two technically independent partial problems. Because they are technically unconnected, the solutions to such partial problems are generally described in different published documents.

In **T 130/89** (OJ 1991, 514) the technical problem intended to be solved by the claimed invention 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 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.

1.4.2 Combination of documents and different passages

In **T 176/89** the Board reached the conclusion that for the closest prior art to be defined, two documents had, exceptionally, to be read in conjunction with each other because they belonged to the same patentee, were invented by substantially the same inventors, and apparently related to the same series of investigations. The Board also held that the teachings of two documents ought rarely, if ever, to be combined if it is apparent that their teachings are mutually conflicting.

In **T 552/89** the Board confirmed that, when assessing inventive step, it is 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 are merely aggregated together in the claimed invention.

In **T 366/89** the Board held that it would not be obvious for the skilled person to combine an isolated 50 year-old document (which was not influential on technical development and went contrary to the present trends) with the document which represented the closest prior art.

According to established Board of Appeal case law, when examining what has been made available by a document, the disclosure has to be considered as a whole and not only on the basis of the examples contained in it (**T 12/81**, OJ 1982, 296; **T 332/87** and **T 666/89** (OJ 1993, 495). In **T 95/90** the Board held that this means that **different passages of one document** can be combined provided there are no reasons which would prevent a skilled person from making such a combination. Moreover, the technical teaching of examples could be combined with that disclosed elsewhere in the same document provided that the examples concerned are indeed representative of the general technical teaching disclosed in the document in question.

1.5 Combination invention

When assessing inventive step in a combination invention (**T 388/89**) 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 (see also **T 717/90**, Case Law Report 1991, p.28).

2. Skilled person

2.1 Definition of the skilled person – team of experts

The Guidelines (C-IV, 9.6) state that the **person skilled in the art** should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. 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. There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, than a single person.

Regarding the role of the skilled person, the Board gave the following ruling in **T 32/81** (OJ 1982, 225): “If the problem prompts the person skilled in the art 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”.

Citing the above-mentioned decision **T 32/81** the Board took the view 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. The semiconductor specialist would be expected to team up with the plasma expert and entrust him with the task of increasing the efficiency of the reactive species generation.

In **T 60/89** (OJ 1992, 268) the Board was of the opinion that the skilled person in the field of genetic engineering in 1978 is not to be defined as a Nobel Prize laureate, even if a number of scientists working in this field at that time were actually awarded the Nobel Prize. Rather, it is understood that the skilled person was to be seen as a graduate scientist or a team of scientists of that level of skill, working in laboratories which were developing genetic engineering techniques, in contrast to developing the science of molecular genetics at that time.

This case law was confirmed in the decision “Biogen II” **T 500/91** (for the first “Biogen” decision see **T 301/87**, OJ 1990, 335). The Board stated that the notional skilled person who may be represented by a team of appropriate specialists is oriented towards practicalities, and the development of the art normally expected by him does not include solving technical problems by performing scientific research in areas not yet explored. It finally concluded that, having regard to the fact that the area of genetic engineering here under consideration was relatively new at the relevant date, having further regard to the uncertainty at the date about facts influencing the success of the attempted recombinant-DNA techniques, and to the absence of a well-established general level of knowledge in this particular technical area, the present successful technical application of recombinant-DNA techniques according to claims 1 and 2, involved an inventive step.

Further comments on the concept of the “team of experts” are to be found in the following decisions: **T 57/86**, **T 295/88**, **T 460/87**, **T 99/89** and **T 222/86** (in advanced laser technology, the skilled person as a production team of three experts in physics, electronics and chemistry respectively).

2.2 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 may 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 must also include prior art in a non-specific (general) field dealing with the solution of any general technical problem which the application solves in its specific field. Such solutions of general technical problems in non-specific (general) fields must be viewed as forming part of the general technical knowledge which a priori is to be attributed to those skilled persons versed in any specific technical field. These principles were applied in a large number of decisions.

In the headnote to **T 28/87** (OJ 1989, 383) the Board gave the following ruling: "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 rated to the applicant's or proprietor's disadvantage as a neighbouring field merely on account of that reference." The document to which the proprietor of the patent had himself referred in the introduction to the description was therefore not taken into account in the assessment of inventive step.

According to **T 454/87** a skilled person specialising in a particular technical field (gas chromatography equipment) would in the course of his normal professional activity also observe developments in equipment used in a related technical field (absorption spectral analysis).

The subject-matter of the patent in **T 767/89** was a carpet with fibre-optic cables woven into its pile which, when exposed to a light source, produced decorative light effects. The Examining Division had regarded the relevant prior art as being an American patent application for a wig featuring fibre-optic cables to produce light effects. The Board ruled that with regard to carpeting, the field of wigs can be regarded as neither a neighbouring field nor a broader general field of which the specific field is part. From the viewpoint of related technical fields, therefore, the skilled person would have no reason to investigate solutions disclosed in the art of wigs. The problems to be solved by the two inventions, and particularly the demands made on the products in use, were held to be different.

In **T 560/89** (OJ 1992, 725) it was held that a skilled person also considered prior art in fields which were neither neighbouring nor represented a broader general field if he had grounds so to do on account of the related nature of the materials used and a discussion of the technical problems confronting both fields.

Echoing **T 560/89** the Board ruled in **T 955/90** that it corresponds to a real life assessment that a person skilled in a broader general field consults the particular narrower technical field of the well-known main application of this general technology in order to look for a solution of a problem which is independent of a particular use of this technology.

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 does not lead the person skilled in this art to the field of filling a tank of a chain saw by means of a special kind of container); **T 189/92**, **T 365/87**, **T 47/91** and **T 443/90**.

2.3 Skilled person – level of knowledge

In **T 60/89** (OJ 1992, 268) (see also I.D. 2.1) the Board confirmed that 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.

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 achieve 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.

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 is part of the general knowledge of a specialist in that specific technical field. 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, conformed to the definition of the state of the art given in Art. 54 according to which no account is taken of the location at which the skilled person exercises his profession.

3. Proof of inventive step

3.1 General issues

In **T 532/88** the Board referred to the ruling in **T 109/82** (OJ 1984, 473) that the posing of a new problem does **not** constitute a contribution to the inventive merits of the solution if the problem could have been posed by the average person skilled in the art. 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 does not constitute inventiveness.

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.

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 (**T 513/90**). 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 marketplace was devoid of mental or practical effort, or of "purposive selection", in the absence of anything to the contrary.

3.2 Comparative examples

In certain cases an effect demonstrated by means of a comparative test may be regarded as indicating that an inventive step has occurred.

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 are submitted as evidence of an unexpected effect, there must 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 the 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 are 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 must be such that the effect is convincingly shown to have its origin in the distinguishing feature of the invention. For this purpose it may be necessary to modify the elements of comparison so that they differ only by such a distinguishing feature.

In **T 390/88** the Board addressed the question of the circumstances under which the production of comparative examples is 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.

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).

3.3 Surprising 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).

According to **T 154/87** the achievement of a surprising effect is no precondition for the existence of inventive step. All that is necessary is to ascertain that the respective subject-matter could not be derived by the skilled person in an obvious manner from the available prior art.

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, 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.

3.4 Prejudice in the art

In Board of Appeal case law, the existence of a prejudice is determined on the basis of circumstantial evidence.

According to the leading case **T 119/82** (OJ 1984, 217), appellants who wish to rely on a prejudice which might have deflected the skilled man from the alleged invention have the onus of demonstrating the existence of such prejudice. A mere reference to an unpublished pending patent application, which is not available to the public and to the Board, does not constitute sufficient substantiation (on substantiation, see, *inter alia*, **T 60/82**, **T 631/89**, **T 695/90**).

Generally speaking, prejudice **cannot** be demonstrated by a statement in a single patent specification. 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 601/88**).

In order to claim that a prejudice has been overcome, the proposed solution has to go beyond the prevailing conventional teaching; it is not enough to adduce the negative opinion of individual experts (**T 62/82**, **T 410/87**, **T 500/88**).

The mere fact that a disadvantage has been accepted or a prejudice ignored does not mean that a prejudice has been overcome (**T 69/83**, OJ 1984, 357; **T 262/87**).

3.5 Further secondary considerations in inventive step

In the “**Epilady**” case (**T 754/89**) the Board detailed its reasons for ruling that an inventive step was involved. The documents cited by the opponent were based on entirely different drive principles and also related partially to entirely different fields of application. Neither alone nor in combination, therefore, did they render the design of the claimed depilatory device obvious to a person skilled in the art. 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 dismissing the appeal the Board pointed out that **commercial success** alone cannot be regarded as indicative of inventive step even if the Board were satisfied that the success was due to technical features of the process and not to extraneous causes (**T 219/90**).

3.6 Obvious new use

In **T 112/92** 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 of **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 as per document (1), such 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.

4. Intermediate products

In **T 22/82** (OJ 1982, 341) the Board held that the preparation of new intermediates for a surprisingly advantageous complete process for the preparation of known and desired end products was to be regarded as inventive.

This case law was adopted by another Board in its decision **T 163/84** (OJ 1987, 301) in which it acknowledged the patentability of such intermediates because their further processing to the known end products was judged to be inventive. The Board, however, concluded that a new chemical intermediate does not become inventive merely because it is prepared in the course of an inventive multi-stage process and is further processed to a known end product. There must also be other factors, such as the fact that the process for preparing the new intermediate enabled it to be prepared for the first time and did so inventively and other methods of preparing it appeared to be ruled out.

In **T 648/88** (OJ 1991, 292) the Board did not follow the position expressed in the decision **T 163/84**, discussed above. Upholding the view already set out in **T 22/82**, it stated that an intermediate intended for the manufacture of a known end product was considered to be inventive if its preparation involved inventive manufacture or inventive further processing or formed part of a complete inventive process.

In **T 18/88** (OJ 1992, 107) the applicant had claimed that the insecticidal properties of the known final products – significantly improved over those of another known insecticide product with a similar structure – were sufficient to establish the inventiveness of the intermediate products, even if the final products lacked novelty and/or inventiveness. The Board rejected the applicant's argument, referring to **T 65/82** (OJ 1983, 327): "Claimed intermediates must themselves be based on an inventive step to be patentable. Whether, under certain circumstances, new and inventive subsequent products may support an inventive step of intermediates is not the question here because the subsequent products in this case are either not novel or not inventive. Thus, the superior effect of subsequent products which are neither novel nor inventive is not sufficient to make the intermediates inventive."

II. CONDITIONS TO BE MET BY AN APPLICATION

A. Sufficiency of disclosure

1. General principles

It has been consistent Board of Appeal case law since at least **T 14/83** (OJ 1984, 105), that sufficiency of disclosure within the meaning of Art. 83 must be assessed on the basis of the application as a whole – including the description and claims – and not of the claims alone (see e.g. **T 82/90**, **T 126/91**, **T 435/89**).

1.1 Standards for sufficiency of disclosure

In decision **T 226/85** (OJ 1988, 336), which follows **T 14/83**, the Board considered that even though a reasonable amount of trial and error is permissible when it comes to the sufficiency of disclosure, e.g. in an unexplored field or where there are many technical difficulties, there must then be available adequate instructions in the specification or on the basis of common general knowledge which would lead the skilled person necessarily and directly towards success through the evaluation of initial failures.

In **T 292/85** (OJ 1989, 275) and **T 60/89** (OJ 1992, 268), the Board concluded that an invention is 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 unspecified 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 have the same effect for the invention. In **T 212/88** (OJ 1992, 28), the Board reaffirmed that the requirements set out in Art. 83 are fulfilled if the description indicates at least one reproducible way of carrying out the invention.

According to **T 94/82** (OJ 1984, 75) and **T 487/89**, the absence of an upper limit was not a ground for objection where the claim sought to embrace values which should be as high as possible above a specified minimum level, given the other parameters of the claim. This problem, which also arises in respect of clarity of claims (see II.B.1.2.4.b.) is often addressed by opponents under Art. 100(b), as lack of clarity of the claims is not a ground of opposition; the point must then be dealt with by the Board in the context of sufficiency of disclosure of the invention. **T 297/90** dealt with a similar matter. The contested patent related to non-woven sheets; the claim comprised only the lower limit for the tensile strength of the fibrous sheet. By giving the specific values in some very detailed examples the patentee had outlined his invention. These specific examples, with their resulting specific tensile strength values, satisfied the Board that the claim did not involve **vague “desiderata”**, but concretely obtained values. In the Board’s view, limiting the criticised value to the highest value as disclosed in the examples given would unjustifiably restrict the scope of the invention to a particular range, especially since it was obvious to the skilled person that there was an inherent upper limit to the tensile strength of the non-woven sheet, depending not only on the fibre strength but also on the bond strength, which were both the direct result of the different concrete technical features.

In **T 60/89** (OJ 1992, 268) the Board came to the conclusion that 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 (see also I.D. 2.1).

1.2 General knowledge and cross-references

In **T 611/89**, the Board held that reference to a document already **mentioned** in the original description completed the disclosure, and the teaching claimed in the invention was reproducible since the person skilled in the art could reasonably easily find out how to carry it out.

In **T 51/87** (OJ 1991, 177), **T 580/88** (Case Law Report 1990, p. 29) and **T 772/89** the principle was developed that an invention cannot be sufficiently disclosed by documents **not mentioned** in the application as filed, unless these are general technical literature or standard works indisputably of common general knowledge. Referring to decision **T 171/84** (OJ 1986, 95), the Board reaffirmed in **T 580/88** the need to draw a distinction between “general technical literature” or “standard textbooks”, which are clearly within common general knowledge, and patent specifications, which as a rule are not.

Exceptionally, however, patent specifications too could be considered as being of 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 772/89**). In **T 654/90** the Board held that two documents which were necessary for sufficient disclosure of the invention, but which could only be found after an in-depth search of the literature, could not be regarded as forming part of the skilled person’s common general knowledge.

1.3 Establishing sufficiency of disclosure

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. In **T 665/90**, the Board ruled that insufficiency had not been demonstrated; the opponent had repeated the patented process under conditions covered by Claim 1 but differing in many respects from those applying in the contested patent’s examples. He had therefore not “repeated” the invention properly.

In **T 740/90**, the Board ruled that an invention could only be repeated using the examples given. Insufficiency could not be adduced on the basis of laboratory trials when the only embodiment exemplified in the patent was an industrial fermentation process. In **T 406/91**, the Board added that the burden of proof was borne by the opponent. Because the opponent had only used equivalents of the surfactants given in the patent, the disclosure was sufficient.

In **T 449/90**, the scientific basis for the invention was still uncertain on the date of priority. The Board was called upon to decide on the proof of repeatability of an AHF-enriched composition for use in manufacturing a medicament to treat bleeding in haemophiliacs. The composition contained a human Factor VIII concentrate and was heated in lyophilised form at between 60 and 125 °C to inactivate any Aids or hepatitis viruses. A characterising feature was that the Aids and hepatitis viruses were rendered “substantially inactive”.

The issue was whether sufficiency of disclosure could be established, given that at the priority date no direct method was known for testing whether these viruses (only recently discovered, and not yet cultivatable or precisely describable) had been inactivated. By reference to a pre-published application however a test method was disclosed in which a verifiable and particularly hardy virus was given the same inactivation treatment and used as a biological indicator for its success with the actual virus. The Board considered that the requirements of Art. 83 had been satisfied, as the claimed degree of inactivation (“substantially”) could be demonstrated with sufficient certainty. Complete inactivation of the life-threatening Aids virus – which the opponent had argued was necessary – was indeed highly desirable, but not an Art. 83 issue given the claim as worded.

2. Biotechnology

The general principle has been established that a biological invention is sufficiently disclosed if at least one way is clearly indicated enabling the person skilled in the art to carry it out (**T 292/85**, OJ 1989, 275). Furthermore, the Board has held that there is no requirement under Art. 83 for a specifically described example of a process to be exactly repeatable (**T 281/86**, **T 181/87**, **T 299/86**, **T 19/90**). Several decisions have laid down important points of procedural and substantive law relating to European patent applications based on a deposit of micro-organisms.

2.1 Reproducibility of biological inventions

Chemical Board of Appeal 3.3.2 has several times been faced with the question of the reproducibility of an invention on the basis of the description.

In **T 292/85** (OJ 1989, 275) the Board held that an invention is sufficiently disclosed if at least one way is clearly indicated enabling the person skilled in the art to carry it out. The non-availability of particular variants of a functionally defined component feature of the invention, or the unsuitability of unspecified variants thereof is immaterial to sufficiency as long as there are suitable variants known to the skilled person through the disclosure or common general knowledge which produce the same effect. The disclosure need not include specific instructions as to how all possible component variants within the functional definitions should be obtained. As to the possible non-availability of certain starting materials, the Board held that generally applicable biological processes are not insufficiently described for the sole reason that some starting material or genetic precursors therefor, e.g. a particular DNA or plasmid, are not readily available to obtain each and every variant of the expected result of the invention, provided the process as such is reproducible.

In **T 281/86** (OJ 1989, 202) the Board had to decide whether the invention must be exactly repeatable. The Board found that there is no requirement under Art. 83 stipulating that 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. The sufficiency of disclosure with regard to an intermediate plasmid in the

field of genetic materials primarily depends on utilisable possession of basic DNA structures and other components needed to lead to other plasmids and finally to the expression of a desired polypeptide at the end of a complex process. As long as such potential is verifiable and there are no elements or components in the plasmid which would contradict this, the description is not insufficient.

In **T 301/87** (OJ 1990, 355) 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. This case relates to an unknown but probably finite number of human and animal interferons of the alpha-type; the materials would differ from each other somewhat in constitution but still have some structural similarity in view of the affinity in hybridisation tests; furthermore, as a class, the members provide end products with the same biological activity; as long as this is achieved by the invention there is no necessity to provide instructions in advance on how each and every member of the class would have to be prepared; in view of the nature of the technique there is not even a guarantee that the same product would be obtained from the same source after an identical repetition of the complicated and lengthy experiments; at this broad level, any member of the class is an adequate representative of the invention. 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, are 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.

This consistent case law was also confirmed by decision **T 181/87**, which held that if the invention as claimed is broader than one particular example describing the preparation of a definite plasmid, the requirements of Art. 83 are not such that this example has to be reproducible identically, as long as there is evidence that the disclosure of the preparation of the specific plasmid leads reliably to plasmids which may differ from the specifically mentioned plasmid but nevertheless fall under the broad terms of the claim. As far as the plasmid pEco-63 is concerned, the requirement of Art. 83 was considered by the Board to be satisfied by the disclosure of the patent application because it provided sufficient information for a person skilled in the art to be able to reproduce the plasmid.

Likewise, in **T 299/86** (OJ 1988, 88) the Board confirmed previous case law by stating that the requirements under Art. 83 are not such that a specifically described example of a process must be exactly repeatable; "thus the description provides support for the view that hybridomas excreting the claimed monoclonal antibody are not so rare that the process as a whole would not lead to the claimed substance; in the absence of evidence to the contrary it is thus the Board's position that the description provides a sufficient disclosure repeatably to produce the claimed monoclonal antibody reliably and there is thus no need to reproduce identically the example given in the specification".

In **T 19/90** (OJ 1990, 476) the Examining Division had decided that the disclosure of the invention (defined by the incorporation of an activated oncogene sequence into the genome of non-human mammalian animals in general) was insufficient, particularly in view of the inventor's declaration that the positive results with mice had been surprising; it would therefore have been even more surprising if the invention could be car-

ried out on other animals. The Board disagreed: such a declaration had to be construed as demonstrating inventiveness in general, irrespective of the type of animals involved. The declaration had no influence on whether the disclosure was to be considered sufficient. The Board drew a distinction between this case and decision **T 226/85** (OJ 1988, 336) in which the Board had found the information provided in the application insufficient. The invention in the present case was undoubtedly reproducible on mice. Referring to decision **T 292/85** (OJ 1989, 275), the Board stated that “the mere fact that a claim is broad is not in itself a ground for considering the application as not complying with the requirement for sufficiency of disclosure under Art. 83. Only if there are serious doubts, substantiated by verifiable facts, may an application be objected to for lack of sufficient disclosure”.

2.2 Deposit of living material

2.2.1 Substantive questions

Decision **T 418/89** (OJ 1993, 20) dealt with the sufficiency of disclosure provided by a deposit of a hybridoma producing monoclonal antibodies with certain reactivities. It appeared that the characteristics of the monoclonal antibodies produced by the deposit were different from those mentioned in the claims and in the description, rendering it extremely difficult for the skilled person to carry out the invention and necessitating repeated requests for deposit samples and advice from the depository institution. The Board held that sufficiency of disclosure requires not only that an invention can be carried out at all, but also that it can be done without undue burden. The Board stated that a disclosure of a patent is sufficient if during its lifetime the technical teaching can be repeated. Even if the theory assumed to be the basis of the technical effect turns out to be incorrect, the disclosure can still be regarded as sufficient as long as the invention as such can be reproduced. However, this was not so in this case, because the written description of the invention was wrong from the beginning. The Board concluded that a disclosure in the form of a deposit under R. 28 is not sufficient within the meaning of Art. 83 if it is only possible to reproduce the invention after repeated requests to the depository institution and by applying techniques considerably more sophisticated than those recommended by the depository institution. The respondent's (patentee's) auxiliary request to restrict the scope of the patent to what had been deposited was rejected, as a mere deposit of a hybridoma without any corresponding written description does not provide a sufficient disclosure of a technical teaching within the meaning of Art. 83.

The same decision was reached on very similar facts in decision **T 495/89**.

2.2.2 Procedural questions

a. Deficiency in deposit

Decision **T 39/88** (OJ 1989, 499) dealt with the complications arising where a European patent application is based on a deposit of micro-organisms originally made for a purpose other than the filing of that application. In this particular case a European application was filed for an invention involving the use of a micro-organism as referred to by R. 28, claiming priority from a US application. A deposit of the micro-organism had been made with a depository institution in the USA shortly before the US application

was filed and this institution was fully recognised by the EPO both under the Budapest Treaty and by virtue of a special agreement. However, there was no suggestion indicating that the deposit was made under the Budapest Treaty, or for the particular purpose of R. 28, nor had the deposit, originally made under US legislation, been converted into a deposit under R. 28 or the Budapest Treaty before the filing of the European application. Therefore the deposit could only be considered as covering the US application, but not the subsequent European application filed within the priority year.

The Board confirmed the Examining Division's view that R. 28 had not been complied with. Nevertheless, the decision under appeal, refusing the European application because the requirements of Art. 83 in conjunction with R. 28 had not been met due to this deficiency in deposit, was set aside on the ground that the European application had been filed at a time when the situation was still at least rather unclear as to how to cope with deposits originally filed for the purpose of national US applications and then used for claiming priority for subsequent European applications. It would seem unfair in such a case to let the applicant bear the whole risk of this lack of clarity which was inherent in the system of deposit at the time.

The Board considered that the inherent risk of complications arising out of such situations had not been foreseen when the system of deposit of such organisms was introduced; this is indicated, *inter alia*, by an amendment of the special agreement between the EPO and certain depository institutions made at a later stage, providing for the "conversion" of a deposit originally made for another purpose into a deposit under R. 28. In the Board's view, only at that time (1986) was it made quite clear that the proper way of bringing a deposit originally filed for another purpose into line with the requirements of the EPC system was formally to convert the deposit either into a deposit under R. 28 not later than the date of filing of the European application (in the case of a deposit made on the basis of a special agreement between the EPO and the depository institution) or into a deposit under the Budapest Treaty (which automatically covers R. 28), as the case may be. Decisions **T 239/87**, **T 90/88** and **T 106/88** deal with cases which are in all relevant respects identical to **T 39/88**.

b. Identity of applicant and depositor

R. 28(1) stipulates that a culture of the micro-organism must have been deposited with a recognised depository institution not later than the date of filing of the application. In principle, applicant and depositor must be one and the same.

In decision **T 118/87** (OJ 1991, 474) the Board considered that if a parent company has authorised a subsidiary to deposit micro-organisms on its behalf for patent applications which the parent company intended to file and the parent company alone has control of the deposits, these special circumstances exceptionally justify considering the parent company and subsidiary as one entity for the purpose of R. 28 since the applicant has full control of the deposits and the actual depositor has acted only as executive organ for the applicant.

c. Late submission of deposit number

In **T 815/90** the Board of Appeal had to consider the question of failure to meet the time limit of sixteen months for indicating the deposit number for a patent application relating to micro-organisms, as required by R. 28(2)(a). The Board, following decision **T 418/89** which stated that Art. 83 requires not only that an invention can be carried out

at all but also that this can be done without undue burden, held in its interlocutory decision that it is decisive for sufficiency of disclosure that the public be informed of the deposit number. This number has to be stated in the application. The Board, disagreeing with decision **J 8/87** (OJ 1989, 9), concluded that “if an invention can only be carried out by a skilled person within the meaning of Art. 83 by using living material deposited with a recognised depository and only identifiable by the file number of the culture deposit, this is a precondition for sufficiency of disclosure of a patent application which must already have been fulfilled at the date of filing of the application and not a mere formal requirement of a patent application”. The Board referred to the Enlarged Board of Appeal the question whether the information concerning the file number of a culture deposit according to R. 28(1)(c) may be submitted after expiry of the time limit set out in R. 28(2)(a). The case is pending before the Enlarged Board under reference number **G 2/93**.

B. Claims

Article 84 lays down the relevant principles governing the content and wording of the claims, and is supplemented by R. 29, which provides that claims should be clear and concise and be supported by the description.

1. Clarity

1.1 Text of the claims

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).

Moreover, in decision **T 165/84** it was considered that the text of the claims lacks clarity when the exact distinctions which delimit the scope of protection cannot be learnt from them.

In decision **T 94/82** (OJ 1984, 75) the Board ruled that the requirement of clarity may be fulfilled in a claim to a product when the characteristics of the product are specified by parameters related to the physical structure of the product, provided that those parameters can be clearly and reliably determined by objective procedures which are usual in the art.

In addition, the Boards established two further general principles with regard to the requirements to be met by the text of the claims: 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”) are unallowable as contrary to R. 29(4) and (6), unless absolutely necessary, e.g. when a plurality of conditions would not lend themselves to verbal expression without such a reference. These cases include inventions containing features or limitations which can only be expressed by means of drawings or graphs defining a particular shape or a plurality of conditions.

On the other hand in **T 237/84** (OJ 1987, 309) the Board stated that the purpose of reference signs in a claim (R. 29(7)) is to make the claims easier for all to understand. They do not limit the scope of the claim but they do affect its clarity and may enable it to be expressed more concisely than would otherwise be possible.

In **T 115/83** and **T 32/82** (OJ 1984, 354) it was stated that Art. 84 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 clearly the object of the invention, 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. Both decisions were confirmed in **T 269/87**.

Decision **T 622/90** confirmed the opinion of the Board in **T 32/82** and said that lack of clarity can be caused not only by the presence of an ambiguous feature, but also by the absence of a feature which is necessary for clarity.

In case **T 271/88** the Board upheld **T 150/82** and decided that it is 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) were meant to cover structural chemical formulae. This interpretation is not affected by the terminology employed in the Guidelines, which deal with the meaning of other rules; nor can much help be derived in construing R. 29(6) from the express wording of R. 35(11). The mere fact that references to structural chemical formulae on separate sheets are accepted and even required by some national patent offices of the Contracting States cannot be relevant, let alone decisive, to the interpretation of the EPC. There is not much difference between reliance on references to the description and reliance on references to a separate sheet.

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, results to be achieved, functional or unspecified features.

1.2.1 Admissibility of disclaimer

In accordance with decision **T 4/80** mentioned above, disclaimers are admissible if the subject-matter remaining in the claim cannot technically be defined directly more clearly and concisely.

In decision **T 433/86** these principles were confirmed and the cases where disclaimers are applied were specified in greater detail: when there is an overlap between the prior art and the claimed subject-matter defined in generic terms, a specific prior art may be excluded even in the absence of support for the excluded matter in the original documents. Such an exclusion may be achieved by way of a disclaimer, or preferably in positive terms if this leads to clearer and more concise language.

The same principles apply when a smaller partial area of the generally defined subject-matter of the invention is to be excluded not in view of the state of the art but because it does not solve the technical problem (see **T 313/86**).

In decision **T 188/83** (OJ 1984, 555) the Board made it clear that the range is not rendered novel by the fact that the values calculated from the examples described in a citation are excepted by means of a disclaimer if these values cannot be regarded as individual.

In decision **T 170/87** (OJ 1989, 441) the Board established that a disclaimer can render new an inventive teaching which overlaps the state of the art, but cannot impart inventive step to a teaching which is obvious.

In decision **T 11/89** the Board held that claims containing a disclaimer should clearly show the technical features by which the claimed subject-matter is distinguished from the excluded subject-matter. The publication number of a patent specification is obviously not a technical feature and is therefore not appropriate for determining the scope of a disclaimer. The claim 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°....".

1.2.2 Features in the form of results to be achieved

In **T 752/90** the Board found that as a general rule, claims which attempt to define the invention, or a feature thereof, by a result to be achieved should not be allowed. However, they may be allowed if the invention can only be defined in such terms and if the result is one which can be directly and positively verified by tests or procedures adequately specified in the description and involving nothing more than trial and error.

1.2.3 Functional features

In decision **T 68/85** (OJ 1987, 228) the Board found that functional features defining a technical result are permissible in a claim if, from an objective viewpoint, such features cannot otherwise be defined more precisely without restricting the scope of the invention, and if these features provide instructions which are sufficiently clear for the expert to reduce them to practice without undue burden, if necessary with reasonable experiments. The Board further points out that "... the effort to define a feature in functional terms must stop short where it jeopardises the clarity of a claim as required by Art. 84."

The following decisions agreed with the one referred to above: **T 139/85**, **T 292/85**, **T 293/85**, **T 299/86**, **T 322/87**, **T 418/89**, **T 707/89**, **T 822/91**, **T 281/92**.

T 332/87 offers an interpretation of the Guidelines C-III, 4.8 and states, " This means only that it may 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 can only be considered as novel if this functional feature differentiates the product in substance from known products."

In **T 361/88** the Board distinguishes 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 is allowable if that feature provides a clear instruction to a skilled person to reduce it to practice without undue burden.

1.2.4 Unspecified features

Unspecified features are permitted on the following conditions:

a. It must not be possible to describe the invention in another way, without undue limitation of the scope of the claim and if the person skilled in the art can verify the result by tests involving nothing more than trial and error. This was the case, for example, in **T 88/87**, which ruled that, in order to define the scope of a claim as accurately as possible, an essential feature should be clearly specified. In the present case, the capability of springing back depended on several parameters such as, for example, the strength and resiliency of the material of the cap and the thickness of the central portion of the same. To avoid an undue limitation of the scope of the claim a functional characterisation relying on the resulting effect is allowable. The extent to which the applicator member should be capable of springing back can be specified by the indication of the effect to be produced (i.e. the freeing of the orifice) because the person skilled in the art can verify the result directly by tests involving nothing more than trial and error. Consequently, no objection is to be made to the clarity of the claims pursuant to Art. 84.

b. The meaning of the feature must be intelligible from the actual claim. Thus, the claim in case **T 487/89** was based on the fact that both the tenacity and the toughness had been indicated with a lower but no upper limit. The Opposition Division took the view that such "open-ended" parameters are always objectionable if they relate to an inherently desirable characteristic. The Board did not accept that view in its generality. Whether the absence of an upper or lower limit is acceptable in a claim in any individual case depends on all the surrounding circumstances. Where, as in the present case, the claim seeks to embrace values which should be as high as can be attained above a specified minimum level, given the other parameters of the claim, then such open-ended parameters are normally unobjectionable. This decision was upheld by **T 129/88** (OJ 1993, 598), **T 87/84**, **T 92/84**, and **T 136/84** (see also II.A. 1.1).

In **T 454/89** and **T 760/90** the Board rejected the claims containing unspecified features, although they would have been intelligible if they had been read in the light of the description. It was confirmed that it is not permissible to refer to the description to interpret claims. On the other hand, 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. (With regard to the problem of the interpretation of claims in general, see II.B. 4.)

This was also stated indirectly in decision **T 194/89** where the Board came to the conclusion that "approximately" was as such a very vague concept without any generally recognised technical meaning in the present context. Nor was there any support in the description or the drawings for how to interpret this concept in a reasonably clear way. 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.

2. Conciseness

In **T 79/91** the Board stated that the lack of clarity of the claims as a whole could arise from the lack of conciseness. The invention 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.

3. Claims supported by the description

Art. 84 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 does not include a feature described in the application (on the proper interpretation of the description) as an essential feature of the invention, and which is therefore inconsistent with the description, is not supported by the description for the purpose of Art. 84.

Similarly in case **T 888/90**, the appellant had removed from 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 *ab ovo* 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 decision **T 435/89** a process feature was missing from the apparatus claim. The Board took this as an objection that the claims were not adequately supported within the meaning of Art. 84. Nor could it be argued from this provision that a claim for an apparatus *per se* had to 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.

