



**European
Patent Office**



Case Law

**of the Boards of Appeal
of the European
Patent Office**

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

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Foreword to the second edition

The keen interest with which the publication "Case Law of the Boards of Appeal of the European Patent Office" was greeted and the rapid development of case law pointed to the need for a new edition of that publication after little more than two years. Since the appearance of the first edition the Enlarged Board of Appeal has commented in more than fifteen decisions and opinions on important points of European patent law and thus exerted a decisive influence on EPO and board of appeal practice, for example with regard to grant procedure, oppositions, appeals, the deposit of biological material, the claiming of priority and the authorisation of amendments.

For this new edition the Legal Research Group of the boards of appeal has revised and substantially expanded the original text. Board of appeal decisions dating from 1978, when the EPO began its activities, are now included and 1995 decisions have been taken into account where time constraints have permitted.

I would like to thank all colleagues at the EPO who have helped produce this new edition of the case law report, particularly the members of the Legal Research Group and the Language Service, whose active support and co-operation have once again made possible simultaneous publication in all three official languages of the European Patent Office.

This publication is intended to give an up-to-date overview of the decisions of the EPO's judicial body. I hope it will be of use to all interested parties, patent applicants and their representatives and the staff of the EPO.

Paolo Gori

Chairman of the Enlarged Board of Appeal

Vice-President of the EPO

Foreword to the first edition

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. Table 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
Corr.	corrigendum
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
RDR	Regulation on discipline for professional representatives
REE	Regulation on the European qualifying examination for professional representatives
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 the table of cases 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 1992**", for example, refers to the case law of the Boards of Appeal of the EPO in the year 1992 (i.e., 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 or 68.3 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 lists 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, ie 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) and it can be protected if it meets the requirements of Art. 52 to 57.

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

In 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 coordinate 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) cannot be regarded as a patentable invention within the meaning of Art. 52(1).

In **T 769/92** (OJ 1995, 525) the Board held that an invention comprising functional features implemented by software (computer programs) is not excluded from patentability under Art. 52(2)(c) and (3) if technical considerations concerning particulars of the solution of the problem the invention solves are required in order to carry out that same invention. Such technical considerations lend a technical nature to the invention in that they imply a technical problem to be solved by (implicit) technical features. An invention of this kind is

considered not to pertain to a computer program as such under Art. 52(3). The decision set out that non-exclusion from patentability cannot be destroyed by an additional feature which as such would itself be excluded, as in the present case features referring to management systems and methods which may fall under the “methods for doing business” excluded from patentability under Art. 52(2)(c) and (3).

In **T 59/93** a method for entering a rotation angle value into an interactive draw graphic system was claimed. This method, implemented on a programm-controlled computer, its operator being the user, allowed the rotation of displayed graphic objects with increased accuracy. The board held that the method claim defined, by the steps the method comprised, the functional features of said system. These features were neither regarded as relating to mathematical methods as such (the calculating steps were considered to be only means used within the overall method), nor as claims to computer programs as such (the operation of the system, in its use under the control of such programs, brought about technical effects which solved a problem which was to be regarded as involving technical considerations), nor as relating to the presentation of information as such (the excluded subject-matter was not claimed as such, but was only a tool for implementing certain steps of the method claimed as a whole). The board held that methods comprising excluded features, but nevertheless solving a technical problem and bringing about technical effects, were to be considered as making a technical contribution to the art.

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 p. 23): 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. Thus, 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).

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** (OJ 1994, 557) the invention was for a method of transforming a first editable document form prepared using a batch word processing system into a second editable document form for use on an interactive or batch word processing system. Following **T 163/85** (OJ 1990, 379) the Board found that control items (e.g. printer control items) included in a text represented in the form of digital data 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.

In **T 71/91** the board considered the patentability of an electronic document system consisting of a plurality of processors or workstations which receive and transmit documents in the form of a data stream. The data represent both the contents of a document and information on the kind of processing to be performed relative to it. If a processor detects processing information which it is not capable of performing, that information is not merely ignored but is stored in a memory and retrieved when the data stream is transmitted to another processor. The data stream is thus reconstituted and the transmitted data is substantially the same as the received data, no information having been lost. The board held, following **T 38/86** (OJ 1990, 384), that it was clear that the claimed subject-matter made a contribution to the art in a field not excluded from patentability. The board also pointed out that in an analogous case, **T 110/90** (OJ 1994, 557), the “control of hardware such as a printer” was held not to be excluded under Art. 52(2)(c) since it was not concerned with “the linguistic meaning of words of the text”. Similarly, in the case before the board, the data to be processed was also distinct from the content of the document itself.

The interrelationship of excluded and non-excluded features was considered in **T 236/91**. Following **T 208/84** (OJ 1987, 14), **T 38/86** (OJ 1990, 384) and **T 26/86** (OJ 1988, 19), the board reiterated that while the EPC does not prohibit the patenting of inventions consisting of a mix of excluded and non-excluded features, and 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 (only) in those cases in which the invention involves a contribution to the art in a field not excluded from patentability.

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

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 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.

Further to **T 115/85** (see p. 25) the Board ruled in **T 362/90** that automatic visual display of the conditions prevailing or desirable in an apparatus or system was basically a technical problem. A claim directed to a device displaying (especially in heavy goods vehicles) both the gear in use and (by evaluating signals about engine performance) the best gear to be in was not unpatentable under Art. 52(2)(d) even if it did involve non-technical features relating to the presentation of information.

In **T 790/92** the Board considered **T 115/85** (OJ 1990, 30) where it was held that displaying messages indicating a specific event which may occur in the device in a processing system is basically a technical problem. The problem was considered to be basically of a technical nature in that it had to do with the internal functioning of a device. In the present case, however, the board stated that it was not such a technical “event” or “condition” concerning the functioning of a device and therefore posing a technical problem which would give rise to a message, but a discrepancy between the information presented by the chart and the information the chart is normally intended to present. The Board held that such a discrepancy between normal and modified presentations of information cannot be considered as being of a technical nature.

In **T 887/92** one of the objects of the invention was to render the usual HELP facility provided with many computer programs more user-friendly. The claimed method involved the steps of (1) determining what commands are valid as the next command by an analysis of the current state of the process task being performed by the system at the time the help request is issued, (2) displaying a help panel containing only these commands, (3) positioning a “selection” cursor to the line of a displayed command, and (4) executing the command selected by pressing the “enter” key. The board held that giving visual indications automatically about conditions prevailing in an apparatus or system is basically a technical problem. Thus, the displaying of only valid commands in the help panel had technical character because it clearly reflected the status or condition of the system. The computer program on which step (1) relied was considered to constitute a technical means for carrying out the invention.

1.4 Methods for doing business

A computer manufacturer applied to patent a method for operating an electronic self-service machine (e.g. cash dispenser which could be accessed using any machine-

readable card. A prospective user first had to insert such a card to enable its identification data to be stored; he then keyed in credit information about himself on to an “electronic application form”, thereby permitting a decision to be taken on whether to authorise him as a user. Once authorised, he could access the system using that same card. In **T 854/90** (OJ 1993, 669) the Board ruled that this was not patentable – parts of the method claimed were merely instructions for using the machine, and although technical components were used this did not alter the fact that what was being claimed was a method for doing business as such.

In **T 636/88** claim 1 was for a method of distributing material transported in bulk by ship: on the quayside was mounted a weighing and bagging apparatus which could be shipped in standard containers and was used to unload and bag the material before moving on to the next port. The other claims were directed to the bagging apparatus itself. The opponent argued that the patent proprietor’s commercial success derived merely from a method for doing business within the meaning of Art. 52(2)(c), namely contract bagging of bulk material in a manner permitting offloading at ports (e.g. in developing countries) which did not have any bagging plant on site. The Board however took the view that the method claimed clearly did have technical character, involving as it did the use of technical equipment (bagging apparatus) to achieve a technical end (the production of sealed, weighted bags of the material in question). It also necessitated the use of bagging apparatus which had no counterpart in the prior art.

In **T 769/92** (OJ 1995, 525) the applicant claimed a computer system for plural types of independent management including at least financial and inventory management and a method for operating said system. Data for the various types of management which could be performed independently from each other with this system could be inputted using a single “transfer slip”, in the form of an image displayed on the screen of the display unit of the computer system, for example.

Although financial and inventory management would generally fall under “doing business”, the board held that the invention was not excluded from patentability under Art. 52(2)(c) and (3). In its view the particular kinds of management mentioned were not decisive; the fact that they were of different “specific” types to be performed “independently” of each other was found to be important. The application contained the teaching to provide, in the memory unit of the computer system, certain files and processing means for storing and further processing the data entered and causing the processing unit to perform these functions. The implementation of this teaching required the application of technical considerations. In the board’s view the non-exclusion from patentability also applied to inventions where technical considerations were applied concerning particulars of their implementation. The very need for such technical considerations implied the occurrence of an at least implicit technical problem to be solved and at least implicit technical features solving this problem.

Furthermore, the provision of the single transfer slip required the application of technical considerations. This “user interface” implied that, in effect, independent financial and inventory management systems were combined by a common input device allowing data entered for use in one of the said systems also to be used, if required, in the other system. The implementation of such an interface in the claimed computer system was not merely an act of programming, but rather concerned a stage of activities involving technical considerations to be carried out before programming could start.

In the view of the board, restricting the application to financial and inventory management did not give rise to an objection under Art. 52(2)(c). By this restriction, the claimed subject-

matter only gained, in addition to the combination of features which were not excluded from patentability, a further feature which, as such, would be excluded. However, it was established board of appeal practice to allow patentability for a mix of technical and non-technical features.

In **T 1002/92** (OJ 1995, 605) a system was claimed for determining the queue sequence for serving customers at a plurality of service points. The system gave the customer the possibility of selecting one particular service point; it comprised, in particular, a turn-number allocating unit, terminals for each service point, an information unit which indicated the particular turn-number and the particular free service point to the customer.

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

1.5 Aesthetic creations

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

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

In decision **T 119/88** (OJ 1990, 395) the subject-matter of the application in question related to a flexible disk jacket made of a plastic sheet presenting to the outside world a surface colour of a certain minimum light intensity. The board first of all stated that the feature of having a specific colour as such 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).

1.6 Lack of technical character in general

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

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

In **T 854/90** (see p. 29) 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 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, ie 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.

In some decisions, the boards came to the conclusion on the facts that no technical contribution had been made to the state of the art:

In **T 833/91** the board stated that all the different matters or activities listed in Art. 52(2) seem to have in common that they imply something non-technical and, secondly, that from Art. 52(3) it would appear to be the EPC's intention to permit patenting (only) in those cases in which the invention involves some contribution to the art in a field not excluded from patentability. The board thus concluded that, in accordance with the consistent case law of the Boards of Appeal, it can be said that the technical contribution to the art rendering a claimed invention an invention within the meaning of Art. 52(1) and thus patentable, may lie either in the problem underlying, and solved by, the claimed invention, or in the means constituting the solution of the underlying problem, or in the effects achieved in the solution of the underlying problem. In the case in point the claimed invention concerned the designing or developing of application (or user) programs for computers, ie it addressed a program designer or programmer. The board pointed out that programs for computers as such are expressly excluded from patentability and a programmer's activity would involve performing mental acts and therefore also fall within the exclusions under

Art. 52(2)(c). Furthermore, displaying data is presentation of information and thus excluded by Art. 52(2)(d). The Board held that the contribution to the state of the art made by the invention was not technical, that the subject-matter did not make any contribution to the art in a field not excluded from patentability and was not therefore to be regarded as an "invention" within the meaning of Art. 52(1).

In **T 204/93**, the claimed invention related to the art of generating "concrete" software programs (ie those written in a particular programming language). These "concrete" software programs are generated from supplied "generic" specifications, which are program components or modules written in a more generally usable language, so they have to be "translated" before insertion into the "concrete" program. The principle of using named program modules, stored elsewhere, in a computer program to be generated, resembled, except for the level of language used, the well-known calling-up of stored sub-routines in main programs. As far as the claimed subject-matter was concerned, the Board did not dispute that it would improve the efficiency of the programmer. However, this did not mean that the computer would work in an essentially new way from a technical point of view.

Computer programs are not patentable irrespective of their content, ie even if that content happens to be such as to make it useful, when run, for controlling a technical process. Similarly, a programmer's activity of programming, would, as a mental act, not be patentable, irrespective of whether the resulting program could be used to control a technical process. Finally, automating that activity, in a way which does not involve any unconventional means, would not render that programming method patentable either, irrespective of the content of the resulting program.

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

2. Medical methods

2.1 Introduction

Art. 52(4) states that methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body are not to be regarded as inventions which are susceptible of industrial application.

In **T 116/85** (OJ 1989, 13) the board found that the scheme of Arts. 52 to 57 made it quite clear that even though certain methods were in general potentially patentable subject-matter, the particular methods defined in Art. 52(4) were excluded from patentability. In other words, for the particular methods defined in Art. 52(4), Art. 52(4) took precedence over Art. 57.

The exclusion of such methods from patentability is not a new provision under the EPC. Before the EPC came into force, such methods were excluded from patentability under

the national laws of many European countries. The policy behind the exclusion of such methods was clearly to ensure that those who carry out such methods as part of the medical treatment of humans or the veterinary treatment of animals should not be inhibited by patents (see **T 116/85**, OJ 1989, 13; **T 82/93**, OJ 1996, 274).

According to **G 5/83** (OJ 1985, 64) the intention of Art. 52(4) was only to prevent non-commercial and non-industrial medical and veterinary activities from being restrained by patent rights (see **T 245/87**, OJ 1989, 171). In **T 385/86** (OJ 1988, 308) the board stated that Art. 52(4), first sentence, represented an exception to the general obligation to patent inventions. The intention was to exclude only methods of therapeutic treatment from the possibility of patent protection, so that no one could be hampered in the practice of medicine by patent legislation. Like any exclusion clause, Art. 52(4), first sentence, had to be narrowly construed, a fact underscored by the statement in the second sentence that the exclusion from patentability did not apply to products for use in such methods. In **T 144/83** (OJ 1986, 301) the board made it clear that such exclusions from patentability had to be construed narrowly and should not apply to treatments which were not therapeutic in character.

2.2 Medical character of the excluded methods

As stated above, Art. 52(4) is intended to exclude from patent protection only medical methods, so that no one carrying out such methods can be inhibited in the practice of medicine by a patent.

In **T 385/86** (OJ 1988, 308) (see below) the board examined whether the claims defined methods which could not be considered susceptible of industrial application because they could only be carried out by a doctor in the exercise of his healing skills. The board came to the conclusion that a person skilled in nuclear spin resonance spectroscopy could implement the measures claimed in a commercial laboratory environment without specialist medical knowledge or skills. The board found that the various steps for which protection was sought did not include any measures having the character of medical treatment or requiring a doctor to carry them out.

In **T 245/87** (OJ 1989, 171) claim 1 sought protection *inter alia* for a method in which an electrically conductive liquid containing a drug such as insulin was introduced into the body through the pump of an implantable device for controlled drug administration. The application was refused by the examining division on the basis of Art. 52(4). The board held that the steps described in claim 1, even when applied to an implanted device for controlled drug administration, only involved measuring the volume of the drug solution flowing into the body per unit of time. The flow itself was not affected. These steps might therefore be performed without any medical knowledge and had no therapeutic effect whatsoever in themselves. The doctor was in no way hindered in exercising his professional skills, ie preventing, curing or alleviating illness. The board ruled that a method did not fall within the scope of the first sentence of Art. 52(4) if there was 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.

In **T 24/91** (OJ 1995, 512) the question to be answered by the board was whether or not the claimed invention, involving a process for reprofiling the anterior curvature of a synthetic lenticule, secured to the cornea of the human eye for correcting vision, by ablating (ie removing) with a laser portions of said lenticule, represented a method for

treatment of the human body by surgery or therapy within the meaning of the first sentence of Art. 52(4). The appellant had argued that the claimed process was merely a process for physical treatment of a synthetic lenticule secured to the cornea of the human eye and did not comprise any surgical step or therapeutic treatment of the human body. He further contended that it could be carried out by a technician having no medical knowledge. The board did not accept these arguments and stated that a method for treatment of the human body could normally be said to fall within the exclusion of the first sentence of Art. 52(4), at least in those cases where, in view of the health risk connected with such a treatment, it had to be performed by, or under the supervision of a physician. The board noted that the claimed process was and had to be carried out by the ophthalmologist or ophthalmic surgeon himself, or at least under his supervision, so that the claimed process did fall under the exclusion of Art. 52(4). Directing the laser beam to the lenticule bore the serious risk of damaging the neighbouring tissue of the eye, and the physician was bound to exercise extreme care both during the medical treatment and during the use of medical apparatus. The board further stated that the lenticule having been secured to the cornea of the eye, was a real implant, in contrast to, for example, an arm or leg prosthesis. Therefore, the claimed process represented a treatment by therapy.

In **T 400/87** the board observed that the effects of the continuous static magnetic field and the magnetic gradient fields which were applied according to claim 1 did not, as far as was known, have any harmful side-effects on living matter. The claimed method could therefore be implemented without specialist medical knowledge or skills.

Decision **T 182/90** (OJ 1994, 641) considered in detail the interpretation of the concept "methods for treatment of the human or animal body by surgery" referred to in Art.52(4). The application related to a method for measuring the blood flow of a laboratory animal. The method comprised steps clearly representing surgical treatment and the step of sacrificing the animal involved. The board stated that the presence of a surgical step in a multi-step method for treatment of the human or animal body would normally confer a surgical character on that method. In this case, however, it took the view that the method which consciously ended in the laboratory animal's death could not be regarded as a method for the treatment of an animal by surgery. The board analysed the terms "treatment", "surgery" and "surgical treatment" and found that in a number of definitions of "surgery" a reference to healing was included. It further noted that, in current medical and legal linguistic usage, non-curative treatments (eg cosmetic treatments, termination of pregnancy, artificial insemination, the removal of organs) were also regarded as surgical treatments if carried out by surgery. In the board's view, however, the semantic change in the terminology could not extend so far that the opposite of the original meaning fell within its scope: a method involving the deliberate killing of a laboratory animal was not in the nature of a method of surgical treatment. The board held that a method which included a surgical step practised on a living animal and the additional step of sacrificing the animal, which step was necessary to carry out the method, could not be regarded in its entirety as a method for treatment of an animal by surgery within the meaning of Art. 52(4).

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

method when carried out by a veterinarian, and to say that the method, when carried out by a farmer was an industrial activity and when carried out by a veterinarian was a therapeutic treatment not patentable under Art. 52(4).

2.3 Allowability of claims under Article 52(4) EPC

The recent case law of the boards of appeal concerning inventions excluded by Art. 52(4) has made it clear that the exclusion of one feature under Art. 52(4) is sufficient to exclude the whole claim from patentability. It is important to draw a clear distinction between this principle and the established case law under Art. 52(2) and (3) concerning the patentability of a mix of technical and non-technical features because the reasons for exclusion from patentability of medical methods and of the subject-matter under Art. 52(2) and (3) are different. Art. 52(4) prevents the methods specified from being patented, even though otherwise they might be considered as inventions susceptible of industrial application as required by Art. 52(1). By way of contrast, Art. 52(2) and (3) is based on the assumption that only technical inventions can be protected by patents and, consequently, excludes subject-matter and activities without technical character.

In **T 820/92** (OJ 1995, 113) a claimed invention consisting of a contraceptive method involving a concurrent therapeutic step was refused by the examining division on the grounds that the claims did not comply with the requirements of Art. 57. In an official communication pursuant to Art. 110(2) the board stated that consideration had to be given to the question of whether the combination of a contraceptive method with a therapeutic method was excluded from patentability under Art. 52(4). The appellant argued that therapy was not the subject of the claims, and that in particular the method claims were directed to the prevention of pregnancy and not to a therapeutic application, so that no exclusion under Art. 52(4) should apply.

The board observed that while the treatment of the female mammal with a given effective amount of an LHRH composition was carried out to produce the desired contraceptive effect, the concurrent treatment with the oestrogenic and progestational steroids was carried out not to produce any contraceptive effect but as a prophylactic treatment to avoid the ill consequences which would otherwise occur as a result of the use of the LHRH composition. The latter step, therefore, was a treatment by therapy within the meaning of Art. 52(4). In the board's judgment, in considering whether a request for a particular set of claims was allowable under Art. 52(4), the critical question was whether there was any disclosure of a method none of whose steps fell under the prohibition of Art. 52(4), ie none of whose steps were either a method for the treatment of the human or animal body by therapy or surgery, or a diagnostic method practised on the human or animal body. The question was not merely one of having a suitably worded claim, but whether on the disclosure of the case such a method claim was allowable at all. The board noted that in the case of a method involving the administration of two or more substances, the question for the purposes of Art. 52(4) was not whether the main or even the only reason for carrying out the whole of the claimed method was non-therapeutic. Rather, a method claim fell under the prohibition of Art. 52(4) merely if the purpose of the administration of one of the substances was a treatment by therapy, and the administration of this substance was a feature of the claim.

In **T 82/93** (OJ 1996, 274) the opponent had argued that the claimed method was a method of treating the human body by therapy, which, pursuant to Art. 52(4), was to be regarded as not susceptible of industrial application and therefore not patentable. The opposition

division in its decision rejected this objection on the grounds that the defined method of operating a pacemaker included steps which necessarily implied that an algorithm was implemented in the pacemaker and used to control the pacing rate. Since such control of the pacing rate was “a technical operation performed on a technical object”, the opposition division held that the claimed method could not be considered as a method for treatment of the human body by therapy within the meaning of Art. 52(4), and that it was a method which was susceptible of industrial application within the meaning of Art. 57.

The board noted that whether or not the claim included features directed to “a technical operation performed on a technical object” was legally irrelevant to the application of Art. 52(4). In fact, a claim could contain nothing but technical features directed to a technical operation performed on a technical object and a subsequent technical operation performed on a human or animal body, but such a claim would be unallowable under Art. 52(4) if it defined a method for treatment of such a body by therapy or surgery. The board, after making clear that claims including both features relating to physical activities and features relating to physical entities were also possible, held that under Art. 52(4) a claim was not allowable if it included at least one feature defining a physical activity or action (eg a method step) which constituted a “method for treatment of the human body by therapy” (following **T 820/92**).

2.4 Therapeutic methods

2.4.1 Meaning of “therapy”

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, was 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; **T 290/86**, OJ 1992, 414).

In **T 820/92** (OJ 1995, 113) the board stated that a prophylactic treatment, aimed at maintaining health by preventing ill effects that would otherwise arise, amounted to a method for treatment by therapy as referred to in Art. 52(4), and that therapy was not limited to treatments which restored health by curing diseases which had already arisen.

In **T 24/91** (OJ 1995, 512) the board observed that the term “therapy” was not restricted to curing a disease and removing its causes. Rather, this term covered any treatment which was designed to cure, alleviate, remove or lessen the symptoms of, or prevent or reduce the possibility of contracting any disorder or malfunction of the human or animal body.

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).

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

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

In **T 438/91** it was necessary to decide whether or not a method for breeding domestic animals in claims 1 and 2 related to a therapeutic or prophylactic treatment. Two effects were observed as a result of the breeding method claimed: (a) the remedying of scours and, (b) a weight increase in the animals being bred. The board found that, in the light of the patent disclosure, the two effects were linked by the single action of feeding the animals, and that the intention was to obtain both effects at the same time in animals suffering from scours (treatment by therapy) and to prevent the latter complaint in those animals which did not already have it (treatment by prophylaxis). In conclusion, the board was of the opinion that the subject-matter of claims 1 and 2 related to a therapeutic or prophylactic treatment of domestic animals and thus fell within the prohibition on patentability set out in Art. 52(4).

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.

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

In **T 144/83** (OJ 1986, 301) 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 board pointed out that the language of the claim in question "clearly covers a method of cosmetic use and is unrelated to the therapy of a human or animal body in the ordinary sense. This is because loss of weight, like gain of weight, is normally not dictated as a desirable effect by medical considerations at all". On the facts of the case, the board considered that it might be difficult to distinguish between loss of weight to improve bodily appearance (cosmetic treatment) and loss of weight to treat obesity (therapeutic treatment), but that this should not be allowed to work to the disadvantage of an applicant who, according to the wording of his claim, sought patent protection for cosmetic treatment but not for the therapeutic treatment as such. Therefore, the board held that the fact that a chemical product had both a cosmetic and a therapeutic effect when used to treat the

human or animal body did not render the cosmetic treatment unpatentable (see reasons, 4). Art. 52(4) was to be construed narrowly so that it did not disadvantage an applicant seeking patent protection for the cosmetic treatment only. The board went on to state that the invention also complied with the requirements of Art. 57, according to which the invention was to be considered as susceptible of industrial application if it could be made or used in any kind of industry. Enterprises in the cosmetic field - such as cosmetic salons and beauty parlours - were part of industry in the sense of Art. 57, since the very notion of "industry" implied that an activity was carried out continuously, independently and for financial gain (see **T 36/83**).

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

In **T 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 in the claim of the term "non-therapeutic" served as a disclaimer, excluding the therapeutic effects of the medication.

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 was necessarily a method for treating the human (or animal) body by therapy using a pacemaker, and was not patentable. However, if the claim referred to steps which did not define a method of treatment but rather, in functional terms, the structural features of a pacemaker, then the claim did not define a method but rather an apparatus (pacemaker) in terms of the functions of its components. Thus, Art. 52(4) did not prejudice the patentability of the subject-matter of the claim.

2.5 Diagnostic methods

Under Art. 52(4) diagnostic methods practised on the human or animal body are also excluded from patentability.

In **T 208/83** the board explained that its understanding was that a diagnostic method ought always to contain a reference to the diagnosis to be made. Accordingly, a diagnostic method included not only the method of analysis enabling a specific result to be achieved but also the diagnosis constituting the result of the analysis. Since the claimed process quite simply did not include any reference to the diagnosis as the result of an analysis, it could not relate to a diagnostic method within the meaning of Art.52(4) (see **T 61/83**, **T 385/86**, **T 18/84** and **T 45/84**).

In **T 385/86** (OJ 1988, 308) the invention was concerned with a method for determining chemical and/or physical conditions inside a living animal or human body using magnetic resonance. The board ruled that the only diagnostic methods to be excluded from patent protection were those providing results which immediately enabled a decision to be taken

on a particular line of medical treatment, ie methods containing all the steps required to make a medical diagnosis. Methods providing only interim results were thus not diagnostic methods within the meaning of Art. 52(4), first sentence, even if they could be utilised in making a diagnosis.

The board further ruled that where the facts showed a particular subject-matter to be covered by the first sentence of Art. 52(4), both the examination (measurement of actual value) and the establishing of symptoms on the basis of the examination results - ie the deviation measured from the norm - had to be carried out on a living human or animal body. The board thus had to determine whether the temperature measured as claimed in claim 1 or the pH value measured as claimed in claim 2 was directly readable from parts of the body. It found that the measures described in independent claims 1 and 2 resulted in a measured value only visible outside the body in the high-resolution resonance spectrum that appeared on a screen or plotter page in the final stage of the diagnostic apparatus. The data on temperature and pH value thus obtained were therefore visible on a data carrier detached from the body only after further technical measures which took place outside the body. Any further step, which as a result of comparison with a norm revealed an abnormal deviation, did not require the patient's presence. The board therefore held that neither the features described in claim 1 nor those in claim 2 defined a method "practised on the human body" (confirmed in **T 83/87** and **T 400/87**).

Equally, in **T 400/87** the invention was concerned with a method of deriving image information from an object using nuclear magnetic resonance signals. The board found that the measures described in claim 1 resulted in diagrams which showed a two-dimensional spin-density distribution in selected planes. A possible deviation from the norm was discerned from these diagrams and not from the human or animal body itself. For these reasons, the board came to the conclusion that the object of claim 1 did not represent a diagnostic method within the meaning of Art. 52(4), first sentence.

In **T 775/92** each independent claim contained the following introductory clause: "A method for providing bone densities ... for the evaluation of an X-ray photograph of a bone, comprising the steps of: ...". The board discussed whether a diagnostic method had thereby been claimed. It took the view that the expression "evaluation of an X-ray photograph" in the said paragraphs was so vague and general that it could also cover diagnosis. The expression could be interpreted as meaning that the final data distributions of bone densities according to the claimed steps were evaluated by a doctor, for example, by comparing these distributions with model distributions in order to find out the status of a client with regard to ageing or bone diseases. Such an evaluation would not only provide interim results, but would also localise a deviation from a particular clinical picture and thus allow the doctor to start medical treatment. Such an interpretation meant that the subject-matter of all the claims would qualify as diagnostic methods, thus falling within the field identified by Art. 52(4).

2.6 Methods not susceptible of industrial application

Methods of contraception are not excluded *per se* from patentability under the EPC (**T 74/93**). However, in **T 820/92** (OJ 1995, 113) the question as to the circumstances under which a method for preventing pregnancy might be claimed was left open (see p. 35).

In **T 74/93** (OJ 1995, 712) the claimed invention related to alicyclic compounds and their contraceptive use. The **product** claims and a claim for the **process** of preparation of a contraceptive composition by formulating the claimed compounds with a non-toxic carrier

were not objected to. However, the application was refused by the examining division because claim 5, which was directed to the use of a contraceptive composition (eg a cream) comprising these compounds for applying to the cervix of a female capable of conception, was not susceptible of industrial application as required by Art. 57 in so far as the compound was to be applied to the cervix of a human female. The board took the view that a method of contraception was not excluded *per se* from patentability under the aspects of industrial application as stipulated in Arts. 57 and 52(4), first sentence. Pregnancy was not an illness and therefore its prevention was not in general therapy according to Art. 52(4). However, it was not sufficient for such methods to be susceptible of industrial application in general. Rather, the invention as claimed in the specific case had to fulfil the requirement of Art. 57. The board held that a method of contraception which was to be applied in a woman's private and personal sphere was not susceptible of industrial application. The fact that for some women contraception was connected with professional activities did not give an act which was in essence private and personal an industrial character. The board stressed that this did not apply to contraception in general but to the specific type of application of a composition as claimed in claim 5.

B. Exceptions to patentability

1. Introduction

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

Decision **T 49/83** (OJ 1984, 112), concerned a patent application for propagating material, treated with chemical agents, for certain genera of plants, first established the general principle that “no general exclusion of inventions in the sphere of animate nature can be inferred from the EPC”, with reference to Art. 52(1), Art. 53(b), R. 28 and R. 28a.

Concerning the genetic manipulation of animals, the board stated in **T 19/90** (OJ 1990, 476) that in such cases there are compelling reasons to consider the implications of Art. 53(a) in relation to the question of patentability, that is, whether the invention is contrary to “ordre public” or morality.

The boards of appeal also established the general principle that Art. 53(b), which prohibits the patenting of plant or animal varieties or essentially biological processes, is an exception to the general rule under Art. 52(1) that European patents shall be granted for any inventions which are susceptible of industrial application, are new, and involve an inventive step. Like any exception to a general rule of this kind, the exceptions must be narrowly construed (decisions **T 19/90** and **T 320/87**).

2. Inventions contrary to “ordre public”

Decision **T 19/90** was the first 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 it is in precisely such cases that 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.

The issue of morality was again raised in **T 356/93** (OJ 1995, 545). The board emphasised that under Art. 53(a) the relevant question is not whether living organisms are excluded as such but rather whether or not the publication or exploitation of an invention relating to a particular organism is to be considered contrary to “ordre public” or morality. This question must be answered in each particular case on its merits.

The board held that the concept of “**ordre public**” covered the protection of public security and the physical integrity of individuals as part of society. This concept also encompassed the protection of the environment. Accordingly, inventions the exploitation of which was likely to seriously prejudice the environment were to be excluded from patentability. However, the revocation of a European patent under Art. 53(a) would only be justified if the threat to the environment was sufficiently substantiated at the time the decision to revoke the patent was taken by the EPO. In the present case, the evidence provided by the appellant/opponent did not lead to the definite conclusion that the exploitation of the invention would seriously prejudice the environment.

Furthermore, the board pointed out that the patentee might exploit the invention only within the framework defined by national laws and regulations. In this context, the board noted that patent offices, whose function is to grant patents, find themselves side-by-side with regulatory authorities and bodies, whose function is, *inter alia*, to ensure that the exploitation of a given technology, regardless of whether it is protected by a patent or not, takes place within the regulatory framework provided by laws, international treaties, administrative provisions, etc. As the potential risks in relation to the exploitation of a given invention for which a patent has been granted could not be anticipated merely on the basis of the disclosure of the invention in the patent specification, these specialised authorities and bodies had the duty and are in a position to carry out a realistic assessment of the risks.

In the board's judgment, the concept of **morality** was related to the belief that some behaviour is right and acceptable whereas other behaviour is wrong, this belief being founded on the totality of the accepted norms which are deeply rooted in a particular culture. For the purposes of the EPC, the culture in question is the culture inherent in European society and civilisation.

The board also emphasised that, although it may be difficult to judge whether or not a claimed subject-matter is contrary to "ordre public" or morality, the provisions of Art. 53(a) may not be disregarded by the EPO when assessing patentability.

The board came to the conclusion that plant biotechnology *per se* cannot be regarded as being more contrary to public morality than traditional selective breeding. None of the claims of the patent in suit referred to subject-matter which related to a misuse or destructive use of plant biotechnical techniques; they only concerned activities (production of plants and seeds, protection of plants from weeds or fungal diseases) and products (plant cells, plants, seeds) which cannot be considered to be wrong as such in the light of conventionally accepted standards of conduct of European culture.

3. Patentability of animals and animal varieties

Various issues arose for discussion in **T 19/90** (OJ 1990, 476), a case which aroused interest not only among those directly associated with patent law. These issues included the meaning of Art. 53(b), in particular of the term "animal varieties".

The patent application was for a transgenic mouse which, as a result of the introduced gene, showed increased susceptibility to carcinogenic substances. Following **T 320/87**, the board of appeal emphasised the narrow interpretation to be given to the exception to patentability for animal varieties ("Tierarten" / "races animales") under Art. 53(b).

Noting that for animals, unlike plant varieties, no other industrial property right exists, the board stated that the object and purpose of the law ("ratio legis") 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 therefore held that the exception to patentability under Art. 53(b) applies to certain categories of animals but not to animals as such. Thus, product protection can in principle be granted for animals.

Furthermore, it was 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 animal varieties or essentially biological processes for the production of animals under Art. 53(b), first half-sentence, does not extend to the products of a microbiological process.

4. Patentability of plants and plant varieties

Art. 53(b) excludes plant varieties from patentability. The meaning of this term was discussed in **T 49/83** (OJ 1984, 112). The board held that the skilled person understands the term “plant varieties” to mean a multiplicity of plants which are largely the same in their characteristics and remain the same within specific tolerances after every propagation cycle. The board explained that plant varieties are excluded from patent protection under the EPC mainly to avoid double protection in respect of subject-matter capable of protection within the UPOV Convention. It was thus held that Art. 53(b) prohibits only the patenting of plants or their propagating material in the genetically fixed form of the plant variety. Indeed, the very wording of Art. 53(b) before the semi-colon precludes the equation of plants and plant varieties, which would also be at variance with the general sense of the provision.

The board therefore concluded that a claim directed to a propagating material, treated with chemical agents, for certain genera of plants (in this case cultivated plants) without specific varieties being claimed individually does not contravene the prohibition on the patenting of plant varieties in Art. 53(b).

This approach was also adopted in **T 320/87** (OJ 1990, 71), where the board concluded that the hybrid seed in question and plants from it, lacking stability in some trait of the whole generation population, could not be classified as plant varieties within the meaning of Art. 53(b).

In **T 356/93** (OJ 1995, 545) the aim of the invention was to develop plants and seeds resistant to a particular class of herbicides and thus selectively protected against weeds and fungal diseases. In accordance with the revised UPOV Convention (1991), the concept of “plant varieties” was defined as any plant grouping within a single botanical taxon of the lowest-known rank which, irrespective of whether it would be eligible for protection under the UPOV Convention, is characterised by at least one single transmissible characteristic distinguishing it from other plant groupings and which is sufficiently homogenous and stable in its relevant characteristics.

It was further held that a claim is not allowable if the grant of a patent in respect of the invention defined in the said claim is conducive to an evasion of a provision of the EPC establishing an exception to patentability. As the claim in question encompassed plant varieties, it followed that it was only allowable if the exception to patentability concerning plant varieties did not apply because a microbiological process was involved. In fact the board held that the product was not the result of a microbiological process (see 6 below)

As a result, the President of the EPO referred the following question to the Enlarged Board of Appeal on 28.7.1995:

“Does a claim which relates to plants or animals but wherein specific plant or animal varieties are not individually claimed, contravene the prohibition on patenting in Art. 53(b) if it embraces plant or animal varieties?”

In **G 3/95** (OJ 1996, 169), the Enlarged Board of Appeal held that decision **T 356/93** was not in conflict with the findings in either of decisions **T 49/83** or **T 19/90**. Consequently, the referral of the question to the Enlarged Board of Appeal by the President of the EPO was held to be inadmissible under Art. 112 (1) (b).

5. Essentially biological processes

The meaning of “essentially biological processes” under Art.53 (b) was considered in decision **T 320/87** (OJ 1990, 71). The appellant had submitted claims relating to processes for the preparation of hybrid plants. During the appeal proceedings product claims deriving from those processes were also submitted. The board, overruling the examining division, held 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.

Moreover, 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 a trivial level. Furthermore, it is not a matter simply of whether such intervention is of a quantitative or qualitative character.

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

In **T 19/90** the board agreed with the examining division that the process claims for the production of transgenic non-human mammals through chromosomal incorporation of an activated oncogene sequence into the genome of the non-human mammal was not an “essentially biological process” within the meaning of Art. 53(b). The product claim for the genetically-manipulated animal included descendants not directly genetically manipulated themselves but produced by the essentially biological process of sexual reproduction. The board held that this was a product claim defined in terms of the process by which it was produced and that a product-by-process claim remains a product claim 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.

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

6. Microbiological processes and the products thereof

In **T 356/93** the board defined the term “micro-organism” as including not only bacteria and yeasts, but also fungi, algae, protozoa and human, animal and plant cells, ie all generally unicellular organisms with dimensions beneath the limits of vision which can be propagated and manipulated in a laboratory, including plasmids and viruses. Accordingly,

the board interpreted the term “microbiological” as qualifying technical activities in which direct use is made of micro-organisms.

The board thus defined the concept of “microbiological processes” under Art. 53(b) as processes in which micro-organisms are used to make or modify products or in which new micro-organisms are developed for specific uses.

The particular plant claimed was produced by a **multi-step** process which, in addition to the initial microbiological process step of transforming plant cells or tissue with recombinant DNA, comprised the step of regenerating plants from the transformed plant cells or tissue and the step of reproducing the plant material. The board held that the plant was not the product of a microbiological process - although the initial microbiological process step undoubtedly had a decisive impact on the final result, the claimed plant was not merely the result of this (microbiological) initial step, but also of the subsequent series of relevant agrotechnical and biological steps.

A claim directed to transformed plant cells, however, was allowed. The board took the view that plant cells as such, which modern technology allowed to culture like bacteria and yeasts, cannot be considered to fall under the definition of a plant or a plant variety. They can be considered to be “microbiological products” in the broad sense under the current practice of the EPO.

C. Novelty

1. State of the art

1.1 Abstracts as state of the art

In **T 160/92** (OJ 1995, 35) the appellant objected to the fact that the examining division had based its judgment on whether the claimed subject-matter involved an inventive step on an abstract of a Japanese patent document without introducing the original document and citing specific passages from it. With respect to the question of citability of an abstract, the board held that the teaching of a previously published abstract of a Japanese patent document, considered *per se* without its corresponding original document, formed *prima facie* part of the prior art and might be legitimately cited as such if nothing on the file pointed to its invalidity. The party intending to contest the validity of said teaching on the basis of the original document's teaching had the burden of proof. As to whether or not citing the abstract, without the original document from which it was taken, was permissible or constituted a procedural violation, the board noted that it had to be considered whether the statement based on such an abstract alone could be regarded as reasoned within the meaning of Rs. 51(3) and 68(2). In the case in question, the abstract provided certain information and, for the skilled reader, there was no indication that such information was invalid. The examining division's line of reasoning was complete and understandable.

1.2 Background art

In **T 654/92** the board noted that the English version of R. 27(1)(b) requires an applicant to "indicate the background art which, as far as is known to the applicant, can be regarded as useful for understanding the invention...". In this rule the expression "background art" was, in the board's view, to be interpreted as background prior art, ie art within the meaning of Art. 54(2). This was the only reading consistent with the French and German versions of the rule, which referred to "l'état de la technique antérieure" and "bisherige Stand der Technik" respectively. The practice of starting out from art which was known to the applicant but which was not public at the claimed priority date was accordingly inconsistent with the requirements of the EPC.

1.3 Documents published during the priority interval

The Enlarged Board decided in **G 3/93** (OJ 1995, 18) that a document published during the priority interval (ie during the interval between the filing of the first priority document and the filing of the (final) European patent application), the technical contents of which corresponded to that of the priority document, constituted prior art citable under Art. 54(2) against a European patent application claiming that priority, if such priority was not validly claimed. This also applied if a claim to priority was invalid due to the fact that the priority document and the subsequent European application did not concern the same invention because the European application claimed subject-matter not disclosed in the priority document.

1.4 European prior rights

Under Art. 54(3) and (4) the state of the art comprises the content of other European applications filed earlier than, but published under Art. 93 on or after the date of filing of

the application being examined, to the extent that the earlier and later applications designate the same state or states.

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

In **T 447/92** an earlier European patent application designated the same contracting states as the opposed patent. The whole contents of this earlier document within the meaning of Art. 54(3) and (4) had therefore to be considered as forming part of the state of the art as far as novelty was concerned. As regards the alleged lack of novelty, it was necessary to investigate whether all the features of the air circuit breaker according to claim 1 were unambiguously disclosed in the earlier European patent application. The board pointed out that the boards of appeal had consistently applied a very restrictive interpretation of disclosure in order to reduce the risk of self-collision. To do otherwise would, in the board’s view, undesirably undermine the exclusion from consideration of documents within the meaning of Art. 54(3) when deciding whether there had been an inventive step under Art. 56, second sentence.

1.5 PCT applications as state of the art

An international application for which the European Patent Office is a designated Office is considered as comprised in the state of the art in accordance with Art. 54(3) if and from the time it has been filed at the EPO in an official language and the national fee has been paid (Art. 158(2) and (3)). This effect applies to European patent applications only in so far as the same states are designated (Art. 54(4)).

In **T 404/93** the European patent application was limited to the contracting states IT, NL and SE in view of an earlier international application, published after the filing date of the former. The board noted that the earlier PCT application had mentioned several EPC contracting states, including IT, NL and SE, as being designated for a European patent. However, when the earlier application had entered the European phase, no designation fees had been paid for IT, NL and SE. Accordingly, the board found that the earlier international application was not comprised in the state of the art under Art. 54(3) for IT, NL and SE.

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

1.6 Excluded national prior rights

In **T 550/88** (OJ 1992, 117) (see p. 300) the board made it clear that, on the proper interpretation of Art. 54(3), prior national rights were **not** comprised in the state of the art, and only prior filed European patent applications made under the EPC (and published on

or after the filing date of a European patent application) could be considered as comprised in the state of the art under Art. 54(3). As to the references to Part VIII of the EPC made by the appellants, the board found that they rather confirmed that the effect of a prior national right upon a European patent was a matter purely for national law, whereas the effect of a prior European application upon a European patent was specifically provided for in Art. 54(3) (which might also be a ground for revocation under national laws by virtue of Art. 138(1)(a)). In other words, the combined effect of Arts. 138(1) and 139 was to provide an additional possible ground for revocation under national laws based upon the existence of a prior national right, which was not available under Art. 54.

In the board's view, it was clear that the wording of Art. 54(3) was intended deliberately to exclude national applications from having the prior art effect therein stated in respect of a European patent. At the time the EPC had entered into force it had still been uncertain whether the national laws of contracting states would include the same prior right effect as set out in Art. 54(3). The national law in Switzerland provides for a different prior right effect ("prior claim") from that set out in Art. 54(3) ("whole contents"). The omission of prior national rights from Art. 54(3) had been made in the context of such international uncertainty. The board went on to note that if Art. 54(3) were to include prior national rights, the result would be a legal inconsistency particularly so far as Switzerland was concerned, having regard to Art. 139(2): in an opposition to a European patent before the EPO in which a national prior right was relied upon under Art. 54(3), the conflict would be resolved in accordance with the "whole contents" system of Art. 54(3), whereas in revocation proceedings under national law in Switzerland in respect of the European patent the same conflict would be resolved pursuant to Art. 139(2) in accordance with the prior claim system (Swiss Patent Law, 1954, as amended in 1976 and in force since 1 January 1978, Art. 7a).

2. Disclosed content of prior publications

2.1 General issues

A prior art document anticipates the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document.

In **T 450/89** the board stated that it was of fundamental importance for the determination of the issue of novelty that a conclusion of lack of novelty not be reached unless the prior document contained a **clear and unmistakable** disclosure of the subject-matter of the later invention. Similarly, in **T 511/92** the board agreed with the Guidelines (C-IV, 7.2) which state that a document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document, stressing the importance of the words "derivable directly and unambiguously". In **T 677/91** the board held that the features in question in a prior document had to contain a clear and unmistakable teaching of the claimed features. In **T 465/92** (OJ 1996, 32) the board reached the conclusion that the disclosure of a prior art document was too vague and unspecific to amount to a clear and unmistakable disclosure of the claimed subject-matter.

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

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

In **T 332/91** the appellant (opponent) disputed the novelty of the subject-matter of a claim in the light of the disclosure of a cited document on the basis of earlier decision **T 666/89** (OJ 1993, 495), according to which it was necessary to consider the whole contents of a citation, ie its express and implicit technical teaching, when deciding the question of novelty. Although the appellant in this case admitted that the amount of activator as claimed was not explicitly disclosed in the cited document, it contended that the skilled addressee, reading the document in the light of his common general knowledge, would have immediately understood that the claimed amounts were those normally used. However, the appellant, on whom the burden of proof rested, did not provide any evidence that the amounts of activator as claimed would have been usual in detergent compositions of the type claimed. The board thus rejected the appellant's allegations of lack of novelty.

In **T 164/92** (OJ 1995, 305; Corr. OJ 1995, 387) the board decided that the disclosure of a publication was determined by what knowledge and understanding could and might be expected of the average skilled person in the technical field in question. In this case, the opponent had alleged prior public use of a program. Appendix J to a particular prior art document contained program listings which did not, however, explain the programs in normal language. The opposition division considered the disclosure to be insufficient as the skilled person would not necessarily have any knowledge of programming. The board observed that sometimes the average skilled person in electronics, particularly if he did not have an adequate knowledge of programming languages himself, might be **expected to consult** a computer programmer if a publication contained sufficient indications that further details of the facts described therein were to be found in a program listing attached as an annex thereto. In the oral proceedings the respondent had further maintained that, according to the Guidelines (C-II, 4.14a), examiners were evidently not to be burdened with the search and examination of programs. In this respect, the board came to the conclusion that it might consider a citation which was partly written in a programming language if it was available to the EPO at the search or examination stage, and the Office was equipped to perform such a search or examination (see also **T 582/93**).

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

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

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

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

In **T 310/88** the board of appeal had to consider a **discrepancy** between what actually happened in practice when carrying out a technical teaching in a prior document according to the letter of its description, and what this prior document said would happen. According to the description in the prior document a particular component was not present, whereas the presence of this component was essential for the later invention. However, in practice, when following the teaching of the prior document literally, this component would be present. The board held that the invention was novel over the prior document because the latter did not contain a sufficiently clear teaching for that conclusion not to be reached. The skilled person, by following the document’s teaching, was led in a direction clearly pointing him away from the claimed subject-matter because it stated that the composition obtained did not comprise a component contained in the claimed compound. The subject-matter was new even if by reproducing the examples described in the prior document a skilled person would inevitably obtain a composition corresponding to the composition claimed and comprising the specific component. According to the board, the teaching of the prior document had to be interpreted as meaning that further steps would be needed to eliminate the additional component.

In **T 666/89** (OJ 1993, 495) the board observed that Art. 54(2) defined the state of the art as comprising “everything made available to the public by means of written or oral description, by use or in any other way”. The term “available” clearly went beyond literal or diagrammatical description, and implied the communication, express or implicit, of technical information by other means as well. One example of the available information content of a document extending beyond this literal descriptive or diagrammatical content was the case where the carrying out of a process, specifically or literally described in a prior art document, inevitably resulted in a product not so described. In such a case, the board stated, the prior art document would deprive a claim covering such a product of novelty. It was thus content, express and implied, rather than mere form, that was decisive for the issue of novelty in general, and “selection” novelty in particular.

In **T 624/91** it was held that exact disclosures for alloy compositions in the state of the art had to be interpreted as average or nominal values within a small range in view of known fluctuations in reproducibility and in analytical results, unless there was evidence available to the contrary. The board pointed out that whenever a metallurgist aimed at producing an

alloy in accordance with a given nominal composition, the composition of the final product would deviate somewhat from this target or even be undefined within certain narrow limits. The metallurgical production process was not ideally reproducible and the actual composition of different batches aiming at the same nominal composition would be spread over a certain area around this target. Consequently, the nominal composition of a cited alloy not only disclosed the composition as a specific point which nobody would be able to realise in practice, but also a certain range around this average or nominal composition into which the majority of the analyses of those alloys fell which had been prepared aiming at the nominal composition and using the care usual in this art when producing and analysing an alloy.

2.2 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 (see **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 held that the “whole contents” of an earlier document did not also comprise features which were equivalents of features in the later document.

2.3 Entire disclosure of a prior art document

According to the consistent case law of the boards of appeal the information available from a document has to be established on the basis of the entire disclosure.

In **T 124/87** (OJ 1989, 491) the board stated that Art. 54(1) did not allow what already formed part of the state of the art to be patented. When part of the state of the art was a written document, what had to be considered was whether the disclosure of the document as a whole is such as to make available to a skilled man as a technical teaching the subject-matter for which protection was sought in the claims of the disputed patent.

In decision **T 56/87** (OJ 1990, 188) the board emphasised that the technical disclosure in a document should be considered in its entirety, as it would be by a person skilled in the art, and that there could be **no** justification for arbitrarily **isolating parts** of the document in order to derive therefrom an item of technical information which would be distinct from or even contradict the integral teaching of the document. Therefore, the board considered that a particular feature relating to the positioning of the outer electrodes of a transmission ion chamber, in such a way that they partially lay in the shadow of a collimator, for implementing a process for correcting alignment errors of a divergent beam of rays, was not disclosed in a prior art document which, however, contained a figure in which such positioning could be identified. The reason was that the figure in question was obviously

a schematic illustration showing neither the proportions nor the dimensions of the actual apparatus. In order to be able to interpret it correctly, the skilled technician therefore had to refer to the other figures and to the written description of the document; he would have deduced from the latter, however, that the outer electrodes should be positioned entirely in the radiation field, and not partially in the shadow of the collimators, as set out in the claims examined (see **T 441/91**; **T 657/92**, **T 332/87**).

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

In **T 969/92** a prior document disclosed a surgical fastening system comprising all the features specified in the pre-characterising portion of claim 1 of the application. The board, however, held that this document did not anticipate a characterising feature of claim 1, namely, that each connection between two adjacent receivers comprised a plurality of parallel linkages. Claim 1 of the prior document read as follows : "each of said retainer members being connected by at least one such link to at least one other retainer member so that all the retainer members are connected to each other to form a unitary assembly" (the terms "retainer member" and "link" used in the document were synonymous with the terms "receiver" and "linkage", respectively, used in the application). According to the board, this statement could be interpreted to mean that each connection consisted of at least one link, the consequence being that the feature of claim 1 of the application that each connection between two adjacent receivers comprised a plurality of parallel linkages fell within the scope of the quoted general statement in the prior document. However, in the board's view, this did not mean that the aforementioned feature of claim 1 concerning the plurality of linkages per connection had been made available to the public by the prior art document within the meaning of Art. 54(2). The board decided that in order to determine what had been made available to the public, not only the main claim but also the **remainder** of a document had to be carefully considered for guidance as to what had really been taught in the prior document, ie its real express and implicit information content.

Likewise, in **T 500/89** it could only be seen from the disclosure considered in its entirety that the prior art document did not cause lack of novelty, because the method constituting the closest prior art differed from the claimed method in one functional characteristic. The disputed patent related to a method for the production of photographic material by the simultaneous application of several layers of fluid photographic coating materials. Although the document cited in support of the opposition listed the numerical ranges for layer thickness, viscosity, coating speed, etc; used in the method claimed, the latter was nevertheless held to be new because the cited document described the choice of these numerical ranges as leading to intermixing between two particular layers. The contested patent was to be assessed according to a different criterion because it described the application of the layers as being "substantially free from intermixing". The "intermixing" described as an objective in the citation was not merely a stated purpose not constituting one of the technical features of the method described, but a functional feature - a criterion, in effect - forming an essential element of the teaching set out in this publication.

2.4 Disclosure by means of drawings

The EPC does not exclude the possibility that in the course of opposition proceedings followed by an appeal the claims of a European patent which in accordance with Art. 123(3) do not extend the protection conferred may be limited by the fact that specific features referred to in the claims are clearly shown in the drawings originally filed and are clearly, unmistakably and fully derivable from the drawings in terms of structure and function by a person skilled in the art and so relatable by him to the content of the description as a whole as to be manifestly part of the invention (**T 169/83**, OJ 1985, 193).

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

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

In **T 56/87** (OJ 1990, 188) (see p. 51 above) the board held that a technical feature which was derived from or based on dimensions obtained from a diagrammatic representation and which technically contradicted the teaching of the description, did not form part of the disclosure of a document.

2.5 Disclosure by means of examples

In **T 651/91** the board cited the Guidelines (C-IV, 7.4) with approval, confirming that a **generic disclosure** did not normally take away the novelty of any **specific example** falling within that disclosure. The board further added that a disclosure could be generic even where it only left open the choice between two alternatives. In **T 508/91** the board, citing the same paragraph of the Guidelines, held that, on the other hand, the prior disclosure of the subset "vegetables" took away the novelty of the wider set "fruits and plants".

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

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

In **T 290/86** (OJ 1992, 414) the board decided that what was "made available to the public" by specific detailed examples included in a document was not necessarily limited to the

exact details of such specific examples but depended in each case upon the technical teaching which was “made available” to a skilled reader. The amendment of a claim by including a disclaimer in respect of such specific detailed examples could not render the claim novel.

In **T 12/81** (OJ 1982, 296) the board held that the teaching of a cited document was **not** confined to the detailed information given in the examples of how the invention was carried out but embraced any information in the claims and description enabling a person skilled in the art to carry out the invention (see **T 562/90**). In **T 424/86** the board stated that the disclosure of a document was not to be construed only on the basis of the examples thereof; rather, the entire document had to be taken into consideration. In **T 68/93** the board stated that it was not allowable to take a particular example out of context. In

, the board decided that the disclosure in a prior document likely to affect the novelty of a claim was not necessarily limited to the specific working examples but also comprised any reproducible technical teaching described in the document (see also **T 658/91** and **T 247/91**).

2.6 Disclosure - difference in wording

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

In **T 198/84** (OJ 1985, 209) the board stated that the purpose of Art. 54(1) was to prevent the state of the art from being patented again (see **T 12/81**, OJ 1982, 296). Since novelty was an absolute concept, a definition of an invention which differed only in its wording was insufficient; what had to be established in the examination as to novelty was whether the state of the art was likely to reveal the content of the invention’s subject-matter to the skilled person in a technical teaching.

2.7 Accidental disclosure

In **T 161/82** (OJ 1984, 551) the reason given by the examining division for the refusal was that the subject-matter of the claim lacked novelty having regard to a prior art patent document. The board found that the prior art document was concerned with the solution of a **problem** totally **different** from that stated in the application at issue and concluded that in cases where an anticipation was of a **chance nature**, in that what was disclosed in a prior document could **accidentally** fall within the wording of a claim to be examined for novelty without there being a common technical problem, a particularly careful comparison had to be made between what could fairly be considered to fall within the wording of the claim and what was effectively shown in the document.

T 601/92 concerned “accidental anticipation”. The invention claimed was a radial ventilator, characterised in that the ventilator wheels were mounted on the ventilator shaft

and offset against each other in such a way that the spokes of one ventilator wheel, viewed in the direction of the axle, were arranged opposite the gaps between the spokes of the other ventilator wheel. The prior art comprised fans, during the assembly of which no attention was paid to the angle of rotation of the spokes of the two ventilator wheels in relation to each other. The probability that such fans, which coincidentally had the spoke arrangement claimed, had been sold was extremely high. The board held that this was evidence of an anticipatory prior use of the claimed product, stating that in the case of anticipation of a chance nature where there was no common technical problem, particular care had to be taken when considering what could be deemed to be part of the claim and what was derived from the prior publication. In contrast to **T 161/82** (OJ1984, 551), in which the claimed subject-matter was also structurally the same as the prior subject-matter, but had a different function, there was no recognisable difference in function in this case. **T 208/88** (OJ 1992, 22) was not comparable since in the present case a product was claimed and not a new possible use for a known substance based on a previously unknown effect or function of that substance.

The auxiliary request related to a process for manufacturing low-noise radial ventilators, characterised in that the ventilator wheels were systematically mounted on the ventilator shaft and offset against each other in such a way that the spokes of one ventilator wheel, viewed in the direction of the axle, were arranged opposite the gaps between the spokes of the other ventilator wheel. In the board's view this claim was clearly delimited from the prior art by the feature "systematically". This feature clearly referred to a procedural step and could acquire significance as a substantial distinguishing feature vis-à-vis the prior art only within a process claim. The fact that the claim for a manufacturing process contained predominantly product features was a logical consequence of the close connection between product and process and did not prevent the claim from being allowed.

2.8 Relevant point of time

The boards of appeal have dealt with the question of the correct date for the interpretation of a prior document when determining novelty.

In the case of a prior document according to Art. 54(3), the board held in **T 233/90** that only the actual content of a prior document as it would have been understood by a skilled person on its effective date could cause lack of novelty. The effective date was the date of filing or the priority date of the said document.

In the case of a previously published document most of the cases decided by the boards of appeal in this respect found, with one exception, that the disclosure of the prior document had to be determined as at the date of publication of that document.

In **T 205/91** the board substantiated its view as follows: "Following the practice adopted to date by the European Patent Office, the board takes the view that, for determining the disclosure of a document belonging to the state of the art within the meaning of Art. 54(2), what counts is that document's publication date. The interpretation of a document using knowledge that did not become available to persons skilled in the art until sometime between the date of publication of the cited prior art and the date of filing or of priority [of the later document] is of no relevance in determining the disclosure of the prior document for the purpose of assessing novelty but applies to the evaluation of inventive step."

In **T 677/91** the appellant (opponent) maintained that the document cited as anticipating the patent should be interpreted as at the priority date of the patent in suit (1982). The

respondent (the patent proprietor), on the other hand, contended that it should be interpreted as at its publication date of 1968 when assessing novelty. The board held that, when considering whether a prior document disclosed the technical features of a claim, the disclosure of the prior document had to be determined as at the date of publication of that document. The disclosure of a document did not change from time to time. The technical content of a document was what was disclosed to a skilled person at the time it was written and published. In contrast, whether the technical features of a claim were obvious in view of a prior document had to be determined as at the filing date of the claimed subject-matter.

In **T 229/90** the board stated that when the question of novelty was considered, a prior document had to be interpreted in the light of common general knowledge available at its publication date. Common general knowledge which did not exist at this date but which only became available at a later date could not be used to interpret such a document.

In **T 74/90**, however, the board of appeal adopted a different approach to the question. In considering the disclosure of a cited prior art document, the board found it necessary to decide how the person skilled in the art at the filing or priority date of the patent in suit would have interpreted it. **T 74/90** illustrates the application of this principle. 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 had to 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 cause lack of novelty. The board pointed out that in this 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.

2.9 Implicit disclosure and inventive step

In decisions **T 572/88** and **T 763/89** the boards warned against using the concept of "implicit prior description" in such a way that considerations relevant to the evaluation of inventive step were transferred to the assessment of novelty. A fair assessment of an invention's patentability called for a clear distinction between novelty and inventive step. In decision **T 763/89** (see also p. 76), for example, the opponent could not claim "implicit prior description" for a material with exactly three layers, as claimed in the disputed patent, on the grounds that a skilled person, aware of the considerable outlay required for further sub-layers and the limited improvement in the quality of the image they bring, would have understood the wording of the claim, which set no upper limit for the number of layers,

to be virtually synonymous with "two or three layers". To do so would be to adduce a typical criterion for the evaluation of inventive step.

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

2.10 Enabling disclosure

The boards of appeal will only assume that a prior art document causes lack of 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 could only be regarded as being disclosed in a particular document if it had been "made available to the public" within the meaning of Art. 54(2). In the field of chemistry this requirement was satisfied if, for instance, a reproducible method was described in the same document. In particular, it was found that a document (in this case a co-pending European application) did not effectively disclose a chemical compound, even though it stated the structure and the steps by which it was produced, if the skilled person was unable to find out from the document or from common general knowledge how to obtain the required starting materials or intermediates. Information which could only be obtained after a comprehensive search was not to be regarded as part of common general knowledge. This need for an enabling disclosure was also in conformity with the principle expressed in Art. 83 for patent applications which had, accordingly, to "disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art". The requirements as to the sufficiency of disclosure were, therefore, identical in all these instances.

In **T 952/92** (OJ 1995, 755) (see p. 67) the board held that the information as to the composition or internal structure of a prior sold product had been made available to the public and became part of the state of the art within the meaning of Art. 54(2) if direct and unambiguous access to such information was possible by means of known analytical techniques which were available for use by a skilled person before the relevant filing date. The likelihood or otherwise of a skilled person analysing such a prior sold product and the degree of burden (ie the amount of work and time involved in carrying out such an analysis) were in principle irrelevant to the determination of what constituted the state of the art. A claim was deprived of novelty if an analysis of a prior sold product was such as to inform the skilled person of an embodiment of the product which fell within the claim.

For selection inventions (see p. 70) 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 could only be regarded as having been made available to the public in so far as the information given to the person skilled in the art was sufficient to enable him to practise the technical teaching which was the subject of the disclosure, taking into account also the general knowledge in the field to be expected of him.

In this particular case, the ranges of a certain parameter as defined in the claim fell within the broader ranges stated for the same parameter in a prior art document. According to the above-mentioned conclusion, the board considered that a realistic approach when assessing the novelty of the invention under examination over the prior art in a case where overlapping ranges of a certain parameter existed would be to consider whether the person skilled in the art would, in the light of the technical facts, **seriously contemplate**

applying the technical teachings of the prior art document in the range of overlap; if it could be fairly assumed that this would be the case, it had to be concluded that no novelty existed. Such was not the case in the matter under consideration, since there existed in the prior art a reasoned statement clearly dissuading the person skilled in the art from using the range under a certain value, and the range of overlaps was under this value; the claimed range was therefore considered novel.

2.11 Mistakes in a disclosure

One cannot rely on a mistake in a prior art document as depriving subsequently claimed subject-matter of patentability. In **T 77/87** (OJ 1990, 280) the abstract published in the journal "Chemical Abstracts" did not correctly reproduce the original paper. The board stated that the original document was the primary source of what had been made available as a technical teaching. Where there was a substantial inconsistency between the original document and its abstract, it was clearly the disclosure of the original document that had to prevail. The disclosure in the original document provided the strongest evidence as to what had been made available to the skilled person. When it was clear from related, contemporaneously available evidence that the literal disclosure of a document was erroneous and did not represent the intended technical reality, such an erroneous disclosure should not be considered part of the state of the art.

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

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

2.12 Combinations within a prior art document

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

- admissible to piece together artificially a more relevant state of the art from features belonging to one or both of these entities, even if they were both disclosed in one and the same document (see **T 901/90**).

In **T 931/92** the board took the view that different alternative embodiments described in the same citation should not normally be combined with each other to produce a new object which could be cited as prejudicial to novelty, unless such a combination was explicitly mentioned in that citation. If that were the case, the new object would also have to be sufficiently complete for it to be cited against the subject-matter of the contested claim without any need for additional reconstruction.

In **T 42/92** the board followed established board of appeal case law in ruling that the disclosed content of an earlier published patent specification viewed as representing the state of the art pursuant to Art. 54(2) only comprised those features that a person skilled in the relevant technical discipline would derive from - and regard as consistent with - the document as a whole. It did not however comprise groups of **individual features** that had been obtained by linking claims in the light of their dependencies, which individual features - for reasons of patent law - had been claimed in **separate claims** and the grouping of which either found no support in the description or even - as in this case - was inconsistent with the embodiments contained in the description.

In **T 739/93** the board ruled that in assessing novelty the technical content of a prior document ought to be considered in its entirety and also had to be interpreted as it would be by a person skilled in the art. Only, according to board of appeal case law, the skilled person had to draw a clear line between the teaching which was, for him, unquestionably derivable from the prior document, without involving any changes thereto, and what he could imagine or consider obvious from such teaching. Novelty could only be assessed within the former, more restrictive limits. It was therefore not permissible to combine with each other different methods of execution or technical information, taken out of context, from the same prior document if that document did not inform the skilled person that such a combination was conceivable.

In **T 291/85** (OJ 1988, 302) the board noted that the disclosure in a prior publication always included not only what it presented as the teaching of the invention but also what it referred to as the prior art. In the board's view, however, when examining for novelty, to read into an account of the state of the art couched in very general terms specific details of the inventive teaching of the same document was permissible only where a person skilled in the art would in fact have made this combination when reading this document. This would, for instance, be the case if a source were to be cited for the prior art described and a specific, relevant disclosure could be derived from the original document, or if the description of the prior art referred directly to the appropriate passage in the description of the invention. Combining a specific feature from the description with the general description of the prior art in this way might in certain circumstances be obvious to a skilled person merely in the light of his general technical knowledge. In the absence of such or similar circumstances, however, one could not, in the board's view, assume that a skilled person would necessarily have derived from the document a teaching based on a combination of this kind. Thus, the board concluded that if a citation gave detailed information about a further development of a prior art described only in very general terms without quoting a specific source, it was not permissible in examining for novelty to combine these **general statements** with the **specific statements** made solely in order to explain the said development unless a person skilled in the art would have made the combination when reading the citation.

In **T 332/87** the board held that when examining novelty, different passages of one document might be combined provided that there were no reasons which would prevent a skilled person from making such a combination. In general, the technical teaching of examples might be combined with that disclosed elsewhere in the same document, eg in the description of a patent document, provided that the example concerned was indeed representative of or in line with the general technical teaching disclosed in the respective document. In the case at issue, the board concluded that a particular composition in an example was not in agreement with the general technical teaching of the prior art document and that in view of this discrepancy the skilled person would not have combined the said disclosure with said example.

2.13 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 cause lack of novelty. It was not permissible to “combine” separate items of prior art. However, in a case where a document referred to “a usual manner” of preparing a product, it was permissible to use documents of reference such as handbooks, encyclopaedias or dictionaries in order to determine what the skilled person would have understood by such a reference on the effective date of the prior document.

In **T 153/85** (OJ 1988, 1) the board held that when assessing novelty, the disclosure of a particular prior document always had to be considered in isolation; in other words it was only the actual content of a document (as understood by a skilled person) which caused lack of novelty. It was not permissible to “combine” separate items of prior art. The board, however, found that where there was a specific reference in one prior document to a second prior document, when construing the first document (ie determining what it meant to the skilled person) the presence of such a specific reference might necessitate part or all of the disclosure of the second document being considered as part of the disclosure of the first document (see **T 645/91**; **T 942/91**; **T 422/92**).

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).

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

3. Availability to the public

Under Art. 54(2) everything made available to the public prior to the filing date of the European patent application causes an invention to lack novelty. How this is done is immaterial, although prior public use plays a key role as it raises specific problems in terms of both substantive and procedural law. However, the notion of availability to the public is the same for prior public use as for any other form of disclosure of an invention.

3.1 The concept of “the public”

(a) General principles

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 said 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**, **T 969/90** and **T 462/91**).

On the other hand, in **T 300/86**, the board took the view that the fact that the report of the invention was passed on 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 (see also **T 406/92**). Also in **T 228/91** the board likewise held that even a limited number of individuals attending a course can represent the public if they were not bound by an obligation to maintain secrecy.

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

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

(b) Obligation to maintain secrecy

If the person who was able to gain knowledge of the invention was under obligation to maintain secrecy, the invention cannot be said to have been made available to the public. Here again the same rules apply regardless of how the invention is disclosed, although the

problem is encountered more frequently where prior public use is claimed than with other kinds of prior published art.

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

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

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

Case law tends to regard pre-sale negotiations as obliging those involved to maintain secrecy:

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

A similar situation was faced in **T 887/90**, where the alleged prior public use hinged on the submission of two quotations, each of which had involved a series of technical discussions with the potential customers. The quotations had not been for finished products, but for systems requiring adjustments to the clients' requirements. The drawings, without which the quotations would have been meaningless, bore clear references to Section 18 of the German law prohibiting unfair competition which had been noted by the clients. The board took the line that an obligation to maintain secrecy was clear from the circumstances. The recipients of the quotations had no discernible reason for passing on the contents of the quotation to third parties and hence for choosing to ignore the references on the drawings. Simply to claim that no mention had been made of any obligation to maintain secrecy was insufficient to invalidate the assumption that there had been an implicit agreement to maintain secrecy. Nor was the fact that sales representatives had also been present enough to prove the contrary.

In **T 634/91** the claimed prior public use consisted of the presentation of a circular saw at

an opponent's place of business during a meeting between the patent proprietor and a potential buyer. Without elucidating further, but referring to the decision in **T 830/90** (OJ 1994, 713), the board held that such talks constituted a tacit understanding to maintain secrecy. Availability to the public was something that had to be proved conclusively.

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

In **T 799/91** the existence of an obligation to maintain secrecy was derived from the circumstances. The opponents asserted that the subject-matter claimed had been in prior public use in that its manufacture had been "sub-contracted out" to a third company. They produced a witness prepared to testify that this third company had had knowledge of the device without there having been any agreement to maintain secrecy. While ruling in favour of the opponents, the board held that prior public use presupposed that members of the public, ie any third party, had gained knowledge of the subject-matter in question. The third company was not any third party because the opponents' decision to place an order was based on a relationship of trust. The board therefore saw no indication of there having been prior public use, nor could the claim have been substantiated by the testimony of the witness.

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

In **T 1076/93** the opponents had, without there having been an explicit agreement to maintain secrecy, offered an apparatus which caused the subject-matter of the invention to lack novelty and had provided drawings to a weapons manufacturer. The board held that the prior use did not cause lack of novelty because a variety of circumstances pointed to there having been an obligation to maintain secrecy. According to the board discretion was generally acknowledged to be the rule on the premises of such companies. The business contacts between the opponents and the weapons manufacturer were restricted to specific individuals. Furthermore, aside from the discretion commonly observed in this branch of industry, almost all the papers used by staff at the company in question bore warnings about the need for confidentiality. It had been demonstrated that this company did not as a matter of principle allow the details of quotations to be passed on to third parties.

In **T 782/92** only 15 examples of a damper had been delivered to a single carmaker. The board took the view that in this case the dampers had been sold for test purposes and that this amounted to an obligation to maintain secrecy.

In **T 221/91** a tyre had been passed on to a third party for test purposes. As there was no evidence of a secrecy agreement having been concluded the board held that the invention had been made available to the public.

In **T 267/91** a sample of the invented product was passed on to the opponents for analysis. The evidence submitted did not show clearly whether there had been a secrecy agreement or not. The board agreed with the patent proprietors that the public nature of the prior use had not been demonstrated and that the opponents had failed to furnish conclusive evidence in support of their claim.

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

3.2 The notion of "making available"

Board of appeal case law has it that the theoretical possibility of having access to information renders it available to the public. This position dates back as far as **T 84/83**, in which a new type of wide-angle mirror had been fitted to a motor vehicle for demonstration purposes for at least six months. The board held this to constitute prior public use as during such a time the vehicle could be expected to be parked on public highways and hence open to inspection by third parties:

In **T 245/88** several vaporisers had been installed in a fenced-off area of a shipyard. The public did not have unrestricted access to this area. The board was of the view that the vaporisers had not been made available to the public. It would have been necessary to prove that persons skilled in the art who had had access to that area of the shipyard had obtained the owners' permission to inspect the vaporisers and to pass on this knowledge. As this was not possible the board ruled that the vaporisers had not been made 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, this was sufficient to establish that the document had been "made available to the public" on that day. It was not necessary as a matter of law that any member of the public would actually have been 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 sufficed to render the document available within the meaning of Art. 54(2). It was immaterial whether a member of the public was aware of this possibility or whether he actually took note of the document. The question as to whether a document had been made available depended on the possibility of inspection, not on whether it was actually inspected by a third party.

In **T 729/91**, one relevant document was a number of a monthly periodical, intended for hoteliers and caterers and which could be bought in South Africa. In accordance with the

evidence brought forward in the case, a copy of this periodical was received by a particular library on 9.8.1984, thus before the priority date (13.8.1984) of the patent in suit. The librarian stated that publications were "generally available to the public as of the date of receipt". There was no absolute certainty that this was the case with the publication in question.

The board was of the opinion that the EPO must decide what happened having regard to the available evidence on the balance of probabilities, ie it must decide what was more likely than not to have happened. In the present case, it was, in the board's view, clearly much more likely that the publication was available to the public as from the date of receipt. In the absence of evidence to the contrary, the board accepted that what in fact happened was what the librarian stated would "generally" happen. So the publication was considered to have been made available to the public before the priority date.

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

In the field of microbiology, in **T 576/91** the board conceded that an unwritten rule may exist within the scientific community whereby biological material referred to in a scientific publication can be freely exchanged. However, this does not amount to an obligation, so that any biological material which is the subject of a publication can be considered as being publicly available. The board further stated that if contractual obligations between parties resulted in access to biological material being deliberately restricted to a group of persons bound either by a research contract or a licence, it could be concluded that this material had been made "available to the public" under the terms of Art. 54(2).

In **G 1/92** (OJ 1993, 277) the Enlarged Board of Appeal established the principle that the chemical composition of a product forms part of 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 can be identified for analysing the composition. The same principle applies *mutatis mutandis* to any other product.

This overturns a number of earlier decisions which 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 in particular **T 93/89**, OJ 1992, 718; left open in **T 114/90**).

The Enlarged Board's decision also overturns **T 62/87** to the extent that it does not equate the delivery of a mixture with prior public use as the mixture in question was not subjected to closer inspection by the customer, merely processed and sold without further analysis. Revealing the formula, on the other hand, was held to amount to a disclosure preventing maintenance of the patent, even though the formula was only made known to a single client.

G 1/92 further stipulates that a commercially available product does not *per se* implicitly disclose anything beyond its composition or internal structure. Other characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions in order to provide a particular effect or result, or to discover potential results or capabilities, therefore point beyond the product *per se* as they are dependent on deliberate choices being made and thus cannot be considered as already having been made available to the public.

3.3 Recognisability of a technical teaching - analysability of a product in prior use

A technical teaching has only been made available to the public, and hence forms part of the state of the art, if it has become recognisable. The question to be addressed therefore is whether the technical teaching embodied in a product has indeed been made available to the public by the prior use.

Thus in **T 245/88** (see also p. 64) two vaporisers had been installed in a fenced-off area of a shipyard. As far as the opportunity to view these vaporisers from outside the fence was concerned, the board was not convinced that a person skilled in the art, without the knowledge of the subject-matter claimed in the contested patent, would have recognised the teaching it contained and the problem it sought to solve, or that he would have detected the claimed spacing ratio among the many dimensions and dimension ratios which can be derived from a multi-tube vaporiser.

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 develop it further.

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

The same principle was followed in **T 461/88** (OJ 1993, 295), where a control system having all the features claimed in the contested patent had been installed in a printing press exhibited at trade fairs before the priority date. The fact that the press had been exhibited had not made the control system available to the public as the public had not had an opportunity to recognise its features.

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.

T 601/92 concerned accidental anticipation. The subject-matter claimed was a radial fan with fan impellers relatively displaced in such a way that when viewed axially along the fan shaft the spokes of one were arranged in the spoke gaps of the other. In the construction of prior-art fans, the relative angle of the impeller spokes had not been an issue. However, it was quite likely that fans had been sold which just happened to have the spoke arrangement claimed. The board considered that the case for anticipatory prior use had

accordingly been proven, arguing that for accidental anticipation where there was no common technical problem, particular care had to be taken in weighing up what the claim covered and what was covered by the prior publication. In contrast to **T 161/82** (OJ 1984, 551), where the claimed subject-matter had a known construction but a different function, in the present case the function did not appear to be different. And since a product was being claimed, and not a new use of a known substance based on a hitherto unknown effect or function of that substance, **T 208/88** (OJ 1992, 22) was not comparable either.

The auxiliary request claimed a manufacturing process for low-noise radial fans with fan impellers systematically fixed on the shaft in the relative displacement described. The board felt that the word “systematically” clearly delimited this claim over the prior art. This feature clearly concerned a step in that process, and only in a process claim could it constitute an essential distinguishing feature over the prior art. That the claim for the manufacturing process was predominantly made up of product features was a logical consequence of the close link between product and process, and did not make it non-allowable.

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

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

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

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

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

In **T 952/92** (OJ 1995, 755) the board held that prior use of a product provided access to what the skilled person would be able to ascertain from that product by means of known analytical techniques. Whether such an analysis could be performed without undue burden was irrelevant to the question of whether the composition of a product had been made available to the public. In giving its reasons the board stated that the original English of **G 1/92** (OJ 1993, 277) was not entirely clear in terms of grammar, since the phrase “without undue burden” could qualify just the reproduction of the product, or both the

discovery of its composition or internal structure and its reproduction. The reference to “without undue burden” was not strictly necessary in order to provide an answer to the referred questions and could not therefore have been intended to alter or add to the existing law concerning what constitutes “the state of the art”. Reproducing a product “without undue burden” was a problem associated with Art. 83. Furthermore, to apply the concept of “undue burden” would introduce a subjective element into the determination of novelty, something which the Enlarged Board had specifically sought to reject in **G 1/92**.

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

3.4 Conditions to be met by allegations of prior public use

3.4.1 Points of fact

Decisions **T 194/86**, **T 328/87** (OJ 1992, 701), **T 93/89** (OJ 1992, 718), **T 232/89**, **T 538/89**, **T 754/89**, **T 78/90**, **T 600/90**, **T 877/90**, **T 441/91**, **T 602/91** and **T 988/91** held that to be able to determine whether an invention has been made available to the public by prior use, the following circumstances have to be clarified:

- (a) the date on which the prior use occurred
- (b) exactly what was in prior use
- (c) the circumstances surrounding the prior use.

3.4.2 Substantiation

The boards have also established criteria for substantiating claims of prior public use.

For the boards to consider claims of prior public use they generally require that such allegations be substantiated, ie that they be presented in such a way that it is readily apparent how the prior use occurred; see expressly **T 6/86**, **T 329/86**, **T 328/87** (OJ 1992, 701), **T 78/90**, **T 988/91**, **T 541/92**. A claim can be said to have been sufficiently substantiated if it can be understood by the EPO and the other parties without their needing to conduct their own investigations (see **T 441/91** for details).

T 328/87 (OJ 1992, 701), **T 988/91** and **T 541/92** in particular emphasised that for an opposition based solely on prior public use to be ruled admissible all three of the above points had to be sufficiently substantiated. **T 988/91** and **T 538/89** held that the allegations must be presented in such a way that the particulars of the alleged prior use are sufficiently understandable from the point of view of a skilled person, for each of the criteria, to permit an examination of whether they are well founded in substance. The conclusiveness of the evidence is not a factor when deciding on the admissibility of the opposition.

In **T 582/90** however the board took the line that in appeal proceedings a claim of prior public use had to be examined by the EPO of its own motion - regardless of whether it had been sufficiently substantiated during opposition proceedings - if it had an obvious bearing on the case. The board thus allowed a witness resident abroad to be heard even though the opposition division had rejected his testimony on the grounds that the alleged prior use was unsubstantiated.

3.5 Issues of proof

3.5.1 Means of proof and the evaluation of evidence

Evidence of a certain teaching belonging to the state of the art may take any suitable form. The EPO is free to weigh the evidence as it sees fit (the principle of the unfettered consideration of the evidence). For more details see p. 245.

3.5.2 Standard of proof

For the standard of proof see p. 246.

3.5.3 Burden of proof

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

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

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

In **T 326/93**, the board held that in assessing public prior use the burden of proof lay with the opponent, who had to show, on the balance of probabilities, firstly that the invention had been publicly demonstrated before the priority date and secondly that the skilled person would have drawn the necessary teaching from the demonstration.

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

In **T 887/90** the obligation to maintain secrecy was derived from the circumstances. In this case the board's view was that the onus for proving the contrary lay entirely with the opponents. See also **T 541/92** and **T 634/91** and chapter "Law of evidence".

3.5.4 Obligation of the EPO to examine of its own motion

A number of cases of alleged prior use called upon the boards to define the extent of the EPO's obligation under Art. 114 to examine of its own motion. In these cases either the opposition had been withdrawn at the appeals stage and establishing prior public use had proved difficult, or the alleged prior use had not been substantiated.

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

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

3.6 Late-filed objection of prior public use

In a number of cases the boards were called upon to decide how to proceed where an objection of prior public use had been filed late. For more details see the chapter on late submission, pages 222 et seq.

4. Chemical inventions and selection inventions

4.1 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 - was disclosed in a manner which caused lack of novelty, if it proved to be the inevitable but undetected result of one of a number of processes adequately described in the prior publication by the indication of the **starting compound** and the **process**.

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

- A substance selection can come about if an unmentioned compound or group of compounds having a formula covered by the state of the art is found, in the absence of any information as to the starting substance or substances. The subject-matter in the case in

question, however, did not involve a selection of that kind in an area which, although marked out by the state of the art, was nonetheless virgin territory.

- However, the disclosure by description in a cited document of the starting substance as well as the reaction process is always prejudicial to novelty because those data unalterably establish the end product.

- If, on the other hand, two classes of starting substances are required to prepare the end products, and examples of individual entities in each class are given in two lists of some length, then a substance resulting from the reaction of a specific pair from the two lists can nevertheless be regarded for patent purposes as a selection and hence as new.

The 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 the case in question, for example, no matter which of the processes described in detail was used, the end product was always the particular starting substance's hydrogenation product, which differed from the starting substance itself only in that it contained two additional hydrogen atoms. The process parameter was thus - seen in terms of the end product - not a variable parameter that would result in an immense widening of the range of possibilities, so that precisely in this case the end product was not the result of two variable parameters.

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 were 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 manifested itself as a chemical entity (C_1 alkyl bromide) from a group of generically defined compounds ($C_1 - C_4$ alkyl bromides). The board had taken the view that the description of the reaction of a certain starting material with $C_1 - C_4$ alkyl bromides disclosed only this product substituted by C_1 methyls and was not ready to recognise the disclosure of the butyl substitutes on the grounds that four isomers of this radical existed.

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

Following on from **T 181/82** it was stated in **T 7/86** that if a class of chemical compounds precisely defined only in structural terms (by a chemical reaction) and with only one generically defined substituent, did not represent a prior disclosure of all the theoretical compounds encompassed by an arbitrary choice of a substituent definition, this clearly

also had to be the case for a group of chemical substances, the general formula of which had two variable groups. Therefore, a class of chemical compounds, defined only by a general structural formula having at least two variable groups did not specifically disclose each of the individual compounds which would result from the combination of all possible variants within such groups.

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 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; T 85/87; T 133/92**).

(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 dealt 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 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 lacked novelty.

In **T 1048/92** the board observed that the fact that the disclosure of the prior document did not embrace more than two possible steric configurations did not take away the novelty of the specific one which was claimed in the application, because there was no unambiguous technical teaching directed to that configuration. It based its ruling on consistent board of appeal jurisprudence, according to which the novelty of such an individual chemical configuration can only be denied if there is an unambiguous disclosure of this very configuration in the form of technical teaching. It was thus not sufficient that the configuration in question belonged conceptually to a disclosed class of possible configurations without any pointer to the individual member. It was clear that, if such a configuration were novel, it would constitute a "new element" within the meaning of **T 12/81**, conferring novelty on any group of individual chemical compounds having this feature in common.

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

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

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

In decision **T 427/86**, the board considered a case where two classes of starting substances were required to prepare the end products, and examples of individual entities in each class were given in two lists. 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 of metal constituents and list of promoters in this document 36 different catalytic systems could be contained. The invention claimed aimed at improving the operation of the catalytic system. It comprised the selection of a very small number of alternatives (one and two respectively) from the list of metal constituents and list of promoters according to the prior document, the combination of which was not mentioned anywhere in the latter. The board was of the opinion that a substance resulting from the reaction of a specific pair from the two long lists was for patent purposes a selection and could be regarded as new, in so far as the wide range of possibilities had not been disclosed to the public. The board added furthermore that in view of the earlier decision **T 198/84** (see p. 54), 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.

4.2 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** as follows: 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, ie 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 entailed more than just a formal delimitation vis-à-vis the state of the art. There would be delimitation only in respect of the wording of the definition of the invention, but not in respect of its content, if the selection were arbitrary, ie if the selected range only had the same properties and capabilities as the whole range, so that what had been selected was only an arbitrary specimen from the prior art. This was not the case if the effect of the selection, eg the substantial improvement in yield, occurred in all probability only within the selected range, but not over the whole known range (purposive selection).

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

In **T 17/85** (OJ 1986, 406) the novelty of the claimed range was denied, because the preferred numerical range in a citation in part anticipated the range claimed in the application. A claimed range 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. It is therefore not sufficient merely for the wording of the definition of an invention to be different. What has to be established in the examination as to novelty is whether the state of the art is such as to make the **subject-matter** of the invention available to the skilled person in a technical teaching (**T 198/84**, OJ 1985, 209; **T 12/81**, OJ 1982, 296; **T 181/82**, OJ 1984, 401; **T 17/85**, OJ 1986, 406).

Decision **T 26/85** (see p. 57) uses this concept to derive the principle that the state of the art only causes lack of novelty in so far as it discloses to the person skilled in the art a reproducible technical teaching. Developing this concept, the decision suggests as a specific test for determining whether a technical teaching has been made available to the public, 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 teaching of the prior art document in the range of overlap. If it can 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**, **T 255/91** (OJ 1993, 318), **T 279/89**, **T 369/91** (OJ 1993, 561) and **T 631/92**.

In decision **T 666/89** (OJ 1993, 495) the board gave a ruling on novelty assessment in cases of overlapping numerical ranges. The patent related in particular to a shampoo comprising 8-25 % anionic surfactant and 0.001-0.1 % cationic polymer. In an earlier patent application a shampoo composition had been disclosed containing 5-25 % anionic surfactant and 0.1-5.0 % cationic polymer. The board held that the composition was not new.

In the board's view, there was no fundamental difference between examining novelty in situations of so-called "overlap" or "selection", and in doing so in other situations, although it might be helpful, in order to verify a preliminary conclusion of a novelty examination in cases of overlap, to investigate whether or not a particular technical effect was associated with the narrow range in question. It needed to be stressed, however, that such a particular effect was neither a prerequisite for novelty nor could it as such confer novelty; its existence could merely serve to confirm a finding of novelty already achieved. The term "available" in Art. 54(2) 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 **T 247/91**, in deciding the question of the novelty of an invention, the board emphasised that consideration had to be given not only to the examples but also to whether the disclosure of a prior art document as a whole was such as to make available to the skilled person as a technical teaching the subject-matter for which protection was sought. In the case in point a document teaching a temperature range of 80 to 170°C for the treatment of an oxidation mixture was cited as taking away the novelty of the subject-matter which claimed a selection from this range of 85 to 115°C. The board agreed that the examples given in the cited document did not describe the treatment of the oxidation mixture at temperatures within the temperature range claimed in the patent in suit. The board also agreed that, on the basis of the examples and the teaching that a lower temperature was associated with a somewhat longer residence time, a preference might be construed for the use of a temperature of about 135°C. However, the board went on to say that it was accepted by the appellant (patent proprietor) that a skilled reader of the cited document had no reason to exclude the range of 85 to 115°C claimed in the patent in suit. The board thus held that in these circumstances the teaching of the cited document was clearly not limited to the use of the exemplified temperatures but extended to the whole described temperature range. Thus the complete temperature range of 80 to 170° had been made available to the skilled person as a technical teaching and the subject-matter of the patent in suit lacked novelty.

In **T 245/91** the appellants (patent proprietors) contested the lack of novelty objection of the respondents in the light of the disclosure in a prior document and contended that the subject-matter of claim 1 amounted to the purposeful selection of a small area from the very broad disclosure in the said document. The board observed that most of the ranges in claim 1 of the patent in suit could be obtained by narrowing down the ranges according to the cited document by approximately 25 to 80% and restricting them to their central portion, and that in a situation like this, where several ranges of parameters were to be considered, a careful comparison had to be carried out in order to assess whether or not the subject-matter of the claimed invention was available to the skilled person. Any obviousness considerations were to be strictly avoided. The board, referring to **T 666/89** (OJ 1993, 495), emphasised that under the EPC novelty had to be decided by reference to the total information content of a cited prior art document. In the board's judgment, the combination of the relevant features would not have been seriously contemplated by the skilled reader and was not made available to him, because the said features were not prominent in the cited document and did not therefore lend themselves to an unambiguous, implicit disclosure. A further point to consider was the number of parameters used to define the claimed subject-matter, since each of the ethylene polymers was characterised by several parameters. The board held that even if most of the ranges for these parameters corresponded to a more-or-less central portion of the range limiting the corresponding parameter in the composition according to the cited document, because of the number of parameters involved, which exceeded 10, the scope of the claimed blends was in reality quite narrow with regard to the breadth of the definition of the known composition. This was also the reason why the argument that there had been an implicit description of this narrow selection in the prior document was not accepted.