4. Interpretation of claims

The subject-matter of the claims is governed by Art. 84 and their function by Art. 69. According to Art. 84 the claims define the invention for which protection is sought. Under Art. 69 the claims determine the extent of the protection which will be conferred by the patent, through their definition of the invention. Under Art. 69 the description and drawings are used to interpret the claims. The question arises as to whether it is possible to interpret the claims in the light of the description and drawings as provided in Art. 69 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 62/88**, **T 89/89**, **T 121/89**, **T 476/89**, **T 544/89** and **T 565/89**, the Boards of Appeal laid down the principle whereby the description and drawings are used to interpret the claims when an objective assessment of the content of a claim has to be made to judge whether its subject-matter is novel and not obvious. In decision **T 50/90** the Board pointed out that the description and drawings are used to

interpréter relevant terms contained in the claims when the extent of protection has to be determined. In a large number of decisions (e.g. **T 23/84**, **T 327/87**, **T 238/88** (OJ 1992, 709), **T 416/88**, **T 194/89**, **T 264/89**, **T 430/89**, **T 472/89**), 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 and to determine the subject-matter of the patent. In **T 238/88** the Board stated that the fact that the features are not in fact usual terms of art does not rule out clarity and conciseness, since according to Art. 69 the description should be used to interpret the claims. In **T 2/80** (OJ 1981, 431), the Board pointed out that a claim does not comply with the requirement of clarity laid down in Art. 84 if it is not, per se, free of contradiction. It must be possible to understand the claims without reference to the description.

In decision **T 454/89** the Board shared this view and explained that Art. 84 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. The applicant's submission that it is the EPC's intention that the description be referred to where a claim lacks clarity presumably referred to Art. 69 and the Protocol on its interpretation. It was true that Art. 69 allowed the description to be used to interpret the claims. However, Art. 69 is only concerned with the extent of protection conferred as one of the effects of an application or patent whenever that extent has to be determined, particularly for third parties. It is not concerned with a claim's definition of the matter for which protection is sought, as is Art. 84. In the course of the examination or an opposition, therefore, the applicant or patentee cannot rely on Art. 69 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** (see II.B. 1.2.4).

5. Wording of the claims

R. 29(1) 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, and a characterising portion stating the technical features which, in combination with the features stated in the first part, it is desired to protect.

In decision **T 13/84** (OJ 1986, 253), the Board ruled that a claim in two-part form must be regarded as appropriate if there exists a clearly defined state of the art from which the claimed subject-matter distinguishes itself by further technical features. It cannot 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. Generally, the apparatus or process constituting the prior art which is nearest to the invention will have to figure in the preamble of the claim, stating such features of it as are necessary for the definition of the claimed subject-matter and which are in combination already part of this prior art. R. 29 makes no reference to the necessity or desirability that the characterising portion of the claim should fairly set out the inventive step. It is the subject-matter of the claim as a whole which embodies the invention and the inventive step involved. This decision was upheld by **T 162/82** (OJ 1987, 533), where the Board added that the extent to which prior art is cited in the description cannot be a determinative factor in deciding the question whether the one-part or the two-part form of a claim is

appropriate in a given case. Likewise, in decision **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.

In **T 170/84** (OJ 1986, 400), it was pointed out that where a two-part claim would lead to a complex formulation it is no longer appropriate. In a one-part claim, the features required for the definition which belong to the state of the art must be sufficiently clear from the description. This principle has been upheld *inter alia* in **T 269/84**, **T 278/86**, **T 120/86** and **T 137/86**. The latter two decisions stipulated that a two-part claim is not justified if it gives an incorrect picture of the state of the art. 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 stipulated that in opposition proceedings there is 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 does not belong to the state of the art. Furthermore, the Board sees R. 29(1) as an implementing regulation which does not constitute a ground for opposition (a similar view was held in **T 168/85**, **T 4/87** and **T 429/88**).

6. Product-by-process claims

6.1 Introduction

Under Art. 64(2) 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 as follows: it necessarily follows from Art. 64(2), 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 and notwithstanding the fact that such product is not new *per se*, by virtue of its physical characteristics (see **T 248/85**, OJ 1986, 261; similarly **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 extend 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) are admissible only if the products themselves fulfil the requirements for patentability and there is no other information available in the application which could enable the applicant to define the product satisfactorily by reference to its composition, structure or some other testable parameter.

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 can 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 cannot by itself give the product novelty. Furthermore Art. 64(2) does not confer novelty upon a claim which is formulated as a "product-by-process" when no novelty exists in such product per se, and does not entitle or enable an applicant for a European patent to include such claims in his patent which do not satisfy the requirements for patentability of Art. 52(1).

In **T 219/83** (OJ 1986, 211) the Board stated that "product-by-process" claims have to be interpreted in an absolute sense, i.e. independently of the process. If their subject-matter as such is new, they still do not involve an inventive step merely because the process for their preparation does so. In order to be patentable, the claimed product as such must be a solution to a separate technical problem which is not obvious in the light of the state of the art.

These criteria were confirmed by many decisions (see **T 251/85**, **T 563/89**, **T 434/87**, **T 171/88**, **T 493/90**), including recently **T 664/90**, where the Board stated that "once the product itself is part of the state of the art and is thus not novel according to the criterion of novelty as set out in Art. 54(1), the fact of defining this product by reference to a new process is irrelevant to the question of novelty. The use of a different parameter for defining a known product does not confer novelty to the product."

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 is not rendered new merely by virtue of a modification to the process. If a chemical product cannot be defined by structural characteristics but only by its method of manufacture, novelty can be established only if evidence is provided that modification of the process parameters results in other products. It is sufficient for this purpose if it is shown that distinct differences exist in the properties of the products. This evidence may not include properties which cannot be due to the product's substance parameters (similarly in **T 279/84**).

In decision **T 300/89** (OJ 1991, 480) it was stated that the application lacks novelty if the claim neither defines the product structurally nor mentions all the specific conditions needed to obtain necessarily the products whose novelty can be demonstrated, e.g. by means of comparative tests.

6.3 Requirement that the claimed product cannot be described in any other way

The criterion that it must be impossible to define the claimed product other than in terms of a process of manufacture was discussed particularly in the following decisions.

The Board stated in decision **T 320/87** (OJ 1990, 71) that product-by-process claims are admissible for hybrid seeds and plants when they are 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 formed by somatic cell fusion of a hybridoma cell and a lymphocyte or quadroma cells formed by somatic cell fusion of two hybridoma cells. The patentability of the process was not questioned; 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 antibod-

ies, which might be contained in the mixture of hybrids, could be screened out and isolated from molecules which might be bispecific but otherwise artificial because misfolding, mispairing or deamination might have occurred during the harsh chemical treatment of the starting materials. 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. The Board emphasised that the established case law of the Boards of Appeal, stating that a product is not rendered novel merely by the fact of being produced by means of a new process, was not called into question.

The Board stated in **T 487/89** that, although in general product-by-process claims are to be avoided, there may be circumstances where, although the product might be capable of being defined in terms of specific parameters, there are no such parameters available to the patentee for introduction into the claim, whereas process features taken from a sub-claim may overcome an objection of lack of novelty or lack of inventiveness.

6.4 Combination of product and process features

In decision **T 148/87** the Board stated that it is 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 may be permissible if their presence was desirable having regard to the impact of the national laws of one or more Contracting States.

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** the claim as granted related to a photographic emulsion characterised by having been prepared by specific manufacturing processes. The amended claim sought protection for only one of these processes. This process was disclosed in the original description. The Board stated that the change in category from a product-by-process claim to a manufacturing process claim was, in the circumstances of the case, admissible. The claim of the patent specification protected a product which was characterised by the processes described in this claim. In a case such as this, the protection afforded by the granted patent must necessarily extend to all those methods of manufacture covered by the processes described in the claim and disclosed in the patent specification. By restricting the claim to only one of these methods 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) to the amended claims.

7. Claims fees

R. 31(1) lays down that any European patent application comprising more than ten claims at the time of filing must, in respect of each claim over and above that number, incur payment of a claims fee. The Legal Board of Appeal ruled in case **J 9/84** (OJ 1985, 233) that R. 31(1) is to be interpreted as meaning that claims numbered 1 to 10 upon filing of the European patent application – or transmittal to the European Patent Office of the international application under the PCT – are exempt from fees, and that claims numbered 11 onwards are not. Accordingly, abandoning a fee-exempt claim after filing – or transmittal – does not have the effect that its fee exemption is 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).

In **J 5/87** (OJ 1987, 295) the Board had to consider this question for the first time. 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. Furthermore, the appellant had admitted that the addendum was included in the application in order to maintain the possibility of making its content a basis for substantive examination. As a result, the answer to the question regarding fees was in the affirmative, because, if the European patent system is to function properly, applicants are not at liberty to ignore the provisions on the form and content of the description and claims contained in R. 27 and 29.

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 that 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

According to Art. 82, 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. 30 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, which entered into force on

1.6.1991, but the principles set out by Board of Appeal case law can still be applied. The amended text of R. 30 includes the minimum guarantees set out in the previous text of the rule (see Notice from the EPO of 3.6.1991, OJ 1991, 300, 303).

The Boards of Appeal are also responsible for judging unity of invention when they decide on a protest made by an applicant against an additional fee charged by the EPO as ISA (see Art. 154(3)). Harmonisation of the definitions regarding the requirement of unity of invention in the PCT (R. 13, amended like R. 30) and the EPC (Art. 82 together with R. 30) means that the criterion of unity of invention in both systems will be subject to uniform assessment by search examiners and Boards of Appeal alike. The principles involved in unity of invention will therefore be dealt with as one.

2. General inventive concept

2.1 Independent claims

R. 30(1) states that where a group of inventions is claimed in one and the same European patent application, the requirement of unity of invention referred to in Art. 82 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 previous R. 30 EPC, 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) a product, a process adapted for the manufacture of the product and a use of the product;
- (b) a process and an apparatus for carrying out the process;
- (c) a product, a process for its manufacture and an apparatus for carrying out the process. The principles laid down in the case law as regards unity of invention were based on this fiction, which no longer exists now that R. 30 EPC and R. 13 PCT have been amended. However, as decision **W 13/89** expressly stressed, the principles set out in the case law of the Boards of Appeal remain unchanged.

In decision **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.

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.

In **W 13/89** the Board found unity of invention between a claim to the use of a substance or compound for the preparation of a medicine intended for a specific use (second medical use) and a claim to a pharmaceutical compound containing that substance (first medical use). This decision was confirmed in **W 5/91**.

In **W 6/90** (OJ 1991, 438) the Board defined the term “single general concept”. Such a concept manifested itself in features common to different teachings expounded individually in the same application. It must, however, be borne in mind 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. 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 be apparent already from the problem as stated. A single general concept might therefore be said to be present only if a partial identity existed among 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. For the purposes of unity of invention, R. 13.1 PCT also stipulated that the single general concept must be inventive. Even with a given single general concept there was lack of unity if the concept had no inventive character. 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. 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 **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.

In **W 32/92** the Board held that there was no unity of invention where the subject-matters of independent claims, including their effects, did not, in the parts of the claims differing from the closest prior art, present any common ground likely to contribute to inventive step.

In **W 10/92** the Board stressed that the problem-solution approach was to be applied to unity of invention.

A series of decisions laid down the principles to be applied when assessing unity of invention in the case of 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 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 the regulatory function of Art. 82

(prohibition of unjustified saving of fees, need for ready comprehensibility) was taken duly into account.

This decision was confirmed by **T 35/87** (OJ 1988, 134) and **T 470/91**. The intermediates in this 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. Therefore, the intermediates of the application were only made available with a view to obtaining the end products and they were sufficiently closely technically interconnected with the final products. Thus, they were integrated into a single overall inventive concept by being oriented towards the final 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.

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**).

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 whether this difference leads to the unity of dependent claims being assessed differently. Board of Appeal case law on PCT cases was uniform: the Boards repeatedly confirmed the principle that the requirement of unity had to be fulfilled by dependent claims too (see *inter alia* **W 3/87**, **W 2/88**, **W 30/89**, **W 32/89**, **W 26/90**, **W 8/91**, **W 54/91**). In EPC cases the Boards likewise assume that dependent claims have to fulfil the requirement of unity. The difference from the PCT procedure is that 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**).

3. Conditions for assessing unity of invention

Absence of unity may be immediately evident “*a priori*”, i.e. before the claims are examined in the light of the prior art, or may only become evident “*a posteriori*”, i.e. after the prior art has been taken into account.

For international applications the question arose whether the ISA had the power to assess unity of invention after an “*a posteriori*” examination of the application. In **W 3/88** (OJ 1990, 126) the Board had answered that 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 had been in the affirmative. In the latter cases the Boards had made reference to the PCT guidelines which permitted examination “*a posteriori*”. The President of the EPO had then referred the question to the Enlarged Board of Appeal (**G 2/89**). At the same time, 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 a decision in **G 1/89** (OJ 1991, 155) and **G 2/89** (OJ 1991, 166). It decided that the EPO in its function 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*”. 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 examining authorities. When an ISA considered that an international application did not comply with the requirement of unity of invention such consideration had only the procedural effect of initiating the special procedure laid down in Art. 17 and R. 40 PCT and was, therefore, not a substantive examination in the normal sense of that term. The requirement of unity of invention had to be examined on the basis of an objective criterion which must be the same for both search and examination.

After the Enlarged Board of Appeal’s decision, the Boards repeatedly used a lack of novelty or inventive step in the general inventive concept underlying the invention to justify lack of unity of invention (see **W 17/89**, **W 27/89**, **W 18/90**, **W 19/90**). According to **W 59/90**, determination of the technical problem to be resolved is essential for assessing unity of invention. This principle was confirmed *inter alia* in **W 17/91** and **W 14/91**. Where lack of inventive step cannot be detected immediately, it should be considered in cases of doubt that there is unity of invention (see **W 23/89** and **W 51/90**). In **W 24/90** the Board felt that for a decision establishing lack of unity “*a posteriori*” to be validly based, the lack of novelty or inventive step had to be immediately apparent and that if this requirement was not fulfilled reimbursement of the additional fees paid was warranted. In **W 21/89** the Board found that since, under the terms of R. 33.1(a) PCT, the prior art consisted of everything which 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 in one of the Contracting States designated it were not possible to cite these documents against a corresponding national patent application.

In **T 249/89** it was possible to discern a single general concept from the elements common to the different claims, i.e. from the common function of identical structural elements. The Board of Appeal felt that there was unity of invention since it had not been established with certainty that the common elements made no contribution at all to inventive step.

If the objection of lack of unity of invention was 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 22/92** and **W 52/92**).

4. Plurality of inventions and 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. 46(1) EPC or Art. 17(3)(a) PCT for each inven-

tion involved. If the fee is paid in due time the applicant may select the single invention or group of inventions that he wants 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) 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) 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) 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 applicant had not paid the further search fees. Instead the applicant must file a divisional application for that subject-matter if he wished to continue to protect it.

In the view of the Enlarged Board, it was clear from the procedural system of the EPC that the invention which was to be examined for patentability must 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 envisaged that an application progressed after filing from the Search Division to the Examining Division. One object of R. 46 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 relates, an applicant must pay such further search fees if he 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) in context. This confirms the practice according to **T 178/84** (see Guidelines C-VI, 3.2a).

5. Dispensing with the imposition of a further search fee

Where there is lack of unity in an international application, in particular if the objection is evident "a posteriori", the search examiner may decide to supplement the international search with a search on the additional inventions as well as the search carried out for the first invention, especially if the concepts of the inventions are very close and none of them require a search in different classification units, so that the search can be performed for all the inventions without creating too much extra work. In such a case no objection of lack of unity should be raised because the imposition of further fees would go against the principle of equity vis-à-vis the applicant (see **W 36/90** and **W 19/89**). In **W 15/91** (OJ 1993, 514), the Board made it clear in this respect that decid-

ing how much time the search would involve was entirely up to the ISA, which under the PCT was also responsible for classification of the international applications it searched. The ISA was thus beyond any doubt thoroughly familiar with the search documentation, which under the PCT had to be available in a form suitable for search purposes, and was thus competent to decide which classification units could reasonably be drawn on for the international search.

6. Consistency of description and claims

In **T 544/88** (OJ 1990, 429) the Board ruled that if an applicant, in response to a lack-of-unity objection under Art. 82, 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)) 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)). It would then be necessary to check in each individual case whether such adjustments ought to be deferred until allowable claims were submitted.

III. AMENDMENTS

A. Article 123(2) EPC

According to Art. 123(2) a European patent application or a 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.

1. Content of the application as originally filed

1.1 General issues

In decision **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).

Decisions **T 673/89** and **T 685/90** prohibit 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 to 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) against a younger application. From this it 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).

In **T 265/88**, the Board refused to allow the addition of originally undisclosed equivalents 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 157/90** and **T 397/89**, it was stressed that it is 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 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.

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) provided the problem as clarified and the solution proposed were deducible 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 citation of 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 special 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.

1.2 Disclosure in drawings

In **T 308/90** and **T 465/88**, the principle that the drawings are an integral part of the documents disclosing the invention was repeated. In **T 523/88** it was added that, during opposition proceedings, the claims could be clarified by features disclosed only in the drawings, provided the structure and function of the clarifying features were immediately and clearly evident from the drawings to a person skilled in the art, there were no contradictions with the rest of the disclosure and no subject-matter was being dropped. In **T 443/89**, the Board of Appeal gathered from a drawing the implicitly disclosed feature “rigid” for the cutting element of a silage cutter.

According to decision **T 145/87** a disclosure *expressis verbis* clearly constitutes only one possible source of disclosure for a teaching or a feature; a further possibility is a drawing including, as a special case, a graph representing a mathematical equation. The present 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 disclosed *expressis verbis*, could be deduced.

1.3 Cross-references

In **T 689/90** (OJ 1993, 616), 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) – 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.

2. Divisional applications

European divisional applications may only be filed in respect of subject-matter which does not extend beyond the content of the parent application (Art. 76(1), second sentence). All features disclosed in the divisional application must have been indicated in the description, claims or drawings of the parent application as filed.

In the decisions **T 527/88** and **T 514/88** (OJ 1992, 570), the Board extended the principles set out in rulings on Art. 123(2) to the relationship between divisional and parent applications. The subject-matter of the amended application or patent (i.e. the divisional application in this case) must be directly and unambiguously derivable from, and consistent with, the original disclosure (i.e. the parent application in this case).

Decision **T 176/90** is based on the principle that the parent application should disclose the invention of 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 requires the disclosure of the structure of the class, usually by means of a general formula, and an indication of a method of preparation. In the opinion of the first instance, the ethers and esters referred to in the divisional application could not be derived from the parent application since the latter only disclosed the corresponding alcohols. The Board took the view that it was true that in the parent application only alcohols as individual compounds were described, but the teaching was not restricted only to this. Rather, it also encompassed ethers and esters of the alcohols specifically defined by the general formula. Since the specific alcohols referred to in the parent application fell within the definition of the general formula and served to illustrate the general formula, the skilled person could infer from the total disclosure of the parent application the generic ethers and esters of these individual alcohols.

3. “Tests” for the allowability of an amendment

3.1 The “novelty test”

In **T 201/83** (OJ 1984, 481) it is stated that the test for compliance with Art. 123(2) is basically a novelty test, i.e. no new subject-matter must be generated by the amendment. This was approved in **T 136/88**.

In the decision **T 416/86** (OJ 1989, 309) it was held that the fact that a work tool is known (in this case a special shape of diaphragm) does not take away the novelty of its equivalents here, diaphragms of a different shape producing the same effect as the aforementioned diaphragm) even if these equivalents are themselves well known. It follows that the equivalents of a disclosed work tool must be considered new and therefore not disclosed if they are not mentioned in the original documents. According to these principles, the Board decided that the replacement of a specific feature disclosed in the invention by a broad general statement is to be considered as an inadmissible amendment under Art. 123(2) when this general statement introduces implicitly 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).

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 novelty of a more generic claim to cellulose fibres. The Board took the view that this approach is based on a misapplication of the novelty test. The test for additional subject-matter corresponds to the test for novelty only insofar as both require assessment of whether

or not information is directly and unambiguously derivable from that previously presented, in the originally filed application or in a prior document respectively. An amendment is not allowable if the resulting change in content of the application, in other words the subject-matter generated by the amendment, is 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 is important that it is the change in content which is tested, that is, the amended content minus the original content, so that the test is applicable to amendment by generalisation or omission of a feature.

The decisions **T 405/87** (according to which the allowability of an amendment depends on whether the added feature is “new compared with the original disclosure”) and **T 192/89** (according to which the question is whether “new matter has been introduced”) followed the same line.

3.2 The “is it essential” test

The second test developed by the Boards of Appeal for the allowability of an amendment, having regard to Art. 123(2) concerns the deletion of an essential feature. Here decision **T 260/85** (OJ 1989, 105) is of fundamental importance. It states that it is not permissible to delete from an independent claim a feature which the application as originally filed consistently presents as being an essential feature of the invention, since this would constitute a breach of Art. 123(2). **T 496/90** and **T 628/91** confirmed this case. 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. The Board 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, he might get the idea 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 58/86** it was decided that the independent claims of a divisional application exceeded in an impermissible way the disclosed content of the original application, since in each of them an essential feature of the relevant subject-matter of the original application was omitted; reinstating this feature would have led to a subject-matter that was already protected in the original application (double patenting).

That the original disclosure is the determining factor also appears 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) provided the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it is not, as such, indispensable for the function of the invention in the light of the technical problem it serves to solve, and (3) the replacement or removal requires no real modification of other features to compensate for the change.

3.3 Reconciliation of the “tests”

In **T 514/88** (OJ 1992, 570), the view is taken 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, are not contradictory but represent the same principle. In both cases the relevant question is whether or not the amendment is consistent with the original disclosure. This means direct and unambiguous derivability from and no contradiction of the totality of the original disclosure. (**T 527/88** and **T 685/90** follow the same reasoning.)

T 118/89 takes a more reserved attitude to the novelty test, but at the same time emphasises the importance of the above-mentioned key question, in stating that the allowability of amendments during the grant procedure can 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 is therefore no objective need to carry out new or modified novelty tests. The test for novelty is similar to that for allowability of amendments under Art. 123(2) only insofar as the former too involves 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.

B. Article 123(3) EPC

Art. 123(3) prohibits amendments to granted claims during opposition proceedings which extend the protection conferred by a European patent.

1. Generalisation of a feature

The Board of Appeal held in its decision **T 371/88** (OJ 1992, 157) that Art. 123(3) is not contravened if a restrictive term in a granted claim which in its strict literal sense does not embrace an embodiment set out in the description is 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 has to be quite clear from the description and drawings and also from the examination procedure up to grant that the further embodiment belongs to the invention and that it was never intended to be excluded from the protection conferred by the patent.

2. Moving features from preamble to characterising portion

In **T 96/89** the Board of Appeal 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) if terms were first generalised in the preamble, then trimmed back in the characterising portion to the subject-matter originally disclosed. Rule 29(1) 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. This was admissible provided the general term in the preamble was cut back in the characterising portion to the term originally disclosed.

In case **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 is determined by the content of **all** claims, not that of one or several only. Thus, for example, even though an independent claim lacks novelty a claim dependent on it can still be valid and the patent proprietor can restrict himself to that claim. It is, moreover, irrelevant when determining the extent of protection whether features are referred to in the prior art portion or characterising portion. The transposition of information from one to the other does not therefore contravene Art. 123(3).

3. Change of claim category

The Enlarged Board decision **G 2/88** (OJ 1990, 93) relates to a change of claim category in opposition proceedings, and in particular to the change from a product claim to a use claim. It states that a change of category of granted claims in opposition proceedings is not open to objection under Art. 123(3), if it does not result in extension of the protection conferred by the claims as a whole, when they are interpreted in accordance with Art. 69 and its Protocol. In this context, the national laws of the Contracting States relating to infringement should not be considered, for there is a clear distinction between the protection which is conferred and the rights which are conferred by a European patent. The protection conferred by a patent is determined by the terms of the claims (Art. 69(1)), 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)) are the legal rights which the law of a designated Contracting State may confer upon the proprietor. In other words, in general terms, determination of the “extent of the protection conferred” by a patent is a determination of what is protected, in terms of category plus technical features; whereas the “rights conferred” by a patent are related to how such subject-matter is protected.

When deciding upon the allowability of an amendment involving a change of category, the considerations are, in principle, the same as when deciding upon the allowability of any other proposed amendment under Art. 123(3).

An amendment of granted claims directed to “a compound” and to “a composition including such compound”, so that the amended claims are directed to “the use of that compound in a composition” for a particular purpose, is not open to objection under Art. 123(3). For it is generally accepted as a principle underlying the EPC that a patent which claims a physical entity per se confers absolute protection upon such physical entity, for all uses of such physical entity, whether known or unknown. It follows that if it can be shown that such physical entity (e.g. a compound) is already part of the state of the art, then a claim to the physical entity per se lacks novelty. It also follows that a claim to a particular use of a compound is in effect a claim to the physical entity (the compound) only when it is 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 confers less protection than a claim to the physical entity per se.

In decision **T 619/88** the Board of Appeal allowed a claim for a process for preparing substance X to be changed to a claim for the use of a compound Y to prepare X. Since the use claim related to the same use of Y as defined in the original process claim the claim category had not in fact been changed.

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. Provided the result of the activity is in itself patentable, such methods are also patentable unless the disclosure is insufficient.

C. Interrelation of Art. 123(2) and 123(3) EPC

1. Cases of conflict

In **T 384/91** the following question was referred to the Enlarged Board: whether given the requirements of Art. 123(2) and (3) 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 also limited its scope of protection. The conflict here was that the “limiting extension” had to be deleted as a breach of Art. 123(2), but to do so would broaden the scope of the patent and thus contravene Art. 123(3). The case is pending under reference number **G 1/93**.

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).

The Board of Appeal held it to be inappropriate to take paragraphs 2 and 3 of Art. 123 as independent of each other while applying them in conjunction to revoke the patent. This “paradox 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) was predominant, the added feature would have to be deleted in spite of Art. 123(3);

(b) If Art. 123(3) 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 the alternative (b); protection of third parties was 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** (see Case Law Report 1992, p. 41) a neutral feature of no particular value for the skilled person was added during the examination proceedings. The feature had no technical significance. The feature could stay in the claim, but could not be taken as delimiting when examining for novelty and inventive step.

In **T 938/90** (see Case Law Report 1992, p. 43), however, the addition was technically significant; it had to be taken into account in the examination for novelty and inventive step. Therefore, the Board declined to apply the principles developed in **T 231/89** and dismissed the patent proprietor's appeal against the revocation of the patent.

2. Resolving the conflict in exceptional cases

In some cases the conflict between Art. 123(2) and (3) 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** the Board concluded that Art. 123(3) 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. **T 673/89** and **T 214/91** followed **T 271/84** (OJ 1987, 405) and **T 371/88** (OJ 1992, 157) in ruling that amending a claim to remove an inconsistency did not contravene Art. 123(2) or (3) if the claim as corrected gave expression to the same thing as the correct interpretation of the uncorrected claim in the light of the description.

D. Rule 88, second sentence, EPC

1. Relation to Art. 123(2) EPC

The Boards have been called upon several times to discuss the question whether a correction under R. 88, second sentence, could be allowed even if the requested amendment would constitute an extension of protection within the meaning of Art. 123(2) over the disclosure made on the date of filing. In the decisions **T 401/88** (OJ 1990, 297) and **T 514/88** (OJ 1992, 570) the answer was negative. In **T 200/88** (OJ 1992, 46) the Board took a similar view with regard to Art. 123(3) and concluded that requests for correction under R. 88 and requests for amendment under Art. 123 must be considered separately.

A further question was whether, for the purposes of correction under R. 88, second sentence, the evidence that nothing else would have been intended than what was of-

ferred as the correction could take the form of documents filed only after the application. On this a different conclusion was arrived at in **J 4/85** (OJ 1986, 205) to that arrived at in **T 401/88**. As a result of a referral by the President of the EPO (**G 3/89**, OJ 1993, 117) and a referral 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). 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 doubt that a mistake existed, or whether nothing else would have been intended than what was offered as the correction.

2. Obviousness of the error and the correction

In the past, the Boards have allowed corrections under R. 88, second sentence, 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 correction required 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 decision **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. 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.

IV. PRIORITY

A. Identity of invention

1 General remarks

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) 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), such other application claiming a priority date within that period and designating one or more of the same States (see Guidelines C-V, 2.1).

In accordance with Art. 87 a European patent application is only entitled to priority in respect of the same invention as was disclosed in the previous application. This 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. Identical wording is not required (**T 81/87**, OJ 1990, 250; **T 184/84**).

In **T 497/91** the Board applied the principle set out in Art. 88(4), that in comparing the priority and subsequent applications the claims do have to be considered, but it suffices if the features claimed in the later application are disclosed by the earlier application taken as a whole.

However, there is no right to priority if any essential element of the invention for which a European patent is sought is missing in the previous application. The question is, therefore, what are the essential elements, i.e. features of the invention, claimed in the European patent application, and are these features disclosed in the priority documents (see **T 81/87**, OJ 1990, 250).

On the other hand, **T 409/90** (OJ 1993, 40) shows that a broad claim in the previous application is not necessarily a suitable basis for a priority right. Decision **T 409/90** was based on the principle that what is disclosed by a priority document is that which can be deduced from the priority document as a whole by a person skilled in the art. However, when considering what is disclosed in a priority document's claim it is necessary to bear in mind the purpose of the claim, that is, to define the protection sought. The fact that a claim in a priority document is broad enough to cover specific subject-matter filed for the first time in a later application is not by itself sufficient evidence that such a subsequently filed subject-matter has already been disclosed in the priority document, or that subsequent claims based on the later filed subject-matter define the same invention as that which is the subject of the priority document.

In this case the applicant had claimed priority from a Japanese patent application for a European divisional application. In the priority period, a document had been published which, together with a document which had appeared prior to the date of filing of the first application, anticipated the invention claimed in the European divisional application.

The applications related to an avalanche photodiode. The Board of Appeal was satisfied, as the Examining Division had been, that the two applications disclosed different

inventions. The problem in both cases was to reduce the dark current in avalanche photodiodes, but the disclosed solutions were different: a skilled person would deduce from the Japanese application that the dark current was reduced by the high doping of an intermediate layer, which had a shielding effect. This highly-doped intermediate layer was not found in the European application; the shielding effect was ascribed to the extremely low doping of the surface layer. This assessment was not affected by the fact that the claim in the first application also contained the features claimed in the second application.

2. Error margins

Error margins or routine alternatives can sometimes be claimed in the subsequent application without changing the substance of the invention as set out in the previous application.

In the case **T 212/88** (OJ 1992, 28) the invention related to a chemical product defined specifically by X-ray diffraction data set out in tabular form. The tables containing the X-ray data were not the same in the priority document and the European application, the latter including error margins for the calculations which had led to the given data. The Board held that the mere inclusion of error margins did not change the character or nature of the invention. Since the same invention was involved in both cases they were entitled to the right of priority.

In **T 581/89** all the specific technical features of the claims – which were not contained expressis verbis in the priority document – constituted nothing more than routine choices normally made by skilled persons. The Board of Appeal held that these specific features did not change what was believed to be “the invention” as such; the requirement of Art. 87(1) that a priority right has to be granted “in respect of the same invention” was therefore met.

3. First application in a Paris Convention country

In principle, only the first application filed in a Paris Convention country can form the basis of a priority right. As far as the EPC is concerned, this is made clear in Art. 87(1).

If, apart from the application whose priority is being claimed in the European subsequent application, an earlier previous application was also filed (and particularly if this was done outside the priority period), it must be established whether the invention claimed in the subsequent application was disclosed in the earlier application and a priority claim based on the later previous application is therefore invalid. 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 invention claimed in the subsequent application was already disclosed in the earlier previous application taken as a whole or only in the later one.

In **T 323/90** the Board compared the alleged first application with the subject-matter of the European patent and concluded that the former disclosed a different invention from the European application and the application whose priority was 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. The Board of Appeal had adopted the same approach in **T 184/84**.

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 255/91** (OJ 1993, 318; see also IV.B. 2.) the Board of Appeal examined whether the earlier previous application destroyed the novelty of the later one to establish whether the priority claim based on the later previous application was valid.

4. Reproducible disclosure in the priority document

The Boards of Appeal require a cited document to contain a reproducible disclosure for it to destroy novelty (**T 206/83**, OJ 1987, 5). According to this principle, the priority document must also disclose the invention claimed in the subsequent application in such a way that a skilled person can carry it out.

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 the disclosure of the essential elements, i.e. features of the invention, in the priority document must either be express or be directly and unambiguously implied in the text as filed; missing elements recognised as essential only later on are not part of the disclosure and gaps with regard to basic constituents cannot 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; such criticality is particularly relevant for features necessary to prepare the prorennin gene, because these are not contained in the state of the art, and can only be provided by the invention itself. In conclusion, the Board held that the first priority document did not disclose all the critical features of the claimed invention as required; these only appeared in the second priority document and in the European application.

Reproducibility also had to be decided in **T 212/88** (OJ 1992, 28). The respondent (opponent) had contested the right of priority by alleging that the priority document did not sufficiently identify the final product. The latter had been defined in the claim by means of data obtained when carrying out Example 1. Since the example was based on a starting product not available to the skilled person the invention could not, according to the respondent, have been reproduced. The Board rejected this argument on the ground that the skilled person would have had no difficulty in identifying the final product from the data given in the priority document.

B. Limiting the extent of protection

In **T 73/88** (OJ 1992, 557) and **T 16/87** (OJ 1992, 212) the Board took the view that a priority right is not lost if the subsequent application contains a claim feature which was not disclosed in the previous application but merely limits the extent of the patent's protection compared with the disclosure in the priority document, so long as the character and nature of the claimed invention are not changed by the additional feature.

In **T 73/88**, the application claimed as conferring priority was British and the invention was described as follows: the provision of an expanded snack food comprising discrete cooked portions of a dough composition comprising gelatinised starch and added bran. The invention involved the technical effect that the addition of bran did not lead to an undesirably low level of expansion in the end product; in its broadest form, as described and claimed in the British application, the invention was not concerned with the inclusion of oil or fat in the product at all; in the description it was made clear that the possibility of a relatively low fat content for a product according to the invention when cooked by frying was a property of the invention, but neither cooking by frying nor the inclusion of fat or oil in the product were part of the invention as such as is described in the British application. The invention described and claimed both in the European patent application as filed and in the granted European patent included an additional technical feature in the pre-characterising portion of Claim 1, namely that the expanded snack food product contained "at least 5% by weight of oil or fat".

The Board established in its decision that this additional feature was clearly an essential technical feature of the claims in that it had the effect of limiting the extent of the protection conferred by the patent, so that products which did not have at least 5% fat or oil did not fall within the protection conferred. However, the inclusion of a technical feature in a claim which is essential for the purpose of determining the scope of protection conferred is not necessarily an essential feature for the purpose of determining priority. In this present case it was clear from the European patent that the additional technical feature concerned the provision of a "fried flavour" to the claimed snack food, and had nothing to do with the essential character and nature of the invention as such, this of course being what has to be considered when deciding upon a claim to priority. The effect of this additional technical feature was really to disclaim some snack products which accord with the essence of the invention as such, but which do not have a fried flavour, and thus to limit the claimed invention to a particular class of products. The presence of this additional feature in the claims of the European patent did not therefore change the character and nature of the claimed invention as such compared with what was disclosed in the priority document, i.e. the British application.

In decision **T 16/87** (OJ 1992, 212), the patent's subject-matter was a catalytic converter for treating exhaust fumes from combustion engines. The opponent had alleged lack of novelty on the ground that a German patent specification published between the priority date and the date of filing disclosed embodiments of the claimed catalytic converter. He alleged that this document was prejudicial to novelty because the French priority had not been validly claimed; the European patent application's claims contained the additional feature of the weight ratio between two components in the catalytic converter which had not been revealed in the priority document. The Board did not share this view. Apart from the weight ratio, the European application contained all the features of the earlier application and, to that extent, priority had been

validly claimed. Moreover, the priority claim was valid in all respects because the added feature did not change the character of the invention claimed in the priority document, but merely constituted a voluntary limitation on the protection sought. The document published after the priority date which would have been prejudicial to novelty was therefore not part of the state of the art to be taken into consideration. This approach was reaffirmed in **T 582/91** (see Case Law Report 1992, p.45).

The view that a voluntary limitation on the protection sought in the subsequent application does not destroy the claim to priority can also work to the applicant's disadvantage, because the same principle must be applied when deciding which of two previous applications represents the invention's first filing. In **T 255/91** (OJ 1993, 318), the legal predecessor of the applicant had filed an application (1) with the USPTO in 1983, the priority of which was claimed in respect of a European application (2); (2) was published on 3.4.1985. The current applicant had filed a further application (3) in the USA on 19.3.1985, from which he claimed priority for an application (4) filed with the EPO on 14.3.1986.

The Board had to consider whether (1) or (3) was the first application in respect of the invention claimed in (4). To answer this question, it examined whether (1) destroyed the novelty of (3). The difference between the two applications resided in the ratio between two pressures: (3) disclosed for the second pressure a range of between atmospheric pressure and 0.75 times the first pressure (which was between atmospheric pressure and 10 atmospheres), excluding 0.56 and 0.67 times the first pressure; (1) disclosed that the second pressure was smaller than the first and greater than atmospheric pressure, without giving an upper limit or excluding particular pressure ratios. The Board came to the conclusion that (1) did not contain anything to prevent a skilled person applying the teaching disclosed in it in the range claimed in (3). The scope of protection in (3) had been restricted, but the nature of the invention remained unchanged. The applicant could thus no longer claim priority from (3) in respect of (4), as the same invention was already contained in (1). The novelty of (4) was thus determined by the date of filing and was destroyed by the publication of (2).

C. Partial and multiple priorities

In cases where partial or multiple priorities can be validly claimed the subject-matter of the subsequent application has two or more operative priority dates. In the case of a partial priority that part of the subsequent application's subject-matter 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. Where the priority of two or more previous applications is claimed, any claim in the subsequent application has the priority date of the previous application in which the matter claimed in the subsequent application was disclosed. Several priorities can be claimed for a particular claim (Art. 88(2), second sentence).

In such situations the question arises as to whether publication of the content of an application forming the basis of a priority during the priority period belongs to the state of the art which can be cited against those parts of the subsequent application which have a priority date after the date of publication. In **T 301/87** (OJ 1990, 335) the

Board decided that this was not so. In this case the European patent application claimed three priorities (I, II, III). One of the authors of the invention had published a document, after the date of the first application (I), but before the date of the second application (II), covering exactly the same invention as the first application. The second application (II) and also the European patent application claiming all these priorities represented developments of the invention compared with the first application. The claims at issue – 2 (d) and 12 – contained features not disclosed in the first priority application (I) but only in the second (II).

In the Board's view the legal position could be summarised as follows. When priority is claimed for a European patent application under Art. 88, the publication (or any other disclosure within the meaning of Art. 4 B of the Paris Convention) of the content of the priority application in the interval between the filing of that application and the filing of the (final) European patent application cannot be used as state of the art against any claim in the latter application. However, if such publication goes beyond the content of a previously filed application and includes subject-matters not covered by the disclosure of that application, such disclosure may in principle be cited against any claim in the (final) European patent application relying on a priority date subsequent to the publication date.

The Board substantiated its view as follows: According to the provisions of Art. 4 B of the Paris Convention any subsequent filing during the priority year "shall not be invalidated" by, *inter alia*, the publication of the invention as covered by the first filing in the priority interval. This means, in particular, that such a publication will neither destroy the novelty of the invention for which priority is claimed in the subsequent filing, nor diminish the inventive step embodied in it, as considered at the date of the first application on which the right to priority is based. This is, of course, aimed at enabling and even encouraging the inventor to make his invention known at an early stage, which is fully consistent with one of the basic objects of the patent system, namely to promote a rapid spread of information and technology.

The President of the EPO has put before the Enlarged Board of Appeal the question whether a document which was published within the priority period and whose technical content corresponds to that of the priority document can be said to form part of the state of the art under Art. 54(2) and therefore cited against a European patent application, if the priority claim is invalidated by the fact that the European application contains subject-matter not disclosed in the prior application (**G 3/93**).

In his referral, submitted to ensure uniform application of the law and in view of the fundamental importance of this point of law, the President drew particular attention to **T 441/91**. Here too the contents of the priority document were published prior to the filing of the subsequent European application. The Board held that the subsequent application contained an additional feature, not disclosed in the previous application, which was absolutely necessary for solving the problem set out in the subsequent application. Hence, the claim in the disputed patent defined a different invention to that disclosed in the priority document and the claim's subject-matter could thus only be ascribed the priority of the European date of filing. The publication of the technical content of the priority document therefore had to be taken into account as prior art when examining for novelty and inventive step. If, however, the Board had applied the principles set out in **T 301/87**, it would not have been allowed to regard the publication of the technical information contained in the priority document as prior art.

V. RIGHT TO A EUROPEAN PATENT

In **J 1/91** (OJ 1993, 281) the Legal Board of Appeal referred to the Enlarged Board a question concerning European patent applications filed by persons not having the right to a European patent. The Board was called upon to consider the application of Art. 61(1)(b) 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 was 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) of the UK Patents Act 1977. The appellant was thus allowed under Section 12(6) of the UK Patents Act 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) in 1990.

The Legal Board of Appeal took the view that the Comptroller's decision was a final decision within the meaning of Art. 61. 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 EPC, that being a matter to be dealt with by the EPO under Art. 61.

The Board then went on to consider whether pendency was required under Art. 61. As the article was open to differing interpretations, the Board therefore decided to refer to the Enlarged Board the following point of law: "Where 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), files a new European patent application in respect of the same invention under Art. 61(1)(b), is it a precondition for the application to be accepted that the original usurping application still be pending before the EPO at the time the new application is filed?" The case is pending under **G 3/92**.

VI. PROCEEDINGS BEFORE THE EPO

A. Rules common to all proceedings – general principles

1. The principle of good faith

One of the general principles of law which is well established in European Community law and which is generally recognised among the Contracting States of the EPC and within the jurisprudence of the Boards of Appeal is the protection of legitimate expectations. This principle is applicable having regard to the good faith existing between the EPO and its users. In the application of this principle to procedure before the EPO, 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).

The principle of good faith governs relations between the EPO and applicants for European patents in procedural matters (**J 10/84**, OJ 1985, 71). In accordance with this principle, a communication from the EPO containing erroneous information which had led the applicant to take action causing the refusal of his patent application is null and void in its entirety (**J 2/87**, OJ 1988, 330).

In **T 14/89** (OJ 1990, 432) the Board pointed out that the principle of good faith requires that the applicant have his attention drawn to deficiencies in his application for re-establishment of rights which are obviously easy to correct if correction of the deficiencies can be expected within the two-month time limit for re-establishment of rights under Art. 122(2).

This principle was also applied in Legal Board of Appeal decision **J 5/89** after misleading information was given by the EPO and also in that Board's decision **J 11/89** on account of the Receiving Section's failure to take any particular action upon the receipt of Japanese patent documents to be considered as priority documents.

Decision **J 1/89** (OJ 1992, 17) elaborated on those previous rulings. The Board held that an applicant must not be disadvantaged by relying on a misleading EPO communication which causes him to make a late payment, even if despatch of such communications is a **voluntary service** provided by the EPO. On the contrary, the applicant can rely on the accuracy and completeness of any such voluntary service. However, the Board reaffirmed its earlier ruling that the applicant cannot rely on having communications sent to him if this service is not prescribed by the EPC. Such communications include those relating to late payment of renewal fees.

2. Oral proceedings

2.1 Right to oral proceedings

The right of parties to oral proceedings in examination, opposition and appeal proceedings is enshrined in Art. 116, 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. The right to an oral hearing is an extremely important procedural right which the EPO should take all reasonable steps to safeguard. Considerations such as speedy conduct of the proceedings, equity or procedural economy cannot take precedence over the principle of the right to oral proceedings (**T 598/88**).

In **T 383/87** it was pointed out that Art. 116(1) guaranteed the right of any party to request oral proceedings, i.e. to argue his case orally before the relevant department of the EPO. A party may feel that he can present his case better orally than in writing, even if he has no new arguments. It is then his genuine right to request oral proceedings without being inhibited by the fear of having to pay additional costs, unless the request for oral proceedings is a clear abuse of law.

In **T 125/89** the Board emphasised that Arts. 113(1) and 116(1) 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, without contravening the provisions of Arts. 113(1) and 116(1) (see also **T 303/86** and VI.D. 7.3.1).

2.2 Discussion with the examiner

A distinction must be drawn between oral proceedings and an informal discussion with the examiner. 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 EPC. 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, 6.1a). In **T 98/88** it was stated that Art. 116 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 19/87**, OJ 1988, 268).

2.3 Request for oral proceedings

The question whether a request for oral proceedings has been made must be decided in each case on the individual facts of the case. If there is the slightest doubt, clarification should be sought from the party concerned. However, there is a clear distinction between actually “making a request for oral proceedings” and “reserving the right to make a request for oral proceedings”. Whether a request for oral proceedings will be granted depends on its wording, which must be clear and unequivocal.

2.3.1 Wording of request

In the 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”. This was interpreted as meaning that the party had not yet decided whether to request oral proceedings. In **T 263/91** this case law was confirmed. The Board considered that the statement “the patent proprietors reserve the right to oral proceedings” is not to be construed as an actual request for oral proceedings. By using the word “reserve” the proprietors conveyed the message that they wanted to leave it at that for the moment and that they did not want to take action at that time.

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. Also the statement “If there are any out-

standing problems, the writer would welcome an opportunity to discuss the case with the Examiner” was not understood as a valid request for oral proceedings (see **T 88/87**).

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.

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.

2.3.2 Withdrawal of request

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 he 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.

According to **T 663/90** a request for oral proceedings by a party can only be deemed to have been withdrawn if a clear written statement to that effect is on file. If there is no unequivocal proof of withdrawal of the request, it must be assumed that the request, once submitted, continues to exist. It therefore also existed at the time of the contested decision.

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.”

As a rule, a party’s silence cannot be interpreted as withdrawal of a request for oral proceedings.

In **T 35/92** the patent proprietor did not reply to a communication asking him to state whether his request for oral proceedings on an auxiliary basis should be maintained. The Board stated that while it was reasonable for the Opposition Division to expect a response and its request 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) could only be withdrawn by a declaration to this effect. There was no basis in the EPC for withdrawal to occur by virtue of inaction, i.e. mere silence. Art. 116, at any rate, did not provide for a party’s silence to have such an effect, which was tantamount to its forfeiting a right.

In **T 766/90** a notice from the formalities officer which granted the proprietor of the patent an extension of up to seven months to respond to the communication of the Opposition Division stated that if a reply had not been received in due time, the procedure would be continued. The Board held that this should not, however, be construed as indicating that a decision would be issued should the patent proprietor fail to re-

spönd. The Opposition Division was in error in construing the silence of the proprietor of the patent in response to the communication as a withdrawal of the request for oral proceedings.

2.3.3 Further oral proceedings

In **T 441/90**, at the conclusion of the oral proceedings the Opposition Division set time limits for the parties to file further evidence and directed that the proceedings were to be continued in writing. The Board stated that such an order in no way inhibited any of the parties from asking for further oral proceedings if they saw fit. However, having made such an order, and in the absence of another formal request for oral proceedings, the Opposition Division was plainly absolved from appointing any further hearing, or even inquiring of the parties whether they wished to be heard further.

2.3.4 Non-appearance at oral proceedings

Deliberate absence from oral proceedings in conjunction with the principle of the granting of the right to present comments is discussed in VI.A. 3.4.

2.4 Infringement of Art. 116 EPC

If a party submits a written request for oral proceedings, the relevant department is obliged to set a date for such proceedings. If the request is ignored, the decision must be set aside as null and void (**T 560/88** and **T 766/90** (see above)). In **T 93/88** an opponent's request for oral proceedings was not granted due to an oversight on the part of the Opposition Division. The Board decided that the decision issued by the Opposition Division in written proceedings must also be set aside as null and void.

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 VI.E. 10.3.1).

2.5 Fixing or postponing the date for oral proceedings

In a notice dated 21.4.1987 published in OJ 1987, 168, a new procedure for fixing the date for oral proceedings was described. This procedure was later modified by a notice of the Vice-Presidents Directorates-General 2 and 3 of 14.2.1989 (OJ 1989, 132). The main innovation was that the EPO would no longer reserve a meeting room for a whole week until agreement on a date had been reached, but would instead specify two concrete alternative dates. Moreover, it was pointed out that the EPO intended to maintain its policy of bringing cases to a conclusion as quickly as possible.

The principles on which **T 320/88** (OJ 1990, 359) was based continue to apply. The Board explained in this connection that the fixing of the date for oral proceedings was a matter to be arranged by the Registrar in conjunction with the parties concerned. In the event of a conflict between the Registrar and one or more of the parties, the Board itself might decide the matter, taking into account the interests of the parties and those of the EPO.

In **T 275/89** (OJ 1992, 126) the Board considered that the illness of a duly represented party was not sufficient to justify the postponement of appointed oral proceedings

unless the ill party 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).

2.6 Curtailment of notice in the summons

According to R. 71(1), second sentence, the notice given in the summons to oral proceedings must be at least two months, unless the parties agree to a shorter period. In **J 14/91** (OJ 1993, 479) (see also VI.A. 11.2), the Legal Board of Appeal severely curtailed the notice. The Board referred to Art. 125 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 quick hearing. Although the EPC did not itself contain any regulation 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 depended on the individual case, taking due account of the circumstances.

2.7 Taking of minutes during opposition proceedings

In **T 396/89** there was a 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 decisions on that concession, unless it was convinced 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.

3. Right to present comments

3.1 Introduction

According to Art. 113(1) 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 being given in a decision turning down his request on which he has not had the opportunity to comment. If a decision does not take into account arguments submitted by a party and is based on a ground on which the party has had no opportunity to present his comments, this represents a contravention of Art. 113(1) and a substantial procedural violation (see **J 7/82**, OJ 1982, 391). In principle, this justifies reimbursement of the appeal fee. Art. 113(1) is also important in connection with the right to oral proceedings laid down in Art. 116(1).

Due process of law as required by Art. 113 has not been applied when 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).

In **J 3/90** (OJ 1991, 550) the Board stated that where the EPO has made an examination of facts of its own motion (Art. 114(1)) the fundamental principle according to Art. 113(1) is not observed unless the parties concerned have been fully informed about the enquiries made and the results thereof and then given sufficient opportunity to present their comments before any decision is issued.

According to **T 243/89**, however, Art. 113(1) does not require that the applicant be given repeated opportunities to comment on the argumentation of the Examining Division, so long as the decisive objections to the grant of the European patent remain the same and the grounds for these objections have been presented to the applicant, in full and in due time (see **T 161/82**, OJ 1984, 551)

3.2 Right to oral proceedings as an essential element of the right to present comments

In **T 209/88** the Board stated that non-compliance with a request for oral proceedings deprives the party of an important opportunity for presenting his case in the manner he wishes and using the possibilities open to him under the EPC. In view 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 is considered to represent an essential part of the requirement under Art. 113(1) that the party must be given sufficient opportunity to present his comments on the grounds for the decision (reaffirmed by the same Board in **T 560/88**).

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 check the admissibility of the amendments.

In **T 330/88** the Board held that the right to present comments had not been contravened because a relevant document had been 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.

3.3 Right to present comments in opposition proceedings

Several decisions focused on the principle of guaranteeing the right to present comments during opposition proceedings when issuing an invitation under Art. 101(2). According to this provision the Opposition Division invites the parties, as often as necessary, to file observations, within a period to be fixed by the Opposition Division, on communications from another party or issued by itself.

In **T 275/89** (OJ 1992, 126) the Board gave its interpretation of the word **necessary**. An invitation to file observations has to be issued only if this is necessary for clarification purposes or to comply with the requirement under Art. 113(1). If a party has been given such an opportunity he is not entitled to receive a communication under Art. 101(2).

In **T 669/90** (OJ 1992, 739) further comments by the respondent on new documents had been sent to the appellant without inviting him to file observations prior to the issue of a decision adversely affecting him on the basis of those documents. In the Board's view, even if Art. 113(1) has been formally complied with in a particular case, it is necessary for the EPO to invite a party pursuant to Art. 101(2) to file observations on a communication from another party or issued by itself, if failure so to invite that party would result in unfair procedure or a violation of the principle of good faith. In this connection, it is of fundamental importance that a party to proceedings should not be taken by surprise by the grounds or evidence on which an adverse decision is based. The issue of the Opposition Division's decision without first informing the appellant in a further communication that the newly introduced documents were not only considered to be sufficiently relevant to be admitted but also potentially decisive against him, and without inviting him to file observations, was contrary to Art. 113(1).

In this connection the Board of Appeal drew attention in its decision **T 190/90** to the fact that in inter partes proceedings such as opposition proceedings the right to present comments is inextricably linked to the principle of equal rights, also referred to in this context as the right to be judged impartially. 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.

In **T 716/89** (OJ 1992, 132) the Board of Appeal decided that the right to present comments meant that the patent proprietor should, under R. 57(1), be informed of the opposition and invited to comment before a decision to revoke the patent is issued. This principle also applies if the patent proprietor files an opposition against his own patent. In the case in point only one of the two patent proprietors had filed an opposition. The co-proprietors of the European patent – both affiliates of a multinational company – had very similar names. The Board stated that, at least a communication should have been sent to the patent proprietor who had not lodged an opposition.

3.4 Non-appearance at oral proceedings and the right to present comments

Differing views have been expressed in some decisions of the Boards of Appeal concerning the extent to which a party forgoes its right to present comments by choosing not to attend oral proceedings. Drawing attention to **T 574/89** and **T 484/90** the President of the EPO has referred to the Enlarged Board of Appeal the question of whether, if one party chooses not to attend oral proceedings, the decision handed down against that party can be based on new facts, evidence and/or arguments put forward during those oral proceedings. The case is pending under reference number **G 4/92**.

In **T 484/90** (OJ 1993, 448) the respondent had sent a fax citing a new document three days prior to the oral proceedings. The appellant was unable to attend the oral proceedings, because his flight to Munich had been cancelled due to a snowstorm. At the end of the oral proceedings the Opposition Division decided to revoke the European patent on the basis of the new document. The Board held that a decision against a party duly summoned to but failing to appear at oral proceedings which is based on new evidence, such as a new document, on which that party has not had the opportunity to comment, may not be pronounced at the close of those proceedings without infringing the party's right to be heard, unless the absent party indicates that it is forfeit-

ing this right. Otherwise the proceedings must be continued in writing or new oral proceedings convened. The non-appearance of a party at the proceedings, even if intentional, should not be interpreted as a renunciation of such a basic right as the right to submit comments.

In **T 574/89**, however, the Board held that, even taking into account the right to present comments, the test results submitted at the oral proceedings had to be considered. The two respondents would have had the opportunity to comment on them during those proceedings. By choosing to stay away from the oral proceedings, they had forfeited their right to present comments (see **T 3/87**, **T 186/83**, **T 215/84** and **T 561/89**). Thus any arguments or evidence submitted by the parties present at oral proceedings can be used as a basis for the decision without it being relevant whether such evidence or arguments were already known to the absent parties from the written submissions or whether they could expect such evidence or arguments to be presented. In the case in point, the appellant had even announced that he would be carrying out precisely described comparative tests.

In **T 435/89** the Board referred to **T 574/89** and stressed that the main purpose of oral proceedings was to discuss with the parties all the facts required for taking a decision. A party freely deciding not to avail itself of this opportunity could not then demand that any new arguments put forward during those oral proceedings first be made known by the Board in writing before an appeal could be decided. This did not constitute a denial of the right to be heard under Art. 113(1), as the party concerned could have attended the oral proceedings and had thus had the opportunity to comment on the oral arguments (see also **T 696/89**).

4. Time limits

4.1 Calculation of time limits

4.1.1 Calculation problems

In **J 14/86** (OJ 1988, 85) the Legal Board of Appeal ruled on the calculation of time limits under R. 83 as follows: The fact that R. 83(2) fixes the point in time from which all the time limits run and defines this point as the day following that on which the event giving rise to the time limit occurred, cannot 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 derives from R. 83(3) to (5). These paragraphs, in conjunction with paragraph 2 of the same rule, establish unequivocally that the time limits are 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 is identical, but its wording largely avoids the lack of clarity found in R. 83.

In **J 13/88** the Legal Board gives an example of how to calculate time limits referring to the above-cited case law. In the case in question the 12-month priority period had to be calculated. The event with reference to which the point in time from which a time limit starts to run is the filing date of the application in respect of which priority is claimed, which was 5.5.1986. The period referred to in Art. 87 is expressed in months; it expires in the relevant subsequent month, (i.e. in this case May 1987) on the day

which has the same number as the day on which the said event occurred, which was 5.5.1987 (R. 83(2) in combination with R. 83(4)).

4.1.2 Public holiday in one of the filing locations

The amendment made to R. 85(1) with effect from 1.8.1987 ensured that time limits would expire at the same time even where there was a public holiday in only one of the filing locations (Art. 75(1)(a)). This rule relates both to the time limit for filing documents, cheques and debit orders and to payments not assignable to any particular filing location, such as for example, payment by means of a bank transfer (for the legal position prior to 1.8.1987 see **J 1/81** (OJ 1983, 53) and **J 30/89**, Case Law Report 1989, p. 45).

4.1.3 Calculation of the additional period for renewal fees

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), R. 83(4) should be applied *mutatis mutandis* in the light of R. 37(1), first sentence. This means that the six-month period does not end on the day of the subsequent sixth month corresponding “in number” to the due date according to R. 37(1), first sentence, but on the day which is 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(3), therefore, R. 83(4), in the context of R. 37(1), first sentence, results in a period running from “the last day of the month to the last day of the month”.

The Legal Board then considered Legal Advice No. 5/80 on “Calculation of aggregate time limits” (OJ 1980, 149, 152, old version) as a possible breach of the “last day of the month” rule, since it mentions in passing that the principles contained therein should also be applied to the additional period under Art. 86(2) EPC. The Board held that “Legal Advice No. 5/80 is not applicable to the start of the additional period under Art. 86(2)”. This means that the additional period starts on the last day of the month specified in R. 37(1), first sentence, even in the circumstances mentioned in R. 85(1).(2) and (4) EPC. It follows that the occurrence of such circumstances at the beginning of the period does not result in the end of the period being postponed beyond the end of the sixth month and into the seventh month. Legal Advice No. 5/80 was superseded by Legal Advice No. 5/93 rev. (OJ 1993, 229) which takes into account the amendments to R. 85a, 85b and 104b(1).

4.1.4 Subsequent payment of designation fees

In **J 5/91** the Legal Board of Appeal was asked to rule on how R. 85a should be interpreted where the time limit under paragraph 1 for the subsequent payment of designation fees for the designation of Contracting States in connection with a European application expired later than under paragraph 2. The new version of R. 85a(1) which came into effect on 1.4.1989 states that if the designation fees are not paid within the specified time limit the EPO must notify the applicant that they may still be validly paid within a period of grace of one month. The two-month period of grace without notification under R. 85a(2) continues to apply to precautionary designations. The Board

therefore concluded: “In cases where the time limits for subsequent payment of designation fees under paragraphs 1 and 2 of R. 85a expire at different times, all designation fees can still validly be paid up to the later date”.

The calculation of the payment for the designation fees is also dealt with in Legal Advice No. 5/93 as revised (OJ 1993, 229).

4.2 Further processing – refusal of a request for extension of a time limit

The rejection of an application for extension of a time limit under R. 84, second sentence, is not a decision subject to appeal within the meaning of Art. 106, because it does not terminate the proceedings as regards the applicant. In **J 37/89** (OJ 1993, 201) the Legal Board of Appeal used the occasion to clarify how the rejection of an application for extension of a time limit under R. 84, second sentence, can be reviewed. The Board held that the applicant can overcome a loss of rights under Art. 96(3) resulting from rejection of an extension by requesting **further processing** in accordance with Art. 121. At the same time, he may request reimbursement of the fee for further processing. This secondary request will have to be decided on in connection with the final decision. Under Art. 106(3), the decision on the secondary request can be appealed together with the final decision. The appeal may also be confined to contesting the decision on the secondary request.

4.3 Interruption of proceedings – R. 90 EPC

In accordance with R. 90(1)(a), which the EPO must apply of its own motion, the legal incapacity of an applicant or his representative has the effect of interrupting proceedings.

Legal incapacity of the **representative** under R. 90(1)(c) is incapacity to carry out professional work before the EPO, and must be of a persistent nature (**J ../86**, OJ 1987, 528). For the purposes of R. 90(1)(c) 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 may have been interrupted (**J ../87**, OJ 1988, 323).

In **J ../87** (OJ 1988, 177) the Board ruled that a brief medical certificate, in which it was stated that the appellant was in a state of physical and mental exhaustion and depression, is not sufficient to establish incapacity within the meaning of R. 90(1)(a). Nothing was included in the certificate about the seriousness and duration of this condition.

In R. 90(4), first sentence, it is stated 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. 90(4) includes two exceptions in this respect, namely the time limits for making a request for examination and for paying renewal fees. In its decision **J 7/83** (OJ 1984, 211) the Board has already interpreted this rule as meaning that the time limit for filing the request for examination and paying the examination fee is suspended with effect from the first day of the representative's or applicant's incapacity and resumed for the time it still has to run on the date proceedings begin again. In **J ../87** (OJ 1988, 323) the Board stated that such an interpretation cannot be applied to renewal fees for which the EPC does not prescribe a time limit for payment but simply dates on which they fall due. The only time limit affecting renewal fees that may be suspended is the six-month period

for paying the renewal fee together with an additional fee referred to in Art. 86, and R. 90(4) has to be interpreted as deferring until the date proceedings are resumed the payment date for renewal fees which have fallen due during the period of the representative's or applicant's incapacity.

4.4 Interruption in the delivery of mail

R. 85(2) provides for a time limit to be extended if it expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Contracting State or between a Contracting State and the EPO. The duration of this period shall be as stated by the President of the EPO.

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 has no discretion to extend the time limit other than in the cases referred to in R. 85(2).

In **J 11/88** (OJ 1989, 433) the Board interpreted R. 85(2) as being so drafted that if a general interruption or subsequent dislocation in the delivery of mail within the meaning of the Rule occurs, any time limit under the EPC which expires within the period of interruption or dislocation is extended by operation of law; accordingly, if the President of the EPO does not issue a statement as to the duration of that period, because he did not have the relevant information at the right time, this cannot 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 qualifies as a "general interruption" is a question of fact, which has to be decided upon the basis 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).

Following **J 4/87** and **J 11/88** the Legal Board of Appeal stressed in **J 3/90** (OJ 1991, 550) that R. 85(2) is not restricted to **nationwide** interruptions. In this case the Board had to consider whether or not the disruption of mail 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 undertook all possible measures to avoid the effects of a postal strike is not a relevant test under R. 85(2).

5. Re-establishment of rights

5.1 Opponent's right

Under Art. 122(1) re-establishment of rights may be granted to both the applicant and the proprietor of a European patent, but in principle not to the opponent. In **G 1/86** (OJ 1987, 447) the Enlarged Board of Appeal admitted an exception to this principle in the following case: An **appellant as opponent** may have his rights re-established under Article 122 EPC if he has failed to observe the time limit for filing the **statement of grounds of appeal**. The Board first of all observed that in drafting Art. 122 EPC, the authors of the EPC intended only to exclude certain cases and time limits from restitution in integrum, and not to restrict that facility solely to applicants and patent proprietors. The wording of Art. 122(1), the historical documentation relating to the EPC and a comparison of the national laws of Contracting States suggest 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 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 has been lodged once this time limit has expired – cannot be extended to the time limit for filing the statement of grounds of appeal, because this uncertainty no longer exists. Once the appeal has been filed, the legal process has begun and the patent proprietor must comply with the procedural requirements like all the other parties and wait until the Board of Appeal arrives 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 to 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 is not entitled to have his rights re-established when he misses the **two-month time limit for filing an appeal** (Art. 108, first sentence). An opponent appellant seeking to have his rights re-established under Art. 122(1) cannot rely on the principle of "equality before the law" (applying Art. 125), where the appeal is not in existence for procedural reasons (distinguishing **G 1/86**, OJ 1987, 447). The applicant or proprietor, having failed to set in motion his appeal, finds himself at the end of the legal road; by contrast, an opponent can, if he wishes, seek revocation in the national courts into whose jurisdiction the European patent will have passed (see also **T 323/87**, OJ 1989, 343 and **T 128/87**, OJ 1989, 406).

Referring to **G 1/86** the Board stated in **T 702/89** that a request for re-establishment of rights by an **opponent** who has failed to observe the **nine-month time limit** under Art. 99(1) for filing the **notice of opposition** and paying the appropriate fee must be rejected as inadmissible.

5.2 Inability to observe time limit

Art. 122(1) requires that the party in question must have been **unable** to observe a time limit. 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. The Board therefore refused the request for re-establishment of rights.

5.3 Exclusion of time limits under Art. 122(5) EPC

The provisions of *restitutio in integrum* do not apply to the time limits referred to in Art. 122(5).

In **G 3/91** (OJ 1993, 8) the Enlarged Board of Appeal held that, contrary to earlier rulings, Euro-PCT applicants were no more 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 **J 16/90** (OJ 1992, 260) the appellant, who had failed to pay the filing fee, the search fee and the designation fees for his **European patent application** either within the time limit provided for in Arts. 78(2) and 79(2) or within the period of grace provided for in R. 85a, applied for re-establishment of rights under Art. 122. In support of his application he cited Legal Board of Appeal case law, according to which **Euro-PCT applicants** who had not paid the appropriate fees had had their rights re-established (see **J 5/80**, OJ 1981, 343 and **J 12/87**, OJ 1989, 366). As a result direct European and Euro-PCT applicants were not being treated equally. This was one of the questions the Legal Board of Appeal referred to the Enlarged Board of Appeal.