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 causing lack of novelty. The board, however, held that it was new: although “at least two” was synonymous with a multilayer material and set the lower limit in the form of a double-layer material (the description related to any multilayer material without specifying an upper limit for the number of possible layers), the only theoretical examples given for such multilayer materials were double-layer materials. Nor did the documents cited in support of the opposition as much as hint at a three-layer material. It might appear logical for a three-layer material to form part of the group of multilayer materials in the cited documents, but this did not mean that it was thereby disclosed. On the contrary, it was a new material forming part of this group and selected from it.

The board 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, ie 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.

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

5. Novelty of use

5.1 First medical use

5.1.1 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”) are not regarded as inventions susceptible of industrial application (Art. 52(4), first sentence). Art.

54(5) provides that the general rules of law relating to novelty (Art. 54(1) to (4)) do not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Art. 52(4), provided that its use for any method referred to in that paragraph is not comprised in the state of the art. Thus in addition to the general concept of novelty (Art. 54(1) to (4)) this article introduces, in respect of substances and compounds used in surgical and therapeutic treatment and in diagnostic processes carried out on humans and animals, a **special concept of novelty** unknown in other technical fields (**T 128/82**, OJ 1984, 164).

For the first medical use of a known substance, Art. 54(5) provides a particular form of claim (purpose-related product claim). In **G 5/83** (OJ 1985, 64) the Enlarged Board observed that the inventor of a "first medical indication" could obtain purpose-limited product protection for a known substance or composition, without having to restrict himself to the substance or composition when in a form technically adapted to a specified therapeutic purpose. The appropriate protection for him was, therefore, in its broadest form, a purpose-limited product claim. No problem arose over its susceptibility of industrial application, within the meaning of Art. 57.

5.1.2 Scope of a purpose-related product claim

In **T 128/82** (OJ 1984, 164) the board considered the question of a first medical indication (first medical use of a known substance) with regard to the breadth of the purpose-related product claim. The examining division had refused the application on the grounds that it failed to fulfil the requirements of Art. 52(4) and Art. 54(5) as the claims were not limited to the specific therapeutic use of the known compounds as first discovered. The board had to consider whether the broad version of the claims was allowable having regard to Art. 54(5) and, in particular, whether the EPC offered a basis for a limited statement of therapeutic purpose susceptible of narrow interpretation. In the opinion of the board of appeal the EPC neither prohibited nor required an unlimited statement of purpose. The board held that Art. 54(5) permitted a purpose-limited substance claim stating a general therapeutic purpose and found that where a known compound was for the first time proposed and claimed for use in therapy, the fact that a specific use was disclosed in the specification did not in itself call for a restriction of the purpose-limited product claim to that use (see also **T 36/83**, OJ 1986, 295; **T 43/82**). The board further observed that the practice of the EPO hitherto had shown that substance and medical preparation claims for therapeutically active compounds not limited to specific indications were allowed, even though as a rule only certain specific activities were stipulated. As a general rule, this practice concerned new compounds. In the board's judgment, it could not be inferred from the EPC that compounds, which - although previously known - were still patentable under Art. 54(5), were in principle to be treated differently. If an inventor was granted absolute protection in respect of a new chemical compound for use in therapy, the principle of equal treatment would also require an inventor, who for the first time made a known compound available for therapy, to be correspondingly rewarded for his service with a purpose-limited substance claim under Art. 54(5) covering the whole field of therapy. Any other treatment would only be justified were Art. 54(5) to forbid outright a broad scope of protection. The fact that Art. 54(5) did not contain any requirement that protection should be broad was not in itself a reason for refusing to grant such protection. As a general rule, the usual practice as it related to new compounds should be followed. On the other hand, the mere fact that there were no instructions concerning all and any possible specific therapeutic applications did not justify limiting the scope to the therapeutic application actually

mentioned. This would not be in keeping with general EPO practice concerning therapeutically active compounds.

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

5.1.3 Protection of a preparation in the form of a "kit-of-parts"

In **T9/81** (OJ 1983, 372) it was held that combined preparations the individual components of which represented known therapeutic agents might be protected in a formulation corresponding to Art. 54(5) even when claimed as a kit-of-parts, providing those components formed a functional unity (true combination) through a purpose-directed application. Claim 1, which was drawn up in the form stipulated in Art. 54(5), referred to a combined preparation containing an oxazaphosphorin cytostatic agent and the sodium salt of 2-mercapto-ethane-sulphonic acid as therapeutic active ingredients. The first-mentioned component of the product was known, and the second was a known mucolytic agent. According to the documentary prior art available to the board, the two active ingredients had never been used together for a **new joint effect** and were **unknown as a composition**. The active ingredients which were administered preferably at the same time according to the invention did not therefore represent a mere aggregate of known agents, but a new combination with the surprising, valuable property that the severe side-effects to be expected when administering the cytostatic agents were absent as a result of the detoxicating effect of the sodium 2-mercapto-ethane-sulphonate.

Claim 1 referred to a product which was limited to simultaneous, separate or sequential use in cytostatic therapy. In the board's judgment, it followed from this indication of purpose that the components were no longer necessarily present as a union, eg in composition, since the components would not otherwise be available for separate or sequential application. The board stated that as a **kit-of-parts**, however, it was not necessarily a true combination in view of the physical separation of the individual components. The mere loose association of known components did not in itself turn them into a functional unity in which a necessary and direct interaction between the components was a precondition for the purposive use (e.g. lock and key, match and striking surface, two-component adhesive). Although the components in the claimed combination did not enter into such direct interaction with each other, the indication of purpose for the combined therapy might re-establish the unity of the product as a functional amalgamation of its two components, if it represented a genuine restriction to the specified application. In so far as the components could not attain the advantageous effect according to the invention independently of each other, the joint effect justified the unity of the combined product as a result of the limitation by the indication of purpose of the area of protection of the claim under the conditions laid down in Art. 54(5), even if the components were presented side-by-side and not as a union. Since the individual components of the combined product in the present claims had themselves known therapeutic applications, these claims, by expressly including the separate presentation of those components, were indeed to be regarded as limited to the joint use of the combined products, so that the individual applications according to the state of the art were excluded.

5.2 Second (further) medical use

The question of law which was referred to the Enlarged Board in **G 5/83** (OJ 1985, 64) (see also **G 1/83**, OJ 1985, 60; **G 6/83**, OJ 1985, 67) arose essentially because of the particular exclusion from patentability in relation to “methods for treatment of the human or animal body” set out in the first sentence of Art. 52(4), and the exception to the novelty requirement set out in Art. 54(5). In the field of medical or veterinary inventions, the normal type of **use claim** is prohibited by Art. 52(4), but Art. 54(5) expressly provides for an exception to the general rules governing novelty (Arts. 54(1) to (5)) in respect of the first medical or veterinary use of a substance or composition, by allowing a claim to the substances or compositions for that use.

The Enlarged Board did not accept claims directed to the use of a known substance X for the treatment of disease Y, because such a claim would relate to a medical method which was not patentable under Art. 52(4). 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.

The Enlarged Board found that no intention to exclude second (and further) medical indications generally from patent protection could be deduced from the terms of the EPC. As a result, the Enlarged Board considered that it was legitimate in principle to allow claims directed to the use of a substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application, even where the process of manufacture as such did not differ from known processes using the same active ingredient.

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 could be derived. According to decision **T 19/86** the question of whether a new therapeutic use was in accordance with decision **G 5/83** should not be answered exclusively on the basis of the ailment to be cured but also on the basis of the subject (in the case in question, the new group of pigs) to be treated. A therapeutic application was incomplete if the subject to be treated was not identified; only a disclosure of both the disease **and** the subject to be treated represented a complete technical teaching. The proposal according to the application to protect animals which could not hitherto be protected from the disease in question, by intranasally administering to them a known serum, could not be considered disclosed in the prior art and therefore constituted a novel therapeutic application in accordance with the above-mentioned decision of the Enlarged Board (see also **T 893/90**).

In decision **T 290/86** (OJ 1992, 414) the board had to give a ruling on the novelty of a claim drawn up in the form of a second medical use. The claim’s subject-matter was the use of a lanthanum salt for the preparation of a composition intended to remove dental plaque (according to the patent proprietor, plaque removal had the effect of preventing caries). The closest prior art disclosed compositions comprising salts containing various elements, including lanthanum, to depress the solubility of tooth enamel in organic acids, and thus to inhibit tooth decay.

The board considered the claimed invention new. The grounds for its decision were as follows: “When a prior document and a claimed invention are both concerned with a

- similar treatment of the human body for the same therapeutic purpose, the claimed invention represents a further medical indication as compared to the prior document within the meaning of decision **G 5/83** if it is based upon a different technical effect which is both new and inventive over the disclosure of the prior document". In this case the technical effect considered new was the removal of dental plaque, whereas the prior art only disclosed the depression of enamel solubility in organic acids.

In **T 51/93** a European patent application relating to the use of human HCG for the manufacture of a medicament for subcutaneous administration was refused by the examining division because prior art document D(1) implicitly disclosed the subcutaneous administration, and because the subcutaneous administration of HCG was an obvious alternative to intramuscular administration. D(4) (cited by the board) disclosed vials for injection containing HCG and diluent, obtained by mixing HCG with a carrier and/or diluent. The only difference between the invention as claimed and the disclosure of D(4) was that the claim was directed to an intended method of subcutaneous administration. The claim was drafted in the form approved in decision **G 5/83** for claims where the novelty was solely that of the intended use, so the only question was whether a difference in the **mode of administration** of a medicament could be treated as a new therapeutic use. The board, relying on **T 290/86**, observed that the mode of administration might be a critical factor in a medical treatment and no reason could be seen for any **a priori** bar to relying on this difference when distinguishing over the prior art. Rather, patentability should be treated as depending only on whether this modification was in fact novel and inventive. Thus, it was possible to acknowledge novelty over D(4).

In **T 570/92** the board allowed a claim which took the form of a claim to a second medical use of a known substance and referred to a substance which had not previously been described in concrete terms. In line with **G 5/83**, what was claimed was the use of that substance for the manufacture of a long-lasting medicament for the oral treatment of hypertension, to be administered once or twice daily. The latter feature, concerning the administration of the medicament, did not lead to exclusion from patentability under Art. 52 (4). The wording used served not to indicate to the doctor the frequency of administration actually intended when treating an individual patient, but merely to convey the teaching that the success of the treatment was assured if the medicament was administered not more than twice a day.

In **T 227/91** (OJ 1994, 491) the board held that the purpose of a surgical use alone could not render novel the subject-matter of a claim relating to the use of the components of a known instrument for its manufacture, ie 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, ie intercepting the laser beam, was a characteristic of the surgical use of the instrument and did not affect the structure or composition of the entity itself. This kind of functional reference could not normally impart novelty to an otherwise known article unless the function implied a necessary modification of the article itself.

In decisions **T 303/90** and **T 401/90** the main claims related to a contraceptive composition comprising known pharmaceutical compounds. The board was of the opinion that the composition as claimed could not be considered novel and the added word "contraceptive" did not change the product claim into a use claim. Only in the case of first medical use could the addition of a purpose characteristic render a product claim new, if the product as such was known in other technical fields.

In **T 51/93** (see above) the board considered a further issue related to the acceptability of a certain formulation of claims directed to a second medical use. The board found that document (4) anticipated process claim 1 put forward in the set of claims for AT, ES and GR, as the novelty of the intended use of the product could only be taken into account as a technical feature limiting the claim where the claim took the form of a use claim as approved in decision **G 5/83**. The use claim as approved in decision **G 5/83** emphasised that the intended use was a **technical** feature to be taken into account in assessing novelty, and which limited the claim. The board stated that normally, however, in a claim to a “Process for making X for use Y comprising the steps of...” the process claim was interpreted as covering the particular process of making X irrespective of whether that X was to be used for use Y or not. Thus, in such a process claim the wording “for use Y” was intended not as a distinguishing technical feature but merely as an **illustration** of what X could be used for. Consequently the board considered that in the process claim 1 for AT, GR and ES the words “for use in the treatment by subcutaneous administration ...” were to be treated in accordance with common practice for process claims as merely illustrative and not as a restrictive technical feature capable of establishing novelty. The board further stated that, for the purpose of assessing novelty in EPO proceedings, the interpretation to be given to a claim had to be the same irrespective of the contracting states for which the claim was put forward. The fact that the contracting states AT, ES and GR had, for a time, laws restricting claimable subject-matter, could not, where the prior art was the same for all designated states, lead to a claim being interpreted as novel and allowable for these states if it was not also novel and allowable for all other contracting states. Thus the fact that process claim 1 was put forward only for AT, ES and GR did not assist the appellant.

In **T 893/90**, however, a board of appeal came to a different conclusion. The claims were formulated as method claims, namely as a method of producing a pharmaceutical composition for controlling bleeding in non-haemophilic mammals characterised by admixing the two components in functionally defined amounts and proportions. In the board’s judgment, the said claims did not substantially differ in their formulation from use claims, ie from claims directed to the use of the mixture of the two components in functionally defined amounts and proportions for the stated purpose, namely for producing a pharmaceutical composition for controlling bleeding in non-haemophilic mammals. In this respect, it was also observed that, according to claim 1, the mixture excluded other physiologically active materials; thus, the said mixture was well-defined in terms of its components. The board concluded that the claims were thus in accordance with established EPO case law that claims are allowable directed to the use of a substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application, even if the process of manufacture as such does not differ from known processes using the same active ingredient(s) (see **G 5/83**).

5.3 Second (further) non-medical use

In general, the European Patent Convention allows both method claims and use claims, but whether any activity is claimed as a method of carrying out the activity (setting out a sequence of steps) or as the use of a thing for a stated purpose (the sequence of steps being implied) is a matter of preference. For the European Patent Office there is no difference of substance (**G 5/83**, OJ 1985, 64).

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

In the non-medical field use claims are admissible and not subject to special conditions. In **T 231/85** (OJ 1989, 74) the board had to judge the novelty of a second non-medical use in a special constellation. It held that the fact that a substance was known could not preclude the novelty of a hitherto unknown use of that substance, even if the new use did not require any technical realisation other than that for a previously known use of the same substance. In the case in question the known use was use as a growth regulator and the new one, now claimed by the applicant, use as a fungicide. The technical realisation was in both cases the spraying of useful plants.

Later, the same board, with a different composition, referred to the Enlarged Board the question whether a claim for the use of a compound for a particular non-medical purpose was novel under Art. 54 having regard to a prior publication which disclosed the use of that compound for a different non-medical purpose, so that the only novel feature in the claims was the purpose for which the compound was used. The specific problem in these cases was that the previously disclosed use of the substance, although specifically stated to be for another purpose, would **inherently** comprise the use as claimed in the new application (**T 59/87** (OJ 1988, 347), **T 208/88** of 20.7.1988).

In decisions **G 2/88** (OJ 1990, 93) and **G 6/88** (OJ 1990, 114), the Enlarged Board stated that the patentability of a second non-medical use of a product was already recognised in principle in **G 5/83** which concerned the second medical use of a substance. However, in that earlier decision the exclusion from patentability of therapeutic and diagnostic methods had caused the Enlarged Board to allow only a special type of claim. These specific difficulties did not arise in the non-medical field; there the question was of a general nature, concerned primarily with the question of interpretation of Art. 54(1) and (2). In **G 2/88** and **G 6/88**, therefore, it was pointed out that a claimed invention lacked novelty unless it included at least one **essential** technical feature which distinguished it from the state of the art. A basic initial consideration, when deciding upon the novelty of a claim, was therefore to analyse it in order to determine its technical features.

The Enlarged Board took the view that the proper interpretation of a claim whose wording clearly defined a new use of a known compound would normally be such that the attaining of a new technical effect on which the new use was based was a technical feature of the claimed invention. Thus, where the particular technical effect underlying such use was described in the patent, the proper interpretation of that claim would require a functional feature to be implicitly contained in the claim as a technical feature - eg the compound actually achieved the particular effect.

Referring to the facts of **T 231/85** (see above) as an example, the Enlarged Board explained that the claim directed to the use of a substance (known as a growth regulator) as a fungicide implicitly included a **functional** technical feature, namely that the said substance when used in accordance with the described means of realisation in fact achieved the effect (ie performed the function) of controlling fungus. The claim should not be interpreted literally as only including by way of technical features "the substance" and "the means of realisation of the claimed purpose", but should in appropriate cases be interpreted as also including as a technical feature the function of achieving that purpose, because that was the **technical result**. When determining novelty the decisive question of what had been made available to the public was one of fact in each case. A line had to be drawn between what was in fact made available and what remained hidden or had not otherwise been made available. In that connection the distinction between lack of novelty and lack of inventive step also had to be emphasised: information equivalent to a claimed invention may be "made available" (lack of novelty), or it may not

have been made available but is obvious (novel, but lack of inventive step), or was not made available and is not obvious (novel and inventive). Thus, in particular, what is hidden may still be obvious.

Under Art. 54(2) the question was not what might 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 had not been made available to the public, was not a ground of objection to the validity of a European patent. In that respect, the provisions of the EPC might differ from the earlier national laws of some contracting states, and even from the current national laws of some non-contracting states. Thus, the question of “inherency” did not arise as such under Art. 54. Any vested right derived from prior use of an invention was a matter of national law.

The Enlarged Board thus concluded that with respect to a claim to a new use of a known compound, such new use might reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a **functional technical feature** of the claim (eg the achievement in a particular context of that technical effect). Had that technical feature not previously been made available to the public by any of the means set out in Art. 54(2), then the claimed invention was novel, even though such technical effect might have inherently taken place in the course of carrying out what had previously been made available to the public.

The final decisions in cases **T 59/87** (OJ 1991, 561) and **T 208/88** (OJ 1992, 22) both held that the claimed use inventions were novel and inventive.

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.

In **T 36/83** (OJ 1986, 295) the board stated that having discovered for the first time the surprising properties of a chemical product already known in the state of the art and having shown those properties in various uses, the applicant had the right to have those uses protected. In the particular case the uses were presented in the description as two methods: a method of medical treatment and a method of non-medical treatment. Under Art. 52(4) a method of medical treatment was not patentable but a product for use in that method certainly was. Claims 1 to 7 had been worded accordingly. The method of non-medical treatment was one falling within the general field of patentable inventions. There could be no objection to the patentability of either use or method claims in general (see **G 5/83**). The applicants had chosen the phrase “use as a cosmetic product of thenoyl peroxide”. The board considered that this form of claim was acceptable in the case in suit. The board noted that when considering the exclusions from patentability under Art. 52(4) the wording of the claim was important. In reaching this conclusion the board held the use of the word “cosmetic” in the context of that application to be sufficiently precise to exclude therapeutic uses, without the need for a specific disclaimer of such uses.

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, ie 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 210/93** the originally claimed process for the production of a rubber product was held not to be novel by the examining division because the claimed temperature range was already disclosed in D1. With reference to **G 2/88** and **G 6/88**, the applicants thereupon claimed the use of this known process for the purpose of preparing the rubber product having a certain maximum ratio of constituent X. They argued that in the absence of a disclosure of this mole ratio in D1, this constituted a "specific technical purpose of achieving the previously unknown chemical structural arrangement". The board observed that decisions **G 2/88** and **G 6/88** related to claims to the use of a known **compound** for a particular purpose, in contrast to the appellants' claim, which was directed to the use of a known **process** for a particular purpose, the purpose being the preparation of a particular product naturally resulting from such process. In the board's view, the use of a process for the purpose of preparing its product(s) could be said to be nothing but that very same process, and the scope of protection appeared to be the same for a claim to the process as such and a claim to such use.

In **T 523/89** a particular prior art document disclosed a container having all the structural features defined in claim 1 of the contested patent. Hence, the only outstanding issue was the fact that D1 nowhere indicated that the container disclosed therein was intended to be used for ice-cream. The board noted that the question of anticipation of a claim to an article for a particular use was dealt with in the Guidelines C-III, 4.8, and C-IV, 7.6, from which it was clear that, with the exception of medical uses of known substances, the indication of intended use was only to be seen as limiting to the extent that the article had to be suitable for that use. In other words, disclosure of an equivalent article without an indication of the particular use claimed - although the article was nevertheless suitable for it - would cause the novelty of a claim to the article for that particular use to lack novelty. The board saw no reason to disagree with this general principle of interpretation laid down in the Guidelines.

In **T 15/91** the board ruled that, according to board of appeal case law, the discovery that known apparatus could be used in a manner not hitherto described did not substantiate the novelty of that apparatus if the hitherto unknown use did not require any modification to the technical design of the known apparatus (see **T 523/89**). In **T 215/84** the board held that the discovery that the known equipment might be used in a new manner could not render the entity itself novel. In **T 958/90** the board mentioned that a known effect could not be novel for the sole reason that it was present in the patent to a hitherto unknown extent.

6. Non-prejudicial disclosures

6.1 Evident abuse

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

A few decisions of the boards of appeal have dealt with instance (a) concerning evident abuse in relation to the applicant.

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

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

In **T 436/92** the board found that although a confidentiality agreement had not been signed on behalf of G. Corp., the fact that G. Corp. had immediately taken part in development work and other relevant circumstances at least indicated a common understanding that G. Corp. was bound by the agreement, albeit tacitly. G. Corp. therefore was not at liberty to disclose any information about its co-operation with the patentee without permission from the latter. The board held, however, that the patentee/appellant had the burden of proving that the publication constituted evident abuse. This term indicated that mere negligence or breach of confidentiality did not suffice. Deliberate intention to harm the other party would constitute evident abuse, as probably also would knowledge of the possibility of harm resulting from a planned breach of such confidentiality. The state of mind of the “abuser” was of central importance (confirming **T 585/92**). The board held that the appellant had not proven, on the balance of probability, that the publications had occurred in violation of the tacitly agreed confidentiality. In other words, the publication was not an evident abuse within the meaning of Art. 55(1).

6.2 Events prior to the priority date

A prior disclosure of the invention is not to be taken into consideration as part of the state of the art under Art. 54 if it occurred no earlier than six months preceding the filing of the European patent application (Art. 55). There are, however, different opinions as to whether Art. 55 is applicable to abuse relating to events prior to the priority date.

In **T 173/83** the board considered whether the disclosure of a particular document had occurred in the period provided for by Art. 55(1). The disclosure had not occurred later than six months prior to filing of the application, but merely later than six months prior to the priority claimed. The problem of the possible accumulation of this six-month period and of the priority period under the Paris Convention therefore arose. In the board’s view, in the text of Art. 55(1), the French term “dépôt” and the English term “filing” corresponded to the term “Einreichung” in the German text. The term “Einreichung” had been expressly

chosen to replace "Anmeldetag" (= date of application) at the Munich Diplomatic Conference and, according to the German delegation, this amendment had apparently been intended to ensure that the period would not be understood as relating to the date of priority but to the actual date of filing of the European patent application. In the light of the minutes of the "travaux préparatoires" for the Munich Conference, it would therefore seem that one should take account of the effective date of filing and not the priority date, where claimed. The board noted that there was no unanimity of doctrine on the question of this period. However, it did not decide on this point in law as no reply to the question was necessary in this particular case, since in the board's opinion the disclosure had not arisen from an evident abuse in relation to the appellants (see also **T 585/92**).

In **T 436/92** there was, in the course of the proceedings, considerable discussion as to whether or not Art. 55 applied to events before the priority date (the so-called "cumulation" issue). The appellant argued that non-cumulation of the six-month period under Art. 55 with the priority date under Art. 89 would lead to absurd results. Firstly, in a situation where a priority was claimed, the grace period allowed by Art. 55(1) had to be interpreted in relation to that document. In other words, the six-month period had to be calculated from the priority date. The value of a priority right would otherwise be prejudiced and would contravene Art. 4 of the Paris Convention on the right to priority protection. Since most applications claimed priority, the right to invoke the defence of abuse under Art. 55 would otherwise lose almost all its significance. Secondly, Art. 55 referred back to Art. 54. Both defined the grace period in terms of the filing of the European patent application. Art. 89, defining the effect of priority rights, did not refer to Art. 55 because the definition of prior art in Art. 54 in conjunction with Art. 55 was already valid for all subsequent references to prior art in the EPC. In the same manner, Art. 89 made no reference to Art. 56 although there was no doubt that the state of the art concerning inventive step was defined in terms of priority. A decision of an **opposition division** of 8.7.1991 (appl. 82 107 958.9) was mentioned which confirmed these conclusions. In other words, it was argued that Art. 55 had to be applicable to abuse relating to events prior to the priority date. The board made it clear that "cumulation" was a misleading term, since the defence of evident abuse did not put back the priority date (i.e. by adding another six months to it). The only legal effect was that the particular prior use was disregarded. All other documentation prior to the priority date as claimed remained state of the art. However, in view of the conclusion that the publication of the document did not constitute an evident abuse, the board dispensed with a discussion on this point, but stated in passing that the article in question did apply to events prior to the priority date.

D. Inventive step

1. Introduction

An invention is considered to involve 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).

Technical progress is not a requirement for patentability under the EPC. Therefore, technical progress shown in comparison with marketed products as an alleged support for inventive step cannot be a substitute for the demonstration of inventive step with regard to the relevant closest state of the art (see **T 181/82**, OJ 1984, 401, **T 164/83**, OJ 1987, 149, **T 317/88**).

2. Problem and solution approach

Board of appeal practice when examining inventive step is usually to take the problem-solution approach. This method involves first determining the closest prior art, then establishing the technical problem to be solved and, finally, considering whether or not the claimed invention, starting from the closest prior art and the technical problem, would have been obvious to the skilled person (see in this connection Guidelines C-IV, 9.5). The boards of appeal frequently cite R. 27(1)(c) as a basis for the “problem and solution approach”. According to R. 27(1)(c) an invention is to be disclosed in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood. The problem and solution are therefore integral parts of any technical invention.

According to board of appeal case law (see **T 1/80**, OJ1981, 206, **T 24/81**, OJ1983, 133, **T 248/85**, OJ 1986, 261), the assessment of inventive step has to be based on the objective, not subjective, achievement of the inventor. By starting out from the objectively ruling state of the art, the technical problem is to be determined on the basis of objective criteria and consideration given to whether or not the disclosed solution was obvious to the skilled person. The correct use of the “problem-solution approach” rules out an ex post facto analysis which inadmissibly makes use of knowledge of the invention (**T 645/92**).

In **T 465/92** (OJ 1996, 32), however, the board refrained from taking the “problem-solution approach” when assessing inventive step, stating that this method was no more than one possible route for the assessment of inventiveness which had its advantages and drawbacks. The board was of the opinion that one of its weaknesses was that it was inherently based on hindsight, as it relied on the results of a search made with actual knowledge of the invention, and therefore called for care in its application in some circumstances. Accordingly, its use was not a sine qua non when deciding inventive step under Art. 56.

3. Closest prior art

3.1 Determination of closest prior art

In a number of decisions (**T 248/85**, OJ 1986, 261, **T 403/89**, **T 306/90**) it was stressed that an objective assessment of inventive step starting from the closest prior art implied that the latter had been positively identified and considered.

In cases where a claimed invention is attacked on the basis of more than one prior

document, each belonging to the same technical field as the claimed invention, the closest prior art is the prior document, starting from which the claimed invention could most easily have been made by a skilled person at the filing date (**T 656/90**). As stated in decision **T 254/86** (OJ 1989, 115), the objectively closest state of the art is the most promising springboard towards the invention which was available to the skilled person (see also **T 282/90**).

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 was apparent that their teachings were mutually conflicting.

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 (see **T 574/88**, **T 834/91**, **T 897/92**, **T 380/93**, **T 1040/93**). In **T 273/92** the board of appeal confirmed the established case law of the boards according to which a document could not qualify as the closest prior art to an invention merely because of similarity in the composition of the products; its suitability for the desired use of the invention also had to be described.

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.

3.2 Choice of the closest starting point

For an objective assessment of inventive step, it is established EPO practice to determine the closest prior art to the claimed invention. A number of decisions handed down by Technical Board of Appeal 3.2.4 (Mechanics) centred on the choice of the closest starting point, ie the prior art offering the skilled person the easiest way of arriving at the solution claimed.

In **T 570/91** the board emphasised that although a person skilled in the art was completely free in choosing a starting point (the prior art disclosure which was "closest" to the invention, ie that which is the most promising starting point for an obvious development leading to the claimed invention), he would of course be bound afterwards by that choice. If, for instance, the skilled person preferred and decided to start from a specific compressor piston, he could further develop that piston but at the end of that development the normal result would still be a compressor piston and not an internal combustion engine piston. In other words, the closest prior art chosen had to be able, or at least potentially able - perhaps after modifications, to produce the same effects as those resulting from the claimed embodiment. Otherwise, such starting point prior art could not lead a skilled person in an obvious way to the claimed invention (see also **T 1040/93**).

In **T 1105/92** it was added that any assessment of inventive step had always to take a technically realistic starting point, ie that the grounds for such an assessment ceased to be logical if they took as their starting point an invention that was generically different from

the one claimed. For it to enable the skilled person to arrive at the objective problem, the prior art chosen as being closest to the claimed invention had to disclose clearly and unequivocally the essential features in relation to that invention.

In **T 439/92** the board pointed out that although there was freedom in the choice of the starting point on which an objection of lack of inventive step was based, there were certain criteria that should be adhered to if the prior art chosen was to be the closest. One such criterion was the problem already stated in the patent. Clearly in many cases it was reasonable for there to be a link between this problem and the prior art chosen as being closest (for details see Case Law Report 1994, 36, **T 495/91**).

3.3 Old prior art documents as closest prior art

The question of inventive step can only be objectively answered if an unrealistic approach is avoided. This implies that it is not appropriate to formulate an artificial and unrealistic technical problem which a skilled person would not in practice have considered (see **T 495/91**, **T 741/91**). It is thus necessary, after the relevant state of the art has been determined, to consider carefully whether or not in the specific circumstances of the case, taking into account all available information about the technical context of the claimed invention, a person skilled in the art would have had good reason to select a particular piece of prior art as the basis for further development. In three decisions Technical Board of Appeal 3.3.1 (Chemistry) considered the determination of the closest state of the art with regard to old prior art documents to be a realistic starting point for the determination of the relevant technical problem. The board found it inappropriate to formulate a technical problem which a skilled person would never have considered.

In **T 334/92** the board held that a document that had been disregarded for more than 20 years by those skilled in the art, had never been used during that period as a basis for further development, was moreover completely silent about the extent of the indicated activity and, finally, did not even mention, let alone discuss, the relevant state of the art, so that the skilled person was not in a position to recognise any technical advantage of these compounds in respect of that state of the art, did not represent the closest state of the art and could not therefore be used to define a realistic technical problem. However, in **T 964/92**, filed as a divisional application to **T 334/92**, the board held that the same document could be considered as a realistic starting point for the determination of the relevant technical problem. The board stated that in **T 334/92** the technical problem that was solved should be seen as the provision of further chemical compounds which were more active in the treatment of angina pectoris than the known compounds and less toxic. In contrast, in **T 964/92** the skilled person set out to seek no more than alternatives to known compounds described as medicaments for treating angina pectoris. Therefore, the board held that the skilled person would consider any compound or group of compounds belonging to the state of the art, and known to have the desired activity, as a suitable starting point. In such a case the length of time for which this document had been available to the public was irrelevant. Thus, there was no reason why said document, which clearly described compounds having a high degree of structural similarity to those claimed, should not be regarded as the closest state of the art.

In **T 1000/92** the board referred to its case law, according to which a document should be considered as the closest state of the art only if a skilled person would have had good reason to select its content as a basis for further development. In the board's judgment the selection of document (1) as the closest state of the art did not meet this criterion

because the disadvantages of the process described in document (1), which had been published about 30 years before the priority date of the application, were so evident and well known that a skilled person would not have tried to improve and develop such an old process (see also **T 616/93**).

4. Technical problem

4.1 Determination of the technical problem

According to board of appeal case law (see **T 1/80**, OJ 1981, 206 and **T 24/81**, OJ 1983, 133), the determination of the technical problem must be based on objective criteria. These criteria can be defined in concrete terms by assessing any technical advance in the subject-matter of the application in relation to the closest prior art (**T 910/90**). A comparison of the problem indicated in the application with that indicated in a prior document must avoid an excessively abstract approach far removed from the practical thinking of the skilled person (**T 5/81**, OJ 1982, 249).

In identifying the problem it is not permissible to draw on knowledge acquired only after the date of filing or priority. According to **T 268/89** (OJ 1994, 50) the non-effectiveness of a prior-art apparatus or method recognised or alleged only after the priority or filing date could not be drawn on in **formulating the problem**, particularly where that problem was adduced in support of inventive step in a “problem invention” (see **T 2/83**, OJ 1984, 265). Inventive step had to be assessed on the basis of the skilled person’s knowledge before the priority or filing date (see also **T 365/89**).

According to decisions **T 229/85** (OJ 1987, 237) and **T 99/85** (OJ 1987, 413) the technical problem addressed by an invention had to be formulated in such a way that it did **not contain pointers to the solution** or partially anticipate the solution, since including part of a solution offered by an invention in the statement of the problem necessarily had to result in an *ex post facto* view being taken of inventive step when the state of the art was assessed in terms of that problem (confirmed in **T 289/91**, OJ 1994, 649, **T 322/86**, **T 184/89**, **T 957/92**). Decision **T 910/90** added that this did not mean that determination of the inventive step could be based on a very general problem unrelated to the invention. Instead, when assessing the objective problem, the closest prior art and any technical advance achieved by the characterising features of the invention had to be taken into account. In so doing, it was not important whether this problem had already been mentioned in the closest prior art; what mattered was what the skilled person objectively recognised as the problem when comparing the closest prior art with the invention.

Furthermore it had to be considered that an objective definition of the problem to be solved by the invention should normally start from the problem described in the contested patent. Only if examination showed that the problem disclosed had not been solved or if inappropriate prior art were used to define the problem, was it necessary to investigate which other problem objectively existed. The definition of **artificial** and **technically unrealistic problems** was to be avoided (see **T 495/91**, **T 246/91**, **T 731/91**, **T 741/91**, **T 334/92**, **T 380/93**, **T 813/93**). In **T 419/93** it was added that, when determining the problem, the statements relating thereto in the application should be examined for correctness with regard to the prior art and for their *de facto* relevance to the claimed features of the solution. Only if the problem described in the application did not meet prior art requirements and/or was not solved in accordance with the features of the invention, should it be adapted to the prior art and/or actual technical success.

Furthermore, advantages not supported by sufficient evidence could not be taken into consideration in determining the underlying problem and hence in assessing inventive step (see **T 20/81**, OJ 1982, 217, **T 124/84**, **T 152/93**).

4.2 Reformulation of the problem

According to 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. The board allowed the problem to be redefined to such an extent that the skilled person “could recognise the same as implied or related to the problem initially suggested”. An appropriate restatement of the problem based on a less ambitious goal was therefore permissible (see also **T 106/91**). In **T 162/86** it was added that there was nothing to prevent a more exact definition of the problem from being given, even in the course of the appeal, provided it was supported by the original disclosure. Furthermore it was stated in **T 13/84** (OJ 1986, 253) that a reformulation of the problem was not precluded by Art. 123(2) if the problem could be deduced by a skilled person from the application as originally filed when seen in the light of the closest prior art (**T 547/90**, **T 469/90**, **T 375/93**).

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**, 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.

In **T 564/89** the appellant submitted that any amendment of the technical problem had to be in line with Art. 123(2). The board stated that this Article was not concerned with the issue of whether or not an objectively reformulated technical problem could be used in the course of the so-called problem-solution approach which was developed by the boards as a tool for achieving objectivity and to avoid ex post facto analysis in the assessment of inventive step. Art. 123(2) would therefore only come into play if an amended technical problem were incorporated into the description itself.

In **T 732/89** the respondent submitted that the “hot/wet” performance of the claimed composites, although admittedly better than that of the control composition, corresponded to a completely new effect which could not be incorporated into the technical problem without contravening Art. 123(2). The board did not follow this line of argumentation and referred to **T 184/82** (OJ 1984, 261) where a redefinition of the problem regarding the effect of an invention was allowed provided that the skilled person could recognise the same as implied or related to the problem initially suggested. In the case in point the board took the demonstrated effect into account in the formulation of the technical problem and stated that in determining which effect was crucial and which was merely accidental (the so-called “bonus effect”), a realistic approach had to be taken, considering the relative technical and practical importance of those effects in the circumstances of a given case (see also **T 227/89**).

In **T 440/91** the board took into account additional advantages associated with the technical problem set out in the application as filed for assessing inventive step and reformulating the problem accordingly. The board pointed out that R. 27 did not rule out

- the possibility of additional advantages - not themselves mentioned in the application as filed but relating to a mentioned field of use - being furnished subsequently in support of patentability for the purposes of Art. 52(1), as such advantages did not alter the character of the invention. Thus, the character of the invention was not altered if the technical problem specified in the application as filed was supplemented by such advantages, since the skilled person might consider them on account of their close technical relationship to the original problem.

The board made a distinction with regard to the situation in **T 386/89** and **T 344/89**, where there was no such technical relationship. In **T 386/89** the board had found that the solution to the technical problem derivable from the application as filed was in no way associated with a technical effect subsequently invoked. This additional effect had thus not been taken into consideration. The alleged effect of a described feature could not be taken into account when determining the problem underlying the invention for the purpose of assessing inventive step, if it could not be deduced by the skilled person from the application as filed considered in relation to the closest prior art. Similarly in **T 344/89**, the board had refused to take account of a subsequently invoked technical effect on the grounds that to do so would have altered the character of the invention.

Another aspect was described in **T 155/85** (OJ 1988, 87). According to this decision, it was not acceptable to rely on an effect which had previously been described as undesirable and of no value by the applicant, to present the same suddenly as possibly representing an advantage from another point of view, and thereby to imply that the technical problem and the considerations for the inventive step should take this reversal into account. While a redefinition of the technical problem was normally permissible and even necessary on the basis of the comparison of achievements with the closest prior art, this should not contradict earlier statements in the application about the general purpose and character of the invention (see also **T 115/89**).

4.3 Alternative solution to a known problem

In **T 92/92** the board noted that Art. 56 did not require that the problem to be solved should be novel in itself and could see no reason why a novel, alternative solution to a known problem should be excluded from patentability for lack of inventive step on the ground that the problem had already been solved in a different manner. The fact that the underlying problem of the patent had already been solved by the prior art does not necessarily require redefinition of the problem for the assessment of inventive step, if the subject-matter of the patent represented an **alternative** solution to this problem. In this context the board referred in particular to decision **T 495/91**. In this case too, the problem stated in the patent specification had already been solved. The problem to be objectively solved was the provision of an **alternative** process and of apparatus which made it possible to produce a floorcovering with specific properties by simple and low-cost means.

4.4 Solution to an unknown problem

In **T 59/90** the board stated that it might not be possible to apply the teaching of a prior art document to the solution of the problem underlying the invention if the prior document dealt with a different problem, and contained no suggestion of a solution to the problem addressed by the contested patent, which had not been encountered in the prior art.

5. Skilled person

5.1 Definition of the skilled person - team of experts

5.1.1 Definition

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, eg 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" (**T 141/87**, **T 604/89**, **T 321/92**).

Thus, the board stated, for example, in **T 424/90** that in real life the semiconductor expert would consult a plasma specialist if his problem concerned providing a technical improvement to an ion-generating plasma apparatus. 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 99/89** too, the board took the view that "competent skilled person" could be taken to mean a team of two or possibly more experts from the relevant branches.

In **T 164/92** (OJ 1995, 305) it was observed that sometimes the average skilled person in electronics, particularly if he did not have an adequate knowledge of programming languages himself, might be expected to consult a computer programmer if a publication contained sufficient indications that further details of the facts described therein were to be found in a program listing attached as an annex thereto.

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

5.1.2 Definition of the person skilled in the art in the field of biotechnology

Several decisions in the biotechnology field have sought to provide a definition of the person skilled in the art within the meaning of Art. 56. 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 was 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, as opposed to developing the science of molecular genetics, at that time.

This case law was confirmed in the "Biogen II" decision, **T 500/91** (for the first "Biogen" decision see **T 301/87**, OJ 1990, 335). The Board stated that the notional skilled person who might be represented by a team of appropriate specialists was oriented towards practicalities, and the development of the art normally expected by him did not include

- solving technical problems by performing scientific research in areas not yet explored.

In **T 223/92** the board had to consider the knowledge and capabilities of the notional skilled person in the field of genetic engineering as at October 1981, more than one year later than was the case in **T 500/91**. By this time, a considerably greater number of genes had been made the subject of cloning and expressing methods, and skills and experience in this technical field were developing rapidly. The knowledge of the notional person skilled in the art had to be considered as that of a team of appropriate specialists who knew all the difficulties still to be expected when considering the cloning of a new gene. However, the skilled person had to be assumed to lack the inventive imagination to solve problems for which routine methods of solution did not already exist.

In **T 412/93** the patent related to the production of erythropoietin. The parties agreed that in this particular case the skilled person should be treated as a team of three, composed of one PhD researcher with several years' experience in the aspect of gene technology or biochemistry under consideration, assisted by two laboratory technicians fully acquainted with the known techniques relevant to that aspect. The composition of the team might vary depending on the knowledge and skills required by the particular aspect dealt with.

In **T 455/91** (OJ 1995, 684) the board set out some reflections on what was believed to be the attitude of the person skilled in the art vis-à-vis possible changes, modifications and/or adjustments in known products (such as a plasmid) or procedures (such as an experimental protocol). It did so with a view to providing a possibly objective answer to the question whether or not the introduction of a given change in a structure or in a procedure could be seen as obvious to the skilled person, avoiding any ex post facto analysis. The skilled person in this field was well aware of the fact that even a small structural change in a product (such as a vector, a protein, a DNA sequence) or in a procedure (a purification process, for example) could produce dramatic functional changes. The said expert would rather be cautious in modifying or adjusting a known product or process. However, within the normal design procedures he would readily seek appropriate, manifest changes, modifications or adjustments which involved little trouble or work and no risks or only calculable risks, especially for the sake of obtaining a handier or more convenient product or of simplifying a procedure. Therefore, a skilled person working in one area of genetic engineering (say, expression in yeast) would regard a means found possible in a neighbouring area of genetic engineering (say, the bacterial art) as being usable in his own area, if this transfer of technical knowledge appeared to be easy and to involve no obvious risks.

5.2 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, ie the question of the extent to which neighbouring areas beyond the specific field of the application might be taken into consideration when assessing inventive step. According to **T 176/84**, when examining for inventive step, a skilled person would, as well as considering the state of the art in the specific technical field of the application, look for suggestions in neighbouring fields or a broader general technical field if the same or similar problems arose, and if he could be expected to be aware of such general fields. **T 195/84** added that the state of the art also had to include prior art in a non-specific (general) field dealing with the solution of any general technical problem which the application solved in its specific field. Such solutions of general technical problems in non-specific (general) fields had to be viewed as forming part of the general technical knowledge which a priori was to be attributed to those skilled

- persons versed in any specific technical field. These principles were applied in a large number of decisions.

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 a US 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 could be regarded as neither a neighbouring field nor a broader general field of which the specific field was 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 would also consider prior art in fields which were neither neighbouring nor represented a broader general field if he had grounds to do so on account of the related nature of the materials used and there was widespread debate on the technical problems confronting both fields. Echoing **T 560/89**, the board ruled in **T 955/90** that it corresponded to a real-life assessment that a person skilled in a broader general field would consult the particular narrower technical field of the well-known main application of this general technology in order to look for a solution to a problem which was independent of a particular use of this technology.

In **T 891/91** the board stated that a skilled person in the field of lenses for ophthalmic use, confronted with the technical problem of adhesion and abrasion resistance of a coating made on a surface of the lens, would also refer to the state of the art in the more general field of coated plastic sheets in which the same problems of adhesion and abrasion resistance of the coating arose and of which he was aware.

Because of the differing security risks, a skilled person could not be expected to search in the field of bulk-goods packaging for ideas for the design of a closure for a means of conveying money (**T 675/92**).

Further comments on the concept of relevant field are to be found in several other decisions, including the following: **T 277/90** (in dentistry, moulding technology and prosthodontics are neighbouring technical fields); **T 358/90** (discharging the content of a portable toilet did not lead the skilled person to the field of filling a tank of a chain saw by means of a special kind of container); **T 365/87**, **T 443/90**, **T 47/91**, **T 244/91** and **T 189/92**.

On a different aspect, with regard to the applicant's reference to a remote state of the art the Board gave the following ruling, in **T 28/87** (OJ 1989, 383, headnote): "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.

5.3 Skilled person - level of knowledge

In **T 60/89** (OJ 1992, 268) the board confirmed that the same level of skill had to be applied

when, for the same invention, the two questions of sufficient disclosure and inventive step were being considered. This chapter will cover the most important decisions in which comments were made on general technical knowledge in connection with inventive step (see also p.118).

According to **T 426/88** (OJ 1992, 427) a book providing general teaching in a general technical field covering the invention's specific technical field was part of the general knowledge of a specialist in that specific technical field. When books, representing common general knowledge, described a basic general technical theory or methodology and exemplified the same with specific applications in certain technical fields only, these did not limit the general scope and relevance of such disclosures so as to exclude possible applications in other fields. The appellant had argued that the book, written in German, was not a general reference book consulted by experts in that field in Great Britain. The board, however, adhered to the definition of the state of the art given in Art. 54, according to which no account was taken of the location at which the skilled person exercised his profession.

In **T 766/91** the board summarised the normally accepted view that common general knowledge was represented by basic handbooks and textbooks on the subject in question. It was knowledge that an experienced person in this field was expected to have, or at least to be aware of to the extent that he knew he could look it up in a handbook if he needed it. Statements in such works were used as convenient references to show what was common knowledge. However, the information itself was likely to have been published much earlier, for example in research papers or patents, or to have been used openly in industrial practice. It had usually not become common general knowledge because it had been published in any particular handbook or textbook, but rather it appeared in handbooks or textbooks because it was already common knowledge. That was why publication in, for example, an encyclopaedia or basic textbook could usually be accepted as evidence not merely that the information was known but that it was common general knowledge. Therefore, substantiation of an allegation that something was common general knowledge was only required if this was challenged by another party or the EPO.

Conference and research reports published in large numbers in relevant trade journals over a relatively short period and concerned with findings relating to technology currently at the breakthrough stage could reflect general common knowledge at the time (**T 537/90**).

In **T 632/91** the board stated that evidence which did not comprise a comparison of the claimed subject-matter with the state of the art might, nevertheless rebut a *prima facie* assumption that there existed some common general knowledge which would have allowed the skilled person to disregard structural differences of chemical compounds.

In **T 61/88** the board indicated that in the face of an optimal but sophisticated solution to a technical problem the skilled person could not be denied the capacity to recognise that less complicated alternatives generally achieved less perfect results and consequently to envisage such alternatives, at least in situations in which the advantages of decreased complexity could reasonably be expected to outweigh the resulting loss of performance.

6. Proof of inventive step

6.1 "Could-would approach"

6.1.1 General issues

According to the established case law of the boards of appeal, the decisive question was not whether a skilled person **could** have performed the subject of the contested patent but rather whether he **would** have done so in the expectation of solving the underlying

technical problem (**T 2/83**, OJ 1984, 265 and **T 7/86**, OJ 1988, 381). It is often possible to show after an invention has been developed that a skilled person could have been led to it by combining separate pieces of prior art, but such considerations had to be disregarded as resulting from an ex post facto analysis (**T 564/89**).

In **T 61/90** the board referred to the established case law, according to which the decisive question was not what the technical means as such might have made feasible for the skilled person, ie what he might have been able to do, but what he actually would have done with adequate certainty. **Technical feasibility** and the absence of obstacles were only necessary requirements for reproducibility but were not sufficient to render obvious **what was actually achievable** for the skilled person.

The fact that the inherent properties of a technical means were known to the skilled person, so that he had the intellectual possibility to apply this means in a conventional device, merely established the **possibility** of using such technical means in such a manner, ie that the skilled person **could** have used it. However, if it was to be established that such intellectual possibility was also a technical measure which it was obvious for the skilled person to use, it was necessary to show that there was a recognisable pointer in the state of the art to combine such known means and such conventional device for achieving the intended technical aim, ie that the skilled person **would** have made such a combination. The existence of such a technical reason was dependent on the known properties not only of the means but also of those of the device (**T 203/93**).

6.1.2 Expectation of success

In accordance with the case law of the boards of appeal, a course of action could be considered obvious within the meaning of Art. 56 if the skilled person would have carried it out in expectation of some improvement or advantage (**T 2/83**, OJ 1984, 265). In other words, obviousness was not only at hand when the results were clearly predictable but also when there was a reasonable expectation of success (**T 149/93**).

In some decisions in the field of genetic engineering the board asked whether in the cases in point it was obvious for the skilled person to try a suggested approach, route or method with a **reasonable expectation of success** (**T 60/89**, OJ 1992, 268).

Decision **T 500/91** related to methods and means for the production of alpha-interferon by genetic engineering. The board stated that the notional skilled person who might be represented by a team of appropriate specialists was oriented towards practicalities, and the development of the art normally expected by him did 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 under consideration was relatively new at the relevant date, and in the light of the uncertainty at the time about facts influencing the success of the attempted recombinant-DNA techniques, and the absence of a well-established general level of knowledge in that particular technical area, the present successful technical application of recombinant-DNA techniques according to claims 1 and 2 involved an inventive step.

In **T 296/93** the board held that, in relation to inventive step, the fact that other persons or teams were working contemporaneously on the same project might suggest that it was "obvious to try" or that it was an interesting area to explore, but it did not necessarily imply that there was a "reasonable expectation of success". "A reasonable expectation of success" should not be confused with the understandable "hope to succeed"; it implied

the ability of the skilled person to predict rationally, on the basis of the knowledge existing before a research project was stated, the successful conclusion of the said project within acceptable time limits. The more unexplored a technical field of research was, the more difficult it was to make predictions about its successful conclusion and, consequently, the lower the expectation of success. In the board's view, the successful achievement of the expression of HBV genes in a recombinant DNA system, regardless of whether it was just a "lucky strike" or the result of "looking for the unexpected" or of a planned strategy, was a major breakthrough in HBV research which, for the reasons given above, no prior art document had anticipated or rendered obvious. The board concluded that the subject-matter of the main request involved an inventive step.

In **T 223/92** the board had to examine whether the provision of interferon-gamma, free from other proteins with which it was normally associated, constituted an inventive contribution to the art. The board stated that since interferon-alpha and interferon-beta had already been produced by the recombinant-DNA technique, this method would in practice also have been considered as a possible route to make interferon-gamma available. However, in 1981, with regard to the prior art, while the skilled person might have opted to try the recombinant-DNA technique, he would only have attempted it despite success being very uncertain, for example because he trusted in his own luck, skill and inventive ingenuity to overcome the known and the - as yet - unknown problems involved, even though these problems were such that the average skilled person would expect to fail. Therefore, the board was convinced that there was no sufficient certainty that the skilled person in this situation would have tried this method with any reasonable expectation of success.

In the light of the closest prior art the board saw the technical problem to be solved in **T 886/91** in the exact identification and characterisation of DNA sequences of HVB genome subtype adyw. The board pointed out that the situation in **T 886/91** could not be compared with the one in **T 223/92** and **T 500/91**, where production of a partially known protein in a recombinant-DNA system was achieved and considered inventive on the basis of the fact that in the specific circumstances of the cases there was no realistic expectation of success. In the case in point the closest prior art had already disclosed the cloning and expression of the HBV genome subtype adyw. The identification and characterisation of the claimed specific sequences of the same genome involved for the skilled person nothing more than the performance of experimental work by routine means in connection with the normal practice of filling gaps in knowledge by application of existing knowledge (see also **T 455/91** and **T 915/93**).

In **T 63/94** the relevant question to be asked was whether a skilled person, faced with the problem of overcoming one or more of the known disadvantages of the prior art "two site" or "sandwich" assay methods, would in a straightforward manner have replaced therein the polyclonal antibodies by monoclonal antibodies with reasonable expectation of some improvement. The board observed that the claims at issue were quite generally worded and covered methods for antigen determination in which at least any two different monoclonal antibodies directed against the same antigen were used, irrespective of their specificity and/or affinity characteristics. The claimed innovation lay merely in the proposed use of a combination of at least two monoclonal antibodies in "sandwich" or "two-site" assays, the burden then being left to the skilled reader to find empirically the appropriate combination of antibody partners. The board stated that the patent specification made virtually no contribution to lessening this burden of work. The skilled person would have readily derived from a prior art document the suggestion that both polyclonal

antibodies be replaced by monoclonal antibodies in “sandwich” or “two-site” assays. The reproducibility of monoclonal antibodies, their availability in large amounts as well as their specificity and the constant affinity for single antigenic determinants would have constituted an incentive in this direction. The skilled person would have seen in monoclonal antibodies the suitable substitutes for products (polyclonal antibodies) which had disadvantages such as non-reproducibility and low specificity. The technical difficulties in connection with the identification of monoclonal antibodies with the required affinity and specificity characteristics would not have constituted for the skilled person a prejudice against replacement. In fact, the skilled person knew that the finding of a suitable antibody, whether by conventional or hybridoma-based techniques, varied considerably from one analyte to another and was merely a matter of time, perseverance and luck, and that the benefits of finding a suitable monoclonal antibody which could be reproducibly produced in general justified the effort required.

6.2 Combination invention

6.2.1 Existence of a combination invention

In assessing the inventive step involved in an invention based on a combination of features consideration must be given to whether or not the state of the art was such as to suggest to a skilled person precisely the combination of features claimed. The fact that an individual feature or a number of features were known does not conclusively show the obviousness of a combination (**T 37/85**, OJ 1988, 86, and **T 666/93**). When assessing inventive step in a combination invention the decisive criterion is not whether individual elements of the combination were known and obvious from prior art, but whether the state of the art would lead a skilled person to this particular overall combination of (possibly already known) features. Were this not so, it would be impossible for a combination consisting exclusively of known individual features to involve an inventive step (**T 388/89**, see also **T 717/90**, Case Law Report 1991, p. 28).

In **T 55/93** the appellant’s argument, according to which the alleged invention should be regarded as a mere aggregation of solutions of two independent partial problems which were not interrelated, was not accepted by the board. In the case in point, not only could the primary problem underlying the contested patent neither be found nor be derived from the prior art documents, but also the claimed features complemented each other. The board stated that the features were functionally linked together, which was the actual characteristic of a combination invention. It was of no consequence whether, in a combination invention, all features were possibly already known *per se*, separately. It was wrong to select, on the basis of a plurality of partial problems to be solved, the respective constructional means used in the apparatus combination, or the steps of the method worded in terms of functional features, which by working together provided a solution to the problem taken as a whole. The non-obviousness of a combination claim turned on the simultaneous application of all its features (**T 175/84**, OJ 1989, 71).

A mere aggregation of features must be distinguished from a combination invention.

In **T 410/91**, claim 1 related to firing equipment operable under turbocharge for a steam generator. The board of appeal stated that no inventive step was involved since, although all the measures in claim 1 contributed to an increase in the efficiency of the plant, that contribution was based on known, different individual effects which resulted in these measures being executed in a manner expected by the skilled person. The subject-matter of claim 1 therefore involved the stringing-together of known measures which displayed

- their characteristic effects; no synergistic effect based on a combination of the individual measures was discernible in the sense of a mutual influence on their respective operation (see also **T 144/85**).

In **T 407/91** the patent related to a process for the production of dimethyl ether of use as a propellant. The process steps (a) to (f) were known as such. The respondent submitted that the combination of features (a), (b) and (f), all known from document 1, with the features (c), (d), and (e), was not obvious to a person skilled in the art. The board, however, came to the conclusion that the **combination of known process features** by merely applying common general knowledge was not inventive. The process for the manufacture of dimethyl ether as disclosed in D1 required a distillative workup of the reaction mixture. In such a process, if the purity of a product was insufficient, it was usual for the skilled person to apply his common general knowledge regarding distillation methods when looking for improvements.

6.2.2 Partial problems

According to current case law, partial problems exist if the features or sets of features of a claim are a mere aggregation of these features or sets of features which are not functionally interdependent, ie do not mutually influence each other to achieve a technical success over and above the sum of their respective individual effects, in contrast to what is assumed in the case of a combination of features (see **T 294/90**). In **T 389/86** (OJ 1988, 87) the two claimed sets of features were not functionally interdependent. The board stated that, under such circumstances, the combined effect of the two sets of features could not be said to involve an inventive step. What had to be established instead was whether each of them separately was obvious in the light of the prior art. Moreover, the subject-matter of the claim could be regarded as involving an inventive step if only one of the sets was found to be inventive (see also **T 701/91**).

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.

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 comprised two technically independent partial problems. Because they were technically unconnected, the solutions to such partial problems were generally described in different published documents.

6.3 Consideration of features in the case of combinations of features

According to the established case law of the boards of appeal, features which do not contribute to the solution of the problem set in the description are not to be considered in assessing the inventive step of a combination of features (see **T 37/82**, OJ 1984, 71).

According to this decision, in assessing the inventive step of a combination of features, consideration had to be given to a feature only if the applicant had provided evidence that it contributed, either independently or in conjunction with one or more of the other features, to the solution of the problem set in the description (see also **T 65/87**, **T 144/90**, **T 206/91**, **T 574/92**). In **T 294/89** the board stated that the additional feature provided no surprising advantage and did not make any contribution to solving the problem indicated. Hence, the said additional feature was not relevant for assessing the inventive step of the combination of features claimed. In **T 144/90** the claim according to the auxiliary request differed from that according to the main request only by one feature which did not contribute to solving the objective technical problem, which was formulated on the basis of document D1 as the closest prior art and which the other features attempted to solve. Thus, this additional feature had to be disregarded when deciding whether the overall combination of features involved an inventive step. Therefore, only claim features which contributed causally to solving the problem had to be taken into consideration (**T 285/91**).

6.4 Similar use

If an article is known as a combination or mixture of components fulfilling known functions, the generation and application of an improved novel component for the same purpose may be patentable as such and also as an improved article incorporating the same. If the component in question forms, on the other hand, part of the state of the art together with its relevant properties, the incorporation thereof in the same article will be obvious in view of its predictable beneficial effect (**T 192/82**, OJ 1984, 415).

In this connection the board also established in **T 130/89** (OJ 1991, 514) that the use of a known material on the basis of its known properties and in a known manner to obtain a known effect in a new combination was not normally inventive ("similar use"). Exceptions to this principle might be allowed in special cases, eg where a selection brought unexpected advantages, a known prejudice was overcome or unforeseen difficulties were encountered, such as the need to alter another component.

Following these decisions, the board summed up in **T 213/87** that, in the absence of any unexpected effect, the mere substitution of an element by another known for its relevant properties to provide that known effect could not be regarded as patentable.

6.5 Combination of documents

It would not be obvious to a skilled person to combine an isolated, very old document, which had not given rise to a trend in the art and whose teaching ran counter to the present trend, with the document reflecting the closest state of the art (see **T 261/87**, **T 366/89**, confirmed in **T 404/90**).

In **T 745/92** the board pointed out that the disclosure of two prior documents - even if they were classified under the same IPC classification - could only be combined so as to result in a finding of lack of inventive step if such combination would have been obvious to a skilled person seeking to solve the problem underlying the claimed invention.

In **T 552/89** the board confirmed that, when assessing inventive step, it was not permissible to combine the teachings of different documents within the state of the art in order to establish the obviousness of a claimed invention, unless it would have been obvious for the skilled person to do so at the time of filing. When a problem defined by reference to the closest prior art as disclosed in a primary document consisted of individual

problems, board of appeal case law stated that the skilled person could be expected to take account of solutions to the individual problems proposed in different secondary documents in the same or neighbouring technical fields. Thus, the teachings of secondary documents might be combined with the disclosure of the closest prior art if such secondary documents provided solutions to specific individual problems forming part of the objective problem in progressing from the closest prior art, in particular when such individual solutions were merely aggregated together in the claimed invention.

According to established board of appeal case law, when examining what had been made available by a document, the disclosure had 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**, **T 138/89** and **T 666/89**, OJ 1993, 495). In **T 95/90** the board held that this meant that **different passages of one document** could be combined provided there were 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 were indeed representative of the general technical teaching disclosed in the document in question.

6.6 Structural similarity of chemical compounds

To deny inventive step for novel chemical compounds because of their structural similarity to known chemical compounds amounted to an assertion that a skilled person would have reasonably expected the same similar usefulness of both the known and the novel compounds as the means for solving the technical problem underlying the application in question. Such an expectation would be justified if the skilled person knew, be it from common general knowledge or from some specific disclosure, that the existing structural differences in the chemical compounds concerned were so small that they would have no essential bearing on those properties which were important for solving the said technical problem and could be disregarded (**T 852/91**).

6.7 Alloys and proof of inventive step

In **T 253/92** the subject-matter of claim 1 related to a method of making a permanent magnet alloy. In the board's view it was obvious to a skilled person to experiment with different alloys having compositions similar to those of the better examples given in the prior art and to measure their magnetic properties. In the course of such routine experimental work, the skilled person would have discovered the alloys which had a combination of excellent resistance to disintegration and an energy product of at least 28.1 MGoe, since these were not hidden properties but rather the very properties that the skilled person would be trying to obtain.

6.8 Equivalents

According to established board of appeal case law, equivalents which are not disclosed in a published document must not be considered in assessing novelty as this properly belongs to the examination for inventive step (**T 167/84**, OJ 1987, 369, **T 446/88**, see also Guidelines C-IV, 7.2). In **T 697/92**, the board dealt with the concept of "equivalent means", according to which two means were equivalent if, despite having different embodiments, they fulfilled the same function with regard to the same result. Both means performed the same function if they shared the same basic idea, ie if they applied the same principle in

the same way. The result was the totality of the technical effects produced by the means. In order to be considered as equivalents, the means had to achieve the same kind and quality of result. A means was thus not equivalent if, because of its different embodiment, it led to a result of the same kind but of a different quality or degree of effectiveness. The result did not necessarily even have to be better; it was sufficient for it to be different, since it was not the result itself which was patentable but the means by which it was achieved. In the present case the board held that there was an inventive step, as the means were not equivalent: whilst they had more or less the same function, they differed in their embodiments and the quality of the result achieved.

6.9 Problem inventions

The discovery of an unrecognised problem may in certain circumstances give rise to patentable subject-matter in spite of the fact that the claimed solution is retrospectively trivial and in itself obvious (see **T 2/83**, OJ 1984, 265, **T 225/84**). The posing of a new problem did not represent a contribution to the inventive merits of the solution if it could have been posed by the average person skilled in the art (**T 109/82**, OJ 1984, 473). It also had to be taken into consideration that it was the normal task of the skilled person to be constantly occupied with the elimination of deficiencies, the overcoming of drawbacks and the achievement of improvements of known devices and/or products (see **T 15/81**, OJ 1982, 2 and **T 195/84**, OJ 1986, 121). In **T 532/88** the board confirmed the established principle that to address a problem simply by looking for ways of overcoming difficulties arising in the course of routine work did not constitute inventiveness. Following this case law, the boards held in **T 630/92**, **T 798/92** and **T 578/92** that the posing of the problem could not confer any inventive merit on the claimed subject-matter.

In **T 971/92** the board emphasised that the appreciation of conventional technical problems which formed the basis of the normal activities of the notional person skilled in the art, such as the removal of shortcomings, the optimisation of parameters or the saving of energy or time, could not involve an inventive step. The appreciation of a technical problem could thus only contribute to the inventive step in very exceptional circumstances. However, if an applicant nevertheless wished to rely on an assertion that the inventive activity resided in the recognition of a technical problem to which the solution was admittedly obvious, then the minimum requirement to be met was that this technical problem be clearly and unambiguously disclosed in the application as filed.

In **T 566/91** the invention related to a soft nystatin pastille formulation for treatment of candidiasis in the oral cavity. In the case in point the board did not agree with the submission by the appellants that the technical problem underlying the contested patent consisted in the unrecognised problem of poor patient compliance, as the average skilled person could have posed that problem where - as in that particular case - one necessarily came to light when an object or product was used. Consequently, a problem which amounted to no more than noticing obvious non-compliance with an obvious desideratum in a given situation, namely poor patient compliance using nystatin formulation as a result of the unpleasant taste of the active substance, could not be retained as the actual problem to be solved.

In **T 540/93** the application related to a pet door enabling cats and dogs to enter a room directly unaided. The pet door known from the closest prior art suffered from the disadvantage that a pet, having once pushed its paw under the flap but then deciding not to continue passing through the door, might encounter difficulty or even injury when trying

to retract its paw which became trapped and wedged between the flap and the tunnel portion. The board, therefore, saw the objective problem as being to avoid paw injury if the pet changed its mind about proceeding through the pet door. The board concluded that the recognition of this particular problem contributed to the inventive step of the subject-matter. The board did not agree with the examining division that the problem of paw injury was obvious. Paw-trapping incidents might well have occurred repeatedly, but hardly with the same pet, since it either would have learnt how to proceed through the door or would have avoided the door in future. In some cases the pet would have freed itself but of course could not report to the owner why the accident had happened. While the malfunctioning occurred repeatedly it could not be said to be repeatable since - until the cause of pet injury or the reason why a pet refused to use the door were determined - the conditions for testing were hard to reproduce; only some pets would trap their paws and even then each pet would probably do so only once.

6.10 New use of a known measure

When determining inventive step in the case of a new use of a known measure, the boards of appeal examine whether or not the problem which has been solved with a known measure in a known case differs from the problem posed in the case to be decided. If this examination reveals that there is no fundamental difference between the two problems, it can in principle be concluded that there is no inventive step if the known measure is adopted (see in particular **T 39/82**, OJ 1982, 419, and **T 142/84**, OJ 1987, 112, **T 332/90**, **T 485/91**).

In **T 39/82** (OJ 1982, 419) the board decided that it was necessary to investigate whether the problem which had been solved with a known measure in a known case differed from the problem posed in the case to be decided. Since the problems differed fundamentally from one another it could not be considered obvious for the skilled person to use this known measure in a different context.

In **T 741/92** the invention consisted in the new use of a known means, namely of a certain mesh structure. In the case of such inventions, the board took the view that it was of little importance that the means was known *per se* if new properties and purposes came into play in its use. The known means was used in the invention to obtain a result not previously known or obvious.

Summing up in **T 301/90**, the board held that it was a generally accepted principle in the assessment of inventive step that, whereas the use of a known measure to achieve a known result on the basis of the expected inherent effect was not normally inventive, the indication of a new and non-obvious technical result, which could be achieved through these known effects (for the field of chemistry see **T 4/83**, OJ 1983, 498, and for the field of physics see **T 39/82**, OJ 1982, 419), might nevertheless convert the use of this known measure into a new and non-obvious tool for solving a new technical problem. It might thus represent an enrichment of the art and imply an inventive step (see **T 1096/92**, **T 238/93**).

In **T 590/90** the respondents argued that both the measures that distinguished the technical teaching of the contested patent from that of document 1 were as such already part of the prior art, and their application to the process described in document 1 was obvious. However, the board held that the application of a measure known as such, contrary to a warning supported by several documents, was not obvious. Since this measure involved an inventive step, the overall process of claim 1 encompassing that

measure likewise involved an inventive step: the modification of a known process by two measures, at least one of which was not obvious, rendered the entire process inventive.

6.11 Conceivable product

According to **T 595/90** (OJ 1994, 695), a product which could be envisaged as such with all characteristics determining its identity including its properties in use, ie an otherwise obvious entity, might nevertheless become non-obvious and claimable as such if there was no known way or applicable (analogous) method in the art for making it and the claimed methods for its preparation were therefore the first to achieve this and do so in an inventive manner.

6.12 Exchange of materials

According to **T 21/81** (OJ 1983, 15), selecting the most appropriate material from those known to him to be suitable for a certain purpose had to be considered part of the normal activities of the skilled person. In **T 410/92** the board stated that the use of high-grade materials as well when designing single-phase synchronous motors with a two-pole permanent-magnet rotor was obvious. The appellant had argued that a skilled person using the improved materials available to him would have produced motors with mysterious starting problems. The board, however, concluded that the occurrence of known problems when using newly developed materials could not deter the skilled person from using them to produce specific, desired improvements, especially as the means for eliminating such problems could be derived from the prior art.

6.13 Obvious new use

In **T 112/92** (OJ 1994, 192) document (1), as the closest prior art, referred to the use of glucomannan as a thickener for an ungelled processed food product, but did not mention its function as a stabiliser. The board applied the principles set out in **T 59/87** (OJ 1991, 561) to the present case and stated that even if glucomannan did act as an emulsion stabiliser in preparing the product 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.

6.14 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.

That case law was adopted by another board in **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 inventive. The board, however, concluded that a new

chemical intermediate did not become inventive merely because it was prepared in the course of an inventive multi-stage process and was further processed to a known end product. There had to be other factors too, 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 confirm the position expressed in **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 render the intermediates inventive."

6.15 Need to improve properties

In its headnote to **T 57/84** (OJ 1987, 53) the board stated: "If a product is required to manifest a particular property (in this case a highly fungicidal effect) under various conditions, the superiority of the invention will depend on whether or not that property is improved under all conditions liable to be encountered in practice and particularly under the various conditions evolved in order to test it (in this case exposure to water and wind). If comparative tests are cited in support of that superiority, it is their combined results that have to be considered. The decisive factor is whether the invention outperforms the substance used for comparison in the tests as a whole (in this case, results in the need to use a significantly lower concentration of the pollutant substance), even if the substance used for comparison proves better in one of the tests." Following **T 57/84**, it was stated in **T 254/86** (OJ 1989, 115) that an invention which relied on a substantial and surprising improvement of a particular property did not also need to show advantages over the prior art with regard to other properties relevant to its use, provided the latter were maintained at a reasonable level so that the improvement was not completely offset by disadvantages in other respects to an unacceptable degree or in a manner which contradicted the disclosure of the invention fundamentally (see also **T 155/85**, OJ 1988, 87). It was thus not necessary for there to be an improvement in every respect (**T 302/87** and **T 470/90**).

In **T 155/85** it was further pointed out that subject-matter falling structurally between two particular embodiments of cited disclosure and displaying, in all relevant respects, effects substantially between those known for the same embodiments, lacked inventive step in the absence of other considerations.

6.16 Optimisation of parameters

In key decision **T 36/82** (OJ 1983, 269), the board stated that inventive step was not considered to be constituted by efforts directed at the concurrent optimisation of two parameters of a particular device by the simultaneous solution of two equations which were known *per se* and respectively expressed those parameters as functions of certain dimensions of the device. The fact that it had proved possible to find a range of values for the dimensions in question which provided an acceptable compromise between the two parameters could not be considered surprising where there were indications in the prior art suggesting that favourable results might be obtained by the method of calculation applied.

In a number of other decisions, inventive step was denied with reference to the above decision, particularly if it was a case of finding a suitable compromise between various parameters.

In **T 263/86** the invention related to a spectacle lens with an astigmatic effect. The board of appeal pointed out that the relationship between residual astigmatism, focussing error and frequency response could be assumed to be known by a spectacles expert. The board therefore saw the quality formula as merely the result of simultaneous optimisation of a number of lens properties which led to a compromise lying within the skilled person's discretion. However, such compromises in the case of a parameter optimisation were not deemed to be surprising and their discovery was thus not considered to involve an inventive step (see also **T 38/87** and **T 54/87**).

In **T 410/87** the board stated that it was part of the activities deemed normal for the skilled person to optimise a physical dimension in such a way as to reach an acceptable compromise, serving the intended purpose, between two effects which were contingent in opposing ways on this dimension (see also **T 409/90**, OJ 1993, 40).

In **T 660/91** the board concluded that claim 1 lacked an inventive step because an optimisation of known contradictory properties in realising a further solution to a known problem was obvious.

In the following two decisions the boards of appeal came to the conclusion that there was an inventive step.

In **T 73/85** the board stated that the very fact that the problem of improving the property in question was solved not - as was normal - by means of a specific change in structural parameters but by amending process parameters had in fact to be considered surprising. In this case it did not matter that the individual reaction conditions claimed in the disputed patent were known *per se*; more important was whether the skilled person, in expectation of the sought-after optimisation had suggested, or - in the absence of possible predictions - had tried as a matter of priority, the combination of measures known *per se* claimed.

In **T 500/89** the board established that the fact that individual parameter areas taken *per se* were known did not imply that it was obvious to combine them specifically to solve the problem according to the contested patent. The combination of the individual parameter areas was not the result of merely routine optimisation of the process according to document 1, as there was nothing in said document to suggest this combination.

6.17 Small improvement of commercially used process

In **T 38/84** (OJ 1984, 368) the board of appeal pointed out that the achievement of a numerically small improvement of a process commercially used on a large scale (here enhanced yield of 0.5%) represented a worthwhile technical problem which should not be

disregarded in assessing the inventive step of its solution as claimed (see also **T 466/88** and **T 332/90**). In **T 155/85** (OJ 1988, 87) the board added that it was correct to say that even small improvements in yield or other industrial characteristics could mean a very relevant improvement in large scale production but the improvement had to be significant and therefore above margins of error and normal fluctuations in the field in consequence of other parameters.

6.18 Analogy process

The headnote to **T 119/82** (OJ 1984, 217) reads as follows, “The effect of a process manifests itself in the result, ie in the product in chemical cases, together with all its internal characteristics and the consequences of its history of origin, eg quality, yield and economic value. It is well established that analogy processes are patentable in so far as they provide a novel and inventive product. This is because all the features of the analogy process can only be derived from an effect which is as yet unknown and unsuspected (problem invention). If, on the other hand, the effect is wholly or partially known, eg the product is old or is a novel modification of an old structural part, the invention, ie the process or the intermediate therefor, should not merely consist of features which are already necessarily and readily derivable from the known part of the effect in an obvious manner having regard to the state of the art” (see also **T 65/82**, OJ 1983, 327).

6.19 Examples of the denial of inventive step

In the following cases the boards of appeal decided that the claims were not inventive.

The mere reversal of procedural steps in the production of component parts could not provide justification for inventive step (**T 1/81**, OJ 1981, 439). Also, 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. It stood to reason that if carrying out such a step was itself already obvious for other reasons, the natural choice of the particular means on the market-place was devoid of mental or practical effort, or of “purposive selection”, in the absence of anything to the contrary (**T 513/90**).

7. Secondary indicia in determining inventive step

7.1 General issues

According to established case law, a mere investigation for indications of the presence of inventive step is no substitute for the technically skilled assessment of the invention vis-à-vis the state of the art pursuant to Art. 56. Where such indications are present, the overall picture of the state of the art and consideration of all significant factors may show that inventive step is involved but this need not necessarily always be the case (see **T 24/81**, OJ 1983, 133, and **T 55/86**). Thus, secondary indicia are merely **auxiliary considerations** in the assessment of inventive step (**T 1072/92**, **T 351/93**).

In the “**Epilady**” case (**T 754/89**) the board detailed its reasons for ruling that an inventive step was involved. Although factors such as commercial success, the overcoming of

prejudice, the age of the documents cited, the cost of advertising and the creation of a new market segment, the satisfaction of a long-standing need, the existence of imitations and forms of infringement had received considerable attention, particularly in the parties' written submissions, the technical facts of the case were such that secondary indications of inventive step had lost any relevance.

7.2 Technical prejudice in the art

It is well established in the case law of the boards of appeal (see **T 119/82**, OJ 1984, 217, **T 48/86**) that inventiveness can sometimes be established by demonstrating that a known prejudice, ie a widely held but incorrect opinion of a technical fact, needs to be overcome. In such cases, the burden is on the patentee (or patent applicant) to demonstrate, for example by reference to suitable technical literature, that the alleged prejudice really existed (**T 60/82**, **T 631/89**, **T 695/90**).

A prejudice in any particular field relates to an opinion or preconceived idea widely or universally held by experts in that field. The existence of such prejudice is normally demonstrated by reference to the literature or to encyclopaedias published before the priority date. The prejudice must have existed at the priority date, any prejudice which might have developed later is of no concern in the judgment of inventive step (**T 341/94**).

Generally speaking, prejudice **cannot** be demonstrated by a statement in a single patent specification, since the technical information in a patent specification or a scientific article might be based on special premises or on the personal view of the author. However, this principle does not apply to explanations in a standard work or textbook representing common expert knowledge in the field concerned (**T 19/81**, OJ 1982, 51, **T 104/83**, **T 321/87**, **T 392/88**, **T 601/88**, **T 519/89**, **T 453/92**). In **T 515/91** the board regarded "ABC Naturwissenschaft und Technik" as a standard work (see also **T 461/92** and **T 152/93**). In **T 943/92** the existence of a prejudice was supported by a specialist book which reflected the technical knowledge in the special field of the contested patent. This book did not contain the opinion of just one specialist author, but that of experts in the field, as it had resulted from the collaboration of "numerous recognised scientists, technicians and practitioners as well as associations and institutes".

In order to claim that a prejudice has been overcome, the proposed solution has to go beyond the prevailing conventional teaching, ie contradicting the experiences and ideas of experts in the field; it is not enough to adduce the negative opinion of individual experts (**T 62/82**, **T 410/87**, **T 500/88**, **T 74/90**, **T 943/92**). 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**, **T 862/91**).

In **T 347/92** the board pointed out that the finding of a relatively small operating window in an area which, according to the teaching of the most recent publications, was considered inaccessible, could not be considered obvious to a person skilled in the art.

Indicative evidence similar to "technical prejudice" is a development of the art in a different direction (see in this connection **T 2/81**, OJ 1982, 394, **T 650/90**, **T 330/92**).

7.3 Age of documents

The age of documents known long before the filing date may only be an indication of inventive step if a need for the solution of an unsolved problem had existed for the whole time between the date of the documents and that of the invention (**T 79/82** and **T 295/94**).

• A period of 23 years between the publication date of the document deemed to be the closest prior art and the priority date of the contested patent in an economically significant and frequently studied field can normally be viewed as an indication of the presence of inventive step (**T 273/92**). In **T 203/93** a period of 11 years was considered to be an indication in support of inventive step, and in **T 986/92** a period of 70 years (see also **T 774/89**, **T 957/92**).

In **T 330/92** the documents reflecting the general knowledge available to experts in the field of the application (injection mould technology for cashcard holders) had been published at least 17 years before the filing date of the contested patent. The board of appeal pointed out that the elements which could have led to the feature combination of claim 1 had thus long been known in the prior art. Nevertheless the experts had for all this time been “blind” to these findings. Nor had other applicants in the same field made use of the knowledge in question.

In **T 478/91** the appellant emphasised the period of over 80 years which had elapsed between publication of the cited document (1899) and the filing of the contested European patent. The board found that, in some cases, this criterion of time indicated the presence of inventive step. Nevertheless, the long period of time to be considered was not the period that had elapsed between the publication of a document and the filing of the European patent application disclosing the teaching of that document, but that between the time the problem became apparent and the date of filing of the European patent application providing a solution thereto.

In **T 540/92** the board held the time factor, ie the 16 years which had elapsed between the date of publication of the closest prior art (document 1) and the priority date of the contested patent to be of considerable importance in a field as active as aromatic polyetherketones as evidenced by the large number of documents cited by the respondents. In particular, the fact that such a long time had been necessary to provide a general solution to various shortcomings which were well-known but had always been considered in isolation spoke for the inventiveness of the solution.

7.4 Commercial success

In principle, commercial success alone is not to be regarded as indicative of inventive step. The following requirements must first be met (see Guidelines for Examination C-IV,9.9): a long-felt need must have been fulfilled, and the commercial success must derive from the technical features of the invention and not from other influences (eg selling techniques or advertising).

In **T 110/92** the board did not dispute that the heating assembly according to claim 1 might have become a commercial success. However, such a commercial success alone, with the technically relevant examination of the claimed subject-matter leading to a negative result, could not be regarded as forming the basis for an indication of inventive step even if the board were convinced that the success derived from technical features of the heating assembly and not from other causes such as those of a commercial nature (see **T 5/91** and **T 219/90**).

In **T 478/91** too, commercial success was not regarded as indicative of inventive step. The board pointed out that it was well known that the commercial success of a product could just as easily be due to factors quite apart from its properties, in particular more streamlined manufacture, a market monopoly, advertising campaigns or efficient selling technique (see **T 270/84**, **T 257/91**, **T 712/92**).

In **T 677/91** the board took the commercial success of the claimed invention into consideration and stated that it would have been wrong to ignore the practical impact that the invention had made in its own field since the priority date. For example, in several passages of a textbook reference was made to the fact that the various advantages of the claimed invention had brought in a new era in this special field. The board concluded that it was difficult to reconcile the contents of such passages with the idea that the claimed invention was a matter of mere routine development and thus held that the invention involved an inventive step.

Efforts undertaken by market competitors to obtain rights of joint use are a subsidiary instance of an indication of commercial success and may result in a decision in support of the presence of inventive step, but need not necessarily do so. In **T 351/93** the board stated that the latter applied particularly where a technical and expert assessment of the invention in the light of the prior art led, according to the problem-solution approach, to the conclusion that the existence of inventive step had to be denied.

7.5 Satisfaction of a long-felt need

The fact that the state of the art has been inactive over a long period prior to the invention may be an indication that an inventive step is involved if during that time an urgent need for improvement has demonstrably existed (see **T 109/82**, OJ 1984, 473, **T 555/91**, **T 699/91**).

In **T 605/91** the board stated that it was not sufficient if only one individual skilled person discovered a “long-felt need”. Only if various and repeated attempts to deal with the relevant disadvantages could be identified would such a long-felt need appear to have persisted. The board therefore held that the time which had elapsed between document D1 and the claimed subject-matter (16 years) was not sufficient to prove the assumed “long-felt need”. In particular, this time could not prove the existence of insurmountable prejudices which would have hindered the skilled person in finding obvious solutions to the corresponding problems.

In **T 1014/92** the board did not accept the appellant’s further argument, that the long period of time (about 35 years) for which documents (1) and (2) had been available to the public without having been combined was in itself cogent evidence that there was no obvious connection between them. The board held that this conclusion might only be drawn if evidence relating to time were corroborated by other evidence, such as long-felt want. Therefore, a finding of obviousness, based on an objective evaluation of the state of the art, could not be affected by the mere fact that two documents had not been combined by a skilled person for a considerable period of time.

If a process has been performed successfully on a commercial scale for more than 20 years in spite of economic disadvantages associated with it, and the claimed invention provides a solution to the technical problem of avoiding such economic disadvantages, this supports a finding of inventive step (**T 271/84**, OJ 1987, 405).

7.6 Simple solution

In a technical field of commercial importance to which considerable attention is directed the simplicity of a proposed solution may indicate inventive step. The difficulty of developing a simple solution without sacrificing quality may therefore indicate inventive step (**T 106/84**, OJ 1985, 132, **T 229/85**, OJ 1987, 237, **T 9/86**, OJ 1988, 12, **T 29/87**, **T 44/87**, **T 528/89**).

In **T 234/91** it was pointed out that experience in structural engineering showed that with the same or even an improved effect - in the case in point an increase in reliability - it was often much more difficult to identify and achieve a simple solution than complicated embodiments. In view of the large number of solutions suggested in the technical literature, the board came to the conclusion that the improvement achieved by the simple structural measure suggested in the contested patent had not been obvious.

In **T 330/87** the board came to the same conclusion. Looking at it retrospectively, the claimed solution seemed simple. However, the board did not consider the measure to be obvious as it was not plausible that such a simple measure which satisfied a long-felt need and was clearly commercially successful had not been realised long before.

In **T 712/92** the board pointed out that although the simplicity of a proposed technical solution could be indicative of inventiveness, nevertheless the recognition of an inventive step presupposed the absence in the prior art of hints at the proposed solution. In the case in point, the board was of the opinion that the skilled person was prompted by the state of the art to go in the direction of the claimed method.

A different aspect was dealt with in **T 113/82** (OJ 1984, 10). In order to proceed from the known art to the invention, a series of steps needed to be taken. The board stated that this could be considered as an indicator of the presence of inventiveness, particularly in a case where the last decisive step had neither been proved to be known from the prior art nor was derivable therefrom, although this last step might at first sight seem to be a very simple one (see also **T 315/87**, **T 508/88**, **T 424/89**, **T 394/90**).

7.7 Surprising effect

7.7.1 "Bonus effect"

An effect which may be said to be unexpected can be regarded as an indication of inventive step (**T 181/82**, OJ 1984, 401). However, certain preconditions have to be met. In **T 21/81** (OJ 1983, 15) the board considered that if, having regard to the state of the art, it would already have been **obvious** for a skilled person to arrive at something falling within the terms of a claim, because an advantageous effect could be expected to result from the combination of the teachings of the prior art documents, such claim **lacked** inventive step, irrespective of the circumstance that an extra effect (possibly unforeseen) was obtained (see **T 365/86**, **T 350/87**, **T 226/88**). This case law was also confirmed in **T 69/83** (OJ 1984, 357). Where, because of an essential part of the technical problem being addressed, the state of the art obliged a skilled person to adopt a certain solution, that solution was not automatically rendered inventive by the fact that it also unexpectedly solved part of the problem.

Furthermore, in **T 192/82** (OJ 1984, 415) the board stated that the skilled person had to be free to employ the best means already available for his purposes, although the use of means leading to some expected improvements might well be patentable in relying on an additional effect, provided this involved a choice from a multiplicity of possibilities. The lack of alternatives in this respect might therefore create a **"one-way-street"** situation leading to predictable advantages which remained obvious in spite of the existence of some unexpected "bonus" effect. The board also pointed out in **T 506/92** that an additional effect achieved inevitably by the skilled person on the basis of an obvious measure without any effort on his part simply represented a bonus under EPO case law which could not substantiate inventive step, even as a surprising effect.

In **T 227/89** the board stated that in determining which effect was crucial and which was merely accidental (so-called “bonus effect”), a realistic approach had to be taken, considering the relative technical and practical importance of those effects in the circumstances of a given case (see also **T 732/89** and **T 729/90**).

When assessing chemical substances for inventive step, it is often their surprising properties that are considered (see in this connection **T 20/83**, OJ 1983, 419).

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

In **T 551/89** the board stated that an effect which was to be expected as the result of an obvious measure could not contribute to recognition of the required inventive step, even if the scale of this effect was surprising to the skilled person. In this case an effect whose scale surpassed the skilled person’s hopes merely represented a bonus effect following inevitably from the use of an obvious measure and obtained by the skilled person without any inventive effort on his part.

In **T 240/93** the application related to an apparatus for the surgical treatment of tissues by hyperthermia, equipped with heat protection means. The application was refused by the examining division, which considered the short treatment duration of one hour and further advantages resulting from the use of cooling means to be extra (bonus) effects. The board, however, stated that in the case in point the objective problem underlying the invention was to provide an apparatus for the effective therapeutic treatment of benign prostate hyperplasia in a short period of time. In view of the many considerable practical advantages of a single one-hour hyperthermia session for a patient, such a short treatment duration could not be dismissed as a mere “bonus” effect, but was crucial to the invention and basis of the objective problem.

7.7.2 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 were submitted as evidence of an unexpected effect, there had to be the closest possible structural approximation in a comparable type of use to the subject-matter claimed. In the case in point the respondent (proprietor of the patent) strengthened support for his claim by voluntarily providing comparisons with variants which, although not expressly belonging to the prior art, differed from the claimed subject-matter only by the distinguishing feature of the invention. The board summarised its position by stating, that in cases where comparative tests were chosen to demonstrate an inventive step with an improved effect over a claimed area, the nature of the comparison with the closest state of the art had to be such that the effect was convincingly shown to have its origin in the distinguishing feature of the invention. For this purpose it might be necessary to modify the elements of comparison so that they differed only by such a distinguishing feature.

In **T 390/88** the board addressed the question of the circumstances under which the production of comparative examples was unnecessary. In the above-mentioned earlier cases the invention had been obvious *prima facie* because the products, although novel,

were very close structurally to the prior art products. The case in point was different. Here, the board said that the production of comparative examples was not essential to establish inventiveness, as the invention had not been obvious from the outset (**T 656/91**).

In **T 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).

8. Evidence of obviousness

In **T 889/91** the appellant (opponent) objected that when the opposition division found that the subject-matter of the patent did not “inevitably” emerge from the prior art in its examination for inventive step, it was using the criterion for the novelty examination. The board contradicted this, stating that it was clear that the indications in the prior art had been judged to be insufficient to lead the skilled person to the subject-matter of the claim with any certainty. Evidence of obviousness was based in principle on a definite, logical conclusion from given premises. In common - albeit often not particularly clear - linguistic usage, this deductive certainty for the skilled person was said to be “inevitable” (or “conclusive”). The appellant appeared to be confusing this with the likewise conclusive certainty of actual pre-existence, ie the description of the subject-matter of a claim, which was required to establish the absence of novelty.

II. CONDITIONS TO BE MET BY AN APPLICATION

A. Sufficiency of disclosure

Art. 83 stipulates that the application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

1. Parts of the application relevant for assessing sufficiency of disclosure

It has been consistent case law of the boards of appeal 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 - (see also **T 169/83**, OJ 1985, 193) and not of the claims alone (see eg **T 202/83**, **T 179/87** dated 16.1.1990, **T 435/89**, **T 82/90**, **T 126/91**).

In **T 32/84** (OJ 1986, 9) it was pointed out that the fact that certain elements of an invention essential to its operation were not referred to explicitly either in the claims, or in the relevant portion of the description nor shown in the drawing of the invention as claimed did not necessarily mean that the application did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art as required by Art. 83. In the case in question a person skilled in the art could have put the invention into practice by applying a principle disclosed in the description which showed as essential to the invention an element shown not in the figure illustrating the invention as claimed but in another figure in the application. This, however, only applied if he did not make use of additional teachings and no inventive step was involved.

2. Knowledge of skilled person relevant for assessing sufficiency of disclosure

The disclosure is aimed at the skilled person.

(a) The skilled person may use his common general knowledge to supplement the information contained in the application (**T 206/83** (OJ 1987, 5), **T 32/85**, **T 51/87** (OJ 1991, 177), **T 580/88**, **T 212/88** (OJ 1992, 28), **T 772/89**, **T 231/92**). He may even recognise and rectify errors in the description on the basis of such knowledge (**T 171/84** (OJ 1986, 95), **T 226/85** (OJ 1988, 336), **T 206/83** (OJ 1987, 5)). According to decisions **T 171/84**, **T 51/87**, **T 580/88** and **T 772/89**, textbooks and general technical literature form part of the common general knowledge.