The Enlarged Board of Appeal stated that the time limits to be observed by Euro-PCT and direct European applicants were in essence identical and that their equal treatment was therefore consistent with the law. Accordingly both the time limits provided for in Arts. 78(2) and 79(2) and those provided for in R. 104b(1)(b) and (c) in conjunction with Arts. 157(2)(b) and 158(2) were **excluded** from re-establishment under Art. 122.

Additionally the Enlarged Board of Appeal discussed the question of re-establishment into the period of grace according to **R. 85a**, stating that the period of grace was closely linked to the normal periods laid down in Arts. 78(2) and 79(2) and in R. 104b(1)(b) and (c) and was accordingly excluded, as they were, from re-establishment under Art. 122(5).

In **G 5/92** and **G 6/92** the Enlarged Board of Appeal considered whether re-establishment of rights should be granted into the time limit for paying the examination fee under Art. 94(2). The Board held that it follows from Art. 122(5) read in conjunction with Art. 94(2), that re-establishment cannot be granted to an applicant who is prevented from meeting this deadline. The Enlarged Board referred to **G 3/91**, according to which Art. 122(5) applies to a Euro-PCT as well as to a European applicant. The time limits under Art. 94(2) were thus excluded from re-establishment of rights, no matter whether the applicant had chosen the “direct” European or the Euro-PCT route. A further referral (**J 4/93**, pending under reference number **G 5/93**) concerns the application of the new case law to proceedings which are still pending.

5.4 One-year time limit under Art. 122(2) EPC

A request for re-establishment of rights is only admissible within the year immediately following the expiry of the unobserved time limit.

In **J 6/90** the renewal fee in respect of the third year was not paid by the due date. The EPO's Receiving Section rejected the request for re-establishment of rights as inadmissible because the EPO had not received a statement of grounds for re-establishment within the period of one year stipulated in Art. 122(2), third sentence. The statement of grounds was not submitted until shortly after the end of that period, but within the period of two months specified in Art. 122(2), which in the present case 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, "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**).

5.5 Two-month time limit under Art. 122(2) EPC and prima facie evidence

According to Art. 122(3), first sentence, an application for re-establishment of rights must state the grounds on which it is based and must set out the facts on which it relies. In **T 324/90** (OJ 1993, 33) the Board held that prima facie evidence proving the facts set out in the application can be filed after expiry of the two-month time limit laid down in Art. 122(2). Only the grounds and a statement of the facts must be filed within the two-month period. It is 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 will be proved. Such evidence may be submitted after the time limit, if so required.

5.6 Removal of the cause of non-compliance

The application for re-establishment of rights must be filed and the omitted act must be completed within two months from the date of the **removal of the cause of non-compliance** with the missed time limit. According to the case law of the Boards of Appeal, the removal of the cause of non-compliance occurs 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.

As stated in **J 29/86** (OJ 1988, 84), in most cases the "cause of non-compliance with the time limit" involves some error in the carrying out of the party's intention to comply with the time limit. The party does not then realise that the error has occurred, and that the time limit has not been complied with, until this fact has been brought to his attention, commonly by means of a communication from the EPO. In such cases, the cause of non-compliance with the time limit cannot generally be removed until the communication is received. The cause of non-compliance with the time limit, and therefore its removal, is a matter of fact which has to be determined in the individual circumstances of each case.

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)). 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) 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) to the professional representative removes the cause of non-compliance. This applies also when parties instruct the (European) professional representatives via their (national) patent attorney. The appointment of an independent service firm for the payment of renewal fees does not constitute such circumstances to the contrary. The professional representative remains responsible for the application notwithstanding the fact that the applicants use such a payment agency.

5.7 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 requires that the applicant have his attention drawn to deficiencies in his application for re-establishment of rights which are obviously easy to correct (in the case in point the fee was not paid and substantiation not supplied), if correction of the deficiencies can be expected within the two-month time limit for restitutio under Art. 122(2). If this communication is not sent by the EPO within the two-month time limit, it must be sent subsequently and a new time limit set. Acts, the deficiencies of which are corrected within this set time limit, are deemed to have been performed in due time within the meaning of Art. 122(2).

This case law was confirmed by the Legal Board of Appeal in the similar case **J 13/90** (see Case Law Report 1993, p. 59).

5.8 Due care

5.8.1 Introduction

The necessary conditions relating to the obligation to exercise “all due care required by the circumstances” were considered by several Boards of Appeal. It is the established case law that Art. 122 is intended to ensure that in appropriate cases the loss of substantive rights does not result from an isolated procedural mistake within a normally satisfactory system (**J 2/86**, **J 3/86**, OJ 1987, 362). Whether or not a request for re-establishment of rights may be allowed, however, depends on whether or not the appellant can show that **all due care required by the circumstances** of the particular case was in fact taken to comply with a time limit. In considering whether “all due care” has been taken the word **all** is important for the purposes of Art. 122(1), the circumstances of each case must be considered as a whole (**T 287/84**, OJ 1985, 333).

5.8.2 Due care on the part of the applicant or the professional representative

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 the present case no such check was made.

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 EPO 1987, 447 and **T 287/84**, OJ EPO 1985, 333). When determining whether all due care required by the circumstances has been taken, the word “all” is important and failure to observe a time limit has 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 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, and R. 64.

In **J 22/88** (OJ 1990, 244) the Legal Board of Appeal had to resolve the question as to whether Art. 122 applies 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 can constitute grounds for granting re-establishment of rights. A prerequisite for granting the request is 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 must, of course, be clear that the financial difficulties were genuine and were due to circumstances beyond the reasonable control of the applicant (confirmed by **J 9/89**).

In **J 31/89** the Legal Board of Appeal confirmed that **erroneous interpretation of the EPC** on the part of the duly authorised representative with regard to the rules for calculating time limits (in the case in point, for the late payment of a renewal fee together with the additional fee) cannot be excused. 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 cannot 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**).

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 confirmed decision **T 869/90** (there the statement of grounds of appeal was filed one day late, due to a miscalculation of the time limit) and 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: “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 present case would be a severe result. Moreover, the interests of any third party misled in the sense of Art. 122(6) by the fact that the statement of grounds of appeal was filed two days late would be protected by Art. 122(6). In contrast, the loss of the patent application because of such a procedural irregularity would be a severe result. The Board allowed the application for re-establishment.

In **T 122/91** the Board held that due care has not been exercised if the head of an office goes off on a **journey** without informing his deputy of matters requiring immediate attention because a time limit is involved.

In **T 30/90** the chain of communication between the patentee and his US and UK representatives had broken down owing to the inadvertent mistransmission of an instruction by a fax operator in the USA. The mistake had not become apparent until after the deadline for filing the notice of appeal had expired. The Board stated that the mistransmission of the fax instruction constituted an isolated mistake in an otherwise satisfactory system, but that this event took place only **one** day before expiry of the time limit for filing the notice of appeal. In the Board's finding it was too late by then, considering all the circumstances of the case, to expect with reasonable certainty that timely action would still be taken by the representative. The important point was that the UK representative had taken no effective action to contact his US instructing agent well before expiry of the time limit.

5.8.3 Due care on the part of professional representatives' assistants

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. 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.

An assistant within the meaning of **J 5/80** includes a **substitute** replacing an assistant who is on leave, ill or absent for some other reason. The same standard of care must be exercised as regards the choice, instruction and supervision of the substitute as of the assistant himself (**J 16/82**, OJ 1983, 262). In **T 309/88** the Board stated that even **employees without formal training** as patent attorney's assistants can perform the task of recording and monitoring time limits. This is routine work which does not require specialised knowledge and professional qualifications. However, the assistant has to be properly instructed in the tasks to be performed and a trained employee must be on hand to give advice.

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 (**J 3/88**).

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. 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.

The following are examples of cases where re-establishment was allowed: non-payment in due time of an additional fee clearly attributable to an unfortunate concatenation of errors by nevertheless properly selected and experienced employees (**T 191/82**, OJ 1985, 189); excusable mistake in addition by an otherwise reliable secretary (**J 11/85**, OJ 1986, 1); incorrect action taken by the office manageress brought to light by their **own** checking procedure within barely a month of the missed time limit, with

the arrangements for recording due dates not being open to criticism (**T 176/91**); evidence submitted revealing that the error by the representative's secretary, which delayed the despatch of the statement of grounds for the appeal, constituted an isolated procedural mistake made in the course of duties which had been reasonably supervised (**T 179/87**).

In the following cases, amongst others, re-establishment was refused: the due care required in the circumstances was absent where the employees of some other firm 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 (**J 12/84**, OJ 1985, 108); a staff replacement inadequately trained in her duties (only 2 days), and her actions also inadequately supervised by the representative (**T 105/85**); no effective system for deputising for employees absent due to illness or other reasons, so that the observance of time limits could still be monitored (**T 324/90**, OJ 1993, 33); the secretary responsible was not familiar with the formalities due to long absence, the employee responsible for monitoring the observance of time limits being on holiday (**T 260/89**).

5.9 Restitutio in integrum – interruption of proceedings

In accordance with R. 90, 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) (**J .. /87**, OJ 1988, 323).

In case **T 315/87** the Board of Appeal was faced with the question of whether the EPO should not of its own motion first check whether the conditions for an interruption of proceedings under R. 90 exist, before considering a request for re-establishment. The Board stated that preference should be given to the application of Art. 122, under which less severe impairment could also be grounds for re-establishment of rights. The question of any interruption of proceedings under R. 90 could be left open provided that all the losses of rights which had occurred could be overcome by restitutio in integrum under Art. 122.

In **J 9/90** the Legal Board held that for R. 90(1)(b) (interruption of proceedings because of insolvency) to be applied in the light of Art. 60(3) and R. 20(3), 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. Someone who is only indirectly affected by an event, such as insolvency, can be "unable" in the sense of Art. 122(1). In such a case, however, the persons so affected must prove that they exercised all due care that could be expected of them in the circumstances of such an insolvency.

6. Late submission

6.1 Introduction

The Boards often have to decide whether late-filed documents and evidence are to be taken into account. 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), 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. It is important to distinguish between the late filing of documents and the submission of fresh grounds for opposition. Referring to the travaux préparatoires for the EPC, the Enlarged Board ruled that, although the concept of grounds for opposition was not formally covered by Art. 114, the principle of examination by the EPO of its own motion was nevertheless relevant to decisions on the admissibility of fresh grounds for opposition (see **G 9/91**, OJ 1993, 408). For further information, see VI.D. 1.

The landmark case for recent decisions on this issue is **T 156/84** (OJ 1987, 372), in which the Board ruled that the principle of examination by the EPO of its own motion under Art. 114(1) took precedence over the possibility under Art. 114(2) of disregarding facts or evidence not submitted in due time. This was not only evident from the wording of both provisions; it also followed from the EPO's duty vis-à-vis the public not to grant or maintain patents which it was convinced were not legally valid. However, Art. 114(2) enabled the EPO to disregard late-filed documents as not material – i.e. having no bearing on the decision – without having to give detailed reasons, as it did in the case of citations submitted in due time. In **T 326/87** (OJ 1992, 522) the Board took the same line, on the grounds that Art. 114(2) 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. (In the case in point, the opponent had submitted a new document when the appeal proceedings were already under way.) The main criterion for deciding on the admissibility of a late-filed document was its relevance, i.e. its evidential weight in relation to other documents already in the case.

In two more recent cases (**T 534/89** and **T 17/91**) the Board referred to Art. 114(2) in deciding to disregard late-filed evidence of prior public use on the grounds that the late filing represented an abuse of the procedure and a breach of the principle of good faith. The Board therefore refused to examine the possible relevance of the submission (see also VI.A. 6.3.2).

6.2 Relevance of citations and time of submission

6.2.1 Examination as to relevance

In opposition appeal proceedings the Board may exercise its power of discretion under Art. 114(2) to disregard new facts or evidence. In practice, this power is exercised in the form of a so-called “examination as to relevance”. If a citation which could have been introduced at an earlier stage in the proceedings is submitted later, the decision whether or not to take it into account will depend on its relevance, i.e. its likely bearing on the outcome of the case (see **T 258/84**, OJ 1987, 119). The EPO is 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 has no material bearing on the decision, the Board may disregard the submission **without having to give detailed reasons** (**T 156/84**, OJ 1988, 372; **T 71/86**, **T 11/88**).

Regarding examination as to relevance, the Board explained in **T 560/89** (OJ 1992, 725) that Art. 114(2) 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 can be rejected by the Boards of Appeal on the ground of their irrelevance, i.e. on the basis that they are no more “weighty” or “cogent” than documents which are already in the case.

However, the late-filed evidence must be admitted into the case and taken into account if it is relevant – i.e. if it may cause the patent to be revoked or its scope to be limited. In **T 164/89** the Board therefore admitted a document which had only been produced during oral proceedings in connection with an appeal. Similarly, in **T 29/87**, the Board subjected a new set of documents – submitted by the opponents during appeal proceedings – to thorough scrutiny, because, *prima facie*, the possibility could not be ruled out of inferring the teaching of the patent from one of these late-filed documents in conjunction with the document cited in the statement of grounds for appeal.

“Relevance” is still seen as the main criterion for deciding whether late-filed documents should be taken into account (see, *inter alia*, **T 446/89**, **T 142/84** (OJ 1987, 112), **T 295/90**, **T 408/89**, **T 297/87** and **T 137/90**).

In **T 705/90**, the Board ruled 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.

If the EPO intends to consider evidence filed late by an opponent in view of its relevance to the decision, and the patent proprietors have filed no observations on the new documents, then under Art. 101(2) they must be invited to do so before the case can be decided on the basis of such evidence. This requirement follows both from Art. 113(1) and from the general principles of procedural law applicable under Art. 125 (**T 669/90**, OJ 1992, 739).

6.2.2 The concept of “lateness”

To prevent delays in settling cases, the parties are supposed to present all the necessary facts, evidence and requests at the start of the proceedings, or – if this is not possible – at the earliest possible juncture. Arguments and documents should not be submitted piecemeal. The Boards have emphasised that the opponents should present all their objections during the opposition period, in accordance with the requirement that proceedings be brought to a speedy conclusion and the principle of fairness to the other party (see **T 101/87**, **T 237/89** and **T 430/89**).

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 has decided that the original citations do 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 may be admitted into the proceedings, instead of being regarded as late-filed.

6.3 Late-filed evidence of prior public use

6.3.1 Incomplete substantiation

In **T 441/91** the Board addressed the issue of the difference between a late-filed document forming part of the prior art and a late-filed allegation of prior public use. Since an actual document would not normally be the subject of conflicting allegations re-

garding the date – or the very fact – of its publication, the Board could immediately begin to consider the document's substantive relevance and its bearing on the patentability of the claimed invention. With allegations of prior use, however, two questions generally have to be clarified before proceeding any further: (a) what was disclosed, and (b) whether the technical facts involved in the disclosure are relevant and have an impact on patentability. This decision follows the same line as in **T 93/89** (OJ 1992, 718), where the Board ruled that if a prior public use is not adequately substantiated, it is immaterial and may therefore be disregarded under Art. 114(2) (see **T 129/88** in VI.D. 3.3.2).

In **T 550/89** the appellants failed to convince the Board that an alleged prior public use was relevant, because the allegation was not only filed late – in conjunction with the statement of grounds for appeal – but was also unsubstantiated. 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 were irrelevant anyway, but this was only a secondary consideration.

6.3.2 Abuse of procedure

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).

Taking a similar line, the Board ruled in **T 534/89** that an objection based on prior use by the opponents themselves which is raised only after the expiry of the opposition period (Art. 99(1)) 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 is 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) in that party's favour. Exercising its power of discretion under Art. 114, the Board found it justified to dismiss the objection of prior use **irrespective of its potential relevance**.

6.4 Documents cited in the patent or the 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 198/88**, OJ 1991, 254). According to **T 291/89** this also applies to a document cited in the search report. In **T 536/88** (OJ 1992, 638), the Board endorsed this principle but made an exception in a specific case, on the grounds that, although the document in question had only been filed after the expiry of the time limit for opposition, it was cited and acknowledged in the European patent as the closest prior art for the purpose of formulating the technical problem set out in the description. A document of this kind formed part of the opposition or opposition appeal proceedings even if it was not expressly cited within the opposition period (decision upheld in **T 234/90**).

Regarding this issue, the Board commented in **T 387/89** (OJ 1992, 583) on the scope of the principle of judicial investigation under Art. 114(1) in opposition proceedings. The Board of Appeal invoked this principle to introduce two documents which were mentioned in the search report but were not specifically cited by the opponents, and on the basis of these documents the appeal against the revocation of the patent was dismissed. 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), however, an Opposition Division or Appeal Board may introduce new documents into the opposition proceedings if it has good reason to suppose that the documents could affect the outcome of the decision. In **T 588/89** the Board similarly introduced a document into the appeal proceedings under Art. 114(1), because in the Board's view, the document reflected the closest prior art and raised doubts as to whether an inventive step had taken place.

6.5 Remittal to the department of first instance

6.5.1 Introduction

If a new citation 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, *inter alia*, **T 258/84**, OJ 1987, 119, and **T 273/84**, OJ 1986, 346), 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) 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. The appropriateness of remittal to the department of first instance is a matter for decision by the Boards of Appeal, which assesses each case on its merits.

6.5.2 New relevant evidence

According to the principles set out in **T 326/87** (OJ 1992, 522), a case may be remitted to the department of first instance if a new document is introduced in appeal proceedings which is relevant to the decision. This preserves the possibility of examining the facts at two levels of jurisdiction and ensures that the patent proprietor is not deprived of a second hearing. Remission to the 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.

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.

6.5.3 Non-relevant citations

In **T 416/87** (OJ 1990, 415), the Board came to the conclusion – after careful scrutiny of the late-filed document – that the maintenance of the patent was not prejudiced. Since the responsibility for the late introduction of the document lay with the appellant

(the opponent), the Board decided to exercise its power of discretion under Art. 111(1) and **refrain** from remitting the case to the department of first instance for further examination.

Referring to the latter case in **T 97/90**, the Board said that cases in which a new ground of objection is raised at a late stage of the appeal proceedings should only be referred back to the department of first instance where admitting the new ground into the proceedings would result in the revocation of the patent. Where the maintenance of the patent would not be put at risk, the Board could either refuse to consider the new ground of objection, or admit it into the proceedings and find against the opponent. The latter option might be preferable, since it had the effect of making detailed written reasons available for possible further use in litigation before national courts.

A further decision refusing to remit the case to the department of first instance was handed down in **T 565/89**. Here, the Board concluded that the late-filed citation did not suggest the claimed teaching or anticipate it in a novelty-destroying sense (see, *inter alia*, **T 49/89** and **T 253/85**).

6.5.4 Raising an entirely fresh case in appeal proceedings

In **T 611/90** (OJ 1993, 50) the appellants (opponents) presented an entirely fresh case – based on prior public use instead of the previously-cited ground of prior publication – in their statement of grounds for appeal. The Board explained that such an appeal – raising a case quite different from that on which the contested decision is based – is admissible if the reasons advanced are still within the same ground of opposition, i.e. Art. 100(a). 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.

In **T 97/90** (see also VI.A. 6.5.3) the opponents had originally requested the revocation of the patent on the sole ground of lack of an inventive step. However, at oral proceedings before the Board of Appeal, they introduced prior publication as a new ground of opposition. Although the two grounds are different, they both fall into the same category under Art. 100(a). Referring to **T 611/90**, the Board confirmed that if fresh evidence, arguments or other matter filed late in the appeal proceedings raise 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 is demanded by fairness to both parties. However, this did not imply that all cases in which a new ground of objection is raised late in the appeal must be remitted to the first instance. On the contrary, this should only be done if the admission of the new ground into the appeal proceedings would lead to the 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. Referring to **T 97/90** the Board confirmed that where a case on appeal turns 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). 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.

6.5.5 Apportionment of costs

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 VI.D. 7.4 and, inter alia, **T 611/90** (OJ 1993, 50), **T 97/90**, **T 326/87** (OJ 1992, 522) and **T 110/91**).

7. Decisions of the EPO departments

7.1 Suspected 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. The case which had led to the referral, **T 261/88**, was published in OJ 1992, 627.

The Enlarged Board stated that the provisions of Art. 24 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 departments of the first instance at the EPO, including Opposition Divisions. This did not, however, justify the conclusion that such employees were exempt from the requirement of impartiality. Even if a very strict observance of this requirement was particularly important in proceedings before the Boards of Appeal and the Enlarged Board of Appeal in view of their judicial functions at supreme level within the European system of patent law, it had to be considered as a general principle of law that nobody should decide a case in respect of which a party might have good reason to assume partiality. The basic requirement of impartiality therefore also applied to employees of the departments of the first instance at the EPO taking part in decision-making activities affecting the rights of any party.

7.2 Right to a decision

The right to a decision upon the noting of loss of rights is a substantial procedural right which cannot be ignored by the EPO. According to **J 29/86** (OJ 1988, 84), if the correctness of a notification of loss of rights under R. 69(1) is challenged, the EPO has a duty to reply within a period of time which is reasonable having regard to the subject-matter of the communication. Under R. 69(2), a person who applies for a decision is entitled to receive one, and failure to issue a decision in such circumstances is a serious procedural deficiency.

7.3 Legal value of the Guidelines

In **T 42/84** (OJ 1988, 251) and **T 162/82** (OJ 1987, 533), two Boards of Appeal ruled on the discretion of Examining Divisions to depart from the EPO Guidelines. According to that case law, the Guidelines are stated to be only general instructions intended to cover normal occurrences. Accordingly, an Examining Division has discretion to depart from them provided that it acts in accordance with the EPC. In reviewing the decision of the Examining Division, the Board of Appeal will, in order to ensure uniform application of the law, judge whether the Division has acted in conformity with the EPC and not whether it has acted in accordance with the Guidelines, in interpreting the provisions of the EPC.

7.4 Principles for the exercise of discretion

In **T 182/88** (OJ 1990, 287) the Board clarified its case law concerning the exercise of discretion given to EPO departments and in particular to the Examining Division (R. 86(3)). In its decision it laid down the following principle: "When a decision hinges upon the exercise of discretion, the reasons should be given. Such reasons should take into account those factors which are legally relevant to the issue in question, and should not simply consider whether the facts of the case are exactly the same as in a previously decided case. Such factors are determined by considering the purpose of the exercise of the discretion by its context, and in the context of the EPC as a whole" (here, the balancing of the EPO's interest in a speedy completion of the proceedings against the applicant's interest in obtaining a patent which is legally valid in all the Contracting States).

7.5 Reasons for a decision

Under R. 68(2) decisions of the EPO which are open to appeal must be reasoned.

In **T 234/86** (OJ 1989, 79) the Board of Appeal considered that where more than one request from one and the same party is refused in a single decision, such decision should as a rule set out the reasons for the refusal of each request. Where in the reasons for a decision, a reference to reasons invoked in earlier communications may exceptionally be allowed, the considerations that played a crucial role for the Opposition Division when taking its decision must nevertheless emerge clearly from the reasons invoked in such communications.

In **T 735/90** the Board likewise decided that no serious procedural violation had occurred if, on the one hand, the decision of the department of first instance failed to give reasons for the view that a portion of the invention was obvious, but, on the other hand, the relevant reasons were contained in previous communications, so that reference to these would have sufficed to remedy the defect.

A decision of an Opposition Division rejecting the opposition was held not to have been correctly reasoned within the meaning of the first sentence of R. 68(2) 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 (**T 493/88**, OJ 1991, 380).

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 or 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 the 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 these grounds did not amount to a reasoned decision.

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. In its decision **T 856/91**, the Board took the view that this incomplete information did not constitute a breach of R. 68(2), since it was sufficient for a decision to be reasoned in some way, even if the reasoning were incomplete and deficient.

In **T 691/89** the appellant claimed that the contested decision did not address an essential characterising feature of the main claim. The Board of Appeal however considered it sufficient for the feature to have been only implicitly referred to, since it could be clearly and directly deduced from the decision that the feature was regarded as known.

Chapter VI.E. 10.3.2, on inadequate reasons given in the decision at first instance, outlines the circumstances in which reimbursement of the appeal fee is justified.

7.6 Formal requirements for a decision

7.6.1 Composition of the deciding body

In **T 390/86** (OJ 1989, 30) oral proceedings took place in the presence of three examiners appointed to form the Opposition Division. The Chairman announced its decision during oral proceedings in the presence of the other two examiners. While the decision was subsequently duly reasoned in writing, it was nevertheless signed by three members other than those before whom the oral proceedings took place. The Board considered that a decision must be written on behalf of and represent the views of the members appointed to decide the matter, and it must bear signatures which indicate this. As a result, the written reasons for a decision delivered during oral proceedings can only be signed by members of the deciding body who took part in the oral proceedings. If, in a case where a final substantive decision has been given orally by an Opposition Division during oral proceedings, the subsequent written decision giving the reasons for such oral substantive decision is signed by persons who did not constitute the Opposition Division during the oral proceedings, the decision is null and void.

In its decision **T 243/87** the Board of Appeal developed the principles established earlier in decision **T 390/86** (see above). In the case in point, only one of the members of the Opposition Division had been replaced after the oral proceedings. The Board held that since one member was replaced after the oral proceedings, there was no longer any guarantee that the reasoned decision subsequently signed accurately reflected the point of view of all three members who took part in the oral proceedings, or of the majority of the Opposition Division. Regarding the exceptional situation of incapacity of one of the appointed members (for example through illness), the Board stated that it was right to accept that the reasoned written decision should be signed only by the members of the division who actually took part in the oral proceedings, and likewise on behalf of the member unable to do so. It is of course advisable to check that the reasoned written decision represents the point of view of all the members who took part in the oral proceedings.

The composition of the Opposition Division contravenes the provisions of Art. 19(2), if the Chairman and one of the members have taken part in the Examining Division responsible for deciding on the application (**T 382/92**).

7.6.2 Date of decisions

In **T 586/88** (OJ 1993, 313) the Board referred the following point of law to the Enlarged Board of Appeal: at what stage does the internal decision-making process end? The Board considered it essential for the date of a decision to be clearly established to prevent the department responsible for taking the decision from wrongly disregarding either a request for amendment, a new pertinent document constituting a prior-art publication or a request for oral proceedings. Where a decision is taken by an Examining Division or an Opposition Division at the conclusion of written proceedings, three different dates could theoretically be considered as the point at which the internal decision-making process at that level within the EPO has come to an end:

- (a) the point at which all the members of the department taking the decision have signed and dated the form;
- (b) the point at which the examiners' clerk or formalities officer has passed the reasoned decision to the EPO's mail service, after which the decision is no longer in the hands of the department empowered to take it;
- (c) the point at which the reasoned decision has been despatched, after which it is no longer within the control of the EPO as a whole.

The case before the Enlarged Board of Appeal has been given the reference number **G 12/91**.

7.6.3 Correction of errors in decisions

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 decision is a rectifiable, obvious error within the meaning of R. 89. In this case a second examiner had also 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. Correction of the two errors by means of a decision under R. 89 is required with retrospective effect from the date of the original decision. The same Board emphasised the retrospective effect of corrections under R. 89 in **T 116/90**. It is unnecessary to redate the decision as from the date of correction.

8. Requests

8.1 Main and auxiliary requests

In decision **T 5/89** (OJ 1992, 348) the Board considered the relationship between main and auxiliary requests. The Board of Appeal's earlier decision **T 234/86** (OJ 1989, 79) ruled that the Opposition Division can decide to maintain a patent on the basis of a subordinate auxiliary request by the patent proprietor, and indeed must do so if the latter pursues a main request together with non-allowable auxiliary requests which precede one which is allowable. A decision to reject preceding requests must be reasoned. In **T 5/89** the Board upheld the principle that a decision can only be restricted to the main request if all subordinate auxiliary requests have been withdrawn.

8.2 Maintenance in case of prior European rights

In **T 117/90**, during the opposition and appeal proceedings, a European patent application was found to be part of the state of the art under Art. 54(3) and (4) and thus novelty-destroying for all the designated States except Austria and Luxembourg. The Board revoked the contested patent for all States, including Austria and Luxembourg, on the grounds that the respondents had requested only the rejection of the opponents' appeal and **not** the maintenance of the patent in Austria and Luxembourg. In comparable situations maintenance of the patent for some of the originally designated States was examined by the Boards. This happened in decisions **T 622/89**, **T 368/90**, **T 755/90**, and **T 806/90** on the basis of **requests** to that effect from applicants or patentees, some of whom had submitted separate sets of claims for the various (groups of) States.

9. Taking of evidence – general principles

9.1 Taking of evidence and lost letter

In **T 128/87** (OJ 1989, 406), a crossed cheque which the appellant said was enclosed with the notice of appeal in payment of the appeal fee had not been received by the EPO's Cash and Accounts Department. Clear evidence that the cheque had actually been enclosed could not be furnished, nor could its loss within the EPO be ruled out with certainty. The Board held that it is in principle possible, by establishing a sufficient degree of probability, to determine whether an act safeguarding a time limit has been performed in due time (see **T 69/86** and **T 243/86**); however, the evidence must reveal a considerably higher probability that the act in question (filing of a document) has been carried out than otherwise; the burden of proof always falls on the filing party. In the present case, considerations of equity prompted a decision in favour of the filing party even though such evidence was not forthcoming (the appeal was filed long before the relevant time limit expired and the EPO could therefore have established that the cheque was missing before the expiry date).

In **J 10/91** the Legal Board of Appeal likewise held that if a letter, and the attached cheque for payment of fee, was lost without there being any further evidence of high probability that it had been lost in the EPO, the risk was to be borne by the sender. In such a situation the impossibility of furnishing proof had in principle to go against the party performing the filing.

In **T 770/91** a fax lodging an opposition was alleged to have been sent within the opposition time limit, but had not been received. Confirmation of the fax was only received after expiry of the time limit. The Board referred to Art. 114, according to which the EPO shall examine the facts of its own motion and considered it likely that, in the present case, a thorough search had not been made. The Board followed **J 20/85** (OJ 1987, 102), which held that in any case where there was disagreement between a party and the EPO about a question of fact, evidence relating to it should be taken as soon as the issue of fact arose. The case was therefore remitted to the Opposition Division for further investigation of the facts concerning the fax alleged to have been submitted.

9.2 Burden of proof, standard of proof, evaluation of evidence

In relation to an issue of fact (in **T 381/87**, OJ 1990, 213, the Board considered the question of when a document was first made available to the public), the EPO must decide what happened, having regard to the available evidence, on the balance of probabilities: i.e. it must decide what is more likely than not to have happened (confirmed by **T 743/89**, where the Board had to consider a similar case).

In **T 270/90** in relation to the standard of proof it was held that a Board's decision need not be based on absolute conviction, but had to be arrived at on the basis of the overall balance of probability, i.e. that one set of facts was more likely to be true than another. Each of the parties to the proceedings carried the separate burden of proof of any fact it alleged. The weight of that burden was the **balance of probability** as distinct from **beyond all reasonable doubt** or **absolute conviction**.

In **T 109/91** the Board added to this concept the criterion of "**verging on certainty**", stating that the standard burden of proof was generally expressed as proof on the balance of probabilities, in which case absolute certainty was not required, but a degree of probability verging on certainty. If the evidence was such that the Division or the Board was able to conclude "**we think it more probable than not**", the burden was discharged. The burden of proof may shift constantly as a function of the weight of evidence.

In decision **T 16/87** (OJ 1992, 212) the Board held that R. 55(c) puts the onus on the opponent requesting a patent's revocation to indicate the facts and evidence in support of his assertion that the invention cannot be carried out in all its claimed embodiments and has therefore not been sufficiently disclosed (Art. 100(b)). In this case the opponent merely raised doubts but did not supply any evidence such as test results.

As evidence of prior public use the respondents in **T 363/90** submitted the names of three witnesses willing to give evidence. Prior to being heard the two witnesses heard by the Opposition Division were advised of their duty to tell the truth and of the possibility under R. 72(3) of their evidence being re-examined under oath. Contrary to the view taken by the Opposition Division, the Board saw no reason to impugn the credibility of the witnesses merely because they were related to one another and had a business relationship with the respondents. The Board therefore held that it was free to evaluate their evidence as it saw fit.

10. Withdrawal and abandonment of application or patent

10.1 Withdrawal of patent application

In **J 7/87** (OJ 1988, 422) the Legal Board of Appeal ruled that an effective withdrawal of a European patent application did not depend on whether the applicant had used the term "withdrawal". The language used must be interpreted having regard to the surrounding circumstances from which it must be clear that the applicant really wanted immediate and unconditional withdrawal rather than passive abandonment leading in the course of time to deemed withdrawal.

In **J 15/86** (OJ 1988, 417) the Board stated with regard to the declaration of withdrawal that, in practice, in the operation of the European patent system, 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 inten-

tion had to be considered on its own facts. A written statement of the applicant or his representative must be interpreted in the context of the document as a whole and of the surrounding circumstances. It was too late to ask for retraction of a letter of withdrawal once the withdrawal had been published in the European Patent Bulletin (see Legal Advice No. 8/80, OJ 1981, 6, point 2).

In **J 6/86** (OJ 1988, 124) the Board considered the statement “applicant wishes to abandon this application” as unambiguous withdrawal of a European patent application, since nothing in the circumstances under which the statement was made could be taken as qualifying such an interpretation.

10.2 Abandoned patent

In the leading decision **T 73/84** (OJ 1985, 241), when the patent was revoked at the instigation of the patent proprietor, the Board stated as follows, “The patent proprietor cannot terminate the proceedings by telling the EPO that he is **surrendering** the European patent, since this is not provided for in the Convention. Thus he will be only able, as far as national law permitted, to surrender the patent vis-à-vis the national patent offices of the designated Contracting States under the relevant national law. If the proprietor of a European patent 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”. The Board held that there is no text of the patent on the basis of which the Board can consider the appeal: under Art. 113(2) the EPO must consider the European patent only in the text submitted to it or agreed by the proprietor of the patent.

Following Legal Advice No. 11/82 (OJ 1982, 87) and **T 73/84** (see above), the Board stated in **T 186/84** (OJ 1986, 79) that if in opposition proceedings the proprietor of a patent requests that his patent be revoked, it is to be revoked without substantive examination. According to this Legal Advice, a European patent is revoked, without any further examination as to patentability, if the proprietor states that he no longer approves the text in which the patent was granted and does not submit an amended text. This was assumed also to apply if the proprietor requested that the patent be revoked.

In **T 237/86** (OJ 1988, 261), the Board added that when it is made clear to the Board of Appeal, whatever the form of words used, that the appellant and the respondent are agreed that a patent should be revoked, the Board may exercise its power under Art. 111(1) to revoke the patent. The statement “we herewith abandon the above patent” sent to the Board of Appeal by the patent proprietor during the appeal stage of an opposition is in this case equivalent to a request that the patent be revoked (see also **T 347/90**).

In **T 459/88** (OJ 1990, 425) the Board confirmed earlier Board of Appeal case law and added that there is no public interest in maintaining a patent against the patent proprietor’s will.

In **T 123/85** (OJ 1989, 336) the Board likewise emphasised that the patent proprietor may not surrender his patent either wholly or in part during opposition proceedings. In opposition proceedings a patentee may only request that his patent be amended. Under Art. 113(2), the EPO must decide upon the patent in the text submitted or agreed by the patentee. It does not follow from this, though, that the patentee is bound by a request involving limitation once he has made it.

In requesting that his patent be maintained in a limited form the patentee is merely trying to delimit his patent to meet objections expressed by the EPO or the opponents. However, the patentee does not, by virtue of such limitation, irrevocably surrender subject-matter covered by the patent as granted but not by the request as thus limited; in any case, the patentee has no legal means for surrendering part of the patent as granted in this way. A patentee is thus quite entitled to make amendments to subject-matter limited at his request and can thus also reinstate his patent in the form in which it was granted. However, the Board has one reservation about the admissibility of amendments to the patentee's request in opposition proceedings. Such amendments must not constitute an abuse of procedural law.

11. Further procedural questions

11.1 Language privilege

Arts. 14(2) and (4) provide that 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 time limit in an official language of the Contracting State concerned. These persons thereby become entitled to a fee reduction under R. 6(3).

In **G 6/91** (OJ 1992, 491) the Enlarged Board of Appeal commented on the points of law referred to it by decision **T 367/90** (OJ 1992, 529) concerning the entitlement to an appeal fee reduction when using an admissible non-EPO language. It ruled that these persons were only entitled to the fee reduction 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. 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.

To be granted the benefit of a 20% reduction in the opposition fee under R. 6(3), that part of a notice of opposition which is governed by R. 55(c) should always be filed in a non-official authorised language (**T 290/90**, OJ 1992, 368).

This ruling was followed by decision **T 905/90**. In this case, the notice of opposition had been filed entirely in English, except for one section headed "Other requests" which was drafted in Dutch. This section stated that 20% of the opposition fee had been withheld pursuant to R. 6(3). The Opposition Division had held that the notice of opposition could not be deemed to have been filed pursuant to Art. 99(1). The Board confirmed that a fee reduction under the Rule was allowable only if an essential item in the first act of relevant proceedings had been filed in a non-official language, with a translation being filed simultaneously or subsequently. A notice of appeal, although linguistically insensitive, was clearly an essential item to appeal proceedings, whereas a simple notification (whether it be in a covering letter or, as in the present case, contained in a notice of opposition filed entirely in English with a space provided for other requests) to the effect that 20% of the relevant fee has been withheld, cannot be re-

garded as an essential item in the relevant proceedings (see also **J 4/88**, OJ 1989, 483).

According to Art. 14(5), however, when such parties avail themselves of paragraphs 2 and 4 of Art. 14 they have to supply a translation in English, French or German within the time limit prescribed in the Implementing Regulations, failing which the application is deemed withdrawn (Art. 90(3)) or the original document is deemed not to have been received (Art. 14(5)) – as **T 193/87** (OJ 1993, 207) confirms. In this case, the translation of the notice of opposition was not filed in due time. The Board ruled that the notice of opposition should be deemed not to have been received and the opposition fee reimbursed.

In decision **T 905/90**, the Board went on to consider what was meant by “small” in Art. 9(1) RFees. This article reads: “It may also, where this is considered justified, overlook any small amounts lacking without prejudice to the rights of the person making the payment”. The Board stated that it was with very small or trifling amounts that Art. 9(1) 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. Therefore, a difference of 20% clearly could not, on purely arithmetical grounds, be regarded as small.

In **T 290/90** (OJ 1992, 368) the Board added that the question of whether or not it may be considered justified to overlook a small amount of a fee which is lacking, under Art. 9(1) RFees, must be decided on an objective, not a subjective, basis. A further ground for exercising discretion in the applicant’s favour was the fact that the amount owing was paid soon after expiry of the period. The Board of Appeal added, however, that immediate payment of the full amount together with a request for reimbursement would have been a more prudent way of having the matter settled.

11.2 Inspection of files

In **J 14/91** (OJ 1993, 479) the Legal Board of Appeal granted a request for inspection of files under Art. 128(2). According to Art. 128(2), anyone who can prove that the applicant has invoked the rights under his European application against him may obtain inspection of the files prior to the publication of that application and without the consent of the applicant.

The decision was based on the following facts: a European patent application was filed claiming priority from a German patent application. The appellant requested inspection of the files of the European patent application on the ground that the applicant (respondent) had issued a warning to him in a letter on the basis of the priority-establishing German application, and had referred at the same time to a parallel European patent application. The Legal Board of Appeal assumed that by referring to the existence of a European application in conjunction with the warning based on the German application, the respondent was invoking his rights under the European patent application within the meaning of Art. 128(2), the very purpose of which is to enable a person making a request to inspect files prior to publication of the application.

The respondent could also no longer claim the principle of confidentiality of applications not laid open for public inspection. The fact that he himself had not maintained secrecy meant that he had relinquished the right to it himself. If an applicant informs a third party of his rights, he must in turn expect that the third party may wish to obtain precise information about those rights.

11.3 Register of Patents

11.3.1 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** 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.

11.3.2 Transfer

In **T 553/90** doubt had been cast on the entitlement of the new patent proprietor entered after grant following a request for transfer. The Board ruled that the Opposition Division was not competent to decide on the entitlement of the person entered in the Register of Patents as the person to whom the right to the patent belonged. Under Art. 20 it was the Legal Division which was responsible for decisions in respect of entries in the Register of European Patents and their deletion. Under Art. 106(1) these decisions could be appealed. Art. 21(2) vested responsibility for these appeals in the Legal Board of Appeal and not in the Technical Boards of Appeal. The Board ruled as follows: "If 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 to take part in these proceedings may not be questioned."

11.4 Professional representative

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 qualification 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) and hence be authorised to act before the EPO. The Board decided that he should not, on the ground that Art. 134(7) is a special provision restricted to the profession of "Rechtsanwalt" as defined in German law. The term "legal practitioner" in the Article's English version is not to be translated as "Rechtspraktiker". According to its authentic interpretation given at the Munich Diplomatic Conference (Minutes M/PR/I, point 805), the term covers the professions of "solicitor" and "barrister" in Great Britain. Art. 134(7) does not therefore apply to German patent attorneys.

B. Preliminary and formalities examination

1. Date of filing

Two decisions point out the necessity of ensuring – if the applicant wishes his application to be accorded a particular date of filing – that application documents are actually received at the EPO itself or at a competent national authority by that date. This is particularly important where applications are filed by post.

In decision **J 18/86** (OJ 1988, 165) the Board stated that according to R. 24 in conjunction with Art. 75(1)(b) the date of filing of a European application is always the date on which the application documents are actually received, either directly at the EPO or at a competent national authority. R. 24 provides a comprehensive and self-sufficient system in accordance with which the EPO can determine the date of filing of a European patent application, wherever (in accordance with Art. 75(1)) it is filed. Nothing in the EPC admits 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), as a result of an unforeseeable postal delay, a European patent application posted in the United Kingdom on 4.12.1985 did not reach the EPO until 11.12.1985. The application claimed priority from 8.12.1984. The postal delay was due to a general interruption in the delivery of mail in the United Kingdom during the period from 15.11.1985 to 5.12.1985 inclusive. Time limits expiring within that period were extended to 6.12.1985 pursuant to R. 85(2) and (3). Thus, in that particular case, the 12-month time limit for claiming priority expired outside the period of interruption of mail specified in the President's notice. The appellant asked for an individual extension of the time limit, on the grounds that nothing in the EPC prevents the EPO from allowing discretion in cases where the applicant may suffer hardship due to exceptional delays in the post. The appeal was dismissed since nothing in the EPC enables the EPO to accord a date of filing for an application other than that on which the main documents making up the application are received at the competent authority. In consequence, the principles set out in decision **J 18/86** above apply equally to an application filed directly at the EPO in Munich.

2. Correction of designation of States

In decision **J 25/88** (OJ 1989, 486) the Legal Board of Appeal considered the issue of the correction of designated States and held that the requirement laid down in Art. 80(b) under which at least one Contracting State must have been designated, has been met even if there is no explicit designation of any particular Contracting State; in the absence of such a designation, the documents filed by the applicant must be considered to contain a precautionary designation of all Contracting States. This interpretation was made possible among other things by the practice of "precautionary designation" which can be legally classified as a presumption of a general wish on the part of applicants to designate Contracting States in the initial stage of the filing of a European patent application. At the same time the Board stated that the system for designating Contracting States (actual designation, fee(s) to be paid, legal effect in the event of non-payment) is self-regulating in the sense that if the designation fee for a Contracting State is not paid, the designation of that State shall be deemed to be withdrawn (Art. 91(1)(e) and (4)) and only those States remain designated in respect of

which the fees have been duly paid; in the unlikely event that no designation fee is paid at all, the European patent application shall be deemed to be withdrawn (Art. 79(3)).

In decision **J 10/87** (OJ 1989, 323) the Legal Board of Appeal supplemented and affirmed its case law relating to the correction of designations of Contracting States with regard to R. 88, first sentence. In the previous decisions of the Legal Board of Appeal a correction relating to the designation of States was, for reasons of legal certainty, only permitted prior to publication or if the request for correction was made sufficiently early for a warning to have been included in the publication (see **J 12/80**, OJ 1981, 143; **J 21/84**, OJ 1986, 75). In decision **J 15/86** (OJ 1988, 417) the Legal Board of Appeal decided that after publication of the withdrawal of a European patent application in the European Patent Bulletin a correction was no longer possible in the public interest.

In its decision **J 10/87** the Legal Board of Appeal made it clear that a correction always called, in principle, for the interests of the general public to be weighed against those of the applicant; the principle to be followed is that the public interest in being able to rely on information officially published by the EPO must rank higher than the interest of the applicant in retracting his withdrawal once publication has already taken place. In such a case the general public interest must prevail for reasons of legal certainty. In accordance with these principles a correction of the withdrawal of the designation of a Contracting State subsequent to the publication of the European patent application is allowable if the following requirements are fulfilled: (a) at the time the retraction of the withdrawal is applied for the public has not been officially notified of the withdrawal by the EPO; (b) the erroneous withdrawal of the designation of a Contracting State is due to an excusable oversight; (c) there is no undue delay in seeking retraction; (d) there is adequate protection of those third persons who, by inspecting the files, have acquired knowledge of the withdrawal and have relied on it, if the correction is allowed. The Board considered that although the public had not been aware of the declaration of withdrawal of the designation, insofar as it had not been published in the European Patent Bulletin and/or the European Patent Register, if some person did know about the declaration through having inspected the file, Art. 122(6) would have to apply *mutatis mutandis* (see **J 12/80**, OJ 1981, 143; **J 26/87**, OJ 1989, 329).

Decision **J 7/90** (OJ 1993, 133) expressly upheld the principle of the fundamental validity of also setting time limitations for the substitution of the designation of States in accordance with R. 88, first sentence. Requests for correction must always be submitted in time for them to be published at the same time as the application (**J 12/80**, **J 3/81** and **J 8/89**). In this case, the applicant requested a correction under R. 88, first sentence, after publication of the application, with "Greece" being replaced by "Switzerland and Liechtenstein". The Legal Board of Appeal upheld the need to impose a "time limitation" for correction of designations. It conceded that the applicant's competitors might not always deserve any special measures to preserve good faith with respect to the designation of States, as their commercial expertise often led them to notice errors of designation. However, it considered "time limitations" a suitable and necessary condition for correcting designations, especially as the applicant has a number of reasons and opportunities to check the designations after he has filed his application. The Board decided that this "time limitation" does not constitute a time limit within the meaning of Art. 122(1), but a temporal condition established by case law.

3. Designation of new Contracting States

The entry into force of the EPC in Denmark on 1.1.1990 gave rise to a number of decisions relating to the date of filing accorded and the designation of new Member States.

In **J 14/90** (OJ 1992, 505), the appellant had filed a patent application on 21.12.1989 in which he designated all the EPC Contracting States with the exception of Greece. The priority period for the application expired on 28.1.1990. On 12.1.1990, the applicant paid a 12th designation fee and asked for this fee to apply to Denmark on the ground that Denmark had been a Contracting State since the instrument of ratification was deposited on 30.10.1989 and was thus covered from that date by the precautionary designation. The applicant appealed against the Receiving Section's adverse decision. He requested that the European application be accorded 1.1.1990 as the date of filing. The Board of Appeal rejected the request. Although, in the Board's view, it is in principle possible to postpone the date of filing, such postponements have to be based on a legal provision or be approved by specific case law. There is no legal provision of this kind in the EPC, and administrative considerations, legal certainty and the interests of third parties all militate against such postponement.

As in the above-mentioned case, the application in **J 18/90** (OJ 1992, 511) was filed prior to the EPC's entry into force for Denmark, namely on 28.12.1989. Again, the priority period expired after 1.1.1990. In contrast to **J 14/90**, however, Denmark had been expressly added to Section 26 and the designation fee paid.

In this case, the applicant's appeal against the adverse decision by the Receiving Section was successful. The Board of Appeal resolved the case not by postponing the date of filing, but by interpreting the content of the request for grant filed on 28.12.1989 in the light of the fact – known at the time both to the EPO and the applicant – that the EPC would enter into force for Denmark on 1.1.1990, while the priority period for the application would not expire until after that date. It is not normally the job of the Receiving Section to check application documents for consistency of content or to clarify discrepancies by requesting further details. However, this does not apply if a patent application filed on 28 December designates a State which can only be designated from the 1 January following. In such a case it is appropriate to weigh procedural economy against the interests of the applicant, and this could make it necessary to deviate from the rule in the applicant's favour. The designation should be interpreted as meaning that the applicant does not wish the date of filing to be any earlier than the date on which the EPC comes into force for the State concerned. The filing date for this particular application was deemed to be 1.1.1990. (For the similar situation on the accession of Portugal and Monaco, see the notice in OJ EPO 1991, 549.)

In decision **J 30/90** (OJ 1992, 516) the applicant had filed a PCT application whereby he applied for a European patent for the EPC Contracting States and a national patent for Denmark. The regional phase began on 26.1.1990. The applicant paid the designation fees for all the EPC States including Denmark. The Receiving Section refused to act as the designated Office for Denmark on the ground that, at the time of filing, Denmark was not an EPC State.

The applicant's appeal was dismissed. The Board held that the EPO is the designated Office under Art. 153(1) for the EPC Contracting States designated in the international application if the applicant has stated therein that he wants a European patent for those States. That is only possible if the designated State was already a Contracting

State to the regional patent treaty (in this case the EPC) at the time of filing. The wording of Art. 153(1) is clear. The same applies to Art. 4(1)(ii) PCT, which also requires that the State for which a regional patent is applied by means of an international application must, at the time of filing, also be a member State of the regional patent treaty.

4. Correction of priority data

Early on the Legal Board allowed correction of State designation under R. 88, first sentence (**J 12/80**, OJ 1981, 143; **J 3/81**, OJ 1982, 100; **J 21/84**, OJ 1986, 75; **J 8/80**, OJ 1980, 293). 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, can be an incorrect statement or the result of an omission, all the previous cases related to omitted priority declarations (**J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121; **J 3/82**, OJ 1983, 171; **J 11/89**, **J 7/90**, OJ 1993, 133).

In the four decisions **J 3/91**, **J 6/91**, **J 9/91** and **J 2/92**, the Legal Board refined the principles which were to be applied to corrections of priority declarations. In **J 6/91**, in particular, it analysed and summarised the previous case law. There, the Board pointed out that the applicant had to prove a mistake, i.e. that the document filed with the EPO does not express the true intention of the person on whose behalf it was filed. In the former decisions the burden of proof on the applicant was defined as a heavy one. In **J 9/91**, however, the Board now took the view that the omission of a priority declaration will, 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.

Irrespective of the fact that R. 88, first sentence, allows correction without any time bar, the present Legal Board followed the established case law that a request for correction of a priority claim should be made sufficiently early for a warning to be included in the publication of the application. This principle was upheld because the EPO, when exercising its discretionary power under R. 88, first sentence, must balance the interests of the applicant in gaining optimal protection and the interests of third parties in respect of legal security, especially in ensuring that the published data of the application are correct. The Board noticed, however, that the previous case law in special circumstances already allowed the correction even without such a warning:

- 1) if the EPO was partly responsible for the fact that no warning was published (**J 12/80**) and/or
- 2) if the interest of the public was not seriously affected because
 - a) the mistake was obvious (in this sense, implicitly, **J 8/80**);
 - b) only a second or further priority was added (**J 4/82**, **J 14/82**, **J 11/89**);
 - c) the public was otherwise informed about the full scope of protection sought by the applicant (**J 14/82**).

In **J 6/91**, **J 3/91** and **J 2/92** it was now held that even after publication of a European patent application without a warning, the priority declaration can be corrected under R. 88, first sentence, provided that there is an apparent discrepancy on the face of the published application which indicates that something is wrong. In such a case, the interests of third parties are not adversely affected by the correction.

In **J 6/91**, the international application in suit, which actually claimed priority from a United States continuation-in-part application, was itself presented as a continuation-in-part application and referred back to an earlier US application. The Board allowed, also with reference to further particular circumstances, the addition of a (first) priority claim referring to this earlier US application.

In **J 3/91** the experienced practitioner could have noticed an apparent 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 2/92** the US priority date which was actually claimed for a PCT application was, owing to a clerical error, a Saturday when the USPTO is 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 according to R. 17.1(b) PCT (a typing error in the document number) the Receiving Office, here, the USPTO, transmitted a wrong document to WIPO. The Board allowed its replacement even after publication of the international application. It added, however, that this may not always be possible.

5. Extent of competence of the Receiving Section

R. 88, second sentence, 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 arises whether the Receiving Section is 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 do 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 has been transferred to the Examining Division.

However, in **J 33/89** (OJ 1991, 288) the Board pointed out that the Receiving Section remains competent for decisions on requests for correction of drawings under R. 88, second sentence, unless the request necessitates a technical examination.

C. Examination procedure

1. Decisions of the Examining Division

According to R. 51(3) any communication of the EPO during examination of a European patent application **shall** contain a reasoned statement covering, where appropriate, **all** the grounds against the grant of the European patent.

The Boards, however, take the view that where the Examining Division exercises its discretion under R. 51(3) and defers the examination there is no substantial procedural violation justifying reimbursement of the appeal fee. In decision **T 98/88** the Board of Appeal held that the Examining Division could defer the examination for novelty and

inventive step if the claims were not clear (Art. 84). Neither the EPC nor its Implementing Regulations (and, in particular, R. 51(3)) require the Examining Division to summarise all the arguments against the grant of the patent in its communication under Art. 96(2).

Board of Appeal decision **T 300/89** (OJ 1991, 480), which also considered a request for reimbursement of the appeal fee, added to the body of case law on the requirements to be met by communications under R. 51(2) and (3). The Board referred to decision **T 84/82** (OJ 1983, 451) which stated that the EPO's aim was to carry out the substantive examination thoroughly, efficiently and expeditiously. It went on to add that "As is stated in the Guidelines, VI, 2.5, the examiner should be guided at the re-examination stage by the overriding principle that a final position (grant or refusal) should be reached in as few actions as possible, and he should control the procedure with this always in mind. Thus even if it is possible for the examiner to envisage amendments which might enable progress towards grant, the burden lies upon an applicant (if he so wishes) to propose amendments (including by way of auxiliary requests) which overcome the objections raised by the Examining Division, in his observations in reply to the first communication in which such objections are raised".

One must not, however, conclude from this that a first instance decision can be based on scant or defective reasoning. On the contrary, the Boards state that it is highly desirable that the Examining Division should give an appealable decision with sufficient reasoning on all the issues that have been properly raised by the EPO during the examination proceedings and dealt with substantively in the applicant's reply. Such "complete" decisions streamline the procedure because they render remittal to the first instance unnecessary: the Board can decide all issues already raised in the first instance without depriving the appellant of an instance (see **T 153/89**, **T 33/93**, and **T 504/89** for the comparable situation in opposition appeal proceedings).

2. Discretion of the Examining Division

According to R. 86(3), after the reply to the first communication from the Examining Division, no amendments may be made to the description, claims or drawings without the consent of the Examining Division.

In decision **T 182/88** (OJ 1990, 287), the Board laid down the principle that in any case where the EPC gives discretion to a department of the EPO in relation to an issue in proceedings before it, in accordance with the general principles of law, such discretion must be exercised having regard to the factors which are relevant to such issue (see VI.A. 7.4). In both **T 182/88** and **T 166/86**, the Board decided that a separate set of claims for Austria at a particular stage in the proceedings and under the particular circumstances was admissible. It added that the user-friendly reputation of the EPO 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 law.

In **T 66/83** the Examining Division exercised its discretion by rejecting the application after the reply to its first communication, thus not offering the applicant another opportunity for amendment. The Board was of the view that "if the applicant's reply to such a first communication is such that it does not alter the Examining Division's opinion as to the lack of inventive step of the subject-matter claimed and judged upon al-

ready in the first communication, it seems entirely legitimate for the Examining Division to reject the application after the first communication”.

3. Approval of the text

The present version of R. 51 entered into force on 1.9.1987. The amendment of the former version was the consequence of a Legal Board decision (**J 22/86**, OJ 1987, 280), the reasoning of which is no longer applicable. The amendment of R. 51 introduced a new structure into the final phase of the grant procedure for European patents. Two recent Technical Board decisions centered on problems arising in the stage immediately before grant.

In **T 1/92** the applicants had initially approved the text in which the Examining Division intended to grant the patent. Within the period allowed by R. 51(4) however, they withdrew the approval and requested an extension of the time limit allowed under R. 51(4), second sentence. The Examining Division took the view that amendments were no longer possible once approval had been given. Although the applicants had taken the steps required by R. 51(6), they had also requested that examination be resumed shortly before the patent was granted. The applicants filed notice of appeal in due time and form against the decision on the granting of the patent. Mention of the grant of patent was nevertheless published in the European Patent Bulletin and the certificate was sent to the applicants. In the Board's view the appellants were adversely affected because a patent had been granted even though it could not be said that they, having withdrawn their approval under R. 51(4), had unambiguously approved the text intended for grant. The Board held the appeal to be allowable as the approval under R. 51(4) was not absolutely binding and it had not therefore been established beyond any doubt that the applicants agreed to the text in which the Examining Division intended to grant the European patent. In the Board's view the fact that publication had gone ahead in spite of the appeal was a substantial procedural violation which was incompatible with the suspensive effect of the appeal and warranted reimbursement of the appeal fee. The same applied if no decision had been taken concerning the request for resumption of proceedings.

In **T 675/90** the applicants only submitted a new set of claims for Austria after the communication under R. 51(6) had been issued. The Board of Appeal held that this amendment had been filed too late and was therefore inadmissible. The function of the communication under R. 51(6) was to draw the amendment procedure at the examination stage to a firm and final conclusion, so as to enable the public to obtain knowledge of the scope of legally prohibited activities upon the publication of the grant of the patent. Accordingly, the discretion under R. 86(3) to consider amendments did not extend to amendments proposed after the R. 51(6) stage.

In decision **T 830/91** the following question was referred to the Enlarged Board: “In the light of Art. 113(2), is R. 51(6) to be interpreted such that an approval submitted under R. 51(4) becomes binding once a communication in accordance with R. 51(6) has been issued?” This matter is pending under reference number **G 7/93**.

4. Grant of a patent

Art. 97(4) stipulates that the decision to grant a European patent does not take effect until the date on which the European Patent Bulletin mentions the grant.

In the case of decision **J 14/87** (OJ 1988, 295) the question was 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 that patent ineffective. The Board considered 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) ineffective. Nevertheless, this matter can be decided only in the light of the case in question and of the fact that the purpose of such publication is to draw the attention of interested parties to the grant of the patent, and that any decision to file opposition cannot be based solely on the particulars given in the European Patent Bulletin but rather, under normal circumstances, also on a careful examination of the extent of protection conferred by the patent. This examination can be carried out satisfactorily only if the patent specification is published at the same time as the mention of the grant of the patent.

5. Metric or SI units

In decision **T 561/91** the Examining Division rejected the application on the sole ground that the applicant had refused to express certain viscosity limits, which were identified in terms of centipoises, in the recognised SI unit of viscosity – the “pascal second”. There was, however, agreement between the applicant and the Examining Division that the centipoise was a well-known metric unit but not an SI unit.

The Board pointed out that R. 35(12) merely obliged applicants to express weights and measures in metric units. If the applicant had indisputably used metric units, then that was decisive for the point at issue. A change from the mandatory use of metric units to SI units was only possible if the Rule were amended by the Administrative Council. The Board added that it had no objections to the Examining Division continuing to encourage applicants to use SI units, so long as it was appreciated that the use of any units other than the prescribed metric units could not be demanded of an applicant.

The later decision **T 176/91** expressly upheld this case law although in the intervening decision **T 589/89** the same Board expressed a different opinion in an obiter dictum. In the latter decision the Board considered that it could not follow the interpretation of the first sentence of R. 35(12) expressed in **T 561/91** since that would go against the trend towards ever more coherent systems of measurement and result, in practice, in many non-official units being allowed in the examination procedure; the EPO would thus have its own system of units, which would contravene the legislation of the Contracting States and the EEC Directives.

6. Divisional applications

In consolidated cases **J 11/91** and **J 16/91**, the Legal Board of Appeal considered the deadline for filing a divisional application. The Board held that Art. 76(3) could not be interpreted as authorising a general prohibition on the filing of divisional applications at a time when the subject-matter which had been divided out from the parent application was still pending before the EPO. There was therefore no justification for the new time limit imposed by the amendment to R. 25(1) of 1.10.1988 for filing a divisional application. The Board thus held that a European divisional application on a pending earlier European patent application could still be validly filed after the approval in accordance with R. 51(4) of the text in which the European patent for the earlier

application was to be granted – a departure from R. 25(1). However, such a late filing of a divisional application would not be effective after the decision had been taken pursuant to Art. 97(2) to grant the patent.

Since decisions **J 11/91** and **J 16/91** differ from **T 92/85** (OJ 1986, 352) the President of the EPO has referred the following question to the Enlarged Board of Appeal in accordance with Art. 112(1)(b): “Until when may an applicant file a divisional application on the pending earlier European patent application?” This referral is pending under reference number **G 10/92**.

In **T 118/91** the relationship between parent application and divisional application was one of the issues before the Board of Appeal. The Board held that neither Art. 76 nor any other article of the EPC gave any support to the contention that the subject-matter of the divisional application should be considered as having been abandoned in the original application. The “content of the application as filed” referred to in Art. 100(c) and 123(2) was the totality of information given to the skilled person by the original application and could not, as a matter of logic, be reduced by the subsequent filing of a divisional application, whatever the content thereof might be. Equally, the Board could find no support for 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. This question is dealt with in the Guidelines at C-VI, 9.6, where it is indicated that one application may generally 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 that particular case, the Board was satisfied that any danger of “double patenting” had been eliminated by extensive restriction of the claims of the divisional application.

D. Opposition procedure

1. The legal nature of opposition proceedings

In decisions **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board considered questions concerning some fundamental aspects of opposition and appeals procedure under the EPC.

In **G 9/91**, the Enlarged Board considered whether the power of an Opposition Division or, by reason of R. 66(1), of a Board of Appeal, to examine and decide on the maintenance of a European patent under Arts. 101 and 102 is dependent upon the extent to which the patent is opposed in the notice of opposition pursuant to R. 55(c).

In **G 10/91**, the President of the EPO referred the complementary question whether the Opposition Division, in the examination of the opposition, is obliged to consider all the grounds for opposition referred to in Art. 100 or whether the examination should be restricted to the grounds referred to by the opponent in his notice of opposition.

In reaching its decision, the Enlarged Board considered the nature of the opposition procedure under the EPC. The Board pointed out that opposition under the EPC takes place only after grant of the European patent. Thus, the relief sought by the opponent is not, as in traditional pre-grant opposition, refusal of the patent application but revo-

cation of the patent as granted. The Enlarged Board noted that the concept of post-grant opposition under the EPC differs considerably from that of classical pre-grant opposition and in fact has several important features more in common with the concept of traditional revocation procedure. It thus seemed to the Enlarged Board that post-grant opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment.

The Enlarged Board noted that it is inherent in any post-grant opposition procedure that the patent office cannot take any action in respect of a granted patent, however clear it may have become after grant that the patent is invalid, unless initiated under an admissible opposition. Moreover, a post-grant opposition procedure may be constructed in different ways – an opponent could, for example, be allowed to confine his action to making a simple request for a general re-examination of the patent on the basis of some general observations. However, the post-grant opposition procedure under the EPC is not constructed this way. As appears from Art. 99 in conjunction with R. 55(c), the notice of opposition must, *inter alia*, contain a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds.

The Enlarged Board therefore considered that the core of the matter in the cases before it was whether the statement of the opponent under Rule 55(c) EPC limits the power and obligation of the EPO in its examination of the case or whether such examination may or even should go beyond the opposition as filed and be extended to other parts of the patent and to other grounds for opposition than those covered by such statement. A further question which arose was whether the same principles are to be applied to proceedings before an Opposition Division and to appeal proceedings.

The Enlarged Board held that R. 55(c) only makes sense interpreted as having the double function of governing (together with other provisions) the admissibility of the opposition and of establishing at the same time the legal and factual framework, within which the substantive examination of the opposition in principle shall be conducted. Moreover, a distinction has to be made between the two main requirements of R. 55(c), i.e. the indication of the extent to which the European patent is opposed and the grounds for opposition.

The Enlarged Board pointed out that it is rather unusual for the opposition to be limited to only a certain part of the patent. If, however, this is the case, the examination of an opposition under Art. 101 was limited by the statement in the notice of opposition of the extent to which the patent is opposed. It was further stated that neither the Opposition Division nor a Board of Appeal has the obligation or power to examine and decide on the maintenance of a European patent except to the extent to which it is opposed. The decision reached was based on the consideration that 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. In this context, the Enlarged Board referred to **T 9/87** (OJ 1989, 438), where Board 3.3.1 had already set out these principles.

Further decisions of Board 3.3.1 came to the same conclusion: **T 406/86** (OJ 1989, 302), **T 117/86** (OJ 1989, 401), **T 648/88** (OJ 1991, 292), holding that the EPO's compe-

tence was therefore limited to checking the legal validity of the claims contested in the notice of opposition. In decision **T 192/88** amendments had been proposed to claims not comprised in the notice of opposition, but since they all contained a reference to a contested claim, the Board construed the notice of opposition as comprising these claims to the same extent as they referred to the contested claim.

The Enlarged Board held that the requirement of R. 55(c) to specify the extent to which the patent is opposed within the time limit prescribed by Art. 99(1) 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 EPC. Subject-matter not included by the opponent in his opposition is therefore not subject to any "opposition", nor are there any "proceedings" in the sense of Arts. 114 and 115 in existence concerning the non-opposed subject-matter. Consequently, the EPO has no competence to deal with them at all.

The Enlarged Board therefore held in **G 9/91** that the power of an Opposition Division or a Board of Appeal to examine and decide on the maintenance of a European patent under Arts. 101 and 102 depends on the extent to which the patent is opposed in the notice of opposition pursuant to R. 55(c). However, subject-matter of claims depending on an independent claim, which falls in opposition or appeal proceedings, may be examined as to their patentability even if they have not been explicitly opposed, provided their validity is *prima facie* in doubt on the basis of already available information.