According to **T 171/84**, other patent specifications cannot normally contribute to the sufficiency of the disclosure unless they are available to the skilled reader of the patent in question. By the same token, documents cited by the appellant in the statement of grounds must also be disregarded.

T 206/83 makes it clear that information which can only be obtained after a comprehensive search is not to be regarded as part of common general knowledge (see also **T 654/90**).

By way of exception, however, patent specifications and scientific publications may be considered to form part 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 51/87** (OJ 1991, 177) and **T 772/89**).

In **T 60/89** (OJ 1992, 268) 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 (see also p. 96).

(b) References may also enable the skilled person to carry out an invention.

For example, **T 6/84** (OJ 1985, 238) established that structural features of a means for performing a chemical process (in this case the catalyst “offretite”) which are not mentioned in the application documents themselves but in a document (in this case a Canadian patent specification) to which they refer may be incorporated into a patent claim if they unequivocally form part of the invention for which protection is sought. However, all the essential structural features thus disclosed which belong together must be incorporated into the claim; it is not permissible to single out a particular one (in this case a silica/ alumina ratio).

In **T 288/84** (OJ 1986, 128) it was established that where an invention relates to the improvement of prior art originally cited in the description of the invention, a feature (in this case “activated” support) described in broad terms in the cited document but not mentioned expressly in the invention is sufficiently disclosed if it is realised in the examples of the invention in the form of an embodiment also mentioned in the reference document (in this case activation by grinding).

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 discover how to carry it out.

An invention is also sufficiently disclosed if reference is made to another document in the patent specification and if the skilled person can obtain from this cross-reference the information required to reproduce the invention but not disclosed in so many words in the description itself (**T 267/91**).

If the disclosure of a document is supplemented by a reference to another document, that reference can only be taken into account if it was available to the relevant addressees of the document containing the reference. This means that the document referred to must be unambiguously identified and that the relevant addressees must have ready access to it. It was held in **T 737/90** that the answer to the question whether or not a document incorporated in the text of a European patent application by way of a reference could be unambiguously identified and easily retrieved depended solely on the facts of the case. Neither Art. 123(2) nor the Guidelines for Examination required or implied that a patent application referred to had to be identified by a number in order to be taken into account for the purposes of Art. 83. In the case in question the information available from the application in suit was the date of filing, the applicant and the technical field of the application referred to. This enabled the EPO, by using its database, to identify the application referred to unambiguously and without undue difficulty, since only two applications had been filed by the applicant in question on the relevant date and in the relevant technical field and one of those was the application in dispute, so that the other one had to be the one referred to. In the particular circumstances of the case, the patent application referred to could also easily be retrieved by the public on the publication date of the disputed application by consulting the European Patent Bulletin.

The reference in **T 156/91** presented a special case. The contested patent related to a catalytic, isothermal process for the dehydration of ethylbenzene to styrene in the presence of water vapour. The process involved the use of a catalyst whose composition

and method of manufacture had been kept secret by the manufacturers. The board expressed doubts about the sufficiency of disclosure of an invention that could be carried out only with products whose method of manufacture was not disclosed but which were commercially available, although their availability was not guaranteed for any identifiable period. Catalyst manufacturers would in fact supply their products without modifications only as long as there was a demand for commercially viable quantities. The fact that commercial catalysts could in principle be analysed did not mean that they were available to the public since, if they were to be permanently available, the details of their manufacturing process would also have to be disclosed. The reproducibility of the dehydration process therefore involved extreme dependence on the catalyst manufacturer. Since the process lacked inventive step, however, the board did not ultimately have to resolve the question of reproducibility.

3. Clarity and completeness of disclosure

In **T 219/85** (OJ 1986, 376) it was found that the invention had been insufficiently disclosed and the applicant had failed to comply with the requirements of Art. 83 if he acknowledged during examination proceedings that he had not furnished actual details of the production process in the description in order to prevent the invention being easily copied, and if the missing information could not be supplied from the general knowledge of a person skilled in the art.

It must be possible to reproduce a claimed step using the original application documents without any inventive effort over and above the ordinary skills of a practitioner (**T 10/86**).

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 particular variants of a functionally defined component feature of the invention is immaterial to sufficiency as long as there are suitable variants known to the skilled person through the disclosure or common general knowledge which provide the same effect for the invention. This has been confirmed by the following decisions: **T 81/87** (OJ 1990, 250), **T 301/87** (OJ 1990, 335), **T 212/88** (OJ 1992, 28), **T 238/88** (OJ 1992, 709), **T 182/89** (OJ 1991, 391), **T 19/90** (OJ 1990, 476), **T 740/90**, **T 456/91** and **T 242/92**.

In **T 281/86** (OJ 1989, 202) the board held that there was no requirement under Art. 83 for a specifically described example of a process to be exactly repeatable. Variations in the constitution of an agent (in this case: genetic precursor) used in a process are immaterial to the sufficiency of the disclosure provide the claimed process reliably leads to the desired product (reasons 6) (see also **T 292/85** (OJ 1989, 275), **T 212/88** (OJ 1992, 28), **T 182/89** (OJ 1991, 391)).

In decision **T 409/91** (OJ 1994, 653) the board clarified this aspect of the case law and, with regard to sufficiency of disclosure, refused to accept the applicant's reasoning that sufficiency should be acknowledged because one way of obtaining small wax particles, namely using the additives, had been disclosed. In the board's view, the disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed **in the whole range claimed**. This was considered a question of fact. However, the board compared the case in question to cases where a group of chemical compounds is claimed and not all the claimed compounds can be prepared by the methods disclosed in the description or forming part of common general knowledge. It was not considered sufficient to disclose a method of obtaining **only some** members of the claimed class of

chemical compositions. In the board's view, sufficiency of disclosure presupposes that it enables the skilled person to obtain substantially **all** embodiments falling within the ambit of the claims. This was also the view taken by the board in decisions **T 19/90** (OJ 1990, 476), **T 435/91** (OJ 1995, 188), **T 242/92**, **T 418/91**, **T 548/91** and **T 659/93**.

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 reproducibility 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 (which had only recently been discovered, and could not yet be cultivated or precisely described) 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.

4. Reproducibility without undue burden

The disclosure must be reproducible without undue burden.

In decision **T 226/85** (OJ 1988, 336), which followed **T 14/83** (OJ 1984, 105), the board considered that even though a reasonable amount of trial and error was permissible when it came to the sufficiency of disclosure, eg in an unexplored field or where there were many technical difficulties, the skilled person had to have at his disposal, either in the specification or on the basis of common general knowledge, adequate information leading necessarily and directly towards success through the evaluation of initial failures. The same view was taken in decisions **T 48/85** and **T 307/86**.

In **T 487/91** the board held that it sufficed for the disclosure of an invention that the means intended to carry out the invention were clearly disclosed in technical terms which rendered them implementable and that the intended result was achieved at least in some, equally realistic, cases.

The occasional failure of a process as claimed does not impair its reproducibility if only a few attempts are required to transform failure into success, provided that these attempts are kept within reasonable bounds and do not require an inventive step (**T 931/91**). Nor is reproducibility impaired if the selection of the values for various parameters is a matter of routine and/or if further information is supplied by examples in the description (**T 107/91**).

Several decision addressed the question of what constituted undue burden.

In **T 32/85** the skilled person could only establish by trial and error whether or not his particular choice of numerous parameters would provide a satisfactory result. This was considered to be an undue burden under the circumstances.

According to **T 256/87** all that had to be ensured was that the skilled person reading the specification would be able to carry out the invention in all its essential aspects and know

when he is working within the forbidden area of the claims. The possibilities of indirect empirical investigation referred to in the specification were in the board's view an acceptable solution which was sufficient in itself to fulfil the requirement of Art. 83 without undue burden.

In **T 312/88** it was held that experiments constituted an undue burden if they first of all had to find the solution to the problem and were not carried out just to determine the numerical limits of a functionally defined range.

According to **T 475/88** experiments should quickly give a reliable picture of how the products can be produced or manufactured.

In **T 721/89** the board was of the opinion that there was no requirement in the EPC to the effect that, where it was not explicitly described how the claimed invention was to be carried out, this had to be practicable with the aid of only a few additional non-disclosed steps. Rather the only essential requirement that had to be fulfilled was that each of those additional steps be so apparent to the skilled person that, in the light of his common general knowledge, a detailed description of them was superfluous.

In **T 418/89** (OJ 1993, 20) it was held that if the description of the invention left the skilled person in doubt, so that he could not carry out the invention on the strength of his own skill and a reasonable amount of experimentation. The disclosure was not sufficient.

5. Biotechnology

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, there is no requirement under Art. 83 for a specifically described example of a process to be exactly repeatable (**T 281/86** (OJ 1989, 202), **T 181/87**, **T 299/86** (OJ 1988, 88), **T 19/90** (OJ 1990, 476)).

Several decisions deal with important points of procedural and substantive law relating to European patent applications based on a deposit of micro-organisms.

5.1 General

In **T 158/91** the board held that the question of sufficient disclosure has to be examined in each case on its own merits. An examination as to the sufficiency of a disclosure depends on the correlation of the facts of the case to certain general parameters. These parameters include, for example, the character of the technical field and the average amount of effort necessary to put into practice a certain written disclosure in that technical field, the time when the disclosure was presented to the public and the corresponding common general knowledge, and the amount of reliable technical details disclosed in a document.

5.2 Reproducibility of biological inventions

The boards of appeal have several times been faced with the question of the reproducibility of an invention on the basis of the description.

5.2.1 The extent to which the invention must be reproducible

On the particular facts of the case 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 materials 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 19/90** (OJ 1990, 476) the invention was defined by the incorporation of an activated oncogene sequence into the genome of non-human mammalian animals in general. The examining division had decided that the disclosure of the invention 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 carried 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. Distinguishing **T 226/85** (OJ 1988, 336), where the information provided in the application had been held insufficient, the board found that 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".

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 board went on to say that the sufficiency of disclosure with regard to an intermediate plasmid in the field of genetic materials primarily depended 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 was verifiable and there were no elements or components in the plasmid which would contradict this, the description was 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. 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 approach was continued in decision **T 181/87**. Here the board 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 was 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 repeatedly to produce the claimed monoclonal antibody reliably and there is thus no need to reproduce identically the example given in the specification".

5.2.2 Undue burden

In **T 412/93**, the board rejected claim 3 of the main request which read "a cDNA sequence according to claim 1 or 2" on the ground that the patentee had not been able to show that the common general knowledge in the art would have enabled the skilled person to obtain a mRNA from which a complementary single-stranded DNA coding for human erythropoietin could be synthesised by reverse transcription in vitro at the priority date, given only the extremely scant information in the patent-in-suit.

On examining an auxiliary request, the board had to consider whether claim 1 was also insufficiently disclosed, in the light of their conclusions regarding claim 3, because it covered human cDNA. The board held that it could not be assumed from the mere existence of dependent claim 3 as granted that cDNA necessarily fell within claim 1. Moreover, the advantage in the cDNA appeared not so much to lie in the sequence itself, but in having a route via mRNA by which this sequence could be obtained.

The opponents/appellants argued that the time the skilled person would require to arrive at something falling within claim 1 amounted to an undue burden, especially in view of the errors and omissions contained in the examples. They therefore argued that the patent did not comply with Art. 83. The board noted that this argument conflicted with evidence submitted in support of the ground of obviousness and, by verification and comparison of the different experimental reports submitted by the parties, concluded that the time needed for carrying out the invention substantially coincided with the estimates put forward by the patentee. Whilst the board accepted that the disclosure of the patent still required the public to invest a lot of time and effort, it held that this did not, in the circumstances, amount to an undue burden. Although errors and omissions prejudiced the reproducibility of one of the examples in toto and of another example in part, these examples were considered as alternative ways of previous examples and did not render uncertain the reproducibility of the invention.

In **T 223/92** the board rejected an objection by the appellant/opponent that the provision of a DNA sequence coding for human interferon-gamma was in itself not sufficient and that

it amounted to an undue burden for the skilled person to repeat the invention on the basis of this knowledge.

The board was well aware of the fact that even with the full disclosure of the DNA sequence, reproducibility of the whole process of expressing the gene to produce the desired interferon gamma was still a difficult, complex and time consuming task in 1981. However, the board was nevertheless convinced that the provision of the DNA sequence in 1981 enabled those skilled in the art to reproduce the invention, possibly in a time consuming and cumbersome way, but, in the given circumstances, without undue burden of experimentation and without needing inventive skill.

However, in **T 772/89** the board considered whether the description contained a disclosure that enabled a skilled person to prepare the two kinds of host claimed, that is, a host suitable for cloning and a host suitable for expressing a genomic bovine growth hormone sequence. The board held that the disclosure was insufficient in respect of the second kind of host, as the skilled person could not have found suitable expression hosts in a straightforward manner at the priority date.

5.3 Deposit of living material

According to R. 28, if an invention concerns a microbiological process or the product thereof and involves the use of a micro-organism which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in Art. 83 if a culture of the micro-organism has been deposited with a recognised depository institution within a given time limit.

Several decisions of the boards of appeal deal with the various aspects relating to the deposition of micro-organisms.

5.3.1 Substantive questions

In decision **T 418/89** (OJ 1993, 20) the board had to decide whether the deposited hybridoma enabled the skilled person to carry out the invention as claimed. 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. Repeated requests for deposit samples and advice from the depository institution were both necessary. 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. A disclosure is not regarded as being sufficient if and when 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 the characteristics of the deposit differed from the written disclosure in the patent. 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**.

In **T 349/91** the board held that an application was not sufficiently enabling where a

laborious screening process was necessary to produce a hybridoma cell line secreting an antibody corresponding to a specific deposited antibody.

However, R. 28(1) cannot be interpreted such that there is an obligation to deposit material to facilitate the reproduction if the invention can be repeated on the basis of the written description, even if this should be a much more cumbersome way than by merely growing the deposited micro-organism (**T 223/92**).

Similarly, in **T 412/93** the board stated that the need for a deposit cannot be introduced by reference to the concept of undue burden. This concept relates more to cases where the route that the reader is to follow is so poorly marked that success is not certain such as in **T 418/89** (see above). If the road is certain but long and laborious, the patentee is under no obligation to assist the disclosure by making actual physical samples available. The board felt that to come to the opposite conclusion would be effectively to introduce a requirement to make the best mode immediately accessible to the public, and such a requirement is not part of the European Patent system.

5.3.2 Procedural questions

a. Identity of applicant and depositor

According to decision **T 118/87** (OJ 1991, 474) the patent applicant and depositor must, in principle, be one and the same. However, where a parent company has authorised a subsidiary to deposit micro-organisms on its behalf for patent applications which the parent company intended to file, special circumstances may exceptionally justify considering the parent company and subsidiary as one entity for the purpose of R. 28. Here, the special circumstances were that the parent company alone had full control of the deposits and the actual depositor had acted only as executive organ for the applicant.

b. Deficiency in deposit

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.

A number of decisions affirmed the principle that one important purpose of R. 28 is to make the availability of the deposited organisms independent of any consent by the depositor.

In **T 39/88** (OJ 1989, 499) 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. According to US practice, a deposited micro-organism is not normally made available to the public without the consent of the depositor unless, and until, a US patent is granted. The board therefore held that the deposit could only be considered as covering the US application and that R. 28 had therefore not been complied with.

Nevertheless, the board held that it was not justifiable to refuse the European application on these grounds alone, as it had been filed at a time when it was still unclear how to deal with deposits originally filed for the purpose of national US applications and then used for

claiming priority for subsequent European applications. It was unfair to let the applicant bear the whole risk of this lack of clarity which was inherent in the system of deposit at the time. Comprehensive information was first published in an EPO Notice in 1986 (OJ 1986, 269), and thus only from that time was it made clear that the proper way of bringing a deposit originally filed for another purpose into line with the requirements of the EPC was formally to convert the deposit into a deposit under R. 28 or the Budapest Treaty, as appropriate, not later than the date of filing of the European application.

Decisions **T 239/87**, **T 90/88** and **T 106/88** also deal with cases which are in all relevant respects identical to **T 39/88**.

c. Late submission of deposit number

According to R. 28(1)(c), the application must state the depositary institution and the file number of the culture deposit.

In decision **G 2/93** (OJ 1995, 275) the Enlarged Board of Appeal held that the information concerning the file number may not be submitted after expiry of the time limit set out in R. 28(2)(a) (ie sixteen months after the date of filing of the application or, if priority is claimed, after the priority date).

The Enlarged Board reasoned that the provisions of R. 28 are subordinate to the requirements of Art. 83. In order to be sufficient under Art. 83, the disclosure of an invention in a European patent application must further enable a person skilled in the art to carry out the invention. This requirement is satisfied under R. 28 by making a deposited culture available to the public. This availability is brought about by stating the depositary institution and the file number of the culture deposit in the application, because, under R. 28(2), the "communication of this information" is regarded as constituting the unreserved and irrevocable consent of the applicant to the deposited culture being made available to the public within the meaning of R.28. The mere indication of the identification reference given by the depositor to the micro-organism does not bring about this legal effect.

The Enlarged Board thus concluded that the indication of the file number of a culture deposit in a patent application is substantive, because, under the EPC, it is instrumental in enabling a person skilled in the art to carry out the invention.

6. The relationship between Article 83 and Article 84

6.1 Article 83 and support from the description

In **T 94/82** (OJ 1984, 75) it was pointed out that the patent claims had to clearly define the subject-matter for which protection was sought (Art. 84). This requirement might be fulfilled in a claim to a product when the characteristics of the product were specified by parameters related to the physical structure of the product, provided that those parameters could be clearly and reliably determined by objective procedures which were usual in the art. In such a product claim, it sufficed to state the physical properties of the product in terms of parameters, since it was not mandatory to give instructions in the claim itself as to how the product was to be obtained. The description, however, had to fulfil Art. 83 and thus enable the person skilled in the art to obtain the claimed product described therein (see also **T 487/89** and **T 297/90**).

As explained in **T 127/85** (OJ 1989, 271), it is however of relevance whether a problem falls under Art. 83 or Art. 84 since in the first case examination in respect of this requirement is still permitted during opposition proceedings while in the second case it is limited during

opposition proceedings to those cases where there has been an amendment (see also **T 301/87** (OJ 1990, 335, reasons 3)). For examination in respect of Art. 84 during opposition proceedings see p. 30.

In **T 292/85** (OJ 1989, 275) the stated grounds for the refusal were that the disclosure was not sufficient under Art. 83 and that there was consequently a lack of proper support under Art. 84. The board pointed out that in appropriate cases it is only possible to define the invention (the matter for which protection was sought, Art. 84), in a way which gives fair protection having regard to the nature of the invention which had been described by using functional terminology in the claims. The need for fair protection governs both the considerations concerning the scope of claims and the requirements for sufficient disclosure.

Unless the claims also contained variants of components, which were, at the time or later on, equally suited to achieving the same effect in a manner which could not have been envisaged without the invention, the protection provided by the patent would be ineffectual. Thus it was the board's view that an invention is sufficiently disclosed if at least one way is clearly indicated enabling the skilled person to carry out the invention. Consequently, any non-availability of some particular variants of a functionally defined component feature of the invention is immaterial to sufficiency as long as there are suitable variants known to the skilled person through the disclosure or common general knowledge, which provide the **same** effect for the invention.

In **T 409/91** (OJ 1994, 653) (ex parte proceedings) and **T 435/91** (OJ 1995, 188) (inter partes proceedings) it was pointed out that the protection conferred by a patent should correspond to the technical contribution to the art made by the disclosure of the invention described therein, which excludes the patent monopoly being extended to subject-matter which, after reading the patent specification, would still not be at the disposal of the skilled person. The available information must enable the skilled person to achieve the envisaged result within the whole ambit of the claim containing the respective functional definition without undue difficulty, and the description with or without the relevant common general knowledge must provide a fully self-sufficient technical concept as to how this result is to be achieved.

In **T 409/91** (OJ 1994, 653) (ex parte proceedings) the invention related to mineral oils containing paraffin wax such as diesel fuel. Such oils become less fluid as the temperature of the oil decreases due to crystallisation of the wax. The inventors found that waxy fuels having wax crystals of sufficiently small size at low temperatures to pass through paper filters used in diesel engines may be obtained by using additives with a structure described in the application by a general formula. In the description of the application in suit the use of these additives was presented as an essential constituent of the fuel oil composition. As this feature was missing in the claims, the board found that the claims defined some other invention - namely the "principle" of avoiding so-called "cold filter plugging" by reducing the size of the wax crystals. It was held that the claim to the latter invention was not supported by the description, as the description constantly referred to the use of additives.

Furthermore, the board pointed out that the disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed **in the whole range claimed**. This was considered a question of fact.

In decision **T 435/91** (OJ 1995, 188), in inter partes proceedings, one of the essential technical features of claim 1, an additive which forces a detergent composition into the

hexagonal liquid crystal phase, was defined only by its function. The patentee admitted that it was not possible to identify, on the basis of the information contained in the patent specification or of common general knowledge, other compounds than those specifically mentioned as bringing about the desired effect. The board was of the opinion that the compositions must all be available to the skilled person if the definition is to meet the requirements of Art. 83.

However, as long as there were no concrete grounds for believing that the invention could not be carried out within the whole range claimed, there was no reason for not allowing more broadly based claims in an application (**T 242/92**, **T 484/92**). In opposition proceedings the opponent bore the burden of proving that the invention could not be carried out within the whole range claimed (**T 456/91**, **T 418/91**, **T 548/91**).

6.2 Article 83 and clarity of claims

In particular when undefined parameters are used in the claims and there are no details of the measuring methods, the question arises whether there is a problem with respect to Art. 83 or Art. 84. How this question is answered is important in view of the possibility of examination during opposition proceedings.

In some decisions (**T 123/85**, **T 124/85**, **T 172/87**, **T 358/88**, **T 449/90**, **T 148/91**, **T 267/91**, **T 697/91**, all inter partes proceedings) the absence of information in the application on methods for measuring undetermined parameters in the application was considered a problem with respect to Art. 83. In two other cases, both ex parte proceedings, (**T 122/89** of 5.2.1991 and **T 503/92**), this problem was also addressed with reference to Art. 83. In **T 860/93** (OJ 1995, 47), also ex parte proceedings, it was decided that the absence of methods for measuring a relative quality in the claim was a problem with respect to the clarity of the claim (see also **T 230/87**, **T 176/91**, **T 917/92**).

In **T 1055/92** (OJ 1995, 214), also ex parte proceedings, the invention related to a control system for an image transformation system acting on input arrays of data samples representing video fields in order to compute, for each of a multiplicity of fields in a sequence, a modified array of data samples in accordance with the values, in respect of that field, of a plurality of command parameters which determine for each field a spatial transformation of an image represented by the respective input array of data samples. The examining division rejected the patent application under Art. 84 because **in the claim** it was not clear how the values of the command parameters were to be computed.

The board stated that since the primary function of a claim is to set out the scope of protection sought for an invention this implies that it is not always necessary for a claim to identify technical features or steps in detail. This function of the claims should be clearly distinguished from the requirement that the European patent application must disclose the invention in such a way that it enables a person skilled in the art to carry out that same invention. The board considered that it is sufficient if the application as a whole describes the necessary characteristics of an invention in a degree of detail such that a person skilled in the art can perform the invention. This requirement, however, relates to Art. 83 and is not relevant to Art. 84. Under Art. 83 sufficient disclosure is required of a European patent application but not of an individual claim as such. A claim must comprise the essential features of the invention; the essential features should in particular comprise those features which distinguish the invention from the closest prior art.

7. Evidence

In **T 182/89** (OJ 1991, 391) it was stated, that, in order to establish insufficiency, the burden of proof is upon an opponent to establish on the balance of probabilities that a skilled reader of the patent using his common general knowledge would be unable to carry out the invention. A mere statement that one of several examples in a patent has been repeated once “exactly as described” without obtaining exactly the results claimed in the patent is in principle inadequate to discharge that burden (see also **T 406/91**, **T 418/91** and **T 548/91**). For more details see the chapter on the burden of proof, p. 247.

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 reproduced using the examples given. Insufficiency could not be proven 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 still considered sufficient.

B. Claims

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

As explained in decision **G 2/88** (OJ 1990, 93, corr. 469), Art. 84 provides that the claims of a European patent application “shall define the matter for which protection is sought”. R. 29(1) further requires that the claims “shall define the matter for which protection is sought in terms of the technical features of the invention”. The primary aim of the wording used in a claim must therefore be to satisfy such requirements, having regard to the particular nature of the invention, and the purpose of the claims.

The purpose of claims under the EPC is to enable the protection conferred by the patent (or patent application) to be determined (Art. 69), and thus the rights of the patent owner within the designated contracting states (Art. 64), having regard to the patentability requirements of Arts. 52 to 57.

There are basically two different types of claim, namely a claim to a physical entity (eg product, apparatus) and a claim to a physical activity (eg method, process, use). These two basic types of claim are sometimes referred to as the two possible “categories” of claim. Within the above two basic types of claim various sub-classes are possible (eg a compound, a composition, a machine; or a manufacturing method, a process of producing a compound, a method of testing, etc.). Furthermore, claims including both features relating to physical activities and features relating to physical entities are also possible. There are no rigid lines of demarcation between the various possible forms of claim.

The technical features of the invention are the physical features which are essential to it. The technical features of a claim to a physical entity are the physical parameters of the entity, and the technical features of a claim to an activity are the physical steps which define such activity.

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 claims lacked clarity if the exact distinctions which delimited the scope of protection could not be learnt from them.

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

In **T 452/91** the board held that the characterisation of a product - here a fibre yarn - solely by parameters could not be objected to if the parameters were usual in the art and defined positively various aspects directly characterising the chemical and physical nature of the product.

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") were unallowable as contrary to R. 29(4) and (6), unless absolutely necessary, eg when a plurality of conditions would not lend themselves to verbal expression without such a reference. Examples of such exceptions included inventions containing features or limitations which could only be expressed by means of drawings or graphs defining a particular shape or a plurality of conditions.

In case **T 271/88** the board upheld **T 150/82** and decided that it was not possible to base claims on an appendix showing structural chemical formulae designated as "chemical formulae incorporated within claims". The board held that it was quite evident that the terms "description" and "drawing" in R. 29(6) were meant to cover structural chemical formulae. This interpretation was not affected by the terminology employed in the Guidelines, which dealt with the meaning of other rules; nor could much help be derived in construing R. 29(6) on the basis of the express wording of R. 35(11). The mere fact that references to structural chemical formulae on separate sheets were accepted and even required by some national patent offices of the contracting states could not be relevant, let alone decisive, to the interpretation of the EPC. There was not much difference between reliance on references to the description and reliance on references to a separate sheet.

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)) was to make the claims easier for all to understand. They did not limit the scope of the claim but did affect its clarity and might enable it to be expressed more concisely than would otherwise be possible.

In **T 115/83** and **T 32/82** (OJ 1984, 354) it was stated that Art. 84 had 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 were necessary for solving the technical problem with which the application was concerned had to be regarded as essential features. Both decisions were confirmed in **T 269/87** and **T 409/91** (OJ 1994, 653).

In **T 409/91** the invention related to mineral oils containing paraffin wax such as diesel fuel. Such oils become less fluid as the temperature of the oil decreases due to crystallisation of the wax. The inventors found that waxy fuels having wax crystals of sufficiently small size at low temperatures to pass through paper filters used in diesel engines could be obtained by using additives with a structure described in the application by a general formula. The claims defined a distillate fuel oil having wax crystals of an average particle size less than 4000 nanometres at a defined low temperature but did not mention the additives.

The board held that the claims did not define the matter for which protection was sought by reference to **all** its essential technical features as required by Art. 84, first sentence: in the description of the application in suit the use of certain additives was presented as an essential constituent of the fuel oil composition. As this feature was missing in the claims, the board found that they defined some other invention - namely the "principle" of avoiding so-called "cold filter plugging" by reducing the size of the wax crystals. It was held that the claim to the latter invention was neither supported by the description nor was that invention sufficiently disclosed.

In the board's view, the requirement that the claims be supported by the description (Art. 84, second sentence) reflected the general legal principle that the extent of a patent monopoly, as defined by the claims, should correspond to the technical contribution to the art. Claims should not therefore extend to subject-matter which would still not be at the disposal of a skilled person after reading the description. Consequently, a technical feature described and highlighted in the description as being an essential feature of the invention also had to be part of the claims. As the description constantly referred to the use of additives, the claim directed to fuel oils without mentioning additives was not supported (or justified) by the description and therefore contravened Art. 84, second sentence.

The board's opinion in **T 32/82** was confirmed in **T 622/90**, where it was held that lack of clarity could be caused not only by the presence of an ambiguous feature, but also by the absence of a feature which was necessary for clarity.

In cases **T 759/91** and **T 522/91** the claims contained the expression "comprising substantially". The board was of the opinion that this term lacked clear, explicit boundaries and its scope needed interpretation. While in everyday language the word "comprise" might have both the meaning "include" or "comprehend" and "consist of", in drafting patent claims legal certainty normally requires it to be interpreted by the broader meaning "include" or "comprehend". The word "substantially" imposes a restriction on the word "comprising" in the sense that "to a large extent only that is comprised which is specified". The boundaries of the term "comprising substantially" are therefore to be drawn where the essential characteristics of the specified subject-matter cease. The scope of the term "comprising substantially" was therefore interpreted as being identical to that of "consisting essentially of". However, in view of the unequivocal character of the words "consisting of" as compared to "comprising", the expression "consisting essentially of" was to be given preference.

In decision **T 711/90** the board confirmed the assumption in the case law that the substitution of the term "consists of" for "contains" in a claim raised the question of clarity of the claim. When, as in the claim in question, the glass consisted of components denoted i, ii and iii, the presence of any additional component was excluded and, therefore, the proportions of the components i, ii and iii expressed in percentages should have added up to 100 mole % for each claimed composition.

In **T 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.

1.1.1 Clarity of broad claims

It was stated in decision **T 238/88** (OJ 1992, 709) that the clarity of a claim is not diminished by the mere breadth of a term of art (eg "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 p. 139)

In **T 523/91** the claim in question was worded as follows: "Filled granules for further processing in machines with plasticising equipment, comprising one or more plastics in combination with inserts imparting high strength and/or a high screening effect, characterised in that at least a portion of the inserts have a longitudinal expansion ..., and in that

this insert is combined with the plastics granules in a wound or folded manner". The board held that the wording "plastics in combination with inserts" and "this insert is combined with the plastics granules in a wound or folded manner" did not cause the subject-matter of the claim to be unclear within the terms of Art. 84. Although the nature of the combination covered many possibilities, the resulting subject-matter of the claim was broad rather than unclear. The broadness of a claim could not be contested on its own but only in conjunction with other criteria such as novelty, inventive step or reproducibility.

Likewise in **T 688/91** the board stated that a broad claim was not to be equated with one lacking clarity. In this instance the claim was worded as follows: "Integrated microprogrammed apparatus ... with apparatus to generate the T-states T0 ..., T1 ..., ... characterised in that ... the generation both of the T-states T0, T1 ... and of the further T-states ... is in each case effected as a function of preceding T-states and of state parameters **such as** the instantaneous values of state and/or mode signals and ...".

The board held that, even if the words "such as" were understood to mean "for example", with the result that the subsequent information was not to be interpreted in a restrictive sense, the words "state parameters" were clear in as much as they conveyed the fact that T-state generation was to be effected as a function of any parameters representing one of the states of the apparatus. Although the claim was to be regarded as broad, since the terms used were open to general interpretation, breadth was not to be equated with an absence of clarity.

In **T 630/93** the board noted that Art. 84, first sentence, implies that it is not always necessary for a claim to identify technical features or steps in full detail. The function of the essential features, although normally expressed in technical terms, is often to define the borders of an invention rather than details of the invention within those borders. Thus, essential features could often be of a very general character and in extreme cases indicate only principles or a new idea.

1.1.2 Technical features

In decision **T 816/90** plasmids were defined by use of a designation which had no technical meaning *per se*. Moreover, their structure was defined by reference to a figure. The board was of the opinion that such a definition of a plasmid was contrary to the requirements of Art. 84 and therefore could not be accepted.

1.1.3 Categories of claim

In the aforementioned decision **T 688/91** the board found that the fact that claims of different categories were deemed to be independent claims did not preclude reference to other independent claims. In the board's view, however, any such reference had to make perfectly clear whether or not the reference was intended to replace features. In the former case, it had for reasons of clarity to replace **all** the features, and in the latter case none.

In decisions **T 418/92** and **T 453/90** the boards confirmed that it is possible for claims to relate to both physical activities and physical entities, in particular where the inventions concerned are fully disclosed as processes to the skilled person only if apparatus features are also included in the definition.

In **T 426/89** (OJ 1992, 172) the board decided that a claim relating to a "method for

operating" a device was not "clear" (Art. 84) if the claimed features only described how the device worked.

1.2 Exceptions to the principles

Exceptions to these principles have been permitted for practical reasons and under certain circumstances claims granted which contained features in the form of disclaimers and functional or unspecified features.

1.2.1 Admissibility of disclaimer

In accordance with decision **T 4/80** (OJ 1982, 149), 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 exceeded 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 **T 597/92** (OJ 1996, 135) the board confirmed this, stating that there is no basis in the EPC for the substantiation of inventive step by way of a disclaimer. This method may only be used by way of exception for avoiding anticipation, if the subject-matter of a claim cannot be restricted on the basis of the original disclosure in positive terms without unduly impairing its clarity and conciseness. A hypothetical novelty attack in possible proceedings before a national court, unsupported by pleadings or evidence on file before the EPO, is not a sufficient reason under the EPC for allowing a disclaimer.

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 in question was of the type "X-derivatives of the general formula I ... with the exception of the X-derivatives of the general formula I disclosed in patent specification N°...".

In decision **T 124/90** the board allowed a disclaimer in a case where the terms of the disclaimer were more comprehensive than the specific prior art excluded.

In decision **T 623/91** the board stated that the effect relied upon for patentability had to operate throughout the whole range of compositions being claimed and if the evidence

before the board showed that this was not the case, albeit only in a minority or an extremely small proportion of instances, the compositions which did not provide the effect had to be disclaimed.

The appellant had sought to exclude a range of non-working base oils by reference to a trade mark or trade designation under which they were sold by a company who was not a party to the proceedings. The board was of the opinion that, in order to satisfy the requirements of Art. 84, this trade mark or trade designation had to refer to a unique and definitive range of base oil compositions.

It was accepted by both parties that the physical parameters normally quoted for such base oils determined the range of chemical composition. The board was of the opinion that it was more credible that changes in the range of chemical composition would not be likely without a corresponding change in the trade name or trade mark. It followed that the exclusion of the non-working base oils by reference to the trade mark or trade designation would not introduce uncertainty and therefore not offend against Art. 84.

1.2.2 Broad claims

(a) 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 these findings: **T 139/85**, **T 292/85** (OJ 1989, 275), **T 293/85**, **T 299/86** (OJ 1988, 88), **T 322/87**, **T 418/89** (OJ 1993, 20), **T 707/89**, **T 752/90**, **T 822/91**, **T 281/92**, **T 488/92**, **T 104/93**.

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 distinguished between two types of functional feature as follows: "... 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.

In **T 893/90** the board held that the feature "being present in amounts and proportions just sufficient to arrest bleeding" was a functional feature which defined a technical result which also constituted a testable criterion to be satisfied by the claimed pharmaceutical composition. Because such testing involved only routine trials, the adopted functional

language was allowable. The introduction of a reference to specific amounts and/or proportions of the components would limit the claim and was not necessary.

In decision **T 446/90** a mixing step was defined in a claim by the result to be achieved, namely obtaining a dense packing of particles B. The definition of the dense packing referred to in the claim represented in fact a theoretical, idealised scientific model about the packing of particle systems. Such models were well known. The reference to this theoretical model could be understood by the skilled person on the basis of the further information given in the patent in suit, and at least one indirect method suitable for testing the density of the packing had been disclosed in the description. Under these circumstances the definition of the mixing conditions by the result to be achieved was considered by the board to meet the requirements of clarity. In this respect the board noted that the incorporation into the claim of the mixing conditions described in the examples would unduly limit the scope of protection and was therefore not suitable.

In case **T 720/92** claim 1 read as follows: "A wall for a package, which wall comprises, or includes a layer comprising, a composition which comprises a polymer, and which is capable of scavenging oxygen, characterised in that the composition is capable of scavenging oxygen through the metal promoted oxidation of an oxidizable organic polymer component, the metal oxidation promoter comprising a transition metal in a positive oxidation state, such that the permeance of the wall for oxygen is not more than ...". The application was refused inter alia because claim 1 was held not to be clear since it used the obscure terms "metal promoted oxidation" and "oxidizable organic polymer"; the indication of a maximum oxygen permeance was considered a definition by result to be achieved which could not represent a technical feature.

The board did not concur with this opinion and held that the term "clarity" in Art. 84 refers to the practical meaning of the language of the patent claims. Claims with functional features which do not enable the skilled person to carry out the invention in the light of the disclosure and on the basis of common general knowledge do not meet the requirement of clarity according to Art. 84. However, a claim combining functional definitions limited to features, which a skilled person would have no difficulty in determining on the basis of common general knowledge, and a structural definition of the essential contribution to the art is not contrary to Art. 84.

In **T 391/91** claim 1 set out in general terms the sequence of steps to be followed in order to put the invention into practice, ie in order to produce unicellular micro-organism host cells having INA (ice nucleation activity) or enhanced INA. The claim was in fact a generalisation from the particular examples. The department of first instance considered inadmissible the definition in general functional terms of the DNA fragment encoding an expression product responsible for the INA+ phenotype. The board stated that as there was no reason to doubt that it was possible to generalise the specific teaching of the examples given, it would be unfair to the appellant to require a restriction of the claim by incorporation therein of the specific features of the examples. The skilled person could use any suitable variant capable of providing the same effect of the invention. This might be tedious, but it was nothing out of the ordinary in this field and involved only routine trials.

(b) Unspecified features

Unspecified features are permitted on the following conditions:

(aa) 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**, in which the board ruled that, in order to define the scope of a claim as accurately as possible, an essential feature should be clearly specified. In that case, the ability to spring back depended on several parameters such as, for example, the strength and resiliency of the material of a 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 (ie 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.

(bb) The meaning of the feature must be intelligible from the actual claim.

Thus, the objection in case **T 487/89** was based on the fact that the claim had indicated both tenacity and toughness with a lower but no upper limit. The opposition division took the view that such "open-ended" parameters 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 case in question, the claim seeks to embrace values as high as can be attained above a specified minimum level, given the other parameters of the claim, then such open-ended parameters cannot normally be objected to. This decision was upheld by **T 129/88** (OJ 1993, 598), **T 87/84**, **T 92/84**, and **T 136/84**.

In **T 227/91** (OJ 1994, 491) the claims comprised a coating thickness defined by a formula with two parameters (a) and (t). Parameter (a) represented the thermal diffusivity of the coating means and was therefore a feature inherent in the instrument. Parameter (t) represented the effective pulse time of the laser and was related to the laser operating conditions, not to the structure of either the laser or the instrument. The thickness defined in the claims was still connected with the mode of operation of the laser, that is, with a human factor irrelevant to the instrument *per se*. The extent of the protection conferred by the subject-matter of the claims was therefore regarded by the board as ambiguous and indefinite.

In case **T 455/92** independent claim 2 was worded as follows: "Covering ... for a pressing ..., characterised by:

- (a) a length which corresponds at least to the circumference of the shell face of the pressing to be covered,
- (b) an overall breadth sufficient to cover the shell face and both end faces of the pressing, and
- (c) a fold such that ... the breadth ... corresponds to the breadth of the shell face of the pressing ...".

The board did not see this as a breach of Art. 84, since reference had been made to a physical entity which was known; hence the range of sizes was definable in so far as it excluded packaging materials for other physical entities. Furthermore, it was self-evident to a skilled person in this field that the size of the packaging material (the covering) was dependent on the physical entity to be packed.

For the interpretation of claims see p. 139.

2. Conciseness

In **T 79/91** the board stated that lack of clarity of the claims as a whole could arise from lack of conciseness. The invention in this case had been set out in at least ten independent claims of different scope. The board was of the opinion that this presentation made it difficult, if not impossible, to determine the matter for which protection was sought, and placed an undue burden on others seeking to establish the extent of the monopoly.

In **T 246/91** the application comprised 191 claims. In appeal proceedings the appellant restricted the number of claims to 157. The board ruled that the number of claims had to be reasonable, bearing in mind the nature of the invention claimed. Although no hard and fast definition could be accorded to the term reasonable, this did not mean that the requirement was wholly devoid of meaning and legal effect. In deciding the matter, regard had to be had to the interest of the relevant public, since patents ought not to be allowed to erect a legal maze or smoke screen in front of potential users of the inventions to which they laid claim. Patent claims taken singly as well as in totality, must be clear and concise in order to enable such potential users to ascertain, without undue burden, let alone recourse to litigation, whether their planned commercial use was likely to infringe the patent monopoly. Having to construe the remaining 157 claims and form a valid and commercially useful opinion on whether or not any one of them could prevent or hinder the commercial activities imposed, necessarily, a severe and totally undue burden on the public. It followed that the application in question contravened the clear provisions not only of R. 29 but also of Art. 84.

On the same topic, the board took the view in **T 350/93** that, because a single main claim which would have to present a multiplicity of alternatives corresponding to the plurality of processes claimed would lack clarity, the claims were concise within the meaning of Art. 84.

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.

On this matter see also **T 409/91** (OJ 1994, 653) above (p. 131).

In **T 659/93** the board confirmed that the requirement that the claims should be supported by the description meant that they had not only to contain all the features presented as essential in the description, but had also to reflect the applicants' effective contribution by enabling the skilled person to carry out their teaching throughout the field to which they applied.

In ex parte proceedings **T 484/92**, the board concluded that, in contrast to **T 409/91**, the requirement of support by the description had been met and the appellant was entitled to claim the alleged invention in broad functional terms, ie in terms of the desired end effect, because, having disclosed one mechanism for achieving that goal, there were alternative ways of performing the invention at the disposal of the person skilled in the art, which would become apparent to him upon reading the description, based on his common general knowledge.

For the problem of the relationship between Arts. 83 and 84 see p. 126 above.

In **T 1055/92** the invention related to a control system for an image transformation system acting on input arrays of data samples representing video fields in order to compute, for each of a multiplicity of fields in a sequence, a modified array of data samples in accordance with the values, in respect of that field, of a plurality of command parameters which determined for each field a spatial transformation of an image represented by the respective input array of data samples. The examining division rejected the patent application under Art. 84 because **in the claim** it was not clear how the values of the command parameters were to be computed.

The board stated that since the primary function of a claim is to set out the scope of protection sought for an invention this implies that it is not always necessary for a claim to identify technical features or steps in detail. This primary function of the claims should be clearly distinguished from the requirement that the European patent application must disclose the invention in such a way that it enables a person skilled in the art to carry out that same invention. The board considered that it is sufficient if the application as a whole describes the necessary characteristics of an invention in a degree of detail such that a person skilled in the art can perform the invention. This requirement, however, relates to Art. 83 and is not relevant to Art. 84. Under Art. 83 sufficient disclosure is required of a European patent application but not of an individual claim as such. A claim must comprise the essential features of the invention; the essential features should in particular comprise those features which distinguish the invention from the closest prior art.

In **T 156/91** the alleged absence of essential features in the claim was not viewed as a question of reproducibility of the invention within the meaning of Arts. 83 and 100(b), for which the disclosure as a whole is always the criterion; instead, what was involved was an objection under Art. 84.

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.

Similarly, in **T 888/90** (OJ 1994, 162), the appellants had removed from their claim 1 a feature deemed to be necessary to the solution of the technical problem. The board stressed that the omission of a feature in a combination could mean that a claim related merely to a sub-combination of an invention. Such a sub-combination with no function other than that of an intermediary building block for providing an inventive full combination might also be patentable in principle, if expressly presented as such in the application as filed and if it otherwise satisfied all conditions for patentability. Such sub-combinations were analogous to intermediate compounds in a chemical synthesis. However, in the board's view, it could not be assumed that assemblies *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.

4. Interpretation of claims

The subject-matter of 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 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**, **T 565/89** and **T 952/90**, 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 interpret relevant terms contained in the claims when the extent of protection has to be determined.

In a large number of decisions (eg **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**, **T 606/91**), 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 456/91** the board was of the opinion that the clarity of a claim is not diminished by the mere breadth of a term of art contained in it, if the meaning of such term is unambiguous for a person skilled in the art, either *per se* or in the light of the description. In this case an extremely large number of compounds could be used for carrying out the invention. It was clear from the claims, when read in the light of the description, which peptides were suitable for the present invention.

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. While it is true that this article allows the description to be used to interpret the claims, it 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**.

In **T 1045/92** the claims read as follows: "A two-pack type curable composition comprising ...". In the board's view "a two-pack curable composition" was an item of commerce as familiar to readers skilled in the polymer art as everyday articles are to the public at large. The claim was therefore clear.

Likewise, in **T 860/93** (OJ 1995, 47), the board assumed that the description may be used to determine whether the claims are clear. It accepted the reasoning in **T 454/89** namely that the description could only be used to determine the extent of the protection conferred and not to establish clarity, only in the case of claims which were self-contradictory but not in general.

In **T 442/91** the respondents wanted the board to rule on the extent of the protection conferred by what they considered to be broad claims. The board, however, felt that it should not concern itself in opposition appeal proceedings with the extent of the protection conferred by a patent (except for the purposes of Art. 123(3)), as this was the responsibility of the national courts dealing with infringement cases. Whilst the EPO made it clear how terms of art used in the claims should be understood, it should not proffer any further interpretation of the patent's future scope beyond that.

In line with this thinking, the board in **T 439/92** and **T 62/92** interpreted the claims with a view to identifying their subject-matter.

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.

Which features are known and hence to be included in the preamble has to be decided in the light of the objective facts (**T 6/81**, OJ 1982, 183).

In decision **T 13/84** (OJ 1986, 253), the board ruled that a claim in two-part form must be regarded as appropriate if a clearly defined state of the art exists 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 determining factor in deciding whether the one-part or the two-part form of a claim is appropriate in a given case. Likewise, in **T 850/90**, it was confirmed that examination for inventive step should also take account of the features in the preamble, since the invention was defined by the claims as a whole.

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**).

In decision **T 688/91** (see above) the board took the view that there is a breach of R. 29 and Art. 84 if an incorrect distinction has been made between the preamble and the characterising portion.

In **T 350/93** the patent application disclosed processes for the production of electro-active material and composite materials containing such material. It included main claims 1 to 4 and 6 to 8 in one-part form. The board observed that the one-part form was justified because details in certain process steps distinguished the claimed processes from those known from the prior art and the resulting distinctive features were difficult to pick out in a simple and unambiguous form.

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 that 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, ie 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 434/87**, **T 171/88**, **T 563/89**, **T 493/90**), including **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 on 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, eg 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 specifically 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, ie with the same structure as native antibodies, which might be contained in the mixture of hybrids, could be screened out and isolated from molecules which 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.

In **T 552/91** (OJ 1995, 100) the patent proprietors had claimed protection for groups of chemical substances and individual compounds originally defined by a structural formula which subsequently proved incorrect. They then attempted to secure this protection on the one hand by a further substance claim directed to the group of compounds with the structural formula subsequently found to be correct (main request) and, on the other, by product-by-process claims not containing the structural formula found to be incorrect (auxiliary request).

Whilst the main request was disallowed on the grounds that it contravened Art. 123(2) (see p. 160), the board allowed the auxiliary request. It took the view that a formula merely serves to define the substance to be protected. If the originally selected definition by a structural formula subsequently proved to be incorrect and the original documents contained other means of unambiguously characterising the disclosed substances, these could be used instead to formulate a claim directed to this substance. The prime example here was a method of production, which, as a rule, was indicated anyway in the original application to ensure that the substance invention was sufficiently disclosed. However, in such a case it was necessary to include in the claim all the process parameters required for defining unambiguously the claimed substance as inevitable process products.

As chemical reactions only rarely took one particular course and therefore only rarely led to uniform substances, it was generally necessary to indicate not only the starting materials and reaction conditions, but also the method by which the reaction mixture was processed to obtain the claimed substances, especially when, as in the case in question, their isolation was hampered because the correct structure of the products to be isolated could not be given.

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 those processes. That 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 that claim. In a case such as this, the protection afforded by the granted patent had of necessity to 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 those 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 EPO 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 had been included in the application in order to maintain the possibility of making its content a basis for substantive examination. As a result, the answer to the question regarding fees was in the affirmative, on the grounds that, 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

Under 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 7.12.90, which entered into force on 1.6.91, 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 3.6.91, 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 or IPEA (see Art. 154(3)). Harmonisation of the definitions regarding the requirement of unity of invention in the PCT (R. 13 PCT, amended like R. 30 EPC) 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

Under Art. 82 and new R. 13.1 PCT, the international application must relate to one invention only or a group of inventions so linked as to form a single general inventive concept. In **W 5/92** the board considered it to be implicit in this definition that the "invention" be considered in the broadest sense. Thus, according to Chapter VII, paragraph 5 of the PCT Search Guidelines (Doc. PCT/GL/2, published in PCT-Gazette No. 30/1992, Sec. IV; No. 29/1993, Sec. IV), in the mere fact that an international application contains claims of **different categories** or several independent claims of the **same category** is in itself no reason for objection on the grounds of lack of unity of the invention.

R. 30(1) EPC and R. 13.2 PCT state 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 list was not exhaustive and other combinations were permitted if they had met the requirements of Art. 82 (**T 861/92**). The same applied to the old version of R. 13.2 PCT (**W 3/88**, OJ 1990, 126; **W 28/88**, **W 3/89**).

The principles laid down in previous board rulings on 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 this case law remain unchanged.

In **W 39/90** the board observed that it is not the formal choice of words or form of reference, but the actual content of the claims which establishes technical relationships between the subject-matter of different claims, and which is thus decisive for the question of unity. In **W 33/92** the board emphasised that R. 13.1 PCT did not require that the link between the subject-matter of the two independent claims be expressly stated in their wording. All that was required was that there be a single inventive concept.

In **W 2/95** the board of appeal arrived at the conclusion that it was too soon to infer that the inventions lacked unity just because the technical features in a product claim and the independent claim relating to the product's manufacture were not worded in the same way. A comparison of the features of claims which possibly lacked unity or were presumed to do so had to include the description so that, with its help, the effect to be assigned to the individual claim features could be examined. Only on the basis of such examination could it be decided whether there was a technical relationship between the inventions based on "corresponding" (see R. 13.2 PCT and R. 30(1) EPC) technical features.

In **W 23/91** the board confirmed the ISA's view that the **novelty** of a given product might justify claims of different categories being contained in a single application without contravening the requirements of unity of the invention (several new uses of the product in different areas and/or new processes concerning the product, eg preparation). In the case in point, the two independent product claims related to two "products", namely a nucleic acid sequence and the protein relating to the nucleic acid sequence. The board held that these products might constitute the common link if they were novel.

In **T 702/93** the board held that R. 29(2), which referred expressly to Art. 82, made it quite clear that the requirement of unity had to be met for the subject-matters of the independent claims in the **same category**. R. 30 (old version in force until 31.5.91), on the other hand, provided, with regard to the subject-matters of independent claims in **different categories** as a specific exception from the requirement of Art. 82, that such independent claims should also be treated as possessing unity if they related to the same product (eg process for its production - inasmuch as the means provided for that purpose had been specially adapted or specially developed for that purpose - or use claims). This was also true if the independent claims in different categories did not contain the same or corresponding features linking these claims by reciprocal interaction. The board of appeal concluded that R. 30 did not provide for such a fictitious unity in the case of independent claims in the **same** category. It held that the general inventive concept referred to in Art. 82 had to be evident individually in each of the independent claims in the same category. This was clear from the fact that the scope of the invention had to be defined in the independent claims, in accordance with Art. 69(1) and Art. 84, first sentence, in conjunction with R. 29(1) and (3).

In **T 202/83** it was concluded from the old version of R. 30(c) that the requirement of unity was not met by every subject-matter for carrying out a process. On the contrary, the provision presupposed that the means for carrying out the process had been specifically designed. Consequently, such a means in connection with the corresponding process did not meet the unity requirement if it was obvious that it could also serve to solve other technical problems.

In **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. Likewise, in **W 16/89** the method and the devices were found to comply with R. 13 PCT. The **devices were specifically designed** for carrying out the process and could therefore be considered as being linked with the process so as to form a single general inventive concept, even if they could eventually have other possible uses.

In **T 861/92** the apparatus claimed was specifically adapted for carrying out **only one step** of the claimed process. The board came to the conclusion that the subject-matter of the claims satisfied the requirements of Art. 82 as there was a technical relationship between both inventions.

In **W 40/92** the board took the view that there can be unity of invention if one independent claim to a process and another to the means for executing that process are comprised in one application and if the said means is also itself a process.

In **W 29/88** the international application related to chemical products, a process for their preparation and their use. The board was of the opinion that a particular use of a class of compounds on the one hand, and, on the other hand, a claim to that class of compounds *per se* or to certain members of that class of compounds could form a single general inventive concept. The board stressed that the salient point was not the identity of the respective structural scopes, but the question whether the compounds claimed *per se* (and the process for their manufacture) contributed to the solution of the problem underlying the use invention.

In **T 492/91**, the board found that, for the purposes of Art. 82, the whole composition covered by claim 6 (new composition) need not be the product of the process according to claim 1 (process for preparing known products). It was sufficient for one component of the composition to be such a product where the composition and the process were intended to solve the same technical problem. The board concluded that the scope of claim 6 therefore did not have to be limited to the compositions resulting from the process according to claim 1, thus excluding the compositions obtainable by subsequent mixing.

In **T 200/86** the board held that it was possible to claim, in one application, not only a product for pharmaceutical use, but also the product's non-therapeutic (cosmetic and dietary) uses. In the case in point the applicants had claimed two non-therapeutic (cosmetic and dietary) uses in addition to the pharmaceutical use.

In **W 13/89** the board found unity of invention between a claim to the use of a substance or composition for the preparation of a medicine intended for a specific use (second medical use) and a claim to a pharmaceutical product containing that substance or composition (first medical use). This decision was confirmed in **W 5/91** and **W 28/91**.

2.2 Dependent claims

R. 13.4 PCT expressly provides that dependent claims must fulfil the requirement of unity in accordance with R. 13.1 PCT. The EPC makes no comparable express provision. The question has therefore arisen as to whether dependent claims have to be treated differently under the two provisions. Board of appeal case law on PCT cases has been uniform: the boards repeatedly confirmed the principle that the requirement of unity must

also be met by dependent claims (see inter alia **W 3/87**, **W 2/88**, **W 30/89**, **W 32/89**, **W 26/90**, **W 8/91**, **W 54/91**). In EPC cases the boards likewise assume that dependent claims have to meet the requirement of unity. As distinct from the PCT procedure, under the EPC the approach is not as strict as in the case of independent claims, where the examination is always carried out in accordance with the express requirement, but only in those cases where unity could be problematical (see **T 140/83** and **T 249/89**).

In **W 8/91**, it was decided that, where claims 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.

2.3 Intermediate products

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 if all these subject-matters were technically interconnected and integrated into a single overall concept by being oriented towards the end-products. In this context, starting materials which were used in a process for preparing end-products and which were themselves products of a disclosed, albeit unclaimed, production process were also considered to be intermediates. This principle was confirmed in **T 110/82** (OJ 1983, 274) for low-molecular products. According to that board, an invention relating to new low-molecular end-products and to several groups of new low-molecular intermediates invariably had unity if the groups of intermediates prepared and oriented towards the end-products were technically closely interconnected with the end-products by the incorporation of an essential structural element into the end-products and if due account was taken of the regulatory function of Art. 82 (prohibition of unjustified saving of fees, need for ready comprehensibility).

This decision was confirmed by **T 35/87** (OJ 1988, 134) and **T 470/91** (OJ 1993, 680). 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. The intermediates of the application were therefore only made available with a view to obtaining the end-products and they were sufficiently closely technically interconnected with those end-products. Thus, they were integrated into a single overall inventive concept by being oriented towards the end-products. This was not prejudiced by the fact that the two sets of intermediates were not structurally related to each other since the orientation of the intermediates towards the end-products permitted the individual technical problems addressed by the intermediates to be combined into a unitary overall problem to the solution of which both sets of purpose-made intermediates contributed.

In **W 35/91** the board ruled that the requirements of unity of invention as set out in R. 13(1) and (2) PCT were met, if the novel intermediates designed to give rise to the novel end-products were technically sufficiently closely related by their contribution to an essential structural element of the end-products.

In **W 7/85** (OJ 1988, 211) the board stated that there was sufficient technical information to justify a *prima facie* finding of unity of invention between a claim to a **mixture** and a claim to one essential component of that mixture or a narrowly defined version thereof. If a

finding of unity is justified in cases of chemical intermediates and end-products even when, as is often the case, only a part of the intermediate structure is actually incorporated, there is all the more reason to view the intact components and the corresponding compositions in a mixture as technically interconnected by incorporation. The former are not even destroyed when the admixture is prepared and fully retain their properties and functions in the product, unlike typical intermediates, which lose their identity in the process. Thus, both inventions could be considered to fall within the same general inventive concept. In such cases the requirement that the means for preparing the end-product should be «specially designed for carrying out the process» appeared to be fulfilled since none of the means led or was related to an end-product outside the scope of its definition. In view of this the character of the invention in the component was, *prima facie*, also dependent on the existence of an invention in the end-product.

2.4. Conditions for assessing unity of invention

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

For international applications the question arose as to whether the ISA had the power to assess unity of invention *a posteriori*, ie after an examination of the application. In **W 3/88** (OJ 1990, 126) the board had answered this question in the negative, interpreting the expression “a single general inventive concept” of R. 13.1 PCT as being simply the general concept of what the applicant subjectively claimed to be his invention. By contrast, in **W 44/88** (OJ 1990, 140) and **W 35/88**, the answer had been in the affirmative. In the latter cases the boards had made reference to the PCT Guidelines which permitted assessment of unity *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 capacity as an ISA might, pursuant to Art. 17(3)(a) PCT, request a further search fee where the international application was considered to lack unity of invention *a posteriori*. 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**).

In **W 23/91** the board carried out a preliminary examination of novelty in the light of two prior-art documents mentioned by the ISA in its search report, but refrained from examining whether the claims fulfilled the requirements of inventive step because the case at issue was not at all a clear case, as required by the decision of the Enlarged Board of Appeal (see p. 367).

In **W 8/94** the board held that, according to the jurisprudence of the boards of appeal, denial and also acknowledgement of unity of invention according to Art. 3(4)(iii) PCT required a discussion of the problem underlying the claimed subject-matter, because only then was it possible to decide whether or not a common special technical feature in the sense of R. 13.1 and 13.2 PCT existed for different embodiments (see **W 11/89**, (OJ 1993, 225); **W 59/90**, **W 17/91**, **W 14/91**, and **W 6/91**). In **W 10/92** the board stressed that the **problem-solution approach** was to be applied to unity of invention.

Where lack of inventive step cannot be detected immediately, it should in **cases of doubt** be held that there is unity of invention (**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 well-founded, the lack of novelty or inventive step had to be **immediately apparent** and that if this requirement were not met 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 that had been made available to the public before the date of filing of the international application, the ISA could use such documents as grounds for a decision of lack of unity a posteriori even if in one of the contracting states designated it were not possible to cite these documents against a corresponding national patent application.

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**).

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, ie the outcome or results achieved by the invention as claimed, would usually already be apparent from the problem as stated. A single general concept might therefore be said to be present only if a **partial identity** existed between the teachings in an application deriving from the structural features of the subject-matters claimed and/or the outcome or results associated with those subject-matters. Where subject-matters of the same category were concerned, a partial identity, generating unity of invention, could result from the structural features of these subject-matters and/or their associated effects. 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. These criteria governing unity of invention for the purposes of R. 13.1 PCT also applied in principle where the inventive step was based chiefly on the discovery of an unrecognised problem. If the common problem, ie the effects to be achieved, was itself already known or could be recognised as generally desirable (a mere desideratum) or obvious, there would be no inventive merit in formulating the problem. If the common structural features were to be found only in the prior art

portions of the claims, and if these known features did not help to solve the problem of the combined whole, this might also indicate a lack of unity.

In **W 38/92** the board confirmed **W 6/90** above and noted that the common features in the claim groups represented the “sole concept” linking the various subject-matters. The board stated that the remaining question was whether or not any of these specific features in the claim groups or their combination could make a **contribution** to the inventive steps relating to each claimed subject-matter, and that this would render the said concept linking the various subject-matters inventive. The board observed that the new R. 13 PCT also required such a contribution by the suggested common «special technical features» over the prior art, ie not that they merely provide novelty. 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 35/91** the board observed that, according to R. 13.3 PCT, the determination of whether a group of inventions was closely linked so as to form a single inventive concept had to be made without regard to whether the inventions were claimed in separate claims, or as alternatives within a single claim.

In **W 48/90** and **W 50/90** the board noted that as far as chemical compounds were concerned, unity of invention was no mere question of the respective structural features, but had to be decided taking into account the technical problem to be solved and whether or not the respective compounds contributed to the solution found.

In **T 249/89** it was possible to discern a single general concept from the elements common to the different claims, ie 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.

In **W 32/92** (OJ 1994, 239) the board held that there was no unity of invention where the subject-matters of independent claims, including their effects, had no common inventive feature in those parts of the claims differing from the closest prior art.

In **W 9/93** the board noted that the intermediate compounds were known, so that these products could not serve as a common inventive concept, and that a technical feature contained in the process claims was also known. The board pointed out that a technical feature which already formed part of the **state of the art** could not, by definition, make a contribution over the prior art and did not, therefore, qualify as a unifying element in the sense of R. 13.1 PCT. The board observed that, according to R. 13.2 PCT, as in force from 1.7.1992, an international patent application may relate to a group of inventions if there was a “technical relationship” among those inventions involving one or more of the same or corresponding “special technical features”, ie such technical features as defined a contribution which each of the claimed inventions made over the prior art. The board went on to say that R. 13.1 PCT did not simply require some link between a group of inventions claimed in an international patent application, but a **common inventive concept**. This meant that there must be either a common technical problem or at least, if there was more than one technical problem, there must be one single technical concept behind the solutions of these different problems. Neither of these conditions was, however, met in this case.

In **W 1/94**, the EPO acting as ISA had found that the compounds according to the “inventions” it had identified did not have a new structural element. Nevertheless the board concluded that the absence of such an element did not automatically destroy the unity of the invention. On the contrary, it was clear from the PCT Administrative Instructions that a

technical relationship must be recognised for a group of alternative chemical compounds, such as all the compounds having a common property or activity, and such a **common activity** existed in the case in point. The new use could therefore form the general inventive concept linking the subject-matters of the claims in accordance with R. 13.1 PCT and had to be treated as a functional characteristic linking the compounds claimed.

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**).

3. 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) or Art. 17(3)(a) PCT for each invention involved. If the fee is paid in due time the applicants may select the single invention or group of inventions they wish to retain in the main application.

The consequences of non-payment of the further search fee for the procedure for the grant of a European patent have been the subject of conflicting interpretations on the part of the boards. While it was stated in **T 178/84** (OJ 1989, 157) that in the case of non-payment of the further search fee under R. 46(1) 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 applicants had not paid the further search fees. Instead the applicants must file a divisional application for that subject-matter if they wished to continue to protect it. In the view of the Enlarged Board, it was clear from the procedural system of the EPC 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 related, applicants must pay such further search fees if they wished to ensure that one of the further inventions could become the subject of the claims of that application. That was the proper interpretation of R. 46(1) in context. This confirms the practice according to **T 178/84** (see Guidelines C-VI, 3.2a).

4. Dispensing with a further 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 on the first invention. This is particularly so 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 charging further fees would be incompatible with 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 deciding 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.

In **W 2/92** the board pointed out that according to the Guidelines for International Preliminary Examination to be carried out under the PCT (Doc. PCT/GL/3, Chapter III, 7.6 published in PCT-Gazette No. 7/93, Sec. IV), which is binding for the EPO acting as IPEA (see decision **G 1/89** and **G 2/89**, OJ 1991, 155 and 166), although lack of unity of invention should certainly be raised in **clear cases**, it should neither be raised nor persisted with on the basis of a narrow, literal or academic approach. Moreover, the benefit of any doubt should be given to the applicant. These Guidelines also state that reasons of economy may make it advisable for the examiner to avail himself of the option referred to in R. 68.1 PCT by choosing not to invite the applicant to restrict the claims or to pay additional fees (see Guidelines, Chapter III, 7.10). In the light of the Guidelines, the board was satisfied that the case in point was clearly one in which the examiner should have chosen not to issue an invitation pursuant to R. 68.1 PCT in respect of lack of unity (see also Guidelines, Chapter VI, 5.9). This was particularly the case as the lack of unity was based on the examiner's assumption that the compounds of general formula V were known and that the examiner had found that claims 1 to 12 directed to a process of preparation of said compounds satisfied the criteria of novelty, inventive step and industrial applicability. The board went on to say that even if it could be shown that compounds falling within the scope of the general formula V were known, it considered that the two inventions identified by the IPEA were conceptually so close as to represent a single inventive concept since they both related to a process for the preparation of the same end-products from the same starting materials by concomitant dehydration and cyclisation. Therefore, in the board's judgment, the requirements of R. 13.1 PCT were satisfied.

5. Consistency of description and claims

In **T 544/88** (OJ 1990, 429) the board ruled that if an applicant, in response to an objection of lack of unity under Art. 82, 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 **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). For the purpose of Art. 123(2), “the content of the application as filed” also did not include any priority documents, even if they were filed on the same day as the European patent application (**T 260/85**, OJ 1989, 105).

In **T 605/93** the board held that where the application documents of the European application as filed were a translation of the international application as it was filed, the content of the “application as filed” (for the purpose of Art. 123(2)) was that of the international application as it was filed. In all normal circumstances, it ought however to be assumed that the published European application was identical in content with the published international application.

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 of explicitly disclosed features did not automatically belong to the content of a European patent application as filed, when this content was used as state of the art according to Art. 54(3) and (4) against a more recent application. It therefore concluded that such equivalents could not belong to the content of a European patent application either, when this content was assessed to determine whether an amendment was admissible under Art. 123(2).

In **T 265/88** the board refused to allow originally undisclosed equivalents to be added by using a wider technical term in place of the single technical means originally disclosed. **T 118/88** had concluded that the obviousness of a feature was no replacement for the original disclosure.

In **T 157/90** and **T 397/89** it was stressed that it was insufficient for the generalisation of a feature to have only formal support in the application as filed. If, for example, the application as filed only described specific embodiments, and the feature’s general applicability was not evident to the skilled person, then generalisation could not be allowed.

In **T 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 could have been deduced from the application as a whole in the form originally filed.

Decision **T 784/89** (OJ 1992, 438) ruled on a computer-controlled method of producing NMR images disclosed explicitly in the documents as filed. By reference to another patent application an apparatus was implicitly disclosed comprising a programmable component which, when suitably programmed, was used for the claimed method. The board considered that only this specific combination had been disclosed. To claim an apparatus for carrying out a method was considered an inadmissible extension of the European patent application because the claim covered apparatus which could also be used in other methods and to achieve other effects. The only allowable claim was for an apparatus for carrying out a method comprising a programmable component which could be suitably programmed to carry out the method.

In **T 54/82** (OJ 1983, 446) the board held that an objection under Art. 123(2) did not necessarily arise when an amendment was proposed which involved combining separate features of the original subject-matter of an application. When considering whether different parts of the description in an application may properly be read together, the state of the art might also be taken into account.

In **T 526/92** the patent related to an additive concentrate having a high TBN of at least 235 for incorporation in a lubricating oil composition. The application as filed contained no explicit reference to TBN apart from the examples where 235 was the lowest value mentioned. The feature "having a high TBN of at least 235" was introduced during the examination proceedings to distinguish the claimed subject-matter from compositions with low TBN values up to 100 disclosed in a citation:

The board revoked the patent on the grounds that it breached Art. 123(2), stating that the precondition of the disclaimer had not been met. Subject-matter which was broadly disclosed in generic terms could be delimited even in the absence of express support in the application. In this case, however, TBN values had not been originally disclosed as a "broad" range but only as single, punctate values; thus a new range was defined which had not been disclosed originally. Furthermore, the generic part of the original specification did not contain any information indicating that TBN played any role in the framework of the application in suit. This meant that there was also no information whatsoever concerning a TBN range, whether open-ended or not. Nor was there any information at all in the description regarding the contribution of a TBN to the solution of a technical problem. Moreover, it could not be concluded that the individual TBN values disclosed in the examples were representative of a TBN range starting at 235 and without any upper limit. The board held that there was a contravention of Art. 123(2) where values of a parameter were given only in the examples, without the significance of this parameter becoming evident from the original specification, arbitrarily forming a range which was open-ended in one direction and had one limit selected from the examples in the other.

T 201/83 (OJ 1984, 481) and **T 17/86** (OJ 1989, 297) started from the assumption that a limitation could also constitute an inadmissible extension of the subject-matter of the application. In **T 201/83**, however, the board came to the conclusion that the amendment of the concentration range for a component of a claimed alloy was allowable on the basis of a value described in a specific example since the skilled person could have readily recognised that this value was not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention to a significant degree. The new limit could therefore be deduced from the original documents. In **T 17/86** the examining

division took the view that although the introduction into a claim of a particular technical feature constituted a limitation, it nevertheless contravened Art. 123(2) since the feature concerned had been described in the application solely in association with another feature not included in the claim. The board, however, stated that the application as filed unmistakably showed that the combination of technical features in the new claim thus amended was sufficient to produce the result sought in the application.

1.2 Technical contribution of added feature

G 1/93 (OJ 1994, 541) stated that the underlying idea of Art. 123(2) was clearly that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. If, however, an added feature merely excluded protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such a feature could not reasonably be considered to give any unwarranted advantage to the applicant. Nor did it adversely affect the interests of third parties. Therefore, a feature which had not been disclosed in the application as filed but which has been added to the application during examination was not to be considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2), if it merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, without providing a technical contribution to the subject-matter of the claimed invention.

The question of whether an added feature made a technical contribution or merely limited the scope of protection was discussed in several decisions.

In **T 384/91** of 27.9.1994 (OJ 1995, 745) it was held that the added feature did make a technical contribution. This decision was based on the following considerations: the example mentioned by the Enlarged Board illustrated a case where the feature was clearly not merely a limitation. However, the borderline beyond which a feature was no longer to be considered as making a technical contribution to the subject-matter of the claimed invention and was merely limiting the protection conferred, was not co-terminous with this example but lay between it and the limit of complete technical irrelevance. According to the board this view was consistent with the fact that the Enlarged Board had rejected relevance as a criterion for novelty and inventive step, which would also have implied a comparison with the cited prior art documents. Thus the board also rejected the argument that the condition that the feature must not make a technical contribution to the subject-matter of the claimed invention applied to "inventions". These "inventions" therefore, had to be "identified" by assessing novelty and inventive step in order to see whether they really were "inventions" and, if so, on the basis of which features. The board explained that the term "invention" did not necessarily imply the presence of novelty and inventive step, as was apparent from the wording of Arts. 52, 54 and 56.

The board concluded that there was no need to take into account the prior art documents, but that the assessment of whether the exception for mere limitations applied in a particular case should depend only on the technical relationship of the added feature to the content of the application as originally filed, as understood by a skilled reader. At the least, a feature went beyond providing a mere limitation not involving a technical contribution to the invention if it interacted with the way in which the other features of the claim solved the technical problem, as it was understood from the application as originally filed.

In **T 526/92** (see p. 156) the patentee also submitted that the feature of a "TBN of at least 235" was of great importance for limiting the scope of protection but of no relevance to the originally disclosed technical teaching and that, therefore, following **G 1/93**, the amendment was allowable as merely excluding protection for concentrates having a TBN of less than 235. According to the board, the addition of the feature concerned made a technical contribution to the claimed invention because it not only introduced a technical parameter on which no information had been available in the original specification, but, moreover, selected a particular range which had not originally been disclosed. Furthermore, by not disclosing the particular state of the art of the citation but selecting a TBN of 235 as a lower limit the applicant had gained more distance from this state of the art which had improved his position at least in relation to inventive step; such improvement would be an unwarranted advantage.

T 802/92 (OJ 1995, 379), (an ex parte case) addressed the question whether the omission of a feature made a technical contribution to the subject-matter of the claimed invention. The application as filed contained only product claims relating to "a double heterojunction p-i-n photovoltaic cell having at least three different semiconductor compound layers composed together of at least four different elements, comprising ... first and second ohmic contacts ...". In the course of examination proceedings the applicant also claimed the method of making such a photovoltaic cell. However, the method claim did not contain a feature relating to the formation of first and second ohmic contacts.

The board allowed the omission of this feature in the method claims. It explained that the aim of the invention was to make photovoltaic cells with certain abilities. This aim was achieved by the use of three different semiconductor layers formed of at least four different elements. In the board's view, it followed from the description that the presence of ohmic contacts did "not provide a technical contribution to the subject-matter of the claimed invention". Therefore, the presence or absence of such ohmic contacts did not affect the carrying out of the described invention since they were not an essential part of it. The board invoked the principles underlying the interpretation of Art. 123(2) set out by the Enlarged Board in **G 1/93** (see p. 157). According to the board in this case these considerations were equally applicable to cases where a feature had been removed from a claim or omitted, so as to broaden its protection. Thus the removal from a claim of a feature which did not provide a technical contribution to the subject-matter of the claimed invention and whose removal merely broadened the protection conferred by the claim did not contravene Art. 123(2).

1.3 Disclosure in drawings

In **T 169/83** (OJ 1985, 193), **T 308/90** and **T 465/88** it was pointed out that where drawings existed they were to be regarded as an integral part of the documents disclosing the invention. From this it was inferred in **T 169/83** and **T 523/88** 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 372/90** the board confirmed that features for which a skilled person could clearly derive the **structure and function** from the drawings could be used to define more precisely the subject-matter for which protection was sought.

In **T 191/93** amendments were based exclusively on the original drawings and introduced only some of the features disclosed in the drawings. The board held that the subject-

matter of the patent had been extended compared to the application as filed because it was not derivable from the drawings that the two newly introduced features could be isolated from the other features shown in the drawings. The subject-matter defined in the claims thus amended was ambiguous. In this case, however, the ambiguity could be removed by also introducing into the claim a third feature, disclosed in the drawings as filed, together with the other two features.

In **T 676/90** the applicant wished to delete the rolling-device features of a carrying aid for a pair of skis. The board found, however, that the original documents had disclosed only a carrying aid consisting of a rolling device and a carrying strap or only of a rolling device, but not an option without a rolling device. Nor was the board swayed in its view by the applicant's argument that the carrying strap was shown separately in a drawing. It held firstly that, according to the description, this drawing was an expanded view of the carrying strap shown in Figure 1 (which, moreover, showed a ski with the carrying strap in conjunction with the rolling device). Secondly, a drawing could never be interpreted in isolation from the overall content of the application but only in that general context. The content of an application was defined not only by features mentioned or shown therein but also by their relationship to each other.

In **T 748/91** the board reached the conclusion that size ratios could be inferred even from a **schematic drawing** as long as the delineation provided the relevant skilled person with discernible and reproducible technical teaching. Schematic drawings depicted all the essential features; in the case in point, the thickness of the superimposed layers, together with the ratio of layer thicknesses, was clearly an essential component of the subject-matter of the application.

However, a figure which served only to give a schematic explanation of the principle of the subject-matter of the patent and not to represent it in every detail did not allow the sure conclusion that the disclosed teaching purposively excluded a feature not represented. Such a "negative" feature (in this case: "with no internal fittings") could not subsequently be incorporated into the claim (**T 170/87**, OJ 1989, 441).

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 constituted only one possible source of disclosure for a teaching or a feature; a further possibility was a drawing including, as a special case, **a graph representing a mathematical equation**. This case related to a process for regulating the print quality of printers which could only be carried out using statistical calculations. On the basis of a formula given expressis verbis, its representation as a graph according to the Cartesian co-ordinate system and a basic knowledge of statistics, the possible values of two parameters in the formula, though not expressly disclosed, could be deduced.

1.4 Cross-references

In **T 6/84** (OJ 1985, 238) the subject-matter of the application was a chemical process solely characterised in that the catalyst was synthetic offretite having a silica/alumina mole ratio of 5 to 10. For the definition of synthetic offretite the description referred to a Canadian patent specification in which the offretite used was defined as aluminosilicate having the given mole ratios for the oxides and a characteristic X-ray powder diffraction pattern. The board took the view that structural features of a means for performing a chemical process (here the catalyst "offretite"), which were not mentioned in the applica-

tion documents themselves but in a document (here a Canadian patent specification) to which they referred, could be incorporated into a patent claim if they unequivocally formed part of the invention for which protection was sought. However, it was not permissible to single out a particular one of their number (here a silica/alumina ratio) in the absence of evidence that this feature alone was a sufficient characterisation. It was instead necessary to recite fully the other essential components of the structure and the diffraction pattern figures which belonged together, as originally disclosed and defined in that document.

In **T 6/84** it was clear having regard to the facts that the further characterising parameters of synthetic offretite which were included in the main claim by way of amendment were indeed features which unequivocally formed part of the invention for which protection was already sought, because the use of synthetic offretite as a catalyst was already the only characterising feature in the claim as originally filed, and the features which were added to that claim simply defined such synthetic offretite better.

In **T 689/90** (OJ 1993, 616), however, the description of the invention as originally filed did not in any way suggest that the "further details" of a certain feature to be found in a document D1 referred to and now to be included in the main claim were intended to identify features of the invention for which protection might be sought or that such features implicitly clearly belonged to the description of the invention. The board decided that features disclosed only in a cross-referenced document which was identified in the description as filed were *prima facie* not within "the content of the application as filed". Only under particular conditions would adding them to a claim not be an infringement of Art. 123(2) - 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.

1.5 Errors in the disclosure

1.5.1 Calculation errors

In **T 13/83** (OJ 1984, 428) the board held that R. 88 did not apply to a non-obvious correction of an error in the description or claims which resulted from an erroneous technical calculation. A correction of such an error was allowable under Art. 123(2) if the amendment would be regarded by the skilled reader as clearly implied by the disclosure of the application as filed. If more than one arithmetical possibility of correction could be envisaged, the correction chosen had to be the one which the application as a whole clearly implied.

1.5.2 Incorrect structural formula

In **T 552/91** (OJ 1995, 100) the question arose - apparently for the first time - as to whether and in what form protection could be obtained for groups of chemical substances and individual compounds whose originally disclosed structural formula proved incorrect. The applicant's main request was aimed at securing such protection by a further substance claim for the group of compounds with the structural formula subsequently found to be

correct. This request was refused on the grounds that it would violate Art. 123(2). The board defined "content" within the meaning of Art. 123(2) as "the entire technical disclosure derived by a skilled person from the application". Thus it was not enough to prove that as a result of amendments to the original patent application nothing other than the originally disclosed subject-matter was claimed; what was more important was that technically relevant information which the skilled person could not derive from the original documents was not thereby added to the application. In this case, the subsequently amended general formula gave the skilled person for the first time crucial information about the true chemical structure of the group of substances. This led to conclusions regarding properties that could be put to use. The information added to the application through the amendment of the general formula and relating to the true composition of the group of substances could not have been obtained from the application as originally filed (see also p. 144).

1.5.3 Amendment based on errors

In **T 740/91** the board allowed a change in the upper limit of the amount of epoxy compound present on a yarn from 5.0 % by weight to 0.6 %. This amendment conferred both novelty and inventive step on the claimed subject-matter. The value of 0.6 % was explicitly disclosed in example IV. However, the patentee conceded that this figure had been inserted in error in place of the true figure of 0.49 %.

The board concluded that the fact that the figure was wrong did not alter the situation that it was actually and credibly disclosed. It could thus be relied on as the basis for the new upper limit. This interpretation of Art. 123(2) was consistent with its underlying intention, which was to protect the public from being faced at a later stage with claims which were wider in their scope than what had been disclosed in the application as filed, and published for the information of the public, including the applicant's competitors. In this case, any such competitor who had read the application as first published had formed the view that the originally claimed range of 0.1 to 5 % was too wide in the light of the prior art, and had thought that the broad claim could not validly be sustained. He would have seen at once that the highest figure for the cured epoxy resin given in any example was 0.6 %, as clearly disclosed in example IV, and therefore could not have been taken by surprise if the upper limit of 5 % were later to be reduced to 0.6 %. The fact that the figure was wrong would be unknown to competitors, and therefore could not influence their judgment.

1.5.4 Elimination of contradictions

In **T 172/82** (OJ 1983, 493) the deletion of a feature in a claim was considered admissible because the sole purpose of such deletion was to clarify and/or resolve an inconsistency. And in **T 271/84** (OJ 1987, 405) it was stated that an amendment to a claim to clarify an inconsistency did not contravene Art. 123(2) or (3) if the amended claim had the same meaning as the unamended claim, on its true construction in the context of the specification.

In **T 758/92** the board allowed the deletion of a feature because it was clearly inconsistent with the teaching disclosed in the application as filed, and there was a clear basis in the original disclosure for its deletion. A skilled reader of the original application documents would have realised that the feature to be deleted was erroneously introduced in the claim because the resulting definition was contradictory to the functioning of the described embodiment of the invention.

In case **T 60/90** the applicant had deleted the lower limit of a temperature range in order to eliminate an inconsistency between the claims and the examples. Resolving this inconsistency was found unobjectionable under Art. 123(2). The board held that, (1) the feature in question was not explained as essential in the disclosure (it was originally a preferred embodiment), (2) it was not, as such, essential for the function of the invention (the examples used a lower temperature - the source of the contradiction), and (3) its removal required no real modification of other features to compensate for the change.

1.6 Subsequent addition of details

1.6.1 Amendments in the description of the prior art

In **T 11/82** (OJ 1983, 479) it was pointed out that the mere addition to the description of a reference to prior art could not reasonably be interpreted as the addition of "subject-matter", contrary to Art. 123(2). Whether it did so would clearly depend on the actual language used and the circumstances of the case.

In **T 211/83** the board even considered it essential that details of the way a component of the invention worked, which could only be inferred from previously published advertising literature referred to in the description, be included in the description since they were of significance for the invention.

In **T 889/93** the appellant/applicant explained that the closest prior art was shown in two figures of the contested application. In his reply to the board's objection of obviousness he submitted that these figures did not show the state-of-the-art-device correctly as they were misleadingly oversimplified. The board allowed originally filed drawings to be replaced by better ones since this only removed an inaccuracy in the representation of the state of the art and did not affect the disclosure of the invention per se.

Equally, an amended claim does not contain subject-matter which extends beyond the content of the application as filed if the preamble to the claim has been amended by substituting an appropriate more general term, which is apt to define a feature common to both the closest prior art described in the application as filed and the invention which is the subject of the application, for a specific term which was not apt to define that feature of the prior art (**T 52/82**, OJ 1983, 416).

1.6.2 Subsequent addition of effects

In **T 11/82** (OJ 1983, 479) it was stated that it was not inevitable that the addition of a discussion of the advantages of the invention with reference to the prior art would constitute a contravention of Art. 123(2). In **T 37/82** (OJ 1984, 71), for example, a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully. It could however be deduced from the original application on the basis of normal expert considerations.

In the Guidelines, Part C-VI, 5.7 and 5.7a, it is pointed out that amendment by the introduction of further examples and statements of effects or advantages of the invention not mentioned previously should always be looked at very carefully in the light of the general considerations. Under certain circumstances, later filed examples or new effects, even if not allowed into the application, may nevertheless be taken into account by the examiner as evidence in support of the patentability of the claimed invention.

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 decisions **T 527/88** and **T 514/88** (OJ 1992, 570), the boards 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 (in this case the divisional application) had to be directly and unambiguously derivable from, and consistent with, the original disclosure (in this case the parent application).

T 176/90 was 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 required the disclosure of the structure of the class, usually by means of a general formula, and an indication of a method of preparation. In the opinion of the department of 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 although the parent application described alcohols only as individual compounds, 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.

In **T 441/92** a divisional application was filed with a description which was substantially identical to that of the parent application. After an amendment of the claims the divisional application comprised the same subject-matter as the parent application which in the meantime had lapsed irrevocably (thus the question of double patenting did not arise).

The board stated that it was a generally accepted principle of patent law that, once a divisional application had been validly filed, it became separate and independent from the parent application. Thus, once the conditions of Art. 76(1) had been met, the divisional application was to be examined as an application quite separate from the parent application and had itself to comply independently with all the various requirements of the EPC.

A divisional application therefore had to meet both the requirements of Art. 76(1) and those of Art. 123(2): it had neither to extend beyond the content of the parent application as filed nor be amended after filing in such a way that it contained subject-matter which extended beyond the content of the divisional application as filed.

In this case the board found that the claims now contained in the divisional application did not introduce subject-matter beyond the content of the parent application and thus did not contravene Art. 76(1). Nor was Art. 123(2) contravened, since all the claims were directly and unambiguously derivable from the description of the divisional application as filed.

Equally no objection arose from the fact that the divisional application as originally filed did claim a different invention from that specified in the amended claims. While the content of an application must not be extended after filing, the protection sought by the claims might be extended beyond that sought in the claims as originally filed as long as the

application was pending; in this respect, there was no distinction between a normal application and a divisional application.

Furthermore, the subject-matter of the claims of the parent application could not be considered to have been abandoned because the parent application in this case had lapsed. The board found that the lapse of the parent application could not have the effect of reducing the content of a previously filed divisional application.

3. “Tests” for the allowability of an amendment

3.1 The “novelty test”

In **T 201/83** (OJ 1984, 481) it was stated that the test for compliance with Art. 123(2) was basically a novelty test, ie no new subject-matter may be generated by the amendment. This was approved in **T 136/88**. **T 17/86** (OJ 1989, 297, Corr. 415) added that novelty could be found in a limitation, the addition to a claim of a further feature, or even in the absence of one of the elements of a device. The novelty test was incorporated in the Guidelines, Part C-VI, 5.4.

In **T 416/86** (OJ 1989, 308) it was held that the fact that a technical means (in this case an aperture of a special design) was known did not take away the novelty of its equivalents (in this case, apertures of a different design producing the same effect as the former) even if the equivalents were themselves well known. It followed that the equivalents of a disclosed technical means had to be considered new and therefore not disclosed if they were not mentioned in the original documents. In accordance with these principles, the board decided that the replacement of a specific feature disclosed in the invention by a broad general statement was to be considered as an inadmissible amendment under Art. 123(2) when this general statement implicitly introduced for the first time specific features other than that originally disclosed. Therefore, the substitution in the claim of a structurally defined element of that claim by its known function (or disclosed function) was considered contrary to Art. 123(2).

Decisions **T 405/87** (according to which the allowability of an amendment depended on whether the added feature was “new compared with the original disclosure”) and **T 192/89** (according to which the question was 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 a feature. In **T 66/85** (OJ 1989, 167) it was pointed out that if a technical feature was deleted from a claim in order not to exclude from protection certain embodiments of the invention, the broadening of the claim did not contravene Art. 123(2) as long as there was a basis for a claim lacking this feature in the application as originally filed. It was immaterial whether or not the feature in question was relevant to the inventive concept of the claimed subject-matter.

T 133/85 (OJ 1988, 441) concerned a case where a feature was described as an essential feature of the invention but was not contained in the claim. The claim was therefore not supported by the description (Art. 84). An **amendment to the description** to provide support for the claim was, however, not allowable under Art. 123(2), because the amended description would contain subject-matter which extended beyond the content of the

application as filed - namely information that such feature was not an essential feature of the invention.

Decision **T 260/85** (OJ 1989, 105) was of fundamental importance for the opposite case. It stated that it was not permissible to **delete from** an independent **claim a feature** which the application as originally filed consistently presented as being an essential feature of the invention, since this would constitute a breach of Art. 123(2). **T 496/90**, **T 189/94** 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. It argued that the low and high AC voltages were consistently referred to in the description and claims as being three-phase: the expression “three-phase” appeared about 200 times in the application as originally filed and no other number of phases was mentioned at all. The skilled person reading the application as originally filed would not necessarily have regarded the numerous references to “three-phase” as being purely by way of examples. Although it was possible that upon reflection, and using his imagination, it might occur to him that it was not essential to use three phases, this would be his own idea, resulting from his own thinking. It was not part of the content of the application as originally filed.

In **T 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 is also clear from **T 331/87** (OJ 1991, 22), in which deletion of a non-essential feature was allowed: the replacement or removal of a feature from a claim may not be in breach of Art. 123(2) if the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and (3) the replacement or removal required no real modification of other features to compensate for the change (see also **T 60/90**, p. 162).

3.3 Derivability of amendments from application as filed

In a number of recent decisions boards viewed with reservation the “novelty test” for the admissibility of amendments to a patent application. **T 133/85** (OJ 1988, 441) pointed out that care was necessary when applying the law relating to novelty to questions which arise in relation to Art. 123(2). In **T 177/86** the novelty test was described as “not very useful” for examining the admissibility of broadening a claim.

Decision **T 194/84** (OJ 1990, 59) related to amendments leading to the generalisation of the subject-matter of an application or to the omission of a feature (in this instance, the use in an electrode of a storage battery cell of cellulose fibres in general instead of natural cellulose fibres). The patentee had taken the view that the amendment was admissible because the original application could properly be cited against the novelty of a more generic claim to cellulose fibres. The board took the view that this approach was based on a misapplication of the novelty test. The test for additional subject-matter corresponded

to the test for novelty only in so far as both required assessment of whether or not information was directly and unambiguously derivable from that previously presented, in the originally filed application or in a prior document respectively. An amendment was not allowable if the resulting change in content of the application, in other words the subject-matter generated by the amendment, was novel when compared with the content of the original application or, looked at another way, if the said change in content would be novelty-destroying for a hypothetical future claim when the original content would not be. It was important that it was the change in content which was tested, ie the amended content minus the original content, so that the test was applicable to amendment by generalisation or omission of a feature.