In **G 10/91** the Enlarged Board of Appeal turned to the second main requirement of the statement under R. 55(c), i.e. the indication of the grounds on which the opposition is based. The Board noted that the problems here differ from those related to the first main requirement in that in the case of the extent to which the patent is opposed, it is a question of the formal competence of an Opposition Division or a Board of Appeal to deal with a non-opposed part, whereas the problems connected with the grounds for opposition are more concerned with the procedural principles to be applied where the European patent or part of it has been correctly opposed.

The Enlarged Board agreed that Art 114(1) is no legal basis for an obligatory review of grounds for opposition not covered by the statement pursuant to Rule 55(c). The Board then went on to consider whether Art. 114(1) actually empowers the Opposition Division or the Board of Appeal to investigate such grounds at all. As far as the Opposition Division is concerned, the Board held that an Opposition Division may, in application of Art. 114(1), of its own motion raise a ground for opposition not covered by the statement pursuant to R. 55(c). However, this should only take place where, *prima facie*, there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent.

The Enlarged Board then went on to clarify the situation in respect of the appeal procedure. The Board, overruling **T 493/88** (OJ 1991, 380), held that in contrast to the merely administrative character of the procedure before the Opposition Division, the appeal procedure is to be considered as a judicial procedure. Such procedure is by its very nature less investigative than an administrative procedure. Thus, although Art. 114(1) formally covers the appeal procedure too, it is justified to apply this provision in a more restrictive manner than in the opposition procedure. The Board considered that fresh grounds for opposition should not be introduced at the appeal stage unless the patentee agrees.

The Enlarged Board thus held in **G 10/91** that an Opposition Division or a Board of Appeal is not obliged to consider all the grounds for opposition referred to in Art. 100, going beyond the grounds covered by the statement under R. 55(c). Exceptionally, however, the Opposition Division may in application of Art. 114(1) consider other grounds for opposition, which, *prima facie*, in whole or in part would seem to prejudice the maintenance of the European patent.

2. General issues

2.1 Acceleration of proceedings in 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.) stipulate that it should, in principle, process submissions in order of receipt. However, the Guidelines also list cases to be given priority. An EPO notice dated 11.7.1990 (OJ 1990, 324) clarified this matter. The EPO speeds up its processing of an opposition case when it is informed by a party to the proceedings or by the court or other competent authority of a Contracting State that an infringement action is pending.

Decision **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, whereupon the opponent filed an appeal on 12.4.1989. A communication under R. 69(1) stating that the opposition was deemed not to have been filed was issued on 2.6.1989, followed by a decision under R. 69(2) on 29.1.1990. 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.

In its decision the Board of Appeal held accelerated processing to be a basic principle in procedural law. It is essential for a patent to be enforceable in practice and timing is often a matter of great importance for the patentee and his competitors. It is therefore not only important to decide quickly about the appeal but also to bring the opposition proceedings to a speedy conclusion. Hence, if several oppositions are filed and the admissibility of one of them is questioned, the opposition should be processed up to the point when it is ready to be decided, and at the same time as the appeal is being examined, so that the opposition can be decided soon after completion of the appeal proceedings. Art. 106(1), second sentence, stipulates that appeals have suspensive effect, so the potentially inadmissible opposition should be considered admissible unless and until the Board of Appeal decides otherwise.

2.2 Intervention of an alleged infringer

In case **T 202/89** (OJ 1992, 223) the following point of law was referred to the Enlarged Board of Appeal: Does a party which gives valid notice of intervention in opposition proceedings (Art. 105) during the period for appeal following the Opposition Division's decision have a right of appeal under Art. 107?

In **G 4/91** (OJ 1993, 339), the Enlarged Board held that the intervention under Art. 105 of an assumed infringer in the opposition proceedings presupposes that opposition

proceedings are pending at the time he gives notice of intervention. Moreover, a decision of the Opposition Division on the relief sought must be regarded as conclusive in the sense that the Opposition Division no longer has power thereafter to amend its decision. The Enlarged Board further held that proceedings before an Opposition Division are terminated upon issue of such a final decision, regardless of when such decision takes legal effect. Thus, in a case where, after issue of a final decision by an Opposition Division, no appeal is filed by a party to the proceedings before the Opposition Division, a notice of intervention which is filed during the two-month period for appeal provided by Art. 108 has no legal effect. The situations where notice of intervention is given during the time limit for filing an appeal and is then followed by an admissible appeal, or where the intervention is made during appeal proceedings, are now before the Enlarged Board of Appeal in case **G 6/93** (see VI.E. 3.2).

2.3 Transfer of opposition

The following question regarding the transfer of an opposition was put to the Enlarged Board of Appeal: Is an opposition pending before the EPO transferable only to the opponent's heirs or can it be transferred freely either with the opponent's enterprise or with a part of that enterprise operating in a technical field in which the invention to which the patent in suit relates can be exploited?

In its decision **G 4/88** (OJ 1989, 480), the Enlarged Board of Appeal, after noting that the EPC implicitly acknowledged the transmission of the opposition to the opponent's heirs (R. 60(2)), held that the opposition constitutes an inseparable part of the enterprise's assets; therefore, insofar as those assets are transferable or assignable under the applicable national laws, the opposition which is part of them must also be regarded as transferable or assignable in accordance with the principle that an accessory thing when annexed to a principal thing becomes part of the principal thing.

2.4 Withdrawal of opposition – continuation of opposition proceedings (R. 60(2) EPC)

2.4.1 Withdrawal during opposition proceedings

In **T 197/88** (OJ 1989, 412) the Board considered the circumstances under which opposition proceedings may be continued by the EPO of its own motion under R. 60(2) when an opposition is withdrawn. In a communication under R. 58(4) the Opposition Division had proposed an amended version of the patent which the patent proprietor approved. The opponent at first raised objections but then withdrew his opposition, whereupon the Opposition Division terminated the proceedings. In response to the patent proprietor's appeal, the Board remitted the case to the Opposition Division to continue the proceedings. The Board pointed out the EPO's duty to the public not to maintain patents which it is convinced are not legally valid at all or only to a limited extent. Furthermore, it is often the patent proprietor who is interested in limiting his patent to ensure that his claims stand up to legal scrutiny. The proceedings should therefore be continued if they have 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.

2.4.2 Withdrawal of opposition during appeal proceedings

In several cases the Boards of Appeal considered the significance in procedural law of the withdrawal of the opposition during the appeal proceedings.

In particular, in **T 629/90** (OJ 1992, 654), two oppositions had been lodged against the granting of a patent. Opponent (1) had withdrawn his opposition prior to delivery of the decision by the Opposition Division. The patent proprietor lodged an appeal against the patent's revocation. Opponent (2) withdrew his opposition prior to oral proceedings.

The Board held that, in contrast to the situation in opposition proceedings, where it is a matter of discretion whether the case is continued following withdrawal of the opposition, such withdrawal in appeal proceedings has no direct significance in terms of procedural law if the Opposition Division has revoked the European patent. In this case, the Board of Appeal would have to examine the substance of the Opposition Division's decision of its own motion; it could only set the decision aside and maintain the patent if the latter met the requirements of the EPC. The Board could also take account of evidence submitted by an opponent prior to withdrawal of the opposition (see also VI.E. 4.2).

3. Admissibility of opposition

3.1 General remarks

Under R. 57 EPC "if the opposition is admissible", the Opposition Division will notify the proprietor of the patent and invite him to file observations and amendments, where appropriate, within a specific period. In **G 1/84** (OJ 1985, 299) the Enlarged Board stated that notice of opposition against a European patent is also admissible if it is filed by the proprietor of the patent.

In decision **T 222/85** (OJ 1988, 128), the appellant contended that "once the opposition has been declared admissible by way of the communication according to R. 57(1) there is no basis in the EPC to reverse such decision and declare the opposition inadmissible". However, the Board decided that a communication under R 57(1) indicating the admissibility of an opposition is not a decision of the Opposition Division, and the sending of such a communication does not prevent the subsequent rejection of the notice of opposition as inadmissible under R 56(1), for example, if the admissibility is challenged by the proprietor of the patent in such proceedings.

In decision **T 289/91** the Board went a stage further. Here the respondent (patentee), although doubtful of the admissibility of the opposition, did not raise any objection until the appeal proceedings were under way, not even contesting in their appeal the Opposition Division's finding that the opposition was admissible. The Board held that, although such action was not to be condoned, it was nonetheless possible at any stage in the proceedings (even a late one) to object that the opposition was inadmissible, e.g. (as in this case) by reason of the opponent's non-entitlement; for admissibility was an indispensable procedural prerequisite for considering the opposition, and as such had to be established by the Office of its own motion.

3.2 Formal requirements

3.2.1 Notice of opposition/opposition period

According to Article 99(1), notice of opposition must be filed within nine months from the publication of the mention of the grant of the European patent. In decision **T 438/87** the question asked was whether a delay in publication of the European patent specification could in any way affect calculation of this time limit. From the wording of Art. 99(1), the Board of Appeal noted that “the EPC does not contain any other reservation making the conditions for application of this time limit subject to publication of the relevant patent specification” and concluded that “since mention of the grant of the patent in suit was brought to the public’s attention in the normal way in the Bulletin ... it is this latter date which should be taken as the point from which the opposition time limit runs, irrespective of what problems may have affected publication of the patent specification and what consequences such untoward event may have for certain third parties owing to their geographical location”.

In decision **T 317/86** (OJ 1989, 378) the Board of Appeal had to decide on the admissibility of a notice of opposition. Because the opponent had not indicated the title of the invention within the period specified under R. 56(2), the Formalities Section concluded that the notice of opposition was inadmissible. The Board scrutinised all the rules governing the admissibility of a notice of opposition as laid down in the EPC, and found, in particular, judgments to the effect that the name of the opponent - contrary to the letter of Rules 55(a) and 56(2) - cannot be freely added later on. This ruling applies when the point at issue is the identity of the opponent, which should be established conclusively before the opposition period expires (R. 55(a), Art. 99(1)). 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 - does not constitute a deficiency within the meaning of R. 56(2), provided that the other particulars available to the EPO are together sufficient to identify easily and beyond doubt the patent being contested by means of an opposition.

3.2.2 Identifiability of opponent

In decision **T 219/86** (OJ 1988, 254) it was held that deliberate concealment of an opponent’s identity must be regarded as intentional non-compliance with R. 55(a) and it cannot be corrected as a “mistake” under R. 88 at any time. However, if an opponent is not correctly identified in the notice of opposition, owing to a genuine mistake, the Board held that, in principle, the mistake can be corrected even after expiry of the opposition period, under R. 88.

In **T 635/88** (OJ 1993, 608) the Board of Appeal considered the admissibility of an opposition filed by a consultancy firm, ostensibly acting on its own. The patent proprietor company alleged that the firm was acting on behalf of a company against which the proprietor had commenced infringement proceedings. The Board held that, on the evidence, a legitimate doubt did exist about the real opponent’s identity and that this doubt did not comply with Rule 55(a) EPC. It accordingly requested the firm under Article 117(g) EPC to file a sworn statement confirming that it was acting on its own behalf. The firm replied, reiterating its position and stating that it could make a sworn statement, but it did not in fact do so.

The Board held that the firm was a “legal person” within the meaning of Article 99(1) EPC, which states that “any person may give notice of opposition” and also that the firm did not need to be represented by a professional representative. However, the following questions had to be answered: 1) whether a lack of interest in opposing patent rights was a ground for inadmissibility of an opposition; 2) whether a firm of international consultants and brokers in international property was legally entitled to file an opposition against a European patent before the EPO in its own name, and, if so; 3) whether the opposition remains admissible even if a legitimate doubt remains relating to the real opponent’s identity.

The Board found that the EPC does not require any particular interest to start opposition proceedings and that the firm was also legally entitled to file an opposition in its own name. However, the Board held that the reasoning in **T 10/82** (OJ 1983, 407) was applicable. Here a professional representative was held not to be entitled to give notice of opposition in his own name, when he is in fact acting for a client. Thus the positive answer to the second question assumed that “any person” had been clearly identified, i.e. that the “any person” giving notice of opposition is acting in his own name and not on behalf of a third party. The opposition was therefore rejected as inadmissible.

3.2.3 Signature of professional representative

In decision **T 665/89** the Board of Appeal addressed the question of the admissibility of an opposition by an opponent whose residence is in a Contracting State if the notice of opposition is signed by a person who is neither a professional representative (Art. 134(1) or (7)) nor an employee of the opponent (Art. 133(3)). The Board of Appeal concluded that the actions of the unauthorised person should be judged as if the signature were missing, and thus assumed that the deficiency was remediable. The opponent obtained the correct signature at the Office’s request within the time limit laid down. The document thus retained the original date of receipt in accordance with R. 36(3), third sentence.

3.3 Substantiation and burden of proof

3.3.1 General remarks

Under R. 55(c) the notice of opposition shall contain three items: a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds.

Several decisions have considered, in particular, the third requirement of an indication of the facts, evidence and arguments presented, and the conditions to be satisfied in order for it to be fulfilled.

In decision **T 222/85** (OJ 1988, 128), the Board of Appeal held that this requirement is only satisfied if the contents of the notice of opposition are sufficient for the opponent’s case to be properly understood on an objective basis. The Board reasoned that the purpose of requirement (3) of R. 55(c) (in combination with requirements (1) and (2)) is to ensure that the notice of opposition sets out the opponent’s case sufficiently so that both the patentee and the Opposition Division know what that case is. Require-

ment (3) of R. 55(c) in combination with Art. 99(1) is substantive in nature and calls for reasoning which goes to the merits of the opponent's case. A well-drafted opposition should contain reasoning that is full but concise. And in general, the less reasoning that a notice of opposition contains, the greater the risk that it will be rejected as inadmissible. The Board held that the question whether a particular notice of opposition meets the minimum substantive requirements of Art. 99(1) and R. 55(c) can only be decided in the context of that particular case (since various relevant factors, such as the complexity of the issues raised, vary from case to case).

The Board further pointed out that the sufficiency of the notice of opposition in this respect must be distinguished from the strength of the opponent's case. On the one hand, an unconvincing ground of opposition may have been clearly presented and argued. Conversely, a deficient submission may be rejected as inadmissible even though, if properly drafted, it would have succeeded.

Decisions **T 453/87** and **T 2/89** (OJ 1991, 51) followed this decision, the latter also stressing that the question whether an opposition satisfies the requirements of R. 55(c) should be distinguished from the question of the merits of bringing the opposition.

Several decisions then considered in greater detail what constitutes sufficient substantiation in the notice of opposition. An opposition which does not deal with all the features of a contested claim and an opposition based on a subsequently published document which refers to a document published before the priority date have both been held to satisfy the requirements of R. 55(c).

In **T 134/88** the opposition did not deal with all the features of the contested claim, but still satisfied R. 55(c). The Board summed up by saying that an opposition directed against alleged lack of inventive step in the case of a combination invention is generally inadmissible if it relates 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 is based are indicated, circumstances become recognisable which enable 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.

Regarding the question of the admissibility of an opposition based only on a subsequently published document, in decision **T 185/88** (OJ 1990, 451) the Board of Appeal ruled that grounds for an opposition are present in due form if the only document cited in support of the sole assertion of lack of inventive step (German patent specification) is in fact published **after** the date of filing or priority but nevertheless contains a reference to the publication known **before** the date of filing or priority (German unexamined application or "Offenlegungsschrift").

In **T 344/88** the Board of Appeal considered whether citing the wrong number for a patent specification by the opponent contravened R. 55(c), where 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.

Citing Guidelines D-IV, 1.2.2.1(f), the Opposition Division held that the content of the statement of grounds for the opposition must be such as to enable the patent proprie-

tor and the Opposition Division to carry out an examination without recourse to independent enquiries, on the basis of the documents cited during the period for opposition. The opposition thus did not comply with R. 55(c) and was inadmissible.

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.

On the other hand, in several cases the Board found the substantiation in the notice of opposition insufficient.

In **T 448/89** (OJ 1992, 361) the Board of Appeal followed decision **T 222/85** and rejected the opposition as inadmissible. The Board held that the requirement under R. 55(c) for facts and evidence in support of the grounds to be indicated is not fulfilled if several different subject-matters are described in a document cited as prejudicial to novelty and it is neither stated nor readily discernible which of them incorporates 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 is not enough if it is neither stated nor readily discernible which document is being presented in support of which argument.

The Board came to a similar decision in **T 204/91**. In this case the opponents had filed a notice of opposition citing four documents and indicating that the whole of each cited document was being relied upon under both the grounds of opposition invoked and against specified claims. Although the Board decided the appeal on a different point, it expressed serious doubts as to whether the mere citation of documents of some length could, in this case at least, be regarded as a clear indication, in accordance with R. 55(c), of the case the patentees have to answer.

In decision **T 550/88** (OJ 1992, 117) the Board of Appeal considered whether national prior rights can as a matter of law constitute "facts or evidence" which are relevant to the ground of lack of novelty under Arts. 54(1) and (3). If not, such facts and evidence do not support the ground of opposition which has been alleged and therefore do not satisfy the requirement of R. 55(c).

In the Board's judgment on the proper interpretation of Art. 54(3), national prior rights are not comprised in the state of the art and only prior European patent applications filed under the EPC can be considered as such under Art 54(3). 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.

The opponent must not only base his opposition on substantiated arguments, he also bears the burden of proof that the ground for opposition actually exists. The burden of proof is also on the opponent to show that a technical disclosure in a prior art document is the same as the one in a patent attacked by an opponent (see **T 270/90**, **T 109/91** and IV.A. 9.2).

In the latter case, the Opposition Division had requested a comparison of the complete nucleotide sequence of two deposited plasmids. However, the Board doubted

whether the opponents, in order to supply the necessary proof, had to provide an analysis of each and every technical detail of the deposited material. The Opposition Division had based its request on the assumption that, by the deposition of living material, the depositor de facto not only disclosed some properties of this living material, but made the whole molecule available to the public and thus potentially disclosed its properties in their entirety.

In the Board's opinion, the Opposition Division had confused the requirements of Arts. 54, 83 and R. 28 and the quantity and quality of the burden of proof on an opponent in opposition proceedings. R. 28 stated that a sufficient disclosure within the meaning of Art. 83 was required for micro-organisms which could not be verbally described such that a skilled person could carry out the invention. A plasmid described in accordance with R. 28, as in this case, could be used by a skilled person without knowing its molecular structure.

In the case before it, the Board found that the appellants had provided enough evidence to demonstrate to the conviction of the Board that the plasmids in question were identical. The mere allegation by the respondents that they were not was not convincing. It was incumbent upon the respondents to substantiate their allegation.

3.3.2 Substantiation in the case of public prior use

In cases of alleged public prior use particular substantiation in the notice of opposition is required. However, a difference must still be made between examining the admissibility of the opposition and its substantive merit.

The particular substantiation required was set out in **T 328/87** (OJ 1992, 701). Here, the Board of Appeal held that when an opposition is based on prior use, the notice of opposition must, in order to satisfy R. 55(c), indicate within the opposition period all facts which permit the date, object and circumstances of the prior use to be established, as well as the evidence in support thereof. However, that rule did not prescribe that the evidence must be put on file within this time limit. The Board further held that when an opposition is deemed inadmissible it cannot be examined substantively, not even by the Office of its own motion in accordance with Art. 114(1).

In **T 538/88**, the Board of Appeal stressed that a difference must be made between examination of the opposition's admissibility and of the substantive arguments in its favour. In this decision, the Board stated that there was no EPC provision requiring that the notice of opposition be conclusive in itself in order to guarantee the opposition's admissibility. In the Board's opinion, it was sufficient for the information on the alleged public prior use submitted within the period for opposition to be comprehensible enough to an average skilled person for an examination of its substantive merits to be initiated. The evidence specified could be submitted after expiry of the period for opposition. Nomination of a witness for a subsequent examination of witness was deemed to constitute indication of evidence.

Although a Board of Appeal has an obligation under Art. 114 to investigate matters of its own motion, that obligation does 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 (**T 129/88**, OJ 1993, 598). In this decision the Board held that the reason for this was that the obligation to investigate of its own motion imposed on the

EPO by Art. 114(1) 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 country 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 prior public use had already been substantiated by documents of undisputed authenticity, or if the material facts with respect to the alleged prior public use were undisputed.

4. Admissibility of amendments

4.1 General remarks

The case law of the Boards of Appeal has made it clear that the opposition procedure is designed to provide an examination of the validity of a patent on the basis of the objections to validity raised under Art. 100. Opposition proceedings, therefore, are not an opportunity for the patent proprietor to propose amendments to the text of a patent for purposes which are not clearly related to meeting grounds advanced for an opposition under Art. 100 (see **T 295/87**, OJ 1990, 470 and **T 127/85**, OJ 1989, 271).

This principle was developed further in decision **T 406/86** (OJ 1989, 302), where the Board of Appeal held that the law does not guarantee the patent proprietor the right to have proposed amendments incorporated and that it is for the department concerned, exercising due discretion, to allow or refuse them; only if such amendments are “appropriate” and “necessary” as provided for in Art. 101(2) and R. 57(1) and 58(2) should the Opposition Division or the Board allow them.

This was confirmed by decision **T 295/87** (OJ 1990, 470), which also set out once more the criteria for considering whether the proposed amendments are “appropriate” and “necessary”; this is the case only if they can be fairly said to arise out of the grounds for opposition laid down in Art. 100. These criteria were again upheld in **T 317/90** which found that opposition proceedings therefore do not provide an opportunity to include new subject-matter in the claims which might have adequate support in the description but had not previously been claimed as such.

In decision **T 127/85** cited above, the Board of Appeal also 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 the amendments were to comply with Art. 123.

However, this does not mean that the patent proprietor cannot amend his requests during opposition proceedings without this constituting an abuse of procedure. In **T 64/85**, for example, the patent proprietor reinstated his European patent as granted after initially trying to accommodate the opponent’s wishes. In **T 296/87** (OJ 1990, 195) the Board of Appeal considered that the complexity of the subject-matter made understandable the appellant’s considerable uncertainty about what form of limitation the EPO would accept for the purposes of novelty. Thus, in both these cases, the Boards held that an amendment to the requests could not in the circumstances be considered an abuse.

In **T 123/85** (OJ 1989, 336) the Board followed this principle, holding that a patentee is quite entitled to amend his request after it has been made. Here the Board applied this principle to a proposed amendment by the patentee limiting, or revoking, part of his patent. The opponent claimed that the patentee could not amend this, as he had surrendered that part of the patent. The Board could not agree, citing decisions **T 73/84** (OJ 1985, 241) and **T 186/84** (OJ 1986, 79) (see also VI.A. 10.2).

4.2 Lack of clarity – clarification of ambiguities in the granted patent

As was stated above (see 4.1), the patent proprietor may not make amendments to the text of a patent for purposes which are not clearly related to meeting grounds advanced for an opposition under Art. 100. This applies equally to amendments during opposition proceedings intended merely to clarify ambiguities in the claims or description (see **T 50/90**, **T 24/88** and **T 324/89**).

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 or by the Board under Art. 114, 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, such claims may be more widely construed than a court would have construed them by the application of Art. 69.

However, in the Board's opinion, the removal of an inconsistency between a claim and the description should be allowed if the inconsistency arises from an error, provided that the error is 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 does not represent an abuse of opposition proceedings. Moreover, the removal of the discrepancy is in the interest of legal certainty.

In decision **T 127/85** (OJ 1989, 271) the Board of Appeal held that objections to clarity of claims or any consequent requests for amendment are only relevant to opposition proceedings insofar as they can influence the decisions on issues under Art. 100 or arise in relation to matter to be amended in consequence of such issues.

In decision **T 89/89** the Board held that since the amendment proposed by the patent proprietor could not overcome the ground for opposition the question of whether the claims were clear could not be considered. The claim had to be understood as it stood and interpreted, if necessary, in the light of the description and drawings. The Boards have followed this reasoning in a number of other cases (**T 16/87**, **T 62/88** and **T 565/89**), interpreting disputed claims in the light of the description and drawings as laid down in Art. 69(1) and the Protocol on its interpretation (see also II.B. 4.).

In decision **T 16/87** (OJ 1992, 212) the patent proprietor and opponent were in dispute about the meaning of a claim. The Board of Appeal ruled that the provision under Art. 69(1) stipulating that the description and any drawings are to be used to interpret the claims also applies to opposition proceedings when the meaning of a claim has to be objectively determined to assess its subject-matter's novelty and inventiveness.

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, not Art. 84, and may therefore be taken into consideration in opposition proceedings (**T 175/86**).

Where amendments are requested by a patentee in the course of opposition proceedings, Art. 102(3) confers upon the Opposition Division as well as the Boards of Appeal jurisdiction, and thus the power, to consider the whole of the EPC, including Art. 84 (**T 472/88**). In this case the Board took the view that an amendment wholly unconnected with, e.g. an Art. 84 issue, could not, by its mere existence, legitimately invoke the operation of that Article in appeal or in opposition proceedings. However, an amendment directly giving rise to an ambiguity under Art. 84 would need to be dealt with by the Board.

It is also well established that an opponent may not oppose a patent on the grounds that the claims or description are unclear. In **T 23/86** (OJ 1987, 316), for example, the opponent alleged that an (unamended) claim was unclear. However, the Board of Appeal held that Art. 84 is an EPC requirement concerning patent applications. It must be taken into account in opposition proceedings whenever the patent proprietor makes any amendments, but is not a ground for opposition itself under Art. 100. The Board explained that opposition proceedings are not a continuation of the examination proceedings involving third parties, but, like revocation proceedings, serve as a substantive legal test of whether the patent still stands in the light of facts emerging after it has been granted.

5. Examination of the opposition

5.1 Extent of the examination

The case law of the Boards of Appeal has for some time been divided on the extent to which the Opposition Division (or, under R. 66(1), a Board of Appeal) may examine the patent in accordance with Arts. 101 and 102. Some Boards have advocated that examination be restricted to the contested claims (e.g. **T 9/87**, **T 192/88**). Others have favoured unrestricted examination of the grounds for opposition and the claims in accordance with Art. 114(1) (e.g. **T 493/88**, **T 156/84**, **T 197/88**, **T 266/87**, **T 392/89**).

The matter has now been decided by the Enlarged Board of Appeal in **G 9/91** (OJ 1993, 408), which is discussed in detail under VI.D. 1. above. In its decision, the Enlarged Board held that the power of an Enlarged Board to examine and decide on the maintenance of a European patent under Arts. 101 and 102 depends upon the extent to which the patent is opposed in the notice of opposition pursuant to R. 55(c). However, subject-matters of claims depending on an independent claim, which falls in opposition or appeal proceedings, may be examined as to their patentability even if they have not been explicitly opposed, provided their validity is *prima facie* in doubt on the basis of already available information.

A related question was decided by the Enlarged Board of Appeal in **G 10/91** (OJ 1993, 420), also discussed in more detail under VI.D. 1. above. Here the question referred was whether the Opposition Division in the examination of the opposition is obliged to consider all the grounds for opposition referred to in Art. 100 or is this examination restricted to the grounds referred to by the opponent in his statement of grounds of opposition?

The Enlarged Board held that an Opposition Division or Board of Appeal is not obliged to consider all the grounds for opposition referred to in Art. 100, going beyond the

grounds covered by the statement under Rule 55(c). In principle, the Opposition Division should examine only such grounds for opposition which have been properly submitted and substantiated in accordance with Art. 99(1) in conjunction with R. 55(c). Exceptionally, however, the Opposition Division may, in application of Art. 114(1), consider other grounds for opposition, which, *prima facie*, in whole or in part would seem to prejudice the maintenance of the European patent. Finally, fresh grounds may be considered in appeal only with the approval of the patentee.

In order to avoid any misunderstanding, these two Enlarged Board decisions also confirmed the principle first set out in **T 227/88** (OJ 1990, 292) that where amendments are made to the claims or other parts of a patent 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, e.g. with regard to the provisions of Art. 123(2) and (3).

5.2 Unity of invention in opposition proceedings

In its decision **G 1/91** (OJ 1992, 253) the Enlarged Board of Appeal came to the conclusion that, for the maintenance of a patent as amended, unity of invention was not one of the requirements that had to be met under Art. 102(3) by a European patent and the invention to which it related. In opposition proceedings it was therefore irrelevant if the European patent, either as granted or following amendment, did not meet the requirement of unity of invention. The question arose in **T 220/89** (OJ 1992, 295), where the appellant (opponent) opposed maintenance of a patent as amended on the grounds that amendment of the claims had led to a lack of unity of invention. Unity of invention was a requirement that had to be met under Art. 102(3) by a patent amended during opposition proceedings, since R. 61a provided that Part III, Chapter II of the Implementing Regulations, and thus also R. 30 in conjunction with Art. 82, applied to opposition proceedings.

On the basis of Art. 102(3), the Enlarged Board established that it could be concluded from the wording of this provision that the requirements to be met by an amended patent were not necessarily the same as those to be fulfilled by a patent application. Furthermore, R. 61a referred to provisions governing documents. R. 30 was not concerned with the form and content of documents but was rather a legal norm for interpreting Art. 82. The fact that R. 61a contained a global reference did not preclude such an interpretation. The Interim Committee which had prepared the insertion of R. 61a was itself of the opinion that a global reference was better in view of the complexity of the subject-matter, although some of the provisions in the Chapter referred to were obviously not applicable to opposition proceedings.

According to the Enlarged Board of Appeal, this interpretation was in keeping with both the unity of invention requirement and the opposition procedure: unity of invention served several routine administrative purposes, in particular in determining the responsibilities of the departments dealing with the application, as well as financial purposes. Once a patent had been granted both aspects became unimportant. The opposition procedure gave competitors the opportunity to oppose unjustified property rights. Lack of unity of invention could only result in an application being divided to produce two or more patents: it did not rule out patent protection. Since it was no longer possible to divide a patent at the opposition stage, the Enlarged Board of Appeal considered it inappropriate to give a competitor the opportunity to attack a patent on the grounds of lack of unity of invention.

6. Decision of Opposition Division

6.1 Revocation by 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) 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) 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). It saw an analogy between revocation under Art. 102(4) and (5) and the grant procedure. Other Boards' case law, on which the revocation by decision was based, had not considered the alternative, namely automatic loss of rights. In view of R. 58, which had since been amended to allow a period of grace in the event of non-observance of the time limits under Art. 102(4) and (5), the Board refrained from referring this point of law to the Enlarged Board of Appeal.

However, the President of the EPO took the matter up under Art. 112(1)(b) in the light of diverging decisions of the Boards of Appeal, because it touched on principles of procedural law and because it had to be clear to the opponent when the proceedings had been terminated. Non-observance of the time limits still had to be expected even after the introduction of a period of grace, particularly if the patent proprietor was no longer interested in the protective right.

In **G 1/90** (OJ 1991, 275) the Enlarged Board of Appeal commented that the revocation of a patent under Art. 102(4) and (5) **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). The Enlarged Board also considered the issue of legal certainty and, in the light of the "travaux préparatoires" relating to R. 69, discussed the question of when a loss of rights noted in accordance with that provision became non-appealable. The procedure of pronouncing revocation by decision leads neither to legal uncertainty nor to misunderstandings. Whereas, in the grant procedure, there was a clear basis for 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), which is followed on request by a decision (R.69(2)), and when a decision is not preceded by such a communication. If the EPC had laid down different provisions for grant and opposition, that did not constitute an internal contradiction.

6.2 Interlocutory decisions

Under Art. 106(3), the EPO may issue interlocutory decisions. In **T 89/90** (OJ 1992, 456), the Board of Appeal examined the extent to which this practice is justified in opposition proceedings, the opponents having lodged objections to an interlocutory decision which maintained the patent as amended. The Board held that, in the absence of general provisions in the EPC, it was at the discretion of the responsible department to decide whether to deliver an interlocutory decision or a final decision terminating the proceedings. Costs could also be taken into account. The long-established practice of

the EPO of delivering interlocutory decisions subject to appeal when a patent was maintained as amended was based on just such a consideration and could not be objected to on formal or substantive grounds (see also VI.E. 8.3.2).

7. Apportionment of costs

7.1 Introduction

In principle, each party to opposition proceedings meets its own costs. However, under Art. 104(1) the Opposition Division or Board of Appeal can, for reasons of equity, order a different apportionment of costs incurred during taking of evidence or in oral proceedings.

7.2 Taking of evidence

In decision **T 117/86** (OJ 1989, 401) the Board said the phrase “taking of evidence” used in Art. 104(1) refers to the receiving of evidence by an Opposition Division or a Board of Appeal; the wording of Art. 117(1) makes it clear that the phrase “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”. This interpretation has been repeatedly confirmed in the Board of Appeal case law (see **T 101/87**, **T 416/87**, **T 323/89** (OJ 1992, 169), **T 596/89**).