In **T 514/88** (OJ 1992, 570) the board took the view that the two tests in relation to the question of broadening of claims before grant by abandoning a feature, ie the test for essentiality (or inessentiality) on the one hand and the novelty test on the other, were not mutually contradictory but represented the same principle. In both cases the relevant question was whether or not the amendment was consistent with the original disclosure. This meant direct and unambiguous derivability from and no contradiction of the totality of the original disclosure. **T 527/88** and **T 685/90** followed the same reasoning.

T 118/89 took a reserved attitude to the novelty test, but at the same time emphasised the importance of the above mentioned key question, in stating that the allowability of amendments during the grant procedure could be determined without reference to the state of the art simply by comparing the protection sought on the basis of the current claims with the disclosure in the application as filed. There was therefore no objective need to carry out new or modified novelty tests. The test for novelty was similar to that for allowability of amendments under Art. 123(2) only in so far as the former also involved a direct comparison, in this case between the claims and the disclosure in a document or other evidence possibly prejudicial to novelty, ie the state of the art.

It is also clear from **T 288/92** and **T 187/91** (OJ 1994, 572) that the decisive question is whether the amendment can be directly and unambiguously deduced from the application documents as filed. In **T 288/92** the appellant/applicant contended that the amendment resulted in a limitation of the original claim. The board rejected this argument on the grounds that the expression "subject-matter which extends beyond the content of the application as filed" in Art. 123(2) prohibited the introduction of any technical information which a skilled person would not have objectively derived from the application as filed, so that the examination of the allowability of an amendment according to Art. 123(2) was directed to the process of "derivation" (see also **T 383/88**), as distinct from a simple comparison of the scopes of amended and unamended subject-matters. In the view of the board this provided a definitive method for deciding the allowability of an amendment. Any other "test", such as the "novelty test", necessarily posed hypothetical questions.

On the facts of the case the board held that it was not permissible to amend a generic formula defining a class of chemical compounds by restricting an originally disclosed generic definition of a substituent to a specific (individual) one which was arbitrarily selected from chemical entities, such as in the examples, without some support for such restriction in the general part of the description.

In **T 187/91** the appellant requested that a patent on a fibre optic amplifier be granted. The claims in the application as filed referred to "a plurality of pump light sources", ie **two** or more light sources; the amended claims referred to "a pump light source" and, thus, sought protection for a fibre optic amplifier including **one** or more light sources. The board

conceded that there was clearly a close conceptual correlation between the assessment of novelty and the assessment of what was an allowable amendment under Art. 123(2). It further explained, however, that two considerations which underlay Art. 123(2) were different from those that underlay Art. 54: firstly, a reader of an application published pursuant to Art. 93(1) after 18 months would be informed of the maximum extent of its subject-matter and therefore its maximum content some time before the text of the application including the claims was finalised, having regard to the drawing up of the European search report and the subsequent examination of the application. Secondly, the relationship between the claims and content of the European patent application was determined by the idea that, after appropriate amendment if necessary, the granted claims should give a fair protection for the inventive subject-matter contained in the application as filed.

The board found that a skilled reader of the application as filed would seriously contemplate the use of only one light source when carrying out the described invention; there was nothing in the application as filed or in his common general knowledge which would cause the skilled person to exclude the possibility of using only one light source. Additionally, on a careful and analytical reading of the whole content of the application as filed, there was no reason to regard the use of a plurality of light sources as essential to the invention in order to achieve its stated aims. On the contrary, the proper interpretation of the content of the application as filed was that it included as one possible practical variation of the preferred embodiment of the invention a fibre optic amplifier having only one light source.

B. Article 123(3) EPC

Art. 123(3) prohibits amendments to granted claims during opposition proceedings in such a way as to 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) was not contravened if a restrictive term in a granted claim which in its strict literal sense did not embrace an embodiment set out in the description was replaced by a less restrictive term. The restrictive term should not, however, be so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the description and drawings. Moreover, it had to be quite clear from the description and drawings and also from the examination procedure up to grant that the further embodiment belonged to the invention and that it was never intended to be excluded from the protection conferred by the patent.

In **T 231/93** the claim in the granted patent had been amended in the opposition proceedings in such a way that it also encompassed parameter values which, for technical reasons relating to the problem stated in the granted patent, could not have been considered by the skilled person. However, the granted patent gave no information about these technical considerations. The board concluded that, having regard to the prohibition in Art. 123(3) on extending the scope of the patent, such values were not necessarily excluded when the claim was interpreted in order to determine the extent of the protection conferred.

2. Moving features from preamble to characterising portion

In **T 16/86** the board pointed out that it was the subject-matter of the claim as a whole which embodied the invention: Therefore, in so far as a change in the position of a feature inside a claim did not alter the meaning thereof, the extent of protection conferred therefore remained unchanged and such an amendment did not contravene either Art. 123(2) or Art. 123(3).

In **T 160/83** the board had no objection to the appellants' amendment of the characterising clause so as to include a feature which was previously in the preamble but not shown in the document representing the closest state of the art.

In **T 96/89** the board of appeal again allowed the transposition of features from the preamble of a claim to its characterising portion. This did not alter the subject-matter claimed, and thus did not extend the scope of protection. Nor was it in breach of Art. 123(3) if terms were first generalised in the preamble, then trimmed back in the characterising portion to the subject-matter originally disclosed. R. 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 **T 49/89** the subject-matter of granted claim 1 had been limited during opposition proceedings to a special embodiment according to granted dependent claim 2. The board of appeal held that the protection had not been extended because new claim 1 indicated

all the features in granted claim 1 and the newly incorporated features were merely elaborations on those contained in granted claim 1. The extent of protection conferred by a European patent was determined by the content of **all** claims, not that of one or several only. Thus, for example, even though an independent claim lacked novelty a claim dependent on it could still be valid and the patent proprietor could restrict himself to that claim. It was, moreover, irrelevant when determining the extent of protection whether features were referred to in the prior art portion or characterising portion. The transposition of information from one to the other did not therefore contravene Art. 123(3).

3. Change of claim category

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

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

An amendment of granted claims directed to "a compound" and to "a composition including such compound", so that the amended claims were directed to "the use of that compound in a composition" for a particular purpose, was not open to objection under Art. 123(3). For it was generally accepted as a principle underlying the EPC that a patent which claimed a physical entity per se, conferred absolute protection upon such physical entity, for all uses of such physical entity, whether known or unknown. It followed that if it could be shown that such physical entity (eg a compound) was already part of the state of the art, then a claim to the physical entity per se lacked novelty. It also followed that a claim to a particular use of a compound was in effect a claim to the physical entity (the compound) only when it was being used in the course of the particular physical activity (the use), this being an additional technical feature of the claim. Such a claim therefore conferred less protection than a claim to the physical entity per se.

In **T 912/91** the appellant/patentee claimed the use of graphite for obtaining a sintered composite ceramic body having certain characteristics. The board held that the change of claim category from the granted product claims for composite bodies to these use claims did not broaden the scope of protection of the granted claims. Even if it were considered that the use claim was notionally equivalent to a claim to a process including the step of using the graphite in the sintered body and that the effect of Art. 64(2) was to confer

protection on the product resulting from this process as well, this would not represent an extension of protection within the meaning of Art. 123(3), since the sintered composite body was defined in the use claim in a more restricted way than the composite body of the granted claim (narrower range of the graphite content, etc.).

In 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.

A change from a product claim to a claim for the use of the product was also allowed in **T 37/90**, **T 75/90**, **T 938/90** and **T 879/91**.

In **T 420/86** a change from a claim for a process for treating soil, in which X was used, to a claim for the use of X for treating soil was allowed. In **T 98/85** on the other hand, a change from a "process for the preparation of a ... composition" to the "use of this ... composition as a ..." was seen as a breach of Art. 123(3).

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 was in itself patentable, such methods were also patentable unless the disclosure was insufficient.

A change from a product claim to a claim for a process for manufacturing the product is generally seen as unproblematical (**T 54/90**, **T 191/90**, **T 762/90**, **T 153/91**, **T 601/92**). In **T 423/89** the change in category from a product-by-process claim to a manufacturing process claim was admissible. In **T 402/89**, however, the board pointed out, in passing, certain difficulties in interpreting the term "protection conferred".

In **T 5/90** the patent was granted with a claim in the form "a product having product features x and product-by-process features characteristic of process steps y". This claim, however, turned out not to be novel. The patentee finally claimed "a process of making a product having product features x by using process steps y and process steps z".

The board interpreted such a claim as covering the process steps only in so far as a product having product features x actually resulted. This was called a process-limited-by-product claim by the board. The direct product of this process would also be protected under the provisions of Art. 64(2), but such product inevitably fell within the scope of the product claim originally granted. The board regarded a process-limited-by-product claim of this type as clearly complying with the requirements of Art. 123(3) because it would only be infringed if the product fell within the originally granted product claim and in addition the particular form of manufacture using process steps z was used.

In **T 378/86** (OJ 1988, 386) the board pointed out that a change of category after a patent had been granted was admissible, having regard to Art. 123(3), only in exceptional cases. Where the granted patent related to a method of working, its subsequent conversion into an apparatus patent was such an exceptional case if the extent of protection conferred by the process patent (Art. 69) encompassed the apparatus for carrying out the method of working. However, it was then necessary for the means of carrying out the process to be described in such detail and so comprehensively that an average skilled person could, without undue effort, deduce fully and clearly the apparatus suitable for carrying out the protected process from the technical teaching defined in the process patent.

In **T 426/89** (OJ 1992, 172) the claim related to a process for operating a pacemaker. An actual operating method for a pacemaker for arresting a tachycardia would necessarily be a method for treating the human (or animal) body by therapy using a pacemaker, and would not be patentable. However, the patentee maintained that the claim referred to the steps in a technical method which did not define a method of treatment but rather, in functional terms, the structural features of a pacemaker. The board agreed. If correctly interpreted in accordance with Art. 69(1), second sentence, claim 1 did not define a method but rather an apparatus (pacemaker) in terms of the functions of its components. Since the reference to a method in the designation of the subject-matter of claim 1 did not make this explicit, the board regarded claim 1 as not "clear" within the meaning of Art. 84. The differences between the patent according to the auxiliary request and the granted version were that in claim 1 the title of the invention, "Method for the operation of a pacemaker", had been replaced by "Pacemaker". The board pointed out that the amendment of claim 1, including its change of category, did not contravene Art. 123(3). Claim 1 as granted was already a product claim containing a functional definition of a pacemaker. So the seeming change of category did not alter the content of the claim but simply served to clarify it (see also **T 378/86**).

In **T 82/93** (OJ 1996, 274) the granted patent contained a claim 1 relating to a method of operating a pacer. The board found that this claim defined a method for treatment of the human body by therapy and therefore was not allowable under Art. 52(4) (see p. 35). It held that the device claim of the auxiliary request was not allowable under Art. 123(3). The subject-matter protected by the granted claim was a pacer, **when in use**; in contrast, the claim of the auxiliary request only included technical features which defined physical characteristics of the pacer device itself. The board explained that in general terms, if a patent as granted only included claims defining the operation of a device and therefore containing both "device features" and "method features", and the patent as proposed to be amended during opposition proceedings included claims which only contained "device features", the proposed amendment was not allowable having regard to Art. 123(3), because the patent as granted conferred protection upon the device only when it was in use so as to carry out the method, whereas the patent as proposed to be amended would confer protection upon the device whether or not it was in use, and would therefore confer additional protection compared to the patent as granted.

In contrast to the findings in **T 426/89** mentioned above, in this case the board held that claim 1 as granted was clear, defined the use of a device to carry out a method of treatment of the human body by therapy and was not a pure "device claim" since it also included method steps. Thus, under such circumstances, Arts. 52(4) and 123(3) might operate in combination as an "inescapable trap".

C. Relationship between Article 123(2) and 123(3) EPC

1. Cases of conflict

In **T 384/91** (OJ 1994, 169) 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 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 was dealt with under reference number **G 1/93** (see pp. 157 and 172 below).

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 “paradoxical result” could be avoided by interpreting the two paragraphs in terms of their mutual relationship, where one was predominant, ie independent, and the other subordinate, ie 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 alternative (b); protection of third parties was then crucial. If, on the other hand - as was the case here - the added feature had no technical significance, then alternative (a) seemed appropriate and, thus, the deletion of the feature justified.

In **T 10/91** (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. It could therefore stay in the claim, but could not be taken as delimiting when examining for novelty and inventive step.

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

2. Decision of the Enlarged Board of Appeal

In **G 1/93** (OJ 1994, 541) the Enlarged Board of Appeal pronounced on the question of “limiting extensions”:

If a European patent as granted contained subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) and which also limited the scope of protection conferred by the patent, such patent could not be maintained in opposition proceedings unamended, because the ground for opposition under Art. 100(c) prejudiced the maintenance of the patent. Nor could it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which was prohibited

by Art. 123(3). Therefore, in principle, if the European patent as granted contained a “limiting extension” as described above (1.), it had to be revoked. Paragraphs 2 and 3 of Art. 123 were mutually independent of each other. In this sense, it had to be admitted that Art. 123(2) in combination with Art. 123(3) could operate rather harshly against an applicant, who ran the risk of being caught in an inescapable trap and losing everything by amending his application, even if the amendment was limiting the scope of protection. However, as submitted by the opponent, this hardship was not *per se* a sufficient justification for not applying Art. 123(2) as it stood in order to duly protect the interests of the public. Nor did it, in principle, matter, that such amendment had been approved by the examining division. The ultimate responsibility for any amendment of a patent application (or a patent) always remained that of the applicant (or the patentee).

The Enlarged Board, however, also mentioned three other instances:

- If the added feature could be replaced by another feature disclosed in the application as filed without breaching Art. 123(3), the patent could be maintained (in amended form). This might turn out to be a rare case in practice (see p. 173, **T 166/90**).
- An added undisclosed feature without any technical meaning could be deleted from a claim without violating Art. 123(3).
- An added feature, which did not provide a technical contribution to the subject-matter of the claimed invention but merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, was not considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2). In this case also the patent could be maintained (see p. 157).

3. 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** (OJ 1994, 228) 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 had the same meaning as the correct interpretation of the uncorrected claim in the light of the description.

D. Rule 88, second sentence, EPC

1. Relation to Article 123(2) EPC

The boards have been called upon several times to discuss the question whether a correction under R. 88, second sentence, 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 decisions **T 401/88** (OJ 1990, 297) and **T 514/88** (OJ 1992, 570) the answer was negative. In **T 200/89** (OJ 1992, 46) the board took a similar view with regard to Art. 123(3) and concluded that requests for correction under R. 88 and requests for amendment under Art. 123 had to 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 offered as the correction could take the form of documents filed only after the application. On this point a different conclusion was reached in **T 401/88** (OJ 1990, 297) than in **J 4/85** (OJ 1986, 205). As a result of referrals by the President of the EPO (**G 3/89**, OJ 1993, 117) and by a board of appeal (**G 11/91**, OJ 1993, 125) both questions came to be decided by the Enlarged Board. The Enlarged Board's conclusion was that the parts of a European application or patent relating to the disclosure (description, claims and drawings) could be corrected only within the limits of what the skilled person would derive directly and unambiguously, using common knowledge and seen objectively and relative to the date of filing, from the whole of these documents as originally filed. Such a correction was of a strictly declaratory nature and thus did not infringe the prohibition of extension under Art. 123(2). Other documents - notably priority documents and the abstract - could not be used for correction purposes even if filed together with the application, but could, however, be adduced as evidence of common general knowledge on the date of filing. Evidence of what constituted such knowledge on that date could be furnished in any suitable form. And documents not relating to the disclosure could, under certain circumstances, be included partially or wholly in the disclosure by means of reference.

No correction was possible if there was any doubt as to whether a mistake existed, or whether nothing else could have been intended other than what was offered as the correction.

2. Correction at the discretion of the EPO

R. 88 gives the EPO discretion in allowing corrections. In **T 726/93** (OJ 1995, 478), considering the highly unusual circumstances of the case, the board exercised its discretion by allowing the erroneously filed wrong claims and description to be replaced by the documents which the appellant had actually intended to file. The board took the view that it was immediately evident on the filing date, from obvious inconsistencies in the application documents, that the appellant's intention had been to file documents corresponding to the priority document filed on the filing date, since the claims and description of the priority document exactly matched the particulars in the request for grant and the drawings filed, which were the correct ones.

In **J 21/85** (OJ 1986, 117), however, the Legal Board had held that R. 88 did not permit an invention covered by a request for grant of a patent to be exchanged for another, even if a request for correction under R. 88 was submitted immediately the application had been filed and it was demonstrated beyond doubt that the inventions were unintentionally confused.

In **J 21/94** (OJ 1996, 16) doubts were raised about **T 726/93** and the following question

was referred to the Enlarged Board: "Can the complete documents forming a European patent application, that is the description, claims and drawings, be replaced by way of a correction under Rule 88 EPC by other documents which the applicant had intended to file with his request for grant?" The case is pending under Ref. No. **G 2/95**.

3. 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 required correction to an error in the claim was evident from the description. In **T 488/89** the reference to a parallel application enabled the skilled person to establish without difficulty the correct limit values. In **T 365/88** it was ruled that an abbreviation in the claim could be corrected because it appeared correctly in the description; an additional Roman numeral I in the abbreviation of an enzyme was implicitly disclosed because at the time of filing only one enzyme of this type was known, and clarification prevented confusion with enzymes of the same type discovered at a later date.

In **T 990/91** the board allowed the correction of a chemical name on the grounds that an obvious error had been made in naming a salt which was the subject-matter of the application – the molecular formula of this salt was clear from the application. However, the molecular formula corresponding to the name was different. Guided by the content of the application and taking into account cited documents which were published before the priority date of the application in question, the correction required would be immediately evident to the skilled person.

In **T 417/87** the board of appeal allowed the number of a publication cited in the original description to be corrected under R. 88, second sentence. In **T 158/89**, however, correction of a percentage range of a component was not allowed. In the board's view, the skilled person could have deduced from inconsistencies in the claims and description that an error had occurred. However, there were two plausible ways of correcting it. Since the skilled person would have regarded both alternatives as equally plausible, it was not immediately obvious that nothing else had been intended other than the proposed correction.

In **T 606/90** the board allowed a correction pursuant to R. 88, second sentence, in the opposition proceedings although the correction was not so obvious from the published text of the patent that it was immediately evident that nothing other than the proposed correction could have been intended. The applicant had filed typed amendments to the claims and the description and had also submitted the "working document" with the handwritten corrections for the dossier. The typed version of claim 1 omitted the detail which was now the subject of a request for correction pursuant to R. 88; the same detail was present in the corresponding passage in the description. When the text was being prepared for publication of the patent, the detail in question was also omitted from the description owing to an error by the EPO. The board concluded that the omission in the description should not be taken into account when considering the admissibility of the correction and stated:

"It is therefore clear that the phrase in question was omitted from the typed version of claim 1 as a result of an error by the applicant and that the reader of the patent would immediately have noticed the need for correction of this error if a transcription error had not likewise been committed by the EPO. The correction requested is therefore admissible within the terms of R. 88".

E. Standard of proof for allowing amendments and corrections

In **T 383/88** the board held that the normal standard of proof in proceedings before the boards of appeal, namely “the balance of probability”, was inappropriate for determining the allowability of an amendment under Art. 123(2). Instead, a rigorous standard, ie one equivalent to “beyond reasonable doubt” was considered by the Board to be the right one to apply in such a case, since applying a lower standard could easily lead to undetected abuse by allowing amendments on the basis of ostensibly proven common general knowledge.

It had frequently been argued that certain technical features could be directly and unambiguously derived from a specification as filed by reading it in the light of common general knowledge. However, the board recommended viewing this approach with considerable caution. Firstly, the issue of the allowability of an amendment under Art. 123(2) had to be decided by reference to what could be derived from the patent application as filed in the light of common general knowledge and not vice versa. Secondly, it was notoriously difficult to prove common general knowledge. For example, information might be generally disseminated, and therefore known within the community of skilled addressees, but it might well, at the same time, not be commonly accepted. Furthermore, too much reliance could not be placed on affidavit evidence from over-qualified persons, for the relevant knowledge was that of a notional, ie average, skilled addressee, and not that commanded by leaders in the relevant scientific discipline or field. The board added that it could not normally be the case that an affidavit by a single person was sufficient to discharge the burden of proof to the strict standard that was required.

In **T 581/91** the board held that the balance of probabilities was not an appropriate criterion to be applied in a case where a correction under R. 88 was at stake. Following decision **T 383/88**, the board stated that a more rigorous standard, that is one equivalent to “beyond reasonable doubt”, ought to be applied.

As to extension of the protection conferred, see **T 113/86** (see pp. 246, 300).

IV. PRIORITY

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).

Arts. 87 to 89 provide a complete, self-contained code of rules on claiming priority for the purpose of filing a European patent application (see **J 15/80**, OJ 1981, 213). However, since the EPC - according to its preamble - constitutes a special agreement within the meaning of Art. 19 of the Paris Convention, it is clearly intended not to contravene the basic principles concerning priority laid down in the latter (see **T 301/87**, OJ 1990, 335, Reasons for the Decision, 7.5; **G 3/93**, OJ 1995, 18).

A. Applications giving rise to a right of priority

1. National deposit of industrial design

In **J 15/80** (OJ 1981, 213) it was held that a priority right based on the deposit of an industrial design was not recognised for a European patent application. As the EPC was a special agreement within the meaning of Art. 19 of the Paris Convention, a general understanding by the contracting states to the EPC that the deposit of an industrial design clearly gave a priority right for a national patent application could, by application of Art. 4 of the Paris Convention, lead to an interpretation of Art. 87(1) going beyond its terms and permitting such deposits to give priority rights for European patent applications. However, in the absence of such a general understanding there was no reason to read Art. 87(1) more broadly than its express terms and scope required.

In the board's opinion it was the law under the Paris Convention that, in relation to patent applications, a right of priority under that Convention existed if the prior application was for the protection of an invention as such and contained a disclosure of it. The deposit of an industrial design in essence protected aesthetic appearance. Although the deposited design might incorporate an invention, according to national design laws the deposit would not protect the invention as such.

2. Postdating of the previous application

Swiss patent law allows a patent application to be postdated if it is subsequently amended. In **T 132/90** the patent proprietor had claimed 11.3.1983, the original filing date of the earlier Swiss application, as the priority date for their European application dated 9.3.1984. In 1985 the Swiss Patent Office ordered that the filing date of the Swiss patent application be set at 1.7.1983 following subsequent completion of the technical documentation.

The board of appeal concluded that the original application should serve as the basis for claiming a priority right and that the priority date was the filing date of the original application. The postdating order did not have *ab initio* effect, and the subsequent fate of the original application was immaterial as far as the priority date was concerned. Furthermore, the patent proprietor had only claimed a priority right with respect to the Swiss patent application with the filing date of 11.3.1983, not for the subsequently filed amendments.

B. Identity of invention

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.

1. Disclosure in the previous application

1.1 Disclosure in the previous application as a whole

Disclosure in the previous application means that the subject-matter of the claims of the European application must be clearly identifiable in the documents of the previous application taken as a whole (**T 184/84**, **T 359/92**, **T 469/92**, **T 597/92** (OJ 1996, 135)). 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 (see also **T 184/84**, **T 359/92**). Art. 88(4) cannot be construed as meaning that a priority document must comprise claims in order to form a regular national filing (as defined by Art. 87(3)) which can give rise to a right of priority. If the priority document does not include any claims, this does not mean that the conditions of Art. 88(4) are not fulfilled (**T 469/92**). Features of the invention may also be disclosed in the drawings (**T 169/83**, OJ 1985, 193, Reasons for the Decision, point 4.2).

1.2 “Essential” features

(a) In order to give rise to priority all the essential elements, ie features of the invention in the priority document must be either expressly disclosed or directly and unambiguously implied by the text as filed. The question therefore arises as to what constitutes the essential elements, ie features of the invention, claimed in the European patent application, and whether or not these features are disclosed in the respective priority documents (see Art. 88(4), **T 81/87**, OJ 1990, 250; also **T 65/92**, **T 127/92**, **T 296/93**). Missing elements recognised as essential only later on, are thus not part of the disclosure of the previous application. The authoritative decision on these principles is **T 81/87**; it has been followed by inter alia **T 301/87**, OJ 1990, 335, Reasons for the Decision, point 6.3, **T 269/87** and **T 296/93**.

(b) In **T 581/89** the European application contained two features which were not expressly mentioned in the priority document. These features, however, were not necessary to establish an invention over the prior art, and there was no correlation between them. What the applicants regarded as their invention was defined by other features. The board held that the requirement that priority could be validly claimed only in respect of “the same invention” had been met: the features in question constituted nothing more than routine choices of parameters which would normally be made by skilled persons and did not change what was believed to be “the invention” as such.

1.3 Error margins

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

In **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, since the latter included 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 the applicants were entitled to the right of priority.

In **T 957/91** the board held that the fact that the figure "29.4" for the lower limit of a draw ratio was not expressly mentioned in the priority document could not, in a situation where the very close figure of 30 was disclosed in conjunction with the same quantitative and qualitative correlation of this feature (draw ratio) to the other relevant essential criteria, change the substance of the subject-matter concerned.

1.4 Definition of limits

Where the limits defined in a subsequent application differ from those in the previous application consideration must be given to the individual circumstances of the case.

In **T 65/92** the upper limit for the molecular weight of a particular protein had been given in the earlier application as 65 kilodaltons (kD); in the subsequent application it was given as 68 kD. The other features of the invention were the same in both applications. Since molecular weight can, in any case, be determined only approximately the board had no reason to assume that the reported difference originated from a true structural difference between the product of the present application and that of the priority document, or from an attempt by the appellant to cover - through the change of the upper limit from 65 kD to 68 kD - elements which had been recognised as essential only later. The board thus came to the conclusion that both applications related to the same invention. The difference of 3kD was therefore immaterial in assessing the validity of the priority right.

In **T 131/92**, the claimed invention related to mucopolysaccharides with pharmaceutical applications. The board concluded that the inventions in both the previous and the subsequent applications were not identical. The molecular weights of the products according to the valid product and process claims ranged from 2000 to 8000 daltons, whereas the priority documents only mentioned a preferred range of 3000 to 6000 daltons. The preparation process according to the priority document and that according to the granted patent were identical except for molecular weight.

The board found that the preparation processes were not identical. The molecular weight feature could not be regarded as the inherent result of the process, since it was determined by external intervention, ie by the point at which the process was interrupted. It was self-evident that a process interrupted when the products prepared had a molecular weight of the order of 30000 to 6000 and one interrupted when the molecular weight was of the order of 2000 to 8000 were not identical. Moreover, the influence of molecular weight on the properties of the claimed products meant that the range of those products was not co-extensive with that of the products described in the priority document. In view of the interdependence between the molecular weight and the biological activity of the products claimed, identical properties could not be expected within and outside the range of 3 000 to 6 000 daltons.

1.5 Disclosure in the claims of the previous application

T 409/90 (OJ 1993, 40), on the other hand, showed that a broad claim in the previous

application was not necessarily a suitable basis for a priority right. This decision was based on the principle that what was disclosed by a priority document was what could be deduced from the priority document as a whole by a person skilled in the art. However, when considering what was disclosed in a priority document's claim it was necessary to bear in mind the purpose of the claim, ie to define the protection sought. The fact that a claim in a priority document was broad enough to cover specific subject-matter filed for the first time in a later application was not by itself sufficient evidence that such subsequently filed subject-matter had already been disclosed in the priority document, or that subsequent claims based on the later filed subject-matter still defined the same invention as that which was the subject of the priority document.

In this case the applicant had claimed priority from a Japanese patent application for a European divisional application. During 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, where the shielding effect was ascribed to the extremely low doping of the surface layer. This assessment was unaffected by the fact that the claim in the first application also contained the features claimed in the second application.

2. Enabling disclosure in the priority document

The boards of appeal require a cited document to contain an enabling disclosure for it cause lack of 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 pre-prorennin, only the priority claim of the second previous application was valid because in the first one the steps leading to the desired bovine preprorennin gene were not sufficiently disclosed. The board took the view that in order to give rise to priority rights the essential elements, ie the features of the invention, in the priority document had to be either expressly disclosed or directly and unambiguously implied in the text as filed; missing elements recognised as essential only later on were not part of the disclosure, and gaps with regard to basic constituents could not be retrospectively filled by relying on knowledge acquired in this manner. It could become a misuse of the priority system if some parties in a competitive situation were allowed to jump ahead of others on the basis of mere expectations and by omitting the critical features of the invention altogether; the features necessary for preparing the prorennin gene were critical, because they were not contained in the state of the art, and could 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.

In **T 296/93** the board was not convinced by the opponent's arguments that priority document B1 was deficient in respect of the relevant technical information necessary to

enable a skilled person to reduce the claimed invention to practice without undue burden. As no essential elements (ie features) of the claimed invention could be said to have been recognised or added only later on in the sense that they were not part of the disclosure of the priority document, the claims under discussion and the priority document on which they were based had to be regarded as relating to the same invention within the meaning of Art. 87(1). Consequently, the said claims were entitled to the BI priority date.

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 from carrying out an example. Since that 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 grounds that the skilled person would have had no difficulty in identifying the final product from the data given in the priority document.

3. 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 was not lost if the subsequent application contained a feature in the claims which had not been disclosed in the previous application but merely limited 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 were not changed by the additional feature.

In **T 73/88**, priority was claimed from a British application, in which the invention was described as an expanded snack food comprising discrete cooked portions of a dough composition comprising gelatinised starch and added bran. A technical effect of the invention was 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 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 in a claim of a technical feature which was essential for the purpose of determining the scope of protection conferred was not necessarily essential for the purpose of determining priority. In this case it was clear from the European patent that the additional technical feature was concerned with 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 had to be considered when deciding upon a claim to priority. The effect of the additional technical feature was really to disclaim some snack products which were in accordance with the essence of the invention as such, but which did not have a fried flavour, and thus to limit the claimed invention to a particular class of products. The presence of the 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, ie the British application.

In **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 grounds that a German patent specification, published between the priority date and the date of the European filing, disclosed embodiments of the claimed catalytic converter and was prejudicial to novelty because the French priority had not been validly claimed. The priority was invalid because the European patent application's claims contained an additional feature - the weight ratio between two components in the catalytic converter - not revealed in the French 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, which meant that 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) and **T 669/93**.

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 applicant's legal predecessors had filed an application (1) with the USPTO in 1983, the priority of which had been claimed in respect of a European application (2), published on 3.4.85. The current applicant had then filed a further application (3) in the USA on 19.3.85, from which he claimed priority for an application (4) filed with the EPO on 14.3.86.

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), since 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. First application in a Paris Convention country

In principle, only the first application filed in a state party to the Paris Convention can form the basis of a priority right. In the EPC, this is made clear in Art. 87(1).

If, apart from the application whose priority is being claimed in the subsequent European application, an earlier previous application was also filed (particularly outside the priority period), it must be established whether the invention claimed in the subsequent application was disclosed in the earlier application, which would render a priority claim based on the later previous application 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 to that in the European application and the application from which priority had been claimed: the claimed process (for increasing the filling power of tobacco lamina filler) differed as regards both the moisture content of the tobacco for processing and the first step in the process.

In **T 400/90** priority had been claimed from a US application in respect of a European application concerning an electromagnetic flowmeter. The opponents submitted that the same invention was already the subject of an earlier US application filed by the same applicant outside the priority period: the earlier US application disclosed all the features contained in the European application with the exception of the use of saddle-shaped coils; however, the latter were already known and used frequently. In the board's opinion, the question to be answered was whether the use of saddle-shaped coils had been disclosed in the earlier US application, and not whether it was obvious to use such coils in place of the magnets disclosed in the earlier application. The board came to the conclusion that the inventions claimed in the US applications were different and priority had rightly been claimed from the later application because, according to the teaching of the earlier application, coils of any shape could be used, whereas according to the teaching of the priority document saddle-shaped coils had to be used.

In **T 184/84** a method of producing a single crystal of ferrite was claimed in a Japanese application, the priority of which was claimed in respect of a European application, and in a previous Japanese application. The starting materials were defined differently in the two Japanese applications. The method disclosed in the later application and the European application was clearly more advantageous than that forming the subject-matter of the earlier Japanese application. The board held that the significant differences in properties were indicative of the presence of different materials and therefore found that the earlier Japanese application was not the first filing of the invention claimed in the European patent application. It based its finding on **T 205/83** (OJ 1985, 363, Reasons for the Decision, point 3.2.1), which stated that the novelty of products prepared using a modified process could be established by the fact that according to an empirical principle in chemistry, a product's properties were determined by its structure, so that differences in the properties of products indicated a structural modification.

In **T 255/91** (OJ 1993, 318; see p. 182) the board of appeal examined whether the earlier previous application anticipated the later one in order to establish whether the priority claim based on the later previous application was valid.

A further two cases dealt with earlier applications disclosing similar inventions to those in applications from which priority had been claimed for subsequent European applications. In **T 251/91** the board held that the novelty test should be applied in order to establish whether an invention was already disclosed in an earlier previous application, in the situation where a subsequent application claims priority from a later previous application. In **T 1090/92** a European patent application claimed priority from documents (D2) and (D3). Documents (D4) and (D5), which had in turn been claimed by (D3) and (D2) as giving rise to a right of priority, had not disclosed the invention according to the contested patent as they did not cause either (D3) or (D2) to lack novelty.

D. 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, claims in the subsequent application have the priority date of the previous application in which the matter subsequently claimed was disclosed. Multiple priorities may be claimed for any one 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 **G 3/93** (OJ 1995, 18), the Enlarged Board decided that a document published during the priority interval, the technical contents of which corresponded to that of the priority document, constituted prior art citable under Art. 54(2) against a European patent application claiming that priority, if such priority was not validly claimed. This also applied if a claim to priority was invalid due to the fact that the priority document and the subsequent European application did not concern the same invention because the European application claimed subject-matter not disclosed in the priority document.

The Enlarged Board emphasised that the existence of a right of priority depended, *inter alia*, on the fulfilment of the requirement of identity of invention, that is whether the previous application disclosed the same invention as that claimed in the subsequent European application. Where priority was claimed but could not be allowed because the inventions were not the same (despite the fact that the unity requirement was fulfilled), there was no right to priority. Consequently, any publication of the contents of a priority document during the priority interval constituted prior art citable against elements of the European application which were not entitled to priority.

In **G 3/93** the Enlarged Board rejected the arguments on the claiming of multiple priorities put forward in **T 301/87** (OJ 1990, 335, Reasons for the Decision, point 7.4). In this case the European patent application had 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). Board of Appeal 3.3.2 took the view that the publication of the content of the earliest application prior to the filing of the second application should not be counted as prior art when examining the patentability of the subject-matter of the second application. It stated that, according to Art. 4B of the Paris Convention, when priority was claimed, the content of the earlier application, despite publication, was not included in the prior art to be considered during examination of a subsequent application filed in due time.

The Enlarged Board, however, confirmed the view taken in **T 441/91**: in that decision Board of Appeal 3.4.1 counted publication of the content of the priority document during the priority year as part of the prior art to be taken into account when assessing the patentability of the subsequent European application. It found that the subsequent

application claimed a feature which was absolutely necessary for solving the problem set out in the subsequent application, but which was not disclosed in the previous application. The priority right was thus invalid because the invention claimed in the subsequent application and that disclosed in the earlier application were not identical. The subject-matter of the subsequent application could therefore be awarded only the priority of the European filing date.

In **T 127/92** a European patent application claimed the priority of two German utility models, which had been published during the priority interval (documents D1 and D2). The board of appeal took the view that priority had been validly claimed from D1 for claim 1 and several dependent claims. It was necessary to establish whether those sub-claims that also contained elements not disclosed in D1 were entitled to claim partial priority from D1 for the subject-matter of claim 1 contained within them. On the basis of the principles developed in **G 3/93**, the board came to the conclusion that D1 and D2 formed part of the state of the art in respect of these claims and that, consequently, the subject-matter of these claims no longer involved an inventive step. The patent proprietor therefore deleted them.

T 132/90 concerned a case in which claim 1 of the contested patent contained a feature B not disclosed in the Swiss priority document. The board held that a priority right therefore subsisted only with regard to part of the subject-matter of the claim, ie claim 1 without feature B, but not with regard to the subject-matter of that claim as a whole. The part of the subject-matter entitled to priority did not involve an inventive step. The subject-matter as a whole of claim 1 of the European application, which only had the priority status of the filing with the EPO, was no longer new because the patent proprietors had published all its features after filing the Swiss application.

In **T 620/94** it became apparent that the granted **claim 1 covered two alternatives A and B** of the invention. Only alternative B was disclosed in the priority document; alternative A was contained only in the subsequent European application. Prior art published during the priority interval rendered obvious alternative A. The patent could thus only be maintained in amended form, ie limited to alternative B.

V. RIGHT TO A EUROPEAN PATENT

In **G 3/92** (OJ 1994, 607), the Enlarged Board of Appeal 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 had been published, and in 1986 deemed to be withdrawn for non-payment of the examination fee. Thereupon the appellant claimed from the UK Patent Office Comptroller, and was granted, entitlement to a patent for the invention disclosed in the prior European application under Section 12(1) 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 referring Legal Board of Appeal took the view in its interlocutory decision **J 1/91** of 31.3.1992 (OJ 1993, 281) 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 referring board then went on to consider whether pendency was required under Art. 61. As the article was open to differing interpretations, the board decided to refer the question to the Enlarged Board.

The Enlarged Board of Appeal held that when it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Art. 61, files a new European patent application in respect of the same invention under Art. 61(1)(b), it is not a pre-condition for the application to be accepted that the earlier original usurping application is still pending before the EPO at the time the new application is filed.

The Legal Board of Appeal therefore ruled in **J 1/91** of 25.8.1994 that the conditions of Art. 61(1)(b) had been met and accordingly remitted the patent application to the Receiving Section for further prosecution.

VI. PROCEEDINGS BEFORE THE EPO

A. Rules common to all proceedings - general principles

1. The principle of the protection of legitimate expectations

1.1 Introduction

A general principle well-established in European Community law, and one generally recognised in the EPC Contracting States and board of appeal jurisprudence, is that of the protection of legitimate expectations. This principle is applicable having regard to the good faith existing between the EPO and its users. Its application to procedure before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings (**J 10/84**, OJ 1985, 71, **G 5/88**, **G 7/88**, **G 8/88**, OJ 1991, 137). Some decisions also use the term "good faith" to describe this concept.

According to the jurisprudence of the boards of appeal, the principle of the protection of legitimate expectations governing procedure between the EPO and applicants requires that communications addressed to applicants must be clear and unambiguous, ie drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee.

A communication from the EPO containing erroneous information which leads 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). An applicant must not suffer a disadvantage as a result of having relied on a misleading communication (**J 3/87**, OJ 1989, 3). On the contrary, if his actions were based on a misleading communication he is to be treated as if he has satisfied the legal requirements (**J 1/89**, OJ 1992, 17).

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 **J 11/89** where the Receiving Section failed to take any particular action upon the receipt of Japanese patent documents intended to be considered as priority documents, but whose priority was not claimed in the request for grant.

In **T 905/90** (OJ 1994, 306, Corr. OJ 1994, 556) the board held that specific communications or other actions within the framework of particular proceedings and official statements such as guidelines were not the only sources of legitimate expectations; these could also properly arise from the actual general conduct or established practice of organs of the EPO. All changes in these practices should be officially announced at the earliest possible moment in order to avoid misleading the parties.

In **T 160/92** (OJ 1995, 35), the board made it clear that all procedural actions - whether formal or informal - taken by EPO employees vis-à-vis parties to proceedings were governed by the principle of the protection of legitimate expectations (including telephone calls, for example, which are not part of the formal procedure). The answer to the disputed question of whether the applicant was misled about the possibility of imminent refusal of the application by a telephone call was to be sought by focusing on the procedurally relevant content of the file.

1.2 Obligation to draw attention to easily remediable deficiencies

The protection of legitimate expectations requires the EPO to warn the applicant of any impending loss of rights if such a warning can be expected in all good faith. This

presupposes that the deficiency can easily be identified by the EPO and the applicant is in a position to correct it within the time limit. This means that anyone requesting re-establishment of rights must have his attention drawn to easily remediable deficiencies in his request if removal of the deficiency can be expected within the two-month period under Art. 122(2) for requesting re-establishment (**T 14/89**, OJ 1990, 432). If such a reminder of an imminent loss of rights can be expected but is not issued to the applicant within the time limit to be observed, the EPO must set a period for the applicant to correct the deficiency and perform the procedural act in due time (**J 13/90**, OJ 1994, 456).

In **J 15/90** of 28.11.1994 the Legal Board of Appeal held that an insufficient payment of a fee does not result in a loss of rights if the error occurred 18 days before the period expired and the EPO failed to inform the applicant.

In **J 15/92** the Legal Board of Appeal held that "in the case of a request whose true nature is uncertain (ie it is unclear whether this is a request for re-establishment or a request for a decision), the EPO should clarify the matter by asking the requester". It would have been sufficient in the case in point for the EPO to invite the applicant to define his request more precisely. For the EPO to interpret the request arbitrarily constituted an error rendering the impugned decision null and void (see also **J 25/92**).

In **J 41/92** (OJ 1995, 93) the board pointed out that the users of the EPC cannot, by merely asking the EPO to warn them of any deficiency that might arise in the course of the proceedings, shift their own responsibility for complying with the provisions of the Convention to the EPO. If, however, a deficiency is readily identifiable by the EPO and can easily be corrected within the time limit, the legitimate expectations principle requires the EPO to issue a warning.

In **T 690/93** the board held that the request for restitutio was inadmissible because the fee had not been paid in time. The board saw no justification for the suggestion that the legitimate expectations principle imposed on a board an obligation to warn a party of deficiencies within the area of the party's own responsibility. Once a case is within the jurisdiction of the board, the latter must avoid any action that could undermine the absolute impartiality it has to maintain between applicant, opponent and public in all proceedings. The board added that to issue a warning systematically for every readily identifiable deficiency, ie basic and mainly gross deficiencies, would only be to the benefit of negligent or incompetent parties or representatives. There could be no doubt in that context that the provisions of Art. 122(3) were extremely clear and simple. It is a consistent feature of the EPC that applications are only deemed to have been filed after payment of the requisite fee. The parties could not reasonably expect a board to issue warnings, at any time, for deficiencies of that fundamental order.

1.3 Courtesy services performed by the EPO

The principle of the protection of legitimate expectations also applies to courtesy services provided by the EPO where these are not worded so as to rule out any misunderstanding on the part of a reasonable addressee. However, an applicant cannot rely on the EPO systematically providing certain courtesy services and therefore is not entitled to base a claim on their omission (**J 12/84**, OJ 1985, 108, **J 1/89**, OJ 1992, 17, **J 27/92**, OJ 1995, 288).

In **J 1/89** the board held that the applicant was entitled to rely on the accuracy and completeness of information provided as a courtesy service. He could not, however, rely

on courtesy services not required by the EPC being systematically provided. An example cited was the due date for a renewal fee. If an applicant pays a renewal fee late as a result of a misleading reminder, he must be treated as if he had paid in time.

In **J 34/92** the fifth-year renewal fee had not been paid in full. The professional representative did not however receive the communication the EPO usually issues drawing attention to the fact that late payment of the renewal fee is possible upon payment of an additional fee. Furthermore, the communication under R. 69(1) was sent out so late that a request for re-establishment of rights could no longer be submitted within the one-year absolute time limit under Art. 122(2). The Legal Board of Appeal referred to its consistent jurisprudence according to which the EPO may subsequently grant applicants a time limit sufficient to allow them to perform acts they had been unable to perform previously because of the EPO's failure to exercise due care; but this is only applied to non-absolute time limits, as an **absolute time limit**, by definition, was non-extendable.

In **J 14/94** (OJ 1995, 825) the facts were quite different. The applicant had failed to pay the third renewal fee. Nevertheless, the EPO continued the examination procedure for several years without informing the applicant of any loss of rights. The board held that if, during a long period of time, the EPO by its conduct leads the parties and the public to the legitimate belief that no loss of rights has taken place, the EPO cannot later refer to a loss of rights which occurred several years previously as this would constitute "*venire contra factum proprium*" and therefore contravene the legitimate expectations principle. In such circumstances, the late payment of a renewal fee may - by way of exception - be considered as having been made in time, if the EPO had not informed the applicant of the outstanding payment, had accepted later renewal fees without objection and had continued the examination proceedings for several years.

In **J 27/94** (OJ 1995, 831) the board followed the ruling in **J 14/94** that if a declaration which is subject to a condition and, therefore, invalid, is treated as a valid procedural act by the EPO, the EPO is not allowed later to go back on its own earlier conduct which served as a basis for the applicant's decision on how to proceed because this would represent "*venire contra factum proprium*" and thus offend against a generally recognised legal maxim.

In **J 27/92** (OJ 1995, 288) the appellant had raised the question of whether European representatives were entitled to rely on the advice given by the Information Office. A representative maintained that he had been misled by information voluntarily given to him on the **telephone** by an officer of the EPO with regard to the amount of the examination fee payable. The board pointed out that parties to proceedings before the EPO - and their representatives - were expected to know the relevant provisions of the EPC, even when such provisions were intricate. Where such a service has been rendered, however, an applicant is entitled to rely upon its content if the communication from the EPO was the direct cause of the action taken and, on an objective basis, it was reasonable for the appellant to have been misled by the information. These principles apply not only to written communications but also to **oral communications** from the EPO.

1.4 Departure from previous jurisprudence and the legitimate expectations principle

This chapter deals with the question of when a new decision which deviates from existing practice to the detriment of an applicant becomes generally applicable and how the legitimate expectations of users of the EPO are protected. In three decisions (**G 5/88**, OJ 1991, 137, concerning an administrative agreement, **G 5/93** OJ 1994, 447 and **G 9/93**, OJ 1994, 891) the Enlarged Board of Appeal reached the conclusion that decisions over-

turning earlier rulings would not be applied up to the date on which they were made available to the public.

According to **G 5/93** the EPO was bound, by its own interpretation and practice, to admit the possibility of Euro-PCT applicants having their rights re-established with regard to the time limit for paying the national fee provided for in R. 104b in all cases where re-establishment of rights was applied for before decision **G 3/91** (OJ 1993, 8) was made available to the public (see also on p. 213 and **J 9/93**).

In **G 9/93** (OJ 1994, 891) the Enlarged Board of Appeal overturned its earlier ruling in decision **G 1/84** and held that a European patent cannot be opposed by its own proprietor (see also p. 282). The Enlarged Board held that where purely procedural matters are concerned there may be reasons of equity for not applying the new interpretation of the law to pending cases. As to the referred question of the admissibility of self-opposition, obviously patent proprietors in cases then pending before the EPO had had every reason to expect that such an opposition would be considered as admissible, relying on the decision in **G 1/84**, which had been followed for many years. In the view of the board, it would be inequitable to prevent them then from continuing the proceedings, which they embarked on in good faith and which could not adversely affect the rights of any third party. The board's ruling that, contrary to the earlier interpretation of the EPC, self-opposition was inadmissible, should therefore not be applied to notices of opposition filed before the decision in the case in question had been made available to the public.

In **J 27/94** (OJ 1995, 831) the board stated that there may be cases in which the public has a legitimate expectation that the department of first instance will not deviate from the established case law. This might apply if the relevant case law had become enshrined in the consistent practice of the department of first instance, and in particular if this had been made known to the public in published Guidelines, Legal Advice or Notices from the EPO. In such a situation, an applicant may legitimately expect that a practice allowing or even recommending a particular way of proceeding will not be changed without appropriate advance information. The facts of **J 27/94** differed substantially from those of **G 5/93**, in which the EPO had expressly drawn the applicants' attention to the opportunity provided by the case law to have the application restored after certain losses of rights. In the case in point the applicant argued that **J 11/91** (OJ 1994, 28) was binding on the department of first instance on the basis of the legitimate expectations principle. However, the headnote of **J 11/91** was published in the same issue of the OJ as the referral of this point of law to the Enlarged Board of Appeal. Taking this information into account, there was no reason to believe that the department of first instance would follow **J 11/91** in future cases. On the contrary the Guidelines for Examination remained unchanged, which fact gave reason to expect that the practice based on them would likewise not be changed. The department of first instance was therefore not obliged by the principle of the protection of legitimate expectations on the basis of decision **J 11/91** to allow the filing of a divisional application after the approval of the text intended for grant until opinion **G 10/92** (OJ 1994, 633) was made available to the public.

In **T 716/91** the board came to the conclusion that **G 4/93** (corresponding to **G 9/92**, OJ 1994, 875) had also to be applied to pending cases. In the case in point an appeal against the interlocutory decision of the opposition division maintaining the patent in an amended form was only filed by the opponent. The respondent (patent proprietor) requested that the patent be maintained as originally granted. In **G 4/93** the Enlarged Board of Appeal stated that under such circumstances the patent proprietor is primarily limited to defending the amended version as accepted by the opposition division. Therefore, in view of **G 4/93**, the

board rejected the main request of the respondent in spite of his argumentation that it was uncertain until the publication of **G 4/93** whether it was allowable for the patentee to maintain a request based upon the originally granted claims and that contrary case law existed on this issue. The board pointed out that **G 4/93** did not contain any indication limiting the applicability of the law as interpreted therein to pending cases. Therefore this case was not analogous to the situation in **G 9/93** (see above). On the contrary, following the arguments of the respondent itself that “contrary case law” existed, the respondent should have taken the appropriate procedural steps (here by filing an appeal) to ensure he could still request the maintenance of the patent as granted, instead of taking the risk of the other possible interpretation being followed by the present board.

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 (**T 19/87**, OJ 1988, 268, **T 663/90**, **T 808/94**). If a request for oral proceedings has been made, such proceedings must be appointed. This provision is mandatory and leaves no room for discretion (**T 283/88**). The body concerned may not then issue any decision affecting the requesting party without first appointing oral proceedings (**T 19/87**, OJ 1988, 268, **T 93/88**, **T 663/90**). 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, ie to argue its case orally before the relevant department of the EPO. A party may feel that it can present its case better orally than in writing, even if it has no new arguments. It is then its genuine right to request oral proceedings without being inhibited by the fear of having to pay additional costs, unless the request for oral proceedings is a clear abuse of the law. In **T 125/89** the board also 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. In **T 1051/92** the board pointed out that the mere information, provided by the opposition division in its communication, to the effect that if the appellants did not submit new arguments at the oral proceedings they would - for this reason alone - run the risk of having to pay substantial costs incurred by the respondent, cannot be considered a substantial procedural violation (see also **T 303/86**).

The failure of a party to submit new and substantial arguments at the oral proceedings does not as a rule lead to a different apportionment of costs pursuant to Art. 104. In certain cases, however, eg if a request for oral proceedings is withdrawn or postponement is requested, if a party does not turn up for the oral proceedings or if there is an abuse of the oral proceedings, a different apportionment of costs may be ordered in accordance with Art. 104 (see p. 313).

2.2 Oral proceedings before the Receiving Section

Under Art. 116(2) oral proceedings must take place before the Receiving Section at the

request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application.

A case in which the Receiving Section has to decide whether the loss of a right has resulted from the EPC in accordance with R. 69(2) is not a case in which the Receiving Section “envisages refusing the European patent application” within the meaning of Art. 116(2). The Receiving Section may therefore refuse an applicant’s request for oral proceedings where it does not consider such proceedings expedient (**J xx/xx**, OJ 1985, 159). In **J 20/87** (OJ 1989, 67) the Legal Board added that a board, exercising powers within the competence of the receiving section under Art. 116(2) in conjunction with Art. 111(1), may refuse a request for oral proceedings made by an applicant in the course of an appeal against a decision of the Receiving Section where the board does not consider such proceedings to be expedient and where it does not envisage refusing the European patent application.

2.3 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 held 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 235/85**, **T 19/87**, OJ 1988, 268, **T 409/87**, **T 193/93**, **T 589/93**).

In **T 523/91** too the examining division did not take up an offer to discuss the case. The board pointed out that the appellant could have requested oral proceedings under Art. 116(1) in the form of an auxiliary request. However, examining divisions are required to carry out the examination expeditiously and economically. In the case in point it was clearly not in the interests of economy to turn down the offer to discuss the matter, because the applicant was making a serious attempt to counter the examining division’s objections. However, failure to take up such an offer did not amount to a substantial violation within the meaning of R. 67.

2.4 Request for oral proceedings

A party’s right to oral proceedings is subject to a clear and unconditional request for such proceedings (**T 299/86**, OJ 1988, 88, **T 433/87**, **T 663/90**). The question whether a request for oral proceedings has been made must be decided on the individual facts of each case. If there is the slightest doubt, clarification should be sought from the party concerned. (**T 19/87**, OJ 1988, 268, **T 283/88**).

2.4.1 Wording of request

In interlocutory decision **T 299/86** (OJ 1988, 88) a party made the following statement: “In the event, however, that the examining division is minded to refuse the application, I reserve my right to request oral proceedings under Art. 116”. This was interpreted as meaning that the party had not yet decided whether to request oral proceedings. This case law was confirmed in **T 263/91**, where the board held that the statement “The patent

proprieters reserve the right to oral proceedings” was 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. The statement “If there are any outstanding problems, the writer would welcome an opportunity to discuss the case with the examiner” could not be understood as a valid request for oral proceedings either (see **T 88/87**).

In **T 19/87** (OJ 1988, 268) the board considered that the request in the applicant’s letter for “an interview as a preliminary to oral proceedings” could only be construed as both a request for an interview (which might or might not be granted) and a request for oral proceedings. In the case in question it was mandatory that oral proceedings should take place before the examining division (see also **T 283/88**).

In **T 668/89** the phrase “... applicant’s representative claims his right to appear and argue the case orally” was deemed to be a valid request for oral proceedings.

2.4.2 Withdrawal of request

A party’s request for oral proceedings can be withdrawn only by virtue of a clearly expressed intention not to proceed with the request, for example in the form of an unambiguous written statement to that effect on the file. If there is no unequivocal proof of the withdrawal of the request, it must be assumed that the request, once submitted, continues to exist and therefore also existed at the time of the contested decision (see **T 283/88**, **T 663/90**, **T 879/92**).

In **T 3/90** (OJ 1992, 737) oral proceedings were appointed as a result of a party’s request for such proceedings on an auxiliary basis. The party subsequently stated that it would not be represented at the oral proceedings. In its decision, the board stated that such a statement should normally be treated as equivalent to a withdrawal of the request for oral proceedings.

A party’s silence in response to a communication inviting it to state whether it wishes to maintain its request for oral proceedings may not, in principle, be interpreted as a withdrawal of the request.

In **T 35/92** the board stated that while it was reasonable for the opposition division to expect a response to its communication, which was justified in the interests of keeping the proceedings as brief as possible, there were nevertheless no legal grounds whatsoever for interpreting silence on the part of the appellants as withdrawal of the subsidiary request for oral proceedings. A request within the meaning of Art. 116(1) could only be withdrawn by a declaration to that effect. There was no basis in the EPC for believing that withdrawal could occur by virtue of inaction, ie 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 686/92** the patent proprietors’ silence following a communication from the opposition division, asking whether they maintained the request for oral proceedings, had also been interpreted by the opposition division as a withdrawal of that request. The

board stated that in the case of an auxiliary request for oral proceedings by a party there was no room for discretion on the part of the opposition division. The board held that the opposition division had no power to issue a decision adversely affecting the party without first appointing oral proceedings. In a similar case (**T 795/91**) the board added that a withdrawal requires an unambiguous expression of the party's wish to withdraw (see also **T 766/90**, **T 879/92**).

2.4.3 Further oral proceedings

According to Art. 116(1), sentence 2, the EPO may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same.

In **T 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.

In the following cases a request for further oral proceedings was rejected.

In **T 748/91** the board considered that in the case in point no substantially new situation had arisen with regard to Art. 116(1), second sentence, to justify further oral proceedings (see also **T 692/90**, **T 755/90**, **T 25/91**, **T 327/91**). In **T 547/88** too the board rejected the request for further oral proceedings since the parties and the subject were the same. The purpose of continuing the proceedings in writing after the first oral hearing was merely to provide further clarification of the same facts.

In **T 614/90** the board did not consider further oral proceedings expedient. The opportunity to comment in writing on the board's reasons for refusing further oral proceedings was also rejected because the reasons for the refusal had been given to the respondent in a communication.

In **T 731/93** the board stated that where fresh evidence had been admitted into the proceedings, the "subject" of such proceedings, as construed by reference to the text of Art. 116(1) in all three official languages, could no longer be the same. In this case the refusal of a request for further oral proceedings constituted a substantial procedural violation.

2.4.4 Auxiliary request for oral proceedings

According to the established practice of the boards of appeal, a request for oral proceedings on an auxiliary basis is interpreted as a request for oral proceedings unless the board intends to decide the case in favour of the requesting party (see **T 3/90**, OJ 1992, 737).

In **T 344/88** the appellants requested that oral proceedings be held if the opposition division intended to maintain the patent in whole or in part. The opposition division rejected the opposition as inadmissible without appointing oral proceedings. The board found that while it was true that, in rejecting the opposition as inadmissible, no formal decision had been taken to maintain the patent, this was nevertheless the consequence of the decision. A party's auxiliary request for oral proceedings therefore should not be viewed solely in

terms of its wording. In view of the particular importance of the right to present comments in the form of oral proceedings, if it could reasonably be assumed from the wording of the request that oral proceedings were desired, such proceedings should be appointed or, where there were genuine doubts, the extent of the auxiliary request should be clarified by consulting the requesting party.

In **T 924/91** the appellants requested oral proceedings if the patent was not to be granted on the basis of the written submissions. The board remitted the case to the department of first instance and stated that there was no need to appoint oral proceedings because remittal meant that the decision under appeal was being set aside, not that the application was being refused. The board emphasised that the appellants' conditional request for oral proceedings was a request in the current appeal proceedings and would have no effect in the further proceedings before the examining division. Likewise, in **T 166/91** the board stated that the decision to remit the case to the department of first instance was not to be considered as adversely affecting the appellants, so that no oral proceedings needed to be appointed (see also **T 808/94**).

In their statement of grounds of appeal the appellants in **T 494/92** made an unconditional request for oral proceedings. The board stated that in view of the positive conclusion it had reached regarding the question of inventive step, and in the absence of any other substantive and/or procedural issues, such oral proceedings would serve no purpose. The board thus treated the request as merely conditional.

2.4.5 Request for oral proceedings in further prosecution proceedings

In **T 892/92** (OJ 1994, 664) (see pp. 283, 284), the appellants submitted that after the case had been remitted to the opposition division for further prosecution, the oral proceedings they had originally requested had never taken place. The board considered the question whether the original request for oral proceedings had been revived on remittal and was therefore legally effective and stated that "further prosecution" proceedings on remittal by the board of appeal were to be regarded as a continuation of the original opposition proceedings, particularly where the original interlocutory decision had been set aside by the board and was therefore no longer legally effective. Consequently, the patent proprietors' original request, which had never been withdrawn or amended, became effective again after remittal, so that the opposition division should not have taken a decision adversely affecting the proprietors without giving them an opportunity to present their case orally (Art. 116(1)).

2.5 Infringement of Article 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 19/87**, OJ 1988, 268, **T 560/88**, **T 663/90**, **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 under "Reimbursement of the appeal fee", p. 354).

2.6 Non-appearance at oral proceedings

2.6.1 Right to present comments and non-attendance of a party by choice

On the question whether a decision pronounced against a party who has chosen not to attend oral proceedings may be based on new facts, evidence and/or arguments introduced during those oral proceedings, the Enlarged Board of Appeal held as follows in its opinion **G 4/92** (OJ 1994, 149):

A decision against a party who has been duly summoned but who fails to appear at oral proceedings may not be based on facts put forward for the first time during those oral proceedings. Similarly, new evidence may not be considered unless it has been previously notified and it merely supports the assertions of the party who submits it, whereas new arguments may in principle be used to support the reasons for the decision.

Further comments on non-attendance by choice at oral proceedings are to be found in the section "Non-appearance at oral proceedings and the right to be heard" on p. 202.

2.6.2 Obligation to give notice if not attending oral proceedings

In **T 653/91** the board made the following statement, "If, having been summoned to oral proceedings, a party does not wish to attend such proceedings, both the board (through its Registrar) and any other parties to the proceedings should be notified in writing of this fact as early as possible before the appointed day. Except in special circumstances, telephone communications concerning such matters are inappropriate, especially in inter partes proceedings."

Also in **T 930/92** (OJ 1996, 191) the board pointed out that there is an equitable obligation upon every party who is summoned to oral proceedings to inform the EPO as soon as it knows that it will not attend as summoned. This is the case whether or not that party has itself requested oral proceedings, and whether or not a communication has accompanied the summons to oral proceedings. If a party who has been summoned to oral proceedings fails to attend as summoned without notifying the EPO in advance that it will not attend, an apportionment of costs in favour of another party who has attended as summoned may be justified for reasons of equity in accordance with Art. 104(1); see also p. 312.

2.7 Preparation and conduct of oral proceedings

2.7.1 Fixing or postponing the date for oral proceedings

Under the terms of a notice issued by the Vice-Presidents Directorates-General 2 and 3 dated 14.2.1989 (OJ 1989, 132), the EPO no longer reserves a meeting room for a whole week, but specifies one date and two concrete alternative dates. The notice also said 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 still 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 reason for postponing 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).

2.7.2 Curtailment of notice in the summons

Under 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 p. 261), 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 swift hearing. Although the EPC did not itself make any provision for urgent cases, it was a generally recognised principle of procedural law in the contracting states that notice could be curtailed in urgent cases. The degree of curtailment depended on the individual case, taking due account of the circumstances.

2.7.3 Communication under Article 11(2) RPBA

Under Art. 11(2) RPBA the board may send with the summons to oral proceedings a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other observations that may help concentration on essentials during the oral proceedings.

In **T 614/89** it was pointed out that a communication in accordance with Art. 11(2) RPBA preparatory to the oral proceedings, in which the board presented its provisional assessment of the facts, was by no means binding and ought not to be interpreted by any party as meaning that the proceedings were pointless. Rather, that party had an absolute right to have the case discussed at the oral proceedings. The communication in accordance with Art. 11(2) RPBA was a snapshot, intended to clear up certain points of controversy in advance and accelerate the proceedings, as well as to encourage the parties to come up with further and sounder arguments in order to provide a reliable basis for the decision.

By a decision dated 13.12.1994 the Administrative Council introduced a new R. 71a concerning the preparation of oral proceedings. The new rule provides as follows: "When issuing the summons, the European Patent Office shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed...". In **T 276/93** (OJ 1996, ***) the board pointed out that it was obvious that R. 71a was mandatory whereas Art. 11(2) RPBA left it to the boards' discretion whether to send a communication with the summons. In view of the applicability of R. 71a to the boards of appeal the board in this case referred the following point of law to the Enlarged Board of Appeal: "1. Does it lie within the general powers of the Administrative Council pursuant to Art. 33(1)(b) to change an existing rule of procedure of the boards of appeal which it had already enacted pursuant to special powers under Art. 23(4)? 2. If the answer to the above question is "yes" to what extent, if any, does Art. 23(3) limit the changes which the Administrative Council may so enact?". The case is pending under reference number **G 6/95**.

2.7.4 Taking of minutes

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 decision on that concession, unless it was convinced that the facts conceded were not true. However, if an important matter of fact was conceded, that concession ought to be carefully recorded in the minutes of the hearing.

2.7.5 Interpreting costs during oral proceedings

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 either that such party gives notice to the EPO at least one month before the date appointed for such oral proceedings or makes provision for interpreting into the language of the proceedings.

In **T 473/92** the respondents asked the EPO, three days before the oral proceedings, to arrange for and bear the cost of interpreting services. According to the respondents, the period of one month stipulated in R. 2(1) had not been observed because the EPO had failed to issue a corresponding invitation: they submitted that the EPO ought to have drawn their attention to the period of notice mentioned in R. 2(1). The board, however, decided that the respondents had to bear the costs of interpreting at the oral proceedings. If the parties were being offered a free interpreting service, the EPO should at least be enabled to minimise its costs by having sufficient time to organise the interpreting efficiently. Obviously, only the EPO could assess how much preparation time was needed. Nor was the EPO under any obligation to draw the respondents' attention to the notice period of one month. A professional representative before the EPO was supposed to be familiar with both the EPC and its Implementing Regulations.

In **T 44/92** the board came to the conclusion that if a patent proprietor with several appointed representatives chose to use another official language for the oral proceedings in addition to the language of proceedings, the EPO would not bear the costs of interpreting (R. 2(1) and (5)).

3. Right to be heard

3.1 Introduction

Under 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.

These "grounds or evidence" within the meaning of Art. 113(1) are to be understood as meaning the considerations in the decisions, both as to the facts and the law, which led to the decision (**T 532/91**), ie the reasoning upon which the EPO has based its decision. It is essential that a party affected by a decision, given either at first instance or by the board of appeal, be afforded an opportunity to present its comments concerning the basis on which such a decision has been given (**T 105/93**).

A decision which fails to take into account arguments submitted by a party and which is based on a ground on which the party has had no opportunity to present its comments, represents a contravention of Art. 113(1) and a substantial procedural violation (see **J 7/82** (OJ 1982, 391)).

In **J 20/85** (OJ 1987, 102) it was pointed out that Art. 113(1) is of fundamental importance for ensuring a fair procedure between the EPO and a party to proceedings before it, especially when issues of fact arise. A decision against a party to proceedings upon such an issue of fact can only properly be made by the EPO after all the evidence on which such decision is to be based has been identified and communicated to the party concerned. Furthermore, in **J 3/90** (OJ 1991, 550) the Legal Board of Appeal held that where the EPO has made an examination of facts, Art. 113(1) is not complied with unless the parties concerned have been fully informed about the enquiries made and the results and then given sufficient opportunity to present their comments before any decision is issued.

Art. 113(1) is also important in connection with the right to oral proceedings provided for in Art. 116(1). 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. By virtue of his request for oral proceedings, the party could rely on such proceedings being appointed before the issue of an adverse decision and therefore had no reason to submit further arguments in writing. In this respect Art. 116 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**).

Due process of law as required by Art. 113 has not been observed if a decision to refuse an application is based essentially on documents which, though supplied by the applicant in support of his case, are used against him to produce an effect on which he has not had an opportunity to make observations (see **T 18/81** (OJ 1985, 166)). This principle also guarantees that grounds put forward are taken into consideration, and it is contravened if a translation, subsequently filed in an official language, of a Japanese document cited in due time is disallowed (**T 94/84** (OJ 1986, 337)).

In **T 195/84** (OJ 1986, 121) the representative objected at the oral proceedings that new grounds were being presented, challenging the existence of an inventive step, to which he had not previously had an opportunity to reply. The board could not share this opinion as the representative had been aware that such prior art existed, and he had thus had sufficient time to consider it in full. Furthermore, he had not requested any additional time to examine this art in greater detail and had not asked for an adjournment.

In **T 405/94** the board held that a party which, although made aware by at least one letter from another party that an objection has been raised about the availability to the public of the content of a thesis, does not react before the oral proceedings at which a decision can be taken, or which provides for the first time at the oral proceedings information which is found to need confirmation, has had sufficient opportunity to comment on the objection and need not be given a further opportunity for providing such confirmation.

The case law concerning the specific aspects of the right to be heard which arise in examination proceedings where a patent application is refused following a single communication without a further invitation to submit comments is discussed in detail on page 272 ff. The problem, relating to the right to be heard in opposition proceedings, as to when an invitation to file observations under Art. 101(2) must be issued is also discussed in the section on opposition proceedings on page 282.

3.2 Right to be heard in oral proceedings

A number of decisions have been issued on the subject of enabling the parties to exercise their right to be heard in oral proceedings when a new claim, relevant document or new argument is introduced.

In a case where an opposition division or a board of appeal feels bound by Art. 114 (1) to examine new facts or evidence submitted for the first time during oral proceedings, it must, in accordance with Art. 113 (1), give the other parties the opportunity to comment before issuing a reasoned decision based on such facts or evidence (**G 4/92**, OJ 1994, 149; see also **T 484/90**, OJ 1993, 448; see "Late submission", p. 222, and **T 330/88** and **T 356/94**).

In **T 783/89** the opposition division had presented the parties at the start of the oral proceedings with a new version of the main claim, giving them ten minutes to consider it. The board ruled that this had taken the appellants by surprise. Nor had the time given been enough to establish whether the amendments were allowable.

In **T 248/92**, the examining division had based its decision on arguments submitted for the first time during oral proceedings. The board held that the examining division's decision had not been taken contrary to Art. 113(1). Although one of the purposes of oral proceedings is to settle as far as possible all outstanding questions relevant to a decision, they do not have a constraining effect in the sense of requiring an **immediate** decision to be taken at the end of those proceedings. If the appellant had felt the need for further reflection, he could have requested that the oral proceedings be adjourned or that the proceedings be continued in writing so that he could study carefully the newly introduced arguments, which were obviously crucial to the decision.

In **T 484/89** the issues involved were similar. The board held that the opposition division was empowered under Art. 114(1) to take account of and refer to all relevant documents cited. If it intends to do so it will normally issue a communication to that effect when appointing oral proceedings. In this case, however, the opposition division had considered it necessary to refer to the document during the oral proceedings. In such cases the parties should, at their request, be granted an adjournment or else new oral proceedings should be appointed to give them the opportunity to comment. Since no such request was made according to the decision or the record of the oral proceedings, no breach of Art. 113(1) had taken place.

In **T 411/92** the board introduced a relevant document during the oral proceedings. It granted the appellant/applicant two months to comment.

In **T 566/91** the opposition division, albeit inadvertently, based its decision to revoke the patent on a version of a citation which was more complete than the version which both parties present at the oral proceedings before the board had in their possession. In order to comply with Art. 113 in the proceedings before the board, the board offered the parties a half-hour suspension of the proceedings to enable them to study the fuller version of the document with the help of the interpreters.

3.3 Non-appearance at oral proceedings and the right to be heard

Differing views have been expressed in some decisions of the boards of appeal concerning the extent to which a party forgoes its right to be heard by choosing not to attend oral proceedings. Drawing attention to **T 574/89** and **T 484/90** (OJ 1993, 448) (see also Case Law of the Boards of Appeal 1987 - 1992, pp. 94, 95) the President of the EPO 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.

In **G 4/92** (OJ 1994, 149) the Enlarged Board of Appeal held that, in view of the right to present comments, a decision against a party who has been duly summoned but who fails to appear at oral proceedings may not be based on facts put forward for the first time during those oral proceedings. Evidence put forward for the first time during oral proceedings may not be considered unless it has been previously notified and it merely supports the existing assertions of the party which submits it. However, new arguments may - in principle - be used in the reasons for the decision as they do not constitute new grounds or evidence, but are reasons based on the facts and evidence already put forward. This opinion relates only to inter partes proceedings.

The way in which **G 4/92** is interpreted and applied in practice is illustrated in a number of decisions.

In **T 341/92** (OJ 1995, 373), together with a statement setting out grounds of appeal the appellants (patent proprietor) filed a main request and an auxiliary request with new claims. However, the appellants - having notified the board to that effect in advance - were not represented at the oral proceedings. During oral proceedings the question of whether the subject-matter of claim 1 in accordance with the main request infringed Art. 123(3) was brought up by the board **for the first time**. The board concluded that the **main request** constituted an inadmissible extension of the protection conferred. At the end of oral proceedings it was announced that the patent would be maintained with the claims according to the **auxiliary request**. The board did not consider itself prevented by reasons of procedural law from taking the fact that Art. 123(3) precluded the maintenance of the patent in this version as a basis for its decision on the main request in accordance with the outcome of the oral proceedings. It argued that the situation differed from **G 4/92** in that the extension to which objection had been made arose solely from a comparison of the wordings of the respective claims according to the granted patent and the main request before the board, and therefore not from facts that had only been introduced into the case during oral proceedings. At all events, it was possible to base a decision on a ground discussed for the first time during oral proceedings which would prevent the patent being maintained as amended, at least if the stage reached in the case was such that the absent - albeit duly summoned - patent proprietors could have expected the question to be discussed and were aware from the proceedings to date of the actual basis on which it would be judged.

In **T 133/92** the board concluded that considering and deciding in substance on the maintenance of the patent on the basis of claims as amended during oral proceedings in the absence of the appellants (opponents) did not conflict with the opinion of the Enlarged Board of Appeal in **G 4/92**. The board stated that the respondent's (patentee's) restrictions to the claims removed objections already raised by the appellants. In such a situation the appellants could not have been taken by surprise, because they had reasonably to expect that the respondent would try to overcome all objections. The submission of auxiliary requests was clearly not a "fact" within the meaning of **G 4/92**. Were it otherwise, no decision could ever be issued at the end of a hearing where, as is usually the case, auxiliary requests are filed and, as is also frequently the case, the opponent does not attend the hearing, thereby rendering such hearings pointless and a waste of time, as well as offending against the general principle of legal certainty, ie the general interest of the public in the termination of legal disputes.

In cases **T 912/91**, **T 202/92**, **T 856/92** and **T 890/92**, which were based on similar facts, the board also concluded that Art. 113(1) had been satisfied.

In **T 501/92** (OJ 1996, 261), however, the board ruled that if a new ground for allowing the appeal based upon the facts set out in the file record is raised by an appellant for the first time as a new argument during oral proceedings from which the respondent is voluntarily absent, it would be contrary to Art. 113 (1) and contrary to the principles underlying **G 4/92** to decide to allow the appeal on the basis of this new ground without first giving the respondent an opportunity to comment. In the case in point the appellant (opponent) submitted at the oral proceedings that the failure by the proprietor to file a formal request for maintenance of the European patent should lead automatically to revocation of the patent.

T 55/91 raised the principle of the right to be heard in ex parte proceedings when the applicants/appellants, who are duly summoned to attend oral proceedings, fail to take advantage of the opportunity presented. The board considered that the appellants had had an opportunity to present their comments on the novelty objection raised by the board, but had not availed themselves of this opportunity. On considering the case at the oral proceedings, duly held pursuant to R. 71(2) despite the absence of the appellants, the board came to the conclusion that the subject-matter of claims 1 and 2 lacked novelty for reasons already set out by the board.

3.4 Communication pursuant to Rule 58(4) EPC

In **T 219/83** (OJ 1986, 211) and **T 185/84** (OJ 1986, 373) the board stated that, after oral proceedings in an appeal from opposition proceedings, the parties must be sent a communication pursuant to R.58(4) only if they cannot reasonably be expected to state their observations concerning the maintenance of the European patent in the amended form definitively during the oral proceedings. This case law was confirmed in several decisions (**T 75/90**, **T 895/90**, **T 570/91**).

In **T 446/92** the board held that where an opponent who has been duly summoned is not represented at oral proceedings before a board of appeal, the decision of the board to maintain the contested patent in amended form in accordance with a request of the patentee submitted during these oral proceedings may nevertheless be given orally pursuant to R. 68(1) at the end of these oral proceedings if no new facts or evidence are dealt with during these oral proceedings. Under these circumstances, the application of R. 58(4) may be dispensed with because the patent in suit is maintained with an amended text emanating from and approved by the patentee (see **G 1/88** (OJ 1989, 189)) and, furthermore, because the opponent's deliberate decision to refrain from being represented at oral proceedings before the board is to be regarded as being tantamount to a tacit abandoning of his right to present comments pursuant to Art. 113(1) and R. 58(4). In the previous decisions **T 424/88**, **T 561/89** and **T 210/90** the board did not send the parties/participants a communication pursuant to R. 58(4), even though the appellants (opponents) had not attended the oral proceedings.

3.5 Article 113(2) EPC

Under Art. 113(2) the EPO may consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent.

In **T 32/82** (OJ 1984, 354) the board pointed out that, when taking its decision a board of appeal (or department of first instance) has no authority to order the grant of a European patent containing claims which are different from those submitted by the applicant in their content or interdependency. Amendment of the text by the examining division represents a substantial procedural violation (**J 19/84**).

In **T 73/84** (OJ 1985, 241) the board stated that the patent is to be revoked 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 (for Revocation on request of the proprietor, see p. 304).

In **T 647/93** (OJ 1995, 132) the board pointed out that the provision of Art. 113(2) is a fundamental procedural principle, being part of the right to be heard, and is of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation. In any case, such violation occurs when, as in the case in point, the examining division does not make use of the possibility of granting interlocutory revision under Art. 109 after the mistake has been pointed out in the grounds of appeal.

In **T 666/90** the status of the requests on file was not clarified during oral proceedings before the opposition division. This resulted in a disagreement in the period between oral proceedings and the drafting of the written decision. The board pointed out that in a case such as this the appropriate action to take was to request a written copy of the final version of the requests and clarification of the order in which they were to be ranked prior to the decision being issued. Failure to clarify the position was in breach of Art. 113(2) and hence constituted a substantial procedural violation.

In **T 543/92** and **T 89/94** the opposition division unintentionally failed to take account of a document introducing amended claims. In both cases the patent was revoked. The board ruled that once an item of mail has been received at the EPO it must be considered to have been received by the organ deciding the case. Responsibility for correct processing of mail thereafter lay with the relevant departments within the EPO. The decision under appeal was thus in breach of Art. 113(2).

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 made the following ruling on the calculation of time limits under R. 83: The fact that R. 83(2) fixed the point in time from which all the time limits ran and defined this point as the day following that on which the event giving rise to the time limit occurred, could not be interpreted as requiring the addition of a day to time limits expressed in years, months and weeks, hence the grant of an additional day for reasons of equity. The expiry date of time limits expressed in years, months or weeks was derived from R. 83(3) to (5). These paragraphs, in conjunction with paragraph 2 of the same rule, established unequivocally that the time limits were fixed in full years, months and weeks, without any possibility of their being reduced or extended (see also **J 9/82**, OJ 1983, 57).

The calculation of time limits under R. 80 PCT is identical, but its wording largely avoids the lack of clarity found in R. 83.

In **J 13/88** the Legal Board of Appeal gave an example of how to calculate time limits with reference to the above-cited case law. In the case in question the 12-month priority period had to be calculated. The event representing the point in time from which a time limit started to run was the filing date of the application in respect of which priority was claimed, which was 5.5.1986. The period referred to in Art. 87 was expressed in months; it expired in the relevant subsequent month (ie in this case May 1987) on the day which had the same number as the day on which the said event occurred, which was 5.5.1987 (R. 83(2) 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 meant that the six-month period did not end on the day of the subsequent sixth month corresponding "in number" to the due date according to R. 37(1), first sentence, but on the day which was equivalent to this due date by virtue of its being the "last day of the month". For the purposes of calculating the additional period under Art. 86(2), therefore, R. 83(4), in the context of R. 37(1), first sentence, resulted 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 the "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 mentioned in passing that the principles contained therein should also be applied to the additional period under Art. 86(2). The board held that Legal Advice No. 5/80 was not applicable to the start of the additional period under Art. 86(2). This meant that the additional period started 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). It followed that the occurrence of such circumstances at the beginning of the period did not result in the end of the period being postponed beyond the end of the sixth month and into the seventh month. 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** (OJ 1993, 657) 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 applicants 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 that "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 period for payment of designation fees is also dealt with in Legal Advice No. 5/93 rev. (OJ 1993, 229).

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

Art. 121(1) provides that applicants may request further processing of a European patent application if their application is to be refused, has been refused or is deemed to be withdrawn following failure to reply within a time limit set by the **EPO**.

In **J 47/92** (OJ 1995, 180) the Legal Board of Appeal stated that further processing under Art. 121 was available only in respect of those time limits the **duration** of which was to be determined or set by the EPO. As regards the period of grace pursuant to R. 85b the board noted that its duration was defined as one month by the rule itself and not by the EPO. Though it was true that the actual date of expiry of the period of grace depended on an action performed by the EPO, this fact did not imply that the time limit was set by the EPO, since the EPO did not thereby determine the **duration** of the time limit. The period of grace was therefore not open to further processing.

In **J 16/92** the examining division had issued a communication pursuant to R. 69(1) after its first communication inviting observations had failed to elicit a response. The representative had thereupon applied for further processing of the application, requesting an extension of the time limit for filing observations concerning the first communication. The omitted act had, however, not been completed within the time limit laid down by Art. 121(2). The Legal Board of Appeal concluded that where the omitted act consisted in filing a reply in substance to a first communication, it was not completed by filing a request for a time limit for submitting that reply, since a request for a time limit was not equivalent to the act the party in question had proposed performing within the time limit requested.

In **J 37/89** (OJ 1993, 201) the Legal Board of Appeal pointed out that the applicants could overcome a loss of rights under Art. 96(3) resulting from the refusal of a request for a time-limit extension by requesting further processing in accordance with Art. 121. At the same time, they could request reimbursement of the fee for further processing. This secondary request had to be decided on in connection with the final decision. Under Art. 106(3), the decision on the secondary request could be appealed together with the final decision. The appeal could also be confined to contesting the decision on the secondary request.

4.3 Interruption of proceedings - Rule 90 EPC

4.3.1 Legal incapacity of the applicant or his representative

In accordance with R. 90(1)(a), which the EPO must apply of **its own motion**, the legal incapacity of the applicants or their representative has the effect of interrupting proceedings. The EPC does not define the concept of "legal incapacity", which is assessed differently according to whether the person concerned is the applicant for or proprietor of a European patent or the professional representative.

Under Legal Board of Appeal case law (**J xx/xx**, OJ 1985, 159, **J ../87**, OJ 1988, 177 and **J 49/92**), the legal incapacity of a person acting before the Office, **other than the professional representative**, must be determined in accordance with the national law with which that person is connected.

In **J ../87** (OJ 1988, 177) the board ruled that a brief medical certificate attesting that the **applicant** had been in a state of physical and mental exhaustion and depression, was not sufficient to establish incapacity within the meaning of R. 90(1)(a) since the certificate said nothing about the seriousness and duration of this condition.

In **J 49/92** the Legal Board of Appeal was again unable to conclude from the applicant's submission that he had been legally incapacitated in accordance with German law, which was relevant in that case. The board had no evidence - such as a medical certificate - to suggest that the applicant's condition had been such, according to German legal practice, as to exclude his exercising his will rationally, since he had still managed to transfer the fees for the application, even if they had been sent by mistake to the German Patent Office instead of the EPO.

Legal incapacity under R. 90(1)(c) refers to the **representative's** incapacity to carry out professional work before the EPO. Since the profession of representatives before the EPO is unified throughout Europe, there should also be a uniform standard of judging the legal incapacity of those representatives, in order to avoid differences in the application of R.90(1)(c) depending on the nationality or domicile of the representative (**J xx/xx**, OJ 1985, 159). Moreover, the legal incapacity 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).

4.3.2 Interruption of proceedings because of insolvency

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; for the possibility of having rights re-established see p. ***.

4.3.3 Suspension of time limits

R. 90(4), first sentence, states that the time limits in force as regards the applicant for or proprietor of the patent at the time of interruption of the proceedings shall begin again as from the day on which the proceedings are resumed. R. 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 interpreted this rule as meaning that the time limit for filing the request for examination and paying the examination fee was suspended with effect from the first day of the representative's or applicant's incapacity and resumed for the time it still had to run on the date proceedings began again. In **J ../87** (OJ 1988, 323) the board stated that such an interpretation could not be applied to renewal fees for which the EPC did not prescribe a time limit for payment but simply dates on which they fell due. The only time limit affecting renewal fees that might be suspended was the six-month period for paying the renewal fee together with an additional fee referred to in Art. 86. R. 90(4) had to be interpreted as deferring until the date proceedings

are resumed the payment date for renewal fees which had fallen due during the period of the representative's or applicant's incapacity.

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 the period of interruption or dislocation 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 had 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 occurred, any time limit under the EPC which expired within the period of interruption or dislocation was extended by operation of law. Accordingly, if the President of the EPO did not issue a statement as to the duration of that period, because he did not have the relevant information at the right time, this could not affect the rights of a person adversely affected by the interruption or dislocation. The board furthermore stated that whether or not an interruption in the delivery of mail or subsequent dislocation qualified as a "general interruption" was a question of fact, which had to be decided in the light of any credible information available; in case of doubt, the EPO should make official enquiries of its own motion in application of Art. 114(1).

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) was not restricted to **nationwide** interruptions. In this case the board had to consider whether or not a disruption of mail had affected those residing in an area in such a way as to render it of "general character" and decided that the limited geographical extent of the disruption did not disqualify the interruption from being general. Whether or not a representative had undertaken all possible measures to avoid the effects of a postal strike was not a relevant test under R. 85(2).

In **J 1/93** the Legal Board of Appeal again stated that for an interruption in the delivery of mail under R. 85(2) to be considered general in character the public in general residing in an area of some magnitude, even if of limited geographical extent, had to be affected. The loss of a single mailbag might affect a number of individual addressees but not the public in general.

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 **opponent as appellant** may have his rights re-established under Art. 122 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, the authors of the EPC intended only to exclude certain cases and time limits from restitutio in integrum, and not to restrict that facility solely to applicants and patent proprietors. The wording of Art. 122(1), the historical documentation relating to the EPC and a comparison of the national laws of member 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 of the EPC that all parties to proceedings before a court must be accorded the same procedural rights, as a principle deriving from the general principle of equality before the law. Under this principle an opponent must not be treated differently from the patent proprietor as that would result in unjustifiable discrimination against him.

In **T 210/89** (OJ 1991, 433) the board ruled that an **opponent** appellant 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 reestablished 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. In **G 1/86** the Enlarged Board of Appeal held that in appeal proceedings the legal process starts when the appeal has been filed and the appropriate fee has been paid. For the same reasons, the board in **T 748/93** maintained that, in accordance with Art. 99(1), the legal process in opposition proceedings begins when the notice of opposition is filed and the appropriate fee is paid.

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** of 25.6.1992 the board stated that the word "unable" implied an objective fact or obstacle preventing the required action, eg 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 Article 122(5) EPC

5.3.1 General issues

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

Art. 122(5) expressly excludes *restitutio in integrum* for the non-payment of the filing, search and designation fees within the time limits referred to in Art. 78(2) and 79(2) and of the examination fee within the time limit referred to in Art. 94(2). This express exclusion formulated with regard to the non-payment of these fees within the normal time limit also applies in the event of their not being paid within the periods of grace provided for in R. 85a and R. 85b, for the obvious reason that to concede that *restitutio in integrum* applies to the non-observance of these grace periods would allow the unequivocal prohibition contained in Art. 122(5) to be evaded (see **J 12/82**, OJ 1983, 221; **J 18/82**, OJ 1983, 441, and **J 11/86**). In **J 11/86** the board added that a European patent application for which no filing, search and designation fees were paid in due time is deemed to be withdrawn (Art. 90(3), 91(4)). The non-payment of these fees was not a correctable deficiency under Art. 91(2), which the EPO has to give the applicant an opportunity to correct. Thus, the appellants could not derive any right from the non-issuance of a reminder by the EPO and *restitutio in integrum* was excluded by Art. 122(5) whether or not such reminder had been sent.

In **J 3/80** (OJ 1980, 92) the board made it clear that if the national industrial property office concerned fails to forward a European patent application filed with this national office to the EPO in time, with the result that the application is deemed to be withdrawn (Art. 77(5)), the applicant cannot claim restitution of rights, since the EPC provides only for restitution of rights where there has been a failure to observe a time limit which it is for the applicant to observe.

In **J 7/90** (OJ 1993, 133) the board found that the “time limitation” condition imposed under board of appeal case law, which requires that, in general, a request for correction of state designation or priority data must be refused in the public interest if it is not made early enough to enable publication of a warning together with the European patent application, is not a “time limit” in the sense of Art. 122(1).

In **J 12/92** the Legal Board of Appeal ruled that a request for re-establishment in respect of the time limit under Art. 121(2), second sentence, is possible (see. **J ../87**, OJ1988, 323).

The provisions of Art. 122 shall not be applicable to the time limits referred to in paragraph 2 of this article (**T 900/90**).

5.3.2 Time limits under the PCT

Art. 48(2)(a) PCT states that any contracting state shall, as far as that state is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit. The application of provisions concerning *restitutio in integrum* is covered by Art. 48(2)(a) PCT, when the necessary conditions are fulfilled (see **J 5/80**, OJ 1981, 343).

In **W 4/87** (OJ 1988, 425) the board decided that an application for *restitutio in integrum* may be submitted in cases where the statement of grounds supporting the protest under R. 40.2(c) PCT is submitted late, since Art. 122 applies in conjunction with Art. 48(2) PCT. This finding has been confirmed in **W 3/93** (OJ 1994, 931), where the EPO, acting as ISA, requested the applicant to pay additional fees within 30 days of the communication, as it considered that the application did not comply with the requirements of unity. The additional fee was paid under protest (still under the old PCT protest procedure), the applicant contending that the invention did comply with the unity requirements. The protest was rejected as inadmissible by the board on the ground that it was filed too late, whereupon the applicant applied for re-establishment of rights. The board, applying points 5 and 6 of the reasons for the decision in **G 5/83** (OJ 1985, 64) and citing **W 4/87** (OJ 1988, 425), interpreted Art. 48(2) PCT to mean that the same remedies were available on missing the time limit under R. 40.3 PCT as on missing comparable time limits under the PCT or EPC. Thus the provisions of Art. 122 EPC were applicable.

In **J 32/90** the rights of the appellant were re-established in relation to the filing of the English translation of the international application within the time limit prescribed by Art. 22(1) PCT (see also **J 23/87**).

5.3.3 Exclusion of PCT time limits under Article 122(5) EPC

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 Art. 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 Art. 78(2) and 79(2) and those provided for in R. 104b(1)(b) and (c) in conjunction with Art. 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 Art. 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** (OJ 1994, 22 and 25) the Enlarged Board of Appeal considered whether re-establishment of rights should be granted in respect of the time limit for paying the examination fee under Art. 94(2). The Enlarged 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 (OJ 1993, 8), 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.

In **G 5/93** the Enlarged Board added that a Euro-PCT applicant may be re-established in the time limit for paying the **claims fees** provided for in R. 104b(1)(b)(iii) because the direct European applicant is not excluded by Art. 122(5) from re-establishment in the time limit to pay the corresponding fees provided for in R. 31.

Concerning the application of the new case law to proceedings which are still pending (see the referral by the Legal Board of Appeal in **J 4/93**), the Enlarged Board of Appeal stated in **G 5/93** (OJ 1994, 447) that Euro-PCT applicants may be re-established in the time limit for paying the national fee provided for in R. 104b in all cases where re-establishment of rights was applied for before decision **G 3/91** was made available to the public.

5.4 One-year time limit under Article 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** (OJ 1993, 714) the statement of grounds was not submitted until shortly after the end of the period of one year stipulated in Art. 122(2), third sentence, 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 **J 16/86** and **T 270/91**).

In **J 34/92** the Legal Board of Appeal confirmed that a request for re-establishment of rights is only admissible within the year immediately following the expiry of the unobserved time limit. Under no circumstances could an applicant therefore be allowed to revive an application as this was ruled out by the expiry of the absolute time limit under Art. 122(2), which by its nature could not be extended.

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

In **J 17/89** the board stressed that the two-month period laid down in Art. 122(2) was clearly designed to enable the parties to carry out the necessary investigations and consultations, as well as to prepare the documentation for submission of a request under Art. 122.

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 (eg 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 (see also **T 667/92**).

In **J 5/94** it was decided that the grounds on which a request for re-establishment of rights is based may be amplified, provided this completes the submission that was filed in due time and thus does not alter the basis on which the original request for re-establishment was filed.

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 of 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 the case of an error of facts the removal occurs on the date on which any **person responsible** for a patent application should have discovered the error made. This is not necessarily the date of receipt of the communication under R. 69(1) (see **T 315/90**). If, however, such a communication has duly been served, it may, in the absence of circumstances to the contrary, be assumed that the removal was effected by this communication (**J 7/82**, OJ 1982, 391; **J 27/90**, OJ 1993, 422).

In **T 191/82** (OJ 1984, 415) the board held that in a case in which non-compliance with a time limit leading to a loss of rights under the EPC is discovered by an employee of a representative, the cause of non-compliance, ie failure to appreciate that the time limit has not been complied with, cannot be considered to have been removed until the representative concerned has himself been made aware of the facts, since it must be his responsibility to decide whether an application for re-establishment of rights should be made and, if it is to be made, to determine the grounds and supporting facts to be presented to the EPO (see also **J 7/82**, OJ 1982, 391, **J 9/86**, **T 381/93**).

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.

In **T 900/90** the board emphasised that in all cases in which the receipt of the notification under R. 69(1) can be regarded as the removal of the cause of non-compliance it has to be clearly established that neither the representative nor the applicant was aware that the application had been deemed to be withdrawn **before** the receipt of that notification.

In **J 7/82** (OJ 1982, 391) the provisions of R. 78(2), last sentence, which deem postal notifications to have been made when despatch has taken place, do not apply in a case in which the receipt of a notification under R. 69(1) is relevant to the question when the cause of non-compliance with a time limit has been removed, for the purposes of Art. 122. In such a case the significant date is the date of actual receipt by the applicant. Likewise, in **J 22/92** the communications under R. 69(1) and R. 85a(1) had been correctly made under the provisions of R. 78(2), the applicant having neither residence nor principal place of business within the territory of one of the contracting states. Notwithstanding that, the board held that the removal of the cause of non-compliance took place **thereafter**, through a telephone conversation between the newly appointed professional representative and the EPO. The board emphasised that the removal of the cause of non-compliance is a matter of fact and therefore must be established beyond any reasonable doubt. This is not the case where under R. 78(2) the notification is only deemed to have been made when despatch has taken place and when the receipt of the letter cannot be proved. Thus, the board considered the date on which the responsible representative of the appellant first became aware of the missed time limit to be the date on which the removal of the cause of non-compliance with the time limit occurred (see **T 191/82**, OJ 1995, 189).

In **J 27/88** the board considered that the effective date of removal of the cause of non-compliance is not necessarily the date at which the omission has been discovered but the date at which it should have been discovered if all due care had been observed (see also **T 315/90**).

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: fee 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**.

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** and **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 and, for the purposes of Art. 122(1), the circumstances of each case must be considered as a whole (**T 287/84**, OJ 1985, 333). The requirement of due care must be judged in view of the situation existing **before** the time limit expired. This means that the measures taken by the party to meet the time limit must only be judged with regard to the circumstances as they were at that time (**T 667/92**, **T 381/93**).

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

In **T 381/93** the board of appeal observed that the duty of care in cases of re-establishment of rights applies not only to the applicant’s representative but also to the applicant. The applicant is entitled to rely on his duly authorised professional representative to deal with the EPO. However, the board held that to the extent that he is on notice that a time limit has not been met and/or that instructions are required in order to meet it, an applicant has a duty to take all due care in the circumstances to meet the time limit. In this case, the board was satisfied that the applicant as well his representative exercised all due care required by the circumstances.

In **J 3/93** the board ruled that the duty to exercise all due care stipulated by Art. 122 applied first and foremost to the applicant and then, by virtue of the delegation implicit in his appointment, to the professional representative authorised to represent the applicant before the EPO. The fact that the representative had acted correctly did not exempt his client from suffering the consequences of his own mistakes, or even negligence.

T 166/87 of 16.5.1988 centered on the question whether a particular system used in a particular office **to ensure that procedural acts** such as the payment of fees are **completed in due time** satisfies the requirement of “all due care” in Art. 122. In the board’s view, what has to be decided is whether the system during normal operation is reasonable and normally satisfactory, and therefore such as to establish that the applicant used “all due care required by the circumstances” in his efforts to observe the time limit in question. In **J 9/86** the board was of the opinion that in a **large firm** where a large number of dates have to be monitored at any given time, it is normally to be expected that **at least one effective cross-check** is built into the system. In contrast, in **T 166/87** the board held that in a relatively **small office**, normally working in an efficient and personal manner, employing normally reliable personnel, a cross-check mechanism, especially in relation to one-off payments such as an appeal fee, could fairly be regarded as superfluous.

In **T 73/89** the board rejected the application for re-establishment of rights because, in order to work properly, **the normally satisfactory diary system** required a qualified attorney to check whether, in any particular case, an extension was necessary or possible; in this case no such check was made.

In **J 32/90** the board held that the fact that a system operated efficiently for many years was evidence that it was normally satisfactory (see also **T 309/88**).

In **J 5/94** the board made allowance for the fact that the appellant was an individual applicant who had not appointed a representative and who was neither familiar with the

requirements of the EPC nor in possession of an established office organisation attuned to ensuring that procedural deadlines were met. The board pointed out that in such a case the same standards of care as those required of a professional representative or the patent department of a large firm could not be applied.

According to board of appeal case law, in a **large firm**, where a considerable number of deadlines have to be monitored at any given time, it must normally be expected that at least an effective system of **staff substitution** in the case of illness and for absences in general is in operation (see **T 324/90**, OJ 1993, 33). In **J 41/92** (OJ 1995, 93) the Legal Board of Appeal conceded that, in the case of a professional working alone and having a much smaller number of time limits to comply with, less strict standards in this respect may be applied. However, the board went on to say that a careful and diligent professional representative must, in any case, be expected to take into account that he or she might fall ill and be prevented for some time from taking care of time limits. Therefore, if a professional representative runs a one-person office, appropriate provisions should be made so that, in the case of an absence through illness, the observance of time limits can be ensured with the help of other persons. If there is no substitute or assistant at the representative's office, co-operation with colleagues or with a professional association could, for example, be sought for this purpose.

In **T 250/89** (OJ 1992, 355) the opponent had claimed that he could not have filed the statement of grounds in due time because he would have needed to refer to documents withheld by a third party. The board confirmed the line taken in earlier decisions (see **G 1/86**, OJ 1987, 477, and **T 287/84**, OJ 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 (see **J 31/89**, **T 822/93**). In **J 9/89** the board noted that there was no evidence before the board of any effort having been made by or on behalf of the appellant to find financial support during the critical period.

In **J 23/87** the board maintained that, in order to comply with the requirements concerning the taking of all due care under Art. 122, an applicant may not rely entirely on information given to applicants by the authorities under the PCT and by the EPO at various stages of the procedure as a service as a basis for prosecution of his application, but must ensure that, irrespective of such information not being received or being delayed, he is normally capable of observing the basic time limits laid down in the PCT and the EPC.

In **T 111/92** the statement of grounds of appeal had been filed two days late due to an **error of calculation** of the due date on the part of the representative. The board held that the mistake in calculating the ten-day period due to human error at a time when the person in

question was under pressure was an isolated mistake in an otherwise satisfactory system. The board referred to the **principle of proportionality** and stated: "In accordance with general principles of law, as applied in the context of administrative law, a procedural means used to achieve a given end (eg 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). The board allowed the application for re-establishment (see also **T 869/90**).

In **D 6/82** (OJ 1983, 337) the board decided that a **mistake of law**, particularly one regarding the provisions on notification and **calculation of time limits**, does not, as a general rule, constitute grounds for re-establishment of rights. The board further stated that neither ignorance of the provisions applicable nor a mistake as to the resulting legal position can justify re-establishment of rights. The obligation to take "all due care required by the circumstances" means that persons engaged in proceedings before or involving the EPO must acquaint themselves with the relevant procedural rules.

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. The appellant and the representative failed to determine correctly the last date for valid payment of the renewal fee (see **J 42/89**, **T 853/90**).

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 601/93** the appellant was not aware of the need to file a statement of grounds within the time limit. The board held that any legal error which may have led the appellant to believe that the requirement was not to be observed would exclude the application of due care, considering the unequivocal provision in Art. 108.

In **J 28/92** the board held that the misinterpretation of a provision of the EPC by a representative was not without basis or unreasonable and considered that there was no basis for penalising the representative for having arrived at a not unreasonable interpretation of a rule of the EPC, which subsequently turned out to be wrong. The missed time limit was actually the result of the failure of the representative's secretary to carry out his instructions correctly. The representative of the applicant could show that he had a normally effective system for monitoring time limits and that he had duly instructed the reliable secretary. The board observed that the representative's interpretation of a legal provision of the EPC was not the result of, and did not lead to, a failure to exercise all due care required by the circumstances.

In **J 22/92** the board held that the applicant, who had appointed US attorneys for the purpose of the PCT application, was entitled to believe that a copy of said communication had been sent to the US attorneys as well. The board referred to the **principle of proportionality** and stated that the loss of the patent application as a result of what may be considered at most a minor procedural irregularity would otherwise appear an extremely severe result. The board held that, in the case in point, the due care to be considered was in fact not that which is expected from a professional representative but that which is expected from an applicant unaware of the proceedings.

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, and 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.

In **J 16/92** the board made it clear that anyone getting himself into a situation where he cannot be sure of being able to complete the omitted act runs the risk of his request for further processing being ruled inadmissible for failure to complete the omitted act in good time. In this case the representative had not started working on the file until four days before expiry of the time limit for further processing and hence had discovered too late that he was unable to find the first communication to which he was to respond.

In **J 13/90** (OJ 1994, 456) the applicant's rights were re-established because they acted with all due care required by the circumstances. Being a small firm with about 15 employees, they had been in the process of negotiating a takeover with another company. In the course of the negotiations a change of attorney had taken place. The negotiations had foundered so the planned transfer of responsibility for renewal fee payments had not materialised. As a result of the unforeseeable breakdown in negotiations plus the fact that action had already been taken to replace the previous attorney, payment of the fourth-year renewal fee had been overlooked. This **isolated mistake** in a special situation was, in the board's opinion, excusable and the requested re-establishment of rights was therefore granted.

In **T 469/93** the board found that even if all due care required by the circumstances were to be exercised, the **occasional error** during complex transfers of company ownership could not entirely be avoided. The error in this case being an exceptional one, the causes of which had since been removed, the appellant's request for re-establishment of rights was to be allowed.

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 (see **J 32/90**, **J 33/90**, **J 22/92** and **J 26/92**).

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. In **J 3/88** the board held that as regards the requirement of "all due care" within the meaning of Art. 122(1), the US patent attorney must be regarded as the agent of the appellant. Thus, in order to comply with this requirement, it has to be established that the US patent attorney has taken the due care required of an applicant for or proprietor of a European patent by Art. 122(1). This means among other things that, in the case of culpable errors committed by the US patent attorney's assistants, the appellant may only benefit from the provisions of Art. 122 if he is able to prove that these assistants were carefully selected and properly instructed in the tasks to be performed, and that a reasonable supervision of their activity has been exercised (see **J 5/80** above). In the case in point, the appellant failed to establish that the US patent attorney had taken the due care required by Art. 122.

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.

Since the EPC was adopted, the **use of private mail delivery services** has increased greatly in frequency and significance. The necessary conditions for the use of private courier services relating to the obligation to exercise "all due care required by the circumstances" have been considered by the boards of appeal.

In decision **T 667/92** the board considered whether the appellant could be said to have taken all the due care required by the circumstances when allowing only two days for the delivery from the UK to Germany and whether, in these circumstances, the choice of using a special carrier for the delivery was in keeping with the due care requirement. The board pointed out that a party who misses a time limit must also show **due care in its choice of method of delivery** and that the use of outside agents might be held against the applicant under Art. 122 owing to a lack of proper safeguards. The board added that in parallel situations telefaxing should preferably be used. The board took into account the very extraordinary circumstances regarding the withholding of the item by the customs in Munich for 36 hours, an incident which could not reasonably be foreseen, and allowed the request.

In **T 381/93** the problem arose from the failure of the private courier service to deliver the package containing the corresponding documents to the EPO as instructed. In deciding on

due care, the board referred to decision **T 667/92** (see above), in which it was stated that a party who has missed a time limit must also show due care in its choice of method of delivery. The board held that once a reliable carrier has been chosen and commissioned for the delivery, a party is entitled to rely on them, provided that the party has given all the **necessary and proper instructions** to the carrier.

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** of 8.4.1991); 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**, **T 321/94**); unusual combination of exceptional circumstances (**J 21/92**, **J 24/92**).

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 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 of Appeal 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 the due care that could be expected of them in the circumstances of such an insolvency.

5.10 Interrelation of Article 122 and Rule 85(2) EPC

T 192/84 (OJ 1985, 39) held that if the President of the EPO extends time limits expiring during a period of general interruption in the delivery of mail in a contracting state (R. 85(2)), a pending application for re-establishment of rights considered to have been lost during that period which has been made by a representative having his place of business within that state must be deemed to have been made without purpose *ab initio* even though the non-observance of the time limit was due to causes other than the interruption in the delivery of mail. Accordingly, it could be declared that no rights were lost and the fee for re-establishment of rights could be refunded.

6. Late submission

6.1 Overview

The boards often have to decide whether late-filed documents and evidence are to be taken into account. Under Art. 114(1), 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.

In recent years board of appeal practice regarding late filing of documents has been determined by the landmark decision **T 156/84** (OJ 1988, 372), according to which the principle of examination by the EPO of its own motion under Art. 114(1) takes precedence over the possibility under Art. 114(2) of disregarding facts or evidence not submitted in due time. Accordingly, the main criterion for deciding on the admissibility of late-filed documents and evidence was their **relevance**, ie their evidential weight in relation to other documents already in the case.

In some more recent decisions the relevance of late-filed documents was no longer viewed as being the only decisive criterion for admitting them. Other criteria, such as how late the documents were and whether their submission constituted a procedural abuse or whether admitting the late-filed documents could lead to an excessive delay in the proceedings, were also held to be decisive (see **T 534/89**, OJ 1994, 464, **T 17/91**, **T 951/91**, OJ 1995, 202). The extent to which the principles set out by the Enlarged Board of Appeal in **G 9/91** and **G 10/91** (OJ 1993, 408, 420) with regard to the admissibility of fresh grounds of opposition (see, in this connection, Opposition procedure, p. 296) influence the admissibility of late-filed new "facts, evidence and arguments" in support of grounds of opposition already contained in the notice of opposition is shown in **T 1002/92** (OJ 1995, 605).

In **T 122/84** (OJ 1987, 177) the board summarised the historical development of the principle of *ex officio* examination with regard to late submission on the basis of the "travaux préparatoires" to the EPC.

6.2 Examination as to relevance in the area of conflict of Article 114 (1) and (2) EPC

6.2.1 Examination as to relevance - general principles

In board of appeal practice the power of discretion granted by Art. 114(2) 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, ie its likely bearing on the outcome of the case (see **T 258/84**, OJ 1987, 119). According to decision **T 156/84** (OJ 1988, 372) the principle of examination by the EPO of its own motion under Art. 114(1) took precedence over the possibility of disregarding late-filed facts or evidence provided for in Art. 114(2). 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. 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, according to Art. 114(2), disregard the submission without having to give **detailed** reasons (see **T 71/86**, **T 11/88**).

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 with the statement of grounds of appeal.) The main criterion for deciding on the admissibility of a late-filed document was its relevance, ie its evidential weight in relation to other documents already in the case.

According to **T 273/84** (OJ 1986, 346) the discretionary power contained in Art. 114(2) is clearly granted to ensure that proceedings run smoothly and to forestall tactical abuse (see also, in this connection, **T 110/89** and **T 315/92**).

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, ie 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 - ie if it may cause the patent to be revoked or its scope to be limited (**T 164/89**, **T 1016/93**).

According to **T 97/90** (OJ 1993, 719) the wording of Art. 114(1) does not mean that the boards of appeal have to conduct rehearings of the first-instance proceedings, with unfettered right, and indeed obligation, to look at all fresh matter regardless of how late it was submitted. Art. 114(2) as well as Art. 111(1) set a clear limit to the scope of any new matter that may be introduced into an appeal by the parties so that cases on appeal must be, and remain, identical or closely similar to those on which first-instance decisions have been rendered. This case law was confirmed by the boards of appeal inter alia in **T 26/88**, OJ 1991, 30 (where it was stated that the essential function of the appeal procedure was to determine whether the decision issued by a first-instance department was correct on its merits), **T 326/87**, OJ 1992, 522, **T 611/90**, OJ 1993, 50, and **T 229/90**.

6.2.2 Examination as to relevance with regard to **G 9/91** and **G 10/91**

In the light of **G 9/91** and **G 10/91** (OJ 1993, 408, 420) and with reference to the aforementioned case law on limited ex officio examination in appeal proceedings, the examination as to relevance was looked at critically in a number of recent decisions.

According to the new approach to this question, in the exercise of discretion under Art. 114(2), late-filed facts and evidence can be excluded on grounds of abuse of procedure and during appeal proceedings on grounds of restrictions on the principle of *ex officio* examination.

According to **G 9/91** and **G 10/91** (OJ 1993, 408, 420) the principle of *ex officio* examination enshrined in Art. 114 also applies - at least in proceedings before the opposition division - to the grounds for opposition, even if the opposition division should go beyond the actual content of the statement referred to in R. 55(c) only if there are, *prima facie*, clear reasons in favour of so doing. In the appeal procedure, which is a judicial procedure, the principle of *ex officio* examination should be applied more restrictively, which means that new grounds of opposition (see in this connection Appeal procedure, p. 323) should normally no longer be allowed into the proceedings unless the patentee agrees to their introduction. Although late submission must be differentiated from the allegation of new grounds of opposition, in **T 1002/92** (OJ 1995, 605) in particular late submission of new "facts, evidence and arguments" in support of grounds of opposition already contained in the notice of opposition was judged according to the principles for admissibility of new grounds of opposition developed by the Enlarged Board of Appeal.

According to the Enlarged Board of Appeal, R. 55(c) only makes sense interpreted as having the double function of governing (together with the 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 is to be conducted. In **T 1002/92**, the technical board of appeal came to the following conclusions:

(a) In proceedings before the **opposition divisions**, late-filed facts, evidence and related arguments, which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55(c) in support of the grounds of opposition on which the opposition is based, should only **exceptionally** be admitted into the proceedings by the opposition division, if **prima facie**, there are clear reasons **to suspect** that such late-filed material would prejudice the maintenance of the European patent in suit.

Such consideration of relevance as the principal factor follows from the administrative character of the opposition proceedings.

(b) In contrast to the first instance procedure, the appeal procedure is a judicial procedure and therefore "less investigative". Therefore, as regards proceedings before the **boards of appeal**, new facts, evidence and related arguments, which go beyond the "indication of facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55(c) in support of the grounds of opposition on which the opposition is based, should only **very exceptionally** be admitted into the proceedings if such new material is **prima facie highly relevant** in the sense that it is highly likely to prejudice maintenance of the European patent. Also, other relevant factors in the case, in particular whether the patentee objects to the admissibility of the new material and the reasons for any such objection, and the degree of procedural complication that its admission is likely to cause should be taken into account. In general the later that such new material is filed, the greater the degree of procedural complication that it is likely to cause (confirmed in **T 212/91**).

In **T 951/91** (OJ 1995, 202) too, the board of appeal came to the conclusion that, although Art. 114(1) formally covered also the appeal procedure, it was generally applied in a more restrictive manner than in opposition proceedings.

The board added in **T 1002/92** that, as regards the admissibility of new facts, evidence and arguments in **appeal proceedings**, it set out principles based on opinion **G 10/91** which were clearly more restrictive than those set out in **T 156/84** (OJ1988, 372). In its decision the board was satisfied that the facts and evidence filed by the opponent in connection with alleged prior use were *prima facie* not sufficiently highly relevant to justify their admissibility into the appeal proceedings.

In **T 255/93** the board held the position in this case to be the same as the exceptional situation described in point (b) of the appeal procedure with regard to document 5 and added it to the procedure. Here account was taken of the fact that the respondents had had some four weeks to prepare their observations concerning this document. The new technical facts to be put forward did not require any further substantive clarification. The procedure would thus not have been delayed or unreasonably impeded.

In **T 212/91** the board confirmed that cases decided by the boards of appeal should have the same, or substantially the same, legal and factual framework as the case on the basis of which the first instance's decision had been rendered. The late-filed evidence related to the ground of insufficiency and in the board's view did substantially alter the factual (but not the legal) framework of the case which the respondent had to deal with before the first instance. Furthermore, the evidence had been filed at a very late stage of the proceedings, ie more than a year after the appellant (opponent) had become aware that the opposition division regarded the ground of insufficiency as being unfounded. The board considered all the circumstances of the case, including the lack of satisfactory explanation as to why the evidence had been filed in such a tardy manner, the fact that the patent was some 14 years old and, lastly and possibly most significantly, the fact that the evidence was not of such a high degree of relevance as to be reasonably likely to change the eventual result. The board accordingly decided to exclude the late-filed evidence.

6.2.3 Examination as to relevance and abuse of procedure

a. General issues

In some cases the boards of appeal disregarded late-filed material on the grounds of abuse of procedure.

In **T 951/91** (OJ 1995, 202) the board refused to take account of late-filed evidence **even before it was actually submitted** and pointed out that the discretionary power given to the departments of the EPO pursuant to Art. 114(2) served to ensure that proceedings could be concluded swiftly in the interests of the parties, the general public and the EPO, and to forestall tactical abuse. Parties must take into account the possibility that late-filed material will be disregarded and do their best to submit the facts, evidence and arguments relevant to their case as early and completely as possible. If a party fails to do so without adequate excuse, and admitting the evidence would lead to an excessive delay in the proceedings, the boards of appeal are fully justified in refusing to admit it in exercise of the discretion provided by Art. 114(2). The board informed the parties in a communication that the submission of further fresh experimental data proposed to be filed by the appellant (opponent) at some unspecified later date, some 20 months after the statement of grounds of appeal had been filed and at a time when the decision was substantially completed, was regarded as an abuse of procedure.

In **T 496/89** the board pointed out that the late introduction of documents and of other matter into the appeal proceedings is inimical and contrary to the public interest, quite

apart from being unfair to the other party. Attempts by either party to spring a surprise on the other by deliberate late-filing, as well as inadvertent omissions to present arguments and the evidence needed to support them, run counter to the spirit and intent of the EPC (see also **T 430/89**).

In **T 741/91** the board stated that filing evidence only one day prior to the oral proceedings before the opposition division, thus not allowing the other party to consider and respond to it during the oral proceedings, is not acceptable conduct on the part of the submitting party. The opposition division should disregard such evidence by exercising the discretion conferred upon it under Art. 114(2).

In **T 375/91** the board could see no reason why the respondent (opponent) did not present its tests in due time, that is promptly in reply to the appellant's statement and certainly before oral proceedings were appointed, so leaving the patentee sufficient time to reply, if necessary by filing countertests. To have waited with the presentation of the tests until only seven weeks before the oral proceedings jeopardised the whole object of such proceedings, which was to prepare a case for decision on conclusion of the oral proceedings, and denied the appellant the right to file a detailed counterstatement. This was contrary to fair and proper procedure.

b. Procedural abuse in the case of prior public use

Stricter standards have been set by the boards of appeal particularly in the case of the admissibility of late-filed evidence of prior public use by the opponent. On the basis of Art. 114(2), the boards did not include late-filed evidence in the proceedings because in the specific circumstances there had been an abuse of procedure and a breach of the principle of good faith. In such cases the boards chose to refrain from examining the **potential relevance** of the submission (see **T 17/91** and **T 534/89**, OJ 1994, 464, **T 211/90**).

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** (OJ 1994, 464) 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.

Four weeks before the oral proceedings in **T 211/90** the appellant alleged prior public use for the first time. However, the evidence was already familiar to the appellant before expiry of the opposition period. The board held that the fact that the appellant was unaware of the relevance of this evidence, even though familiar with it at the time of filing the opposition, did not justify it introducing the evidence into the proceedings for the first time at such a late stage - irrespective of the reasons why it did not become aware of the potential relevance of this material until then.

Neither the fact that the appellant had changed representatives during the appeal proceedings, nor the fact that it was the new representative who first recognised the relevance of this material could justify taking it into account. The board therefore decided not to consider this material in the further proceedings, without examining its potential relevance.

6.3 Late submission and right to be heard

A number of decisions addressed the question of how the right to be heard is safeguarded if the EPO intends to take into account in the decision late-filed facts and evidence.

In a case where an opposition division or a board of appeal feels bound by Art. 114(1) to examine new facts or evidence submitted for the first time during oral proceedings, it must, in accordance with Art. 113(1), give the other parties the opportunity to comment before issuing a reasoned decision based on such facts or evidence (**G 4/92**, OJ 1994, 149, see also **T 484/90**, OJ 1993, 448).

In **T 330/88** the board held that the right to be heard had not been contravened by virtue of a relevant document being submitted late during oral proceedings. The representative was given sufficient time during the oral proceedings held on two consecutive days to consider this document, consisting of only seven pages including the claim page and two figure sheets. He could be expected to be able to react to this new situation either by rejecting the document as irrelevant or by filing amended claims.

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).

In **T 356/94** the board added that any late-filed facts or evidence may be admitted in the opposition proceedings in so far as such facts or evidence are subsequently discussed by the parties concerned in accordance with Art. 113(1), which means allowing the parties sufficient time, depending on the nature of the facts or evidence submitted, to provide explanations. Taking into consideration comparative tests presented on the same day as oral proceedings were held could constitute an infringement of the other party's right to be heard, since the latter had had no material opportunity to check them.

6.4 The concept of "lateness"

6.4.1 Procedural delay

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 bit by bit. The underlying principle is one of early and complete presentation of the parties' cases as opposed to the piecemeal and tardy introduction of their arguments and evidence. The boards have emphasised that the opponents should present all their objections in detail 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 173/89**, **T 237/89**, **T 430/89**, **T 951/91**, OJ 1995, 202). In **T 339/92** the board stated

that late-filed documents should be taken into consideration if this did not cause any delay in the proceedings.

6.4.2 Justification for late submission

In **T 117/86** (OJ 1989, 401) it was pointed out that facts and evidence in support of an opposition which are presented after the nine-month period has expired are out of time and late, and may or may not be admitted into the proceedings as a matter of discretion under Art. 114(2).

In some decisions, however, it was decided that the delay was less important if the party was reacting to a finding in the contested decision or to the opponent's submission.

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.

In **T 49/85** the board stated that a reference filed by an opponent for the first time with its statement of grounds is not submitted in due time unless representing the effective counter evidence to a newly emphasised reason given in the decision (see also **T 172/85** and **T 561/89**). The same applies if the party reacts to its opponent's submission, eg in **T 705/90** where documents I to N were cited by the appellant in its observations in support of an argument presented in response to the respondent's statement of grounds. Also in **T 238/92** the board of appeal did not consider a document presented for the first time with the statement of grounds of appeal as "**late-filed**", since it served as the first evidence of a feature considered in the contested decision as essential for the assessment of inventive step (see also **T 117/92**).

The explanation for the late submission of arguments and of a document was that the representative took over the case only recently. In **T 430/89** the board held that this could not be accepted as a justification for tardiness.

6.5 Late-filed arguments

In **T 92/92** the board pointed out that Art. 114(2) does not provide a legal basis for disregarding late-filed **arguments** on the grounds that they were presented for the first time in oral proceedings. The board held that the EPC in the English version makes a clear distinction between "facts and evidence" on the one hand and "arguments" on the other in Art. 114(1) and that Art. 114(2) does not refer to arguments. Art. 114(2) is to be interpreted such that the parties' right to argue their case is not unduly restricted.

Taking a similar line in **T 861/93**, the board ruled that decisions referred to by a party in support of its arguments were never citations which, under Art. 114(2), could be rejected as being late. Arguments were not covered by the said provision. Therefore, decisions to which a party referred in support of its arguments should be regarded as part of these arguments and should not be rejected as being filed late.

6.6 Late-filed facts

If it is apparent that a newly cited document is relevant to the decision to be taken it must be admitted into the case and taken into account. In **T 164/89** the board therefore admitted a document which had only been produced during oral proceedings in connection with an appeal (confirmed in **T 1016/93**). The “relevance” of late-filed citations which were mentioned for the first time in the appeal proceedings was seen as the main criterion for deciding whether they should be taken into account in, inter alia, **T 142/84** (OJ 1987, 112), **T 29/87**, **T 297/87**, **T 408/89**, **T 295/90**, **T 556/90**, **T 653/90**, **T 266/92** and **T 230/92**.

In **T 1019/92** the board reached the conclusion that the fact that an opponent after the end of the opposition period subsequently submitted prior art material originating from itself did not constitute an abuse of the proceedings in the absence of evidence that this was done deliberately for tactical reasons (in contrast to the situations found to exist in decisions **T 534/89** and **T 17/91**). The board admitted the late-filed document into the proceedings. Also in **T 315/92** the board of appeal did not consider that there had been a tactical abuse and took the late-filed documents into account under the principle of examination by the EPO of its own motion, since these might have put maintenance of the patent at risk (see also **T 110/89**).

In **T 140/91** and **T 446/89** the late-filed documents were not admitted into the appeal proceedings because they were considered irrelevant, ie taking them into account would not have lead to a different decision. Likewise in **T 327/91** the board disregarded two documents, as they had been filed far too late in the appeal proceedings, in fact after the oral proceedings had been held.

In **T 705/90**, the board pointed out that any decision to disregard late-filed documents had to be accompanied by a statement of reasons. It was not enough simply to point out that the documents were late.

6.7 Late-filed evidence

6.7.1 General issues

It is frequently the case that, in support of alleged facts already filed, a party to the proceedings submits at an advanced stage in the proceedings further evidence such as comparative tests, test results, documents or examples of prior public use.

In several decisions, (**T 207/91**, **T 137/90**, **T 139/90**, **T 713/91**, **T 796/91** and **T 141/92**), the late-filed evidence was not admitted into the appeal proceedings because it was considered irrelevant. The comparative tests presented by the appellant in **T 708/89** for the first time in the statement of grounds of appeal were not considered by the board - exercising its discretion under Art. 114(2) - owing to lack of relevance.

In **T 270/90** the board refused to consider late-filed experimental data, on the grounds that the principle of fairness had been breached. In point of fact, the data was irrelevant anyway, but this was only a secondary consideration.

This case law was confirmed by **T 939/90**, in which the board was of the opinion that the evidence submitted was rightly excluded by the opposition division to the extent that its lateness practically precluded the opponents from countering it by tests of their own. The board stated that for obvious reasons this no longer applied to the appeal proceedings and admitted the evidence into the proceedings.

Also in **T 685/91** the board confirmed that the opposition division had rightly decided not to consider the experiment report, which was submitted about one month prior to the oral proceedings before the opposition division, because such a short period was clearly insufficient to carry out counter-experiments. However, the report was admitted into the appeal proceedings since the same comparative data had been submitted together with the statement of grounds of appeal in support of the objection of lack of inventive step raised initially in the statement of grounds of opposition. The board considered that the technical report did not take the respondent by surprise since the latter had had ample time and opportunity to carry out its own experiments.

6.7.2 Late-filed evidence of prior public use

a. Claim of prior public use by party itself

In some decisions the board of appeal did not, having regard to Art. 114(2), admit the opponents' late submission of prior public use, because in the specific circumstances there had been an abuse of procedure and a breach of the principle of good faith. In such cases the board of appeal chose to refrain from examining the **potential relevance** of the submission (**T 17/91**, **T 534/89**, OJ 1994, 464, **T 211/90**; see also p. 226 f.).

In **T 985/91** the board referred to **T 17/91**, and held that in cases such as that before it, where the late-filed material related to an alleged prior use by the party filing it, this material should only be admitted into the proceedings in exceptional circumstances. Therefore, the board disregarded the late-filed material relating to an alleged prior use because neither the reasons given for the filing of the material concerned more than four years after the end of the time limit for opposition and only one week before the date of the oral proceedings, nor the content of the material itself, were such as to persuade the board that it would be proper to allow its introduction into the proceedings.

In **T 847/93** the board held that the conclusions arrived at in **T 17/91** could not be applied directly to the case in point because the prior use asserted in that case was not based on the opponent's own activities, but rather referred to an apparatus manufactured by a third company and delivered to the opponent. The board remitted the case to the department of first instance.

b. Incomplete substantiation and examination as to relevance

According to established EPO board of appeal case law, the very admissibility of a notice of opposition depends on whether the indication of the facts, evidence and arguments presented in support of the grounds in accordance with R. 55(c) is sufficient for the opponent's case to be properly understood on an objective basis (see **T 222/85**, OJ 1988, 128), and whether that case is presented in sufficient detail for it to be understood by the EPO and the patent proprietor without further investigation (see **T 2/89**, OJ 1991, 51, **T 550/88**, OJ 1992, 117). When an opposition is based on grounds of prior use, the requirements of R. 55(c) are only fulfilled if the notice of opposition indicates, within the opposition period, all the facts which make it possible to determine the date of prior use, what has been used, and the circumstances relating to the alleged use. The notice of opposition must also indicate the evidence and arguments presented in support of the grounds for opposition. Prior public use is only adequately substantiated if specific details are given of what was made available to the public where, when, how and by whom (see **T 328/87**, OJ 1992, 701, **T 93/89**, OJ 1992, 718).

It was confirmed in **T 97/92** that such complete substantiation, which enables a case to be checked without any enquiry into the facts, should be required particularly when evidence and facts are mentioned late, so as to avoid any unreasonable extension of the proceedings.

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 regarding 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.

Therefore, the boards of appeal concluded that a prior public use is immaterial if it is not adequately substantiated, and can therefore be disregarded under Art. 114(2) if it is filed late (see **T 129/88**, OJ 1993, 598, **T 550/89**, **T 93/89**, OJ 1992, 718, **T 441/91**, **T 97/92**, **T 614/93**).

In **T 45/88** the late-filed prior use was disregarded in view of the length of time the proceedings had already lasted (five years since the notices of opposition had been filed) and the need to carry out an extremely thorough examination of facts dating back more than nine years. As in the case of **T 262/85**, which the board endorsed, the circumstances associated with the taking of evidence - namely course, duration and outcome - were so uncertain as to warrant discretion being exercised in a negative sense.

In **T 231/90** and **T 938/91** likewise, late-filed allegations of prior use based on the opponent's own activities were disregarded. In **T 237/89** the board disregarded the alleged prior use, which had been filed for the first time with the statement of grounds of appeal, only after concluding that the evidence was not relevant in the sense that it could not prejudice the maintenance of the patent (see also **T 847/93**).

In **T 628/90** an allegation of prior public use, which was filed for the first time in appeal proceedings and was adequately substantiated, was taken into account because of its possible relevance to enable thorough consideration to be given to the patentability of the subject-matter of the contested patent.

6.8 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, **T 155/87**, **T 436/88**, **T 484/89**). 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 (see **T 234/90**, **T 300/90**).

Regarding this issue, the board commented in **T 387/89** (OJ 1992, 583) on the scope of the principle of ex officio examination under Art. 114(1) 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 its view, the document reflected the closest prior art and raised doubts as to whether an inventive step had taken place.

6.9 Remittal to the department of first instance

6.9.1 Remittal in the case of possible relevance

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 **T 258/84**, OJ 1987, 119, **T 273/84**, OJ 1986, 346, **T 621/90**, **T 166/91**), 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 assess each case on its merits.

In **T 326/87** (OJ 1992, 522) the board added that remittal to the department of first instance is particularly desirable if the new citation puts the maintenance of the patent at risk: where this is not the case, the board itself may decide on the matter.

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.

6.9.2 Decision on the merits by boards of appeal

The mere fact that a late-filed document is admitted to the proceedings does not mean that the case must automatically be remitted to the first instance for further consideration. It is established board of appeal practice that where the board comes to the conclusion that the document is not such as to prejudice the maintenance of the patent, the board may itself examine and decide the matter under Art. 111(1) (**T 326/87**, OJ 1992, 522, **T 416/87**, OJ 1990, 415, **T 457/92**, **T 527/93**).

In **T 416/87** (OJ 1990, 415) the board of appeal pointed out that the board may itself examine the matter under Art. 111(1) in a case where a prior document is cited by an opponent for the first time during the appeal stage and is considered by the board to be the closest prior art and therefore admissible but not such as to prejudice maintenance of the patent (see also **T 97/90**, OJ 1993, 719).

In **T 881/91** the board of appeal, following **T 416/87** in this respect, exercised the discretion conferred upon it under Art. 111(1) and decided on the opposition itself, as it essentially took as a basis documents which had been presented late by the opponent but

which did not prejudice maintenance of the patent. The board pointed out that although the appellant (opponent) would be deprived of one level of jurisdiction for examining the documents, this was fair because it was the appellant which had presented the documents late.

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 way which caused lack of novelty (see **T 253/85** and **T 49/89**).

6.9.3 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 it may, subject to the circumstances, be inappropriate for an appeal board to deal itself with the allowability of such an appeal, raising as it does a case quite different from that on which the contested decision is based. The public's and the parties' interest in having the proceedings speedily concluded may then be overridden by the requirement that appeal proceedings should not become a mere continuation of first-instance proceedings. To ensure fairness to both parties, the board remitted the case to the opposition division. It admitted the late-filed material into the proceedings but decided that the party responsible for the late submission should bear all the additional costs arising from it (see **T 847/93**).

In **T 97/90** the board referred to **T 611/90** and confirmed that if fresh evidence, arguments or other matter filed late in the appeal proceedings raised a case substantially different from that on which the contested decision was based, the case should be remitted to the department of first instance where this was demanded by fairness to both parties. However, this did not imply that all cases in which a new ground of objection was raised late in the appeal must be remitted to the first instance. On the contrary, this should only be done if the admission of the new ground into the appeal proceedings would lead to revocation of the patent.

In **T 852/90** the board of appeal acceded to a request from the appellants (opponents) for permission to introduce fresh evidence at the start of oral proceedings. The board confirmed that where a case on appeal turned out to be different from - or dissimilar to - the case decided by the department of first instance, it should be remitted to that department, pursuant to Art. 111(1). 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.

6.10 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 p. 306, and **T 117/86**, OJ 1989, 402, **T 326/87**, OJ 1992, 522, **T 97/90**, **T 611/90**, OJ 1993, 50, **T 110/91**, **T 705/92**, **T 847/93**, **T 1016/93**).

7. Rules relating to Fees

7.1 Date of payment

Art. 8 RFees, which was amended with effect from 3.1.1991, stipulates that the date on which payment shall be considered to have been made shall be the date on which the payment is "actually" entered in an account held by the EPO. The revision of Art. 8 RFees, and in particular Art. 8(3) RFees, was prompted by the case law of the boards of appeal, since in earlier decisions it had sometimes happened that if the actual date of entry of a payment fell after expiry of the relevant time limit but a situation existed - before the actual date of entry of the payment and within the time limit - which was legally equivalent to entry of the payment in the account, a late payment was deemed to have been made in due time (see **J 24/86**, OJ 1987, 399, which summarises the case law on this matter, and **T 47/88**, OJ 1990, 35).

The new version of Art. 8(3) RFees provides that the period for payment of a fee will be considered to have been observed even if payment is not received until after expiry of the period in which it should have been made, on condition that the following requirements are met:

(a) the person who made the payment must provide evidence to the EPO that within the period within which the payment should have been made he effected the payment in a contracting state, for example through a Giro account held by the EPO;

(b) the person who made the payment must pay a surcharge of 10% on the relevant fee unless he effected payment not later than ten days before the expiry of the period for payment.

In **T 842/90**, which deals with payment of the opposition fee in due time, these requirements were met.

Under Art. 8(1)(a) RFees where an amount is transferred to a bank account the date on which the amount of the payment or transfer is actually entered in the EPO's bank account is considered to be the date on which the payment has been made to the EPO. In **T 45/94** the appellants had mistakenly transferred the appeal fee to an account held by the German Patent Office. The board ruled, however, that neither the date on which a transfer to the German Patent Office is entered nor the date on which an order to transfer an amount to the German Patent Office is issued may be taken into account when establishing whether a fee due to the EPO has been paid in due time. In the Administrative Agreement between the German Patent Office and the EPO concerning procedure on receipt of documents and payments dated 29.6.1981, as amended on 13.10.1989 (OJ 1991, 187), there are no provisions regarding the passing on of the payment or notification of the EPO for such erroneous transfers. According to Art. 1(5) of the Administrative Agreement payments sent by post to the German Patent Office are accepted for the EPO and set aside for daily collection by an EPO employee. This does not however apply to bank transfers. Sums of money payable to the EPO and paid into one of the accounts held by the German Patent Office are, under the terms of the Administrative Agreement, repaid to the payer (**J 49/92**).

7.2 Small amount lacking

Under Art. 9(1) RFees, a time limit for payment is in principle be deemed to have been observed only if the full amount of the fee has been paid in due time. However, sentence

four of that provision gives the EPO the discretion, where this is considered justified, to overlook any small amounts lacking without prejudice to the rights of the person making the payment.

The justification for overlooking a small fee underpayment has been considered by the boards of appeal in several cases. In **T 130/82** (OJ 1984, 172) the board decided that it was justified to overlook an underpayment of just over 10%. In **J 11/85** (OJ 1986, 1) the board stated that an underpayment of about 10% may as a rule be considered as a small amount (see also **T 109/86** of 20.7.1987).

In **T 290/90** (OJ 1992, 368) the board found that the question whether or not it may be considered justified to overlook a small fee underpayment must be decided on an objective basis (having regard to all the relevant circumstances of the case), and not on a subjective basis. The board reached the conclusion that in the circumstances of that case, 20% of the opposition fee could properly be regarded as a small amount for the purpose of Art. 9(1) RFees, because it was inappropriate to punish the appellant for contending he was entitled to a reduction in the opposition fee and the missing 20% was paid soon after expiry of the period.

However, in **T 905/90** (OJ 1994, 306, Corr. OJ 1994, 556) the board found that the meaning of smallness could best be determined by comparing the amount of shortfall with the amount of the full fee. When viewed in this light, and regardless of its absolute quantity or its quantity in relation to the ability to pay, or the consequences of not paying it, a difference of 20% clearly could not, on purely arithmetical grounds, be regarded as small. 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.

In **J 27/92** (OJ 1995, 288) the examination fee was not paid in full, but with an underpayment of 20%, amounting to DEM 560. Distinguishing **T 905/90**, the board defined the concept of a "small amount lacking" in Art. 9(1) RFees as a fixed proportion of the amount of the particular fees to be paid. At most, 20% of the fee to be paid may be regarded as small within the meaning of the said provision. Moreover, the choice of 20% as the percentage to be considered a "small amount" will achieve the desirable end of making it possible to apply Art. 9(1) RFees to cases where a party paying fees mistakenly seeks to take advantage of the 20% reduction in fees available in relation to Art. 14(2) and (4) under R. 6(3) and Art. 12 RFees. In the case in point the board decided that it was justified to overlook the deficit as the applicant not only paid it without delay, but would appear also to have been misled into paying only 80% of the fees as a result of information provided by the EPO.

7.3 Payment of fee

It was pointed out in **T 415/88** that the remittance of German Patent Office fees vouchers did not comply with Art. 5 RFees and thus could not be regarded as payment of a fee.

8. Procedural steps

A procedural step is an act, performed by a party to the proceedings, which falls under procedural law as regards the conditions governing it and its effect, and which influences the course of the proceedings.

The decisions of the boards of appeal have developed a number of principles regarding procedural steps.

In proceedings before the EPO a distinction can be made between two kinds of procedural step: those affecting the scope, subject-matter and effect of the requested decision, and those affecting the form of the proceedings. This chapter looks at general principles applying to both types of procedural step. The special features relevant to opposition and appeal statements, to requests for a different apportionment of costs, reimbursement of the appeal fee and appointment of oral proceedings, and to the filing of amended claims are dealt with in the appropriate chapters.

Procedural statements may not be subject to any conditions. In **J 27/94** (OJ 1995, 831) the applicant, replying to the communication under R. 51(4), approved the text of the patent and also made the following statement: "The applicant ... will file in due course a divisional application". After filing the response it filed the divisional application. The Receiving Section refused to treat the application as a divisional application. The decision was based on opinion **G 10/92** which stated that an applicant may only file a divisional application on the pending earlier application up to the approval in accordance with R. 51(4). The applicant filed an appeal against the decision of the Receiving Section, stating inter alia that the reply to the communication under R. 51(4) did not contain a clear and final approval of the text because it expressed the clear intention to have the previously deleted subject-matter protected by means of a divisional application.

The board was of the opinion that the two statements could not be separated from each other without neglecting their correlation and mutual dependence. Hence, the examining division should not have treated the letter as a valid approval, because it contained a condition which made the approval invalid. In the interests of legal security procedural statements have to be unambiguous. This implies that a statement must not be subject to any condition, leaving it unclear whether or not the EPO can proceed further on the basis thereof.

Procedural statements are open to interpretation (**G 9/91**, OJ 1993, 408). They are not valid if they are filed by a person who is not entitled to do so (**J 28/86**, OJ 1988, 85). Statements filed during proceedings before the department of first instance are not valid in the subsequent appeal proceedings (**T 34/90**, OJ 1992, 454; **T 45/92**; **T 501/92**, OJ 1996, 261).

According to **T 212/88** (OJ 1992, 28) all requests by parties, including any request for apportionment of costs, should be made before announcement of the decision at the conclusion of oral proceedings.

In **T 501/92** (OJ 1996, 261) the opponent had filed an appeal against the rejection of the opposition by the opposition division, requesting that the patent be revoked. The patent proprietor had not filed any observations in response and, after notifying the board, did not take part in the oral proceedings. The opponent took the view that the appeal should be allowed without a substantive examination on procedural grounds, as the respondent had not filed a request for maintenance of the patent. After upholding the opinion expressed in **T 34/90** (OJ 1992, 454), according to which the procedural statements made during the first-instance proceedings were not applicable to the appeal proceedings, the board reached the conclusion that an admissible appeal would be examined for allowability whether or not the respondent filed a request of its own. There was no provision in the EPC laying down such a condition for substantive examination of the appeal. The reference to "issues to be decided" in R. 66(2)(e) did not mean that more than one request had to be filed, but only that all requests filed had to be examined.

Requests relating to ancillary proceedings (eg apportionment of costs) remain pending, even if the appeal is withdrawn (**T 265/93** and, similarly, **T 789/89**, OJ 1994, 482).

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'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 auxiliary requests which could not be allowed but which preceded the request that was allowable. A decision to reject preceding requests must be reasoned. In **T 5/89** the board upheld the principle that a decision rejecting the opposition can only be restricted to the main request if all subordinate auxiliary requests have been withdrawn.

In **T 785/91**, the board again confirmed established case law requiring the opposition division to ensure that the patent proprietor has expressly withdrawn all subordinate requests before a negative decision is issued solely on the basis of his main request (following **T 5/89**, OJ 1992, 348). Failure to do so constitutes a substantial procedural violation.

In **T 792/92** the board considered as inadmissible the appellant's request at the end of the oral proceedings that, should the outcome of the discussions be negative for him, he be given the opportunity to formulate new requests.

8.2 Maintenance in the 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 caused lack of novelty 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 was the case in decisions **T 622/89**, **T 368/90**, **T 755/90**, **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.

In **T 796/90** the board held that the cited document (D15) - a European patent application - prejudiced the novelty of the patent in dispute. D15 was part of the state of the art for the Contracting States DE, FR, IT and SE under Art. 54(3) and (4). Since a request for maintenance of the patent in limited form or only for the Contracting State not designated in D15 (GB) had not been made, the board revoked the patent in its entirety.

9. Withdrawal of application and surrender of patent

9.1 Withdrawal of patent application as a whole

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 had to be interpreted having regard to the surrounding circumstances from which it had to be clear that the applicant really wanted immediate

and unconditional withdrawal rather than passive abandonment leading in the course of time to deemed withdrawal.

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

In **J 11/87** (OJ 1988, 367) the board held that declarations of withdrawal were to be accepted only if the context in which they had been made allowed no other reasonable interpretation. Where there was even the slightest doubt as to the proprietor's actual intent the board had always considered that such a declaration should be construed as a declaration of withdrawal only if the subsequent facts confirmed that such had been his true intent.

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

9.2 Surrender of patent as a whole

In the key decision **T 73/84** (OJ 1985, 241), when the patent was revoked at the instigation of the patent proprietor, the board stated that "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 would only be 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 stated in opposition or appeal proceedings that he no longer approved the text in which the patent had been granted and would not be submitting an amended text, the patent was to be revoked. The board held that in such a case there was no text of the patent on the basis of which the board could 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, 57) and **T 73/84**, the board stated in **T 186/84** (OJ 1986, 79) that if in opposition proceedings the proprietor of a patent requested that his patent be revoked, it was 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 was made clear to the board of appeal, whatever the form of words used, that the appellant and the respondent were agreed that a patent should be revoked, the board could 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, was 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 was no public interest in maintaining a patent against the patent proprietor's will.

9.3 Abandonment of parts of an application or patent

(a) Abandonment of subject-matter of the application or patent

If an applicant or patent proprietor abandons claims the question arises whether his aim is the **substantive abandonment** of the relevant subject-matter of his application or patent, or whether his intention is to file a **divisional application** in respect of the subject-matter involved or whether the action is merely an **attempt to reformulate the claims** to take account of objections made by the EPO or an opponent.

(aa) If the abandonment has substantive effect, there is no possibility of reinstating the abandoned subject-matter, either as part of pending grant or opposition proceedings or by filing a divisional application. This is the assumption if the relevant parts of the description are also abandoned.

In **T 61/85** the applicant had amended the claims before the examining division and requested during appeal proceedings that the claims be granted as originally filed. The board refused this request since the applicant had expressly and unambiguously abandoned the entire original claim and **the relevant parts of the description**.

In **J 15/85** (OJ 1986, 395) the applicant had submitted new claims to dispel objections by the examining division and had declared that the other claims should be deleted. The applicant had, however, not stated that such deletion should be without prejudice to the filing of a divisional application (see reasons, 3). After the communication pursuant to R. 51(4), based on the new claims, had been issued, the applicant's representative had filed a divisional application in respect of the claims that had been dropped. The board did not allow such reinstatement. At the date of abandonment of the claims the parent application had already been published so that the public had access to the file and was entitled to assume that the appellant had irrevocably abandoned the claims and would not thereafter seek to obtain protection for them.

A declaration of abandonment could, however, be interpreted to the effect that there was no intention to abandon definitively the subject-matter of the application or patent.

In **T 910/92** the applicants had expressly abandoned several claims in their application, but later retracted their declaration and requested that the claims deleted from the application be reinstated in a divisional application. The board considered under what circumstances it was possible to retract a declaration of abandonment. It referred to the case law, which required that the real intention of the party making the declaration be established, taking into account all the circumstances of the case, and came to the conclusion that in this case the appellants' real intention was not to abandon part of the original disclosure altogether, but to avoid the lack of unity that had arisen as a result of the change in the protection sought. In contrast to the case in **J 15/85** the board did not see any need in this case to protect the public interest by generally prohibiting the retraction of a declaration of abandonment. It could be expected that any third parties interested in the proceedings

relating to the application in question would have asked to inspect the files at suitable intervals up until the conclusion of the proceedings.

In **J 24/82**, **J 25/82** and **J 26/82** (OJ 1984, 467) the applicant had amended his claims several times in response to objections by the examining division and had stated in a letter that “the subjects of former Figs. 15-30 were part of the subject-matter divided out, no longer subject-matter of the present application and to be pursued separately as appropriate”. The divisional application was not filed within two months of the limitation of the earlier application. The board ruled that the content of the letter had to be interpreted objectively and not in isolation, but in the context of earlier communications by the examining division and letters from the applicant. Although the limitation appeared unconditional if the content of the letter was considered by itself, this view could not be upheld if the previous letters and communications were also considered. The board allowed the divisional application.

In **J 13/84** (OJ 1985, 34) the board applied the same criteria to the interpretation of a declaration of abandonment as the case law had developed for declarations of withdrawal of an application (see above). In particular, all the circumstances had to be taken into consideration and not just the preceding declarations.

In the case in question the applicants had deleted their claim 21 in response to a communication from the examining division, adding that “in accordance with the examiner’s suggestion, we are filing a divisional application for the intermediate products ... and for their method of preparation”. The Receiving Section took the view that the divisional application, with the former claim 21 as its subject-matter, was not filed within the period prescribed in R.25(1)(b) (old version). It argued that claim 21, which had already been divided out from the application on 6.6.1983 and therefore no longer formed part of the parent application on 31.8.1983 (the date of filing of the divisional application), could no longer be converted into a divisional application.

The board did not share this view and called for the declaration of abandonment to be interpreted in the same way as a declaration of withdrawal of an application, ie taking into account all the circumstances. It added that, generally speaking, and as stated in the summary of the Legal Board’s decision in **J 11/80** (OJ 1981, 141), “a request for withdrawal should only be accepted without question if it is completely unqualified and unambiguous”. The board also referred to decisions **J 24/82**, **J 25/82** and **J 26/82** (see above), in which it was found that, where claims were withdrawn specifically under R. 25(1), the applicant’s restrictive intention was not to be interpreted in isolation on the strength of particular statements but in the context of the entire procedure. The board took the view that in this case no express intention to drop the claim ensued from the circumstances. The divisional application was therefore admissible.

(bb) The limitation of claims may represent attempts to respond to objections by the EPO or an opponent without necessarily involving any immediate intentions of substantive abandonment.

In **T 89/85** the patentees had limited their claims before the opposition division. The patent had been revoked. They filed new narrower claims with their statement of grounds of appeal and asked as their main request that the claim rejected by the opposition division be granted and as an auxiliary request that the claims filed with the statement of grounds of appeal be granted. The opponent took the view that the patent proprietors, by filing new claims with their statement of grounds of appeal, had abandoned the previous version. The board did not share this view and allowed the main request to be examined.

In **T 64/85** the patent proprietor had first amended his claim 1 during opposition proceedings. He had then asked as his main request that the patent be maintained as granted. The opponent was of the opinion that the patent proprietor had, by his amendments, abandoned certain subject-matter. Since both the opponent and the public ought to be entitled to trust that this subject-matter was no longer protected, such abandonment should not be reversible. The board took the view that decision **J 15/85** was not applicable in this case since **the amendments here did not affect any embodiment in the description or the drawings**, with the result that they did not unambiguously limit the protection originally sought but rather clarified features which were already implicitly comprised in the description. The board also held that an amendment made before the opposition division had commented on patentability could not be definitive.

Decision **T 123/85** (OJ 1989, 336) has been cited and confirmed as a leading decision in many later decisions. In this case the patent proprietors had first added a feature and then deleted it again. The opponents were of the opinion that this was not admissible since the appropriate part of the patent had been surrendered. The board held that, apart from the fact that they could not surrender their patent either wholly or in part, patent proprietors were **not** in any way bound by a request involving revocation or limitation once they had made it. In requesting that their patent be maintained in a limited form the patent proprietors were merely trying to delimit their patent to meet objections expressed by the EPO or the opponents. However, the patent proprietors did not, by virtue of such limitation, irrevocably abandon subject-matter covered by the patent as granted but not by the request as thus limited.

This view was confirmed in many decisions: **T 296/87** (OJ 1990, 195), **T 155/88** (withdrawal of main request at suggestion of opposition division had no detrimental effect), **T 225/88**, **T 285/88** (as long as a patent had not been finally revoked, the department before which the proceedings were pending, could allow amendments to the text and reinstatement in the proceedings), **T 331/89**, **T 576/89** (OJ 1993, 543), **T 217/90**, **T 823/90** (request for revocation of patent could be withdrawn at any time up to issue of decision), **T 10/91**, **T 705/91** (claims had been amended before the examining division, the opposition had been rejected, and in the appeal proceedings the request for grant on the basis of the original version was allowed), **T 715/92**.

In **T 770/89** the opposition division had maintained the patent as amended. The patent proprietors had filed several new claims and then, only one day before the oral proceedings before the board of appeal, requested grant on the basis of the originally granted version. The board held that they had never surrendered that version as their conduct could not have been interpreted as constituting the surrender of their patent. The request was therefore admissible.

In **T 217/90** it was confirmed that an amendment during opposition proceedings did not constitute the surrender of the patent. In **T 472/91**, in ex parte proceedings, the board held that the reinstatement during appeal proceedings of claims amended during the examination procedure was allowed.

In **T 506/91** the appeal was rejected because the patent proprietors were not adversely affected because they had revoked their main request before the opposition division and agreed to the grant on the basis of the auxiliary request.

In **T 118/91** the board ruled that the inclusion of a particular claim in a divisional application did not mean that claim had been dropped from the parent application.

(cc) However, aspects of procedural law could present obstacles to the reinstatement of dropped claims or the filing of a divisional application involving such claims.

In **T 12/81** (OJ 1982, 296), the application had been refused. In their statement of grounds of appeal the applicants requested that claim 5 be deleted. During the oral proceedings, however, the applicants requested that this claim be reinstated in the application. The board refused this request on the grounds that allowing such a late request contravened the *ratio legis* of R. 86(3) in conjunction with R. 66(1), which was to prevent proceedings becoming unduly prolonged.

In **T 92/85** (OJ 1986, 352) the applicants had amended their claims several times and finally proposed "to limit the application to the embodiment of Figure 6 which had been the subject-matter of the original claim 8". They had then filed correspondingly limited claims. After the communication pursuant to R. 51(4) and (5) (old version) had been sent out the applicants' representative requested the extension of the claims and submitted a set of amended claims and an amended description. He also requested permission to file a divisional application. The board held that after the issue of the communication pursuant to R. 51(4) and (5) and in the absence of exceptional circumstances, the examining division could refuse to allow the filing of a divisional application in the exercise of its discretion under R. 25(1)(a) (old version) and also refuse its consent to further amendments pursuant to R. 86(3).

(b) Non-payment of further search fees in the case of lack of unity

According to **T 178/84** (OJ 1989, 157) it is clearly the intention of R. 46(1) to regard subject-matter as abandoned in a particular patent application if, in response to an invitation according to this rule, the further search fee is not paid for this subject-matter within the time limit set by that rule. Since a different view was taken in **T 87/88** (OJ 1993, 430), the President of the EPO referred the matter to the Enlarged Board of Appeal which, in **G 2/92** (OJ 1993, 591), held that an applicant who failed to pay the further search fees for a non-unitary application could not pursue that application for the subject-matter in respect of which no search fees had been paid. He would have to file a divisional application in respect of such subject-matter. However, non-payment was not to be equated with the abandonment of parts of the application.

(c) Non-payment of claims fees

If an applicant fails to pay claims fees, he is considered under R. 31(2) to have abandoned the claims. Apart from resolving the specific question whether certain parts of the application were part of the description or were claims, decision **J 15/88** (OJ 1990, 445) made clear that such abandonment of certain claims could only cause a **substantive** loss of subject-matter if the subject-matter involved was contained only in the claims and not also in the description or drawings. The board held that an applicant who declined to pay claims fees when they were demanded ran the risk that features of a claim deemed to have been abandoned pursuant to R. 31(2), **which were not otherwise to be found in the description or drawings**, could not subsequently be reintroduced into the application and, in particular, into the claims. The idea that there could be forced abandonment of subject-matter, in reliance on R. 31(2), appeared rather to be in conflict with the principles of higher law to be deduced from Art. 52(1) in conjunction with Art. 123(2). An applicant normally had the right to derive subject-matter from any part of the description, claims or drawings as originally filed (see reasons 6 and 7).

This view has since been confirmed in other ex parte proceedings, namely **T 490/90**.

10. Law of evidence

10.1 Introduction

Before an administrative authority or a court takes a decision, it is required to establish the existence of the material facts, ie the facts from which, under the relevant legal provision, the legal effect ensues. The facts are established by taking evidence. However, facts need not be proved if they have already been established or if the authority or court has to assume their existence.

Where the onus is on the parties to present their case, they are required to furnish proof of the facts they allege, in so far as such facts are disputed. Where the investigative principle applies, the evidence relating to the facts to be proved must be obtained by the body which has to take the decision, although the lengths to which it must go are left to it in the proper exercise of its discretion. The body in question is not bound by mutually corroborating statements made by parties on opposing sides; it has wide discretion to decide what evidence to accept and the weight it attaches to it (the principle of unfettered consideration of the evidence).

Art. 117 and R. 72 to 76 contain provisions governing means of giving or obtaining evidence, the procedure for taking evidence and the conservation of evidence. The boards of appeal have considered other questions arising in connection with the law of evidence.

10.2 Taking of evidence

10.2.1 Terminology

The boards have interpreted the term “taking of evidence” broadly, applying it not only to the procedures listed in R. 72 but also to the production of documents of any kind, unsworn declarations and the giving and obtaining of evidence, whatever its form (see **T 117/86**, OJ 1989, 401; **T 416/87**, OJ 1990, 415; **T 323/89**, OJ 1992, 169; **T 314/90**).

The term “documents” in Art. 117(1)(c), which is not elucidated in the EPC, was defined in **T 314/90** as meaning essentially all written documents in which thoughts are expressed by means of characters or drawings, including published documents.

10.2.2 Procedure

It was made clear in **J 20/85** (OJ 1987, 102) that the Receiving Section too has the power to take evidence, although this EPO body is not listed in Art. 117. The board also laid down the principle whereby, in any case of disagreement, evidence relating to it should be taken as soon as it arises.

Evidence may also be taken from parties without the presence of their patent attorneys if the latter have been informed of the hearing (see **T 451/89** and **T 883/90**).

In **T 804/92** (OJ 1994, 862) the opposition division had, in a communication to the parties, suggested in detail the content of a statement under oath. Such a practice was firmly rejected by the board because it involved the risk of leading witnesses and could seriously undermine the probative value of such statements. This applied to departments at any instance in proceedings before the EPO.

In **T 232/89** the opponent/respondent had produced two affidavits which had not been contested by the patent proprietor/appellant, but had not tendered any witnesses. The

opponent's request that the authors of the affidavits also be heard as witnesses was rejected, as the affidavits were quite sufficient in the circumstances.

In **T 674/91** it was stated that according to the practice of the boards of appeal, affidavits or statutory declarations, whether originals or copies, are acceptable as evidence. As one of the purposes of this form of evidence is to avoid having to call the signatory as a witness, it seems superfluous to have them confirmed in this way. Since these statements were usually drawn up on the basis of answers to questions formulated by lawyers, it was not surprising to find the same stereotyped formulations in different declarations. The board is not required to check the signatures of the persons concerned, unless evidence disputing their validity is produced.

In **T 953/90** the board held that when a party seeks to prove potentially relevant facts by means of the statement of a witness, it is particularly important that this statement be furnished early in the opposition phase so as to enable the witness to give oral evidence in accordance with Art. 117, if the statement is disputed by a party on the other side or if the EPO considers it necessary.

T 760/89 (OJ 1994, 797) dealt with the possibility of returning documents which had been filed as evidence and were subject to an obligation to maintain secrecy. The ruling was that documents filed as evidence during opposition proceedings and submissions referring to them in principle remain in the file until the end of the proceedings and for at least five more years (see R. 95a). Documents filed as evidence may only exceptionally and on a substantiated request remain unconsidered and be returned. Such an exception exists if the interests of the filing party in having them returned unconsidered clearly prevail over the interests of any other party and the public interest. This may be the case if the documents were filed in breach of a confidentiality agreement and if they did not belong to the state of the art but were third party statements filed as part of the response to the opposition, and if the other parties involved agreed with the request. The same applies to submissions referring to such documents.

10.2.3 Admissibility of evidence

The question has often arisen as to whether a particular submission may be admitted as evidence. This question has to be kept separate from that of the actual consideration of the evidence. Art. 117 does not contain an exhaustive list of admissible evidence. Nor does the EPC provide that certain points of fact may be established only by certain means of evidence. The boards have therefore assumed that any kind of evidence is admissible for any facts that have to be proved.

In **G 11/91** (OJ 1993, 125) the Enlarged Board of Appeal stated that evidence of what was common general knowledge on the date of filing of a patent application may be furnished in connection with an admissible request for correction under R. 88 2nd sentence in any suitable form allowed by the EPC - and Art. 117(1) in particular - as a means of giving or obtaining evidence. It may thus be based upon means of evidence in other than document form (see also **G 3/89**, OJ 1993, 117).

The Legal Board of Appeal decided along the same lines in **J 11/88** (OJ 1989, 433), according to which questions of fact must be settled on the basis of any credible information available. In **T 838/92** too, the board established that any kind of evidence is admissible.

In **T 482/89** (OJ 1992, 646) the board took the view that an employee of one of the parties

to the proceedings may be heard as a witness (see also **T 443/93**). In **T 124/88** and **T 830/90** (OJ 1994, 713) employees of the opponent were heard without the admissibility of such oral evidence being called into question. It was also pointed out in **T 838/92** and **T 443/93** that the fact that a witness may be biased does not make his oral evidence inadmissible but is a matter to be taken into account when the EPO considers the evidence.

Art. 117(1)(g) allows sworn statements in writing as a means of giving or obtaining evidence. In **T 674/91** the board noted that it was board of appeal practice to regard affidavits or statutory declarations in original or copy form as admissible means of providing evidence, to avoid having to call the person who had made the declaration as a witness. In **T 770/91** the board pointed out that although statutory declarations were not covered by Art. 117(1)(g), they were taken into account in accordance with the principle of the unfettered consideration of evidence.

In **T 327/91** it was ruled that any kind of document, regardless of its nature, was admissible in proceedings before the EPO. The fact that an affidavit was submitted by the appellant's General Manager did not make it inadmissible. Assessment of the affidavit was a question to be dealt with in accordance with the principle of the unfettered consideration of evidence.

In **T 231/90** it was made clear that evidence supplied in the form of testimony by witnesses or statutory declarations was not admissible if such means of evidence were offered in place of delivery notes which could no longer be produced because such a long time had been allowed to elapse that they had been destroyed during routine shredding.

10.3 Evaluation of evidence

The EPC says nothing about how the outcome of taking evidence should be assessed. The principle of unfettered consideration of evidence applies. The body required to take the decision therefore decides - on the basis of the whole of the evidence taken and the proceedings, and in the light of its conviction arrived at freely without reference to any legislative provisions on the evaluation of evidence - whether an alleged fact has occurred or not (see **T 482/89** (OJ 1992, 646), **T 327/91**, **T 838/92**).

Nor, consequently, have any general rules for the evaluation of evidence been laid down, but it has been decided in individual cases when a particular means of evidence was sufficient.

Thus, in **T 473/93** the board decided that the appellant's surmise that he had been in error in making his statutory declaration was not sufficient to allow orally presented facts which deviated from the declaration to appear more credible. The fact alleged orally therefore had to be regarded as not proven.

In **T 332/87** a dated internal paper, marked as being confidential and not signed, was - together with an undated leaflet - not considered sufficient evidence. In **T 595/89** the board decided that the opponent's in-house documents relating to the installation of a device in an aeroplane and to the sale thereof were not sufficient to prove public prior use. In **T 204/88** a letter of tender was not sufficient to prove public prior use because it was not discernible when and to whom the device was to be delivered and because the device was described in terms too general for anyone to identify whether it corresponded to the invention. In **T 725/89** too, a dated tender was not regarded as sufficient evidence, as it was not proven when the tender had actually been presented, and the date of the tender was only one week prior to the priority date. In **T 482/89** the board took the view that an unsigned delivery note, together with other documents, can constitute sufficient evidence of delivery.

In **T 162/87** and **T 627/88** it was decided that the statement made by an employee of the party alleging prior use can be sufficient. The statements of employees of one of the parties were also used in the above-mentioned decisions **T 124/88**, **T 482/89**, **T 830/90** (OJ 1994, 713), **T 838/92** and **T 327/91**, without any grounds for their credibility being given. The credibility of witnesses cannot be impugned merely because they are related to one another and have a business relationship with one of the parties (**T 363/90**).

10.4 Standard of proof

The facts on which the decision is based must have been established to the satisfaction of the deciding body. Particularly if the decision has to be taken on the basis of the evidence adduced by the parties, the question arises as to what degree of satisfaction is necessary. A substantial number of board of appeal decisions deals with this problem.

The boards of appeal generally apply the standard of the "balance of probabilities", ie they are satisfied on the basis that one set of facts is more likely to be true than the other. This applies particularly in opposition appeal proceedings to questions of novelty and inventive step, see **T 173/89**, **T 182/89**, OJ 1991, 391; **T 270/90**, OJ 1993, 725; **T 859/90**, **T 953/90**, **T 741/91**, **T 541/92**, **T 296/93**, OJ 1995, 627; **T 326/93**. However, this standard is also applied in the decisions issued in ex parte proceedings, **T 381/87**, OJ 1990, 213 (evidence of the state of the art) and **T 69/86** as well as **T 128/87**, OJ 1989, 406 (evidence of the filing of a document with the EPO).

According to **T 270/90** (OJ 1993, 725), this standard should also be applied to evidence of public prior use. In **T 782/92** however, the board took the view that public prior use had to be proved beyond any reasonable doubt. **T 270/90** and **T 173/89** expressly rejected the standard of "absolute conviction" or "beyond all reasonable doubt", which called for stronger evidence. In **T 109/91**, on the other hand, the board was in favour of a synthesis, stating that the standard burden of proof in opposition cases is generally expressed as proof on the balance of probabilities, in which case absolute certainty is not required but a degree of probability which in human experience verges on certainty. If the evidence is such that the division or the board can conclude "we think it more probable than not", the burden is discharged (see also **D 5/86**, OJ 1989, 210).

However, when examining Art. 123(2) or R. 88, second sentence, the boards only allowed amendments or corrections if it was certain beyond any reasonable doubt that the subject-matter of the application had not been extended beyond that of the application as filed (**T 383/88**, **T 581/91**). When examining Art. 123(3) the board laid down the principle in **T 113/86** that voluntary amendments requested by the patentee which are not necessitated by any of the grounds for opposition raised by the opponent or by the board should, in principle, not be allowed if there is the slightest doubt that the unamended patent could be construed differently to the patent as amended.

In cases of re-establishment of rights it is usually ruled that, on the basis of the evidence furnished, the board is or is not satisfied that the facts adduced to substantiate the application for re-establishment of rights are true. In **T 243/86** and **T 13/82** (OJ 1983, 411), a request was made for "Glaubhaftmachung" (ie that the facts on which the application relies be set out) in accordance with Art. 122 (3), first sentence. Whether this term signifies - as in German, Austrian or Swiss law - that a lower degree of probability is sufficient has not yet been decided.

10.5 Burden of proof

If a material fact is not or cannot be proven, a decision is taken on the basis of who carries the relevant burden of proof: the fact that the real position cannot be established operates to the detriment of the party which carries the burden of proof for this fact. The EPC contains no explicit provisions in this respect. However, a few principles can be inferred from board of appeal practice.

With regard to opposition proceedings, the principle was laid down in **T 219/83** (OJ 1986, 211, Corr. OJ 1986, 328) that the patent proprietor is given the benefit of the doubt if the parties make contrary assertions regarding facts barring patentability which they cannot substantiate and, furthermore, the EPO is unable to establish the facts of its own motion (see also **T 293/87**, **T 459/87**). In appeal proceedings, the party's status as opponent makes no difference when it comes to assigning the burden of proof (this follows eg from **T 740/90** and **T 270/90**, OJ 1993, 725). If the opponent disputes eg the existence of an inventive step, he bears the burden of proof in this respect at first and second instance.

In **T 547/88** inventive step was contested. Although the board had asked the parties to issue a joint protocol stating what tests had to be done and under what conditions, each party in fact conducted his own experiments and obtained contradictory results. It was therefore not possible for the board, on the basis of these tests, to conclude definitively that no inventive step was involved. The board held that in such a case the patent proprietor should be given the benefit of the doubt with regard to the relevance of the claimed features to the problem to be solved. Moreover, since the prior art did not suggest the subject-matter of the contested claims, that subject-matter implied an inventive step. The patent was therefore maintained.

These principles were confirmed with regard to facts barring patentability in many decisions, eg regarding inventive step in **T 197/86** (OJ 1989, 371), **T 345/86**, **T 282/87**, **T 459/87**, **T 85/88**, **T 298/90**, **T 601/91**, **T 596/93**; regarding novelty and state of the art in **T 293/87**, **T 108/89**, **T 82/90**, **T 968/91**, **T 10/92**, **T 160/92** (OJ 1995, 35), **T 326/93**; regarding non-reproducibility of the invention in **T 122/84** (OJ 1987, 177), **T 16/87** (OJ 1992, 212), **T 182/89** (OJ 1991, 391), **T 665/90**, **T 740/90**, **T 109/91**, **T 334/91**, **T 393/91**, **T 406/91**, **T 418/91**, **T 456/91**, **T 548/91**, **T 675/91**, **T 273/92**.

The legal position where public prior use is alleged is dealt with on pages 69 and 70.

In **T 270/90** (OJ 1993, 725) it was pointed out that each party carried the burden of proof for the facts it alleged. If one party furnished convincing proof of the fact it had alleged, the burden of proof for the other party's contrary assertion shifted to the latter (see also **T 838/92**, **T 859/90**, **T 239/92**, **T 250/92**, **T 476/93**).

In **T 585/92** (OJ 1996, 129) the board held that in opposition proceedings the burden of proving that the objections raised under Art. 100 have been substantiated lies with the opponent. However, once the opposition division has decided to revoke the patent, the burden shifts to the proprietor of the patent, who must demonstrate on appeal that the reasons for revoking the patent were not sound, ie that the opposition division's decision was wrong as to the merits.

In ex parte proceedings the applicant bears the burden of proof for the facts in his favour, eg the fact that a document cited by the examining division does not form part of the state of the art (**T 160/92**, OJ 1995, 35), the fact that the conditions laid down in Art. 123 have been met (**T 383/88**) or the fact that a limitation of the claims is admissible (**T 2/81**, OJ 1982, 394).

Questions relating to the allocation and shifting of the burden of proof can also arise in connection with procedural questions. According to **T 128/87** (OJ 1989, 406) a party presenting a cheque to the EPO bears the burden of proof for its receipt by the EPO. If the EPO denies receiving a document, but the party furnishes proof that it was filed, according to **T 770/91** and **J 20/85** (OJ 1987, 102) the EPO carries the burden of proof for its allegation that it did not receive the document. In **J 10/91** the board held that if a letter, and attached cheque in payment of a fee, has been lost without further evidence or high probability that it has been lost in the EPO, the risk is then borne by the sender.

If a party relied on the fact that there was a general legal maxim along the lines of Art. 125, according to which his appeal would have to be allowed (here: the principle whereby decisions of a court of final jurisdiction may be set aside in the event of serious procedural errors), he would have to produce evidence that such a procedural principle exists in most EPC contracting states (**T 843/91**, OJ 1994, 832).

11. Professional representatives

In **J 19/89** (OJ 1991, 425), the Legal Board of Appeal considered whether a patent attorney under national law should, in view of his legal qualifications and entitlement to act as a professional representative in national patent matters, be regarded as a "legal practitioner" within the meaning of Art. 134(7) and hence be authorised to act before the EPO. The board decided that he should not, on the grounds that Art. 134(7) was a special provision restricted to the profession of "Rechtsanwalt" as defined in German law. The term "legal practitioner" in the English version of Art. 134 (7) was 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 the United Kingdom. Art. 134(7) therefore did not apply to German patent attorneys.

The reunification of Germany posed its own problems, in **J 18/92**, **J 30/92**, **J 31/92**, **J 32/92** and **J 33/92**, regarding the admission of professional representatives. The appellants argued that the provisions of Art. 163(6) should be applied to patent attorneys, even where they had qualified in West Germany and not the former GDR. In the board's view, Art. 163(6) could only be applied by analogy to those finding themselves in a similar situation to the patent agents of a country acceding to the EPC. This requirement was fulfilled only by patent agents from the former GDR and not by their colleagues who had already been admitted in the West. The board held that it would be strange if those who were admitted as patent agents in a contracting state were able to become authorised representatives without having to pass the examination merely by way of analogy with people working in a country which had just become a member. The appeals were accordingly dismissed.

In **J 35/92** the board was presented with quite a different problem. The first-named of two individual joint applicants had transferred his rights in the application to a company, which had appointed another representative who had then purportedly withdrawn the application. The second applicant did not agree to the withdrawal. The department of first instance held that the company was entitled unilaterally to withdraw the application by virtue of R. 100 (1), according to which the first-named applicant could be regarded as the representative of both, but the board of appeal disagreed. R. 100 applies only where no joint professional representative has been appointed, whereas in this case the original applicants had appointed a representative, who continued to act for the second applicant. The board therefore concluded that the purported withdrawal of the application by the first-

named applicant was invalid. The parties were given two months to appoint a joint professional representative, failing which one would be appointed by the EPO.

A number of decisions dealt with questions relating to who is allowed to appear and plead before the boards of appeal.

In **T 227/92** it was held that a sub-authorisation from a professional representative to a person who was not a professional representative within the meaning of Art. 134 was invalid. The latter person's role was therefore limited to that of technical adviser to the professional representative.

In **T 80/84** (OJ 1985, 269) the duly authorised representative (a German "Rechtsanwalt") informed the board at the commencement of the oral proceedings that he intended to present the case formally and then leave the detailed **viva voce** presentation to an unqualified and unauthorised person who was training to be a German "Patentanwalt". The representative stated that he would remain present and accept full responsibility for everything said by the unqualified person. He asserted that this was an accepted mode of presenting a case in German national proceedings and cited Art. 125. The board held that representation could not be undertaken in oral proceedings except by persons entitled to represent a party in accordance with Arts. 133 and 134 and duly authorised to do so. The board considered that it was abundantly clear from the very detailed regulation of this matter in the EPC that representation was not to be regarded in any way as a merely formal matter which could be undertaken as a matter of substance by persons other than those duly entitled and authorised. With regard to Art. 125, the board found no relevant principle of procedural law generally recognised in the contracting states to support the representative's contentions.

In **T 598/91** (OJ 1994, 912) the European representative of the respondent was assisted during oral proceedings by a qualified Dutch patent attorney who had not yet been entered on the list of European professional representatives in accordance with Art. 134. In its decision the board observed that, according to the general practice of the boards of appeal, representatives had for several years been authorised to be assisted at oral proceedings by assistants or experts who could explain matters and argue the case in lieu of the representative in certain fields. In the board's view, Art. 133 did not exclude the possibility of an assistant presenting the case during oral proceedings in technical or legal matters, in addition to argument by the professional representative, the authorised employee or the party itself, provided that the board and the party for which the assistant spoke had given its permission and the representative, employee or party continued to supervise the proceedings and bore full responsibility for what was said. The board observed that **T 80/84** had not distinguished between the concepts of "pleading" or arguing a case ("Vortrag" - "plaidoirie") and "representation" ("Vertretung" - "représentation"). Whilst "representation" comprised acting in lieu of someone for the purpose of exercising a right, "pleading" merely comprised developing arguments orally in court. In the board's view, such intervention was in essence and character no different from the written statements these assistants or experts introduced into the proceedings. Moreover, many of the parties' and representatives' own submissions had been researched and written by assistants or auxiliaries. The board held that it was within the discretion of the board to give or withdraw its permission for an assistant to argue a case.

In **T 603/92** the board followed **T 598/91** (OJ 1994, 912) and allowed the appellant's case to be presented by an assistant in the professional representative's firm who had not yet qualified, since the appellant had given his approval.

In **J 11/94** (OJ 1995, 596) the authorised representative was accompanied during oral proceedings by a former chairman of the Legal Board of Appeal who had retired about a year and a half previously. The professional representative requested permission for the former board member to make submissions in addition to his own arguments. In order to ensure uniform application of the law, the Legal Board of Appeal decided to refer the following question to the Enlarged Board of Appeal under Art. 112(1)(a):

“May a board of appeal exercise discretion in deciding whether or not a person not entitled under Article 134(1) and (7) EPC to represent parties to proceedings before the EPO may make submissions during oral proceedings in addition to the pleadings by the professional representative?

If the answer to [this] question ... is “yes”:

(a) What criteria must the board observe when exercising this discretion?

(b) Do special criteria apply to former board of appeal members?”

In its referral the board drew attention to the possible contradiction between **T 80/84** and **T 598/91**.

The Enlarged Board of Appeal decided on this referral in **G 2/94** (OJ 1996, xxx) dated 19.2.1996.

In **T 803/93** (OJ 1996, 204) another specific question arose, namely, as to whether, and if so in what circumstances, an “accompanying unqualified person” might, during opposition or opposition appeal proceedings, make oral submissions on technical matters, other than in accordance with the provisions of Art. 117. This question went beyond the circumstances of **J 11/94** above, which concerned ex parte proceedings involving only legal issues. Another question of law raised in this case was whether, having regard in particular to the provisions of Arts. 133 and 134, a person who was not qualified in accordance with Art. 134 but was a qualified patent lawyer in a country which was not an EPC contracting state might present some or all of a party’s case as if he were qualified under Art. 134. The board decided to refer the questions at issue to the Enlarged Board of Appeal. The Enlarged Board of Appeal decided on this referral in **G 4/95** (OJ 1996, xxx) dated 19.2.1996.

The giving of evidence under Art. 117 must be distinguished from acting as a representative.

In **T 883/90** and **T 451/89** the professional representative, although duly informed, did not attend the oral proceedings. He had informed the board that he would not be present. During the taking of evidence by hearing the party, in accordance with Art. 117(1)(a), the appellant only answered questions put by the board. The board noted that Art. 133(2) stipulates that natural or legal persons not having either a residence or their principal place of business within the territory of one of the contracting states must be represented by a professional representative and act through him in all proceedings established by the EPC, other than in filing the European patent application. The Implementing Regulations may permit other exceptions. The appellant, being an Australian citizen having neither a residence nor his principal place of business within the territory of one of the contracting states therefore had to be represented by a professional representative in order to be able to act before the board during oral proceedings, and could not himself act like a professional representative, e.g. by filing new requests. Due to the specific circumstances of the case, in which a propulsion apparatus and a propulsion method which seemed to operate in a manner clearly contrary to well-established physical laws were disclosed, the board decided to proceed

to take evidence by hearing the party (appellant) in accordance with Art. 117(1)(a) in order to give the appellant the opportunity to reply to questions put by the board. In the board's view, the taking of evidence by hearing the party in this way was possible without the presence of the duly informed professional representative.

In **T 843/91** (OJ 1994, 818) of 17.3.1993 the appellant alleged that an unauthorised representative had been allowed to present a substantial part of the patentee's case and had even changed certain requests made earlier by the authorised representative. The board pointed out that neither of the parties had objected either to the presence of the unauthorised person or to his addressing the board. The board went on to say that it was common practice of the boards of appeal to allow contributions by experts under the control of the authorised representative when they considered it would be expedient for a proper understanding of the case. The board held that the contribution of the "unauthorised representative" was based on Art. 117, which enables a board to request information, and that, accordingly, it was not at odds with **T 80/84**. For these reasons the board found that no substantial procedural violation had occurred.

12. Decisions of EPO departments

12.1 Right to a decision

The right to a decision after notification 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 reasonable period of time 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 substantial procedural violation.

12.2 Composition of examining divisions

In **T 714/92** the board could not find any indication in the part of the file open to public inspection that the primary examiner had already signed the impugned decision before the date on which he left the examining division. The board held that to take a decision on a date on which the examining division no longer existed in its stated composition, without the examining division ensuring that it be apparent from the part of the file open to public inspection that the member who left the examining division had agreed the text of the decision before leaving, had to be considered as a substantial procedural violation. Thus the impugned decision was set aside as void ab initio and without legal effect.

12.3 Composition of opposition divisions

Art. 19(2) stipulates that an opposition division must consist of three technical examiners, at least two of whom must not have taken part in the proceedings for grant of the patent to which the opposition relates.

In **T 390/86** (OJ 1989, 30) oral proceedings had taken place in the presence of three examiners appointed to form the opposition division. The Chairman had announced its decision during the oral proceedings in the presence of the other two examiners. Although the decision had subsequently been duly reasoned in writing, it had been signed by three members other than those before whom the oral proceedings had taken place. The board considered whether the decision of the opposition division was valid having regard to the circumstances. The board held that it was quite clear from Art. 19(1) and (2) that an

opposition in respect of a European patent is in all cases to be conducted and decided by three technical examiners appointed on a personal basis in respect of a particular opposition (in some cases an additional legal examiner may also be appointed), and that oral proceedings must be before the three technical examiners personally appointed to form the opposition division. Further, the reference to voting in the final sentence of Art. 19(2) made it clear that an opposition should be decided on the basis of the personal votes of the individual examiners appointed to constitute a particular opposition division. It was thus clear from Art. 19 that the power to examine and decide an opposition pursuant to Arts. 101 and 102 must at all times be exercised personally by the examiners appointed to do so. In accordance with the well-known principle "*delegatus non potest delegare*", the power of a department of the EPO such as an opposition division to issue a decision must not only be exercised personally but also be seen, both by the parties and by the public, to be exercised personally. Similarly, where a decision is issued in writing setting out reasons for an oral decision, the parties and the public should be able to see from the written decision that it has been taken by the examiners appointed to the particular opposition division responsible for that oral decision. It is of course possible that not all the appointed members are able to sign a written decision (for example through illness). However, in the board's view, if the decision of a particular division is to be legally valid, it must have been written on behalf of and represent the views of the members who were appointed to that division to decide the issue or issues which are the subject of the decision, 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 the members of the deciding body who took part in the oral proceedings. The board therefore held that if, in a case where a final substantive decision has been given orally by an opposition division during oral proceedings, the subsequent written decision giving the reasons for that oral substantive decision is signed by persons who did not constitute the opposition division during the oral proceedings, the decision is null and void.

It was further held that since the oral proceedings had taken place more than two years before and the (invalid) written decision had been given more than one year before (almost one year after the oral decision), the requirements of R. 68(1) could no longer be properly complied with, and the substantive decision was therefore incurably void. The opposition had therefore to be re-examined.

In its decision **T 243/87** the board of appeal developed further the principles established in decision **T 390/86** (see above). The board held that even though only one member of the opposition division had been replaced after the oral proceedings, there was no longer any guarantee that the reasoned decision signed subsequently accurately reflected the point of view of all three members who had taken part in the oral proceedings, or even of the majority of the opposition division. In the board's view, the exceptional situation in which one of the appointed members is incapacitated (for example through illness) is quite different. In such cases, it is right to accept that, although the reasoned written decision should be signed only by the members of the division who actually took part in the oral proceedings, one of them could sign on behalf of the member unable to do so. It 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.

In **T 251/88** the composition of an opposition division was held to be contrary to Art. 19(2), because two of the three members had taken part in the proceedings for grant of the patent to which the opposition related. The board of appeal ordered that the decision of the opposition division be set aside and the case be remitted for fresh examination by an opposition division with a different composition (see also **T 382/92**).

12.4 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. In the case which had led to the referral, **T 261/88** (OJ 1992, 627), the primary examiner was a former employee of the opponent and had represented that company many times in examination and opposition proceedings before the EPO. The Enlarged Board observed that although the questions referred to it were directly related only to proceedings before an opposition division, the problems involved were of a general character and also had a bearing on the activities of the other EPO departments of first instance charged with the procedure, eg the examining divisions (see Art. 15).

The Enlarged Board stated that it must be considered as a general principle of law that **nobody should decide** a case in respect of which a party may have good reasons to assume partiality. The basic requirement of impartiality therefore also applied to employees of the EPO departments of first instance engaged in decision-making activities affecting the rights of any party. Although the provisions of Art. 24 on exclusion and objection only applied to members of the boards of appeal and the Enlarged Board of Appeal and not to employees of the EPO departments of first instance, including opposition divisions, this did not justify the conclusion that such employees were exempt from the requirement of impartiality. Furthermore, although Art. 24 was only applicable to appeal proceedings, it seemed justified to apply the principles underlying the provisions of Art. 24(3), second and third sentences, to an objection on the ground of suspected partiality before a department of first instance. Such an objection may thus be disregarded if it is not raised immediately **after** the party concerned becomes aware of the reason for the objection or if it is based on nationality. Finally, the Enlarged Board found that the question whether or not an objection to a member of an opposition division on the ground of suspected partiality is to be considered justified can only be decided in the light of the particular circumstances of each individual case. Such considerations involve factual questions of degree rather than points of law and are therefore not a matter for the Enlarged Board of Appeal to decide.