7.3 Facts which justify apportionment of the costs

7.3.1 Abuse of procedure

In decision **T 167/84** (OJ 1987, 369) the Board considered that apportionment of costs should take place, because the oral proceedings were held at the request of the appellant, not at the request of the respondent, and the appellant failed to succeed on any point. Furthermore no new point was introduced at the oral proceedings by the appellant and the case could have been decided without oral proceedings, added to which the respondent’s representative had to travel a considerable distance to attend the oral proceedings.

However, this view was not shared in several decisions which stated that parties have an **absolute right to oral proceedings** even if they have no new point to introduce (see **T 303/86**, **T 383/87**, **T 305/86**, **T 125/89**, and also VI.A. 2.1).

In decision **T 461/88** (OJ 1993, 295) the Board decided that the appellant’s insistence on hearing witnesses was clearly compatible with the principle of 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.

According to decision **T 79/88**, the wording of Art. 116(1) makes it clear that it is a genuine right of any party to request oral proceedings if it considers them to be necessary. Nor does the fact that one of the parties has to travel a longer distance than the other 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.

In decision **T 614/89** it was pointed out that the right of a party to have its case discussed in oral proceedings was subject to no restrictions. In trying for as long as possible to sway the Board in its favour, it was not breaching the rules of proper procedure, nor did its behaviour amount to an abuse of the law.

In **T 318/91** the Board upheld a previous decision to the effect that an appeal's chances of success, even if slender, could not be a reason for ordering a different apportionment of costs.

7.3.2 Late submissions

Despite decision **G 10/91** the case law concerning the belated submission of facts and evidence remains relevant because although **G 10/91** imposes a limitation on the late submission of a new ground for opposition, it does not refer to belated submission of facts and evidence for grounds on which the opposition was originally based.

A reapportionment of costs was ordered in those cases where documents or requests were filed late – unless there were good reasons for the delay – as it was assumed that higher costs had been incurred as a result. Whether or not the documents were relevant to the decision on the merits was considered to be immaterial. These were the only circumstances in which reapportionment of costs was ordered (see **T 10/82**, **T 117/86**, **T 101/87**, **T 326/87**, **T 416/87**, **T 323/89**, **T 596/89**, **T 622/89**, **T 611/90**, **T 755/90**, **T 110/91**).

In decision **T 117/86** (OJ 1989, 401) the Board also dealt with the question of opposition costs attributable to documents being filed late. 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 are 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 for reasons of equity. The Board accordingly decided, within the limits set by R. 63(1), to order an apportionment of costs on the following terms: the appellants to pay the respondents fifty per cent of the costs incurred by the respondents' representative for the preparation and filing of the reply to the appeal.

In decision **T 416/87** (OJ 1990, 415) Board of Appeal 3.3.1 clarified its case law with regard to the apportionment of the costs of opposition proceedings, established in particular by earlier decision **T 117/86**. The fact that the appellant relied in the statement of grounds of appeal on three new documents exclusively, and for the first time even raises the issue of novelty on the basis of a document already discussed in the patent in suit, was regarded by the Board as an abuse of the opposition procedure. By introducing arguments and documents which bear little relation to those filed in the original opposition, the appellant has 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. As provided in R. 63(1), such costs include the remuneration of the representatives of the parties.

In decision **T 326/87** (OJ 1992, 522) the Board elaborated on earlier rulings concerning the apportionment of costs in opposition proceedings and added, “ The degree of apportionment must depend on the circumstances of each case, but where a document successfully introduced at a late stage is of such relevance that the Board decides to remit the case to the 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.” This decision was confirmed by **T 611/90** (OJ 1993, 50).

In **T 323/89** (OJ 1992, 169) the appellants first drew attention to additional prior art in their statement of grounds for appeal. The Board considered that the introduction of this new prior art more than two years after expiry of the opposition period meant that the respondents and patent proprietors once again had to devote time and energy to countering objections which the appellants could easily have advanced within the opposition period. This put the patent proprietor to extra expense because commenting on submissions made within a short span of time during the opposition period is less costly than having to consider the material sporadically over a number of years. The appellants could easily have come forward with the above-mentioned prior art during the opposition period – their own prior use, after all, being at issue. Nor have the appellants explained why the new state of the art was only cited so late in the day. The Board ordered that the appellants meet part of the additional costs incurred by the respondents.

In **T 297/86** the Board refused to apportion costs, saying that “the Board sees no reason for charging costs of one party to the other party in the present case, since (the late-filed document) was considered ... by the Board pursuant to Art. 114(1), and the late citation ... cannot be considered as an abuse of the appeal proceedings and since costs incurred during taking of evidence or in oral proceedings are not existent.”

In decision **T 212/88** (OJ 1992, 28) the Board refused an apportionment of costs because it was not satisfied that costs in relation to the opposition and the appeal proceedings as a whole would necessarily have been avoided or reduced, if the documents had been submitted in time.

7.4 Costs to be apportioned

In **T 167/84**, **T 117/86** and **T 416/87** cited above the Boards confirmed that representatives’ costs could be apportioned. In **T 326/87** the Board decided that all costs caused by remittal to the first instance should be apportioned.

In **T 323/89** and **T 416/87** it was **assumed** that costs had arisen.

7.5 Procedural requirements

In decision **T 212/88** cited above, the Board ruled that 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 decision **T 193/87** (OJ 1993, 207) the Board refused the apportionment of costs because "...the Board cannot see in the present case reasons of equity which could justify such an apportionment of the costs, nor has the respondent brought forward any evidence in this respect...". Also, in many other unpublished decisions the Boards insisted on the submission of evidence (e.g. **T 193/87**, **T 49/86**, **T 404/89**, **T 523/89**, **T 705/90**, **T 776/90**).

In **T 934/91** the Board made it clear that, under Art. 111(1), a Board of Appeal, when considering a request for the apportionment of costs, was empowered to specify the amount of costs to be paid, having regard to Art. 104(2).

7.6 Article 106(4) EPC

In **T 154/90** (OJ 1993, 505) the Board considered Art. 106(4). The decision was based on the following facts. The request of the appellant (opponent) for revocation of the patent was inadmissible due to inadequate substantiation. However, the appellant also requested that the first-instance decision, according to which he was liable for the costs of the oral proceedings he had not attended, be set aside. The opponent had withdrawn his request for oral proceedings in a letter which reached the EPO eight days prior to the date of the oral proceedings, but did not reach the Opposition Division until after its decision had been given. The Board came to the conclusion that, if an appeal relating to the revocation of a patent is rejected as inadmissible and there is no other admissible request, an appeal relating to apportionment of costs is normally inadmissible under Art. 106(4) because it would then be the sole subject of the appeal. However, if the impugned decision did not take into account the withdrawal of a request for oral proceedings and was therefore based on a substantial procedural violation, that part of the impugned decision relating to apportionment of costs must be set aside.

E. Appeal procedure

1. Introduction

The appeals procedure is laid down separately in Arts. 106 to 111 and R. 64 to 67 and in the Rules of Procedure of the Boards of Appeal. R. 66(1) plays an important role since it stipulates that, unless otherwise provided, the provisions relating to proceedings before the department which has made the decision from which the appeal is brought are applicable to appeal proceedings *mutatis mutandis*. Such analogous application is, however, not permissible automatically in every case and for every provision. 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. The Enlarged Board of Appeal, in particular, has emphasised certain features of that procedure over a period of time. It has been established that it is judicial in nature (**G 1/86**, OJ 1987, 447). Decisions **G 7/91** (OJ 1993, 356) and **G 8/91** (OJ 1993, 346) refer to the procedure which is proper to an administrative court (see also **G 9/91**, OJ 1993, 408 and **G 10/91**, OJ 1993, 420). The purpose of the appeals procedure is to review the decisions of the first instance.

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 developed by the Enlarged Board of Appeal that the general principles of court procedure, such as, for example, the principle that parties may direct the course of the proceedings themselves ("the principle of party disposition"), also apply in appeal proceedings (see **G 2/91**, OJ 1992, 206 and **G 8/91**), and that a review of the decision of 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**). The individual procedural consequences and the decisions of the Enlarged Board of Appeal are dealt with in greater detail below.

2. The language of proceedings in appeal proceedings

The same arrangements for languages apply to appeal proceedings as to all other proceedings before the EPO. Under R. 1(1) any party may use any official language in written proceedings (for the legal position prior to the deletion of R. 3 see **T 379/89** and **T 232/85**, OJ 1986, 19) and, under R. 2(1), any party to oral proceedings before the EPO may, in lieu of the language of the proceedings, use one of the other official languages of the EPO, on condition that such party either gives notice to the EPO at least one month before the date laid down for such oral proceedings or makes provision for interpreting into the language of the proceedings.

In **T 34/90** (OJ 1992, 454) the respondent neither gave the required notice as mentioned above nor made provision for interpreting. The respondent's representative submitted that because he had lawfully used an alternative official language in the oral proceedings before the Opposition Division, he should be allowed to use the same language in the hearing before the Board. Although not stated by him in clear terms, this submission plainly implied that the appeal proceedings were no more than a continuation of the first instance – in this case the opposition proceedings. The Board reiterated the principle that appeal proceedings were definitely not and had never been intended to be the mere continuation of first-instance proceedings. Rather, their function was to give a judicial decision upon the correctness of a separate earlier decision given by the first-instance department. It followed that, for the purpose of deciding the permissibility of the use of an alternative official language under R. 2(1), as well as for other procedural purposes, appeal proceedings were wholly separate and independent from first instance proceedings. Notice therefore had to be given again.

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 that all parties to the proceedings had given their agreement.

3. The position in terms of procedural law of parties to the appeal proceedings

3.1 General remarks

According to Art. 107 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. For opposition proceedings, Art. 99(4) provides that opponents as well as the proprietor of the patent are parties to the opposition proceedings. In addition,

Art. 105 provides for the possibility of intervention by the assumed infringer. For other proceedings, the general principle applies that those whose legal interests are affected by the decision are parties to the proceedings. (See, for example, **T 811/90**, where opposition proceedings had been concluded and the time limit for lodging an appeal had expired. Only the patent proprietor lodged an appeal, but this was against a separate decision on a point incidental to the opposition. It was held that the party had no right to be a party to the appeal as he had not been a party to the decision.) Third parties, who in accordance with Art. 115 present observations concerning the patentability of the invention in respect of which the application has been filed, are not parties to proceedings before the EPO.

3.2 Intervention

In this connection the question arose up to what stage in the proceedings **intervention** was still possible and what rights the parties to appeal proceedings enjoyed.

The first question was decided with regard to opposition proceedings by the Enlarged Board of Appeal in **G 4/91** (OJ 1993, 339) as follows: intervention after a decision has been issued in opposition proceedings but during the period for appeal is invalidated if none of the parties has filed an appeal (see VI.D. 2.2). It remains unresolved whether intervention is permissible **during** appeal proceedings or during the period for appeal, when an appeal has been filed, since according to its wording, Art. 105 applies to opposition proceedings. It will now have to be decided whether it also applies to opposition appeal proceedings. This question was referred to the Enlarged Board of Appeal in **T 27/92** with reference to **T 390/90**. It is pending under reference number **G 6/93**.

3.3 Parties to proceedings in accordance with Art. 107 EPC

As far as the rights of parties to appeal proceedings are concerned, the case law recognises the right of all parties to be heard (see **J 20/85**, **J 3/90**, **T 18/81**, **T 94/84**, **T 716/89**), albeit within the limits of expediency (see **T 295/87**, OJ 1990, 470). The parties also have a right to oral proceedings VI.A. 2 and 3.)

Furthermore **G 1/86** (OJ 1987, 447) recognised the validity of the principle that all parties to proceedings must be treated equally in similar legal situations in proceedings before the EPO 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. This right was not dependent on whether or not the parties had personally filed an appeal. The withdrawal of an appeal by the appellant did not immediately halt the proceedings. If there was already one valid appeal, no further appeals were needed and the fees paid for appeals filed later had to be reimbursed.

In its decision **G 2/91** (OJ 1992, 206) the Enlarged Board of Appeal did not go along with this interpretation of the principle of equal treatment. It was of the opinion that, from the legal point of view, the status of parties who had filed an appeal could not be compared with the status of the other parties. 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, only guaranteed parties to the first-instance proceedings, who had not filed an appeal, that they were parties to the **existing** appeal proceedings. A person who was entitled to appeal but did not do so and instead confined himself to being a party to the appeal proceedings “automatically”

had no independent right of his own to continue appeal proceedings if the appellant withdrew his appeal. He acquired this right only by filing an appeal himself and paying the associated appeal fee. For this reason, there was also no ground for reimbursing the fee for any appeals filed after the first, unless the requirements of R. 67 were met.

3.4 Revision of decisions to the detriment of the appellant – “reformatio in peius”

In **G 2/91** the question arose whether certain limits applied to a party to proceedings who had not filed an appeal himself, when it came to filing his own requests in appeal proceedings, particularly whether he had the right to contradict the appellant’s requests in his own. The Enlarged Board of Appeal, however, refrained from deciding this question.

This same question then arose in another connection in cases **G 9/92** and **G 4/93**, which are still pending before the Enlarged Board. In both cases the question referred is whether the Board of Appeal may revise the contested decision to the detriment of the appellant and, if so, to what extent. Case **G 9/92** is based on the Board’s referral in cases **T 60/91** and **T 96/92** (OJ 1993, 551), which had been consolidated as far as this point is concerned. In both cases the Opposition Division had maintained the patent as amended on the basis of a subsidiary request. In **T 60/91** the patent proprietor had filed an appeal with the request that the patent be maintained in the version according to the main request filed during opposition proceedings. The opponent and respondent had requested the revocation of the patent. In **T 96/92** the opponent had filed an appeal with the request that the patent be revoked. The patent proprietor and respondent had filed a request that the patent be maintained in the original version. In neither case had the respondents filed their own appeal. Because of its fundamental importance and the different decisions of the Boards of Appeal the question was referred to the Enlarged Board (see **T 369/91** (OJ 1993, 561) in which, on the basis of **G 2/91**, the restriction on the filing of requests by parties who had not filed an appeal themselves was approved, and **T 576/89** (OJ 1993, 543), in which such a restriction was rejected). Case **T 96/92** has in the meantime been referred back to the responsible Board since, before the Board of Appeal, the respondent withdrew the request which had given rise to the referral. Case **G 9/92** continues on the basis of the referral in **T 60/91**. Case **G 4/93** is based on the referral in **T 488/91**, which in turn is founded on the same arguments as **T 96/92** except that, in the former case, the patent proprietor and respondent had requested that the patent be maintained in the version according to the main request filed during opposition proceedings, whose scope was narrower than that of the version originally granted by the Examining Division.

3.5 Extent to which the patent is contested

In **G 9/91** (see VI.D. 1.) the Enlarged Board of Appeal considered whether, on appeal, the Board should be restricted to examining the contested subject-matter and decided that any part of a patent’s subject-matter which is not opposed within the nine-month time limit, e.g. individual claims, could not be the subject-matter of either opposition or appeal proceedings. The opponent’s statement under R. 55(c) establishes the extent to which the patent is contested and thus the formal competence of the Opposition Division or Board of Appeal.

3.6 Change in the grounds for opposition

A related and yet independent question is which grounds for opposition the Board of Appeal may examine. The Enlarged Board established in **G 10/91** (see VI.D. 1.) that only grounds for opposition already introduced at the opposition stage may be considered on appeal. Fresh grounds for opposition may only be introduced on appeal with the **consent** of the patent proprietor, whose power of veto applies regardless of the degree of relevance of the fresh grounds.

3.7 Reasons for the decision of the department of first instance and extent of powers to review

T 396/89 also concerned the extent of the Board of Appeal's powers to review decisions. In this case the Opposition Division had revoked the patent. In its decision it found that Claims 1 to 5 were novel but Claim 6 was not. The remaining Claims 7 to 24 had not been examined. The patent proprietor lodged an appeal requesting that the patent be granted in the version examined by the Opposition Division or, alternatively, without Claim 6. The opponents, who had not filed an appeal themselves, argued against the Opposition Division's decision and challenged the novelty of Claims 1 to 5. The patent proprietor was of the opinion that this finding could not be reviewed since the respondents had not filed an appeal themselves. The Board took the view that it was not bound by the findings of the Opposition Division since, in the appeal, the whole case, including the parts relating to Claims 1 to 5, had to be considered.

4. Termination of appeal proceedings

Under the EPC it is possible to withdraw a patent application, opposition and appeal. The consequences of such withdrawal for pending appeal proceedings are considered below. This problem is closely linked with the questions discussed above.

4.1 Withdrawal of an appeal

In decisions **G 7/91** and **G 8/91** (OJ 1993, 346 and 356) the Enlarged Board of Appeal found that, insofar as the **substantive issues** settled by the contested decision at first instance were concerned, appeal proceedings are **terminated**, in ex parte and inter partes proceedings alike, when the sole appellant withdraws the appeal.

This confirmed previous established practice in accordance with which the Board of Appeal simply noted the withdrawal of the appeal and the parties merely received a communication from the Registry to the effect that the appeal proceedings were thus terminated. The application by analogy of R. 60(2), second sentence (which applies to opposition proceedings), to appeal proceedings was considered by the Boards in their decisions **T 357/89** (OJ 1993, 146) and **T 695/89** (OJ 1993, 152), which referred the question to the Enlarged Board. The latter rejected the analogy, holding that the fact that the two procedures were of a different legal nature spoke against application by analogy: the appeal procedure is that proper to an administrative court, so that any exception from general procedural principles, such as the "principle of party disposition", would have to be supported by much weightier grounds than in administrative proceedings. Furthermore, R. 60(2), second sentence, had to be viewed in the special

context of the EPC's post-grant opposition procedure and therefore was not capable of analogy. Neither Art. 114(1) nor the interests of the general public or the respondent spoke against this interpretation. Art. 114(1) was restricted to the examination of the facts. Moreover, the withdrawal of an appeal did not come under the category of "relief sought", within the meaning of Art. 114(1), second part of the sentence, but constituted a procedural act not requiring the consent of the relevant Board of Appeal. The interests of the general public were primarily safeguarded by the opposition system. It therefore had to be assumed that the patent did not disturb those who had not filed an opposition. Consequently, it was not necessary to continue the appeal proceedings in order to safeguard the interests of those who had filed no opposition at all. Nor were the respondents' interests any more worthy of protection if they had not themselves filed an appeal, as was explained in detail in **G 2/91** (see also VI.E. 3.3). Finally, the Enlarged Board of Appeal pointed out that when the sole opponent withdrew his appeal, the suspensive effect of the appeal lapsed and the decision of the Opposition Division accordingly became final insofar as the **substantive issue** was concerned.

After the withdrawal of an appeal it is still permissible to decide on ancillary questions (**T 85/84**). Thus, in decisions **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 the withdrawal of the appeal and in **T 117/86** (OJ 1989, 401), **T 323/89** (OJ 1992, 169) and **T 614/89** with requests for apportionment of costs.

4.2 Withdrawal of the opposition during the appeal procedure

The effects of withdrawing an opposition during the appeal proceedings vary according to whether the opponent in the appeal proceedings is the appellant or the respondent.

If the opponent is the appellant, his statement withdrawing the opposition is considered under established case law as a withdrawal of the appeal and the proceedings are terminated (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 the withdrawal of the opposition are irrelevant (see **T 381/89**). Decision **T 544/89**, however, allowed continuation of the appeal proceedings by the EPO of its own motion in cases where the patent could be revoked or limited. In this context decision **T 148/89** referred the following question to the Enlarged Board: "Are appeal proceedings ended when the sole appellant and opponent withdraws his opposition and the patent proprietor requests the termination of the proceedings, even when the Board of Appeal is of the opinion that the patent as granted does not satisfy the requirements of the EPC?" The case is pending under reference number **G 8/93**.

If, however, the opponent is the respondent, the withdrawal of the opposition has, under established case law, no influence on the appeals procedure (see **T 135/86**, **T 272/86**, **T 362/86**, **T 373/87**, **T 377/88**, **T 419/88**, **T 149/89**, **T 697/89**, **T 194/90**, **T 358/90**, **T 548/90**, **T 629/90** (OJ 1992, 654), **T 138/91**, **T 247/91** and **T 627/92**). However, according to **T 789/89**, the withdrawal of an opposition by the respondent results in the respondent's ceasing to be a party to the appeal proceedings as far as the substantive issues are concerned. He remains a party to the proceedings only in respect of the question of apportionment of costs.

4.3 Request for the revocation of a patent

If the opponent is the appellant and the patent proprietor intimates that he is no longer interested in maintaining the patent, according to established case law the appeal proceedings are terminated by a decision ordering the revocation of the patent without going into the substantive problems. This is supported by Art. 113(2), according to which the patent may only be maintained in a version approved by the patent proprietor. If there is no such version, one of the substantive requirements for maintaining the patent is lacking. It is irrelevant whether the patent proprietor expressly requests revocation of the patent. The wording of his statement is to be interpreted according to its meaning. Even a statement requesting – incorrectly at this stage in the proceedings – withdrawal of the application (instead of revocation of the patent) is interpreted as a request for revocation and thus as cancellation of the version approved under Art. 113(2). The same applies to a statement surrendering the patent vis-à-vis the national patent offices (see **T 73/84** (OJ 1985, 241), **T 186/84** (OJ 1986, 79), **T 230/84**, **T 264/84**, **T 157/85**, **T 237/86** (OJ 1988, 261), **T 251/86**, **T 415/87**, **T 459/88** (OJ 1990, 425), **T 92/88**, **T 68/90**, **T 677/90**, **T 308/91**, **T 370/91**, **T 936/91**).

In **T 347/90** the **patent proprietor** was the **appellant** (see also VI.A. 10.). He gave notice during the appeal proceedings that he was withdrawing his application. Here too the Board interpreted his statement as a request for the revocation of the patent, rejected the appeal without going into the substantive issues, and thus confirmed the revocation of the patent by the department of first instance.

4.4 Patent expired in all designated States

In **T 329/88** the Board of Appeal applied R. 60(1) by analogy to appeal proceedings and terminated the proceedings without any decision on the issues, since the European patent had expired during the appeal proceedings in all the designated Contracting States. The opponent/appellant had not requested continuation of the appeal proceedings. It is to be noted here that the termination of proceedings has no repercussions corresponding to revocation under Art. 68. Rather it is based on the fact that the patent has already – ex nunc – expired with effect in each of the designated Contracting States.

5. Binding effect of Board of Appeal decisions

Under Art. 111(2) 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.

In decision **T 79/89** (OJ 1992, 283) it was stated that if a Board of Appeal has issued a decision rejecting certain claimed subject-matter as not allowable and has remitted the case for further prosecution in accordance with an auxiliary request, the legal effect of Art. 111(2) is that examination of the allowability of the rejected claimed subject-matter cannot thereafter be reopened, either by the Examining Division during its further prosecution of the case, or by the Board of Appeal in any subsequent appeal proceedings (see **T 21/89**).

In decision **T 757/91** the Board confirmed this principle. 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, in particular, **T 113/92**).

In **T 934/91** the Board stated in relation to the meaning of “*ratio decidendi*” used in Article 111(2) that it is well accepted that the *ratio decidendi* of a decision is the ground or the reason for making it, in other words, the point in a case which determines the outcome of the judgment, the Board approving a dictionary definition. The Board also held that the doctrine of “*res judicata*” applied in the circumstances of the case and approved for this purpose a dictionary definition of “*res judicata*” as 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.

6. Remittal to the department of first instance

Under Art. 111(1) the Board of Appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed. Criteria for the exercise of this discretion have been developed by the Boards as follows:

If a document is relied upon for the first time during the appeal proceedings and it is admitted because it is relevant, the case is normally to be remitted to the department of first instance (see for example **T 28/81**, **T 147/84**, **T 258/84** (OJ 1987, 119), **T 273/84** (OJ 1986, 346), **T 170/86**, **T 198/87**, **T 205/87**, **T 215/88**, **T 611/90** (OJ 1993, 50).

If there is no excuse for the late introduction of the document, but the outcome of the appeal is nevertheless unfavourable to the party who introduced it, then remittal is not ordered, as the loss of one instance of examination is not unfair in such a case (see **T 416/87**, OJ 1990, 415 and **T 626/88**).

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 first instance had 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 392/89**, **T 5/89** (OJ 1992, 348) and **T 137/90**).

In decision **T 274/88** the Board of Appeal held that if an irregularity has been remedied during appeal proceedings, the matter should normally be remitted to the department of first instance. In the case in point (*ex parte* proceedings), however, the Board did not remit the matter because the subject-matter of the application after the correction was patentable, the appellants had expressly waived their right to two instances, and the Examining Division had already indicated that it was of a positive opinion on the question of patentability.

If a request is filed during the appeal proceedings with amended claims, then the case is remitted if the amendments are substantial and require further substantive examination (see **T 63/86**, OJ 1988, 224, **T 200/86**, **T 296/86**, **T 98/88**, **T 423/88**, **T 501/88** and **T 47/90**, OJ 1991, 486).

In **T 125/91** the Opposition Division had disregarded one of the opponents' right to be heard. Because of this substantial procedural violation the Board ordered the remittal to the first instance, effective as regards both opponents since the case could not be divided.

7. Interlocutory revision

Under Art. 109(1) in ex parte proceedings the department whose decision is contested shall rectify its decision if it considers the appeal to be admissible and well founded.

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 is to be considered well founded within the meaning of Art. 109(1) if the main request of the appeal includes amendments which clearly meet the objections on which the refusal of the application was 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 **T 690/90** and **T 47/90**, OJ 1991, 486).

In **T 473/91** (OJ 1993, 630) the Board made it clear that interlocutory revision is only possible if the contentious issue can be settled immediately on the basis of the appeal submissions themselves. The jurisdiction of the department of first instance does not extend to a request for re-establishment of, rights in respect of a time limit relating to the appeal itself.

8. Admissibility of the appeal

8.1 Appealable decision

Under Art. 106(1), first sentence, an appeal lies against **decisions** of the departments of the EPO listed in that Article.

In **J 13/83** the Board made clear that a communication referred to in R. 69(1) is not an appealable decision. In **T 5/81** (OJ 1982, 249) the Board confirmed that an appeal may relate only to a decision subject to appeal within the meaning of Art. 106(1) and not to the preparatory measures referred to in Art. 96(2) and R. 51(3). The Enlarged Board of Appeal stated in decision **G 5/91** (OJ 1992, 617) that there is no legal basis under the EPC for any separate appeal against an order of a director of a department of the first instance such as an Opposition Division rejecting an objection to a member of the division on the ground of suspected partiality. However, the composition of the Opposition Division may be challenged on such a ground of appeal in an appeal against the final decision of the division or against an interlocutory decision under Art. 106(3) allowing separate appeal.

Whether a document constitutes a decision or a communication depends on the substance of its contents, not upon its form (**J 8/81**, OJ 1982, 10). In **T 934/91** (see Case Law Report 1992, p. 82) the Board stated that a "decision" does need to involve a reasoned choice between legally viable alternatives.

Under Art. 106(3) 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 separate appeal.

A separate appeal is admissible against interlocutory decisions regarding the admissibility of the opposition (e.g. **T 10/82**, OJ 1983, 407) and against interlocutory decisions regarding the maintenance of a patent in amended form (see e.g. **T 247/85** and **T 89/90** (OJ 1992, 456) and also VI.D. 6.2).

8.2 Board having competence to hear a case

The responsibilities and the necessary composition of the Boards are set out in Art. 21. In **G 2/90** (OJ 1992, 10) the Enlarged Board of Appeal made it clear that under Art. 21(3)(c), the Legal Board of Appeal has competence only to hear appeals against decisions taken by an Examining Division consisting of fewer than four members, provided also the decision does not concern the refusal of a European patent application or the grant of a European patent. In all other cases, i.e. those covered by Art. 21(3)(a), (3)(b) and (4), it is the Technical Board of Appeal that has competence. The provisions relating to responsibilities and composition in Art. 21(3) and (4) are not affected by R. 9(3).

8.3 Entitlement to appeal

8.3.1 Entitlement to appeal – formal aspect

In **T 563/89** the opponent company had been sold to another company prior to the appeal proceedings which had been filed by the latter company as successor in title to the opponent company. The Board referred to **G 4/88** (OJ 1989, 480) (see also VI.D. 2.3) and held that the right to lodge an appeal had been transferred together with the company. The appeal was admissible.

In **J 1/92** the appeal was rejected as inadmissible since it had been filed in the name of the representative instead of the party adversely affected by the decision impugned.

8.3.2 Party adversely affected

Under Art. 107 any party to proceedings adversely affected by a decision may appeal.

a. A party is adversely affected if the decision fails to meet that party's (main) requests. In order to establish that a party has been adversely affected it is necessary both to compare that party's objective with the substance of the decision, and to check that the party was so affected at the time when the contested decision was delivered and the appeal filed (see **T 244/85**, OJ 1988, 216).

Thus, in **J 12/83** (OJ 1985, 6), the Board stated that an applicant for a European patent may be "adversely affected" within the meaning of Art. 107 by a decision to grant the patent, if it is granted with a text not approved by the applicant in accordance with Art. 97(2)(a) and R. 51(4). In **J 12/85** (OJ 1986, 155) the Board held that an applicant for a European patent may only be "adversely affected" within the meaning of Art. 107 by a decision to grant the patent if such a decision is inconsistent with what he has specifically requested (see **T 114/82**, **T 115/82** (both in OJ 1983, 323) and **T 1/92**).

In decision **T 234/86** (OJ 1989, 79) the Board made it clear that the patent proprietor is adversely affected by the rejection of a request or requests preceding an auxiliary request which is allowed (see **T 392/91** and **T 793/91**).

In decision **T 73/88** (OJ 1992, 557) mentioned above, the Board made it clear that if a patentee's request in opposition proceedings for the maintenance of the patent is upheld by the decision of the Opposition Division, he may not file an appeal against

reasoning in the decision which was adverse to him (here, his claim to priority), because he is not adversely affected by the decision within the meaning of Art. 107.

b. A party is not adversely affected if he agrees with the decision. The way in which R. 58(4) was applied by the EPO department of first instance (see Guidelines of March 1985, D-VI, 6.2.1) and also in many appeal proceedings led to a referral to the Enlarged Board of Appeal in **T 271/85** (OJ 1988, 341). In appeal proceedings, for example, a Board held that silence in respect of a communication within the meaning of R. 58(4) is to be interpreted as a sign of agreement with the maintenance of the patent in the proposed form (see in particular **T 244/85**, where the Board stated that an appeal by an opponent who has not notified his disapproval of the maintenance of the patent in the amended form within the period of one month laid down in R. 58(4) is inadmissible because he cannot 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), 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 answer given by the Enlarged Board of Appeal in decision **G 1/88** (OJ 1989, 189) was that the fact that an opponent has failed, within the time allowed, to make any observations on the text in which it is intended to maintain the European patent after being invited to do so under R. 58(4) does not render his appeal inadmissible. This conclusion was based inter alia on the following reasoning:

"The ambiguous wording of R. 58(4) would at first sight, then, seem to indicate that the text of R. 58(4) cannot be construed as meaning that the opponent is required to state his objections. 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 cannot, however, be simply presumed: A jure nemo recedere praesumitur. Deeming silence to be equivalent to surrender would also be inconsistent with the logic of how the Convention operates, since it would be at odds with its basic drafting philosophy and with the way in which it deals with losses of rights.

Where the legal consequence of an omission is to be a loss of rights, this is expressly stated – in line with the Convention's general drafting philosophy. There are numerous examples of cases where loss of rights is based on an assumption. To impose a loss of rights as a penalty for an opponent's silence in connection with R. 58(4) is also scarcely compatible with the logic of the Convention.

It also has to be remembered that under Art. 164(2) the Implementing Regulations must always be interpreted in the light of the Convention. Consequently, the interpretation of the Implementing Regulations which corresponds most closely to the principles of the Convention prevails. It is a principle of the Convention, however, that parties' rights are safeguarded by the possibility of appeal to at least one higher-ranking tribunal. In some Contracting States this principle is even constitutionally guaranteed. The Implementing Regulations should therefore be construed in such a way that R. 58(4) is not allowed to interfere with the right of appeal under Art. 106 and 107.

The teleological interpretation, that is to say interpretation in the light of the sense and purpose of the procedure under R. 58(4), leads to the same goal. It enables possible rulings on the specific point of law to be tested against the overall context of the Convention. ...

From the literal wording of R. 58(4), its interpretation by reference to the general logic of the Convention and application of the principle that the Implementing Regulations

must be construed in the light of the Convention, the Enlarged Board of Appeal therefore concludes that the question referred to it must be answered in the affirmative."

In **T 457/89**, following the reasoning in **G 1/88**, the Board confirmed that an appeal by a party to opposition proceedings is not rendered inadmissible because the party had not responded within the time limit to the Opposition Division's invitation to file observations in accordance with Art. 101(2).

In **T 831/90**, the appellants submitted two new claims in writing after the communication under R. 51(6) had been issued. The Examining Division did not take these new claims into consideration. The Board held that the appellant was not adversely affected by this decision, as he had already expressed his approval of the wording of the patent.

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 lodged an appeal against the interlocutory decision, which maintained the patent so amended, arguing that the circumstances had changed and he was no longer bound by his consent. The appeal was dismissed as inadmissible.

In **T 299/89**, the Board examined the extent of entitlement to appeal of an opponent who, in his opposition, requested only partial revocation of the patent, but in the appeal requested revocation of the entire patent. It decided that the entitlement to appeal is determined by the scope of the original request made in the opposition. The opponent is only adversely affected within the meaning of Art. 107 to the extent that this request is not granted and he cannot on appeal file a wider request.

In **T 273/90**, the Board came to the conclusion that legal uncertainty arising from an inadequate adaptation of the description to amended claims represents sufficient grievance under Art. 107, as the commercial interests of the appellant could be adversely affected.

In **T 793/91**, the Board found the applicants to be adversely affected by the rejection of their application even if the amendments requested in appeal proceedings could already have been made during proceedings before the Examining Division.

8.4 Form and time limit of appeal

Under Art. 108, notice of appeal must be filed in writing within two months after the date of notification of the decision appealed from. Under R. 64(a) the notice of appeal shall contain the name and address of the appellant and under R. 64(b) a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested.

8.4.1 Appeal filed within the time limit

In **T 389/86** (OJ 1988, 87) the Board stated that an appeal which is filed after pronouncement of a decision in oral proceedings but before notification of the decision duly substantiated in writing complies with the time limit pursuant to Art. 108, first sentence. For a discussion on time limits in general see VI.A. 4.

8.4.2 Form and content of appeal

a. Rule 64(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.

b. Rule 64(b) EPC

If the extent to which cancellation of the decision is requested is not expressly stated in the notice of appeal, then the Board checks whether this extent can be determined from the totality of what the appellant has put forward (see **T 32/81**, OJ 1982, 225, and **T 7/81**, OJ 1983, 98).

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, 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 to be the same as that of the original opposition, from the fact that the appeal had been filed at all, taking into account the proceedings before and the decision of the first instance (see also **T 1/88**).

Merely paying the fee for appeal does not constitute a valid means of lodging an appeal. This applies even if the object of the payment is indicated as being a "fee for appeal" relating to an identified patent application and the form for payment of fees and costs is used (**J 19/90**).

8.5 Statement of grounds of appeal

A statement setting out the grounds of appeal must be filed in accordance with Art. 108, second sentence.

8.5.1. General principles

In two decisions the Boards of Appeal established the principles applicable to statements of grounds. In decision **T 220/83** (OJ 1986, 249) the Board stated that grounds for appeal should state the legal or factual reasons why the decision should be set aside. The appellant must state his arguments sufficiently clearly and precisely so that the Board and the other party or parties can immediately understand why the decision is alleged to be incorrect, and on what facts the appellant bases his arguments, without first having to make investigations of their own.

Any passages in literature showing the state of the art, to which passages sufficiently precise reference is made in the grounds of appeal, may be considered as much part of the grounds as though contained in them, but they cannot 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**.

In connection with these decisions, in **T 213/85** (OJ 1987, 482) the Board stated that grounds sufficient for the admissibility of an appeal must be analysed in detail vis-à-vis the main reasons given for the contested decision. If an opposition has been dis-

missed on the grounds of insufficient substantiation and the grounds for appeal merely dispute patentability without elaborating on the admissibility of the opposition, the appeal is inadmissible for lack of adequate substantiation (see also **T 169/89**)

In the following decisions an exception to these principles was made. In **J 22/86** (OJ 1987, 280) the Board made it clear that exceptionally, where the written statement does not contain such full reasons, the requirement for admissibility may be regarded as satisfied if it is immediately apparent upon reading the decision under appeal and the written statement that the decision should be set aside.

In case **T 1/88** the Board considered a statement of the grounds of appeal as being sufficient in accordance with the criteria of decisions **T 220/83** and **T 213/85**, where it was argued that there had not been "appropriate evaluation" of document (e) and it was sought to prove from certain passages in (e) that the process of the patent in suit was obvious.

Some decisions have considered as adequate a statement of grounds which, though not dealing with the reasoning of the decision under appeal, had attacked that decision on other grounds. In **J 20/86** and **J ..87** (OJ 1988, 323) the Board stated that an appeal is to be considered sufficiently well-founded to satisfy the requirements of Art. 108, third sentence, if it refers to a new circumstance which, if confirmed, will invalidate the contested decision.

In case **T 611/90** (OJ 1993, 50) the statement of grounds developed an entirely fresh case on lack of novelty. The Board considered the appeal to be admissible because the fresh reasons presented, though unconnected with those in the decision under appeal, were still within the same opposition **ground** (see also **T 525/88**).

8.5.2 Change of circumstances after delivery of the decision

The above principles cannot be applied in cases where the facts have changed after the decision was reached, so that the decision is based on grounds which can no longer apply.

In **T 105/87** the Board was of the opinion that there is nothing in the wording of the provisions of the EPC to support the idea that the task of a Board of Appeal should be strictly limited to considering whether or not the decision of the first instance is correct only on the basis of facts and arguments presented before the first instance. Instead, an appeal can be based on the ground that though the correctness of the decision of the first instance is not questioned, subsequently amended claims have been submitted which are not consistent with the reasoning of the decision.

In **T 459/88** (OJ 1990, 425) the Board expressly stated that the case law on statements of grounds is not applicable where the circumstances change after the department of first instance has given its decision as exemplified in decision **T 105/87**. These principles are also valid where the change involved is a request by the patent proprietors after the decision of the Opposition Division was taken that their patent be revoked.

In **J 2/87** (OJ 1988, 330) and **T 195/90** the Board took the view that the minimal requirements of Art. 108 were satisfied when the notice of appeal could be interpreted as containing a request for rectification of the decision concerned on the grounds that, due to the fact that the conditions set forth in a former communication from the EPO

were now fulfilled, the decision was no longer justified. The circumstances must, however, already have changed by the time the statement of the grounds of appeal is filed. In the opinion of the Board in **T 22/88** (OJ 1993, 143), a written statement announcing only that the appellant will complete an omitted act does not comprise sufficient reasons, and therefore does not constitute a valid statement of the grounds of appeal. According to **T 387/88** it is sufficient to state that the act, the omission of which formed the basis of the decision, has now been completed.

8.5.3 Reference to an earlier submission

The Boards are often faced with the question of whether a statement of grounds which refers to submissions made in the first instance proceedings is sufficient. In principle, a statement of grounds which merely refers generally to previous submissions is not considered sufficient (see **T 254/88**, **T 432/88**, **T 90/90**, **T 154/90**, OJ 1993, 505, **T 253/90**, **T 287/90**, **T 188/92**, **T 563/92**).

However in some decisions such a statement of grounds was accepted. In **T 355/86** a statement of grounds which referred generally to previous submissions was considered as sufficient. In **T 140/88** the Board considered that the appellant's submission referring to the statement filed earlier with the Opposition Division was intended to have the same effect as a new filing of this prior statement and should be effectively given this effect. In **T 725/89** a written submission to the Opposition Division was made the subject of the statement of the grounds of appeal. This written submission commented on the result of the oral proceedings and was received by the Opposition Division before it sent out its written decision. The Board of Appeal accepted this as valid filing of the statement of grounds.

8.5.4 References to other documents

In some cases the question arose whether a reference to other documents is an adequate statement of grounds.

In **T 145/88** (OJ 1991, 251) attention was drawn in the statement of grounds to a passage in the description, but no submissions were made in support of the allowability of the claim. This was despite the fact that in the decision under appeal it was held that the claim did not involve an inventive step. The Board was of the opinion that such a statement of grounds did not fulfil the requirements of Art. 108.

In case **T 869/91** the appellant alleged lack of inventive activity in his statement of grounds and in support of this allegation merely referred generally to several documents. The Board held this statement of grounds to be sufficient, as, despite the merely general reference, it was recognisable what the appellant sought to deduce from these documents.

9. Late-filed claims in appeal proceedings

Several Boards of Appeal considered when the deadline occurs for admitting alternative claims in appeal proceedings. This question is particularly important for the applicant or patentee, since it relates to the point in time by which he must react to evidence or arguments brought forward by the other party or the Office. The Office is concerned here with ensuring both that the procedure is streamlined and that the opponent is granted sufficient opportunity to comment on alternative claims.

9.1 Reinstatement of claims in appeal proceedings

In opposition proceedings it is generally admissible to reinstate granted claims after having proposed limited claims, for example to meet the objections of the opponent or Opposition Division, provided that this does not constitute an abuse of procedural law (see also VI.A. 10.2).

In **T 217/90** the Board confirmed the principles laid down in **T 123/85** and added that in the case in point the partial reinstatement of Claim 1 as granted did not contravene the principle of good faith vis-à-vis Opponent II. In the oral proceedings Opponent II, who was a party to the appeal proceedings, was not represented, in conformity with his reply to the summons. The Board therefore held that, since Opponent II had had the opportunity to be heard, it was not prevented by the provision of Art. 113(1) from considering and deciding upon the request.

9.2 Submission of amendments at a very late stage

In appeal proceedings new claims should normally be filed with the statement of grounds of appeal or as soon as possible thereafter. The admission of amended claims to appeal proceedings is at the discretion of the Boards. In **T 95/83** (OJ 1985, 75) it was decided that amendments not submitted in good time before **oral proceedings** should only be considered on their merits where there was some clear justification both for the amendment and for its late submission. In **T 153/85** (OJ 1988, 1) it was further said that the Board might justifiably refuse to consider new claims which had been filed at a very late stage, for example during the oral proceedings, if such claims were not **clearly allowable**.

The law does not guarantee a patent proprietor the right to have proposed amendments incorporated in **opposition (appeal) proceedings**. Whether or not they are will be decided by the department concerned exercising due discretion. They may be refused if they are neither **appropriate** nor **necessary** as provided for in Art. 101(2), R. 57(1) and R. 58(2) (**T 406/86**, confirmed by **T 295/87**, OJ 1990, 470; see also VI.D. 4.1).

The Boards of Appeal applied these principles in several decisions. In **T 381/87** (OJ 1990, 213) the Board admitted to the proceedings an auxiliary request made for the first time during the oral hearing and remitted the case to the Examining Division for further prosecution in relation to the auxiliary request. The Board stated that in the particular circumstances of the case, the alternative claims were not clearly unallowable and the question of inventive step of the subject-matter of the claims had not been considered by the Examining Division. However, it pointed out that the course it had adopted was contrary to the public interest, because the result of it was that there was inevitably a further delay in the making of a final decision as to whether or not a European patent might be granted.

In **T 406/86** (OJ 1989, 302) the patent proprietor submitted a proposal for amendments during the appeal proceedings once a draft decision had already been prepared and examination of the appeal under Art. 110 EPC had been practically completed. The Board considered that admitting the amendments at that stage would have slowed down the proceedings and affected the rights of third parties. A different conclusion might be reached in exceptional circumstances, for example, if the amended text were obviously allowable.

In several decisions (including **T 51/90** and **T 270/90**) it was emphasised that for rea-

sons of fairness any new claims filed during appeal proceedings should be submitted at least one month prior to oral proceedings, unless they were simple and clear enough to be understood immediately and were obviously allowable. In **T 241/92** the Board pointed out that late-filed claims could delay the proceedings, in particular when filed unexpectedly during the oral proceedings and when the core of the invention was radically changed.

In **T 25/91** the Board ruled that the late-filed amended claims were inadmissible at oral proceedings, because they had been filed only **one day** before the hearing took place. The Board said that no good reason had been advanced at the oral proceedings as to why the amendments had been filed so late. Moreover, even from a preliminary examination of the facts, it was clear that the amended claims represented a radical departure from the claims previously maintained (see also **T 961/91**).

9.3 Remittal to the first instance because of substantial amendments to claims

In a case where substantial amendments to the claims are proposed on appeal, which require a substantial further examination in relation to both the formal and substantive requirements of the EPC, such further examination should be carried out, if at all, by the Examining Division as the first instance, only after the Examining Division has **itself** exercised its discretion under R. 86(3). In this way, the applicant's right to appeal to a second instance is maintained, both in relation to the exercise of discretion under R. 86(3), and in relation to the formal and substantive allowability of the amended claims (see leading decision **T 63/86**, OJ 1988, 224). Several Boards of Appeal have applied this case law in their decisions: **T 296/86**, **T 501/88**, **T 47/90** (OJ 1991, 486).

10. Reimbursement of appeal fees

10.1 Introduction

According to R. 67 the reimbursement of appeal fees shall 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**.

In certain cases the Board of Appeal 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 (**T 271/85**, **T 598/88**, **T 346/88**, **T 484/90**, OJ 1993, 448).

It is a precondition for reimbursement of the appeal fee that the appeal be deemed allowable. In **T 792/90** the Board held that an appeal decision in which the main request of the appellant was rejected, but an auxiliary request was allowed, was not a decision in which the appeal was deemed to be allowable within the meaning of R. 67, if, as was the case, the main request corresponded to the request refused in the appealed decision. The appeal fee was thus not reimbursed.

Normally there is no procedural violation justifying reimbursement of the appeal fee if the EPO adopts a wrong procedure in a situation where the EPC does not lay down clearly what procedure is to be followed, and case law has not yet established any settled practice (**T 234/86**, OJ 1989, 79). This 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 – cannot be regarded as a substantial procedural violation.

The fact that the Board came to a different conclusion than did the department of first instance does not by itself mean that the latter has committed a substantial procedural violation (**T 538/89**, **T 87/88**, OJ 1993, 430).

10.2 Inadmissibility or withdrawal of appeal

In a case of inadmissibility of an appeal no reimbursement of the appeal fee is provided for in the EPC. Reimbursement of the fee may only be ordered in the circumstances set out in R. 67. The appeal fee cannot be refunded for the reason that a statement of grounds was not filed, or was filed too late (**T 13/82**, OJ 1983, 411; **T 324/90**, OJ 1993, 33). This also applies in a case 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 only appellant had withdrawn his appeal before the Board of Appeal had considered whether the appeal could be deemed allowable. The Board decided that the appeal fee could not be reimbursed, since the appeal had been effectively filed.

This is to be distinguished from the situation where an appeal is deemed not to have been filed because the payment was not made in due time. Here, 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 (see **J 16/82**, OJ 1983, 262; **T 324/90**, OJ 1993, 33).

10.3 Substantial procedural violation

In **T 682/91** the Board of Appeal emphasised that the appeal fee can only be reimbursed if there really is a substantial procedural violation. This means in particular that a procedural violation which does not adversely affect anyone cannot be considered as substantial. The seriousness of a procedural violation derives from its adverse effects.

10.3.1 Oral proceedings and the right to be heard

Normally, refusal of a request for oral proceedings amounts to a breach of the requirements of Article 113(1) that 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. Such a violation justifies reimbursement of the appeal fee (**T 283/88**, **T 598/88**, **T 668/89**, **T 663/90**, **T 766/90**, **T 35/92**). This also applies to other violations of the provisions of Art. 113 (1) as stated in a number of decisions (**T 18/81**, OJ 1985, 166; **T 716/89**, OJ 1992, 132; **T 448/90**, OJ 1993, 448).

Failure to summon the parties to oral proceedings was considered to be a substantial procedural violation in **T 209/88** and **T 93/88**. In **T 560/88** the Board of Appeal held that there was a substantial procedural violation where a clear auxiliary request of the appellant for oral proceedings to be held was not granted.

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. Furthermore the failure to seek clarification from the

appellant as to whether oral proceedings were being requested did not constitute a breach of any procedure.

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 **T 783/89** the parties were only given 10 minutes' time 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 (see also VI.A. 2. and 3).

10.3.2 Inadequate reasons given in the decision at first instance

In the context of deciding on requests for reimbursement of the appeal fee, some decisions have commented on whether the reasons given in the decision at first instance were adequate. In **T 493/88** (OJ 1991, 380) the Board held that a failure to comply with the provisions of the first sentence of R. 68 (2) on stating reasons for decisions constituted a serious procedural violation, as a result of which it was equitable to reimburse the appeal fee. In **T 292/90** it was stated that reasons given should enable the appellant and the Board to understand whether the decision was justified or not, and ordered reimbursement of the appeal fee (see also **T 52/90**). In **T 856/91** the Board held that it was sufficient compliance with R. 68(2) that some reasons, even if incomplete and inadequate, were given. Therefore the request for reimbursement was rejected (see also **T 735/90** and **T 153/89**).

10.3.3 Other miscellaneous cases

In **J 5/81** (OJ 1992, 155) it was held that there was a substantial procedural violation where the Receiving Section had ignored the suspensive effect according to Art. 106(1) of an appeal.

It does not amount to a procedural violation that the Examining Division wrongly found that Claim 1 was not sufficiently clear to comply with the requirements of Art. 84, even despite a possible error of judgment and failure to seek clarification from the appellant (**T 680/89**).

The Board of Appeal ordered reimbursement of the appeal fee in **T 382/92**, because the composition of the Opposition Division did not comply with the requirements of Art. 19(2). The Chairman and one member of the Opposition Division had already been members of the Examining Division which decided on the application leading to the patent concerned.

In **T 205/89**, due to a mistake by a formalities officer, a request for an extension of the time in which to submit comments in the opposition proceedings never reached the Opposition Division, which therefore decided without taking into account the argument presented in the later-filed submission. The Board held that this amounted to a substantial procedural violation.

F. Proceedings before the Disciplinary Board of Appeal

1. European Qualifying Examination – powers of the Disciplinary Board

The Regulation on the European Qualifying Examination for professional representatives before the EPO (REE) was amended by decision of the Administrative Council of 7.12.1990 (OJ 1991, 15). The additions to Arts. 12(2) to (4) REE in Art. 2 of the amending regulations in conjunction with the implementing provisions under Art. 12 REE revised by the Examination Board with effect from 1.1.1993 (OJ 1993, 73) introduce a system for the overall assessment of candidates' papers which diverges from the previous legal situation. Under the new provisions a candidate is successful, when assessed overall in accordance with Art. 12(2) REE, if he

(a) has failed only one paper, which has been awarded a grade 5, and that grade is offset by a grade 3 or better in at least one other paper;

(b) has failed only one paper, which has been awarded a grade 6, and

i) if that grade is in paper A or B, it is offset by a grade 3 or better in paper B or A and in at least one other paper;

ii) if that grade is in paper C or D, it is offset by a grade 3 or better in paper D or C and in at least one other paper;

(c) has failed two papers, each of which has been awarded a grade 5, those grades being in only one of A and B and only one of C and D, and offset by a grade 3 or better in both of the remaining two papers.

In **D 1/92** (OJ 1993, 357) the appellant claimed that the examiners' assessment of his work was defective. The Disciplinary Board pointed out that as far as the reviewing of decisions of the Examination Board by the Disciplinary Board of Appeal of the EPO was concerned, even after the above-mentioned amendments, the principles of **D 4/88** applied. This means that decisions of the Examination Board may in principle only be reviewed for the purposes of establishing that they do not infringe the Regulation on the European Qualifying Examination, the provisions relating to its application or higher-ranking law.

The Board therefore concluded that its functions did **not** include reconsidering the examination procedure **on its merits**. It could only consider serious and obvious mistakes by an examiner marking a candidate's papers where the contested decision of the Examination Board was based on such a mistake. Furthermore, the alleged mistake had to be so obvious that it could be established without reopening the entire marking procedure.

Any further claims regarding alleged defects in the assessment of candidates' work fell outside the Board's jurisdiction, since value judgments were not subject to judicial review.

In **D 6/92** (OJ 1993, 361) the Disciplinary Board of Appeal referred to the principle outlined above and ruled that, if a candidate had scored grades of 4, 6, 4 and 4 in his papers, giving a total of 18, there was no legal basis under Art. 12 REE for declaring him to have been successful.

2. Drawing up the examination procedure – conditions for enrolment

In **D 4/86** (OJ 1988, 26) it is stated that, for the condition stipulated in Art. 7(1)(b)(i) REE

to be met, it is necessary for the trainee to have completed his training period under conditions suitable for ensuring 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. In decisions **D 5/89** (OJ 1991, 218) and **D 3/89** (OJ 1991, 257) the Disciplinary Board of Appeal confirmed its previous case law that, when drawing up the examination procedure, the Examination Board had discretionary powers whose exercise might be scrutinised only for possible misuse (see **D 1/81**, OJ 1982, 258). According to **D 5/89** it does not constitute a misuse of discretionary powers if the examination procedure requires a candidate without a university-level qualification to have worked for three additional years as corroboration of an equivalent level of knowledge (see point 5.4.1 of the examination procedure, OJ 1980, 220). In **D 3/89** the candidate had submitted a diploma from a German vocational college (Fachhochschule) in order to fulfil the requirements of Art. 7(1)(a) REE. The Disciplinary Board of Appeal, however, stated that under current law a qualification from such a college could not per se be accepted as corroboration of an equivalent level of scientific or technical knowledge within the meaning of Art. 7(1)(a), second alternative, REE. Equivalent scientific or technical knowledge may be demonstrated not only by an additional period of three years spent working in a range of activities pertaining to patent matters but also by relevant experience in another appropriate field (e.g. research).

3. 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 12/88** (OJ 1991, 591) the Disciplinary Board of Appeal considered the ban on advertising by a firm of patent agents. According to this decision the ban on advertising imposed on professional representatives before the EPO (see Art. 134(8) and point 2 of the EPI Code of Conduct) represents a balance between the right to freedom of expression on the one hand and, on the other, the need for the law to protect the reputation of others (i.e. here, to preserve the dignity of the profession of professional representatives before the EPO) and the rights of others (here, in particular, ensuring fairness in competition between members of the EPI). A restriction on the fundamental right to freedom of expression enshrined in law and based on such a balance satisfies the principle of proportionality contained in Art. 10(2) of the European Convention on Human Rights.

A member of the EPI is responsible for articles in the press with an advertising character based on information supplied by him. It is not sufficient for members of the press to be referred expressly to the ban on advertising in the Code of Professional Conduct since, by virtue of the constitutional guarantee of press freedom, the press is not bound by the provisions governing the professional conduct of professional representatives before the EPO or by wishes regarding the content of its reports.

VII. THE EPO ACTING AS PCT AUTHORITY

A. The EPO acting as ISA

1. PCT search guidelines binding on the ISA

In decisions **G 1/89** and **G 2/89** (OJ 1991, 155 and 166) the Enlarged Board of Appeal decided that the EPO in its function as an ISA may, pursuant to Art. 17(3)(a) PCT, request a further search fee where the international application is considered to lack unity of invention a posteriori (see also II.C. 3.).

According to Art. 2 of the Agreement between the European Patent Organisation and WIPO concluded on 7.10.1987 (OJ 1987, 515) the EPO must, in carrying out international searches, be guided by the PCT guidelines. This Agreement is based on Arts. 154 EPC and Art. 16 PCT and is therefore binding on the EPO, including the Boards of Appeal when exercising their special functions under the PCT in accordance with Art. 154(3) EPC. The PCT guidelines for international search contain 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. Only in the case of a conflict between the guidelines and the PCT itself does the latter prevail as higher-ranking law. The Enlarged Board, however, could not see such a divergence and therefore concluded that the PCT guidelines should be applied as a matter of principle when examining for non-unity of an application a posteriori.

2. Protest procedure

If the international application does not comply with the requirement of unity of invention, the ISA must invite the applicant to pay additional search fees (Art. 17(3)(a) PCT). The applicant may pay the additional fee under protest and thereby initiate a review of the justification for the invitation (R. 40.2(c) PCT).

2.1 Substantiation of invitation

Under R. 40.1 PCT, the ISA must specify the reasons for which the application is not considered as complying with the requirement of unity of invention. According to established case law the specification of reasons in an invitation to pay additional fees is an essential requirement for the legal effectiveness of such an invitation (**W 4/85** and **W 7/86**, OJ 1987, 63 and 67; **W 9/86**, OJ 1987, 459; **W 7/85**, OJ 1988, 211).

The fundamental decision **W 4/85** (OJ 1987, 63) states the minimum requirement for adequate substantiation. According to that decision, the basic considerations behind the finding that the invention lacks unity must therefore be set out in a logical sequence to enable the applicant and the appeal body to check this finding; only in straightforward cases may it be sufficient just to list the relevant subject-matters provided the list makes it perfectly clear that the application does not relate to a single general inventive concept (as, for example, in **W 7/92**).

In the decisions **W 7/86** (OJ 1987, 67), **W 33/90**, **W 50/90**, **W 16/91**, **W 32/91**, **W 43/91** and **W 9/92**, it is pointed out that listing the inventions which in the ISA's view the application contains is sufficient reasoning only in exceptional cases.

In **W 8/91**, it was decided that, where claims are formally dependent, the ISA has to state expressly why they lack unity; it is not enough simply to say that this is shown directly by the subject-matter as defined by the ISA.

In decisions **W 11/89** (OJ 1993, 225) and **W 10/92**, the Board came to the conclusion that an invitation to pay additional search fees must also contain an exposition of the problem solved by the invention, unless it is perfectly clear that the technical facts listed in the invitation cannot reasonably be subsumed under an overall problem; if that exposition is lacking, the invitation is not legally effective and any additional search fees paid must be reimbursed.

W 50/91 and **W 22/92** held that where the lack-of-unity objection is a priori, the technical problem is to be defined only on the basis of the description, not the prior art.

According to **W 59/90** and **W 14/91** in a posteriori cases, details of the technical problem are required to be given both before and after a novelty-destroying document giving rise to lack of unity is found. If a lack of inventive step is not immediately apparent, in case of doubt unity should be assumed (see **W 23/89** and **W 51/90**).

In **W 14/92**, the Board ruled that it has to be clear to the applicant whether the lack-of-unity objection is a priori or a posteriori.

2.2 Substantiation of protest

In the decisions **W 8/89**, **W 60/90** and **W 16/92**, the Board emphasised that an applicant who wishes to pay the additional search fee under protest must submit a reasoned statement. A protest without sufficient reasoning will be rejected as inadmissible – without substantive examination by the Board as to whether the invitation of the ISA has been properly reasoned. The reasoning must contain verifiable grounds indicating why the applicant considers unity of invention to be present. A mere statement to the effect that the international application meets the unity requirement does not constitute a reasoned statement within the meaning of R. 40.2(c) PCT. Very brief statements of grounds would suffice only in exceptional cases (see **W 48/90**).

2.3 Review of protests by a review panel

A new protest procedure will apply to any protest relating to an invitation to pay additional fees issued on or after 1.10.1992.

Where additional fees have been paid under protest, an EPO review panel will review whether the invitation to pay such fees was justified. The review panel will consist of the Head of the Directorate from which the invitation was issued, an examiner with special expertise in unity of invention and, normally, the examiner who issued the invitation.

If the review panel finds that the invitation was justified, it will inform the applicant accordingly and invite him to pay a fee for the examination of the protest by the Board of Appeal ("protest fee"), if he wishes the protest to be referred to the Board of Appeal for decision. The protest fee must be paid within a time limit of one month from the date of notification of the result of the review. If the protest fee is not paid in due time, the protest will be considered withdrawn. If the Board of Appeal finds that the protest was justified, the additional fee(s) and the protest fee will be refunded.

For details see the Decision of the President of the EPO dated 25.8.1992 and the Notice of the EPO dated 26.8.1992, OJ 1992, 547.

2.4 Devolutive effect of protests

In case **W 53/91**, the EPO as ISA – applying the former protest procedure – invited the applicant to pay an additional search fee on 30.5.1991, followed on 1.10.1991 by a second invitation intended to replace the first one – against which the applicant had meanwhile (on 20.6.1991) filed a protest. He duly filed a protest against the second invitation too, and this the Board was now hearing. The Board's first ruling was that the provisions and principles of the EPC applied *mutatis mutandis* in protest proceedings, which therefore also had a suspensive and devolutive effect. The department of first instance had no power to amend, replace or cancel its own decision once that decision had been appealed. Noting this, the Board also ordered that the search fee paid under protest be reimbursed.

B. The EPO acting as IPEA

In **J 15/91**, it was decided that EPO Appeal Boards had no jurisdiction to examine appeals against the EPO acting in its capacity as an IPEA. The Legal Board of Appeal thereby upheld its previous decision **J 20/89** (OJ 1991, 375).

In case **J 15/91**, the applicant filed an international patent application with the EPO and paid the international preliminary examination fee but failed to submit a demand for international preliminary examination within the time limit, laid down in Art. 39(1)(a) PCT, of 19 months from the date of priority. The EPO, acting as IPEA, notified the applicant that fee payment could not be accepted as a substitute for observing the prescribed time limit. This being so, the applicant was not entitled to benefit from the provisions for postponing entry into the regional phase until 30 months from the date of priority.

The aim of the requests made by the applicant in his appeal against this notification was to obtain a decision to the effect that he had filed his demand for international preliminary examination in due time. The decision of the Legal Board of Appeal was based on the principle that the EPO is bound solely by the provisions of the PCT, the Regulations under the PCT and the relevant agreement between WIPO and the European Patent Organisation (OJ 1987, 515), where the EPO is acting, **in the international phase** of the PCT procedure, in the capacity of an international authority under the PCT. This follows, with regard to proceedings before the IPEA, from Art. 34(1) PCT. To this extent, therefore, the EPC does not apply. Apart from allowing for protests against an invitation by the ISA to pay additional search fees in cases where the requirements for unity of invention have not been met, the PCT makes no provision for appeal during the international phase.

Furthermore, the Board took the view that even if, as in the present case, the EPO had acted as receiving Office, there were no grounds for supposing that its Boards of Appeal had any jurisdiction. International preliminary examination by the IPEA was a separate procedure which had to be distinguished from proceedings before the receiving

Office and the ISA. Under Art. 31(3) PCT, the demand for international preliminary examination had to be made separately from the international application, and Art. 31 (6)(a) PCT stipulated that the demand had to be submitted to the competent IPEA, not the receiving Office. Although the EPO might well perform all the various functions involved in the international phase of the PCT proceedings, the distinction between the procedures still applied.

C. The EPO as designated Office

In its decision **J 26/87** (OJ 1989, 329), the Legal Board of Appeal had to examine the interpretation of a request for grant of an international application by the Australian Patent Office, acting as receiving Office, and the International Bureau in connection with the mention of Italy as designated State. The Board came to the conclusion that if, on the proper interpretation of the request for grant of an international application, an applicant has designated a Contracting State to the EPC for which the PCT is in force, the EPO is bound by the provisions of Art. 153 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.

VIII. INSTITUTIONAL MATTERS

In **G 5/88**, **G 7/88** and **G 8/88** (OJ 1991, 137), the Enlarged Board of Appeal was called upon to address institutional matters. The question whether an opposition was filed in time, had given rise to such considerations. The Presidents of the German Patent Office (DPA) and the EPO entered into an Administrative Agreement in 1981 concerning the filing of documents and payments (OJ 1981, 381). According to Art. 1 of this Agreement, documents and payments filed with the DPA, but addressed to or intended for the EPO, are treated as if they had been received on the day of actual receipt by the DPA.

The Enlarged Board of Appeal considered the validity of this Administrative Agreement, using for the first time the Board's power of judicial review. This power can be derived from Art. 164(2). The Board reached the conclusion that the power of the President of the EPO to enter into such agreements cannot be derived from Art. 5(3) which states that he represents the European Patent Organisation; the President's capacity to represent the European Patent Organisation is merely one of his functions. The extent of the President's power to enter into agreements is rather to be derived from other provisions of the EPC, in this case Art. 10(2)(a), according to which the President is to take all necessary steps to ensure the functioning of the EPO. It was held that an agreement concerning the treatment of misdirected documents does involve a necessary step to ensure the functioning of the EPO for the following reason: the misdirection of papers leads to the danger of a loss of rights, as a result of failure to meet a time limit, caused by late receipt of the documents.

The Administrative Agreement between the EPO and DPA 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 had existed in Munich from the very beginning because of the proximity of the two Patent Offices.

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 neither a filing office nor was a letter-box installed. As no danger of confusion had existed in Berlin before the filing office was established there, the Administrative Agreement was invalid as far as documents and payments which reached the EPO via the DPA's office in Berlin were concerned. The opening of an alternative route for filing documents with the EPO, that is, via the Berlin branch of the DPA, was not covered by the purpose behind the Administrative Agreement. The Enlarged Board of Appeal, however, 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 DPA, 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. In such cases, the President has the power to conclude an Administrative Agreement concerning the treatment of misdirected documents by virtue of his duty to direct the EPO as defined in Art. 10. On 13.10.1989, the Administrative Agreement between the Presidents of the two Patent Offices was adapted to the new situation arising from the establishment of the Berlin filing office (see OJ 1991, 187).

In **T 485/89** (OJ 1993, 214), the Board of Appeal was called upon to consider the admissibility of a notice of opposition filed by fax at the DPA in Munich on the last day of the opposition period. The notice was forwarded to the EPO the next day. The opposition fee had already been paid some days earlier. The first pages of the fax contained references to the European patent and the addressee was given as the EPO with the correct address.

The Board of Appeal held that the opposition was admissible: oppositions filed within the prescribed time by fax at the DPA in Munich while intended for the EPO were covered by the Administrative Agreement of 29.6.1981 concerning procedure on receipt of documents and payments and should be treated by the EPO as if it had received them directly, irrespective of whether or not they had been wrongly delivered.

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