Following the Enlarged Board's decision, several boards of appeal have been concerned with the question of possible partiality.

In **T 261/88** of 16.2.1993 the board noted that the case at issue involved factual questions of degree rather than points of law, as none of the situations mentioned in Art. 24(1) applied and the appellant had only alleged that the examiner was inadvertently partial, this being an inevitable consequence of his previous employment. Furthermore, his partiality would be revealed by manifest errors in judgment appearing in the decision. In the board's judgment, disqualifying partiality is limited to situations where the opinion of a person responsible for taking decisions affecting the right of parties (eg a judge) is swayed by his attitude towards a party. The board examined whether the reasoning underlying the decision under appeal showed such major deficiencies that there was reason to believe that the primary examiner was, either deliberately or inadvertently, trying to "bend" the facts of the case, and that this was done because of a preconceived attitude towards one of the parties. The board could not find anything basically or conspicuously wrong with the analysis of the technical questions. The content of the file did not go beyond the framework of a normal discussion between the EPO and an applicant, and there was nothing manifestly unreasonable to be found in the reasoning, so that disqualifying partiality could not be concluded.

In **T 843/91** (OJ 1994, 818), a newly appointed board had to consider whether the three members of the board of appeal originally appointed could be suspected of partiality. The board agreed with the view held in decision **T 261/88** (see above) that disqualifying partiality presumes a preconceived attitude towards a party on the part of a person in a decision-making capacity. More precisely, partiality would be knowingly to favour one party by granting it rights to which it was not entitled, or by intentionally disregarding the rights of the other party. The board referred to **G 5/91** (OJ 1992, 617) which stated that the question whether or not an objection to members on the ground of suspected partiality is to be considered justified can only be decided in the light of the particular circumstances of each individual case. The board studied in detail all the assertions made with respect to the alleged partiality of the members and came to the conclusion that none of the rights of the opponent in appeal **T 215/88** (which concerned the same patent) had been disregarded or infringed by the board. Hence, the grounds brought forward were not sufficient to exclude the three appointed members from deciding the appeal.

In **T 951/91** (OJ 1995, 202) objections under Arts. 24 and 19(2) were raised by the appellant in the statement of grounds of appeal suggesting that the opposition division had been biased in its attitude to the parties. In reaching its decision on this point, the board observed that nothing in the minutes of the oral proceedings, which the appellant had not criticised, led to the conclusion that the arguments had not been duly considered by the opposition division or that the latter was suspected of bias during those proceedings. The board examined the reasons set out in the appealed decision and observed that the decision itself did not reveal any bias.

In **T 143/91** the board held that a member of an opposition division is biased if it can be shown that he has a personal interest within the meaning of Art. 24(1). The mere fact that the member was previously employed by a company dependent on a party to the opposition proceedings is not, however, sufficient proof of such an interest. The appellant's allegation that a substantial procedural violation had been committed was therefore rejected as unfounded.

12.5 Date of decision

12.5.1 Entry into force of decisions

The Enlarged Board of Appeal has held that it is necessary to distinguish between decisions taken after the closure of the debate in oral proceedings and decisions taken following written proceedings. Where oral proceedings are held, the decision may be given orally. The decision becomes effective by virtue of its being pronounced. The equivalent of that point in time in written proceedings is the moment the decision is notified. Once it has been pronounced and, in the case of written proceedings, notified, the decision enters into force and cannot be amended, even by the department that issued it. A decision may only be revoked by the department that issued it by way of an interlocutory revision under Art. 109 if one of the parties has filed an admissible and well-founded appeal (**G 12/91**).

12.5.2 Completion of the internal decision-making process

In **T 586/88** (OJ 1993, 313) the board referred the following point of law to the Enlarged Board of Appeal: "If the decision of an examining or opposition division is pronounced not at the end of oral proceedings but following written proceedings or proceedings continued in writing after oral proceedings, at what point is the internal decision-making process within that department of the EPO completed?".

In **G 12/91** (OJ 1994, 285) the Enlarged Board of Appeal stated that the point of law referred was of vital importance to the general question of determining the final point at which a first-instance department of the EPO can still take account of further submissions by the parties. The Enlarged Board noted that the point in time at which a decision enters into force, ie the moment it is pronounced or notified, is not the last moment at which parties may still submit observations. This must be done at an earlier point in the proceedings to allow the decision-making department time to deliberate and then issue its decision based on the parties' submissions.

As far as oral proceedings are concerned, established board of appeal case law has this point in time as the time of closure of the debate, which is fixed by the decision-making department - having first heard the parties' submissions - to allow itself time to consider its decision. Once the debate has been closed, further submissions by the parties must be disregarded unless the decision-making department allows the parties to present comments within a fixed time limit or decides to reopen oral proceedings for further substantive debate on the issues.

In the case of decisions taken following written proceedings, the final moment at which fresh matter submitted by the parties can still be taken into account must correspond to the time of closure of the debate during oral proceedings. The need to ensure legal certainty requires that this moment be as clearly fixed as the moment when the debate is closed during oral proceedings. Neither the EPC nor its Implementing Regulations contain any provision fixing that moment.

The Enlarged Board pointed out that the date on which the three members of an examining or opposition division sign a decision is extremely important, as the date indicated is the date on which the division decides whether a patent application must be refused, an opposition rejected or a patent granted or revoked. However, it is also a decision taken "in camera", because at the moment it is taken it does not have any immediate effect on the parties involved and is **not** therefore **binding** on the decision-making department that issued it. If, after it has signed it, the department discovers that it has failed to take account of a key point, it may amend its decision, despite having already signed it, because it has not yet left its custody.

Having weighed up the various arguments, the Enlarged Board of Appeal reached the conclusion that the point in time at which the internal decision-making process is completed is the date on which the formalities section hands over the date-stamped, post-dated decision to the EPO postal service. This is a date the parties can ascertain very easily, because, as the President of the EPO had explained, it is always three days prior to the date stamped. Internal EPO instructions make clear that a period of three days always elapses between the date-stamping of a decision and its despatch. If, for whatever reason, the EPO postal service is unable to despatch the decision on the date stamped, it returns the decision to the formalities section where it is given a new date, which again pre-dates the date of actual despatch by three days. This practice ensures that the date of despatch is always stamped on the decision three days before it is actually despatched. This date is therefore very easy to ascertain, both for the EPO and the parties. It thus fulfils the need for strict legal certainty which the handing down of a decision must ensure.

When a decision is handed over by the formalities section to the EPO postal service for notification, it is taken from the file and is therefore removed from the power of the department that issued it. This moment marks the completion of proceedings before the decision-making department. Once proceedings have been completed the decision-

making department can no longer amend its decision. It must disregard any fresh matter the parties may submit to the EPO thereafter. Seeing that it is important for the parties to know at which point in time the decision-making process following written proceedings is completed, this point in time should be clearly indicated in the decision. The formalities section should also keep a register of the dates on which decisions are handed over to the EPO postal service to enable those dates to be ascertained at any time (see also **T 631/94**, (OJ 1996, 67) p. 285).

12.6 Form of decisions

12.6.1 General issues

In **T 390/86** (OJ 1989, 30) the board stated that when a substantive decision is given orally during oral proceedings it must be formally notified to the parties in writing (R. 68(1)) and formally completed by giving reasons for the decision in writing (R. 68(2)). In the board's judgment, it is clear from R. 68 and Art. 108 that until a substantive oral decision is formally completed in writing and notified to the parties, the two-month period within which a notice of appeal must be filed does not begin.

In **T 42/84** (OJ 1988, 251) the board held that the alleged failure of the EPO to enclose the text of Arts. 106 to 108 with the decision neither invalidated the decision nor did it constitute a substantive procedural violation. R. 68 states that the written communication of the possibility of appeal must draw the attention of the parties to the provisions laid down in Arts. 106 to 108, the text of which should be attached. However, it also states that the parties may not invoke the omission of that communication. This must in the board's view be read as applying also to the omission of the text of the articles alone.

12.6.2 Inconsistency between oral and written decisions

In **T 666/90** the opposition division had indicated during oral proceedings that it would maintain the European patent as amended if new documents conforming to the version of the claims it had said it would allow were submitted. Although such a set of claims had not yet been formally submitted in writing by the applicants' representative during oral proceedings, the representative had given an undertaking to do so later and had done so by the deadline set. The written decision had revoked the patent however. The board held that this inconsistency between the oral and written decisions was in breach of R. 68(1) and hence a substantial procedural violation.

12.6.3 Reasons for the 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 several requests from one and the same party are rejected in a single decision, that decision should as a rule set out the reasons for the rejection of **each request**. Although in exceptional circumstances a reference in the reasons for a decision to grounds given in preceding communications may be allowed, it must be quite clear from those grounds which considerations played a crucial role for the division responsible when it took its decision.

In **T 155/88** the board held that if the patentee files one or more auxiliary requests in addition to a main request and does not withdraw any of them, an opposition division is obliged in its decision to give reasons why each successive request is either not admissible (in the

exercise of its discretion under Rs. 57(1) and 58(2)) (see **T 406/86**, OJ 1989, 302), or not allowable on substantive grounds. If an opposition division allows an auxiliary request without giving reasons in its decision as to why the main request or preceding auxiliary requests are not allowable, that decision should be set aside as void and without legal effect, and the appeal fee refunded on the basis of a substantial procedural violation (see **T 484/88**).

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

In **T 493/88** (OJ 1991, 380) the board held that a decision of an opposition division rejecting an opposition has not 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, considers the subject-matter of the patent to be new, it fails to state the reasons why it considers that the subject-matter also involves an inventive step.

In **T 292/90** regarding inventive step, the examining division had merely said that the claimed process amounted to an obvious juxtaposition of the teachings of documents 2, 3 and 4. There was no explanation of how the examining division had arrived at this conclusion. The board considered this form of reasoning to be insufficient. The reasoning given in a decision open to appeal had to enable the appellants and the board of appeal to examine whether the decision was justified or not. A decision on inventive step therefore had to contain the logical chain of reasoning which had led to the relevant conclusion (see also **T 52/90**).

In **T 153/89** the examining division had given no reasons for finding in its decision that the subject-matter of the dependent claims was not inventive. The board of appeal took the view that the perfunctory statement in the contested decision did not permit the board to judge whether this issue had been sufficiently investigated, or investigated at all. The examining division's decision on such grounds did not amount to a reasoned decision.

In **T 856/91**, the contested decision referred to the knowledge of prominent skilled persons and cited "a statement by a well-known expert" but contained no information enabling the reader to infer who these persons were or exactly what they had said. The board took the view that this incomplete information did not constitute a breach of R. 68(2), since it was sufficient for a decision to be reasoned in some way, even if the reasoning was incomplete and deficient.

In **T 691/89** the appellant claimed that the contested decision had not addressed 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.

In **T 647/93** (OJ 1995, 132) the appellants had lodged an appeal against the decision of the examining division to refuse the application and claimed that the latter had committed substantial procedural violations in that, inter alia, it had not followed the procedure set out in the Guidelines, or provided a written reasoned decision as required by R. 68(2). The board observed that the reasons for the refusal were somewhat enigmatic, and that there was no basis for them in the EPC. However, the board held that even if the reasons for the decision were not well founded, this did not mean that the decision was not reasoned at all within the meaning of R. 68(2).

In **J 4/93** the decision under appeal had not considered the question whether, in the circumstances of the case, the requirements pursuant to Art. 122(1) to (3) had been complied with. The Receiving Section had confined itself to stating that the due care required by the circumstances had not been shown, without giving any reason for this finding. The board stated that neither the appellants nor the Legal Board of Appeal was therefore able to examine the reasons which had led the department of first instance to the above finding. Were the board to decide on those issues, the appellants would be deprived of the opportunity of having their case considered at two instances. Accordingly, the board exercised its power under Art. 111(1) to remit the case to the department of first instance for consideration of the merits of the appellants' request for re-establishment of rights.

See page 357 on inadequate reasons given in the decision at first instance, and the circumstances in which reimbursement of the appeal fee is justified.

12.6.4 Signatures on a decision

In **T 390/86** (see above) the board noted that although R. 70 states that "any communication from the EPO is to be signed by and to state the name of the employee responsible", there is nothing in R. 68 or elsewhere in the EPC which specifically requires the decision of a first-instance department of the EPO (ie a decision which is open to appeal) to be signed by the employee or employees responsible. The board, however, having regard to the principles which were applicable, came to the conclusion that if the decision of a particular division is to be legally valid it must bear the signatures of the members who have been appointed to that division to decide the issue or issues which are the subject of the decision.

12.7 Correction of errors in decisions

In decisions of the EPO, only linguistic errors, errors of transcription and obvious mistakes may be corrected (R. 89).

In **J 12/85** (OJ 1986, 155) it was stated that a board of appeal can only examine appeals from decisions of other-instance departments of the EPO (Art. 21(1)). Thus it cannot examine a request for a correction of the decision under appeal based on R. 89. A decision on such a request must first be taken by the department of first instance before the matter can be referred to a board of appeal.

In **T 150/89** the board held that R. 89 does not relate to factual or substantive considerations or corrections. Only obvious inaccuracies can be corrected under R. 89. Such corrections can be made on request or by the EPO of its own motion.

In **T 212/88** (OJ 1992, 28) the board held that the absence of a chairman's or minute-writer's signature at the end of an opposition division's decision is a rectifiable, obvious error within the meaning of R. 89. In this case a second examiner had been referred to in the minutes as a member of the opposition division, although in fact he was not a member and did not take part in the oral proceedings. The board held that correction of the two errors must be by means of a decision under R. 89 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** but stated that it was unnecessary to redate the decision as from the date of correction.

12.8 Principles for the exercise of discretion

In **J 4/87** the appellant submitted that there is nothing in the EPC which prevents the EPO from exercising discretion in cases of exceptional delay in the post. The board, however, held that as a matter of law the EPO has no general discretion as suggested by the appellant. The EPO can only exercise discretion if the power to do so can be derived from the EPC.

In **J 20/87** (OJ 1989, 67) the Receiving Section had rejected a request for a partial refund of the European search fee. In the reasons for its decision it was stated, *inter alia*, that the criteria for the refund of the European search fee are defined in Art. 10 of the Rules relating to Fees and these do not leave room for any discretion in favour of the applicant. In the present case, these criteria had not been fulfilled. The board confirmed the finding of the Receiving Section and found that there is nowhere any support for the idea that the EPO is entitled to exercise any general discretion based on equity in respect of refunding the fee for the European search report. In fact, the existence of such a discretionary power could lead to serious difficulties in practice, bearing in mind the very large number of applications before the EPO and the great variety of possible borderline cases to be considered individually on such a general basis.

In **T 182/88** (OJ 1990, 287) the board clarified its case law concerning the exercise of discretion given to EPO departments. The board held that when exercising discretion, whether for or against a particular party, the reasons for the exercise of that discretion should be given. In any case where the EPC gives discretion to a department of the EPO in relation to an issue in proceedings before it, general principles of law require such discretion to be exercised having regard to the factors which are relevant to that issue. Those factors are in turn determined by considering the purpose of the exercise of the discretion in its context, and in the context of the EPC as a whole (see **T 183/89**). The board stressed that discretion must always be exercised on a case-by-case basis, having regard to the particular circumstances. Discretion must always be exercised judicially, by taking into account those factors which are legally relevant to the issue in question and ignoring those which are not. Showing consideration towards parties before the EPO should not be confused with the proper exercise of discretion according to law.

The board made clear that where the EPC has given discretion to a department of the EPO in relation to proceedings at first instance before it, such discretion is normally best exercised by the department of first instance, because it has control over the proceedings and should be aware of all the factors which are relevant to the exercise of its discretion. Furthermore, once a department of first instance has exercised its discretion, in any appeal against a decision involving the exercise of that discretion a board of appeal is normally reluctant to interfere with such a decision, unless the reasoning in the decision has clearly been based on wrong principles. In the case in point, the board found that the reasoning of the examining division's decision did not provide an adequate basis for deciding on the exercise of discretion. According to the board, the examining division's function is not merely to consider whether the facts of the case before it are exactly the same as a previous case in which a board of appeal has decided in favour of an applicant. Its function is to decide upon the applicant's request having regard to the factors which are relevant. In the circumstances, the board observed that this was a case in which it should set aside the decision of the examining division and itself decide the question of discretion (pursuant to the board's powers under Art. 111(1)).

In **G 7/93** (OJ 1994, 775) the Enlarged Board stated that if an examining division has

exercised its discretion under R. 86(3) against an applicant in a particular case and the applicant files an appeal against the way in which discretion has been exercised, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, in order to decide whether or not it would have exercised its discretion in the same way as the department of first instance. If a department of first instance is required under the EPC to exercise its discretion in certain circumstances, it should have a certain degree of freedom when doing so, without interference from the boards of appeal. In the circumstances of a case such as that before the referring board, a board of appeal should only overrule the way in which a first-instance department has exercised its discretion if it comes to the conclusion either that the department has not exercised its discretion in accordance with the proper principles as set out above, or that it has done so in an unreasonable way, and has thus exceeded the proper limits of its discretion (see also **T 640/91**, OJ 1994, 918). See also p. 327

12.9 Legal status of the Guidelines for Examination in the EPO

In **T 162/82** (OJ 1987, 533) and **T 42/84** (OJ 1988, 251), two boards of appeal ruled on the discretionary power of examining divisions to depart from the EPO Guidelines. According to these two decisions, the Guidelines are only general instructions intended to cover normal occurrences. Thus, an examining division may depart from them provided it acts in accordance with the EPC. In reviewing the decision of an examining division, a board of appeal will wish to ensure uniform application of the law and judge whether the division has acted in accordance with the EPC, not whether it has acted in accordance with the Guidelines.

In **T 647/93** (OJ 1995, 132) the board stated that it is normally desirable for examining divisions to act in accordance with the Guidelines, but pointed out that these are not rules of law, so failure to follow a procedure set out in them is not in itself a substantial procedural violation.

13. Other procedural questions

13.1 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 given 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 the persons concerned were only entitled to the fee reduction under R. 6(3) 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.

In **T 367/90** of 3.6.92, **T 385/90** and **T 297/92** the boards of appeal applied the aforementioned principles from **G 6/91**.

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 the decision **T 905/90** (OJ 1994, 306; Corr. OJ 1994, 556). 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 this and pointed out that 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 in a space provided for other requests) to the effect that 20% of the relevant fee has been withheld, could not be regarded as an essential item in the relevant proceedings; this was in contrast to the notice of appeal, which, although linguistically insensitive, was clearly an essential item to appeal 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 **T 149/85** (OJ 1986, 103) the board held that it is inadmissible for a German opponent to file an opposition in the Dutch language even if represented by a Dutch patent attorney.

13.2 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.

In **T 811/90** (OJ 1993, 728) the board pointed out that filed documents which, as a consequence of a substantial procedural violation, were to be withdrawn from the part of the file available for public inspection and which furthermore did not fall under one of the alternatives (a) to (c) of R. 93 or belong to the classes of documents mentioned in accordance with R. 93(d) in the President's decision dated 16.9.1985 (OJ 1985, 316), had to be returned to the filing party if it so requested. Thus, even those documents marked as "confidential" in **T 516/89** (OJ 1992, 436) were returned to the party concerned - without note being taken of their contents - since they did not belong to the classes of documents to be excluded from file inspection under R. 93.

13.3 Register of Patents

13.3.1 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** (OJ 1994, 225) and **J 19/91** that registration was no longer possible once the patent had been granted because the EPO had renounced jurisdiction in favour of the national offices of the Contracting States designated in the request for grant.

13.3.2 Transfer

Art. 72 provides that an assignment of a European patent application must be made in writing and requires the signatures of the parties to the contract. In accordance with the new R. 20(1), which entered into force on 1.6.1995, a transfer of a European patent application is recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the EPO that the transfer has taken place. This new text simplifies the transfer verification process by bringing it into line with the PCT system (R. 92bis. 1 PCT).

In **J 38/92** and **J 39/92** the Legal Board of Appeal had to examine whether the conditions laid down in R. 20 were met if it could be verified from the reasons for a court judgment that the parties had signed an instrument of transfer. These decisions referred to the old version of R. 20(1), according to which it was necessary to file either the original or a certified copy of the instrument of transfer, or of official documents verifying the transfer. The board ruled that a transfer could only be recorded in the Register of European Patents on the basis of an official document in accordance with R. 20(1) if that document **directly** verified the transfer. However, in the judgment mention was made only of another document from which it was possible to verify a transfer. For reasons of legal certainty, however, the document filed for the purpose of recording a transfer must testify directly to the transfer which has already taken place.

In **T 553/90** (OJ 1993, 666) 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."

13.4 Suspension of proceedings

Under R. 13(1) the EPO stays the proceedings for grant if a third party provides it with proof that he has opened proceedings against the applicant for the purpose of seeking a judgment that he is entitled to the grant of the European patent, unless the third party consents to the continuation of such proceedings.

In **T 146/82** (OJ 1985, 267) it was stated that suspension must be ordered if satisfactory proof of the opening of relevant proceedings before a national court is given to the EPO by a third party, provided that the European patent application has not been withdrawn or is not deemed to have been withdrawn. If, in accordance with R. 13(3), the EPO sets a date on which it intends to continue the proceedings for the grant of the European patent, the date may be varied or the order staying the proceedings may be discharged at the subsequent request of the applicant or of the third party who applied for the order.

Suspension of the proceedings for grant means that the legal status quo existing at the time they were suspended is maintained, ie neither the EPO nor the parties may validly perform any legal acts while the proceedings are suspended (**J 38/92** and **J 39/92**).

13.5 Notifications to the representative

In **J 19/92** the Legal Board of Appeal held that notifications to an applicant's representative are duly made if they were despatched before the representative relinquished his brief. The notification to the applicant does not therefore have to be repeated after the brief has been relinquished. On the contrary, it is the representative who is obliged to inform his client of the notification.

B. Preliminary and formalities examination

1. Date of filing

Under Art. 90(1)(a) the Receiving Section must examine whether the European patent application satisfies the requirements for the accordance of a date of filing in conformity with Art. 80. The latter stipulates that

- (a) the documents referred to in Art. 78 must be filed together with an indication that a European patent is sought
- (b) at least one contracting state must be designated
- (c) information identifying the applicant must be furnished
- (d) a description and one or more claims must be filed.

1.1 Application documents

The boards of appeal accepted early on that application documents could be filed by facsimile means (**J 20/84**, OJ 1987, 95). Since then, the legal basis for filing by fax has been set out in the decision of the President of the EPO dated 26.5.1992 on the use of technical means of communication for filing patent applications and other documents (OJ 1992, 299) and in the notice from the EPO dated 2.6.1992 (OJ 1992, 306).

Two decisions point out the need to ensure - if the applicant wishes to be accorded a particular date of filing - that application documents are actually received by the EPO itself or by 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 under R. 24 in conjunction with Art. 75(1)(b) the date of filing of a European application was always the date on which the application documents were actually received, either by the EPO directly or by a competent national authority. R. 24 provided a comprehensive and self-sufficient system in accordance with which the EPO could determine the date of filing of a European patent application wherever (in accordance with Art. 75(1)) it was 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. 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 prevented the EPO from allowing discretion in cases where the applicant might 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 by the competent authority. In consequence, the principles set out in decision **J 18/86** above apply equally to an application filed direct with the EPO in Munich.

1.2 Designation of states

1.2.1 Correction of designation of states

In **J 8/80** (OJ 1980, 293) the Legal Board of Appeal interpreted R. 88, 1st sentence, as meaning that a correction is not precluded by virtue of its not being “obvious” within the meaning of R. 88, 2nd sentence. Moreover a mistake could result from an omission. The Legal Board accordingly ruled that the designation of states was correctable if it could be shown which states ought in fact to have been designated (**J 4/80**, OJ 1980, 351; **J 12/80**, OJ 1981, 143) and if a request for correction is made in time for a warning to be given when the patent application is published (**J 3/81**, OJ 1982, 100; **J 21/84**, OJ 1986, 75).

In decision **J 10/87** (OJ 1989, 323) 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 was 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 of the designation of a contracting state once publication had already taken place. In such a case the public interest must prevail for reasons of legal certainty. Correction of the withdrawal after publication of the European patent application was accordingly allowable if the following requirements were fulfilled: (a) at the time the retraction of the withdrawal was applied for the public had not been officially notified of the withdrawal by the EPO; (b) the erroneous withdrawal of the designation of a contracting state was due to an excusable oversight; (c) there was no undue delay in seeking retraction; (d) there was adequate protection for those third parties who, by inspecting the files, had acquired knowledge of the withdrawal and had relied on it, if the correction were to be 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, Art. 122(6) would have to apply *mutatis mutandis* if some person did know about the declaration through having inspected the file (see **J 12/80**, OJ 1981, 143; **J 26/87**, OJ 1989, 329).

Decision **J 7/90** (OJ 1993, 133), furthermore expressly upheld the principle of a time limitation for the substitution of a designation of states in accordance with R. 88, first sentence. Requests for correction must always be submitted in time for them to be published together with 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 special measures to preserve good faith with respect to the designation of states might not be necessary to protect the interests of the applicant’s competitors, who would be capable of noticing errors of designation on account of their commercial expertise. However, it considered “time limitation” a suitable and necessary condition for correcting designations, especially as the applicant had a number of reasons and opportunities to check the designations after filing his application. The board decided that this “time limitation” did not constitute a time limit within the meaning of Art. 122(1), but a temporal condition established by case law.

1.2.2 Precautionary 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, had been met even if there was 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 had been made possible among other things by the practice of "precautionary designation", which could 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) was self-regulating in the sense that if the designation fee for a contracting state was not paid, the designation of that state was deemed to be withdrawn (Art. 91(1)(e) and (4)) and only those states remained designated in respect of which the fees had been duly paid; in the unlikely event that no designation fee was paid at all, the European patent application was deemed to be withdrawn (Art. 79(3)).

1.2.3 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 appellants had filed a patent application on 21.12.1989 designating 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 applicants paid a twelfth designation fee for Denmark on the grounds that Denmark had been a contracting state since the deposit of the instrument of ratification on 30.10.1989 and was thus covered from that date by the precautionary designation. When the Receiving Section decided this request the applicants appealed, asking 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 was in principle possible to postpone the date of filing, such postponements had to be based on a legal provision or approved by specific case law. There was no legal provision of this kind in the EPC, and administrative considerations, legal certainty and the interests of third parties all militated against such postponement.

As in the above 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 applicants' appeal against the Receiving Section's decision 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 to both the EPO and the applicants - 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 28.12. designates a state which can only be designated from 1.1. following. In such cases 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 1991, 549.)

In decision **J 30/90** (OJ 1992, 516) the applicant had filed a PCT application for a European patent covering 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 grounds that, at the time of filing, Denmark was not an EPC state.

The applicant's appeal was dismissed. The board held that the EPO was the designated Office under Art. 153(1) for the EPC contracting states designated in the international application if the applicant had stated therein that he wanted a European patent for those states. That was only possible if the designated state was already a member state of the regional patent treaty (in this case the EPC) at the time of filing. The wording of Art. 153(1) was clear. The same applied to Art. 4(1)(ii) PCT, which also required that the state for which a regional patent was applied for by means of an international application must, at the time of filing, also be a member state of the regional patent treaty.

1.3 Identity of the applicant

The Legal Board of Appeal commented as follows on this requirement in decision **J 25/86** (OJ 1987, 475):

"The requirement of Art. 80(c) for 'information identifying the applicant' is to be considered to be met whenever it is possible to establish beyond reasonable doubt the identity of the applicant on the basis of all data contained in the documents filed by the applicant or his legal representative."

And in **J 7/80** (OJ 1981, 137) "If the wrong applicant is named in an application and the wrong applicant and the correct applicant are both companies forming part of the same group of companies then the mistake may be corrected under R. 88, if there is sufficient evidence to support the request for correction." A correction under R. 88, 1st sentence, is retroactive to the original date of filing (**J 3/91**, OJ 1994, 365; **J 2/92**, OJ 1994, 375); in decision **J 4/85** (OJ 1986, 205) the board accordingly ruled that the application is restored to the form which it should have taken on the filing date if the error had not been made.

2. 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 did not include a technical examination of the file; it should not, therefore, take a decision on a request for correction necessitating such an examination, but should leave the request in abeyance until the file had been transferred to the examining division.

However, in **J 33/89** (OJ 1991, 288) the board pointed out that the Receiving Section

remained competent for decisions on requests for correction of drawings under R. 88, second sentence, unless the request necessitated a technical examination.

3. Correction of priority data

Early on the Legal Board allowed correction of state designation under R. 88, first sentence (**J 8/80**, OJ 1980, 293; **J 12/80**, OJ 1981, 143; **J 3/81**, OJ 1982, 100; **J 21/84**, OJ 1986, 75). Shortly afterwards the rather strict principles developed in these decisions were also applied in cases where correction of priority declarations was at stake. Although a mistake correctable under R. 88, first sentence, can be an incorrect statement or the result of an omission, all the previous cases related to omitted priority declarations (**J 3/82**, OJ 1983, 171; **J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121; **J 11/89**, **J 7/90**, OJ 1993, 133).

In the four decisions **J 3/91** (OJ 1994, 365), **J 6/91** (OJ 1994, 349), **J 9/91** and **J 2/92** (OJ 1994, 375), the Legal Board refined the principles to be applied to corrections of priority declarations. In **J 6/91** it analysed and summarised the previous case law, pointing out that the applicant had to prove a mistake, i.e. that the document filed with the EPO did not express the true intention of the person on whose behalf it was filed. In the earlier decisions the burden of proof on the applicant was defined as a heavy one. In **J 9/91**, however, the board 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 is no need in cases of this kind to require special evidence to discharge the burden on the applicant of proving that a mistake has been made.

Despite the fact that R. 88, first sentence, allows correction without any time bar, the Legal Board followed the established case law requiring a request for correction of a priority claim to be made sufficiently early for a warning to be included in the publication of the application (**J 3/82**, OJ 1983, 171; **J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121). This principle was upheld because the EPO, when exercising its discretionary power under R. 88, first sentence, must balance the applicant's interest in gaining optimum protection and a third party's interest in maintaining legal security and, in particular, in ensuring that the published application data 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 3/91**, **J 6/91** and **J 2/92** it was held that even after publication of a European patent application without a warning, the priority declaration can be corrected under R. 88, first sentence, provided that there is an **obvious discrepancy** in the published application indicating that something is wrong. In such a case the interests of third parties are not adversely affected by the correction.

In **J 3/91** the board held that an experienced practitioner could have noticed the obvious

discrepancy because the claimed Japanese priority date (31.12.1983) and the European application date (3.1.1984) were close together and the Japanese file number was mentioned.

In **J 6/91** the international application in suit claiming priority from a US continuation-in-part application was itself presented as a continuation-in-part application and referred back to an earlier US application. In view of this and other special circumstances, the board allowed the addition of a (first) priority claim referring to the earlier US application.

In **J 2/92** the US priority date claimed for a PCT application was, owing to a clerical error, a Saturday when the USPTO was closed, instead of the previous Friday. The correct date was indicated on the priority document. Owing to a further clerical error in the request for transmittal of priority documents under R. 17.1(b) PCT (a typing error in the document number), the Receiving Office - in this case the USPTO - transmitted the wrong document to WIPO. The board allowed its replacement even after publication of the international application, adding, however, that this may not always be possible.

In the parallel cases **T 972/93** and **T 973/93** the examining division refused a request for the priority date to be corrected. European patent application E1 claimed the priority of a French application F1, from which two French divisional applications F2 and F3 were filed within the priority year claiming the priority of the parent application. The matter at issue in **T 972/93** and **T 973/93** was European applications E2 and E3, which claimed the priority of F2 and F3 respectively. In error however, the filing date of F2 and F3 was given as the priority date. This mistake was detected during examination proceedings, after E2 and E3 had been published with the wrong priority date, because E1 was discovered as a prior right within the meaning of Art. 54(3).

Following **J 6/91** (OJ 1994, 349) in particular, the board of appeal allowed the correction, ruling that the mistake was apparent, because only eight months separated the filing date of E2 and E3 from the incorrect priority date, whereas the priority year is usually exploited to the full. The interests of third parties had not been adversely affected because the precautionary filing of two European divisional applications with respect to E1, which had the same content as F2 and F3, made it possible to gain protection for the subject-matters of E2 and E3 with the priority of F1.

On the other hand, in **J 7/94** the board did not allow the correction. The applicant had claimed three priorities and duly filed the corresponding priority documents. After publication of the application the applicant requested correction of the first priority. It was explained that, when drafting the specification of the second priority application, erroneously reference had been made to an application filed earlier than the application the priority of which should actually have been claimed. This mistake had been carried over to the third priority application, and to the present European application.

The board held that Art. 88(1), 91(1)(d) and (3) stipulate that the right of priority shall be lost if the requirements concerning the claim of priority have not been satisfied. This means that a practice allowing the unlimited addition of priority declarations under R. 88 outside the framework of Art. 88 in connection with R. 38 would be contrary to the EPC. Consequently the mere fact that an existing priority was not claimed cannot justify adding this priority by correction. For these reasons the board maintained its practice that a correction after publication may only be allowable under special circumstances, in particular, if it is apparent on the face of the published application that a priority is wrong or missing. The board stated that it is not sufficient, as suggested by the appellant, that a mistake may be detected after consulting the priority document, since the published data

as such should be reliable at the publication date. In the present case it was not apparent even from the priority document as filed relating to the priority indicated in the request form that the priority data were not correct.

The appellant's argument that the interest of the public is not affected anyway by the addition of a second or subsequent priority was also rejected. It was true that in such a case the publication of the application was not delayed which was an important aspect for the system of early publication as laid down in Art. 93. Nevertheless, the addition of priority of a later date than the priority erroneously claimed might also affect the public because any additional priority was relevant for the evaluation of the validity of the patent. Any other special circumstances justifying the requested correction, comparable to those accepted in the previous case law was not evident.

In **J 11/92** (OJ 1995, 25) the Legal Board of Appeal had to decide whether an omitted priority may be added subsequently. It followed **J 6/91** (OJ 1994, 349) and took the view that an incomplete priority declaration may be corrected under R. 88 by the addition of an omitted priority in special circumstances, even after publication of the European patent application without a warning to the public that a request for correction has been made. In the case in point, the priority of four UK applications was claimed for the European patent application. After the technical preparations for publication of the European application had been completed the applicant requested the addition of an omitted priority. It was explained that the third priority disclosed 24 examples. However, two weeks before the third priority the applicant had filed a UK application which had been inadvertently overlooked in the European filing. This UK application already disclosed 21 of the 24 examples. Accordingly the earlier application was the first one to disclose the subject-matter of these 21 examples, while the latter one was the second to do so, and, thus, provided no basis for priority in respect of the common subject-matter. The Receiving Section refused the request for correction because it was not filed sufficiently early for a warning to be included in the publication of the application.

Following established case law the Legal Board pointed out that a correction under R. 88, first sentence, is at the discretion of the competent authorities and that the interest of the applicant in gaining optimum protection and the interest of the public in legal security are to be balanced. Applying this basic principle to the present case the board allowed the requested addition of a fifth priority claim. It took into account that the appellant filed in due time, as a precautionary measure, a second application claiming priority from the omitted UK application. By this "auxiliary" application the parties were informed of the full scope of European patent protection sought. In addition, the public was fully informed of the scope of European patent protection sought as far as the subject-matter was concerned since the examples disclosed in the omitted priority application were covered by the first and third priority application. Finally, the board took into account the fact that the applicant acted promptly after detection of the mistake and that the patent grant procedure, including publication of the application after 18 months, had not been held up in any way.

C. Examination procedure

1. Introduction

As *ex parte* proceedings, the examination procedure is also subject to general procedural principles such as the protection of legitimate expectations, the right to be heard and the right to oral proceedings. The boards of appeal have dealt with these principles in numerous decisions.

The decisions discussed in the sections on R. 51 refer primarily to new R. 51 in the version of 1.9.1987, which restructured the final phase of the European patent grant procedure.

2. Request for examination

Before the examination of an application can commence, the applicant has to file a request for examination. This request is not considered filed until a written request has been submitted and the examination fee has been paid. Art. 94(2) states that a request for examination may be filed at any time from the date of filing of the application up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report.

In **J 25/92**, following **J 13/90** (OJ 1994, 456), the board held that if an examination fee plus a surcharge had been paid in due time and if there was any doubt in the EPO's mind as to whether the applicant intended to request examination, the principle of the protection of legitimate expectations required the EPO to warn the applicant that he was about to lose his rights for not submitting a specific written request for examination.

3. Communications of the examining division

3.1 General issues

Under the procedure set out in Art. 96(2), if the examination has revealed that the European patent application or the invention on which it is based does not meet the requirements of the EPC, the examining division's communication must contain a reasoned statement covering all the grounds against granting the European patent (R. 51(3)). Moreover, the examining division should invite applicants as often as necessary to file their comments.

In several decisions the boards pointed out that it was highly desirable that the examining division should give an appealable decision with sufficient reasoning on all the issues that had been properly raised by the EPO during the examination proceedings and dealt with substantively in the applicant's reply. Such "complete" decisions streamlined the procedure rendering remittal to the department of first instance unnecessary: the board could decide all issues already raised in the department of first instance without depriving the appellant of the opportunity to have them considered at two instances (see **T 153/89**, **T 33/93**, **T 311/94**).

In **T 98/88** the board pointed out that R. 51(3) did not make it compulsory for communications in accordance with Art. 96(2) to set out all the grounds against the grant of the patent. The board's view in this case was that deferral of the examination in respect of the requirements under Art. 52 until a clear version of the claims had been received did not conflict with R. 51(3).

3.2 Right to present comments and further invitation to do so

This section deals in particular with the question of the right to be heard where an application has been refused after a single communication without a further invitation to present comments being issued. According to the established case law of the boards of appeal, it is left to the examining division's discretion to decide whether to issue a **further** invitation. The words "as often as necessary" indicate that the examining division may use its discretion to act according to the circumstances. Under Art. 113(1), however, it is not necessary to give the applicant repeated opportunities to comment on the examining division's submissions if the main objections to the grant of a European patent remain the same. A further invitation to present comments following a substantiated communication in which deficiencies were recorded is only appropriate if it would appear likely that, in the light of the applicant's reply, the examination proceedings would terminate in the granting of a patent (see **T 84/82**, OJ 1983, 451, **T 161/82** OJ 1984, 551, **T 162/82** OJ 1987, 533, **T 243/89**, **T 300/89**, OJ 1991, 480, **T 793/92**).

In **T 300/89** the board pointed out that even if it were possible for the examiner to envisage amendments which might lead to the grant of a patent, the burden lay with the applicant (if he so wishes) to propose amendments if he so wished (including various alternatives in the form of auxiliary requests). These amendments can be proposed in the applicant's observations in reply to the first communication (Art. 96(2)) from the examining division, where any objections were raised.

In **T 79/91** the board held that the refusal of the application after only one communication was not contrary to Art. 96(2) because it was unlikely that further communication would have produced a positive result. In **T 63/93** the board stated again that a patent application could be refused after the first communication if the applicant's response failed to convince the examining division, particularly where the claimed subject-matter had not been substantially modified (see also **T 66/83**, **T 304/91**).

In **T 220/93** the only written communication from the examining division concerning the claims effective at the time had stated that the subject-matter lacked novelty and inventiveness. In response to the applicant's detailed comments, the first examiner had, during a telephone conversation, merely objected during a telephone conversation to an allegedly unclear formulation in the newly filed claims. The application had then been refused. In the board of appeal's opinion, this manner of proceeding constituted a breach of Art. 113(1), since the appellant could have assumed that the objections previously raised in the written communication were no longer applicable. If such objections persisted or were being raised a second time, the appellant could rightly have expected them to be set out in a further communication, giving rise to a further opportunity to present comments (see also **T 218/93**).

In **T 734/91** the applicant had filed a fresh set of claims to overcome all the objections mentioned in the examining division's communication. The board confirmed that the applicant should not be given repeated opportunities to comment on the same objections but pointed out that, where an applicant had made a bona fide attempt to overcome the objections raised by the examining division, Art. 113(1) might require him to be given the opportunity to present his comments on the grounds for refusing the amended claims.

In **T 89/93** the board again held that the examining division could not refuse an application after a first communication if the applicant had made a serious attempt to overcome the objections raised or if it appeared likely that continuing the procedure would lead to a

positive result. Following **T 908/91**, the board decided, however, that reimbursement of the fee for appeal would not be equitable.

In **T 907/91** the examining division refused the application without informing the applicant of its grounds for not accepting the amended documents submitted after receipt of the first communication and after oral proceedings. The board held this action to be in breach of Art. 113(1) because, prior to issuing the contested decision in written or oral proceedings, the examining division should have given its reasons for refusing to accept the amended documents. Such grounds could be of a formal nature or relate to substantive patent law, depending on the relevant provisions. But other grounds could also be brought to bear, based on generally recognised principles of procedural law (see Art. 125), such as applicant's attempting to delay proceedings by submitting an excessively large number of requests for amendments in clear abuse of the patent grant procedure.

In **T 582/93**, too, the examining division refused the amended claims, filed by the appellant in response to the first communication, without giving him another opportunity to comment. In its decision the examining division referred to a table in document D1, written in programming language, in order to show that the subject-matter of claim 1 was not considered to involve an inventive step with regard to the disclosure of document D1. The board noted that the reasoning presented for the first time in the contested decision relied on a table given in a **programming language**. Following **T 164/92** (OJ 1995, 305; Corr. OJ 1995, 387) the board admitted the part of D1 written in programming language to the proceedings (see also p. 49). However, the board pointed out that in such a case it was extremely important that an examining or opposition division, before taking a decision, ensure that grounds and evidence in the form of a program on which the decision relied, had been communicated to the applicant or patentee so that the requirements of Art. 113(1) were met. It might, for example, be necessary for the applicant or patentee to contact a programming expert to explain a reference written in a programming language.

In **T 891/92** the appellant's submissions in reply to the first communication prompted the examining division to use a line of reasoning based on a different combination of documents in its objection to a lack of inventive step in application's claim 1. The board held that under these circumstances, the examining division was legally obliged under Art. 113(1) to issue a further communication to the appellants in order to give them an opportunity to present their comments on the new argument put forward for refusing to grant a patent.

In **T 640/91** (OJ 1994, 918) the board developed the principles laid down in the case law referred to above and stated that the use of the word "necessary" in Art. 96(2) implicitly recognised that in certain circumstances the examining division would be legally obliged to invite further observations from the applicants before issuing a decision. Having regard to Art. 113(1), there was a "necessary" legal obligation for an examining division to invite further observations from an applicant before issuing a decision adversely affecting him, where the division might be inclined to issue an immediate decision on the ground that he had shown lack of good faith in his previous observations. The board pointed out, moreover, that it was in principle not the function of an examining division to assess either the degree of collaboration from applicants or their good faith when deciding whether or not to invite further observations in the exercise of its discretion under Art. 96(2). The exercise of this discretion depended primarily upon whether or not there was a reasonable prospect that such an invitation could lead to the grant of a patent (see also **T 855/90**, in which the board found that the examining division had exercised its discretion unreasonably).

In **T 951/92** (OJ 1996, 153) the board summed up the case law by stating that Art. 113(1) was intended to ensure that, before a decision refusing an application for non-compliance with a requirement of the EPC was issued, the applicant had been **clearly** informed by the EPO of the essential legal and factual reasons on which the finding of non-compliance was based. This was so that in advance of the decision he knew both that the application might be refused and why, and also so that he might have a proper opportunity to comment upon the reasons and/or to propose amendments so as to avoid refusal of the application. If a communication under R. 51(3) EPC and pursuant to Art. 96(2) EPC did not set out the essential legal and factual reasoning to support a finding that a requirement of the EPC had not been met, then a decision based upon such a finding could not be issued without contravening Art. 113(1), unless and until a communication had been issued which did contain the essential reasoning. If a decision was issued in the absence of a communication containing essential reasoning, Art. 96(2) was also contravened, since in order to avoid contravening Art. 113(1) it was “necessary” to issue a further communication (see also **T 520/94**).

3.3 Reply to a communication of the examining division

A letter of reply to a communication of the examining division filed in due time by the applicant and dealing with substantial points of this communication constitutes a reply within the meaning of Art. 96(3) and thus, from the point of view of procedural law, rules out the possibility of deemed withdrawal. The further declaration that “This present letter is not to be treated as a formal response to that communication” is merely contradictory to the facts, the reality of which cannot be negated by such an expedient (**T 160/92**, OJ 1995, 35).

4. Approval of the text

Before the examining division decides to grant a European patent, it informs the applicant, in accordance with R. 51(4), of the text in which it intends to grant it and requests him to indicate his approval of the text notified. If no such approval is communicated within the relevant period, the application is refused in accordance with R. 51(5). Once the applicant has approved the text notified, the examining division invites him in accordance with R. 51(6) to pay the fees for grant and printing and to file a translation of the claims in the two official languages of the EPO other than the language of proceedings within a period set by the examining division.

4.1 Examining division’s discretion regarding amendments

Under R. 86(3) applicants may, after receiving the first communication from the examining division and of their own volition, amend the description once, claims and drawings provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the examining division. The Guidelines (see C-VI, 4.8 and 4.9) add that “any request by an applicant to replace the text of the application on whose basis a patent could be granted, with one that has been extensively revised should be refused, unless the applicant gives good reasons for proposing the changes only at this stage in the proceedings. ... The communication under R. 51(4) does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure ... normally only those amendments which do not appreciably delay the preparations for grant of the patent will be allowed under R. 86(3)”.

In decision **T 182/88** (OJ 1990, 287) the board laid down the principle that in any case where the EPC allows a department of the EPO to exercise its discretion in relation to an issue in proceedings before it, in accordance with the general principles of law, this discretion, must be exercised having regard to the factors which are relevant to the issue. In both **T 182/88** and **T 166/86** (OJ 1987, 372), the board decided that a separate set of claims submitted at a late stage in the proceedings was admissible under the particular circumstances. It added that the EPO's user-friendly reputation should clearly be excluded from consideration during the exercise of any discretion by the EPO. The showing of consideration towards parties before the EPO should not be confused with the proper exercise of discretion according to the law.

4.2 Requests for amendments after issue of the Rule 51(4) EPC communication

T 375/90 referred to decisions concerning the exercise of discretion in the application of R. 86(3), where amendments were proposed by the applicant after issue of the R. 51(4) communication. These decisions imposed the following conditions:

- (a) There is no discretion involved in the obligation to admit amendments which remove deficiencies constituting violations of the EPC (see **T 171/85**, OJ 1987, 160, **T 609/88**).
- (b) In all other cases the EPO's interest in a speedy completion of the proceedings must be balanced against the applicant's interest in the grant of a patent with the amended claims (**T 182/88**, OJ 1990, 287, **T 76/89**).

In **T 375/90** the board stated that the examining division was not free to deny examination of amendments proposed after issue of the R. 51(4) communication, but had to consider whether the above conditions had been met, and give reasons if it concluded that they had not.

In **T 999/93** the applicant, upon receipt of a communication under R. 51(4), stated his disapproval of the text based upon an auxiliary request proposed for grant and insisted upon receiving an appealable decision regarding the main request. The formalities officer acting for the examining division refused the application pursuant to R. 51(5) on the grounds that there was no text to serve as a basis for the grant within the meaning of Art. 113. The board held that this decision was incorrect since the appellant's letter together with the fact that the appellant had not withdrawn the main and first and second auxiliary requests clearly showed that he did indeed approve and propose the text given in his higher-ranking request.

4.3 Requests for amendment after issue of the Rule 51(6) EPC communication

In **G 7/93** (OJ 1994, 775), in response to a referral in **T 830/91** of 25.5.1993 (OJ 1994, 728), the Enlarged Board of Appeal looked initially at the question of the admissibility of amendments to the patent application after a R. 51(6) communication. Decisions **T 1/92** (OJ 1993, 685) and **T 675/90** (OJ 1994, 58) had differed in their interpretation of this point. The Enlarged Board of Appeal concluded that an approval of a notified text submitted by an applicant pursuant to R. 51(4) was not rendered binding by virtue of a communication being issued in accordance with R. 51(6). Even following the issue of such a communication and until the issue of a decision to grant the patent, it was left to the discretion of the examining division under R. 86(3), second sentence, whether or not to allow amendment of the application.

When exercising its discretion following the issue of a R. 51(6) communication, an

examining division had to consider all relevant factors. In particular it had to consider and balance the applicant's interest in obtaining a patent which would be legally valid in all of the designated states, and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent. Having regard to the object of a communication under R. 51(6), which was to conclude the grant procedure on the basis of the previously approved text, allowance of a request for amendment at that late stage in the granting procedure would be an exception rather than the rule.

A clear example of an exceptional case when it might be appropriate to allow amendment was, in the Enlarged Board's view, where the applicant requested separate sets of claims to be substituted in respect of designated states that had made reservations under Art. 167(2). Similarly, other minor amendments which did not require the re-opening of substantive examination and which did not appreciably delay the issuing of a decision to grant the patent might be allowable after a R. 51(6) communication had been issued.

As to the second question referred to it, of whether the EPO was obliged to consider reservations under Art. 167(2) as constituting requirements of the EPC which had to be met in accordance with Art. 96(2), the Enlarged Board of Appeal held that, "Under Art. 96(2), an examining division is required to consider whether the application or the invention to which it relates meets the requirements of the EPC. When a Contracting State to the EPC makes a reservation under Art. 167(2) it reserves the right to make provisions in its national law on the matters set out in Art. 167(2). Such provisions of national law are clearly not "requirements of the EPC" within the meaning of Art. 96(2)."

Thus **G 7/93** supersedes on this point decisions **T 860/91** and **T 675/90**, in which it was held that the discretionary power conferred by R. 86(3) to allow amendments no longer existed after a R.51(6) communication had been issued.

In **T 790/93** a request for amendment was submitted after the R. 51(6) communication had been issued but before the patent was granted. The formalities officer who issued the decision granting the European patent did not take account of the request for amendment. The board held that the formalities officer had exceeded his authority, ruling that he should have forwarded the request to the examining division since a formalities officer could only take the decision to grant the European patent (R. 51(11)) in clear cases. The decision to correct errors in the description, claims or drawings of the application always lay with the examining division.

5. Divisional applications

5.1 Introduction

Under Art. 76(1) a European divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this provision is complied with, the divisional application is deemed to have been filed on the date of filing of the earlier application and has the benefit of any right to priority. The procedure to be followed for divisional applications is laid down in R. 25 (for further information see also p. 276).

R. 25(2) in its old version was deleted with effect from 1.6.1991, so as to conform with EPO practice, according to which an unamended description, identical to that contained in the parent application, was normally accepted. In accordance with the reason for the proposed change given at the time - more flexibility for both EPO and applicant - it was thought preferable to leave it to the examining division to deal with amendments to the description

and drawings, taking into account the relevant circumstances of the case. The Guidelines too (C-VI, 9.5) state that the repetition in a divisional application of matter in the parent application need not be objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application.

In **T 441/92**, therefore, the board took the view that there was nothing in the EPC to prevent an applicant from repeating the parent description in a divisional application and that there was no contravention of Art. 76(1) in this respect in the case in point. Moreover, with regard to the nature of divisional applications, it was a generally accepted principle of patent law that, once a divisional application had been validly filed, it became separate and independent from the parent application. Thus, once the conditions of Art. 76(1) had been met, the divisional application was to be examined as an application quite separate from the parent application and had itself to comply independently with all the various requirements of the EPC.

The relationship between parent application and divisional application was one of the issues before the board of appeal in **T 118/91**. In this case 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 Arts. 100(c) and 123(2) was the totality of information given to the skilled person by the original application and logically could not be reduced by the subsequent filing of a divisional application, whatever the content thereof. Likewise, 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 was dealt with in the Guidelines at C-VI, 9.6, where it was indicated that one application might 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 this 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.

In **T 441/92** the board added that by analogy, in the reverse situation, the lapse of a parent application could not have the effect of reducing the content of a previously filed divisional application.

In **J 36/92** the appellant approved the text of the patent application according to R. 51(4), stating in the same letter, “We have today filed a divisional application including” However, the divisional application reached the EPO one day after the applicant’s letter. The board referred to **J 13/84** (OJ 1985, 34) and stated that from the wording of the letter it was apparent that the two pieces of information had to be seen as correlated and mutually dependent on each other. Where an applicant approved the text of a European patent application pursuant to R. 51(4) and in the same letter stated that he had that day filed a divisional application, the filing of the divisional application should be allowed, whether or not it was actually received by the EPO together with the letter.

5.2 Time of filing of divisional application

In **G 10/92** (OJ 1994, 633) the Enlarged Board of Appeal considered the question of the point in time up to which an applicant could file a divisional application on a pending earlier European patent application.

The President of the EPO had referred this point of law in accordance with Art. 112(1)(b), pointing out that the ruling in the two consolidated cases **J 11/91** and **J 16/91** (OJ 1994, 28) was at variance with that in **T 92/85** (OJ 1986, 352). In **J 11/91** and **J 16/91** the Legal Board of Appeal had taken the view that an applicant could, notwithstanding R. 25(1) (in the version which entered in force on 1.10.1988), still file a divisional application after the approval in accordance with R. 51(4). R. 25 had been held to be incompatible with Art. 76 as the time limit stipulated in the former did not represent the final date by which a divisional application on a pending earlier European patent application had to be filed. Contrary to the wording of R. 25, a divisional application could still be filed up to the date of the decision to grant pursuant to Art. 97(2).

In its opinion, however, the Enlarged Board of Appeal concluded that under the amended version of R. 25 in force since 1.10.1988 an applicant could only file a divisional application on the pending earlier European patent application up to the approval in accordance with R. 51(4). Art. 76(3) contained a general authorisation for laying down the procedure for filing European divisional applications. This general authorisation also allowed the Administrative Council to determine the point in time up to which a European divisional application could be submitted. R. 25 was therefore consistent with Art. 76(3) and hence was also reasonable and appropriate.

The Enlarged Board of Appeal pointed out that while the approval pursuant to R. 51(4) was a procedural statement, and hence could be withdrawn, the mere fact that approval could be withdrawn did not mean that applicants who withdrew approval then acquired the right to file a divisional application. If, however, the examination procedure was reopened after the approval in accordance with R. 51(4), it was for the purposes of R. 25, the **last approval** given by the applicant during proceedings that was decisive, ie the point at which it was clear that the applicant approved the final text proposed by the examining division. The same was true of appeal proceedings if the board of appeal concluded that the patent had to be amended prior to grant. The applicant then had to approve the amended text again.

5.3 Admissibility of reinstatement of claims deleted from an application in a divisional application

In **T 910/92** the applicant had expressly declared that he was abandoning several claims in his application, but later revoked this declaration and requested that the claims deleted from the application be reinstated in a divisional application. The board of appeal considered the question under what circumstances it was possible to revoke such a declaration. It referred to the case law, which required that the real intention of the party making the declaration be established, taking into account all the circumstances of the case. The Legal Board of Appeal had already stated in decisions **J 24/82** (OJ 1984, 467), **J 25/82** and **J 26/82** (OJ 1984, 467) that a declaration limiting the parent application (R. 25(1)(b), old version) was to be interpreted in the context of the course of the proceedings to date. In **T 910/92** the board came to the conclusion that the appellant's real intention was not to abandon part of the original disclosure altogether, but to avoid the lack of unity that had arisen as a result of the change in the protection sought.

In this connection the board also commented on the Legal Board of Appeal's decision **J 15/85** (OJ 1986, 395). In that case the appellant had failed to state that the deletion of certain claims in a parent application was to be without prejudice to the divisional application. The Legal Board of Appeal held that it was therefore clear that the appellant no longer sought protection for the subject-matter of the deleted claims. At the time when

the claims were abandoned, the parent application had already been published so that the public had access to the file. The public had thus been immediately entitled to assume that, since there was no reference to the filing of a divisional application, the appellants had irrevocably abandoned the claims (see also **T 61/85**).

In **T 910/92**, however, the board did not see the need to protect the public interest by generally prohibiting the revocation of a declaration of abandonment, since the applicants had revoked the declaration only six months later. As the application had already been published at the time of the alleged abandonment, anyone could have inspected the files in accordance with Art. 128(4). It could be expected that any third parties interested in the proceedings relating to the application in question would have asked to inspect the files at suitable intervals up until the conclusion of the proceedings. The public had thus had the opportunity to learn about the revocation of the declaration of abandonment during the proceedings in respect of the earlier application.

6. Withdrawal of patent application

A request for withdrawal of a European patent application should only be accepted without question if it is completely unqualified and unambiguous (**J 11/80**, OJ 1981, 141). Several decisions have confirmed and developed this case law.

In **J 6/86** (OJ 1988, 124) the Legal Board held that the statement "applicant wishes to abandon this application" could be considered as the 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.

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 had to be interpreted with regard to the attendant circumstances, from which it had to be clear that the applicant really wanted immediate and unconditional withdrawal rather than passive abandonment leading in the course of time to deemed withdrawal.

In **J 15/86** (OJ 1988, 417) the Legal Board stated with regard to the declaration of withdrawal that, in practice, in 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 intention had to be considered on its own facts. A written statement by the applicant or his representative had to be interpreted in the context of the document as a whole and of the attendant circumstances. It was too late to ask for retraction of a letter of withdrawal once notice of the withdrawal had been published in the European Patent Bulletin (see Legal Advice No. 8/80, OJ 1981, 6, point 2).

In **J 11/87** (OJ 1988, 367) the Legal Board of Appeal further stated that where there was even the slightest doubt as to the actual intent of the applicant who had made a declaration which could be construed as a withdrawal of the application, that declaration could be so construed only if the related facts confirmed that this was the applicant's true intent (**T 45/91**).

If substantive examination has not yet begun, the examination fee is to be refunded in accordance with Art. 10b RFees, which entered into force on 1.10.1988.

7. Refusal of the entire application

Under Art. 97(1), a European patent application which fails to meet a requirement of the EPC has to be refused in its entirety, without it being necessary to consider whether the application as a whole might contain material indicative of inventiveness (**T 5/81**, OJ 1982, 249, **T 293/86**, **T 398/86**, **T 98/88**).

In **T 162/88** it was stated that if the European patent application in the version submitted or approved by the applicant contained a claim which the examining division considered unallowable, the examining division had to refuse the European patent application in its entirety under Art. 97 and not just the claim concerned. Under these circumstances it was not necessary to comment on any other remaining claims (see also **T 117/88**, **T 253/89**, **T 228/89**).

8. Metric or SI units

Decision **T 561/91** (OJ 1993, 736, see also **T 176/91** and **T 589/89**) led to the amendment of R. 35(12) since it found that the old version of R. 35(12) only required applicants for a European patent to express weights and measures in metric units. The new wording of R. 35(12), sentence 1, now makes it clear that metric units means SI units: "Physical values shall be expressed in the units recognised in international practice, wherever appropriate in terms of the metric system using SI units." R. 35(12) was amended by decision of the Administrative Council of 13.12.1994 and entered into force on 1.6.1995.

9. Errors in the Patent Bulletin

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 decision **J 14/87** (OJ 1988, 295) the question arose to what extent a deficiency in the publication of the mention of grant of a European patent, i.e. the omission of important particulars relating to the grant, might render the patent ineffective. The board held that in principle deficiencies in the publication of the mention of grant in the European Patent Bulletin did not necessarily render the decision to grant within the meaning of Art. 97(4) ineffective. Nevertheless, this matter could be decided only in the light of the case in question and of the fact that the purpose of the publication was to draw the attention of interested parties to the grant of the patent, and also that any decision to file an opposition had, under normal circumstances, to be based on a careful examination of the extent of the protection conferred by the patent and not solely on the particulars given in the European Patent Bulletin. Such an examination could be carried out satisfactorily only if the patent specification was published at the same time as the mention of grant of the patent.

10. Composition of examining division

In **T 714/92** the board stated that the taking of a decision at a date on which the examining division no longer existed in its stated composition, without the examining division's ensuring that it be apparent from the part of the file open to public inspection that the member who had left the examining division had agreed the text of the decision before leaving, had to be considered a substantial procedural violation. Thus the impugned decision had to be set aside as void ab initio and of no legal effect.

D. Opposition procedure

1. The legal nature of opposition proceedings

The nature of the main procedural principles for opposition proceedings has been the subject of a number of decisions by the boards and the Enlarged Board of Appeal.

In **T 198/88** (OJ 1991, 254) the board held that opposition was an **independent procedure** following the grant procedure (confirmed in **T 373/87**). It was a separate procedure in which a patent wrongly granted could be limited or revoked. Consequently, the opposition procedure was not part of the grant procedure. In **G 1/84** (OJ 1985, 299) the Enlarged Board of Appeal held that the opposition procedure was **not** designed to be **an extension** of the examination procedure (see **T 182/89** (OJ 1991, 391), **T 387/89** (OJ 1992, 583), **T 279/88**).

In **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board observed with regard to the general scope of opposition under the EPC, that it was important that opposition took place only after grant of the European patent, ie at a point in time when the proprietor was enjoying in each designated contracting state the same rights as would be conferred by a national patent granted in that state (Arts. 64 and 99). Thus, the relief sought by the opponent was not, as in traditional pre-grant opposition, refusal of the patent application but revocation of the patent as granted (in its entirety or in part) with effect *ex tunc* in all designated contracting states (Art. 68). Furthermore, the grounds for opposition (Art. 100) being limited to and essentially the same as the grounds for revocation under national law (Art. 138), it appeared that the concept of post-grant opposition under the EPC differed considerably from that of classical pre-grant opposition and in fact had 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 were in principle to be considered as **contentious proceedings** between parties normally representing opposite interests, who should be given equally fair treatment.

In **G 9/92** (OJ 1994, 875) the Enlarged Board noted that proceedings under the EPC in respect of European patent applications and patents were, with some exceptions, initiated by a party. The initial "request" determined the extent of the proceedings. This is known as the **principle of party disposition** (*ne ultra petita*).

Opposition proceedings are post-grant proceedings (Art. 99) to which Arts. 99 to 105 and the corresponding provisions of the Implementing Regulations are applicable. In such proceedings the EPO must examine the facts of its own motion (Art. 114(1)). Certain restrictions have however been placed upon this so-called **principle of ex officio examination** in order to make such proceedings clearer, to shorten and accelerate cases, and to limit the risks to the parties.

In **G 9/91** the Enlarged Board addressed the issue of the power of an opposition division or board of appeal to decide upon the patentability of parts of a patent which had not been attacked in the notice of opposition. According to this decision, opposition proceedings are only **pending** to the extent to which the European patent is opposed in the statement pursuant to R. 55(c). Subject-matter not opposed therein is not subject to any "opposition" within the meaning of Arts. 101 and 102, nor are there any "proceedings" within the meaning of Arts. 114 and 115 in existence concerning any unopposed subject-matter (see reasons 10 and 11). The opposition division or board of appeal, therefore, has the power to decide on the revocation or maintenance of a patent **only** to the **extent** to which the patent is opposed in the notice of opposition.

Application of the principle of ex officio examination (Art. 114(1)) to the grounds for opposition is also subject to restrictions. However, in this case the restricted application is not derived from the principle of party disposition; the proper extent of examination has to be determined by the application of other procedural principles (**G 10/91**, reasons 12). In first instance proceedings the opposition division should examine **only** those **grounds** for opposition which the opponents have submitted within the time limit for opposition and have properly supported with facts and evidence. Grounds extending beyond this may only be considered in exceptional cases to which special conditions apply (**G 10/91**, reasons 16).

A further question which arose in this case was whether the same principles were to be applied to proceedings before an opposition division and to appeal proceedings. The Enlarged Board held that in contrast to the merely **administrative character** of the procedure before the opposition division, the appeal procedure was to be considered as a **judicial** procedure. Such a procedure is by its very nature **less investigative** than an administrative procedure (see also **G 7/91** and **G 8/91**, OJ 1993, 356 and 346, reasons 7). Thus, although Art. 114(1) formally covers the appeal procedure too, the application of this provision in a more restrictive manner than in the opposition procedure is justified.

In **G 9/93** (OJ 1994, 891) the Enlarged Board of Appeal looked at another fundamental issue of opposition proceedings under the EPC and overturned the case law established by the Enlarged Board's decision in **G 1/84** (OJ 1985, 299).

In **G 1/84** the Enlarged Board held that a patent proprietor could file a notice of opposition against his own patent. A new referral to the Enlarged Board of Appeal questioned whether this was still applicable in the light of the nature of the opposition proceedings as expounded in decisions **G 9/91** and **G 10/91** (see **T 788/90**, OJ 1994, 708). In **G 9/91** and **G 10/91** - in contrast to **G 1/84** - the Enlarged Board held that, in view of their special post-grant character, opposition proceedings under the EPC were in principle to be considered as contentious proceedings between parties normally representing opposing interests. In other words, they were inter partes proceedings.

In reaching its decision in **G 9/93**, the Enlarged Board endorsed the concept of opposition which it had applied in those recent decisions. It did not share the interpretation of Art. 99 set out in **G 1/84** and concluded, having regard in particular to the nature and purpose of the opposition procedure as provided for in Part V of the EPC, that the words "any person" in Art. 99(1) could only be reasonably interpreted as referring to the public at large which was being given the opportunity to challenge the validity of the patent in question. In the board's opinion, it appeared artificial to include the patent proprietor. The provisions of Part V of the EPC and the corresponding Implementing Regulations were clearly based on the assumption that the opponent was a person other than the patent proprietor and that the opposition proceedings were always inter partes. Thus the board held that the patent proprietor was not covered by the term "any person" in Art. 99(1) and was therefore not entitled to oppose his own patent under that provision. The ruling in **G 1/84** could thus no longer be followed.

2. General Issues

2.1 Right to be heard in opposition proceedings

2.1.1 Opportunity to file observations

Several decisions focused on the principle of guaranteeing the right to be heard 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 this opportunity he is not entitled to receive a communication under Art. 101(2).

In **T 669/90** (OJ 1992, 739) the board ruled that a party has not had “an opportunity to present its comments” within the meaning of Art. 113(1) if the EPO sends a communication which (on a reasonable interpretation) misleads a party into believing that it is not necessary to defend its interests by filing observations in reply to new facts and evidence filed by a party on the other side, and if such new facts and evidence then form the basis for a decision adversely affecting the misled party. Such an action does not constitute a fair procedure and is contrary to the principle of the protection of legitimate expectations governing relations between the EPO and parties to proceedings before it (decision **T 22/89** not followed). The board also stated that it is necessary for the purposes of Art. 101(2) to invite the proprietor to present his comments by filing observations if new evidence filed late by an opponent is to be taken into consideration in view of its relevance, and in the absence of observations upon such evidence by the patent proprietor, before the case can be decided on the basis of such evidence. This necessity follows both from Art. 113(1) and from the general principles of procedural law applicable under Art. 125.

The principles of **T 669/90** were applied in a number of decisions. In **T 190/90** the board of appeal drew attention in its decision to the fact that in inter partes proceedings such as opposition proceedings the right to be heard 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 (see also **T 682/89** and **T 439/91**).

In **T 263/93** the board ruled that the right to be heard enshrined in Art. 113(1) requires that the party concerned be given sufficient time to submit an adequate response if the EPO decides to communicate to a party to proceedings before it an objection raised by another party without an express invitation to reply within a specified time limit. Although the length of the period of time necessary to comply with the requirement depends on the particular circumstances of the case, a party to opposition proceedings before the EPO can fairly expect that it would normally have at least two months to present its comments to the objections raised before a decision based on them is taken.

In **T 832/92** the board added to this case law, ruling that it may not always be necessary for a party to be given sufficient time to respond provided the case is remitted to the department of first instance for further prosecution, so that this party still has the opportunity to contest the argumentation of the other party.

In **T 892/92** (OJ 1994, 664) (see also p. 197) the board ruled that Art. 113(1) requires that an express opportunity to present observations be given to the parties by the opposition division after remittal to it of a case by a board of appeal for further prosecution on the basis of new evidence, even if submissions with respect to this new evidence have already been made during the preceding appeal proceedings (see also **T 769/91**).

In **T 716/89** (OJ 1992, 132) the board decided that the right to be heard meant that the patent proprietor should, under R. 57(1), be informed of the opposition and be 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 a communication should have been sent at least to the patent proprietor who had not lodged an opposition.

2.1.2 Further communication and extent of opposition

In **T 293/88** (OJ 1992, 220) a substantial procedural violation was held to have been committed because the opposition division, which should have assumed the *prima facie* validity of dependent claims not objected to by the opponent at any stage, revoked the patent without issuing a communication in advance, although the patentee had also requested the maintenance of the patent with possible amended claims to be determined in the course of the opposition proceedings.

The situation in **T 165/93** was different. In their statements filed within the opposition period the respondents raised objections to only some of the claims. No ground for opposition was cited against other - dependent - claims. After the end of the opposition period, in response to the appellants' (patentees') filing of amended claims, the respondents opposed all the then existing claims. The patentees, despite having been informed of the additional objection of the opponents concerning the further subclaims, did not react but maintained their sole request for maintenance of the patent with the amended claims. The board held that in this case there was no necessity under Art. 113(1) for the opposition division to announce its opinion in advance in a communication or to give a further opportunity to the patentees to declare whether they were interested in a limited patent. If, following an extension of the opposition to dependent claims originally not impugned after expiry of the opposition period (see **G 9/91**, OJ 1993, 408), the proprietor of the patent who was duly informed about this extension does not show any willingness to include such originally undisputed subject-matter in the independent claim(s), there is no necessity to issue a further communication in this respect before revoking the patent.

2.2 Acceleration of proceedings in the case of pending infringement proceedings

If the opposition division is unable to process an opposition case speedily on account of the amount of work in hand, the Guidelines (D-VII, 1.1) 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 11.6.1990 (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.

2.3 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 when such a conclusive decision is issued, irrespective of when this decision becomes final. Thus, if, after an opposition division has issued a decision terminating the proceedings, none of the parties to the opposition proceedings files an appeal, any notice of intervention filed during the two-month period for appeal under Art. 108 is invalidated.

In **T 631/94** (OJ 1996, 67) the board noted that when a decision to terminate opposition proceedings, taken in written proceedings, was handed over to the EPO postal service, it became public and effective and had therefore been issued. If the parties to the proceedings leading to that decision did not appeal, the opposition proceedings were completed at that point in time and thereafter intervention based on Article 105 EPC was no longer possible. See also p. 256.

Board of appeal decisions concerning further legal aspects of intervention of an assumed infringer under Art. 105 are dealt with on p. 319.

2.4 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 European Patent Office 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

and that, by analogy, the opposition could be transmitted to the opponent's universal successor in law (R. 60(2)), held that the opposition constituted an inseparable part of the enterprise's assets; therefore, in so far as those assets were transferable or assignable under the applicable national laws, the opposition which was part of them had also to be regarded as transferable or assignable in accordance with the principle that an accessory when annexed to a principal object becomes part of the principal object.

In **T 659/92** (OJ 1995, 519) the board found that there had been no transfer of the opponent's business assets or of the particular assets to which the industrial property rights in question related, but only of certain industrial property rights and the rights in opposition proceedings relating to the patent in suit. Contrary to the view of the acquiring party, therefore, there was no question of the opposition having been ceded to a universal successor in title as "an inseparable part" of those business assets in the interests of which the appeal was filed.

2.5 Withdrawal of opposition - continuation of opposition proceedings (Rule 60(2) EPC)

2.5.1 Withdrawal during opposition proceedings

R. 60(2) provides that the opposition proceedings may be continued by the EPO of its own motion if the opposition is withdrawn.

In **T 197/88** (OJ 1989, 412) the board considered the circumstances under which opposition proceedings could be continued by the EPO of its own motion under R. 60(2) when an opposition was 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 was convinced were not legally valid at all or only to a limited extent. Furthermore, it was often the patent proprietor who was interested in limiting his patent to ensure that his claims stood up to legal scrutiny. The proceedings ought therefore to be continued if they had reached such a stage as to be likely to result in limitation or revocation of the European patent without further assistance from the opponent and without the opposition division itself having to undertake extensive investigations.

2.5.2 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. One opponent had withdrawn its opposition prior to delivery of the decision by the opposition division. The patent proprietor lodged an appeal against the patent's revocation. The other opponent withdrew its opposition prior to oral proceedings before the board.

The board held that, in contrast to the situation in opposition proceedings, where it was a matter of discretion whether the case was continued following withdrawal of the opposition, withdrawal in appeal proceedings had no direct significance in terms of

procedural law if the opposition division had revoked the European patent. In this case, the board of appeal had 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 p. 329).

2.6 Surrender or lapse of a European patent

R. 60(1) provides that if a European patent has lapsed or been surrendered in respect of all the designated states, the opposition proceedings may be continued at the request of the opponent, provided the request is filed within two months of the date on which the EPO notified the opponent of the surrender or lapse.

In **T 73/84** (OJ 1985, 241) the board ruled that the patent proprietor could not terminate the proceedings by telling the EPO that he was surrendering the European patent, since this was not provided for in the EPC. Thus he could only, as far as national law permitted, surrender the patent *vis-à-vis* the national patent offices of the designated contracting states under the relevant national law (**T 196/91**, **T 296/87**, OJ 1990, 195).

In **G 1/90** (OJ 1991, 275) the Enlarged Board observed that while the patent grant procedure clearly provided scope for legal fictions, ie withdrawal of the patent application, a similar interpretation was out of the question in proceedings before the opposition divisions. Once a patent had been granted, the proprietor could no longer surrender it by informing the EPO. At this stage in the proceedings, notices of surrender had to be addressed to the national authorities of the designated contracting states (see **T 73/84**, OJ 1985, 241). The provisions concerning entries in the Register of European Patents illustrated the differences between the grant and opposition procedures. Different ways of ending the proceedings were mentioned only in connection with grant (R. 92(1)(n) - refusal, withdrawal, deemed withdrawal). For opposition proceedings, on the other hand, only the entry of decisions was mentioned (R. 92(1)(r)). A comparison between pre-grant and post-grant procedures thus revealed significant differences. In all procedures following the grant of a European patent, standard procedure was to terminate proceedings by a decision.

In **T 194/88** the board found that R. 60(1) established **no legal obligation** for the EPO to ascertain of its own motion the legal status of a European patent and did not apply in the event of an alleged surrender or lapse of a European patent, unless confirmation thereof had been received by the EPO from the appropriate authorities of all the designated contracting states.

In decision **T 329/88** the board decided that where a European patent had lapsed in all the designated states and the opponent/appellant had not requested continuation of the opposition proceedings, the board of appeal involved had to terminate the appeal proceedings in pursuance of the provisions of R. 60(1), which applied also to appeal proceedings by virtue of R. 66(1) (see **T 762/89**).

According to the established jurisprudence of the boards of appeal a declaration by the patent proprietor to the effect that he is surrendering the patent may be construed as a request for **revocation**. In **T 237/86** (OJ 1988, 261) it was held that where it was made clear to the board of appeal, **whatever the form of words used**, that the appellant and the respondent were in agreement that a patent ought to be revoked, the board could 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, was in this case equivalent to a request that the patent be revoked (see also p. 303 and 330).

3. Admissibility of opposition

3.1 General remarks

Under R. 57, if the opposition is admissible, the opposition division shall notify the proprietor of the patent and invite him to file observations and amendments, where appropriate, within a specific period.

In decision **T 222/85** (OJ 1988, 128), the appellant contended that once the opposition had been declared admissible by means of the communication according to R. 57(1) there was no basis in the EPC for reversing this decision and declaring the opposition inadmissible. However, the board decided that a communication under R. 57(1) indicating the admissibility of an opposition was not a decision of the opposition division, and the sending of such a communication did not prevent the subsequent rejection of the notice of opposition as inadmissible under R. 56(1), for example if the admissibility was challenged by the patent proprietor in the proceedings (see also **T 621/91**).

In decision **T 289/91** (OJ 1994, 649), the board went a stage further. Here the respondent (patentee), although doubtful from the start of the admissibility of the opposition, had not appealed against the opposition division’s finding that the opposition was admissible and did not raise any objection until the appeal proceedings were under way. The board held that, although this 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, eg (as in this case) by reason of the opponent’s non-entitlement. This was because admissibility was an indispensable procedural prerequisite for considering the opposition, and as such had to be established by the EPO of its own motion (see also **T 28/93**).

In **T 541/92** it was ruled that the board of appeal was obliged, by virtue of Art. 101(1), to examine the admissibility of an opposition, even if the patent proprietors had not raised the question of its inadmissibility during either opposition or appeal proceedings.

In **T 199/92** it was held that the board was empowered to raise the issue of admissibility of an opposition if it had **sound reasons** for so doing.

In **T 925/91** (OJ 1995, 469) the appealed decision of the opposition division did not confine itself to rejecting the opposition as inadmissible but, in addition, expressed its opinion on the validity of the patent. The board followed the previous case law of the boards of appeal, according to which an opposition could not be examined as to its substance when it had been declared inadmissible. As soon as an opposition had been **rejected as inadmissible**, the opposition procedure was legally terminated and **substantive examination could not be initiated**. The inadmissibility of an opposition, when finally decided, or an appeal, had the effect of transferring the European patent to the national jurisdiction of the designated states, which then assumed sole responsibility for assessing the patent’s validity with reference to their own legislation. The board therefore came to the conclusion that it was inconsistent with the procedural principle referred to above for the decision rejecting the opposition as inadmissible to consider that opposition’s merits. The board further held that remarks on substantive matters in a decision rejecting the opposition as inadmissible had no legal effect. However such remarks should, on principle, be avoided as a procedural deficiency of this kind could result in legal uncertainty during the national

phase and could disadvantage either the proprietor or the opponent (see also **T 328/87**, OJ 1992, 701).

3.2 Formal requirements

3.2.1 Notice of opposition/opposition period

According to Art. 99(1) notice of opposition must be filed within nine months of the publication of the mention of the grant of the European patent.

A notice of opposition is to be rejected as inadmissible pursuant to R. 56(1) if it does not comply with the provisions of Art. 99(1), R. 1(1) and R. 55(c) or does not provide sufficient identification of the patent opposed, unless these deficiencies have been **remedied** before expiry of the opposition period (**T 925/91**, OJ 1995, 469).

In **T 152/85** (OJ 1987, 191) the board stated that Art. 99(1) provided a nine-month period during which notice of opposition could be filed and the **opposition fee** paid, payment of the fee being essential for filing of the opposition. Until the requirements of Art. 99(1) had been met, a potential opponent was not a party to any proceedings before the EPO.

In **T 193/87** (OJ 1993, 207) the board found that if a notice of opposition was filed in a language of a contracting state other than an official language of the EPO and the **translation** prescribed in Art. 14(4) was not filed in due time, the notice should be deemed not to have been received, and the opposition fee was to be refunded (following **T 323/87**, OJ 1989, 343). Since the opposition had not come into effect, there was no question of examining its admissibility under R. 56(1).

In **T 344/88** the board of appeal considered whether the citing by the opponent of the wrong number for a patent specification contravened R. 55(c), if the **mistake** was not corrected until after expiry of the opposition period. The first patent specification cited by the opponent bore no relation at all to the invention. However, the notice of opposition contained enough detailed information for it to have been possible to identify the actual patent specification intended. The board of appeal allowed the number to be corrected. Given such a detailed submission of facts, it would have been taking formal requirements too far to reject the opposition simply because the wrong number had been given for a cited patent specification. Whether or not the EPO actually effected a correction between receipt of the notice of opposition and expiry of the period of opposition was irrelevant. The sole decisive factor was that the error was recognisable within the period for opposition and that the opposition division was able, on the basis of the description of the citation, to establish the latter's identity beyond all doubt.

In decision **T 438/87** the question addressed was whether a delay in **publication** of the European patent specification could in any way affect calculation of the time limit for filing an opposition. The board of appeal noted 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 opponent had not indicated the title of the invention within the period specified under R. 56(2). The board decided that omission from the notice of opposition of the title of the invention - merely an item of bibliographical data

identifying the contested patent - did not constitute a deficiency within the meaning of R. 56(2), provided that the other particulars available to the EPO were together sufficient to identify easily and beyond doubt the patent being contested by means of an opposition.

3.2.2 Entitlement to file an opposition

In **G 9/93** (OJ 1994, 891) the Enlarged Board overturned the decision in **G 1/84** (OJ 1985, 299) by holding that the **patent proprietor** was not covered by the term “any person” in Art. 99(1) and was therefore **not entitled** to oppose his own patent under that provision. The ruling on this matter in **G 1/84** could thus no longer be followed.

In **G 1/84** the Enlarged Board ruled furthermore that the motives of the opponent were in principle irrelevant (otherwise, no doubt, the phrase “any person” would have been rendered as “any person interested”).

In **T 635/88** (OJ 1993, 608) the board found that the EPC did not require any particular **interest** to start opposition proceedings and that a firm was also legally entitled to file an opposition in its own name. A firm was a “legal person” within the meaning of Art. 99(1), which states that “any person may give notice ... of opposition”, and did not need to be represented by a professional representative.

In **T 10/82** (OJ 1983, 407) a professional representative was held not to be entitled to give notice of opposition in his own name, if he was in fact acting for a client (confirmed in **T 635/88**).

3.2.3 Identifiability of opponent

In **T 25/85** (OJ 1986, 81) the board held that if the identity of an opponent had not been established before expiry of the period allowed for opposition, the opposition was inadmissible.

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

In **T 289/91** (OJ 1994, 649) the board confirmed **T 635/88** (OJ 1993, 608) by holding that a statutory declaration that the opponent was acting on his own behalf could only be required if there were concrete grounds for casting serious doubt on the opponent’s true identity. Serious doubts as to the opponent’s true identity were not justified by the mere fact that the opponent did not have any obvious personal or economic interest in the subject-matter of the patent.

In **T 548/91** the respondent had contended that one appellant’s identity as a true opponent was in doubt. In support of this contention and its request for a sworn statement from the appellant to resolve the identity issue, the respondent invoked a lack of interest, referring *inter alia* to the appellant’s personal circumstances, such as technical and professional background and age. The board, concurring with the finding of **T 289/91**, held that, as a minimum requirement, the objecting party requesting a sworn statement ought to submit concrete reasons for its suspicion that the opponent was in fact acting on behalf of a particular third party. The board went on to note that under Art. 99 there was a

presumption that any person who submitted an opposition was also acting on his own behalf.

In case **T 590/93** (OJ 1995, 337) the board held that evidence relating to an opponent's personal circumstances was insufficient, in itself, to undermine the credibility of his stated identity under R. 55(a). This identity could only be challenged by cogent evidence that another legal/natural person was the true opponent. The opposition against the patent in this case had been filed by an **employee**, but not a "Rechtsanwalt" (fully qualified lawyer), in a firm of law and tax consultants. In reaching its decision, the board stated that it followed from the expression "any person" used in Art. 99(1) that the EPO was fully entitled to take declarations of identity at their face value and was not obliged to make enquiries into an opponent's real identity by questioning the veracity of his declaration and statements under R. 55(a) in combination with R. 26(2)(c) **merely** on the basis of doubts or suspicions about the veracity of the opponent's actual declared identity. If, however, the veracity of the statements of identity was challenged on the basis of **cogent evidence**, an invitation to the named opponent to provide evidence as to his "true identity", for example by a sworn statement, could be justified.

3.2.4 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 was in a contracting state if the notice of opposition was signed by a person who was 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 ought to be judged as if the signature were missing, and thus assumed that the **deficiency** was remediable. The opponent made up for the missing correct signature at the EPO's invitation within the time limit laid down. The document thus retained the original date of receipt in accordance with R. 36(3), third sentence.

3.3 Substantiation of the grounds of opposition

3.3.1 General remarks

Under R. 55(c) the notice of opposition must contain three items: a statement of (1) the extent to which the European patent is opposed and (2) of the grounds on which the opposition is based as well as (3) an indication of the facts, evidence and arguments presented in support of these grounds. Such "indication of the facts, evidence and arguments" in support of the stated grounds of opposition is often referred to as the "substantiation" of the grounds of opposition. Several decisions have considered, in particular, this third requirement, 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 was only satisfied if the contents of the notice of opposition were **sufficient** for the opponent's case to be **properly understood** on an objective basis. The board reasoned that the purpose of requirement (3) of R. 55(c) (in combination with requirements (1) and (2)) was to ensure that the notice of opposition set out the opponent's case sufficiently so that both the patentee and the opposition division knew what that case was. Requirement (3) of R. 55(c) in combination with Art. 99(1) was **substantive** in nature and called for reasoning which went into the merits of the opponent's case. A well-drafted opposition ought to

contain reasoning that was full but concise. And in general, the less reasoning that a notice of opposition contained, the greater the risk that it would be rejected as inadmissible. The board held that the question whether a particular notice of opposition met the minimum substantive requirements of Art. 99(1) and R. 55(c) could only be decided in the context of each individual case (since various relevant factors, such as the complexity of the issues raised, varied from case to case). The board further pointed out that the **sufficiency** of the notice of opposition in this respect had to be distinguished from the **strength** of the opponent's case. On the one hand, an unconvincing ground of opposition might have been clearly presented and argued. Conversely, a deficient submission might be rejected as inadmissible even though, if properly drafted, it would have succeeded (**T 2/89**, OJ 1991, 51).

In **T 925/91** (OJ 1995, 469) following decision **T 222/85**, the board observed that the requirement of R. 55(c) would only be satisfied, if there was sufficient indication of the relevant facts, evidence and arguments (ie relevant to the extent to which the patent was opposed) for the reasoning and merits of the opponent's case in relation to the grounds of opposition relied upon to be properly understood by the opposition division and the patentee. This had to be **assessed on an objective basis**, from the point of view of a reasonably **skilled person** in the art to which the opposed patent related.

In **T 621/91** the board again observed that whereas R. 55(a) and (b) could be considered as **formal** in nature, R. 55(c) was **substantive** in nature, and called for reasoning which went into the merits of the opponent's case. Whether a particular notice of opposition met the minimum substantive requirements of Art. 99(1) and R. 55(c) could only be decided in the context of each individual case.

In **T 1019/92** the board stated that the question of whether a notice of opposition fulfilled the requirement of R. 55(c) was an objective one which had to be judged at the date of filing or (if the notice was amended) at the expiry of the nine-month opposition period. The board emphasised that even if, as in this case, an opponent subsequently relied upon prior art material not mentioned in the notice of opposition to support its line of argument, this could not render that notice of opposition inadmissible if at the **relevant date** it complied on an objective basis with the requirement stated above.

In **T 234/86** (OJ 1989, 79) the board found that the EPC nowhere required that an argument brought in support of opposition had to be conclusive in itself for the opposition to be admissible. The board went on to say that considering the evidence - which in this case involved determining whether the documents adduced actually established the facts as maintained - was part of the process of ascertaining whether the opposition was well founded in substance. Under Art. 101(1), this could only be done if it had already been determined that the opposition was admissible (see also **T 453/87** and **T 2/89**, OJ 1991, 51).

In **T 199/92** the board noted that the term "indication" in R. 55(c), according to established case law, meant that a patentee had to be able to understand, without undue burden, the case that was being made against his patent in the notice of opposition. This requirement did not, however, exclude the possibility that a patentee might have to undertake **a certain amount of interpretation**. The board was prepared to accept that in this case, on the balance of probabilities, the respondent could readily have understood the precise nature of the opponent's attack on the grounds of obviousness against the claims as granted.

In **T 204/91** the board stated that the term "indication" in R. 55(c) had to be construed as requiring more than **a mere hint** at a number of possible attacks upon the patent and at the likely support for each such possible attack, which indication (or hint) might then be

augmented by the subsequent late filing, possibly even at the appeal stage, of further evidence, arguments or other matter - even of fresh grounds of objection. Rather, the scope and depth of "indication" needed to be such as to enable the patentee and the opposition division to see clearly just what attack was being mounted against the patent, and what evidential support was being adduced for that attack. In other words, the patentee and the opposition division had to be put in a position of understanding clearly the nature of the objection submitted as well as the evidence and arguments in its support. This required the elaboration of the relevant circumstances of the case to such an extent that the patentee and the opposition division were able to form a definitive opinion on **at least one ground** of opposition raised, without the need to make further investigations (see **T 453/87**, **T 279/88**).

In **T 182/89** (OJ 1991, 391) the board held that in order to establish insufficiency, a mere statement by an opponent that one example in a patent had been repeated once "exactly as described" without obtaining exactly the described results as set out and claimed in the patent was clearly in principle quite inadequate to discharge the burden of proof. Indeed, if a notice of opposition alleged insufficiency under Art. 100(b) as the **sole ground** of opposition, and contained such a **statement** as the only indication of "facts, evidence and arguments" in support of this ground, there would, in the board's view, be good grounds for rejecting such a notice of opposition as inadmissible, on the basis that it contained no sufficient indication of facts and evidence which, **even if subsequently proved**, could provide legal and factual reasons for revoking the patent.

If, as in the present case, a ground of opposition were alleged in the notice of opposition but **not per se properly supported** as required by R. 55(c) within the nine-month period for opposition (in the sense that if it were the only ground of opposition alleged in the notice of opposition, the opposition would be rejected as inadmissible under R. 56(1)), then **that ground** of opposition should be rejected on the same basis as if it were inadmissible under R. 56(1).

The board went on to say that if this course was not followed, the procedure could be easily abused, in that an opponent might allege more than one ground of opposition in his notice of opposition but only support one of these grounds in his notice of opposition; then, at a later stage in the opposition proceedings he might bring forward facts and evidence in support of the other alleged grounds of opposition, causing delay and an increase in costs. In the board's view this should not be allowable: R. 55(c) in conjunction with R. 56(1) clearly required that **every ground** of opposition alleged in the notice of opposition be supported by "facts, evidence and arguments" within the nine-month opposition period and the notice of opposition (at least to the extent that R. 55(c) had not been complied with) be rejected as inadmissible if this had not been done.

Several decisions then considered in greater detail what constitutes **sufficient substantiation** in the notice of opposition.

In **T 134/88** the opposition did not deal with all the features of the contested claim, but still satisfied 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 was generally inadmissible if it related only to the assessment of one individual feature: to be admissible, it would have to deal with the invention as a whole, or at least with its **essential** content, so that when the facts on which the opposition was based were indicated, circumstances became recognisable which enabled the patent proprietor and the assessing body to pass conclusive judgment on the asserted grounds for opposition without having to make enquiries of their own.

In **T 185/88** (OJ 1990, 451), the board of appeal ruled that grounds for opposition were in due form if the only document cited in support of the sole assertion of lack of inventive step (in this case a German patent specification), while actually published **after** the date of filing or priority, nevertheless contained a reference to a publication known **before** the date of filing or priority (in this case a German unexamined application or “Offenlegungsschrift”).

In **T 533/94** and **T 534/94** the correlation between the individual features of the claimed invention and the relevant passages of the prior art documents in the notice of opposition had been made in the form of tables and it had not been explicitly indicated what particular statements therein were alleged to destroy the novelty of the invention or form a basis for an argument on obviousness. The board found that this did not affect the notice’s admissibility. The board observed that a notice of opposition was addressed to the opposition division and the patentee who were not only skilled in the art but also competent in examining novelty and inventive step. Thus, in the board’s judgment, a detailed and exhaustive discussion of matters which were implicit to such skilled persons was not needed to understand the opponent’s case and, therefore, not an admissibility requirement.

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** (above) 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 was not fulfilled if several different subject-matters were described in a document cited as prejudicial to novelty and it was neither stated nor readily discernible which of them incorporated all the features of the contested claim. In this case the objection of lack of inventive step had not indicated the facts, evidence and arguments. A general reference to all publications cited in the European search report was not enough if it was neither stated nor readily discernible which document was being presented in support of which argument.

The board came to a similar decision in **T 204/91** (see above). 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 in support of both the grounds of opposition invoked 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 had to answer.

In **T 545/91** the board of appeal followed the case law established in **T 448/89** (OJ 1992, 361) and **T 222/85** (OJ 1988, 128). The opposition was rejected as inadmissible since the submitted document relied upon contained 200 pages and the notice of opposition made no specific reference to any of its passages. Even if the opponent’s contention were correct that an expert would immediately find the relevant chapter in the index, the board held that further clarification was necessary as this chapter was 86 pages long and contained subjects not directly related to each other.

In decision **T 550/88** (OJ 1992, 117) the board of appeal considered whether **national prior rights** could as a matter of law constitute “facts or evidence” relevant to the ground of lack of novelty under Art. 54(1) and (3). If not, such facts and evidence did not support the ground of opposition which had been alleged and therefore did not satisfy the requirement of R. 55(c). In the board’s judgment, on the proper interpretation of Art. 54(3), national prior rights were not comprised in the state of the art, and only prior

European patent applications filed under the EPC could 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.

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 was based on prior use, the notice of opposition, in order to satisfy R. 55(c), had to indicate within the opposition period all facts which permitted 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 had to be put on file within this time limit (see also **T 28/93**).

In **T 93/89** (OJ 1992, 718) the board found that if an alleged prior public use was not adequately substantiated, it was immaterial and, if not submitted in due time, could be disregarded under Art. 114(2). The board decided that prior public use was adequately substantiated only if sufficiently specific details had been given of what had been made available to the public where, when, how and by whom. An adequate submission therefore had to contain details of the manner, place and time of the alleged use with a specific description of the subject-matter and particulars of its availability to the public with the possibility of subsequent use by other experts. The indication that the period of prior use was, for example, "as long ago as 1979" was so vague that it did not qualify as a clear statement of the time of the prior use (**T 300/86**, **T 194/86**).

In **T 538/88**, the board stressed that a difference had to 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.

In **T 129/88** (OJ 1993, 598) the board noted that although a board of appeal had an obligation under Art. 114(1) to investigate matters of its own motion, that obligation did not extend as far as investigating an allegation of public prior use, where the party previously making that allegation had withdrawn from proceedings and it was difficult to establish all the relevant facts without that party's co-operation. The reason for this was that the obligation to investigate of its own motion imposed on the EPO by Art. 114(1) 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. Legal and factual framework of opposition

4.1 Introduction

In decisions **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board stated that a post-grant opposition procedure could 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 appeared from Art. 99 in conjunction with R. 55(c), the notice of opposition had, *inter alia*, to 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 thus considered that the core of the matter in the cases before it was whether the statement of the opponent under R. 55(c) limited the power and obligation of the EPO in its examination of the case or whether such examination could 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.

The Enlarged Board held that R. 55(c) only made sense when interpreted as having the **double function** of governing (together with other provisions) the **admissibility** of the opposition and of simultaneously establishing **the legal and factual framework**, within which the substantive examination of the opposition was in principle to be conducted.

The **legal framework** of an opposition case is defined solely by (i) the extent to which a patent is actually opposed and (ii) the grounds upon which it is opposed, whilst its **factual framework** is determined by the facts, evidence and arguments adduced and set out in the notice of opposition pursuant to R. 55(c). It is thus self-evident that neither grounds not actually supported by such facts, evidence and arguments, nor claims not actually opposed (as distinct from being merely formally mentioned in the notice of opposition) can be properly regarded as making up the "legal and factual framework" of the opposition (**T 737/92**).

A distinction has to be made between the two main requirements of R. 55(c), *ie* the indication of the extent to which the European patent is opposed and the grounds for opposition.

4.2 Extent to which the European patent is opposed

Art. 99(1) provides *inter alia* that "notice of opposition shall be filed in a written reasoned statement". R. 55(c) requires the notice of opposition to contain, *inter alia*, "a statement of the extent to which the European patent is opposed". Opposition proceedings constitute an exception to the general rule under the EPC that a European patent after grant is no longer within the competence of the EPO but becomes a bundle of patents within the jurisdiction of the designated contracting states. Opposition proceedings are an exceptional procedure whereby, during a limited period of time, a centralised action for revocation of a European patent may be brought before and decided by the EPO. With this background in mind, the board in **T 9/87** (OJ 1989, 438) held that an opponent's statement

pursuant to R. 55(c) of “the extent to which the European patent is opposed”, in combination with the grounds of opposition, provided a definition of the issues raised by the opposition and, therefore, of the extent of competence of the EPO in relation to the examination of the opposed European patent under Art. 101.

The case law of the boards of appeal had for some time been divided on the extent to which the opposition division (or, under R. 66(1), a board of appeal) could examine the patent in accordance with Arts. 101 and 102. Some boards had advocated that examination be restricted to the contested claims (eg **T 9/87**, **T 192/88**). Others had favoured unrestricted examination of the grounds for opposition and the claims in accordance with Art. 114(1) (eg **T 156/84** (OJ 1988, 372), **T 266/87**, **T 197/88** (OJ 1989, 412), **T 493/88** (OJ 1994, 380), **T 392/89**).

In **G 9/91** and **G 10/91** the Enlarged Board pointed out that it was rather unusual for the opposition to be limited to only a certain part of the patent. If, however, this was 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 was opposed. It was further stated that neither the opposition division nor a board of appeal had the obligation or power to examine and decide on the maintenance of a European patent except to the extent to which it was opposed.

The Enlarged Board held that the requirement of R. 55(c) to specify the extent to which the patent was 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 was therefore not subject to any “opposition”, nor were there any “proceedings” in the sense of Arts. 114 and 115 in existence concerning the non-opposed subject-matter. Consequently, the EPO had no competence to deal with them at all (see **T 443/93**).

However, the subject-matter of claims depending on an independent claim, which had fallen in opposition or appeal proceedings could be examined as to patentability even if it had not been explicitly opposed, provided its validity was *prima facie* in doubt on the basis of information already available.

The possible effect of **G 9/91** on the practice of the boards of appeal was discussed in **T 376/90** (OJ 1994, 906). As regards the requirement of R. 56(1) in conjunction with R. 55(c) that the notice of opposition contain a statement of the extent to which the European patent is opposed, the board proceeded on the accepted principle that statements were to be interpreted in the way that an addressee would understand them taking into account the surrounding circumstances (following **T 1/88**). However, the board added that, although it had been the general practice where patents were opposed without an explicit statement of the extent to which they were opposed, to interpret the absence of such a statement as an indication of the opponent’s intention to oppose the patent concerned in its entirety, the continuance of this practice appeared questionable in the light of **G 9/91**. Indeed, in the extreme case where the extent to which a patent was opposed was in serious doubt, this might lead to a rejection of the opposition as inadmissible.

In **T 1019/92** the requirement of R. 55(c) that the notice of opposition state the extent to which the patent is opposed under R. 55(c) was found to be met by an explicit request that the patent be revoked in its entirety. The board held that, in these circumstances, if an opponent requested revocation of the patent in its entirety, then the fact that no specific prior art material had been cited against a dependent claim did not exclude that claim from the opposition.

4.3 Grounds on which the opposition is based

In **G 10/91** (OJ 1993, 420) the Enlarged Board of Appeal turned to the second main requirement of the statement under R. 55(c), ie the indication of the grounds on which the opposition is based. Here the question referred was whether the opposition division, in the examination of the opposition, was 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.

The Enlarged Board noted that the problems here differed from those related to the first main requirement in that in the case of the extent to which the patent was opposed, it was a question of the formal competence of an opposition division or a board of appeal to deal with a non-opposed part, whilst the problems connected with the grounds for opposition were more concerned with the procedural principles to be applied where the European patent or part of it had been correctly opposed.

The Enlarged Board stated that Art 114(1) was **no** legal basis for an **obligatory** review of grounds for opposition not covered by the statement pursuant to R. 55(c). The board then went on to consider whether Art. 114(1) actually **empowered** the opposition division or board of appeal to investigate such grounds at all. As far as the opposition division was concerned, the Enlarged Board held that an **opposition division** could, 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 were clear reasons to believe that such grounds were relevant and would in whole or in part prejudice the maintenance of the European patent.

The Enlarged Board thus held in **G 10/91** that an opposition division or a board of appeal was 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 could, 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.

In appeal proceedings fresh grounds for opposition may be considered only with the approval of the patentee (see p.323).

In **T 986/93** (OJ 1996, 215) the board made it clear, firstly, that if an opposition division chose to disregard belated submissions concerning a new ground of opposition, this could not detract from the fact that the ground had been relied upon, ie introduced, during the opposition proceedings. Secondly, the procedural decision of an opposition division to disregard submissions formed an essential element of its decision-making process and as such was one of the issues subject to review if the final decision of the opposition division was challenged on its merits. The board stated that although it was reluctant to interfere with a discretionary decision of an opposition division pursuant to Art. 114(2), it would do so where necessary and appropriate (see **T 122/84**, OJ 1987, 177). The board held that the boards of appeal were not barred from considering a belatedly submitted ground of opposition which had been disregarded by the opposition division pursuant to Art. 114(2) if they were of the opinion that the opposition division had exercised its discretion in this respect wrongly.

In **T 796/90** the opponent had filed a notice of opposition alleging lack of inventive step. The issue of lack of novelty was not raised until the appeal proceedings. As inventive step and novelty were both grounds for opposition covered by Art. 100(a), the board held that it was nonetheless entitled to consider novelty in accordance with Art. 114(1).

A recent referral to the Enlarged Board of Appeal in **T 937/91** (OJ 1996, 25) questions whether in a case where a patent has been opposed on the basis of Art. 100(a), but the opposition has only been substantiated on the grounds of lack of novelty and inventive step pursuant to Arts. 54 and 56, a board of appeal can of its own motion introduce into the proceedings the ground that the subject-matter of the claims does not meet the conditions of Art. 52(2). This case is pending under **G 1/95**.

In **T 514/92** (OJ 1996, 270) the board considered the definition of the legal concept “**grounds for opposition**” to be an important point of law (Art. 112(1)) justifying reference of the following question to the Enlarged Board: “In the case where a patent has been opposed under Art. 100(a), on the basis that the claims lack an inventive step in view of documents cited in the opposition statement, and the opponent introduces during appeal proceedings a new allegation that the claims lack novelty in view of one of the documents previously cited or in view of a document introduced during the appeal proceedings, must a board of appeal exclude the new allegation because it introduces a new ground of opposition?”. This case is pending under **G 7/95**.

4.4 Late-filed new facts, evidence and arguments

In **T 1002/92** (OJ 1995, 605) the board stated that when considering the admissibility of a further ground of opposition not covered by the notice of opposition after expiry of the opposition period, both before an opposition division and before a board of appeal, the Enlarged Board was necessarily implicitly considering the admissibility of such a **fresh ground** in combination with at least an indication of the fresh “facts, evidence and argument” intended to support it. The mere stating of a fresh ground without any indication of the fresh facts, evidence and argument supporting it would obviously be inadmissible, either within or after expiry of the opposition period. It would be illogical to have one criterion for the admissibility of late-filed **new** facts, evidence and argument in combination with a fresh ground, and a different criterion for judging the admissibility of late-filed new facts, evidence and arguments in support of a ground of opposition already covered by the opposition statement.

Hence, in the board’s view, it followed that the principles set out by the Enlarged Board as underlying the admissibility of fresh grounds of opposition, were also generally applicable to the admissibility of late-filed new “facts, evidence and arguments” intended to support grounds of opposition already covered by the opposition statement (see p. 224).

5. Admissibility of amendments

5.1 General remarks

For the opposition procedure, the Implementing Regulations previously lacked a clear corollary to R. 86 (amendment of the European patent application) governing the proprietor’s right to amend his patent.

The new R. 57a now provides that without prejudice to R. 87, the description, claims and drawings may be amended, provided that the amendments are occasioned by grounds for opposition specified in Art. 100, even if the respective ground has not been invoked by the opponent.

The amendment entered into force on 1.6.1995 and applies to all proceedings pending on that date (see OJ 1995, 409).

So far, boards of appeal have allowed amendments only where occasioned by a ground for opposition actually relied upon by the opponent (see Case Law of the Boards of Appeal of the European Patent Office 1987-1992, page 140). The new rule extends the possibilities of amending the patent.

Under new R. 57a, any amendments made in opposition proceedings must be occasioned by the grounds for opposition specified in Art. 100. That is to say, amendments can be allowed only if they are required in order to meet a ground for opposition. It is not necessary, however, for the ground for opposition in question actually to be invoked by the opponent. For example, in opposition proceedings admissibly brought on the grounds of non-patentability, the patent proprietor can also submit amendments to remove added subject-matter (Guidelines D-IV, 5.3).

Hitherto, amendments in opposition proceedings which were proposed only in view of the existence of national prior rights were not allowable (**T 550/88**, OJ 1992, 117). Under the new rule, amendments occasioned by national prior rights - which are not included in the grounds for opposition specified in Art. 100 - are also admissible during opposition proceedings. The reference to R. 87, which as a general provision of the EPC also applies to opposition proceedings, makes this absolutely clear.

New R. 57a creates a *lex specialis* for amendments during opposition proceedings. It addresses the purely substantive aspects of the proprietor's entitlement to amend his patent, and does not specify the point in time up to which amendment is allowed: here existing practice remains unchanged. Its restriction of the right to amend is in line with the object and purpose of opposition proceedings, and does away with the need for a discretionary provision like R. 86(3) (see Notice dated 1.6.1995 concerning amendment of the EPC, the Implementing Regulations and the Rules relating to Fees, OJ 1995, 409).

5.2 Lack of clarity - clarification of ambiguities in the granted patent

The introduction of R. 57a does not affect other legal aspects set out by the boards of appeal in previous decisions.

In **T 127/85** (OJ 1989, 271) the board of appeal held that it would be an abuse of opposition proceedings if the patent proprietor were allowed merely to tidy up and improve his disclosure by amendments not specifically necessitated by the grounds advanced for the opposition, even if those amendments were to comply with Art. 123. This applied equally to amendments during opposition proceedings intended merely to clarify ambiguities in the claims or description. The board went on to state that objections to clarity of claims or any consequent requests for amendment were only relevant to opposition proceedings insofar as they could influence the decisions on issues under Art. 100 or arose in relation to matter to be amended in consequence of such issues (see **T 406/86**, OJ 1989, 302; **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, the claims could be more widely construed than a court would have construed them by the application of Art. 69.

However, the board was of the opinion that the removal of an inconsistency between a claim and the description should be allowed if the inconsistency arose from an error, provided that the error was so obvious to a skilled person in the light of the patent specification as a whole, that an interested third party could have anticipated the extent of protection conferred by the amended claim. In these circumstances the request for the correction of an error did not represent an abuse of opposition proceedings. Moreover, the removal of the discrepancy was in the interest of legal certainty.

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** (OJ 1992, 212), **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 p. 139).

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 were to be used to interpret the claims also applied to opposition proceedings when the meaning of a claim had to be objectively determined to assess the novelty and inventiveness of its subject-matter.

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**).

It is 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 was an EPC requirement concerning patent applications which, although it had to be taken into account in opposition proceedings whenever the patent proprietor made any amendments, was not a ground of opposition itself under Art. 100. The board explained that opposition proceedings were not a continuation of the examination proceedings involving third parties, but, like revocation proceedings, served as a substantive legal test of whether the patent still stood in the light of facts emerging after it had been granted.

6. Examination of amendments

Where amendments are requested by a patentee in the course of opposition proceedings, Art. 102(3) confers jurisdiction upon the opposition division as well as the boards of appeal, and thus the power to consider the whole of the EPC (**T 472/88**). This jurisdiction is thus wider than that conferred by Art. 102(1) and (2), which expressly limits jurisdiction to the grounds of opposition mentioned in Art. 100. When substantive amendments are made to a patent, both instances have the power to deal with grounds and issues arising from those amendments even if they were not (and could not be) specifically raised by an opponent pursuant to R. 55(c) (**T 227/88**, OJ 1990, 292).

In **T 301/87** (OJ 1990, 335) the board held that when amendments were made to a patent during an opposition, Art. 102(3) required them to be examined to ascertain if the EPC, including Art. 84, was contravened as a result. However, Art. 102(3) did not allow objections to be based upon Art. 84 if they did not arise out of the amendments made. It

would be somewhat absurd if making a minor amendment could enable objections outside Art. 100 to be raised which had no connection with the amendment itself.

In **T 472/88** the board took the view that an amendment wholly unconnected with eg an Art. 84 issue, could not, by its mere existence, legitimately invoke the operation of that article in either appeal or opposition proceedings. On the other hand, an amendment directly giving rise to an ambiguity under Art. 84 would need to be dealt with by the board.

7. Admissibility of observations by the parties

Art. 101(2) provides that the opposition division “shall invite the parties, as often as necessary, to file observations” on communications from another party or the opposition division itself.

In **T 295/87** (OJ 1990, 470) the board noted that R. 57(1) and (2) was concerned with the initial stage of opposition proceedings, immediately following the filing of the notice(s) of opposition, and clearly provided the patentee with an opportunity as of right to file observations in reply to such notice(s) of opposition. Thereafter, however, by way of contrast, R. 57(3) emphasised that following communication of the patentee’s observations (and any amendments) to the other parties, the latter were to be invited by the opposition division to reply to the observations only “if it considers it expedient”. Although Art. 101(2) and R. 57 specifically refer only to the criteria which the opposition division should use when considering whether to invite the filing of observations, it was in the board’s view clearly and necessarily implicit in these provisions that, in the absence of an express invitation from the opposition division, the parties could only file observations if the opposition division, after exercising due discretion, considered them to be “necessary” or “expedient”. The board’s view was that it would make a nonsense of these provisions to interpret them as providing that the parties could file observations as a matter of right even when they were neither necessary nor expedient (see **T 406/86**, OJ 1989, 302).

The board went on to state that it was clearly most desirable in the interests of the smooth and efficient conduct of opposition proceedings, and thus also in the public interest, that observations by parties be properly limited to what was necessary and expedient. This in turn required the exercise of a proper control by the opposition division (and, *mutatis mutandis*, by a board of appeal) over the admissibility of observations by parties as well as of documents filed in support of such observations. Of course, the extent to which further observations from parties were necessary or expedient depended upon various factors, including the complexity of the issues raised, and could only be decided in the context of each individual case. Nevertheless, it ought to be recognised that, in appropriate cases, both the opposition division and the boards of appeal had the power, and indeed the duty, to refuse to admit observations and/or supporting documents for consideration in the opposition and appeal respectively in the exercise of their discretion under Arts. 101(2) and 114(2) and R. 57(3).

The board drew attention to the statement of “General Principles” applying to opposition procedure contained in the Information from the European Patent Office published in OJ 1985, 272, which it endorsed: “The EPO’s aim is to establish as rapidly as possible, in the interests of both the public and the parties to the opposition proceedings, whether or not the patent may be maintained given the opponent’s submissions. It seeks to achieve this by means of a speedy and streamlined procedure, which implies firm control by the opposition division at all stages. This requirement must however be balanced against the

need to allow the parties to present their cases adequately so that the correct decision can be made."

Further legal aspects on the opportunity to file observations in opposition proceedings are dealt with in the chapter "Right to be heard in opposition proceedings" (see p. 282).

8. 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 had arisen in **T 220/89** (OJ 1992, 295), where the appellant (opponent) had 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.

9. Decision of opposition division

9.1 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). Other boards' decisions, on which the revocation by decision was based, had not considered this alternative, namely automatic loss of rights.

The President of the EPO took the matter up under Art. 112(1)(b). In **G 1/90** (OJ 1991, 275) the Enlarged Board of Appeal stated that the revocation of a patent under Art. 102(4) and (5) **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. It found that the procedure of pronouncing revocation by decision led 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 was not preceded by such a communication. If the EPC had laid down different provisions for grant and opposition, that did not constitute an inherent contradiction.

9.2 Revocation on request of the proprietor

Art. 102(1) states that if the opposition division is of the opinion that the grounds for opposition mentioned in Art. 100 prejudice the maintenance of the European patent, it shall revoke the patent.

In **T 73/84** (OJ 1985, 241) the board held that if the proprietor of a European patent stated in opposition or appeal proceedings that he no longer approved the text in which the patent had been granted and would not be submitting an amended text, the patent was to be revoked. In the board's view, since the text of the patent was up to the patent proprietor, a patent could not be maintained against the proprietor's will. If the patent proprietor withdrew his approval, expressed before the department of first instance, of the text of the patent as granted and declared that he would not be submitting an amended text, it could be inferred that he wished to prevent any text whatever of the patent from being maintained. However, the patent proprietor could not terminate the proceedings by telling the EPO that he was surrendering the European patent, since this was not provided for in the EPC. Thus he would only be 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. At the same time, the proceedings ought to be terminated as quickly as possible in the interests of legal certainty, which called for a clarification of the situation with regard to industrial rights. The only possibility in such a case was to revoke the patent, as envisaged for other reasons in Art. 102. The practice already followed by the opposition divisions was thus confirmed.

In **T 186/84** (OJ 1986, 79) the board held that if in opposition proceedings the proprietor of a patent requested that his patent be revoked, it was to be revoked without substantive examination of the impediments to patentability. In **T 459/88** (OJ 1990, 425) it was further stated that it was not in the public interest to maintain a patent against the patent proprietor's will (**T 237/86**, OJ 1988, 261) (see p.287).

9.3 Interlocutory decisions

In **T 152/82** (OJ 1984, 301) the board held that as Art. 110(1) and R. 65 showed, the board of appeal had to examine whether the appeal was admissible before beginning with the substantive examination. Where an appeal was inadmissible, the relevant ruling was given in a final decision but when it was admissible, the ruling could be given in an interlocutory decision establishing the position. As no binding decision on admissibility was taken with the mere transition from examination for admissibility to substantive examination, establishing admissibility in an interlocutory decision could be justified in certain cases. An interlocutory decision could also be appropriate, as in this case, because the points of law concerning admissibility were of general significance and required a speedy decision.

In **T 376/90** (OJ 1994, 906) the first question to be decided was whether the opposition was admissible, and whether it was correct for the preliminary decision on this point to be made appealable only together with the final decision. As to the latter point, the opposition division decided on the admissibility in an interlocutory decision within the meaning of Art. 106(3), ie a decision which did not terminate the proceedings as regards one of the parties. In the board's view, according to the clear language of that provision, such an interlocutory decision could only be appealed together with the final decision, unless the decision allowed separate appeal. Whether to allow a separate appeal was within the discretion of the opposition division. The board held that this discretion under Art. 106(3) was properly exercised by the opposition division with a view to enabling a decision on the substantive issues to be reached as soon as possible.

9.4 Maintenance of the European patent as amended

The long-established practice of the EPO of delivering interlocutory decisions subject to appeal when a patent is maintained as amended was described in detail by the Enlarged Board of Appeal in **G 1/88** (OJ 1989, 189).

According to Art. 102(1) to (3) a decision on an opposition to a European patent can involve revocation of the patent, rejection of the opposition or maintenance of the patent as amended, the latter requiring the publication of a new European patent specification. Under Art. 102(3)(b) a prerequisite for maintenance of the patent as amended is that the printing fee be paid. The request for payment of the fee may, under Art. 65(1), signal the start of the time limit for filing translations in the contracting states.

With these regulations in mind, the EPO very early on adopted the device of an **interlocutory decision**, for which there is no express provision, in order to establish in the first place the text of the amended specification. Only after this interlocutory decision has come into force are the fee for printing and a translation of the claims in the other official languages requested pursuant to R. 58(5). Once these requirements have been fulfilled what is then a non-appealable final decision on maintenance of the patent as amended is given and the new patent specification is published.

A decision to maintain the European patent - even an interlocutory decision - can of course only be given if there is a text "submitted or agreed" by the patent proprietor pursuant to Art. 113(2). In that connection Art. 102(3)(a) states that it must be established, "in accordance with the provisions of the Implementing Regulations", that the patent proprietor approves the text. It has accordingly been standard practice for the EPO's opposition divisions always to proceed in accordance with the relevant R. 58(4), even where the text has already been "submitted or agreed" by the patent proprietor during the proceedings and rejected by the opponent.

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 observed that the EPC contained no general rules as to when an interlocutory decision could or should be delivered. The relevant department therefore had to use its discretion in judging whether an interlocutory decision was appropriate in an individual case or whether the matter could only be settled in a decision terminating proceedings. This involved weighing up various considerations such as whether an interlocutory decision would accelerate or simplify the proceedings as a whole (clarifying a disputed question of priority, for example, could be of key importance for the form and length of the subsequent proceedings) and clearly also included the issue of costs. In the board's view, it was clear that the practice adopted early on by the EPO of delivering appealable interlocutory decisions where a patent was maintained as amended was based on the weighing up of such cost aspects. The board concluded that the EPO's established practice of delivering appealable interlocutory decisions under Art. 106(3) to maintain a patent as amended was both formally and substantively acceptable.

In **T 390/86** (OJ 1989, 30) the board held that Art. 102(3) and R. 58(4) did not preclude that an opposition division could, in the course of opposition proceedings, make a (final) interlocutory decision in respect of a substantive issue raised by the opposition, before the sending of any R. 58(4) communication. What was precluded by R. 58(4) was that the opposition division should "decide on the maintenance of the European patent" in an amended form without first informing the parties of the amended text in which it was intended to maintain the patent and inviting their observations. However, neither Art. 102(3) nor R. 58(4) precluded an opposition division from giving **decisions on substantive issues** in the opposition before sending a communication under R. 58(4), and before "deciding to maintain the patent in amended form". For example, an opposition division could during the course of an opposition make a (final) interlocutory decision (either orally or in writing) that a particular proposed amendment contravened Art. 123. Similarly, in the board's view, an opposition division could make a (final) interlocutory decision during the course of an opposition that the main claim, for example, of the opposed patent could not be maintained. Such a **substantive interlocutory decision** was not a decision actually to maintain the patent in amended form, but was preliminary to such a decision. The making of such substantive interlocutory decisions during the course of opposition proceedings was desirable both in order to move the proceedings forward towards a conclusion, and, in appropriate cases as envisaged in Art. 106(3), to allow a party to appeal such an interlocutory decision before the opposition proceedings were terminated. It was further held that in a case where a final substantive decision had been given, an opposition division had no power thereafter to continue examination of the opposition in relation to the issues which were the subject of that decision, either under R. 58(5) or at all. Further submissions from the parties relating to such issues were inadmissible.

10. Apportionment of costs

10.1 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.

10.2 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**, **T 719/93**).

10.3 Equity of apportionment of costs

There is no definition of equity in the EPC. In a number of decisions (see, for example, **T 765/89**, **T 26/92** and **T 432/92**) it has generally been stated that apportionment of costs is justified if the conduct of one party is not in keeping with the care required, that is if costs arise from culpable actions of an irresponsible or even malicious nature.

The boards of appeal therefore had to develop the criteria determining whether costs were to be apportioned on a case-to-case basis.

An analysis of the decisions of the boards of appeal has shown that the following circumstances typically lead to a request for apportionment of costs:

- (a) late submission of documents and/or requests;
- (b) request for oral proceedings withdrawn or postponement requested;
- (c) appeal or opposition withdrawn;
- (d) one of the parties does not appear at the oral proceedings;
- (e) cases of alleged abuse of procedure.

10.3.1 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 (see however **T 1002/92**, (OJ 1995, 605), p. 299).

a) Late submission not justified

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** (OJ 1983, 407), **T 117/86** (OJ 1989, 401), **T 101/87**, **T 326/87** (OJ 1992, 522), **T 416/87** (OJ 1990, 415), **T 323/89** (OJ 1992, 169), **T 596/89**, **T 622/89**, **T 503/90**, **T 611/90** (OJ 1993, 50), **T 755/90**, **T 110/91**, **T 161/91**, **T 705/92**, **T 867/92** (OJ 1995, 126), **T 719/93**).

However, it should be pointed out that in a large number of cases of unjustified delay, requests for apportionment of costs were refused because there was no proof that higher

costs had been incurred (see, for example, **T 212/88** (OJ 1992, 28), **T 443/90**, **T 582/90**, **T 776/90**).

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 raised 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 bore little relation to those filed in the original opposition, the appellant had produced virtually a new opposition at the appeal stage. This could not, by definition, be the purpose of an appeal. The late filing of documents must have considerably increased the costs incurred by the respondent, compared to what they would have been if all facts and evidence had been filed within the nine-month period. Although the respondent clearly envisaged requesting a decision on costs in the event of oral proceedings only, the abuse of procedure justified the apportionment of costs incurred during the taking of evidence. 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 had 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 867/92** (OJ 1995, 126) the claims had been amended during the opposition proceedings. Eighteen months after the claims had been amended the appellant/opponent cited in the statement of grounds of appeal a new prior art document. The board held that the EPC does not impose a time limit for citing new prior art in response to an amendment of the claims. However, an opponent who cites new prior art with a considerable delay with no special reason justifying the delay runs the risk of having to bear the proprietor's costs incurred in attending oral proceedings which cannot bring the case to an end because of the new citation. However, as there was no suggestion that the appellant/opponent wilfully abused the procedure in the present case, the board considered that the appellant should not have to pay all the costs incurred by the respondent's representative in attending the oral proceedings held before the board, but that it would be equitable to order the appellant to pay half those costs.

In **T 336/86** the appellants submitted a prior patent, which belonged to the respondents for the first time in the appeal proceedings and anticipated the patent in suit. The respondents requested an apportionment of costs as the oral proceedings would not have been necessary had the patent been presented earlier. The board agreed that the late submission was not justified and that higher costs had been incurred as a result. However, as the respondents either had - or should have - been aware of the existence of their own patent, it took the view that an apportionment of costs was not justified.

In **T 297/86** the board refused to apportion costs, saying that the board saw no reason for charging one party's costs to the other party in this case, since (the late-filed document) had been considered by the board pursuant to Art. 114(1), and the late citation could not be considered as an abuse of the appeal proceedings, and since no costs were incurred during the taking of evidence or in oral proceedings.

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. In **T 443/90** one of the reasons why the board refused a request for apportionment of costs was that the party concerned had not substantiated its argument that additional costs had been incurred as a result of the late submission.

(b) Late submission justified

In principle, costs are not apportioned differently if the late submission appears justified. Cases are always assessed individually on their merits. The boards have assumed in particular that belated submission is justified or that no abuse of procedure has taken place if new documents are filed for the first time at a later stage in the proceedings as a reaction to communications from the board, comments from the other party or decisions of the department of first instance which make such documents necessary in the first place (see **T 638/89**, **T 582/88**, **T 765/89**, **T 472/90**, **T 556/90**, **T 334/91**, **T 875/91**, **T 81/92**).

By way of exception, a different apportionment of costs was ordered in a case of justified late submission in **T 847/93**. The statement of grounds of appeal made no substantiated criticism of the reasons for the decision of the opposition division, and relied only on new prior art submitted for the first time in the statement. However, the statement was found to be admissible by the board. Mitigating circumstances for the late filing of new facts and evidence were put forward by the appellants and were held to be credible by the board.

On the other hand, the board was also of the opinion that it was credible that the cost incurred by the respondents were higher as a result of the introduction of an entirely fresh case than if the facts and evidence had not been filed at a late stage. It therefore decided to order an apportionment of costs according to which the appellants had to pay the respondents 50% of the costs incurred by the respondents in respect of the subsequent oral proceedings and taking of evidence before the department of first instance as well as in any subsequent appeal under Art. 104(1).

(c) Late submission unjustified, but not disadvantageous

In a number of cases the board refused a different apportionment of costs despite unjustified late submission because it was of the opinion that the late submission was not disadvantageous to the other party (see **T 336/86**; **T 330/88**; **T 525/88**; **T 534/89** (OJ 1994, 464); **T 737/89**; **T 231/90**; **T 556/90**; **T 876/90**; **T 28/91**; **T 685/91**; **T 875/91**; **T 882/91**; **T 938/91**).

In **T 330/88** the respondents filed a new document two days prior to the oral proceedings. The board took the view that the late filing was unjustified but that an apportionment of costs would not be equitable as the appellants had had sufficient time to deal with the document, especially since the decision was not taken until four months after the oral proceedings and following the opportunity to present comments.

Finally, despite the fact that the late filing was unjustified, the request for apportionment of costs in **T 525/88** was rejected because the documents were of no relevance and did not affect the decision. The same applied in **T 534/89** (OJ 1994, 464) and **T 876/90**.

In **T 882/91** the request for apportionment of costs was refused even though the new documents had been submitted after expiry of the opposition period and the late submission was unjustified. The board did not look into whether the late submission had led to higher costs because it was of the opinion that the other party had not had to spend very much additional time and energy on the documents which had been submitted late and that there was therefore no reason to apportion costs. The same applied in **T 737/89** (very short document), **T 685/91** (no additional work involved in dealing with the new document), **T 556/90** (no additional effort involved in checking new document, remittal not necessary), **T 231/90** (drawings easy to check), and **T 875/91** (checking not difficult).

In **T 28/91** three documents which had already been submitted to the opposition division were re-submitted at a later stage in the appeal proceedings. The board ruled that the late submission was not disadvantageous as no new arguments had been introduced, and therefore no additional work had been necessary.

In **T 938/91** an alleged prior public use was filed for the first time, with drawings pertaining thereto, together with the statement of grounds for appeal. The patentees had requested a different apportionment of costs on the grounds that the complicated drawings required considerable extra effort. The board rejected this request, taking the view that the additional effort involved in studying the drawings would have been necessary even if they had been submitted in good time. No additional costs had therefore been incurred as a result of the late submission.

10.3.2 Request for oral proceedings withdrawn or postponement requested

In **T 154/90** (OJ 1993, 505) the opponents had initially insisted on oral proceedings, although the opposition division did not consider that they were necessary. However,

eight days before the arranged date the opponents informed the opposition division that they wished to cancel the oral proceedings. For reasons of internal organisation at the EPO, the opposition division did not receive this letter until after the date of the oral proceedings. The board of appeal ruled that eight days was a sufficient period of time for the oral proceedings to be cancelled, since, unlike in **T 10/82** (OJ 1983, 407), no evaluation of new facts or arguments was needed. Since the letter was received too late for purely internal reasons, the opponents were not at fault. They were not obliged to bear a part of the costs of the other party. A change of opinion regarding the necessity of oral proceedings could not be regarded as culpable conduct either.

In **T 432/92** postponement of the oral proceedings was requested two days prior to the agreed date as the father of the respondents' representative had died on the previous day. The appellants requested a different apportionment of costs because their representative had already travelled from America to the EPO, thereby incurring unnecessary costs. They argued that the respondents could have been represented by someone else from their patent attorney's firm. The board refused the request because there had been no recognisably wrongful or irresponsible conduct on the part of the other party. The board was of the opinion in particular that the respondents could not be expected to be represented by a different patent attorney, who would have had to have prepared two oral proceedings in one day (one for an ongoing parallel case) and to travel as well.

10.3.3 Appeal or opposition withdrawn

In **T 85/84** the appellants withdrew the appeal in a telex to the EPO and the respondents' representative 48 hours before the date of the oral proceedings. The EPO forwarded this information, together with the decision to cancel the oral proceedings, to the respondents' representative, a member of Bayer AG's patent department in Leverkusen, by telex sent at 16.17 hrs. The telex did not reach the patent department until the next day. By this time, however, the respondents' representative had already departed in order to prepare for the oral proceedings in Munich. He requested apportionment of costs. Although the opposition and the appeal had been withdrawn, a decision was given on the apportionment of costs (see also **T 765/89**). The board refused to apportion the costs as the respondents' representative had been informed in good time that the oral proceedings would not be taking place. Internal delays in forwarding the communication were not the fault of the appellants. The representative's departure for Munich a day before the oral proceedings was not warranted by the distance between Leverkusen and Munich and therefore not necessary from the point of view of the oral proceedings. The appellants should have been able to assume that their communication had reached the representative in good time. There had been no culpable conduct.

In **T 614/89** the appellants had withdrawn the appeal for financial reasons four days before the date set for oral proceedings. The respondents were notified the same day. respondents I filed a request for apportionment of costs on the grounds that they had already prepared themselves for the oral proceedings and the appellants must have known long before the date set that the appeal stood no chance of success. The board took a decision on the request, rejecting it on the grounds that the appeal had been withdrawn sufficiently promptly that no costs had been incurred for the oral proceedings. It also ruled that the right to oral proceedings was subject to no restrictions and that the appellants had acted neither negligently nor with wilful intent.

10.3.4 One of the parties does not appear at the oral proceedings

In **T 591/88** both parties had requested that oral proceedings be held - both in fact filing an "unconditional" request. Without giving any advance notice, the respondents failed to appear. The appellants requested apportionment of costs on the grounds that the oral proceedings would not have been necessary had they known that the respondents would not be attending. The board rejected an apportionment of costs because the appellants had made an "unconditional" request for oral proceedings, ie also covering the eventuality that the other party would not appear.

In **T 632/88** the appellants had requested oral proceedings. The respondents did not reply to the board of appeal's opinion and announced that they would not be attending the proceedings. The board rejected the appellants' request for apportionment of costs as the respondents' failure to appear had not resulted in additional costs.

In **T 507/89** the respondents had not reacted to the statement of grounds and had not appeared at the oral proceedings requested by the appellants. No apportionment of costs was made as the respondents' failure to appear had not resulted in higher costs.

In **T 909/90** oral proceedings had been appointed at the appellants' request. Without giving the board or opponents any advance notice, the appellants did not attend the oral proceedings. Nor did they comment on the board's communication. For this reason in particular the oral proceedings contributed nothing new to the case. The board ordered the apportionment of costs without examining whether higher costs had been incurred as a result of the appellants' failure to appear.

In **T 338/90** oral proceedings had been requested by both parties. However, the appellants did not appear. Their representative only notified the board as the oral proceedings were starting. The board **assumed** that costs had been incurred as a result of the party's failure to appear and ordered the appellants to reimburse the respondents the costs they had incurred for the oral proceedings.

In **T 275/89** (OJ 1992, 126) the appellant's representative filed a request that the oral proceedings scheduled for 09.00 hrs on 3 May be adjourned, on the grounds that the appellant was unable to attend the oral proceedings owing to illness. The request was submitted so late, ie in the afternoon of 30 April, that it was impossible in view of the public holiday the following day to notify the respondents in time: they had already set out during the afternoon of 1 May. The request was refused however and the oral proceedings took place without the appellant. The respondents requested a different apportionment of costs on the grounds that they would not have attended either had they known that the appellant would not be appearing. The board, however, took the view that the appellant could not be made responsible for the fact that the respondents had chosen to make an early start to the journey. Furthermore, the only matter of importance was whether the appellant's absence rendered the oral proceedings unnecessary. This question had to be answered in the negative. The request for costs was rejected.

In **T 838/92** too, the appellants stayed away from the oral proceedings. The respondents requested a different apportionment of costs as they had appeared with seven witnesses. The board rejected the request because the witnesses had been summoned at the respondents' instigation in order to prove the prior uses alleged by the latter. There was therefore no reason to impose the costs on the appellant.

In **T 930/92** (OJ 1996, 191) the board held that there was an equitable obligation on every party summoned to oral proceedings to inform the EPO as soon as he knew that he would

not be attending as summoned. This was the case whether or not that party had himself requested oral proceedings, and whether or not a communication had accompanied the summons to oral proceedings. If a party who has been summoned to oral proceedings fails to attend as summoned without notifying the EPO in advance that he will not attend, an apportionment of costs in favour of another party who has attended as summoned may be justified for reasons of equity in accordance with Art. 104 (1).

10.3.5 Cases of alleged abuse of procedure or abuse of oral proceedings

Even when the proceedings showed no exceptional features attempts were still made, on the basis of an alleged abuse, to have costs apportioned. (For abuse in the case of late submission of documents, see above.)

(a) Abuse of procedure

An apportionment of costs is often requested on the grounds that the notice of opposition or appeal has been incorrectly filed.

In **T 170/83** the opponents had used an incorrect form for payment of the opposition fee, thereby giving rise to a decision by formalities to reject the opposition; the opponents thereupon filed an appeal against this decision. The patent proprietors/respondents requested that the appeal costs be awarded against the appellants, since it was their error which had rendered the proceedings necessary. The board rejected the request, taking the view that the appeal proceedings were not improper. An abuse justifying the apportionment of costs could only be rooted in the party's conduct **during the proceedings**.

In a number of cases the boards took the admissibility or allowability of an opposition or an appeal to be an indication that no abuse had taken place (eg **T 7/88** and **T 525/88**). In **T 99/87** the board held that there had been no abuse as a discussion had taken place during the oral proceedings and the respondents had as a result formulated new claims. In **T 506/89** the board rejected an apportionment of costs because the opposition division had decided during oral proceedings to maintain the patent as amended; there could consequently be no question of an abuse of procedure by the opponents.

In **T 605/92** the principle was laid down that no abuse of procedure has taken place if an appeal is filed even though no new arguments are put forward.

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.

(b) Abuse of oral proceedings

In **T 49/86** the board ruled that an apportionment of costs is justified if excessive costs were incurred for the oral proceedings and were caused mainly by one party.

The parties repeatedly tried to bring about an apportionment of costs on the grounds that no new arguments had been put forward during oral proceedings by the party which had requested them and that therefore there had been an abuse of the oral procedure.

Although costs were apportioned on these grounds in **T 167/84** (OJ 1987, 369), the boards otherwise unanimously took the view that the right to oral proceedings was absolute and not subject to any conditions. The absence of new arguments was not a reason for apportioning costs. The same applied in **T 303/86**, **T 383/87**, **T 305/86**, **T 125/89** (where the opposition division had decided otherwise) and **T 918/92**.

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. This was also the case in **T 26/92**, in which the board stressed that there was no need to examine whether the oral proceedings were relevant from an objective point of view.

In **T 81/92** the board confirmed that the right to oral proceedings was a fundamental procedural right. A different apportionment of costs could not be ordered on the grounds that the patent proprietor had insisted on oral proceedings, although the opposition division had made it clear to him in advance what decision it would take. The board set aside the decision of the opposition division ordering a different apportionment.

In **T 905/91** the respondents had requested a different apportionment of costs on the grounds that the appellants had not come with prepared auxiliary requests to the oral proceedings, which had therefore continued into the afternoon. The board rejected the request for the following reasons. Firstly, the appellants had endeavoured to take account of the reservations expressed by the board and had filed new documents. Secondly, oral proceedings served specifically to clarify the situation completely through the direct exchange of arguments and, if necessary, to rephrase the patent application in the light of the outcome of the discussion. The duration of oral proceedings depended on the particular case; at any rate it was not unusual for such proceedings to continue into the afternoon, and the parties should be prepared for this.

In **T 297/91** it had not been possible during the first oral proceedings, for a number of reasons, to decide all the issues, with the result that the respondents had requested that further oral proceedings be held and that the costs incurred be borne by the appellant. The board rejected the request for apportionment of costs because the further oral proceedings had become necessary for reasons beyond the patent proprietor's control.

In decision **T 461/88** (OJ 1993, 295) the board decided that the appellants' 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.

In case **T 407/92** the appellants and opponents II as a party of right requested the apportionment of costs because they considered it an abuse that the respondents, after the first oral proceedings, had presented numerous additional sets of claims and requested additional oral proceedings, although the board, at the end of the first oral proceedings, had declared that the proceedings should be continued in writing on the basis of the three auxiliary requests presented by the respondents during the first oral proceedings. The board could not see any abusive conduct because, due to the relatively complex technical content of the patent in suit, the board itself considered it necessary to have a further oral discussion with the parties. The request was rejected.

10.4 Costs to be apportioned

In **T 167/84** (OJ 1987, 369), **T 117/86** (OJ 1989, 401) and **T 416/87** (OJ 1990, 415) cited above the boards confirmed that representatives' costs could be apportioned. In **T 326/87** (OJ 1992, 522) the board decided that all costs caused by remittal to the first instance should be apportioned. In **T 416/87** and **T 323/89** (OJ 1992, 169) it was **assumed** that costs had arisen.

In **T 930/92** (OJ 1996, 191) the board held that when fixing the amount of costs to be paid to a party, in addition to the remuneration of the professional representative of that party, the expenses incurred by an employee of that party in order to instruct the professional representative before and during oral proceedings may be taken into consideration under R. 63(1), if such instruction was necessary to assure proper protection of the rights involved.

10.5 Procedural requirements

In decision **T 212/88** (OJ 1992, 28) cited above, the board ruled that all requests by parties, including any request for apportionment of costs, should be made before the 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...". In many other unpublished decisions the boards have also insisted on the submission of evidence (eg **T 49/86**, **T 193/87**, **T 404/89**, **T 523/89**, **T 705/90**, **T 776/90**).

In **T 934/91** (OJ 1994, 184) the board made it clear that, under Art. 111(1), a board of appeal, when considering a request for the apportionment of costs, is empowered to specify the amount of costs to be paid, having regard to Art. 104(2).

In **T 896/92** the request for a different apportionment of costs was rejected for lack of substantiation and because of the absence of obvious reasons.

In **T 789/89** (OJ 1994, 482) it was made clear that although the opponent/respondent who withdraws his opposition ceases to be a party to appeal proceedings as far as the substantive issues are concerned, he nevertheless remains a party if the question of apportionment of costs is still at issue.

In **T 765/89** it was stressed that the board is still responsible for deciding on the request that costs be awarded against the appellants even if the latter have withdrawn their appeal.

In **T 408/91** the board stated that there was no basis for deciding on a different apportionment of costs if the party which would benefit from the decision did not request apportionment and even made it known that it would not enforce any such decision. This applied even if the board considered an apportionment of costs to be equitable.

In **J 38/92** the board held that as a matter of principle costs are not apportioned in transfer proceedings.

10.6 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 appellants (opponents) for revocation of the patent

was inadmissible due to inadequate substantiation. However, the appellants also requested that the decision by the department of first instance, according to which they were liable for the costs of the oral proceedings they had not attended, be set aside. The opponents had withdrawn their 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 the 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.

In **T 753/92**, the respondents I were adversely affected by the decision under appeal only in so far as their request for apportionment of costs was rejected. If respondents I had lodged an appeal against this decision, the appeal, with the apportionment of costs as its sole subject, would have been inadmissible under Art. 106(4). The fact that respondents I submitted the request for apportionment of costs merely as a party to the appeal proceedings as of right (Art. 107) cannot, in the board's judgment, render such a request admissible without contravening the principle of equal treatment. This request must therefore be rejected as inadmissible.

E. Appeal procedure

1. Introduction

The provisions governing the appeal procedure set out 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 took the decision under appeal are applicable to appeal proceedings *mutatis mutandis*. This application by analogy is, however, not automatically permissible in every case and for every provision. Criteria have therefore had to be established for when such an analogy was permissible and when not. To this end it was necessary to analyse the legal nature of the appeal procedure.

Appeal proceedings are wholly separate and independent from the first-instance proceedings. Their function is to give a judicial decision upon the correctness of a separate earlier decision taken by a first-instance department (**T 34/90**, OJ 1992, 454). In **T 501/92** the board deduced from this principle that any procedural request or statement made by a party during proceedings in the first instance was not applicable in any subsequent appeal proceedings, and had to be repeated during the latter if it was to remain procedurally effective.

The Enlarged Board of Appeal, in particular, has emphasised certain features of the appeal procedure during the course of time. It has been established for example that the procedure 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 also to "the procedure which is proper to an administrative court". In **G 9/91** (OJ 1993, 408) and **G 10/91** (OJ 1993, 420) (see also "The legal nature of opposition proceedings", p. 281 above) the Enlarged Board confirmed the judicial nature of the appeal procedure, its purpose being to review decisions by departments of the first instance; **T 534/89** (OJ 1994, 464) took the same line. In **G 9/92** and **G 4/93** (both OJ 1994, 875) it was decided that the extent of appeal proceedings is determined by the appeal.

These characteristics of the appeals procedure not only serve as criteria when assessing whether a provision may be applied analogously in individual cases; they also have general legal consequences in many respects. It follows from the characteristics set out by the Enlarged Board that the general principles of court procedure, such as the entitlement of parties to direct the course of the proceedings themselves ("principle of party disposition"), also apply to appeals (see **G 2/91** (OJ 1992, 206), **G 8/91**, **G 8/93** (OJ 1994, 887), **G 9/92** and **G 4/93**), that a review of the decision taken by the department of first instance can, in principle, only be based on the reasons already submitted before that department (**G 9/91**, **G 10/91**), and that the proceedings are determined by the petition initiating them (*ne ultra petita*) (see **G 9/92** and **G 4/93**). The Enlarged Board has also made it clear that the decision-making powers of opposition divisions, and of the boards in opposition appeal proceedings, are circumscribed by the statement under R. 55(c) of the extent to which the European patent is opposed. They have no powers to decide and thus investigate anything extending beyond that statement (see **G 9/91**, reasons 10 and 11). This has defined the sphere of application of Art. 114(1), and clarified the distinction between the power to initiate and determine the object of proceedings, on the one hand, and the power to examine the facts then relevant, on the other. The individual procedural consequences and the Enlarged Board's decisions are discussed in greater detail below.

2. Suspensive effect of the appeal

Under Art. 106(1), an appeal has suspensive effect. The Legal Board of Appeal defined this effect in **J 28/94** (OJ 1995, 742), in which a third party claimed entitlement to grant of the patent and requested suspension of the proceedings for grant under R. 13(1).

The board took the view that the appeal's suspensive effect meant the contested decision had no legal effect until the appeal was resolved. Otherwise appeal would be nugatory.

Thus, if a decision refusing to suspend the publication of the mention of grant of a patent were appealed, publication should be deferred until the appeal was decided. If (as here) this was not possible for technical reasons, the EPO should take all necessary steps to advise the public that the mention of grant was no longer valid (see also **T 1/92**, OJ 1993, 685, point 3.1).

3. Language of the proceedings

The same language arrangements apply to appeals as to all other EPO proceedings. Under R. 1(1) any party may use any EPO 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 may use another EPO official language instead of the language of the proceedings, provided he either gives the EPO at least one month's notice or arranges for interpreting into the language of the proceedings.

In **T 34/90** (OJ 1992, 454) the respondent did neither. His representative argued that because he had lawfully used an alternative official language in oral proceedings before the opposition division, he should be allowed to use the same language in the hearing before the board. Although he did not actually say so, this plainly implied that appeal proceedings were simply a continuation of the first-instance (ie opposition) proceedings. From the principle that appeal proceedings were wholly separate and independent from first-instance proceedings for the purpose of deciding the admissibility of using an alternative official language under R. 2(1) - and for other procedural purposes - the board inferred that a party could use such a language in oral proceedings before it only if he again gave the requisite notice (see also communication from the Vice-President DG 3, OJ 1995, 489).

In **J 18/90** (OJ 1992, 511) the board recognised that in written proceedings and decisions, organs of the EPO might also use an official language other than the language of proceedings, provided all parties to the proceedings had given their agreement (see also **T 788/91**).

In **T 706/91** the appeal had been drawn up in accordance with R. 1(1) in one of the official languages, namely German. The appellant had therefore cited passages from the disputed European patent's claims and description in that language, even though they had been drawn up in French as the language of the proceedings. The board decided that these references were admissible.

See also "Common provisions governing procedure", chapter "Language privilege", p. 260.

4. Procedural status of the parties

4.1 Parties to appeal proceedings

Under Art. 107, the parties to proceedings before the department of first instance are also

parties to the ensuing appeal proceedings, even if they have not personally filed an appeal. And pursuant to Art. 99(4), opponents as well as the patentee are parties to opposition proceedings. In addition, Art. 105 makes provision for intervention by the assumed infringer. For other proceedings, the general principle applies that the parties to them are those whose legal interests are affected by the decision at issue (see eg **T 811/90**, OJ 1993, 728 - where opposition proceedings had been concluded and the time limit for lodging an appeal had expired). Only the patent proprietor lodged an appeal, but against a separate decision on a point incidental to the opposition. It was held that the other party had no right to be a party to the appeal as he had not been a party to the relevant decision). Third parties commenting under Art. 115 on the patentability of the invention claimed are not parties to the proceedings before the EPO.

In **T 838/92**, the patent proprietor had requested that the opponent be excluded from the proceedings on the grounds that he had submitted a false document and thus not acted in the good faith underlying the whole functioning of the EPO. The board ruled that the opponent should remain party to the proceedings: Art. 107 stated that where one party filed an appeal, any other parties to the first-instance proceedings were parties to the appeal proceedings as of right, and nothing in the EPC enabled an opposition division or board of appeal to exclude a party from ongoing proceedings.

4.2 Intervention

4.2.1 Institution of proceedings

Under Art. 105, to intervene admissibly in opposition proceedings a party must show either that the patentee has instituted infringement proceedings against him or that in response to a request from the patentee to stop allegedly infringing the patent he has himself instituted proceedings for a court ruling that he is not in fact doing so.

In **T 195/93** the board held that if a patentee simply sent a legal warning letter asking the intervener to stop production and sale of a product covered by the patent, this could not be regarded as institution of proceedings for a court ruling even if under national law the addressee became liable for damages 30 days after receiving the letter. The intervention was therefore rejected as inadmissible.

4.2.2 Notice of intervention

One question arising here was up to what stage in the proceedings **intervention** was still possible.

In **G 4/91** (OJ 1993, 707) the Enlarged Board held that a notice of intervention filed during the two-month period for appeal had no legal effect if no appeal was filed.

However, this decision did not resolve whether or not Art. 105 was applicable in appeal proceedings as well. In **T 27/92** (OJ 1994, 853) a board had asked the Enlarged Board whether intervention in opposition proceedings during pending appeal proceedings was admissible. Since the intervention was then withdrawn, however, this case was terminated.

In **G 1/94** (OJ 1994, 787) the Enlarged Board had another opportunity to consider this question, following a further referral in **T 169/92** (where two parties gave notice of intervention during the appeal proceedings) because opposing views had been taken in **T 338/89** of 10.12.1990 and **T 390/90** (OJ 1994, 808). In **T 338/89**, the intervention was

deemed admissible, on the basis that under R. 66(1) the provisions of Art. 105 applied *mutatis mutandis* to appeal proceedings. In **T 390/90**, this *mutatis mutandis* application was ruled out in view of the different - ie judicial - character of appeal proceedings, and the intervention was held to be inadmissible, whereas in **T 27/92** (OJ 1994, 853) the board had held that the difference in character between opposition and appeal proceedings was not so great that Art.105 could not be applied to the latter.

After studying the relevant “travaux préparatoires”, the Enlarged Board concluded that the legislator’s intention had been that Art. 105 should apply to appeal proceedings. The term “opposition proceedings” was not restricted to the department of first instance, but could also refer to such proceedings at second instance. Each provision had to be interpreted separately in order to establish whether this was the case. It was clear from the “travaux préparatoires” that Art. 105 also covered the department of second instance. Intervention during appeal proceedings was therefore admissible.

The Enlarged Board also examined the related question of whether an intervener could raise any of the grounds for opposition under Art. 100 even if they had not yet been examined by the opposition division, and found in the affirmative. If a fresh ground for opposition was raised, the case should be remitted to the department of first instance unless the patent proprietor wished the board to rule on it there and then.

T 296/93 (OJ 1995, 627) dealt with the time limits for intervention. On 1.7.1992, the intervener had been served with a writ of summons before a national court, in which the appellant requested him to cease his alleged infringement of the European patent in suit. On 30.9.1992, the intervener had filed a counterclaim against the appellant, and on 29.12.1992 a notice of intervention with the EPO. In his submissions, he argued that Art. 105 provided for any third party to intervene who could prove both that the patent proprietor had requested that he cease alleged infringement and that he had instituted proceedings for a court ruling that he was not infringing the patent; these were two alternative means of intervention which were not mutually exclusive.

The board took the view that the principle underlying Art. 105 was that as soon as any court action was brought the sole available period for intervention started to run. Consequently, the two alternative starting points under Art. 105(1), first and second sentence respectively for calculating the three-month period for intervention were mutually exclusive. In a given case, this period was triggered by institution of the first court action, regardless of whether it came under the first or second sentence of Art. 105(1).

4.2.3 Intervener’s rights, fees payable

In **T 27/92** of 25.7.1994, the board had found that for an intervention filed during appeal proceedings to be admissible, only one fee - the opposition fee - had to be paid. The fee for appeal did not necessarily have to be paid as well. The board left open the question of whether paying the fee for appeal could affect the intervener’s legal status - giving him the status of an independent appellant - because in the case at issue the intervener did not want this. The fee for appeal was refunded as requested.

The boards have not yet addressed the specific question of whether a party who does not intervene until the appeal stage can acquire, by paying the fee for appeal, an independent right to pursue the appeal proceedings even though he took no part in the proceedings at first instance and therefore could not himself initiate opposition appeal proceedings (see **G 4/91**, OJ 1993, 707).

The situation in **T 1011/92** was that the opponent and appellant had withdrawn his appeal, whereas the intervener in the appeal proceedings maintained his request for revocation and had taken part in the oral proceedings. He had paid the opposition and appeal fees, and requested that the former be refunded. The board found that an intervener - like an opponent - had to pay both fees if he wanted to continue appeal proceedings once the opponent had withdrawn his appeal. The requested refund of the opposition fee was refused. The appeal proceedings were continued, ending after scrutiny of the contested patent in dismissal of the intervener's appeal.

In **T 195/93** an intervener filed a notice of intervention and paid the opposition fee during pending appeal proceedings. Subsequently the appeal was withdrawn. The board took the view that the position of interveners was independent of that of the appellant(s). Accordingly, the fact that the original appellant had withdrawn his appeal after the intervention was filed could not immediately lead to termination of the proceedings. The board therefore considered the admissibility of the intervention (see above, p. 319). It based this ruling on a statement by the Enlarged Board in **G 1/94** (OJ 1994, 787) that intervention by an assumed infringer during pending appeal proceedings could be based on any ground for opposition under Art. 100, including grounds not invoked by the original appellant(s). The board held that, in fact, unless there were compelling reasons for considering the intervention despite withdrawal of the appeal by the opponent, it would not make sense to admit new grounds for the intervention.

4.3 Rights of parties under Article 107 EPC

4.3.1 Overview

In appeal proceedings, the case law recognises the right of all parties to be heard (see **J 20/85** (OJ 1987, 102), **J 3/90** (OJ 1991, 550), **T 18/81** (OJ 1985, 166), **T 94/84** (OJ 1986, 337), **T 716/89** (OJ 1992, 132)), albeit within the limits of expediency (see **T 295/87**, OJ 1990, 470). The parties also have a right to oral proceedings (see p. 193).

Furthermore, **G 1/86** (OJ 1987, 447) recognised the validity of the principle that all parties must be treated equally in similar legal situations in proceedings before the boards of appeal.

Decision **T 73/88** (OJ 1992, 557) deduced from this that all parties to proceedings had the right to continue appeal proceedings, irrespective of whether or not they personally had 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 refunded.

In decision **G 2/91** (OJ 1992, 206) the Enlarged Board did not go along with this interpretation of the principle of equal treatment. It took the view that from the legal point of view the status of parties who had filed an appeal was not comparable with that of those who had not. It was clear from generally recognised principles of procedural law that the appellant alone could decide whether the appeal filed by him was to stand. Art. 107, second sentence, only guaranteed non-appellants who were party to proceedings of the first instance that they were parties to **existing** appeal proceedings. A person who was entitled to appeal but did not do so, settling instead for being "automatically" a party to the appeal proceedings, had no independent right of his own to continue those proceedings if the appellant withdrew his appeal. He acquired that right only by filing an appeal himself and paying the associated appeal fee. By the same token, there was also no reason to refund the fee for any appeals filed after the first, unless the requirements of R. 67 were met. (This

supersedes the general finding in **T 89/84**, OJ 1984, 562, that a cross-appeal does not have to be filed.). The related issue of whether non-appealing parties can file substantive requests is dealt with in **G 9/92** and **G 4/93** (both OJ 1994, 875; see also VI.E.4.3.2 “*Reformatio in peius*” below).

The parties do have the basic right to determine, through their requests, what the proceedings are about and thus what the board will consider. However, this right differs in extent for appellant and respondent. There are also differences between *ex parte* and *inter partes* proceedings. Nor do the parties have any exclusive right to determine the factual basis for the board’s decision; here the principle of *ex officio* examination under Art. 114 applies (see p. 327).

4.3.2 “*Reformatio in peius*”

In **G 9/92** and **G 4/93** (both OJ 1994, 875) the Enlarged Board of Appeal gave the following opinion on whether the boards were bound by the appellant’s requests, and thus whether a patent could be amended in appeal proceedings to the disadvantage of the non-appellant:

If the patentee was sole appellant against an interlocutory decision maintaining his patent in amended form, neither the board of appeal nor the non-appealing opponent (as party to the proceedings as of right under Art. 107, second sentence) could challenge maintenance of the patent as thus amended.

If the opponent was sole appellant against an interlocutory decision by an opposition division maintaining the patent in amended form, the patentee was primarily restricted in the appeal proceedings to defending the patent as thus maintained. Amendments proposed by the patentee (as party to the proceedings as of right under Art. 107, second sentence) could be rejected by the board as inadmissible if they were neither appropriate nor necessary (see eg **T 321/93**).

The basis for the Enlarged Board’s view was that the aim of an appeal is to overcome an adverse decision by having it amended or set aside. Furthermore, under the EPC the filing of a notice of appeal, and hence the right to request the specific redress sought, was subject to a time limit. It would not be consistent with that time limit to give non-appellant parties the unrestricted right to alter the scope of the proceedings by submitting their own requests with no such time limit. **T 856/92** followed **G 9/92**.

G 9/92 is based on a referral of **T 60/91** and **T 96/92** (both OJ 1993, 551), which had been consolidated on this point. In both cases the opposition division had maintained the patent as amended on the basis of an auxiliary request. In **T 60/91** the patentee had filed an appeal requesting that the patent be maintained as per the main request filed during opposition proceedings, whereas the opponent/respondent wanted the patent revoked. In **T 96/92** the opponent had filed an appeal requesting revocation of the patent, whereas the patentee/respondent wanted it maintained in the original version. In neither case had the respondents filed their own appeal. The question was referred to the Enlarged Board because of its fundamental importance and the different decisions taken by the boards (see **T 369/91** (OJ 1993, 561) - which on the basis of **G 2/91** (OJ 1992, 206) found in favour of restricting the filing of requests by non-appellant parties, and **T 576/89** (OJ 1993, 543) which came down against such a restriction). Case **T 96/92** has meanwhile been referred back to the responsible board, following the respondent’s withdrawal of the request which gave rise to the referral. Case **G 9/92** however 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 patentee/respondent had requested that the patent be maintained in accordance with the main request filed during opposition proceedings, whose scope was narrower than that of the version originally granted by the examining division.

4.3.3 Extent of scrutiny in opposition appeal proceedings

The boards' scrutiny - as regards not only which parts of the patent require review but also the grounds for opposition - is circumscribed in the first instance by the notice of opposition filed by the opponent.

(a) Extent to which the patent is contested

In **G 9/91** (see p. 296) the Enlarged Board considered whether, on appeal, the board should be restricted to examining the contested subject-matter, and decided that no part of a patent's subject-matter (eg individual claims) not opposed within the nine-month time limit could be reviewed in either opposition or appeal proceedings. The opponent's statement under R. 55(c) established the extent to which the patent was contested and thus the formal competence of the opposition division or board of appeal (see also p. 327).

T 396/89 also concerned the extent of the board of appeal's powers of review. Here the opposition division had revoked the patent, finding in its decision that claims 1 to 5 were novel but claim 6 was not. Remaining claims 7 to 24 had not been examined. The patentee appealed, requesting that the patent be granted in the version examined by the opposition division or, alternatively, without claim 6. The opponents, who had not appealed themselves, took issue with the opposition division's finding that claims 1 to 5 were novel. The patentee argued that this 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; on appeal, the whole case - including its claims 1 to 5 - had to be considered.

T 896/90 followed **G 9/91**, but ruled that detailed grounds of opposition for a single granted independent claim did not mean that only that part of the patent was being contested. The opponent had indicated on page 2 of Form 2300 that he wanted the whole patent revoked, but in his statement of grounds had said "at least to the extent of claim 1". There were no detailed grounds regarding claims 3 to 12 which referred back to claim 1.

In **T 737/92** the opponent attacked all the claims and cited all the grounds under Art. 100. However, only that under Art. 100(a) was substantiated, and only claims 1 to 8 were challenged in detail. Nothing was said about remaining claims 9 to 14. The board found that an opposition was filed only to the extent that it was substantiated; it therefore only considered the ground for opposition under Art. 100(a) and claims 1 to 8.

(b) New grounds for opposition

The Enlarged Board established in **G 10/91** (see p. 298) that only those grounds for opposition already cited at the opposition stage could be considered on appeal. New ones could be introduced only with the **consent** of the patentee, whose power of veto applied regardless of their relevance. (Broad application of Art. 114(1), ie examination also of uncited grounds for opposition, is restricted to the department of first instance - see also p. 327).

At various times the boards have already had occasion to consider the effects of the above

ruling as regards two particular problems: the meaning of "ground for opposition", and how to proceed where a ground for opposition has been examined by the opposition division of its own motion. The former question has now been referred to the Enlarged Board.

In **T 937/91** (OJ 1996, 25) a European patent was opposed on the ground that its subject-matter was not patentable under Arts. 52 to 57. However, during opposition proceedings only the novelty and inventive step objections to the independent claims were substantiated. In the subsequent appeal proceedings, the board felt the subject-matter of claim 1 was *prima facie* non-patentable under Art. 52(2)(d). This raised the question of whether the board was entitled to table this fresh objection of its own motion without the patentee's consent.

Decisions **G 9/91** and **G 10/91** did not expand on the concept of "grounds for opposition". In **T 937/91** the board thought there were two possible interpretations, the first being that each of the three grounds for opposition mentioned in paragraphs (a), (b) and (c) respectively of Art. 100 should be considered as separate (as in **T 503/90**, **T 588/90**, **T 796/90**, **T 166/91**, **T 381/91**). However, the board saw no logical connection between the objections say that a claim was not novel and that an invention was contrary to ordre public which might justify considering them as one and the same "ground". The second possible interpretation was that only the specific ground (novelty, inventive step, etc.) substantiated in the notice of opposition pursuant to R. 55(c), or - exceptionally - raised *ex officio* by the opposition division, should be considered in appeal proceedings. The board felt however that the constraint imposed by this narrow interpretation on the EPO's obligation to examine the facts of its own motion under Art. 114(1) would go well beyond any reasonable interpretation of that article.

The board considered that decisions **G 9/91** and **G 10/91** required interpretation, and with **T 937/91** therefore referred the following question to the Enlarged Board of Appeal:

"In a case where a patent has been opposed on the basis of Art. 100(a), but the opposition has only been substantiated on the grounds of lack of novelty and inventive step pursuant to Art. 54 and 56, can a board of appeal introduce the ground that the subject-matter of the claims does not meet the conditions of Art. 52(2) of its own motion into the proceedings?"

The case is pending as **G 1/95**.

A similar question was posed in **T 514/92** (OJ 1996, 270), as follows: "In the case where a patent has been opposed under Art. 100(a), on the basis that the claims lack an inventive step in view of documents cited in the opposition statement, and the opponent introduces during appeal proceedings a new allegation that the claims lack novelty in view of one of the documents previously cited or in view of a document introduced during the appeal proceedings, must a board of appeal exclude the new allegation because it introduces a new ground of opposition?"

The case is pending under reference number **G 7/95** and will be consolidated with decision **G 1/95**.

In **T 18/93** too the board interpreted the concept of "grounds for opposition". The opposition division had considered novelty and inventive step, mainly on the basis of the document regarded as the closest prior art. In his grounds of appeal, however, the appellant (opponent) relied for the first time upon several further publications, on whose basis he argued that novelty had to be reconsidered. The respondent however felt that this novelty objection was a "new ground for opposition" which had to be disqualified as not

properly submitted and substantiated during the nine-month opposition period; it could not be admitted into the appeal proceedings without his consent, which was not forthcoming.

The board took the view that **G 9/91** expressly referred to "all the grounds for opposition set out in Art. 100(a) to (c)", ie the three grounds specified there. There was thus no basis for extending the resulting concept to separate "grounds" within a single category thereof. In particular, novelty and inventive-step objections both came under Art. 52(1). Art. 54(1) and Art. 56 only defined the novelty and inventive-step requirements - which related moreover to the common issue of patentability over the state of the art as defined in Art. 54(2) to (5), and therefore to the same ground of opposition in the above sense. Nor did **G 9/91** relate to a situation in which the opposition division had already dealt with the issue of novelty and given reasons for its finding on that point in the decision under appeal (likewise **T 796/90**).

If an opposition division has examined of its own motion a late-filed ground for opposition, then the board of appeal is empowered to rule on it (see eg **T 309/92** and **T 931/91**).

In **T 986/93** (OJ 1996, 215) the question arose as to whether the board can examine - even without the patentee's consent - a ground for opposition advanced only after expiry of the opposition period (ie in oral proceedings before the opposition division) and which the division therefore refused to consider under Art. 114(2). The board found that it was thus empowered, if it felt that the opposition division had not exercised its discretion properly. It interpreted opinion **G 10/91** to the effect that "new grounds for opposition" meant all those grounds not put forward until the appeal stage, rather than those - as argued by the appellant - not submitted within the opposition period under R. 55(c) or else disqualified by the opposition division under Art. 114(2). Even if the division chose not to consider a ground, it had still been brought forward during opposition proceedings and was therefore not "new". Furthermore, the board could also review the opposition division's decision not to consider it, and - if it felt the division had erred - exercise its own discretion and examine the ground in question after all.

In **T 758/90** the board held that it was not possible to deduce with complete certainty from **G 9/91** or **G 10/91** whether grounds for opposition which had been considered by the opposition division but submitted by one opponent only and then taken up by a different opponent as the sole appellant could only be examined by the board with the patentee's consent. However, the board did not need to resolve this question, as the grounds in question were not material to its decision.

In decision **T 1002/92** (OJ 1995, 605) the board applied the principles of **G 10/91** also to late-filed evidence and arguments relating to a ground for opposition already put forward.

In **T 968/92** the board held that claims which remained unchanged after the removal of the references in dependent claims need not be examined in opposition appeal proceedings to see if they contained grounds for opposition raised for the first time in those proceedings, unless the patentee consented.

4.3.4 Extent of scrutiny in ex parte proceedings

In such proceedings, the board has broad scope.

(a) Examination of patentability requirements

In **G 10/93** (OJ 1995, 172) the Enlarged Board had to rule on whether, where the examining

division had refused an application, the board of appeal could uphold that first-instance decision but base its own decision on grounds other than those put forward by the division.

It ruled that in such a case the board had the power to examine whether the application or the invention to which it related met the requirements of the EPC. This also held good for requirements the division had not considered in the examination proceedings or had regarded as fulfilled. If there was reason to believe that such a requirement had not been met, the board had to consider the matter, and then decide in the light of the particular circumstances whether to rule on the case itself or send it back to the examining division.

This followed from the fact that *ex parte* review, which was proper to an administrative court, was not of a contentious nature. It involved examination of the patentability requirements in proceedings in which only one party - the applicant- was involved. The departments involved at every instance had to ensure that these requirements were fulfilled. In *ex parte* proceedings, therefore, the boards of appeal were not restricted either to examination of the grounds for the contested decision or to the facts and evidence on which that decision was based, and could include new grounds even though in *ex parte* cases too the main aim of appeal proceedings was to review the contested decision.

This decision was based on case **T 933/92**, in which an examining division had refused an application for non-compliance with Art. 123(2). Whilst sharing the examining division's view with respect to Art. 123(2), the board felt the application should be refused for lack of inventive step. In the board's view, the question whether grounds could be added or replaced was not resolved by **G 9/91** and **G 10/91**.

The extent of the obligation to review a case where the appeal is partially withdrawn is discussed on p. 328 below.

(b) Extent to which the patent is contested

In **G 9/93** (OJ 1994, 891), although the Enlarged Board overturned **G 1/84** (OJ 1985, 299) and ruled that a patent could not be opposed by its own proprietor, it also decided that for reasons of legal certainty this should not apply to notices of opposition filed before publication of the new ruling.

Thus in **T 788/90** of 28.10.1994 the board was able to set out a principle for all self-opposition cases:

The *ex parte* opposition in question had to be examined in accordance with the principles established by decision **G 1/84**. This meant that the board of appeal had to examine the facts of its own motion. It could thus go beyond the parties' requests and examine the claims in their entirety, even though some of them clearly had not been opposed in the notice of opposition. Nor was the board limited solely to the evidence submitted in support of the opposition; it could cite other, new evidence even if not presented by the opponent/ proprietor.

4.4 Review of first-instance discretionary decisions

The extent to which such decisions should be reviewed was considered in **T 640/91** (OJ 1994, 918). In connection with a request for reimbursement of the appeal fee, the board considered whether the examining division had invited the applicant to file observations "as often as necessary" under Art. 96(2). Noting that this phrase conferred a degree of discretion on the examining division in taking its decision, it ruled that "... if the way in which a first instance department has exercised its discretion on a procedural matter is

challenged in an appeal, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the first instance department, and to decide whether or not it would have exercised such discretion in the same way as the first instance department. ... In the board's view, a board of appeal should only overrule the way in which a first instance department has exercised its discretion if the board comes to the conclusion that the first instance department in its decision has exercised its discretion according to the wrong principles, or without taking into account the right principles, or in an unreasonable way" (see also **T 986/93** (OJ 1996, 215) and p. 260).

4.5 Examination of the facts

Parties have no right to determine what facts will be taken into account in a board's decision. On the contrary, Art. 114(1) - which applies in appeals proceedings too - requires the board to establish the facts of its own motion (see - **T 89/84**, OJ 1984, 562, and **J 4/85**, OJ 1986, 205, both superseded in affirming the board's power to decide without specific request).

In a number of decisions the Enlarged Board has defined the scope of Art. 114(1) in appeals proceedings. In **G 8/91** (OJ 1993, 346) it found that this provision did not allow for continuation of the proceedings once the appeal had been withdrawn. This was evident from the legislative rationale of the EPC. If Art. 114(1) applied to all withdrawal situations, then the R. 60(2) exception for oppositions would be superfluous. Nor was withdrawal of the appeal covered by "relief sought" within the meaning of Art. 114(1), second part of sentence, to which the EPO would not be restricted in examining the facts; it constituted a procedural act not requiring the consent of the relevant board (Reasons, point 8).

In **G 9/91** (OJ 1993, 408) and **G 10/91** (OJ 1993, 420) the Enlarged Board ruled that in appeal proceedings - unlike first-instance ones - Art. 114(1) could serve only to a limited extent as the legal basis for determining the scope of the board's scrutiny. Regarding those parts of the patent to be examined, it found 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 obviously be pointless if later on other parts of the patent than those so opposed could freely be drawn into the proceedings. This would also be contrary to the basic concept of post-grant opposition under the EPC. By limiting the extent to which the patent is opposed to only certain subject-matters, the opponent deliberately refrains from making use of his right under the EPC to oppose remaining subject-matters covered by the patent. Such subject-matters are therefore, strictly speaking, not subject to any "opposition" in the sense of Arts. 101 and 102, nor are there any "proceedings" in the sense of Arts. 114 and 115 in existence concerning such non-opposed subject-matters" (Reasons, point 10).

The Enlarged Board agreed that Art. 114(1) did not constitute a legal basis for obligatory review of grounds for opposition not covered by the statement pursuant to R. 55(c). Furthermore, as explained in **G 7/91** and **G 8/91** (see Reasons, point 7), the appeal procedure - unlike the opposition procedure, which was merely administrative - was to be considered a judicial procedure, which was by its very nature less investigative than an administrative one. Although formally Art. 114(1) also covered appeals, generally a more restrictive application of this provision than in opposition proceedings was therefore justified. In particular, for the above reasons the Enlarged Board considered that fresh grounds for opposition should not normally be introduced at the appeal stage.

Decision **T 182/89** (OJ 1991, 391) sets out what this obligation to investigate involves: Art. 114(1) should not be interpreted as requiring the opposition division or board of appeal to

ascertain whether there was support for grounds for opposition not properly substantiated by an opponent, but as enabling the EPO to investigate fully the grounds for opposition which were both alleged and properly substantiated pursuant to R. 55(c) (**T 441/91** took the same line).

As the Enlarged Board made clear in **G 8/93** (OJ 1994, 887; see also p. 329) - this obligation exists only once proceedings are pending. Earlier, **T 328/87** (OJ 1992, 701) had already ruled that the facts could be investigated only if the appeal was admissible (Reasons, point 4, at the end).

There are however limits to this obligation, for example under Art. 114(2) where facts and evidence are submitted late (see p. 222 f.). The same applies if an opponent/respondent withdraws his opposition: in **T 34/94** the board found that, "If in the event of withdrawal of the opposition the opponent is the respondent, the board may take into account evidence which was submitted by the opponent prior to withdrawal of the opposition. However, for reasons of procedural economy, the duty of the EPO to examine the facts of its own motion pursuant to Art. 114(1) does not extend to its having to examine the submission of the opponent that a previous oral disclosure took place if the crucial facts are difficult to ascertain without his co-operation". This confirmed the case law in **T 129/88** (OJ 1993, 598), **T 830/90** (OJ 1994, 713), **T 887/90** and **T 634/91**. See also **T 252/93**.

Decision **T 60/89** (OJ 1992, 268) set further limits, the board finding (see Reasons, point 3.1.1) that when alleged facts put forward without proof as causing lack of novelty had occurred a long time previously and the question was no longer pursued by the parties it was not obliged to investigate the matter ex officio under Art. 114(1).

5. Termination of appeal proceedings

Under the EPC it is possible to withdraw a patent application, opposition or appeal. Decision **J 19/82** (OJ 1984, 6) ruled that partial withdrawal is also possible. The consequences of such a withdrawal for pending appeal proceedings are considered below. This problem is closely linked with the questions discussed above.

5.1 Withdrawal of an appeal

In **G 7/91** and **G 8/91** (OJ 1993, 346 and 356) the Enlarged Board of Appeal ruled that as far as the **substantive issues** settled by the contested decision at first instance were concerned, appeal proceedings - whether ex parte or inter partes - were **terminated** when the sole appellant withdrew his appeal.

This confirmed the established practice whereby the board simply noted the appeal's withdrawal, and the parties were notified by the DG3 Registry that the appeal proceedings were thus terminated.

In **T 357/89** and **T 695/89** the boards considered the analagous application to appeal proceedings of R. 60(2), second sentence (which applies to opposition proceedings), and referred the question to the Enlarged Board. The latter ruled that such an application was not possible, because the two procedures were of a different legal nature. The appeal procedure was that proper to an administrative court, so any exception from general procedural principles such as the "principle of party disposition" had to be supported by much weightier grounds than in administrative proceedings. Furthermore, R. 60(2), second sentence, had to be seen in the special context of the post-grant opposition

procedure, so again analogous application was not possible. Neither Art. 114(1) nor the interests of the general public or the respondent constituted arguments against this interpretation. Art. 114(1) was restricted to the examination of the facts. Moreover, the withdrawal of an appeal did not come under "relief sought" within the meaning of Art. 114(1), second part of the sentence; it was a procedural act which did not require the board's consent. The interests of the general public were primarily safeguarded by the opposition system. It could be assumed that the patent did not disturb those who had not filed an opposition, so there was no need to continue the appeal proceedings in order to safeguard their interests. Nor were the respondents' interests any more in need of protection if they had not themselves filed an appeal, as was explained in detail in **G 2/91** (OJ 1992, 206). Finally, the Enlarged Board pointed out that when the sole appellant withdrew his appeal, the suspensive effect of the appeal lapsed and the opposition division's decision thus became final as regards the **substantive issue**.

If the sole appellant says he withdraws his appeal, but the parties are in dispute as to whether he did so admissibly, then the board is empowered to rule on that issue (**T 659/92**, OJ 1995, 519).

After withdrawal of an appeal it is still permissible to decide on ancillary questions (**T 85/84**). Thus in **T 21/82** (OJ 1982, 256), **J 12/86** (OJ 1988, 83), **T 41/82** (OJ 1982, 256) and **T 773/91**, the board of appeal dealt with requests for reimbursement of the appeal fee filed after withdrawal of the appeal, and in **T 117/86** (OJ 1989, 401), **T 323/89** (OJ 1992, 169), **T 614/89** and **T 765/89** with requests for apportionment of costs.

According to **T 195/93**, the fact that the appellant withdrew his appeal after an intervention was filed could not immediately lead to termination of the proceedings. The board had to consider the admissibility of the intervention (see above, p. 319 f.).

In **T 6/92** the board took the view that partial withdrawal of an appeal by the sole appellant (opponent) following an allowable limitation of the patent's subject-matter under Art. 123 during appeal proceedings deprived the board of its discretionary power to examine the substantive merits of the remaining, limited subject-matter. The patent therefore had to be granted in its amended form.

5.2 Withdrawal of the opposition during appeal proceedings

The effects of this vary, depending on whether the opponent in the appeal proceedings is the appellant or the respondent.

If he is the appellant, under the established case law his statement withdrawing the opposition is regarded as 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 withdrawal of the opposition are irrelevant (see **T 381/89**).

However, **T 544/89** found that appeal proceedings could be continued by the EPO of its own motion where the patent could be revoked or limited.

This was not confirmed in **G 8/93** (OJ 1994, 887), in which the Enlarged Board took the view that if the opponent as sole appellant filed a statement withdrawing his opposition this immediately and automatically terminated the appeal proceedings, irrespective of the patentee's consent. The proceedings were also terminated if in the board's view the requirements under the EPC for maintaining the patent were not met.

In taking this view, the Enlarged Board emphasised once again the distinction between the power to initiate and continue proceedings and the power to clarify the facts in pending proceedings. According to its case law, in appeal proceedings the former is **exclusively** the province of the appellant, whereas the latter may be exercised by the board subject to Art. 114 provided proceedings are pending.

If however the opponent is the respondent, under established case law withdrawal of the opposition does not affect the appeal proceedings (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 358/90**, **T 548/90**, **T 247/91**, **T 138/91**, **T 194/90**, **T 629/90** (OJ 1992, 654), **T 627/92**, **T 329/92** and **T 822/92**). However, under **T 789/89** (OJ 1994, 482) withdrawal of an opposition by the respondent means the respondent ceases to be party to the appeal proceedings in respect of the substantive issues; he remains party to them only as regards apportionment of costs (confirmed by **T 82/92**, **T 884/91**, **T 329/92**). **T 484/89** on the other hand found that the respondent remained party to the proceedings although not obliged to take an active part.

In **T 634/91** the board took a different view. Here again, the patentee had appealed against revocation of his patent by the opposition division. The opponents withdrew their opposition in the oral proceedings before the board of appeal. The board held that withdrawal of opposition **automatically** meant that the opposition and the appeal against it ceased to exist, irrespective of the opponent's party status in the appeal proceedings. The board could nevertheless continue the proceedings of its own motion under Art. 114(1) and R. 60(2). (**T 197/88**, OJ 1989, 412, cited by the board, had endorsed continuation of the proceedings by the **opposition division** of its own motion in a case where the opposition had been withdrawn after the communication under R. 58(4) had been issued.) However, this was not mandatory, but merely desirable in cases where the facts could be ascertained without time-consuming investigations and the opponent's assistance. (This principle was advanced in **T 129/88** (OJ 1993, 598) for examination of a prior public use following withdrawal of the opponent/respondent from the proceedings). If the proceedings were continued ex officio the board merely had to examine whether - prima facie and in the light of the file as it stood when the opposition was withdrawn - complete or partial revocation of the patent could have been seriously considered.

For the consequences of withdrawal of the opposition as regards the board's powers of ex officio examination of the facts, see "Examination of the facts" on p. 327 above.

5.3 Request for 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, under established case law the appeal proceedings are terminated by a decision ordering revocation of the patent, without going into the substantive issues. This is supported by Art. 113(2) which provides that a 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 patentee expressly requests revocation. Thus even a statement requesting - incorrectly at this stage in the proceedings - withdrawal of the application (instead of revocation of the patent) should be 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 and submitted to 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 315/91**, **T 322/91**, **T 370/91**, **T 936/91**, **T 924/92**; see also p. 237f.).

In **T 347/90** the **patent proprietor** was the **appellant**, and 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, dismissed the appeal without going into the substantive issues, and thus confirmed the patent's revocation by the department of first instance.

The board of appeal came to the same conclusion in **T 18/92**. In this case the patent proprietor/appellant had specifically requested revocation of the patent.

In **T 973/92** the respondent/patent proprietor stated that the patent "had been abandoned since 24.1.1992". The board held that such a declaration could not be considered a request for revocation, because it did not indicate that the patent had been abandoned ab initio. The case law on requests for revocation therefore did not apply here, and it was obliged to examine the appeal as to its merits.

5.4 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 during the appeal proceedings the European patent had expired in all the designated contracting states. The opponent/appellant had not requested continuation of the appeal proceedings (see also **T 762/89**). It should be noted here that termination of proceedings has no repercussions corresponding to those of revocation under Art. 68; instead, it is based on the fact that the patent has already expired without effect ab initio for each designated contracting state.

6. Admissibility of the appeal

6.1 Appealable decision

Under Art. 106(1), first sentence, appeals lie against **decisions** of the EPO departments listed in that article.

J 12/85 (OJ 1986, 155) confirmed that boards can hear appeals only against the decisions taken by other EPO departments. Thus they cannot for example examine a request under R. 89 for correction of a contested decision. Not until the request has been decided at first instance can the matter be referred to the board.

In **T 5/81** (OJ 1982, 249) the board confirmed that appeals could only be directed against decisions within the meaning of Art. 106(1), and not against the preparatory steps referred to in Art. 96(2) and R. 51(3). The Enlarged Board ruled in **G 5/91** (OJ 1992, 617) that there was no legal basis under the EPC for separate appeal against an order by a director of a department of first instance (such as an opposition division) rejecting an objection to a member of the division on the ground of suspected partiality. The composition of the division could however be challenged on such a ground in an appeal against its final decision or against a separately appealable interlocutory decision under Art. 106(3).

T 26/88 (OJ 1991, 30), which held that a document stating that the patent was revoked under Art. 102(4) and (5) did not constitute a decision, was overruled by **G 1/90** (OJ 1991, 275). See also p. 303 f.

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.

Separate appeal is possible against interlocutory decisions regarding admissibility of the opposition (eg **T 10/82**, OJ 1983, 407) or maintenance of a patent in amended form (see eg **T 247/85** and **T 89/90** (OJ 1992, 456) and also p. 305 above).

In **J 13/83** the board made it clear that a communication under R. 69(1) was not an appealable decision. Whether a document constitutes a decision or a communication depends on the substance of its contents, not on its form (**J 8/81**, OJ 1982, 10) (see also **J 26/87**, OJ 1989, 329). In **T 934/91** (OJ 1994, 184) the board ruled that a "decision" did not need to involve a reasoned choice between legally viable alternatives.

In **J 13/92** the board confirmed the principle that a document's content - not its form - determined whether it was a communication or an appealable decision. In this case the applicant had stated that he was dropping the application, and withdrawal was published in the European Patent Bulletin. The applicant then requested that his declaration of withdrawal be considered null and void and the proceedings resumed. This request was rejected by the formalities officer in a "communication". The board found that this communication was a decision.

J 2/93 (OJ 1995, 675) ruled that a letter bearing the letterhead of an EPO Directorate-General and signed by an EPO Vice-President was not appealable under Art. 106 if it was evident from its content that it did not constitute a decision and from its form that it did not emanate from any of the departments listed in Art. 21(1).

In **T 838/92**, the patentee asked the board to declare null and void the minutes of the first-instance oral proceedings, arguing that they had not been drafted in accordance with R. 76. The board ruled that it could not do so, because the minutes of oral proceedings did not constitute a decision.

6.2 Board competent to hear a case

The responsibilities and composition of boards are laid down in Art. 21. In **G 2/90** (OJ 1992, 10) the Enlarged Board made it clear that under Art. 21(3)(c), the Legal Board of Appeal was competent only for appeals against decisions taken by an examining division consisting of fewer than four members and which do not concern refusal of the application or grant. In all other cases, ie those covered by Art. 21(3)(a), (3)(b) and (4), the technical boards are competent. The provisions of Art. 21(3) and (4) governing responsibilities and composition are not affected by R. 9(3).

In **J 30/94** the appeal was against an examining division decision refusing a request for correction of errors under R. 89. As this decision concerned neither a refusal of a European application nor the grant of a European patent, the Legal Board of Appeal was considered responsible for examining it under Art. 21(3)(c). The board held that the fact that the request for correction related to a decision to grant a European patent did not alter its competence to consider it, because what was under appeal was the decision to refuse the request for correction, not the decision to grant a patent.

In **T 850/95** (OJ 1996, ***) the same case occurred, but here the board found that the Legal Board's interpretation of Art. 21(3)(a) in **J 30/94** was not the only one possible. In **J 30/94** the words "the decision concerns ... the grant of a European patent" in Art. 21(3)(a) had been given the same meaning as "the decision under appeal orders the grant of the European patent", and therefore the requirements of Art. 21(3)(a) had not been regarded as fulfilled. However, this wording could also be understood in the broader sense of "the decision under appeal is related to the grant of the European patent". On that basis, correction of the decision to grant could be regarded as being related to or concerned with

the grant of the patent. Examining the object and purpose of Art. 21(3)(a) and(c), the board found that neither the EPC nor its “travaux préparatoires” gave a clear answer on this question of competence. Unable to come to an unequivocal conclusion on the interpretation to be given to Art. 21(3)(a), the board referred to the Enlarged Board the question of whether appeals against an examining division decision refusing a request under R.89 for correction of the decision to grant should be heard by a technical board (Art. 21(3)(a) and(b)) or by the Legal Board (Art. 21(3)(c)), and - if the answer depends on the circumstances of the case - who decides which of the two is responsible.

The case is pending as **G 8/95**.

6.3 Entitlement to appeal

6.3.1 Entitlement to appeal - formal aspects

Under Art. 107, an EPO decision can be appealed only by a party to the proceedings which gave rise to it.

In **T 563/89**, the opponent company had been sold to another company prior to the appeal proceedings, which had been brought by the latter as successor in title to the former. Citing **G 4/88** (OJ 1989, 480) (see also p. 285), the board found that the right to lodge an appeal had been transferred together with the company. The appeal was therefore admissible.

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

In **T 340/92**, the appellant was a company that had obviously been named in the notice of appeal by mistake, instead of a subsidiary which was the real opponent. The actual appellant was the only party adversely affected by refusal of the opposition, and was readily identifiable through its representative who was named in the appeal dossier. The board held that this deficiency could be remedied under R. 65(2), and when the appellant did so in due time the appeal was considered to be admissible.

6.3.2 Party adversely affected

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

(a) A party is adversely affected if the decision does not accede to his (main) requests. To establish whether a party has been adversely affected, it is necessary not only to compare his objective with the substance of the decision but also to check that he was thus affected at the time the contested decision was delivered and the appeal filed (see **T 244/85**, OJ 1988, 216).

Thus in **J 12/83** (OJ 1985, 6), the board found that an applicant for a European patent might be “adversely affected” within the meaning of Art. 107 by a decision to grant the patent, if it is granted with a text not approved by him under Art. 97(2)(a) and R. 51(4). In **J 12/85** (OJ 1986, 155) the board held that he could be “adversely affected” within the meaning of Art. 107 only if the grant decision was inconsistent with what he had specifically requested (see also **T 114/82** and **T 115/82**, both in OJ 1983, 323, and **T 1/92**, OJ 1993, 685). **J 5/79** (OJ 1980, 71) ruled that an applicant whose priority right was found to have lapsed because he failed to file the priority documents was no longer adversely affected if re-established in his rights before the application was published.

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

In **T 73/88** (OJ 1992, 557) the board ruled that if a patentee's request that his patent be maintained was upheld by a decision of the opposition division, he could not appeal against adverse reasoning in the decision (here, regarding his claim to priority) because he was not adversely affected by it within the meaning of Art.107.

(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 for Examination of March 1985, D-VI, 6.2.1) and also in many appeal proceedings led to a referral to the Enlarged Board in **T 271/85** (OJ 1988, 341). A board held for example that silence in respect of a communication within the meaning of R. 58(4) was to be interpreted as a sign of agreement to 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 had not notified his disagreement to maintenance of the patent as amended within the one-month period pursuant to R. 58(4) was inadmissible because he could not claim to have been adversely affected). The point of law referred to the Enlarged Board was: "Is the appeal of an opponent admissible in a case where, following notification of the communication pursuant to R. 58(4), 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 in decision **G 1/88** (OJ 1989, 189) was that the fact that an opponent had failed, within the time allowed, to make any observations on the text despite an invitation to do so under R. 58(4) did not render his appeal inadmissible. Its reasoning was *inter alia* as follows: "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 Arts. 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 was not rendered inadmissible by the party's failure to respond within the time limit to the opposition division's invitation to file observations under Art. 101(2).

In **T 831/90**, the appellant submitted two new claims in writing after the communication under R. 51(6) had been issued. The examining division did not consider them. The board held that the appellant was not adversely affected by this decision, as he had already approved the wording of the patent (note, however, **G 7/93**, OJ 1994, 775; see p. 259 f).

In **T 156/90**, the opponent had stated that he would have no objection to maintenance of the patent if the claims were amended in a specified way. The patent proprietor amended the claims accordingly. However, the opponent appealed against the interlocutory decision maintaining the patent as thus amended, arguing that the circumstances had changed and he was no longer bound by his consent. The appeal was dismissed as inadmissible.

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

In **T 273/90**, the board concluded that legal uncertainty arising from inadequate adjustment of the description to amended claims constituted sufficient grievance under Art. 107, as the commercial interests of the appellant could be adversely affected (likewise **T 996/92**).

In **T 793/91**, the board found an applicant to have been adversely affected by rejection of his application even if the amendments requested at the appeal stage could already have been made during the proceedings before the examining division.

In **T 266/92** the opponent had declared in opposition proceedings that he would withdraw his request for oral proceedings if the patent proprietor agreed to an amended wording of the patent, as indeed he did. The opposition division maintained the patent in amended form. The opponent filed an appeal against this decision together with a request that the patent be revoked. The patent proprietor took the view that the opponent had not been adversely affected because by withdrawing his request for oral proceedings he had implicitly approved the wording of the patent. The board of appeal held that withdrawal of a request for oral proceedings did not in itself imply withdrawal of any other existing request. There might be reasons other than consent - such as a wish to save costs or obtain a quicker decision - for a party who originally asked for oral proceedings to drop his request. Accordingly, the board concluded that the appellant was adversely affected within the meaning of Art. 107, and was entitled to appeal.

In **T 549/93** the examining division sent the applicant the decision granting the patent on 1.4.1993. On 7.4.1993 the applicant filed a divisional application. On 14.4.1993 he filed a notice of appeal on the grounds that because of the grant decision he had lost the opportunity under decisions **J 11/91** and **J 16/91** (both OJ 1994, 28) to file a divisional application after indicating approval of the text of the patent, and was therefore adversely affected. The board held that the appellant was not adversely affected by a possible loss

of rights with regard to the divisional application. The sole decisive factor was that the decision granted a patent to which the applicant had expressly indicated his agreement (**J 12/85**, OJ 1986, 155, confirmed). The question as to whether the legal validity of the subsequently filed divisional application would be affected if the contested decision became valid arose only in relation to examination of the divisional application.

In **T 833/90** the board held that an appeal should be considered admissible if it was not clear or ascertainable whether the opponent/appellant had agreed to maintenance of the patent.

6.3.3 Transfer of party status

G 4/88 (OJ 1989, 480) ruled that a company's opponent status was transferable to the firm which had taken it over.

Following this up, **T 659/92** (OJ 1995, 519) ruled that party status was transferable at any stage during pending appeal proceedings if transferred together with the business assets or part of the company in whose interests the appeal had been filed.

In **T 563/89** the opponent company had been sold to another company prior to proceedings on an appeal filed by the latter as successor in title to the former. Citing **G 4/88** (OJ 1989, 480), the board held that the right to lodge an appeal had been transferred together with the company. The appeal was admissible.

In **T 553/90** (OJ 1993, 666) the applicant had transferred his patent after grant to a firm which had been party to the opposition and ensuing appeal proceedings. At the opposition stage the opponent/appellant had already challenged the legitimacy of the new patentee's claim, which however the opposition division had affirmed. The (five-member) board of appeal ruled that the division was not competent to decide on the respondent's claim. In first-instance proceedings, the Art. 60(3) fiction applied. Nor was the board entitled to take a decision on the matter under Art. 111(1).

6.4 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 under appeal. Under R. 64(a) the notice of appeal must 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.

6.4.1 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.

In **T 613/91** the appellant's precise address was missing from the notice of appeal, but was known to the parties and the board from the opposition proceedings. The board held that there was sufficient information for identification within the meaning of R. 64(a).

In **T 867/91** the notice of appeal designated the patent in suit by its number and the decision under appeal by its date. It also contained the name of the patentee. Furthermore, the notice of appeal contained the name and address of the appellant's representative. It did not contain the address of the appellant and did not expressly state that the patentee was the appellant. The board held that the requirements of R. 64(a) had been met since the notice of appeal provided sufficient information to identify the appellant and his address. 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**).

In **T 371/92** (OJ1995, 324) the board confirmed previous decisions according to which payment of an appeal fee in itself does not constitute the valid filing of an appeal. Nor does notification of the case number and the responsible board of appeal by the registry constitute a decision under R. 69(2) recognising that an appeal is pending.

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, the board tries to ascertain whether the relevant information can be determined from the totality of the appellant's submissions (see **T 32/81**, OJ 1982, 225, and **T 7/81**, OJ 1983, 98, see also **T 932/93**).

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 department of first instance (see also **T 1/88**).

T 631/91, **T 727/91** and **T 273/92** confirmed the principle that the appeal's scope can be ascertained from the appellant's overall submissions if the request filed in the appeal proceedings does not make this clear. Since no indication was made to the contrary in the appellant's submissions, the board of appeal assumed that he wished to file a request in the appeal proceedings along the same lines as that filed in the opposition proceedings (see also **T 925/91**, OJ 1995, 469).

In case **T 632/91** the notice of appeal did not explicitly identify the extent to which amendment or cancellation of the decision under appeal was requested. The substance of the decision under appeal was the refusal of the then pending sole version of the patent application. The board was of the opinion that the wording "... we hereby file notice of appeal to the decision ..." had to and could only be construed as a request to set aside entirely the decision under appeal and to grant a patent on the basis of the documents of the European patent application to which the decision under appeal referred. Therefore, the board concluded that the appeal fulfilled the requirements of R. 64(b) and was admissible.

6.4.2 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; see also p. 254 f.

6.5 Statement of grounds of appeal

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

6.5.1 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 ruled that the grounds for appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. The arguments must be clearly and concisely presented to enable the board and the other party or parties to understand immediately 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. Whilst passages from the literature setting out the state of the art may - provided sufficiently precise reference is made to them in the grounds of appeal - be considered an integral part of the grounds, 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**, **T 706/91**.

Further to 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 dismissed 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 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 **T 1/88** the board considered that the criteria of **T 220/83** and **T 213/85** were satisfied by a statement of grounds in which it was merely argued that a document (e), which allegedly showed that the process of the patent in suit was obvious, had not been properly evaluated, without going into the question of inventive step, on the lack of which the contested decision had been partly based.

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 **T 611/90** (OJ 1993, 50) the statement of grounds developed an entirely fresh case on lack of novelty and did not discuss the reasons upon which the contested decision was based. The board considered the appeal to be admissible because the fresh reasons presented, though unconnected with those in the decision under appeal, were still within the same opposition **ground** (see also **T 525/88**, **T 938/91**, **T 219/92**, **T 229/92**, **T 847/93**).

In **T 3/92** the board took the view that the grounds for appeal were adequate, even if new grounds submitted in the notice of appeal were in no way connected with the reasons for

the contested decision, but were in the same category of grounds as those submitted pursuant to Art. 100 in the preceding opposition proceedings in support of the opposition.

In **T 925/91** (OJ 1995, 469) the board held that if the opposition division has considered the merits of a case but nevertheless rejected the opposition as inadmissible, and if the appellant has only dealt with the substantive arguments in his statement of grounds for appeal, the grounds for appeal are not adequately defined (see **T 213/85**, **T 169/89** and **T 534/89**). However, since the action of the opposition division was erroneous and misleading (its having examined the substance of the opposition although considering it inadmissible), the principle of good faith (**G 5/88**) dictated that the appeal should nevertheless be held to be admissible.

In **T 574/91** the appellant merely argued that the opposition division “had missed the point”, without discussing the reasons for the decision. The board considered this statement of grounds admissible even though it did not discuss any of the arguments in the contested decision and the sole argument put forward bore no connection with the decision. The board took the view that according to established case law, an appellant who wishes to raise objections to the content of the decision under appeal would have to set out the specific factual and legal reasons for doing so in the statement of grounds. In the absence of such specific objections on the part of the appellant, the appeal in this case was limited to a review of the grounds for revocation of the patent.

In **T 45/92** the appellant disputed the accuracy of the decision of first instance because a mistake had been made when assessing inventive step. The board accepted that the mistake had been made but considered the appeal inadmissible for lack of grounds; it did not consider the mistake to be very serious and the recognition of inventive step in the contested decision had **only** been based **inter alia** on the mistake in the assessment. The appellant had not discussed the other considerations with respect to inventive step. The obligation to submit a statement of grounds had not therefore been observed and the appeal was therefore inadmissible.

In **T 961/93** the board took the view that the opponent’s appeal is sufficiently substantiated if the sole ground for the appeal is that the patent proprietor has submitted a request for the patent to be revoked.

6.5.2 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 reasons which are no longer valid.

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 department of first instance is correct only on the basis of facts and arguments presented before that department. An appeal can be based on the ground that - even though the correctness of the first-instance decision is not questioned - subsequently amended claims have been submitted which are not consistent with the reasoning of the decision (see also **T 563/91**).

In **T 459/88** (OJ 1990, 425) the board expressly stated that the case law on statements of grounds was not applicable where the circumstances change after the department of first instance had given its decision, as exemplified in decision **T 105/87**. The same principles were valid where the change involved was a request by the patent proprietors, after the opposition division took its decision, 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, since the conditions enunciated in an earlier 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 whose omission formed the basis of the decision has now been completed.

The board of appeal held in **T 729/90** that an appeal can be admissible if, despite its not being clear from the statement of grounds why the contested decision is incorrect, claims are put forward in **auxiliary requests** which overcome the objections of the department of first instance.

6.5.3 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**, **T 646/92**).

However such a statement of grounds has been accepted for the purpose of some decisions. In **T 355/86** a statement of grounds which referred generally to previous submissions was regarded 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 - and should be accorded - the same effect as a new filing of this earlier statement.

In **T 725/89** a written submission to the opposition division, commenting on the result of the oral proceedings and received by the opposition division before it sent out its written decision, was made the subject of the statement of the grounds of appeal. The board of appeal accepted this as a valid statement of grounds.

6.5.4 References to other documents

The question has also arisen as to 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, even though the decision under appeal held that the claim did not involve an inventive step. The board considered that such a statement of grounds did not fulfil the requirements of Art. 108.

In case **T 869/91** the appellants alleged lack of inventive step in their 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, the conclusions which the appellants wished to be drawn from these documents were evident.

7. Conclusion of the decision-making process

7.1 Closure of the substantive debate

The EPC does not prescribe when the substantive debate should be regarded as closed. Particularly if oral proceedings take place but end without a decision being delivered, it often has to be decided whether or not subsequently filed documents should be taken into consideration.

A distinction needs to be made between the following situations:

(a) the board does not announce its decision at the end of the oral proceedings, but reserves the right to deliver its decision subsequently in writing, but without explicitly stating that the debate is closed;

(b) the board declares at the end of the oral proceedings that the debate is closed and announces that the decision will follow in writing.

In the first case, the boards generally find that submissions filed after the oral proceedings are out of time and can only be considered if they are relevant (Art. 114(2)). See for example **T 456/90** and **T 253/92**.

In the second case, two solutions are adopted by the boards. One - adopted in **T 762/90** - consists of stating in the section of the decision "Summary of facts and submissions" that a document was filed after closure of the debate and that the board will not consider it. Under this option, the document is automatically excluded from the file. The same solution was adopted in **T 411/91**.

The other solution - adopted in **T 595/90** (OJ 1994, 695) - is to rule that submissions filed after closure of the debate cannot be taken into account unless the board decides to reopen the debate. Under this option the submission has to be assessed.

7.2 Decision taken as the file stands

In **T 784/91** the board took the view that if in ex parte proceedings the appellant indicates that he does not wish to comment on the case, this can be construed as signifying agreement to a decision being taken on the case as the file stands.

7.3 Proceedings after delivery of the decision

In **T 843/91** (OJ 1994, 818) of 17.3.1993 it was stated that after a decision has been taken the board is no longer empowered or competent to take any further action apart from drafting the written decision.

In **T 304/92**, the respondent asked to file new claims after the Chairman had announced the board's decision. The Chairman rejected this request. The request and the response were recorded in the summary of facts.

In **T 212/88** (OJ 1992, 28), the appellant submitted a request for apportionment of costs after the substantive decision had been announced at the end of the oral proceedings. The board allowed this request for the following reasons: "The practice before the boards of appeal is that all requests by parties, including any request as to costs, should be made before any decision is announced in oral proceedings. ... However, as far as the board is aware, the above practice has not been published in any form, and there is, therefore, no reason why parties or their representatives should be aware of it. In these circumstances,

exceptionally in this case, the board considered the appellant's request even though the substantive decision had been announced."

In **T 598/92** the decision was delivered at the end of the oral proceedings. On the following day, the appellant requested correction of an error in claim 1. In its reasons for the decision, the board agreed to correct the error.

In **T 296/93** (OJ 1995, 627) the board issued the decision at the end of the oral proceedings on 28.7.1994. On 10.8.1994 the respondent sent a new statement to which the appellant replied on 17.8.1994. In the reasons for the decision the board refused to take these statements into consideration as they had been submitted after the decision had been delivered.

8. 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 should normally 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 which introduced it, then remittal is not ordered, as depriving the party of the opportunity to have the issues considered at two instances is not unfair in such a case (see **T 416/87**, OJ 1990, 415, confirmed also in **T 626/88** and **T 527/93**).

If no new documents are introduced, but merely arguments presented from a different point of view, or if the claims are maintained on the basis of an auxiliary request which the department of first instance 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 5/89**, OJ 1992, 348, **T 392/89** of 3.7.1990 and **T 137/90**).

In a case where substantial amendments to the claims requiring substantial further examination are proposed on appeal, the case should be remitted to the examining division to be examined accordingly - if at all - by the examining division after the latter has exercised its discretion under R. 86(3), final sentence. In this way, the applicant's right to appeal to a department of second instance is maintained, both in relation to the exercise of discretion under 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 200/86**, **T 296/86**, **T 98/88**, **T 423/88**, **T 501/88**, **T 47/90** (OJ 1991, 486).

In **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, once the correction had been made, the subject-matter of the application was patentable, the appellants had expressly waived their right to have the issues considered at two instances, and the examining division had already indicated that it was favourably disposed on the question of patentability.

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 remittal to the department of first instance. This decision applied to both opponents since the case could not be divided.

9. Binding effect

9.1 General principles

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.

The problem of being bound by an earlier board of appeal decision where a case is remitted also arises in connection with a subsequent appeal against the ensuing decision.

The boards of appeal take the view that a binding effect also exists in this case (see for example **T 21/89**, **T 78/89**, **T 1063/92**, **T 153/93**, **T 757/91**, **T 55/90**, **T 113/92**), often on the basis that board of appeal decisions are final and without appeal, so that no EPO body - not even boards of appeal - can take a new decision on facts which have already been decided.

In **T 843/91** of 17.3.93 (OJ 1994, 818), for example, it was stated that "decisions of the boards of appeal are final. This derives from the fact that a decision can only be contested where it is expressly provided for under statute and there are no provisions in the European Patent Convention allowing an appeal to be filed against a decision of a board of appeal. Art. 21(1) and 106(1) state that the only decisions which are subject to appeal are those of the Receiving Section, examining division, opposition division and Legal Division. When the first board of appeal delivered its decision, the content and text of the patent claims became *res judicata* and could no longer be amended in proceedings before the EPO." (See also **T 153/93**).

In **T 934/91** the board held in relation to the meaning of "ratio decidendi" used in Art. 111(2) - citing a dictionary definition - that it was well accepted that the ratio decidendi of a decision was the ground or the reason for making it - in other words, the point in a case which determined the outcome of the judgment. The board also concluded that the doctrine of "*res judicata*" applied in the particular circumstances of the case in point 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. The fact that the boards of appeal were courts had already been established in **G 1/86** (OJ 1987, 447, point 14 of the reasons, German and French versions - the board held that the English translation "act as courts" was inaccurate).

The board stated in **T 288/92** that a board of appeal decision only has the binding effect referred to in Art. 111(2) if the case is remitted to the department of first instance. A board of appeal decision in another case is not binding on the department of first instance. If the latter does not concur with the opinion of the board of appeal, this may be undesirable but does not constitute a procedural violation. (See also **J 27/94**).

9.2 Type of remittal

The legal effects of Art. 111(2) differ in scope according to the type of remittal.

9.2.1 Remittal only for adaptation of the description

In **T 757/91** the board decided as follows: if, after the case was remitted, the only issue still outstanding was the adaptation of the description to the amended claims which were held valid in the first appeal proceedings, that issue was the only one which could be considered in further appeal proceedings. When the first board of appeal delivered its decision, the content and the text of the patent claims became *res judicata* and could no longer be amended in proceedings before the EPO (see also **T 55/90**, **T 113/92**, **T 843/91** of 5.8.1993 (OJ 1994, 832)).

In **T 1063/92** the board of appeal remitted the case to the opposition division with the instruction to maintain the patent on the basis of the respondent's auxiliary request. The opposition division did so by issuing an interlocutory decision, against which it allowed separate appeal. One of the opponents filed an appeal against the decision, claiming new prior art. He took the view that this had changed the facts of the case and thus Art. 111(2) could not be applied.

The board of appeal rejected the appeal as inadmissible in the absence of a decision subject to appeal in accordance with Art. 106: the first board of appeal decision had become final and the material findings could no longer be called into question. Remittal for the description to be amended did not render it possible to challenge substantive patentability again, as a final decision had been taken on both this point and the scope of the patent. Remittal only took place in so far as the department of first instance had been enjoined to maintain the patent after carrying out the procedure in accordance with Art. 102(3) to (5) and R. 58(4) to (8). With regard to patentability a final decision had been taken on the case, which meant it was not possible to change the facts within the meaning of Art. 111(2) by submitting new documents (point 2 to 2.6 of the reasons).

In **T 153/93**, in its first decision, the board of appeal had ordered the maintenance of the patent on the basis of the claims according to the main request, as amended in the course of oral proceedings. Its order remitting the case to the opposition division had made no mention of any adaptation of the description that might be necessary. In the further proceedings the patentee had proposed some amendments to the description which were accepted by the opposition division. The opponent lodged an appeal against this decision and challenged the novelty and clarity of the claims as ordered to be maintained by the board of appeal. Both novelty and clarity had been pleaded, fully argued and decided upon by the board of appeal. The board followed decision **T 843/91** of 5.8.1993 (OJ 1994, 832), stating that all findings of fact that were **a conditio sine qua non** of the finally binding parts of the decision were *res judicata* with the result that new facts, evidence or arguments seeking to cast doubt upon these facts could not be considered either by the opposition division or the board of appeal.

9.2.2 Remittal for the continuation of proceedings

In **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 for allowability of the rejected claimed subject-matter cannot thereaf-

ter be re-opened, either by the examining division during its further prosecution of the case, or by the board of appeal in any subsequent appeal proceedings (see also **T 21/89**).

In **T 255/92** the case was remitted by the board itself "for further prosecution". Under point 9 of the reasons, the board stated, "For avoidance of doubt, it is pointed out that according to Art. 111(2) the examining division is bound by the present decision only to the extent that it has been decided that the subject-matter of claim 1 as amended during the oral proceedings before the examining division on 15.10.1991 involves an inventive step over the prior art considered in the present decision." (See also **T 366/92**).

In **T 26/93** the patent had been granted pursuant to a decision of the board of appeal in **T 194/83**. In the latter decision, the board had concluded that the application did not contravene Arts. 83 and 123(2). The patent was opposed by 13 opponents, all of them requesting that the patent be revoked under Art. 100(a) for lack of novelty and/or inventive step. Some oppositions were also based on the grounds for revocation contained in Art. 100(b) and (c). The opposition division considered the objection under Art. 100(b) and (c) and took the view that, since on these points the facts were the same as those on which the board of appeal had taken its decision in **T 194/83**, the opposition division was bound under Art. 111(2) by that decision.

The board of appeal in the present case concluded that the opposition division was incorrect on this point. Under Art. 111(2), if a board of appeal remits the case for further prosecution to the department whose decision was appealed, that department was bound by the ratio decidendi of the board in so far as the facts were the same. In the present context, the case had been remitted to the examining division. After grant, the opposition division was in no way legally bound by the previous decision of the board of appeal even in so far as the facts were the same.

On the other hand, in the board's opinion it went without saying that the opposition division, which was a department of first instance of the EPO, should not deviate from a previous decision of a board of appeal, which was a department of second instance, on a point where the facts were the same, unless there appeared to be very clear reasons for doing so.

10. Interlocutory revision

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

In case **T 139/87** (OJ 1990, 68) the board of appeal made it clear that an appeal by an applicant for a European patent was to be considered well founded within the meaning of Art. 109(1) if the main request of the appeal included amendments which clearly met the objections on which the refusal of the application had been based as indicated by the examining division. In such a case, the department that issued the contested decision **must** rectify the decision. Irregularities other than those that gave rise to the contested decision do not preclude rectification of the decision (see also **T 47/90**, OJ 1991, 486, **T 690/90**, **T 1042/92**, **T 1097/92**, **T 219/93**, **T 647/93**, **T 648/94**).

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.

11. Referral to the Enlarged Board of Appeal

Under Art. 112(1) it is within the discretion of the boards of appeal to refer a case to the Enlarged Board of Appeal if this appears necessary for ensuring uniform application of the law or if an important point of law arises. It was made clear in **T 184/91** that only questions on a specific point, not entire cases, can be referred to the Enlarged Board of Appeal.

The following decisions are mainly those cases in which the request for referral was refused since the others have already been dealt with elsewhere.

(a) Ensuring uniform application of the law

In principle, the boards always refuse requests for referral where there is no contradictory case law and they see no reason for departing from earlier decisions (see eg **T 170/83** (OJ 1984, 605), **T 162/85**, **T 58/87**, **T 5/89**, **T 315/89**, **T 37/90**, **T 323/90**, **T 688/90**, **T 506/91**, **J 47/92**, (OJ 1995, 180) **T 473/92**, **T 952/92**, **T 702/93**).

There is in principle no contradiction where a different application of the same rule is justified by different circumstances (**T 143/91**).

According to **T 373/87** there is also no contradictory case law where a single, unconfirmed decision departs from the case law established by several decisions.

(b) Important points of law

The board took the view in **T 601/92** that in special cases there was no general interest in clarifying points of law; such points were consequently not important.

A purely theoretical interest in clarifying points of law is no justification for referral (**T 835/90**) nor, according to **T 118/89**, should hypothetical points be referred. Any question referred must, moreover, be of a legal nature and not just a question of fact. The board in **T 373/87** and **T 939/92** took the same view. Nor may technical questions be referred according to the board's ruling in **T 181/82** (OJ 1984, 401), in which the appellants requested referral of the question whether a skilled person would readily understand the technical content of a prior art document on the strength of his own knowledge (see also **T 219/83** (OJ 1986, 211), **T 82/93**). In **T 972/91** the board ruled that questions to which no general answer was possible could not be referred. In this particular case the appellant had requested referral to the Enlarged Board of Appeal of the question how a patent claim was to be interpreted and understood in view of the content of the technical teaching.

The boards have not referred questions where they were of the opinion that the requirement on which the question was based had not been fulfilled (eg in **T 727/89**, where the question presupposed that the claim was not novel and the board took the view that it was, **T 162/90** and **T 921/91**).

Where a board intends to rule in favour of the party requesting referral to the Enlarged Board of Appeal, it generally refuses the request (see **T 461/88** (OJ 1993, 295), **T 301/87** (OJ 1990, 335), **T 648/88**, **T 180/92**, **T 469/92**).

According to **T 26/88** (OJ 1991, 30) there is no important point of law to be clarified where the legal situation on which the question was based has changed in the interim and the question is therefore unlikely to arise again very often.

According to **T 247/85** the question of how permission to appeal against an interlocutory decision should be presented does not involve an important point of law.

Even where a question involving an important point of law has arisen, the boards have not

referred it if they could resolve it themselves without any doubt (see **J 5/81** (OJ 1982, 155), **T 198/88** (OJ 1991, 254), **T 579/88**, **T 708/90**) or if the question was not relevant for deciding the specific case (see eg **J 7/90** (OJ 1993, 133), **J 16/90** (OJ 1992, 260), **J 14/91** (OJ 1993, 479), **T 72/89**, **T 583/89**, **T 676/90**, **T 297/91**, **T 485/91**, **T 860/91**).

In **T 82/93** (OJ 1996, 274) no referral was permitted since the question had already been decided by the Enlarged Board of Appeal. In **T 297/88** the board dealt in detail with the question of when it was possible to refer a question which had already been decided by the Enlarged Board. It took the view that, in principle, any answer by the Enlarged Board on a point of law could be called into question if the Enlarged Board's arguments in the contested decision were so weak that doubts as to the correctness of the decision *per se* were unavoidable. This was also the case where the arguments were based on false premises so that for this reason there were doubts about the conclusion drawn. A decision could also be questioned where the premises were correct, the arguments were conclusive and therefore the conclusion was necessarily also correct, but legal or technical developments occurring in the interim made it seem desirable in the public interest to have the question reviewed again by the Enlarged Board.

In **T 208/88** (OJ 1992, 22) a question was referred, even though it was already pending before the Enlarged Board in other proceedings, because new aspects had emerged in this case which were useful for the decision. A referral was also made in **J 15/90**, although the question was already pending, as the board wished to give the Enlarged Board the opportunity to consider another type of case which might be affected by its answer. In **T 803/93** (OJ 1996, 204) the board referred the question whether a person other than an authorised representative could appear before a board in technical cases, thus complementing the question already pending before the Enlarged Board whether this was possible in legal cases. In **T 184/91** a question already pending was referred again in order to give the parties to the proceedings the opportunity to present their case to the Enlarged Board.

Decision **T 79/89** (OJ 1992, 283) involved proceedings against a decision by the department of first instance made after remittal to that department by the same board. The party concerned requested that certain points of law, relating to subject matter already decided by the board in the earlier proceedings, and therefore having the force of *res judicata*, be referred to the Enlarged Board of Appeal. The board refused this request since it had no power to review such matter. The proper interpretation of Art. 112(1)(a) in context is that a board may only refer questions of law to the Enlarged Board of Appeal "during proceedings on a case" and before it has decided on the issues in the appeal in relation to which such questions of law are considered to arise. The Enlarged Board is not a department of third instance within the EPO, but part of the department of second instance constituted by the boards of appeal.

12. Filing of amended claims in appeal proceedings

12.1 Overview

Several decisions 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 EPO. The EPO is concerned here with ensuring both that the procedure is streamlined and that the opponent is granted sufficient opportunity to comment on alternative claims.

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. The legal basis for admitting amended claims in appeal proceedings is provided by R. 86(3), according to which amendments in examination proceedings require the consent of the examining division. The discretion to refuse late-filed requests accorded to the examining division under R. 86(3) may also be exercised by the opposition division and therefore, by virtue of R. 66(1), by the boards of appeal (**T 63/86**, OJ 1988, 224, ex parte, **T 29/83**, inter partes, **T 38/89**, **T 840/93**, OJ 1996, ***, inter partes). The principle by which proceedings before the EPO should be speedily concluded, in the interests in particular of the general public and the parties involved, is most clearly expressed in R. 86(3). Although not stated with the same degree of clarity in Arts. 101 and 110, this principle also applies in opposition and opposition appeal proceedings (**T 833/90**). In a number of decisions the boards also referred, in view of possibly unjustified procedural delays, to Art. 11(3) RPBA, according to which a case should be ready for decision at the conclusion of oral proceedings before the board (**T 29/83**, **T 626/90**, **T 48/91**).

In a more recent decision, **T 840/93** (OJ 1996, ***), the board pointed out that, as stated by the Enlarged Board of Appeal in **G 9/91** (OJ 1993, 408), the purpose of the appeal proceedings inter partes is mainly to give the losing party the possibility of challenging the decision of the first instance on its merits. Thus, a patentee who has lost before the opposition division has the right to have the rejected requests reconsidered by the board of appeal. The board further concluded that to file an appeal not only in an attempt to reverse the decision on one of the requests actually considered by the opposition division, but also on the basis of new requests raising issues never considered by the opposition division is not in accordance with the purpose of the appeal proceedings. The only justification for admitting late-filed requests is if the patentee would otherwise be deprived of any opportunity of still getting a patent. However, where this "last-chance" argument does not apply, the board should confine itself to its appellate role, and decide only requests which have already been considered by the opposition division in the exercise of its discretion under R. 86(3) to refuse to allow into the proceedings any requests not considered by the department of first instance.

In principle the boards allow late-filed amended or auxiliary requests during the appeal procedure provided that such requests are bona fide attempts to overcome objections raised and, furthermore, are clearly allowable. Amendments may be refused in **opposition appeal proceedings** if they are neither **appropriate** nor **necessary** within the meaning of Art. 101(2), R. 57(1) and R. 58(2) (**T 406/86**, OJ 1989, 302, **T 295/87**, OJ 1990, 470).

In **T 95/83** (OJ 1985, 75, inter partes) it was decided that amendments not submitted in good time before oral proceedings in appeal proceedings should only be considered on their merits where there is some clear justification both for the amendment and for its late submission. In **T 153/85** (OJ 1988, 1, ex parte) it was added that the board might justifiably refuse to consider new claims filed at a very late stage, for example during the oral proceedings, if such claims are not **clearly allowable**.

In **T 51/90** and **T 270/90** (OJ 1993, 725) it was emphasised that for reasons 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** (ex parte) 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.

12.2 Reinstatement of claims in appeal proceedings

The Enlarged Board of Appeal recently addressed the question in **G 9/92** and **G 4/93** (OJ 1994, 875) of whether the patent proprietor can reinstate granted claims in the appeal proceedings following maintenance of the patent in a limited form. It pointed out that the patent proprietor who has not filed an appeal is only a party to the appeal proceedings under Art. 107, second sentence. The EPC does not provide for the possibility of a cross-appeal without limit of time. Unlike the rights he would have as appellant, his requests are therefore subject to restrictions. By not filing an appeal, he has indicated that he will not contest the maintenance of the patent in the version accepted by the opposition division in its decision. He is therefore primarily limited to defending this version. Any amendments he proposes in the appeal proceedings may be rejected by the board of appeal if they are neither appropriate nor necessary, which is the case if the amendments do not arise from the appeal.

In **T 266/92** of 17.10.1994 **only** the opponent lodged an appeal and requested the revocation of the patent. During oral proceedings before the board however, the respondent (patent proprietor) requested that the patent be maintained as granted with broader claims than those allowed by the opposition division. The board applied the above-mentioned principles and held that the respondent's request to restore the patent to the form in which it was granted did not arise as a consequence of issues raised by either the appellant or the board and was therefore inadmissible.

The case law established prior to **G 9/92** and **G 4/93** on the question of whether it is admissible to reinstate a patent in an earlier, broader version, after having proposed limited claims, in order to meet the objections raised by the opponent or the opposition division, must henceforth be assessed in the light of these two cases: the principles continue to be applicable, but the patent proprietor will now have to file an appeal himself if he wishes to reinstate his patent in appeal proceedings.

In **T 123/85** (OJ 1989, 336), which is frequently quoted, the board held that 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** that part of his patent as granted. It follows that a patentee, having offered a restrictive amendment in order to overcome an opposition, is entitled to reintroduce into his claims subject-matter which he has previously offered to delete, provided that such amendments do not constitute an **abuse** of procedure. This line was also followed in **T 155/88**, **T 331/89**, **T 217/90**, **T 10/91**, **T 369/91** (OJ 1993, 561), **T 705/91** and **T 715/92**. In **T 576/89** (OJ 1993, 543), however, the board held that the patent proprietor did not need to file a cross appeal. In this respect this decision has been superseded by **G 9/92** and **G 4/93**.

12.3 Amendments to claims at a very late stage

12.3.1 Consideration of late-filed claims

Under certain conditions amended claims may also be admitted at a late stage in the procedure shortly before or during oral proceedings if they are clearly allowable, if there is good reason for the late submission or if they deal with objections from the board of appeal or the opponent. However, the boards emphasise that unwanted procedural delays should be avoided.

In **T 482/89** (OJ 1992, 646), **T 543/89**, **T 297/91** and **T 252/92** the boards of appeal took account of claims submitted at the beginning of or in the course of oral proceedings as they were obviously clearly allowable. In **T 252/92** (inter partes) the board stated that the claims in dispute resulted from the combination of claims opposed; since only a restriction of subject-matter was involved there was no need for further documents or arguments. In the board's view consideration of the claims could reasonably be expected of the respondent since he was familiar with the subject-matter of the patent in suit. In **T 297/91** the amendment made was not difficult to understand, it was easy to evaluate its implications, and, moreover, it was in line with what could be expected following the board's negative provisional opinion. Furthermore, the board considered that the time factor, ie the time between the date on which the board's communication was deemed to have been delivered to the patentees and the date of the oral proceedings (10 days), was such that the patentees could not have been expected to respond any earlier. In **T 543/89** the claims submitted during the oral proceedings were taken into account as they were clearly allowable and did not cause any procedural delay.

In **T 38/89** (inter partes) the board took the four versions submitted during oral proceedings into consideration because they represented bona fide attempts to overcome the objections raised under Art. 123(2). In **T 1059/92** (ex parte) the board admitted the amended claims into the proceedings, because the amendments were at least partly occasioned by comments made by the rapporteur in a communication (see also **T 933/91**). In **T 459/91** (inter partes) the board admitted into consideration amended claims submitted three weeks before the oral proceedings since they dealt with objections raised in a communication from the board under Art. 11(2) of the RPBA. Also, the parties could be reasonably expected to familiarise themselves with the requested amendments in the time available.

In **T 626/90** the board decided to admit into consideration both sets of claims submitted by the respondent at the oral proceedings. The reasons for late submission put forward by the patentee's representatives at the hearing, namely that they had not been instructed in good time by the patentee, could not in itself be regarded as justifying the late submission. However, the amendments were not such that the board **would have been prevented from taking a final decision** at the end of the oral proceedings. The board was satisfied that the new versions of the claims were bona fide attempts to overcome the objections raised by the appellants in connection with the question of the inventive step of the claimed process, and that no question of the appellants being taken unfairly by surprise arose, because in both requests the amendments were nothing more than a limitation of the claimed subject-matter to preferred embodiments of the invention as described in the patent in suit.

In **T 381/87** (OJ 1990, 213, ex parte) 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 408/91** (inter partes) the representative of the **new** patent proprietor's filed amended claims at the opening of the oral proceedings. The board stated that in the case in point,

having regard to the recent change in ownership of the patent which had occurred long after the date on which the grounds of appeal were filed, and to the fact that the claims according to the new request did appear to be a genuine attempt to meet the grounds on which the patent was revoked by the opposition division, the late-filing seemed to be justified.

12.3.2 Non-consideration of late-filed claims

(a) Extent of and justification for late submission

In a large number of decisions the boards refused to take account of amended claims submitted at a late stage. The factors affecting these decisions were the extent to which the submission was delayed, whether the claims were obviously allowable and whether they differed substantially from previously filed claims. The boards also pointed out that for reasons of fairness any new claims filed in appeal proceedings should be submitted at least one month prior to oral proceedings. In view of possibly unjustified procedural delays a number of decisions referred to Art. 11(3) RPBA, according to which a case should be ready for decision at the conclusion of oral proceedings before the board.

In the following decisions late-filed claims were not taken into consideration as they were filed only shortly before or during the oral proceedings. In **T 92/93** (ex parte) the alternative set of claims included new claims containing subject-matter which had not previously been claimed. The board held that the claims were not clearly allowable, in the sense that they could quickly be seen by the board both to introduce no objections under the EPC and to meet all outstanding objections under the EPC. In **T 631/92** the subject-matter of the auxiliary request differed in various aspects from claim 1 of the set of claims filed with the statement of grounds of appeal and was not clearly allowable. In **T 655/93** (inter partes) the claim was not clearly allowable. In **T 644/89** (ex parte) the board did not admit the five different claims submitted only at the end of the oral proceedings because it was not directly and unequivocally clear that they could form the basis of an allowable patent. In **T 443/87** (ex parte) the independent claims diverged considerably from the claims which had been filed so far. 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 pointed out that, 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**, **T 234/92**). In **T 148/92** the board explained that the appellants had had eight months up to the date of the oral proceedings to submit amended documents. Furthermore, the reasons put forward for the late submission, ie doubts as to the final form which the invention would take and the fact that the appellant had been travelling a lot, were not considered valid by the board. Nor was the claim obviously allowable. In **T 110/85** the representative announced an additional auxiliary request only at the end of the oral proceedings, but did not, however, specify its content. Consideration of this auxiliary request would have led to unacceptable delays in the appeal proceedings. In **T 160/89** (inter partes) the board held that a heavy workload did not represent an exceptional hindrance which justified late filing.

In **T 831/92** the board held that, as a matter of principle, the filing of an auxiliary request in opposition proceedings during oral proceedings before a board of appeal is contrary to procedural fairness. It is difficult for an opponent to deal properly with a request not presented in good time before oral proceedings, and an adjournment, possibly to another day in order to allow further searches, might be necessary if the request were to be admitted.

In **T 406/86** (OJ 1989, 302, inter partes) 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 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 (see also **T 304/92**).

In **T 48/91** (inter partes) the board rejected as inadmissible the late-filed claims, which were submitted as auxiliary requests in the course of the oral proceedings. According to the board, it was clear that the above-mentioned aim could not normally be achieved if at the oral proceedings, ie at the very last moment before a final decision was taken, new claims were submitted which contained one or more additional features the impact of which was either unclear or impossible to assess without further investigations such as carrying out proper comparison tests. The board held that it was too late in the proceedings for the case to be remitted to the first instance for the new issues raised by the auxiliary requests to be examined, as the respondent had had ample time to put forward the request raising new issues earlier, which would have enabled the parties to submit evidence so that evidence could have been available from all parties on these issues at the oral proceedings before the board, but did not do so.

In **T 833/90** (inter partes) the board held that two of the three alternative sets of claims submitted at the beginning of the oral proceedings were inadmissible. Alternative claims which - without good reason - were only submitted at the beginning of the oral proceedings despite the fact that two communications from the board had provided the opportunity to do so before then, and which made pointless the requests filed hitherto during the present proceedings and the requests on which the contested decision was based in that they removed the limitations then incorporated, could only be regarded as **unjustified procedural delays** which prevented a case being brought to a decision in the oral proceedings. The grounds given for the late submission, namely that the previously approved limitation was not necessary in technical terms and that a change of representative had recently taken place, could not be accepted as justification, since the technical facts remained the same and the change of representative had taken place on the party's own initiative. The board did however allow auxiliary request 2, which was appropriate in the circumstances.

In **T 955/91** the appellant filed a large number of alternative auxiliary requests at a very late stage in the appeal proceedings, both shortly before and during oral proceedings, in respect of claims defining different combinations of technical features. The appellant explained that such numerous requests were not made deliberately to complicate the proceedings, but in response to arguments from the respondent. The board made the following general remarks: "It is a misconception of the nature of opposition procedure, in particular opposition appeal procedure, to think that the patentee can continue to file alternative sets of claims in response to an opponent's attack upon the patentee's previous request, right up to and even during oral proceedings. The oral hearing in an opposition appeal is intended to be the very final stage in the opposition procedure, and the point in time at which the decision to maintain or to revoke the patent is taken. It is crucial that such oral hearing and the procedure immediately leading up to it is conducted in a manner which is fair to both sides, and in a manner which allows the board to make its decision in fair and proper circumstances". The board held the late-filed set of claims to be inadmissible.

(b) Non-consideration of late-filed claims in pending divisional applications

In **T 840/93** (OJ 1996, ***) the board held that in the light of **G 9/91** and **G 10/91** (OJ 1993, 408, 420) on the purpose of appeals, special attention must be given to late-filed requests at the appeal stage when divisional applications are still pending. If the distinction between the subject-matter of the divisional applications is not clear and some of them are still pending before the department of first instance, it is inappropriate to admit, during oral proceedings at the appeal stage after opposition, new requests which are neither immediately allowable nor bona fide attempts to overcome objections raised.

In **T 28/92** (inter partes) the claims were not obviously allowable and the alternative of admitting the requests, but referring the matter back to the department of first instance for further examination, was not acceptable, particularly as there were still pending divisional applications of the application on which the patent in suit was based. The board would not wish to increase the number of proceedings in which much the same subject-matter was already being considered by various instances of the EPO.

12.4 Remittal to the department of first instance because of substantial amendments to claims

The amendment of claims during an appeal from a decision to refuse a European patent application is a matter of discretion under R. 86(3). In a case where substantial amendments to the claims are proposed on appeal and the amendments require further substantive examination, the case should be remitted to the examining division so that this examination can be carried out, if at all, by the examining division after it has exercised its discretion under R. 86(3). In this way the applicant's right to appeal to a department of second instance is maintained, both in relation to the exercise of discretion under R. 86(3), and in relation to the formal and substantive allowability of the amended claims (**T 63/86**, OJ 1988, 224, **T 341/86**, **T 919/91**, **T 96/93**, **T 186/93**). In **T 300/89** (OJ 1991, 480) it was added that 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.

In decisions **T 599/92**, **T 1032/92** and **T 1067/92**, all ex parte proceedings, the board referred to this case law, pointing out that the filing of a new request for the first time in the statement of grounds of appeal inevitably leads to undesirable procedural delay. The cases were remitted to the examining division (see also **T 296/86**, **T 501/88**, **T 47/90** (OJ 1991, 486)).

In **T 63/86** (OJ 1988, 224) it was pointed out that, in cases of minor amendments filed during the appeal, it may be appropriate for a board of appeal to exercise its discretion under R. 86 (3) by availing itself of its powers under Art. 111(1).

In **T 184/91** the board found it appropriate to deal only with the amendment directly related to the point at issue, but not to the further substantial amendments to the claims introduced at the appeal stage, since the latter would have entailed an examination with respect to both the formal and substantive requirements of the EPC for the first time at the appeal stage. This would have been contrary to the principle of having two instances of decision. The board remitted the case to the examining division for further prosecution.

In **T 746/91**, an **inter partes** appeal, substantially amended claims were filed with the statement of grounds. The board applied the principles laid down in **T 63/86** (an ex parte appeal, see above) and stated that if the late-filed claims were admitted to the proceedings, they would require further examination in relation to both the formal and substantive

requirements of the EPC. The board remitted the case to the opposition division for it to examine and decide whether discretion should be exercised in favour of the appellant, and if so, whether the claims complied with the EPC's provisions. The board took this view in the particular circumstances because the opposition proceedings had themselves been comparatively brief and had not involved the holding of oral proceedings, thus adhering to the principle of establishing swiftly whether or not a patent can be maintained, and because the amended claims had been filed with the statement of grounds - the earliest possible stage in the appeal proceedings.

12.5 Amendments of claims and delayed citation of new prior art documents

In **T 867/92** (OJ 1995, 126) the claims had been amended during the opposition proceedings. Eighteen months after the claims had been amended the opponent/appellant cited in the statement of grounds of appeal a new prior art document. The board held that the EPC does not impose a time limit for citing new prior art in response to an amendment of the claims. However, an opponent who cites new prior art with a considerable delay with no special reason justifying the delay runs the risk of having to bear some or all of the proprietor's costs incurred in attending oral proceedings which cannot bring the case to an end because of the new citation.

13. Reimbursement of appeal fees

13.1 Introduction

According to R. 67 the reimbursement of appeal fees is 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 (**J 7/82**, OJ 1982, 391, **T 271/85**, **T 346/88**, **T 598/88**, **T 484/90**, OJ 1993, 448). The boards of appeal, however, have no power to reimburse the appeal fee if the conditions of R. 67 are not met (**T 41/82**, OJ 1982, 256).

It also has to be considered that R. 67 applies only to a procedural violation by the instance whose decision is under appeal. Thus, in **T 469/92** the alleged procedural violation was not an act of the opposition division, whose decision was the subject of the appeal, but instead that of the examining division. Even if such an act were to be in breach of the procedural requirements of the EPC, it would not fall within the powers of a board of appeal to order reimbursement.

In the event of the **inadmissibility** or **withdrawal** of an appeal the EPC does **not** provide for the reimbursement of the appeal fee. On the other hand, reimbursement of the appeal fee is ordered if an appeal is **deemed not to have been filed** because the appeal fee had not been paid in due time in accordance with Art. 108, second sentence. 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 21/80**, OJ 1981, 101, **J 16/82**, OJ 1983, 263, **T 324/90**, OJ 1993, 33, **T 239/92**). In **T 323/87** (OJ 1989, 343) the translation referred to in Art. 14(5) had not been filed in due time and the appeal was deemed not to have been lodged. The board ordered that the appeal fee, if paid, be reimbursed.

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.

13.2 Granting of the appeal

R. 67 stipulates as a precondition for reimbursement that the appeal be allowable, ie that it be successful. It is clear from the wording and purpose of the provision that “allowable” is to be understood in the sense that the board of appeal, in substance at least, “follows” the relief sought by the appellants, in other words that it allows their requests (**J 37/89**, OJ 1993, 201). In **J 18/84** (OJ 1987, 215) the Legal Board of Appeal ordered the reimbursement of the appeal fee and indicated that the fact that the appeal was allowed only in part was no impediment to a refund.

13.3 Fairness

A number of decisions dealt with the term “equitable” within the meaning of R. 67. Reimbursement is not equitable in cases where a procedural violation has taken place but the violation neither forms part of the ratio decidendi nor is relevant to the outcome of the case (**T 5/81**, OJ 1982, 249).

In **J 22/85** (OJ 1987, 455) the board did not consider a reimbursement of the appeal fee to be justified, since the appellant had failed to provide the Receiving Section with the evidence subsequently submitted in the appeal proceedings.

In **T 893/90** the contested decision to refuse the application on the grounds of lack of novelty was based primarily on document (1), on which, in contrast to document (2), the appellant had had adequate opportunity to put forward comments. The board stated that even if the passages in the decision relating to document (2) were left out of account, the decision under appeal would have been fully reasoned, and that the procedural violation as regards the reliance on document (2) was thus not sufficiently closely linked to the need to pay an appeal fee for it to be equitable to reimburse the fee.

The board came to the same conclusion in **T 601/92**. The opposition division had not commented, either in a communication or in its decision, on the auxiliary request submitted by the patent proprietor in good time before the decision was issued. In the appeal proceedings further auxiliary requests were submitted in addition to the main request, whereby the auxiliary request which had not been taken into account in the opposition proceedings was classified as auxiliary request (5). Because auxiliary request (2), which was submitted in the appeal proceedings and which preceded auxiliary request (5), was allowed, the board did not see any reason, despite the procedural violation, to reimburse the appeal fee as in this case it was not equitable to do so.

In **T 219/93** the board remitted the case to the department of first instance since it clearly called for revision under Art. 109. The contested decision had also been inadequately reasoned on one point within the meaning of R. 68(2). Nevertheless, the board decided not to reimburse the fee for appeal, since the refusal had been made principally on other

grounds, and the board did not consider the procedural violation in this case as so substantial within the meaning of R. 67 that the reimbursement would be equitable.

In **T 908/91** the board of appeal rejected the request for reimbursement of the fee for appeal although there had been a substantial procedural violation during the grant procedure - namely of the right to be heard. The board took the view that in this case reimbursement of the fee for appeal would not be equitable because the appeal could only be allowed after certain substantial deficiencies had been rectified which had already been criticised by the examining division in a manner procedurally beyond reproach.

13.4 Substantial procedural violation

13.4.1 Definition

According to R. 67 it is a precondition for reimbursement of the appeal fee that a substantial procedural violation has taken place. A "substantial procedural violation" is an objective deficiency affecting the entire proceedings (**J 7/83**, OJ 1984, 211). According to **J 6/79** (OJ 1980, 225), the expression "substantial procedural violation" was to be understood, in principle, as meaning that the rules of procedure had not been applied in the manner prescribed by the EPC. However, the giving of incorrect information by the EPO about rules of procedure which, if followed by the applicant, could lead to the same consequences as the incorrect application of those rules, could also be considered as within the scope of "procedural violation".

In **T 682/91** the board of appeal emphasised that a procedural violation which did not adversely affect anyone could not be considered as substantial. The seriousness of a procedural violation derived from its adverse effects.

13.4.2 Request for oral proceedings

Normally, refusal of a request for oral proceedings amounts to a breach of the requirements of Art. 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 795/91**, **T 35/92**, **T 686/92**).

In **T 879/92** the reimbursement of the fee for appeal was ordered because the request for oral proceedings had been refused, although the request for the decision to be set aside had not been based on a procedural error (see also **T 686/92**). 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 had not been granted (see also **T 543/92**). In **T 666/90** the failure to clarify matters with regard to requests in oral proceedings before the opposition division was deemed to be a substantial procedural violation.

In **T 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 **T 182/90**, OJ 1994, 641, **T 119/91**, **T 523/91**, **T 366/92** and **T 397/94** the boards of appeal stated that it was **not** a substantial procedural violation within the meaning of

R. 67 if a request to be called back by or have an interview with the primary examiner was ignored. It was a matter for the examiner's discretion to decide whether to conduct such informal discussions in accordance with the Guidelines, bearing in mind the particular circumstances of the case (see Guidelines C-VI, 4.4 and 6, and **T 300/89**, OJ 1991, 480).

13.4.3 Right to be heard

In **J 14/82** (OJ 1983, 121), **T 716/89** (OJ 1992, 132), **T 197/91**, **T 640/91** (OJ 1994, 918), **T 734/91**, **T 880/91**, **T 392/92**, **T 892/92** (OJ 1993, 664), **T 1045/92**, **T 220/93** and **T 479/94** reimbursement of the fee for appeal was ordered since the principle of the right to be heard enshrined in Art. 113(1) had been violated, particularly as there had been a lack of opportunity to present comments on the grounds for the contested decision.

In **T 18/81** (OJ 1985, 166) the board of appeal stated that the right to be heard had been infringed when a decision to refuse an application was based essentially on documents which, though supplied by the applicant in support of his case, were used against him to produce an effect on which he had not had an opportunity to make observations.

In **J 7/82** (OJ 1982, 391) the Legal Board of Appeal ordered reimbursement of the appeal fee because the appealed decision had not taken account of any of the arguments put forward by the appellant and had been based on a ground on which he had not had an opportunity to present his comments. In this connection it was held in **T 197/88** (OJ 1989, 412) that causing one of the parties to be taken by surprise amounted to a substantial procedural violation.

In **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.

In **T 543/92** and **T 89/94** the opposition division overlooked amended claims presented in a submission. Reimbursement of the appeal fee was ordered.

In **T 33/93** the appellant argued that the decision under appeal was based on a substantial procedural violation, since it cited for the first time a board of appeal decision on which the appellant had been given no opportunity to present comments. The board stated that the citation of the decision in support of the refusal was not a fresh ground or piece of evidence within the meaning of Art. 113(1), but a mere repetition of arguments, since it only confirmed the position duly brought to the appellant's attention. In **T 990/91** the board held that since there was no need for the examining division to put forward this new argument in order to refuse the application, the lack of opportunity to reply to it could not be considered to be a procedural violation.

In **T 666/90**, **T 543/92**, **T 647/93** (OJ 1995, 132) and **T 89/94** reimbursement of the fee for appeal was ordered because there had been an infringement of the provision of Art. 113(2) that the EPO consider and decide upon the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent.

13.4.4 Inadequate reasons given in the decision at first instance

In several decisions the absence of adequate reasoning in the contested decision in accordance with R. 68(2) was considered a substantial procedural violation justifying the reimbursement of the fee for appeal (**T 493/88**, OJ 1991, 380, **T 522/90**, **T 360/91** and **T 392/91**). 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 (see also **T 52/90**).

In **T 75/91** the board stated that the impugned decision enabled the reader to follow a line of argument for refusing the application. Whether these reasons were convincing and had to be accepted by the board or not was another question and had nothing to do with a substantial procedural violation. In **T 856/91** the board held that 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**, **T 153/89**, **T 647/93**, OJ 1995, 132).

13.4.5 Error of judgment by a department of first instance

In a number of decisions it was discussed whether an error of judgment by a department of first instance could be regarded as a substantial procedural violation justifying reimbursement of the appeal fee (**T 19/87**, OJ 1988, 268, **T 863/93**).

Normally there is no procedural violation justifying reimbursement of the appeal fee if a wrong procedure is adopted 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 principle was extended in a later decision (**T 208/88**, OJ 1992, 22) in which it was held that taking a different line from an as yet isolated appeal decision - as opposed to established board of appeal case law - could not be regarded as a substantial procedural violation. The fact that the board had come to a different conclusion from the department of first instance did not by itself mean that the latter had committed a substantial procedural violation (**T 87/88**, OJ 1993, 430, **T 538/89**).

In **T 367/91** the board stated that to base a decision only on a wrong assessment of prior art and/or the claimed invention had to be regarded as a substantive error, not a procedural violation. In **T 182/92** the board held that the fact that the first instance department had reached a conclusion regarding the priority document which could not be confirmed by the board was a matter of how to interpret the document, ie a matter of judgment, and not a procedural violation.

It does not amount to a procedural violation if the examining division wrongly finds that a claim 1 is not sufficiently clear to comply with the requirements of Art. 84, even despite a possible error of judgment and the failure to seek clarification from the appellant (**T 680/89**).

The misinterpretation of a document does not constitute a procedural violation (**T 1049/92**, **T 162/82**, OJ 1987, 533). In **T 588/92** the board pointed out that a different opinion on the specialist knowledge to be applied when interpreting the technical content did not represent a procedural violation. Even a gross error of judgment on the part of the examining division does not justify reimbursement of the appeal fee (**T 860/93**, OJ 1995, 47). A misinterpretation of a letter directed to the EPO body concerned constitutes an error of judgment and not a substantial procedural violation (**T 621/91**).

The failure of the examining division to follow a procedure set out in the Guidelines is not in itself a substantial procedural violation, unless it also constitutes a violation of a rule or principle of procedure governed by an article of the EPC or one of the Implementing Regulations, as the Guidelines are not legally binding (**T 42/84**, OJ 1988, 251, **T 51/94**).

13.4.6 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.

The board of appeal ordered reimbursement of the appeal fee in **T 382/92**, because the **composition of the opposition division** had not complied with the requirements of Art. 19(2). The Chairman and one member of the opposition division had already been members of the examining division which had decided on the application leading to the patent concerned (see also **T 939/91**). A substantial procedural violation is also deemed to have occurred if the decision has been taken by a formalities officer who is not competent to decide (**J 10/82**, OJ 1983, 94, **T 114/82**, OJ 1983, 323, **T 790/93**).

In **T 231/85** (OJ 1989, 74) the board held that failure to take the applicant's requests into account as a result of a delay within the EPO (in this case 6 weeks) constituted a substantial procedural violation (see also **T 598/88**). Also, 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.

In **J 3/87** (OJ 1989, 3) it was stated that if an EPO communication was not as clear and unambiguous as it ought to be, and led a reasonable recipient into error, that amounted to a substantial procedural violation, even if the ambiguity of the communication was partly due to an unfortunate provision of the law.

In **J 3/91** the Legal Board of Appeal refused the request for reimbursement of the appeal fee stating that the **wrong transcription of a Japanese priority date** could not be considered a procedural violation. The Receiving Section was not obliged by procedural law to inform the applicant that the "Showa" year had been transcribed into the equivalent date in the Christian era. Such transcriptions were a routine matter familiar to practitioners dealing with industrial property rights.

In **T 804/94** the board ruled that there had been a substantial procedural violation as the opposition division had issued a decision rejecting the opposition before **expiry of the four-month period** it had set for responding to its communication.

In **T 291/93** it was held that a simple reference by the appellant to an inadequate search of the prior art could not justify a substantial procedural violation. Also, remarks on substantive matters in a decision rejecting the opposition as inadmissible have no legal effect. Even if misleading, they do not represent a substantial procedural violation justifying the reimbursement of the appeal fee (**T 925/91**, OJ 1995, 469, see also **T 1051/92**).

13.5 Interlocutory revision

According to R. 67 the reimbursement of appeal fees must be ordered in the event of interlocutory revision. However, reimbursement of appeal fees is not an automatic consequence of interlocutory revision. The proper interpretation of R. 67 is that in the case of interlocutory revision there also has to have been a substantial procedural violation (see **T 79/91**, **T 536/92**). In **T 647/93** (OJ 1995, 132) it was pointed out that when the examining division did not make use of the possibility of granting interlocutory revision after the mistake had been pointed out in the grounds of appeal, this was normally deemed to constitute a procedural violation (see also **T 808/94**).

F. Proceedings before the Disciplinary Board of Appeal

1. European qualifying examination - Review by the Disciplinary Board

The Regulation on the European qualifying examination for professional representatives (REE) was amended by decision of the Administrative Council of 9.12.1993 (OJ 1994, 7). The decision entered into force on 1.5.1994, but the new Arts. 14, 15, 24(2) and 28(1) have been applicable since 10.12.1993. The implementing provisions to the REE have also been amended; they entered into force on 19.5.1994 (see OJ 1994, 595).

The system has changed as far as passing the examination is concerned. Under Art. 14 REE it is now possible to sit the examination in two modules. Under Art. 18 a candidate who fails the examination may only resit a paper or papers he or she did not pass. Under R. 10 of the new implementing provisions, a candidate who sits the examination for the first time is deemed to have passed the examination if he or she

(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.

If a candidate's paper is awarded a grade 7 this grade cannot be compensated by any grades in other papers.

Under R. 14 a candidate resitting the examination is only deemed to have passed it when he or she has passed each paper.

Despite these changes the case law of the Disciplinary Board determining the parameters within which decisions of the Examination Board are subject to review still applies.

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, the principles of **D 4/88** (unpublished) 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 re-opening 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 (see also **D 10/93**).

In **D 6/92** (OJ 1993, 361) the Disciplinary Board of Appeal referred to the principle outlined above.

In **D 6/93** the board confirmed that it did not have the authority to replace a rule put in place by the legislator with a different rule, even though the alternative rule may well be desirable. Furthermore, it stated that under the examination regulation only written papers could form part of the European qualifying examination. Other "factors" such as success in professional practice prior to the examination could not be taken into account. Art. 9 REE (old version) can only be interpreted to mean that candidates must prove that they have the knowledge required by this article in the written papers which the examination comprised in accordance with Art. 10 REE (old version).

The basic substance of Arts. 9 and 10 REE (old version) has remained unchanged (see Arts. 12 and 13 (new version), so that the legal concepts enshrined in **D 6/93** continue to apply.

2. Conditions for enrolment

The old Art. 7 REE has been incorporated into Art. 10 (new version). The requirements of old Art. 7(1) REE are now contained in Art. 10(2) of the new REE. The substance has not changed, so that the case law on the old Art. 7 REE remains authoritative.

D 4/86 (OJ 1988, 26) has it that, for the condition stipulated in Art. 7(1)(b)(i) REE to be met, the trainee must have completed his training period under conditions likely to ensure that he has actually assisted a professional representative by constantly taking part in activities pertaining to patent application procedures of which the representative is in fact in charge.

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 according to which, when laying down the examination procedure, the Examination Board had discretionary powers the exercise of which might be scrutinised only for possible abuse (see **D 1/81**, OJ 1982, 258).

3. Disciplinary matters

3.1 Professional secrecy

In **D11/91** of 18.5.1993 (OJ 1994, 401), the appellant had requested the removal of various documents placed on file by the complainant. The appellant argued that his request was justified because, inter alia, their inclusion contravened the rule of confidentiality to which professional representatives are subject. The documents were items of correspondence between the complainant and the disciplinary bodies and correspondence pertaining to an opposition case.

The board decided that the professional secrecy referred to in Art. 2 of the Regulation on discipline for professional representatives (RDR) set limits to the disciplinary bodies' powers of investigation and to the obligation under Art. 18 RDR that a professional representative before the EPO supply all relevant information. However, the mere obligation of confidentiality deriving from the principle enshrined in Part I RDR cannot be invoked to resist a request under Art. 18 RDR.

3.2 Disciplinary measures

According to **D 5/86** (OJ 1989, 210), an infringement of the rules of professional conduct must be established to the satisfaction of the disciplinary body before it can impose a disciplinary measure. Absolute certainty is not required, but a degree of probability which in human experience verges on certainty. A disciplinary measure cannot be imposed if there is reasonable doubt as to whether the infringement has occurred.

In **D 11/91** of 14.9.1994 (OJ 1995, 721) the Disciplinary Board of the EPO had ordered the deletion of the appellant from the list of professional representatives for an indefinite period. In his appeal, the appellant contested the disciplinary measure and held that the procedure before the Disciplinary Board of Appeal did not comply with the provisions of the European Convention for the Protection on Human Rights. He alleged in particular that because the board of appeal had not been established by law but by the Administrative Council of the EPO, the disciplinary bodies did not constitute an independent court, the board of appeal was not a national authority and its decisions could not be referred to a higher court of appeal.

The board decided that the European Convention on Human Rights contained provisions which expressed general principles of law common to the member states of the European Patent Organisation. As such these provisions should be considered part of the legal system of this Organisation and should be observed by all its departments. This therefore applies to Art. 13, which guarantees the protection by the judiciary of the rights of the individual. The “national authority” mentioned in this article is clearly meant to be understood as a competent authority in accordance with the law of the state concerned. However, in ratifying the Munich Convention, the contracting states accepted a transfer of prerogatives whereby professional representatives before the EPO became subject to the same set of professional regulations, controlled by a central body whose decisions are open to effective remedy before a body of second instance whose independence is guaranteed by the rules governing its composition. The drafting of these regulations and the establishment of these bodies was thus consistent with general principles of law, in particular those expressed in the European Convention on Human Rights.

As far as the disciplinary measure was concerned, the board took the view that in order to ensure that the penalty was proportionate to the seriousness of the charges and that the maxim according to which penalties should not be arbitrary but fixed or predetermined was respected, Art. 4(1)(e) of the Regulation on discipline for professional representatives (RDR) should be understood as meaning “for a period not defined by the text”, that is for a discretionary period to be decided by the competent disciplinary body which, in its decision, should fix the said period and give reasons for its choice.

4. Code of Professional Conduct

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 A PCT AUTHORITY

A. Competence of the boards of appeal in proceedings under the PCT

Under Art. 154(3) and 155(3), the function, or competence, conferred by R. 40.2(c) and R. 68.3(c) PCT has been devolved to the EPO's boards of appeal. This function relates solely to the examination of a protest against an invitation to pay an additional fee owing to lack of unity.

In **J 20/89** (OJ 1991, 375) the board had to decide whether, during the international phase of a PCT application, it had jurisdiction to examine decisions taken by the EPO acting in its capacity as an International Preliminary Examining Authority (IPEA) within the meaning of Chapter II of the Patent Cooperation Treaty (see Arts. 150, 155). It noted that the PCT did not contain any provisions for appeal or petition during the international phase. Save as was provided in R. 40.2(c) and R. 68.3(c) PCT, there was nothing in that Treaty, or in the Regulations under it, providing for appeal during the international phase in proceedings before the Authority acting as ISA or as IPEA. Applicants are not, however, entirely deprived of legal safeguards during the international phase. All PCT Authorities in fact accept and duly consider any request for reconsideration of an earlier decision taken during the international phase, although this is not expressly provided for in the PCT. Furthermore, a designated or elected Office can, during the national phase, review a decision taken during the international phase by an ISA or an IPEA.

The board observed that under Art. 150(3) an international application for which the EPO acts as designated Office or elected Office is deemed to be a European patent application. Consequently, there was no obstacle to making use of appeal procedures provided for under the EPC to supplement the provisions of the PCT in such cases (see Art. 150(2)). However, if the EPO was neither receiving Office nor designated Office nor elected Office, but was acting solely **as ISA or IPEA**, the application of Art. 150(2) should be limited, so far as concerns appeal procedure, to supplementing the express provisions of PCT R. 40.2(c) and R. 68.3(c), which relate only to the examination by boards or other special instances of ISAs or IPEAs of protests against the charging of additional fees. Thus the board came to the conclusion that during the international phase of a PCT application, the boards of appeal of the EPO have no jurisdiction to examine appeals against decisions taken by the EPO acting **solely** in the capacity of IPEA within the meaning of Chapter II of the PCT.

In **J 15/91** (OJ 1994, 296), 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 appellant argued that the board of appeal did have jurisdiction in the case, because, unlike in case **J 20/89** (above), where it was acting solely as an IPEA, the EPO had also previously acted as receiving Office. 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 [or by the IPEA] 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. Thus, 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**.

B. 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 p. 150).

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 Art. 154 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). 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, ie 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 within a time limit fixed by the ISA (Art. 17(3)(a), R. 40.3 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** and an invitation is not legally effective unless reasons are given to substantiate lack of unity (**W 4/85** and **W 7/86**, OJ 1987, 63 and 67; **W 9/86**, OJ 1987, 459; **W 7/85**, OJ 1988, 211).

Decision **W 4/85** (OJ 1987, 63) stated the minimum requirement for adequate substantiation. According to that decision, the basic considerations behind the finding that the invention lacks unity must be set out in a logical sequence to enable the applicant and the appeal body to check this finding (see also **W 2/93**); 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**). Also, in **W 7/86** (OJ 1987, 67), **W 43/91**, **W 9/92**, **W 33/90**, **W 32/91**, **W 50/90** and **W 16/91**, it was pointed out that listing the inventions which in the ISA's view the application contains was sufficient reasoning only in exceptional cases.

In **G 1/89** and **G 2/89** the Enlarged Board of Appeal noted that the consideration by an ISA of the requirement of unity of invention should, of course, always be made with a view to giving the applicant fair treatment and that the charging of additional fees under Art. 17(3)(a) PCT should be made only in **clear cases**. In particular, in view of the fact that such

consideration under the PCT was being made without the applicant having had an opportunity to comment, the ISA should exercise restraint in the assessment of novelty and inventive step and in borderline cases preferably refrain from considering an application as not complying with the requirement of unity of invention on the ground of lack of novelty or inventive step.

In **W 26/91** the board concluded that the ISA had contravened the principles laid down by the Enlarged Board of Appeal in **G 1/89** and **G 2/89**, namely that the applicants should be given fair treatment when considering the requirement of unity of invention and that additional fees should be charged under Art. 17(3)(a) PCT only in **clear cases** (see **W 34/89** and **W 23/92**). The mere citation of three documents without any analysis of what was disclosed and the undifferentiated allegation that with regard to these documents there was no novelty or inventive step could not be considered as fair treatment (see also **W 3/92**). 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 3/93** (OJ 1994, 931) the ISA did not base its objection of lack of unity on the prior art referred to in the application or established during the search. It was therefore an "*a priori*" objection within the meaning of Chapter VII.9 of the "Guidelines for international search to be carried out under the PCT". In the board's view the grounds for this objection as stated in the invitation to pay contained virtually nothing more than a repetition of the substance of R. 13.1 PCT in different words. According to established board of appeal case law, only in exceptional cases does such general information fulfil the obligation stipulated in R. 40.1 PCT to submit a reasoned statement (see above **W 4/85** (OJ 1987, 63) and **W 7/86** (OJ 1987, 67)). However, as the applicant in the present case was nevertheless able to make a substantive response, the board could accept the reasoned statement as sufficient on this occasion (confirmed in **W 4/94** (OJ 1996, 73)). Thus, the only issue to be examined was whether, considering the reasons stated by the ISA and the submissions made in support of the protest, retaining the additional fees was justified. The board found that it could not investigate **ex officio** whether an objection of lack of unity would have been justified for reasons other than those given, for example after taking into consideration the documents found during the search or addressing in depth the objectively resolved technical problem. Accordingly, the objection of lack of unity could be raised again on different grounds in the event of subsequent proceedings under PCT Chapter II (confirmed in **W 8/93** and **W 11/94**) (see also **W 4/94** below).

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*.

In **W 11/89** (OJ 1993, 225) and **W 10/92**, the boards 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 was perfectly clear that the technical facts listed in the invitation could not reasonably be subsumed under an overall problem; if that exposition was lacking, the invitation was not legally effective and any additional search fees paid should be reimbursed (see also **W 8/94**). The determination of the technical problem underlying the invention is a mandatory pre-condition for the assessment of unity of invention, that is to say, whether or not the subject-matter claimed as solution of such a problem represents a single general inventive concept. The disregard of this principle was considered to be in itself sufficient justification for reimbursement of the additional search fees (see also **W 14/89**, **W 6/91** and **W 3/92**). **W 50/91**, **W 52/91** 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 document which causes lack of novelty and gives rise to lack of unity is found.

In **W 18/92** the board found as regards inventive step that there was no indication in the invitation of the ISA as to which document represented the closest prior art, what the problem to be solved was in the light of the closest prior art, and whether all five documents had been combined together to arrive at the finding of lack of inventive step, or only some of them.

In **W 31/88** (OJ 1990, 134) the board held that consideration of the clarity and conciseness of claims by the ISA was limited to whether they could be sufficiently understood to permit a meaningful search to be carried out (Art. 17(2)(a)(ii) PCT). Under the PCT the ISA was not competent to consider whether the requirements of Art. 6 PCT (in particular clarity and conciseness of claims) had been met. According to Art. 17 PCT, clarity of claims for the purposes of a meaningful search was a separate question from that of unity of invention. An alleged lack of clarity in a claim cannot be used as a reason for an objection based on lack of unity.

In **W 3/94** (OJ 1995, 775), the EPO, acting as ISA, requested the applicant to pay 16 additional fees, as it considered the application did not comply with the requirement of unity. Three additional fees were paid under protest. The ISA had informed the applicants that, having reviewed the invitation to pay the international search fees in accordance with R. 40.2(c), (d) and (e), it had decided that the invitation was completely justified. The board pointed out that Annex B, Part 1(f) of the PCT Administrative Guidelines (PCT Gazette 15/1992, in force since 1.7.1992) contained specific criteria for assessing the unity of **“Markush” claims**. These guidelines pointed out that the question of unity of invention must be reconsidered if at least one “Markush” alternative is not novel, but that reconsideration did not necessarily imply that an objection of lack of unity would be raised (see Annex B, Part 1 (f), (v)). The requirement of R. 40.1 PCT, whereby the invitation had to be reasoned, would thus be met only if it indicated why the criteria mentioned in Annex B, Part 1, (f)(i), (B)(2) of the PCT Administrative Guidelines had not been fulfilled. This was particularly the case where the unity of alternatives “of a similar nature” in a Markush claim was contested on the basis that they did not share a significant structural element. In the present case there were no facts from which a lack of unity was so manifestly clear that more detailed reasons could be dispensed with. The finding of lack of unity should therefore have been supported by more detailed reasons having regard to the relevant PCT Administrative Guidelines.

2.2 Substantiation of protest

In **W 8/89**, **W 60/90**, **W 57/91** 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**).

In **W 41/91** the board found that it was clear from the applicant’s submissions that he disagreed with the ISA on one concrete point. To this extent, the applicant’s response

sufficed to meet the requirement of a reasoned statement under R. 40.2(c) PCT. The board stated that according to the established jurisprudence of the boards of appeal of the EPO, the substance and not the form of a submission was to be considered (see **J 24/82**, OJ 1984, 467).

2.3 Review of protests by a review panel

A new protest procedure applies 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 these 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 Review of protest by a board

(a) Additional reasons given by the review panel

In **W 11/93**, the EPO, acting as ISA, had issued an invitation to pay three additional search fees, which the applicants paid under protest. The board found that the ISA's invitation under R. 40.1 PCT was invalid owing to lack of (sufficient) reasons. Under the new R. 40.2(e) PCT in conjunction with R. 104a(3), the ISA must carry out a review of the protest. The board also considered whether the reasons accompanying the "result of the review" might not be held to make good the lack of reasons in the case of the invitation. In its decision, the board thoroughly scrutinised the **purpose and structure** of the new R. 40.2(e) PCT and considered whether, when notifying the results of the review in the event of the invitation's being upheld, there was any need at all to supply further reasons. It pointed out that prior review of the protest by the ISA was comparable to interlocutory revision under Art. 109 in the case of an appeal (see also **W 4/94** (OJ 1996, 73)). Furthermore, R. 40 PCT had been revised for reasons of general procedural economy. It would run counter to that object were the ISA to give additional reasons in the event of the invitation to pay's being upheld. With this decision, the board confirmed the case law developed in **W 4/93** (OJ 1994, 939) (see p. 373).

In **W 5/94** the board held that in its examination of the protest against the invitation to pay an additional search fee, the board must not take into consideration any new reasons brought forward in the ISA's review of the justification for the invitation (R. 40.2 (c) to (e) PCT), particularly because any such new reasons could not have been considered by the applicant in his protest against the invitation and because the board's task, by letter of the law (R. 40.2 (c) PCT, second sentence), is limited to the examination of "the protest" (see also **W 12/93**).

(b) Amendment of claims

In **W 3/94** (OJ 1995, 775) it was pointed out, with regard to the applicants' new claim 1, that the board had no power to examine unity on the basis of this new claim. The board's powers derived from Art. 154(3) in conjunction with R. 40.2(c) PCT, which provided for the board to examine the protest. This of course it could only do on the basis of the documents available when the ISA issued its invitation to pay the additional search fees, as there was no provision for amendments during proceedings before the ISA. The replacement sheet could at best be regarded as indicating that the ISA should no longer search certain subject-matter. This was confirmed in **W 6/94**, where the board found that the invitation by the ISA to pay additional fees as well as the examination of the protest by the board under R. 40.2(c) PCT was based on the claims as originally filed. There was no opportunity for the applicant to amend the claim in the international phase until he had received the complete international search report (Art. 19(1) PCT). The decision by the boards of appeal therefore had to be based on the claims as originally filed.

(c) Devolutive effect of protests

In **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.

2.5 Missed time limit for filing the protest

Art. 48(2) PCT requires every PCT contracting state to excuse, so far as that state is concerned, for reasons admitted under its national law, any delay in meeting any time limit and allows such a state, so far as it is concerned, to excuse such delays for other reasons. In **W 3/93** (OJ 1994, 931) (see p. 368), the protest was first rejected as inadmissible by the board on the ground that it was filed too late, whereupon the applicant applied for re-establishment of rights. The board found that by analogy with the principles developed by the Enlarged Board of Appeal in decision **G 1/83** (OJ 1985, 60, points 5 and 6 of the reasons) for interpreting the EPC, Art. 48(2) PCT should be construed to mean that in the event of a delay in meeting the time limit laid down in R. 40.3 PCT the same legal remedies are available as in the case of failure to observe other comparable time limits under the PCT or EPC (see also **W 4/87** (OJ 1988, 425, point 7 of the reasons). Thus, the provisions of Art. 122 were applicable. As the communication notifying the appellant that the application did not meet the requirements of unity required an answer within thirty days of its date, but was not itself posted until one month **after** that date, it was clearly not possible for the appellant to comply with the time limit. The application for re-establishment was therefore granted. The board found that re-establishment of rights restores the legal situation to that existing prior to the decision which declared the protest inadmissible, ie it destroys the legal validity of the decision, which accordingly need not be set aside or amended.

C. The EPO acting as IPEA

1. Protest procedure

1.1 Substantiation of invitation

The requirement of unity of invention under the PCT applies equally to the procedure before the ISA and to the procedure before the IPEA according to Art. 17(3)(a) and 34(3)(a) PCT, which is in conformity with the procedural separation of search and examination. Thus, the requirement of unity of invention under the PCT must in principle be judged by the same objective criteria by both the ISA and the IPEA (**G 1/89** and **G 2/89**, OJ 1991, 155 and 166). Under Art. 155(3) the boards of appeal are responsible for deciding on a protest made by an applicant against an additional fee charged by the EPO, acting as IPEA, under the provisions of Art. 34(3)(a) PCT.

In **W 2/93** the board noted that the applicant did not comply with the invitation to restrict or pay the three additional fees. It held, however, that, in the circumstances of the case, the protest was admissible. In the board's view, it could be inferred from an applicant's letter that the applicant could have reasonably expected from the telephone conversation that, despite the communication of the IPEA refusing his request for an extension of the term for response to the invitation, the IPEA had, in fact, changed its mind and extended the term for response to two months. The board noted that in accordance with the established jurisprudence of the boards of appeal, measures taken by the EPO in proceedings before it should not violate the reasonable expectations of parties to such proceedings (principle of **good faith**). It therefore held that, having regard to the good faith existing between the EPO and its users, the protest had to be regarded as having been filed in time. With regard to the protest made by the applicant against additional fees charged by the EPO, the board held that the invitation of the IPEA could not be considered as containing an acceptable reasoned statement setting out the grounds for the invitation. The reasons relied on were still those that the ISA had put forward in the invitation to pay additional fees issued pursuant to Art. 17(3)(a) and R. 40.1 PCT. The applicant, in the light of the international search report, had submitted to the International Bureau of WIPO an amendment and the statement under Art. 19(1) PCT, and filed two replacement sheets as required by R. 46.5(a) PCT. It was clear that claim 1 before the IPEA was different from the one considered by the ISA. The board stated that, in these circumstances, an invitation relying on the same reasons as those which had been put forward by the ISA in its invitation could not be considered to fulfil the obligation to specify reasons laid down in R. 68.2 PCT.

In **W 4/94** (OJ 1996, 73) the board felt compelled, given the paucity of the IPEA's remarks, to comment on the issue of the obligation to specify reasons, even though the applicants had not expressly referred to this in their protest. The IPEA had established lack of unity with reference to three documents, ie a posteriori, and had maintained its finding unamended after review. Although the relevant remarks were not fully in accord with the PCT Preliminary Examination Guidelines, Chapter VI, 5.5 and 5.7 with reference to Chapter III, 7., the fact that in their protest the applicants had commented on an objection as to the novelty of the subject-matter of the invention according to claim 1 implied that the IPEA's remarks were understandable and not just mere assertion, and as a result the minimum criterion of the obligation under R. 68.2 PCT to provide justification could be seen as fulfilled. The board did not consider the obligation to be infringed if the determinative reason for the decision was identifiable, even though the reasons could be seen as insufficient or incorrect. In the board's opinion, EPO board of appeal case law adhered to this principle. A comparable approach could also be seen in decisions on protests, such as

in **W 3/93** (OJ 1994, 931, point 3.1, see p. 368). In that case the board had taken the view that since the applicants were able to make a substantive response at all, the reasoned statement could be considered sufficient. It concluded that under R. 40.2(c) it only had to examine whether, considering the reasons given by the ISA and the submissions made in support of the protest, retaining additional fees was justified. It could not investigate ex officio whether an objection of lack of unity would have been justified for reasons other than those given, eg after taking into consideration further documents found during the search. It was therefore possible that the objection of lack of unity could be raised again on different grounds in the event of subsequent proceedings under PCT Chapter II.

1.2 Substantiation of protest

In **W 9/94** the EPO, acting as IPEA, informed the applicant that the application did not comply with the requirement of unity of invention for the reasons indicated. The sole argument in the statement accompanying the protest was to the effect that the contents of the claims were already contained in the original claims and therefore the set of claims had already been searched. The board observed that the appellant did not address the point at issue, and since the fact that the claims in question were searched cannot, on its own, constitute a reason for contesting a finding of lack of unity of invention by the IPEA, it follows that a protest statement which relies solely on pointing out this fact cannot qualify as a reasoned statement for the purposes of R.68.3(c) PCT. The same holds for the argument, which may be implicit in the protest statement, that the unitary character of the claims in question can be inferred from the fact that the ISA did not request an additional search fee. The board held that the decision of the ISA was not binding on the IPEA (see **G 2/89**, OJ 1991, 166, points 8.1 to 8.2), and noted that in the matter of a finding of lack of novelty of invention, both the ISA and the IPEA exercise discretion in borderline cases on whether or not to issue an invitation under PCT Art. 17(3)(a) or Art. 34(3)(a) respectively. Because of the difference between the tasks of search and examination, it may in appropriate cases be proper for this discretion to be exercised differently by the respective authorities in relation to a given group of inventions. Thus a group of inventions may sometimes be searchable in full within the bounds of a normal case, while the examination of novelty, inventive step, industrial applicability, excluded subject-matter and clarity for each of the inventions might involve a cumulative effort well beyond such bounds.

In **W 4/93** (see below) the board took the view that the applicant's right to communicate orally with the IPEA (Art. 34(2)(a) PCT) did not include the right to formal oral proceedings. The board added that an informal interview under R. 66.6 PCT usually served no purpose in protest proceedings under R. 68.3(c) PCT.

1.3 Review of protests

W 4/93 (OJ 1994, 939) dealt for the first time with the new procedure for reviewing protests against invitations to pay additional fees for the international preliminary examination in the case of lack of unity of the invention. The board decided that the examination stipulated in R. 68.3(e) PCT of the justification for charging an additional fee should only be carried out on the basis of grounds stated in the invitation to pay the additional fee and that the facts and arguments submitted by the applicant in his grounds of protest should also be included. This precluded the subsequent inclusion of new grounds and evidence when communicating the result of this review. The board had to confine itself in its decision to examining the protest and the invitation to pay (confirmed in **W 11/93**, see p. 370).

In **W 4/94** (OJ 1996, 73), regarding the extent of the notification of the result of the review under R. 68.3(e) PCT, the board noted that the wording of the rule, in contrast to the “invitation to restrict or pay” in Rule 68.2, first sentence, stipulated only that a result be notified and did not expressly mention any obligation to give reasons. The corresponding guidelines on implementing this rule in Chapter VI, 5.7, also stipulated a technical reasoned statement only where the review produced a negative result, ie where the facts in the invitation under R. 68.2 were not confirmed. The board therefore took the view that, where the review body reached the conclusion that the arguments put forward in the protest did not necessitate any further discussion on the technical and/or patent law issues involved, ie did not lead to any new assessment of the facts, the phrase “... doit indiquer les raisons techniques de ce résultat ...” or “... will give a technical reasoning of that result” did not rule out merely referring back to the reasons given in form PCT/IPEA/405 as obviously incorrect. The review under R. 68.3(e) PCT could also be compared with interlocutory revision in accordance with Art. 109 EPC, which did not stipulate any separate obligation to provide justification.

D. The EPO as designated or elected Office

The EPO may be a “designated Office” and an “elected Office” for an international application made under the Patent Cooperation Treaty (PCT). That application is thereby deemed to be a European application (Euro-PCT application) for the purposes of the EPC. In the case of Euro-PCT applications the provisions of the PCT apply in addition to those of the EPC, and where there is conflict between them, the provisions of the PCT prevail.

In its decision **J 26/87** (OJ 1989, 329), the Legal Board of Appeal had to examine the interpretation of a request for grant in an international application, filed with the Australian Patent Office and published by the International Bureau, in connection with the mention of Italy as a 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 an EPO contracting state 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.

In **J 7/93** the International Bureau did not inform the EPO of its election as an IPEA within the 21-month time limit under R. 104b(1). At the end of this period the EPO therefore issued a communication pursuant to R. 85a requesting payment of the fees to be paid under R. 104b, unaware that the extended time limit of 31 months under Chapter II PCT was applicable. However, the fees were not paid within the 31-month time limit and a request for re-establishment of rights was filed. In the meantime, the EPO had issued a notification pursuant to R. 69(1) indicating that the application was deemed to be withdrawn. This notification again referred to the 21-month time limit, the EPO still being unaware of its election. The Receiving Section went on to reject the request for re-establishment on the ground that re-establishment was excluded under Art. 122(5) in respect of the time limits for paying fees pursuant to R. 104b(1)(b) and (c) (following **G 3/91** (OJ 1993, 8)). The board held that the communication pursuant to R. 85a and the notification pursuant to R. 69(1) were legally non-existent because they could not be based on any provision in the EPC or the PCT. Thus, the reasons for which the party refrained from acting upon them were irrelevant as the communications could have no legal effect to the party's detriment. Further, according to R. 85a, the fees could still be paid with a surcharge within a period of grace of one month of notification of the failure to observe the time limit. As no such communication had been sent and the party had paid the fees and the surcharge, the proceedings for re-establishment were not necessary. The fact that the EPO continued the proceedings for, and finally refused, re-establishment of rights without taking into account the fact that these proceedings were unnecessary from the very beginning amounted to a substantial procedural violation.

A decision of an **examining division** of 5 June 1984 (OJ 1984, 565) pursuant to Art. 153(2) in conjunction with Art. 25 and Art. 24(2) PCT concerned the authority of a designated Office under Art. 24(2) PCT to maintain the effect of an international application. The applicant had missed the time limit for filing the authorisation for the representative set by the Japanese Patent Office acting as receiving Office.

The EPO, acting as designated Office, excused the non-observance of time limits which had been set by the receiving Office for the correction of formal deficiencies in accordance with Art. 14(1)(b) in conjunction with R. 26.2 PCT (Arts. 24(2) and 48(2)(a) PCT). The examining division found that the time limit under R. 26.2 PCT was to be compared with time limits set by the EPO under Art. 121 and granted re-establishment of rights according to Art. 122 in respect of the time limit under Art. 121(2).

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 had been filed in time had given rise to these considerations. The Presidents of the German Patent Office (GPO) 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 GPO, but addressed to or intended for the EPO, are treated as if they had been received on the day of actual receipt by the GPO.

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 GPO was therefore found to be valid to the extent that the possibility of confusion regarding the filing offices of both Offices actually existed. This potential for confusion 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 GPO'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 GPO, 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 GPO, relying on the Agreement published in the Official Journal.

The same danger of confusion has existed in Berlin as in Munich since the opening of the EPO's Berlin filing office on 1.7.1989. 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 was called upon to consider the admissibility of a notice of opposition filed by fax at the GPO 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 held that the opposition was admissible: oppositions filed within the prescribed time by fax at the GPO in Munich while intended for the EPO were covered by the Administrative Agreement of 29.6.1981 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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